

# Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection

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*Increasingly, the commercial and popular appeal of fictional characters far surpasses the characters' role within the original work. Thus, it is important to ensure that the characters' creators are fairly and uniformly protected from unauthorized exploitation of their creations. Moreover, many characters are now created outside the context of any specific work, and as a result may be left without any means of legal protection. This Comment examines the current legal protections available for fictional characters. The Comment considers the varying ways in which courts apply copyright, trademark, and right of publicity law to characters. The author argues that the lack of express copyright protection for fictional characters has resulted in inconsistent and inadequate legal protection. The Comment concludes that in order to properly shield characters and guide courts in their adjudication of character infringement cases, Congress should amend the 1976 Copyright Act by creating an express subject matter category exclusively for fictional characters.*

## INTRODUCTION

Fictional characters are second-class citizens in the world of intellectual property. Existing statutory schemes provide insufficient and haphazard protection for fictional characters. Although the laws of copyright,<sup>1</sup> trademark and unfair competition,<sup>2</sup> and publicity rights each offer some protection to fictional characters,<sup>3</sup> none of them adequately protect the economic and artistic interests of the creators of fictional characters.

The expansion of entertainment media during this century has directly enhanced the commercial value of identifiable characters.<sup>4</sup> Film, television, and video bring popular characters to an increasingly broad

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1. See *infra* notes 9-105 and accompanying text.

2. See *infra* notes 106-27 and accompanying text.

3. See *infra* notes 129-36 and accompanying text.

4. This value of characters was even recognized 35 years ago, long before the advent of

range of audiences.<sup>5</sup> Artists and promoters can tailor and retailor a successful character for whatever the market will bear. For example, a character that first appears as a literary portrait may later become the focus of a two-dimensional film, a three-dimensional stage performance, or a toy. With tie-ins to merchandizing, cartoons, commercials, comic books, dolls, and pinball machines, images of a popular character can inundate the media and the marketplace.

A versatile and popular creation, however, often inspires imitations. Despite the risk of unauthorized copying, copyright law gives no express protection to fictional characters—it protects fictional characters only when they are copyrightable components of preexisting “works.”<sup>6</sup>

This requirement and the inconsistent application of alternative protections make the existing protections for such characters problematic. First, the lack of express copyright protection unnecessarily complicates the infringement inquiry by forcing the court to determine whether the allegedly infringed character is copyrightable. Second, tying the character’s copyright protection to the copyright in the work makes determining legal ownership difficult in cases where the creator has separated the character from the work in which it originally appeared.<sup>7</sup> And characters that first appeared in works that have since entered the public domain,<sup>8</sup> or that are created outside the context of any “work” receive no copyright protection and are poorly served under alternative means.

This Comment argues that Congress should create an independent subject matter category in the current Copyright Act expressly for fictional characters. Characters deserve copyright protection independent of the protection given to an underlying work. Creating a distinct category of copyright protection for fictional characters would allow courts to make infringement findings based only on the similarity of the characters at issue and eliminate much of the difficulty in protecting characters as they move between mediums. It also would provide a clearer starting point for analyzing legal protection of a character whose existence precedes use in any work.

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VCR’s, cable television, and the international market for American films. See Waldheim, *Characters—May They Be Kidnapped?*, 12 BULL. COPYRIGHT SOC’Y U.S.A. 210, 215 (1964).

5. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 436 (1986) (noting the increased numbers of sequels and spinoffs). For example, a minor television character in one show can reappear as the central figure in a “spinoff” show. Sequels based on a popular character can generate millions of dollars and are becoming a standard formula for success in the film and television industries.

6. 17 U.S.C. §§ 102, 103 (1988).

7. Brylawski, *Protection of Characters—Sam Spade Revisited*, 22 BULL. COPYRIGHT SOC’Y U.S.A. 77, 78-79 (1974).

8. 1 M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT § 2.12, at 2-178 (1990) [hereinafter NIMMER ON COPYRIGHT].

Part I of this Comment describes the development of copyright protection for characters and its application to cartoon, literary, and audio/visual characters. This Part argues that, in determining whether a character is copyrightable, courts have confused the "copyrightability" inquiry with the infringement inquiry, and thus have given fictional characters inconsistent protection. Part II surveys the alternative protections courts sometimes apply in character cases and examines their strengths and weaknesses. Part III offers a method for implementing a separate fictional character subject matter category. Part IV examines the implications, objections, and applications of a new fictional character category and explains the appropriate role of alternative protections. Finally, this Comment concludes that the creation of a fictional character subject matter category would lead to both expanded character protection and more uniform adjudication of potential infringement claims.

## I

### CURRENT COPYRIGHT PROTECTION FOR FICTIONAL CHARACTERS

#### A. *Characters and Copyright Generally*

Copyright protection provides authors with a legal mechanism to control the use and exploitation of their creations. Copyright laws allow authors to mold the future of their creations, prevent abuses, and reap financial benefits.<sup>9</sup>

The 1909 Copyright Act provided broad copyright protection for all published writings.<sup>10</sup> Section 5 of the 1909 Act enumerated thirteen specific areas of protected works.<sup>11</sup> While the Act made no specific provisions for fictional characters, it protected the component part of a work *if* the character itself was deemed copyrightable.<sup>12</sup> The Copyright Act of 1976 eliminates the publication requirement for securing copyrights,<sup>13</sup> and provides that the creator of an original work of authorship fixed in a tangible medium<sup>14</sup> acquires federal copyright protection upon creation.

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9. Kurtz, *supra* note 5, at 437.

10. Copyright Act, ch. 320, § 4, 35 Stat. 1075, 1076 (1909) (current version at 17 U.S.C. § 102 (1988)). Section 2 provided: "That nothing in this Act shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor." *Id.* § 2, 35 Stat. at 1076 (current version at 17 U.S.C. § 301 (1988)).

11. *Id.* § 5, 35 Stat. at 1076-77 (current version at 17 U.S.C. § 102 (1988)).

12. *Id.* § 3, 35 Stat. at 1076 ("the copyright provided by this Act shall protect all the copyrightable component parts of the work copyrighted") (current version at 17 U.S.C. §§ 102, 103 (1988)).

13. 17 U.S.C. §§ 101-119 (1988).

14. *Id.* § 102(a).

The new act enumerates seven categories of protectable subject matter,<sup>15</sup> but none of the categories explicitly includes fictional characters: the 1976 Act did not change the status of fictional characters.

A fictional character has three identifiable and legally significant components: its name, its physical or visual appearance, and its physical attributes and personality traits or "characterization."<sup>16</sup> The combination of these three elements determines a character's copyrightability.

A fictional character's unique identity can be imagined as occupying a position along a delineation continuum ranging from vague idea to well-defined individuality. The position a character assumes on this continuum is based on the tangibility and objective development of these three elements. For example, a literary character, such as James Bond, is more fully delineated than is a roughly sketched cartoon character, such as a generic ghost. Nevertheless, because a literary character's only distinguishing traits are its name and the "word portrait"<sup>17</sup> of its characterization, courts have historically granted literary characters the least copyright protection.<sup>18</sup> Thus, their inherent ineffability limits the copyright protection of literary characters.<sup>19</sup>

This emphasis on objective criteria in determining a character's threshold copyrightability conflicts with the copyright infringement inquiry process for a work. In determining whether a copyrighted work has been infringed, courts generally undertake a two-step inquiry: First, was the copyrighted work copied? Second, was the copying significant enough to constitute an "improper appropriation of the copyrighted

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15. "Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works; and
- (7) sound recordings." *Id.*

16. Marks, *The Legal Rights of Fictional Characters*, 25 COPYRIGHT L. SYMP. (ASCAP) 35, 37-38 (1980); see also Comment, *Sequel Rights in the Law of Literary Property*, 48 CALIF. L. REV. 685 (1960) (authored by D. Kerson) (character consists of name, physical appearance, and fictional core); cf. Brylawski, *supra* note 7, at 78-79 (breaking down character into two parts: name and physical appearance, and personality).

17. See 1 NIMMER ON COPYRIGHT, *supra* note 8, § 2.12, at 2-178 ("word portraits" are literary characters, or those aspects of a character not represented by visual or audio communication); see also *Warner Bros. v. American Broadcasting Cos.*, 720 F.2d 231, 240 (2d Cir. 1983) (citing cases).

18. See, e.g., *Rokeach v. Avco Embassy Pictures*, 3 Med. L. Rptr. (BNA) 1774, 1779 (S.D.N.Y. 1978) (copyright only protects the "author's means of expression" of a character).

19. See, e.g., *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 755 (9th Cir. 1978) (defendant enjoined from publishing comic book featuring 16 Disney characters involved in various "counter-culture" activities), *cert. denied*, 439 U.S. 432 (1979).

work”<sup>20</sup> A court will find improper appropriation when the copy is substantially similar to the original.<sup>21</sup> Although there are several formulations for what constitutes substantial similarity, courts use “‘the spontaneous response of the ordinary lay observer’”<sup>22</sup> to determine infringement.

Courts use a slightly different analysis when a potentially copied character is at issue. Like the standard infringement test, the analysis involves a two-part inquiry: First, is the original character’s expression sufficiently delineated to be copyrightable? Second, is the infringing character’s expression substantially similar to that of the original character? If the answer to both questions is yes, then the court will find that the original character, as well as the entire work in which it appears, has been infringed. Because copyright adjudication of fictional characters is subject to a threshold “copyrightability” inquiry and because infringement of a character can occur only when there is also infringement of the underlying work, copyright protection for characters is subject to inconsistent adjudication.

### B. *The Delineation Paradox*

The two-step infringement inquiry for characters, discussed above, originated in *Nichols v. Universal Pictures*.<sup>23</sup> In *Nichols*, the court considered whether a motion picture had infringed the copyright in a play. In assessing the degree of similarity between the two works, Judge Learned Hand noted that characters might be enough alike, independent of any “plot proper,” to satisfy a claim of infringement.<sup>24</sup> In addition, he argued that a character’s “copyrightability” depended on its delineation:

If *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

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20. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (plaintiff must prove “(a) that defendant copied from plaintiff’s copyrighted work and (b) that the copying (assuming it be proved) went so far as to constitute improper appropriation”); see also *Warner Bros. v. American Broadcasting Cos.* 720 F.2d 231 (2d Cir. 1983); *Sid & Marty Krofft Television Prods. v. McDonald’s Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977) (“To constitute an infringement, copying must reach the point of ‘imlawful appropriation,’ or the copying of the protected expression itself.”) *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir.), cert. denied, 423 U.S. 863 (1975); W. PATRY, *LATMAN’S THE COPYRIGHT LAW* 191 (6th ed. 1986).

21. *Olson v. National Broadcasting Co.*, 855 F.2d 1446, 1448 (9th Cir. 1988); *Giangrosso v. Columbia Broadcasting Sys.*, 534 F. Supp. 472, 475-76 (E.D.N.Y. 1982); W. PATRY, *supra* note 20, at 196-97.

22. *Harvey Cartoons v. Columbia Pictures Indus.*, 645 F. Supp. 1564, 1568 (S.D.N.Y. 1986) (quoting *Walker v. Time Life*, 784 F.2d 44, 51 (2d Cir. 1986)).

23. 45 F.2d 119 (2d Cir. 1930), cert. denied, 282 U.S. 902 (1931).

24. *Id.* at 121.

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.*<sup>25</sup>

Scholars and judges alike have restated Judge Hand's infringement analysis as a two-step inquiry: "First, was the character as originally conceived and presented sufficiently developed to command copyright protection, and if so, secondly, did the alleged infringer copy such development and not merely a broader and more abstract outline."<sup>26</sup>

This restatement appears to confuse the two prongs of the copyright infringement test. Rather than deciding if the second character copied the first, and then determining whether that copying infringed upon protected expression, courts often fixate on the threshold copyrightability inquiry and never reach the standard infringement question between the works in question.<sup>27</sup> Courts applying these criteria have sometimes determined that characters are insufficiently developed to be copyrightable, thus denying protection to both the character and the underlying work.<sup>28</sup> In other cases, courts have found characters sufficiently delineated and granted copyright protection, even when the appropriation did not affect the underlying work.<sup>29</sup> The problem with this hybrid analysis is that it makes character protection under copyright "fraught with uncertainty" and creates the potential for both over- and under-protection.<sup>30</sup>

For example, in *Giangrosso v. Columbia Broadcasting System*,<sup>31</sup> the court considered whether a television episode had infringed a radio play script. The radio play's four-page script depicted a robbery interrupting a radio station's "remote" broadcast. The defendant's television show focuses on a fictional radio station. In the allegedly infringing episode, members of the station's staff are doing a "remote" broadcast from a stereo store when an out-of-work disc jockey attempts a fake robbery.<sup>32</sup> Under a traditional copyright analysis, the court would have found that

25. *Id.* (emphasis added).

26. Kurtz, *supra* note 5, at 453 (quoting 1 NIMMER ON COPYRIGHT, *supra* note 8, § 2.12 at 2-173); see also *Zambito v. Paramount Pictures*, 613 F. Supp. 1107, 1111-12 (E.D.N.Y. 1985), *aff'd*, 788 F.2d 2 (2d Cir. 1985); *Warner Bros. v. American Broadcasting Cos.* 530 F. Supp. 1187, 1193 (S.D.N.Y. 1982), *aff'd*, 720 F.2d 231 (2d Cir. 1983) (quoting 3 Nimmer on Copyright, § 12, at 2-169 (rev. ed. 1980)).

27. See *Giangrosso v. Columbia Broadcasting Sys.*, 534 F. Supp. 472, 477-78 (E.D.N.Y. 1982); *Fuld v. National Broadcasting Co.*, 390 F. Supp. 877 (S.D.N.Y. 1975).

28. See, e.g., *Olson v. National Broadcasting Co.*, 855 F.2d 1446, 1452-53 (9th Cir. 1988); see also Kurtz, *supra* note 5, at 453.

29. *United Artists Corp. v. Ford Motor Co.*, 483 F. Supp. 89 (S.D.N.Y. 1980).

30. *Anderson v. Stallone*, 1989 Copyright L. Dec. (CCH) ¶ 26,427, at 22,669 (C.D. Cal. 1989).

31. 534 F. Supp. 472.

32. *Id.* at 472-75.

copyright protection existed for the radio script's characters and then asked if the television characters infringed protected delineation of the radio characters. Instead the court focused on the delineation of the characters depicted in each work and denied copyright protection solely on the basis of its threshold character evaluation.<sup>33</sup>

If, however, a court finds a character independently protectable under the "copyrightability" test, it may over-protect the character by guarding against its appearance in a new work. For example, in *Anderson v. Stallone*, after finding that the cinematic character, Rocky Balboa, deserved independent copyright protection, the court prohibited the character's use in a new script for a potential sequel.<sup>34</sup> The court over-protected the Rocky character by stating that even new scripts incorporating the character would be copyright infringements.

Because of the court's uncertainty about the proper scope of character copyright protection, it failed to distinguish the protection of the specific character from the separate copyright protection of the new script. As a consequence, Stallone could take the plot ideas from the submitted script with impunity.<sup>35</sup> Because a fictional character must be exceptionally well delineated to be copyrightable, a preliminary determination that copyrightability exists effectively eliminates the need for making an infringement analysis. Thus, courts demand that artists claiming character infringement meet a higher standard of substantial similarity than artists that bring standard infringement claims.<sup>36</sup>

The inequities implicit under this standard are evident in *Warner Bros. Pictures v. Columbia Broadcasting System*,<sup>37</sup> popularly known as the "Sam Spade" case. In *Sam Spade*, the court examined the scope of the copyright protection that Warner Brothers purchased in Dashiell Hammett's book *The Maltese Falcon*. Warner Brothers claimed that CBS's use of the Sam Spade character in its 1946 radio show "The Adventures Of Sam Spade" infringed Warner Brother's copyright in *The Maltese Falcon*.<sup>38</sup>

After holding that Hammett had contractually reserved sequel rights to the Sam Spade character, the court considered whether

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33. *Id.* at 477-78.

34. *Anderson*, 1989 Copyright L. Dec. (CCH) at 22,671 (copyright protection of characters leads to result that Anderson's script is an unauthorized derivative work).

35. *Id.* at 22, 672-73.

36. 1 NIMMER ON COPYRIGHT, *supra* note 8, § 2.12 at 2-171 (explaining that under current copyright law, 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*").

37. *Warner Bros. Pictures v. Columbia Broadcasting Sys.*, 216 F.2d 945 (9th Cir. 1954), *cert. denied*, 348 U.S. 971 (1955).

38. *Id.* at 948.

Congress had intended to give copyright protection to fictional characters.<sup>39</sup> The court reasoned that the purpose of copyright was to "promote the useful arts," and that purpose would not be furthered if an author necessarily sold the future rights to the characters whenever he sold a story. The court thus proposed a standard for judging character protection that went far beyond the concept of delineation first articulated by Judge Learned Hand in *Nichols*:

It is conceivable that the character really constitutes the story being told, but if the character is the chessman in the game of telling the story he is not within the area of the protection afforded by copyright . . . . We conclude that even if [Hammett] assigned [his] complete rights in the copyright to the [Maltese] Falcon, such assignment did not prevent [him] from using the characters used therein, in other stories. The characters were vehicles for the story told, and the vehicles did not go with the sale of the story.<sup>40</sup>

According to the *Sam Spade* court, unless a character is itself the story, it cannot receive copyright protection.

Professor Nimmer interpreted the *Sam Spade* standard as a denial of copyright protection for all characters, no matter how well defined, because it "seems to envisage a 'story' devoid of plot wherein character study constitutes all, or substantially all, of the work."<sup>41</sup> Ironically, while the rule articulated in *Sam Spade* protected Hammett's right to reuse his characters, the rule potentially relegated all fictional characters to the public domain.<sup>42</sup>

Twenty-five years later, in *Walt Disney Productions v. Air Pirates*,<sup>43</sup> the Ninth Circuit appeared to limit the *Sam Spade* standard to *literary* characters. The *Air Pirates* court stated that the Disney characters' distinctive visual images allowed it to separate the characters' expression from the ideas underlying them. The court concluded that "[b]ecause comic book characters therefore are distinguishable from literary characters, the [*Sam Spade*] language does not preclude protection of [comic book] characters,"<sup>44</sup> and found Disney's cartoon characters copyrightable on the basis of their "physical as well as conceptual qualities."<sup>45</sup> This language, with its emphasis on the development of a given character, marked a shift back towards the *Nichols* formulation.

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39. *Id.* at 950.

40. *Id.*

41. 1 NIMMER ON COPYRIGHT, *supra* note 8, § 2.12, at 2-175.

42. Although the *Sam Spade* court did not, other courts have found that any arguments that the Maltese Falcon characters were in the public domain "were clearly untenable from the standpoint of public policy, for it would effectively permit the unrestrained pilfering of characters." *Goodis v. United Artists Television Inc.*, 425 F.2d 397, 406 n.1 (2d Cir. 1970).

43. 581 F.2d 751 (9th Cir. 1978), *cert. denied*, 439 U.S. 1132 (1979).

44. *Id.* at 755.

45. *Id.*



The *Air Pirates* court also found that the copying of the Disney characters' graphic images alone constituted an infringement.<sup>46</sup> Thus, not only did the court declare that comic book characters were copyrightable in and of themselves, it also asserted that mere visual duplication of a character could support an infringement claim.

Furthermore, when a copied expression includes "characterization," it can infringe the character's copyright even where it inexactly copies physical appearance or name of the underlying character. For example, in *Detective Comics, Inc. v. Bruns Publications, Inc.*,<sup>47</sup> the publishers of "Superman" comics claimed infringement of their character by a competitor's "Wonderman" cartoons. While the court noted that the two characters were not identical in appearance, it nevertheless found infringement because "[t]he attributes and antics of 'Superman' and 'Wonderman' are closely similar."<sup>48</sup>

In conclusion, their uniquely identifiable visual image component distinguishes cartoon and comic book characters from literary characters. Thus, under either the *Nichols* or *Sam Spade* formulation, courts can more easily cross the threshold copyrightability inquiry when the adjudication involves cartoon characters.

### 1. *The Uncertainty of Audio/Visual Characters*

Audio/visual characters incorporate traits of both literary and cartoon characters, but to varying degrees.<sup>49</sup> These hybrid creations, found usually on film or television, can appear anywhere throughout the delineation continuum. Typically, the more cartoonlike the character, the more courts will shelter it under copyright.<sup>50</sup> For example, in *Ideal Toy Corp. v. Kenner Products*,<sup>51</sup> the Southern District Court of New York compared certain characters from the movie *Star Wars* with Ideal's three "Star Team" characters. The court held that the mere similarity of appearance between a three-dimensional doll and a two-dimensional movie character could constitute infringement.<sup>52</sup>

Conversely, in *Warner Bros. v. Film Ventures International*,<sup>53</sup> the court found that the portrayal of a devil-possessed woman in the movie

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46. *Id.* at 756.

47. 111 F.2d 432 (2d Cir. 1940).

48. *Id.* at 433.

49. See Kurtz, *supra* note 5, at 467, 469 (audio/visual characters are hybrids, not fitting either the literary or the cartoon character model).

50. See, e.g., *Warner Bros. Pictures v. Columbia Broadcasting Sys.*, 720 F.2d 231 (2d Cir. 1983) (comparing super-hero characters); *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977) (television commercials were substantially similar to fantasy television program).

51. 443 F. Supp. 291 (S.D.N.Y. 1977).

52. *Id.* at 293.

53. 403 F. Supp. 522 (C.D. Cal. 1975).

*Beyond the Door* did not infringe the plaintiff's copyright on the main character in *The Exorcist*. Applying the *Sam Spade* stringent copyrightability test,<sup>54</sup> the court concluded that because the story of *The Exorcist* was not "subordinated to the character,"<sup>55</sup> the character was ineligible for copyright protection. The inconsistent holdings in these cases are more correctly attributed to the inconsistent approaches taken by the courts rather than to the relative similarities of the characters involved.

Because judicial definitions of copyrightability vary, some commentators have recently argued that viewing fictional character protection in terms of the character's threshold copyrightability muddles the infringement adjudication process.<sup>56</sup> While the pertinent factors in any substantial similarity analysis will necessarily vary, that variation should not be considered in determining whether the original expression of a character should be afforded copyright protection.

Establishing a fictional character category would underscore the importance of characters as independently protectable entities without forcing courts to undertake the threshold copyrightability determination. If a court undertakes a substantial similarity comparison and discovers no copying of a protectable expression, it would then find no infringement. Under this analysis the inquiry would not be muddled by a simultaneous or preliminary inquiry into whether the original character deserves protection. If the court finds copying, it should then use the *Nichols* delineation test to judge the copyrightability of the characters.

### C. The "Works" Problem

Courts have always viewed characters as components of the works in which they appear. This approach leads to a variety of problems. For instance, such characters, even if well developed, may have only a minimal impact on a work as a whole. Similarly, characters may appear in numerous works, sometimes in different media, frequently acquiring new attributes and characterization elements along the way. Finally, such characters may exist prior to inclusion in any recognized work. This Section explores these problems and the uncertainties they create for the protection of fictional characters.

#### 1. Separating the Character from the Work

One commentator has argued that courts should grant separate protection to characters because "the very fact [that the] character [has been] 'developed' or created and projected in depth itself renders the

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54. *Id.* at 525.

55. *Id.*

56. Kurtz, *supra* note 5, at 440, 472; Marks, *supra* note 16, at 40.

character a qualitatively substantial portion of the copied work [and] the subsequent literal copying of the character alone constitute[s] substantial similarity and copyright infringement."<sup>57</sup> In fact, a growing number of courts have evaluated infringement solely in terms of character appropriation.<sup>58</sup> These cases recognize that a character may be important outside the context of the work in which it appears.

This type of character copying analysis was at work in *United Artists v. Ford Motor Co.*<sup>59</sup> In that case, United Artists claimed that Ford had used a copy of the "Pink Panther" character in a series of car commercials. The plaintiffs, whose copyrights in the Pink Panther existed only as a component of its movies, argued that the Pink Panther was a qualitatively substantial element of its movies, even though it had appeared only in the title sequences of them.<sup>60</sup> The court skirted the issue of whether the plaintiff's movie copyrights covered the Pink Panther character by holding that Ford's animated cat and the Pink Panther were not substantially similar.<sup>61</sup> Had it found substantial similarity, the court would have had to determine whether the similarity between the characters was qualitatively substantial enough to support a finding of infringement.<sup>62</sup>

The "qualitatively substantial" standard is an outmoded and potentially dangerous hurdle that focuses the court's attention on an additional, unnecessary inquiry. The length of the character's appearance should not be dispositive. The crucial question should be whether the second character has improperly appropriated the protectable expression of the first character.

Copyright law should include an independent category for fictional characters so that they can be registered as works in and of themselves and receive copyright protection apart from their relation to any other work. The need for this special category becomes particularly acute when the "copied" character appears prior to the original character's incorporation into a completed, copyrighted work.<sup>63</sup>

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57. Davis, *Sequel Rights: Federal Copyright Protection of Fictional Characters*, 2 PERF. ARTS REV. 315, 334 (1971); see also *id.* at 336-37.

58. See, e.g., *Harvey Cartoons v. Columbia Pictures Indus.*, 645 F. Supp. 1564, 1571 (S.D.N.Y. 1986); *United Artists Corp. v. Ford Motor Co.*, 483 F. Supp. 89 (S.D.N.Y. 1980); *Ideal Toy Corp. v. Kenner Prods.*, 443 F. Supp. 291 (S.D.N.Y. 1977).

59. 483 F. Supp. 89 (S.D.N.Y. 1980).

60. *Id.* at 90-91.

61. *Id.* at 93.

62. *Id.* at 89. Perhaps under the 1909 Act this process made sense because the Pink Panther was not published, and hence not eligible for federal copyright protection until it appeared in the movie. Under the current Act, copyright protection exists upon fixation "in any tangible medium." Publication of that creation is not required. 17 U.S.C. § 102(a) (1988).

63. Under this scheme, litigation would have been avoided in the Pink Panther case. Since the Pink Panther character was created prior to creation of the film, it would be deemed copyrightable independent of the film. The animators could have licensed use of the character to Warner Brothers,

## 2. Character Migration Throughout Different Media

*Burroughs v. Metro-Goldwyn-Mayer, Inc.*<sup>64</sup> further demonstrates the importance of giving independent copyright protection for fictional characters. The *Burroughs* court addressed the question of whether the character Tarzan was independently copyrightable. Applying the analysis in *Nichols*, the *Burroughs* court asked whether aspects of copyright law were applicable to the character.<sup>65</sup>

Edgar Rice Burroughs first published *Tarzan of the Apes* in 1912.<sup>66</sup> In 1923, he transferred all his rights in the book, including copyrights, to ERB Inc.<sup>67</sup> In 1931, ERB licensed MGM to use the Tarzan character in an original screenplay.<sup>68</sup> MGM also acquired rights to produce remakes of the first film using the same title and basic story line.<sup>69</sup>

MGM produced its first Tarzan movie in 1932 and a remake in 1959.<sup>70</sup> In December 1977, Burroughs' heirs sent ERB notice of termination of its renewal copyright interest.<sup>71</sup> MGM did not learn of the purported termination until January 1980, at which time production was already underway on a second Tarzan remake.

In reviewing ERB's copyright claim, the court found that the 1931 ERB/MGM agreement did not transfer any copyright interest in Burroughs' book. Rather, the agreement merely conveyed a non-exclusive license to use the character.<sup>72</sup> Before it could apply the termination provision, however, the court had to determine whether Tarzan was a copyrightable character.

In evaluating whether the Tarzan character in Burrough's book was sufficiently delineated to receive copyright protection, the trial court did little more than describe the attributes of the character: "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 emotions. He is athletic, innocent, youthful gentle and strong. He is

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retaining copyrights themselves, or they could have released all authorship rights to the film's producer under a work-for-hire agreement.

64. 683 F.2d 610 (2d Cir. 1982).

65. Such an approach is required by an awkward yet increasingly common licensing approach, where the copyright owner of a particular work authorizes the use of a character within that work by means of a non-exclusive license.

66. *Burroughs*, 683 F.2d at 612.

67. *Id.* at 614.

68. *Id.* at 614-15.

69. *Id.*

70. *Id.* at 615-16.

71. *Id.* at 617-18; see also 17 U.S.C. § 304(c) (1988) entitled "Terminations of Transfers and Licenses Covering Extended Renewal Term."

72. *Burroughs*, 683 F.2d at 622-23.

Tarzan.”<sup>73</sup> This superficial analysis illustrates the difficulty of pinpointing precisely what is required for a literary character’s delineation to meet the elusive copyrightable distinction. Although the evidence noted in the opinion does not seem unduly persuasive, the trial court concluded that Tarzan was “sufficiently delineated by the author to be copyrightable.”<sup>74</sup>

The trial court’s opinion indicates that if Tarzan had not been sufficiently delineated, MGM would have retained its remake rights; the copyright laws would not have shielded the character alone. Thus, authors who license their characters for use in other media risk losing control of their characters. The law offers little reassurance that an adjudication will result in the author’s favor. This Comment suggests that the system could be improved by amending the existing statutes to allow separate copyright protection for the work’s characters, in addition to the general copyright protection for the work as a whole. Thus, a book may serve as the source of both copyright interests. As noted above, proof of delineation sufficient to render a character copyrightable should not be a prerequisite for protection.

When the work in which the character first appears enters the public domain, a new question compounds the infringement inquiry: can a character that originally appeared in a work that has since entered the public domain later appear in a legitimately copyrighted work be recopied for use in a new story?<sup>75</sup> A copier’s use of a sufficiently delineated character would infringe upon those works that retain valid copyrights.<sup>76</sup> Under the derivative-work doctrine, an individual may use a character from an otherwise original work if that work has since entered the public domain.<sup>77</sup> But the second author cannot use traits of the same character that were added in later copyrighted works.<sup>78</sup> According to this doctrine, a character can be dissected into protected and unprotected parts.

The court dissected the Amos ‘n’ Andy characters in this manner in *Silverman v. Columbia Broadcasting System*,<sup>79</sup> Amos ‘n’ Andy first

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73. *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 519 F. Supp. 388, 391 (S.D.N.Y. 1981), *aff’d*, 683 F.2d 610 (2d Cir. 1982).

74. *Id.* Although the lower court found § 304(c) applied to MGM’s license, the court did not enjoin MGM’s further use of the character in the current remake because of a defect in the termination notice given to MGM.

75. 1 NIMMER ON COPYRIGHT, *supra* note 8, § 2.12, at 2-177 to 178.2.

76. *Id.* at 2-173.

77. *See, e.g., Harvey Cartoons v. Columbia Pictures Indus.*, 645 F. Supp. 1564, 1571 (S.D.N.Y. 1986) (ghost logo not an infringement of comic book ghost when original comics now in public domain).

78. 17 U.S.C. § 103(b) (1988).

79. 870 F.2d 40 (2d Cir.), *cert. denied*, 109 S. Ct. 3219 (1989).

appeared on radio and eventually moved to television.<sup>80</sup> The early radio show scripts had fallen into the public domain; however, subsequent radio scripts as well as any television material were arguably still protected by copyright.<sup>81</sup> In *Silverman*, the plaintiff wanted to produce a Broadway musical based upon, and specifically including, the Amos 'n' Andy characters. He sought a declaratory judgment to determine the relative rights of the disputing parties.

The trial court concluded that, although the early scripts had fallen into the public domain, the characters' audio/visual representation on television was "the expression of an idea that goes beyond the word portraits in the public domain scripts and [was,] therefore, protectable by copyright."<sup>82</sup> The Second Circuit reversed on appeal. The court adopted the *Nichols* approach, holding that the Amos 'n' Andy characters that appeared in the early scripts were sufficiently delineated to warrant copyright protection in addition to the protection afforded to the overall works. Because those scripts had since entered the public domain, the plaintiff could use any of the Amos 'n' Andy character traits developed in them.<sup>83</sup> The court also held that any character traits added in the later scripts and television programs still under copyright were protected and could not be used by the plaintiff in his musical.<sup>84</sup> The result in this case was directly in keeping with the derivative-work doctrine.

The *Silverman* decision demonstrates that representations of the same character in different works, especially different works in different media, are considered cumulative expressions of an underlying idea. This judicial interpretation reveals the need to recognize each expression of a character as separately protected under copyright regardless of the character's delineation. Implementation of a fictional character category

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80. Freeman Gosden and Charles J. Correll created *The Amos 'n' Andy Show* for radio in 1928. It became one of the most popular radio shows in the country. *Silverman*, 870 F.2d at 42. Gosden and Correll assigned all their rights in the show to CBS, in 1948. CBS continued the radio programs until 1955. Between 1951 and 1953, CBS broadcasted an *Amos 'n' Andy* television series. The series continued in reruns and non-network syndication until 1966. *Id.*

81. The plaintiff claimed that CBS' placement of the television show videotapes with network affiliates through syndication was equivalent to a general publication without copyright notice, thereby putting the television shows in the public domain. The trial judge ruled that the "synchronized national broadcast" was not a general publication. *Silverman v. Columbia Broadcasting Sys., Inc.*, 632 F. Supp. 1344, 1354 (S.D.N.Y. 1986). The court of appeals did not reach this issue. *Silverman*, 870 F.2d at 49.

82. *Silverman*, 632 F. Supp. at 1355.

83. *Silverman*, 870 F.2d at 49-50 ("[W]e have no doubt that [Amos 'n' Andy] were sufficiently delineated in the pre-1948 radio scripts to have been placed in the public domain when the scripts entered the public domain.").

84. *Id.* at 50. Had the court not recognized that the characters' "word portraits" in the pre-1948 radio scripts alone were sufficient to establish "copyrightability," the characters would have belonged to CBS entirely, by virtue of their audio/visual depiction in the television shows.

would statutorily reinforce this conclusion. When a new author uses an old character in a new work with new attributes, she would have to secure copyrights to the character's previous manifestations.

### 3. "Pure" Characters

The current structure of copyright protection is further challenged when a human character portrayal, or "pure" character, is copied and recast as an audio/visual character. Pure characters such as "Fat Albert," "Pee Wee Herman," "Ernest," and the "Church Lady" may be created by street artists, stand-up comedians, or stage performers. An artist typically conceives of and performs her character before she places it in any "underlying work." Since the 1976 Act protects "works," not characters, it offers no protection to artists who fail to incorporate their characters into a protectable "work."<sup>85</sup>

The steady increase in the creation and use of "pure" characters justifies a corresponding expansion in copyright law. Under current law, character artists risk being robbed of their creations as well as their livelihoods. For instance, a producer may claim rights to another's "pure" character by including it in a film or television program. The injustice in demanding that actor Paul Rubens incorporate his Pee Wee Herman character into a film or television show before he can establish any rights in the character is readily apparent.

Perhaps the most important function potentially served by the creation of a fictional character category is the protection of the "pure" character. This section uses *Columbia Broadcasting System v. DeCosta*<sup>86</sup> to illustrate the unfairness of this current void in copyright law. Victor DeCosta was a Rhode Island mechanic who made public appearances at rodeos, parades, horse shows, and auctions dressed as a cowboy. He wore a mustache, a black shirt, black pants, and a flat-crowned black hat with a St. Mary's medal affixed to the front. He attached a chess knight to his holster. DeCosta was particularly known for his quick-draw demonstrations. Adopting the name "Paladin," DeCosta printed business cards bearing the image of a chess knight, and inscribed with the words "Have Gun Will Travel. Wire Paladin, N. Court St., Cranston, R.I."<sup>87</sup> During the course of his career he handed out more than 250,000 of these cards along with photographs of himself.<sup>88</sup>

Approximately ten years after his retirement, DeCosta saw his Paladin character on CBS television series "Have Gun Will Travel."<sup>89</sup>

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85. 17 U.S.C. § 102 (1988).

86. 377 F.2d 315 (1st Cir. 1967).

87. *Id.* at 316.

88. *Id.*

89. *Id.*

Like the DeCosta character, CBS' Paladin was also mustachioed, and wore a black outfit. In addition, CBS' character handed out cards bearing the image of a chess knight, with the words inscribed: "Have Gun Will Travel. Wire Paladin, San Francisco."<sup>90</sup>

DeCosta filed suit to claim his right to the Paladin character. Because he had not previously sought copyright protection for his character, he brought claims of misappropriation, trade and/or service mark infringement, and unfair competition by "passing off."<sup>91</sup> Only the misappropriation claim was tried.<sup>92</sup> The jury returned a verdict for DeCosta in the amount of \$150,000, but the First Circuit reversed. The appellate court's reasoning reveals the complexity of attempting to apply copyright to "pure" characters.

The First Circuit did not dispute the jury finding that CBS had "pirated" DeCosta's character.<sup>93</sup> The court, however, held that because DeCosta's character was copyrightable and he had not obtained such protection for it, DeCosta was not entitled to recover damages. The court acknowledged that DeCosta's public appearances alone were not enough to divest him of any common law copyright he might have had because they could not be considered a publication of his "writing."<sup>94</sup> The court, however, found that the business cards and photographs that DeCosta distributed had satisfied the publication requirement. Because neither the cards nor the photographs were copyrighted, DeCosta's character was in the public domain.<sup>95</sup> Relying on the Supreme Court decisions in *Sears, Roebuck & Co. v. Stiffel Co.*<sup>96</sup> and *Compco Corp. v. Day-Brite Lighting, Inc.*,<sup>97</sup> the court concluded that, because copyright was available to DeCosta, his other claims were preempted.

The Supreme Court in *Sears* and *Compco* held that a state law that forbade the copying of an article unprotected by a patent would interfere with federal policy.<sup>98</sup> The *DeCosta* court extended the *Sears* and *Compco* rule to include copyright as well as patents.<sup>99</sup> The court concluded "if a 'writing' is within the scope of the constitutional clause, and Congress

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90. *Id.* at 317.

91. The *DeCosta* court defined "passing off" as "appropriation not of the creation but of the value attached to it by public association (the so-called 'secondary meaning')." *Id.* at 318.

92. *Id.*

93. *Id.* at 317.

94. *Id.* at 321. Under the 1909 Act, copyrights did not vest upon creation of a work, but only upon its publication. Until publication, artistic creations were protected by state common law copyright. One of the major effects of the 1976 Act was to grant federal copyright protection upon creation, and not publication, of a work.

95. *DeCosta*, 377 F.2d at 321.

96. 376 U.S. 225 (1964).

97. 376 U.S. 234 (1964).

98. *Sears*, 376 U.S. at 231-32; *Compco*, 376 U.S. at 237.

99. *DeCosta*, 377 F.2d at 319. For an in-depth discussion of the *Paladin* case and its preemption ramifications in light of the *Sears* and *Compco* decisions, see generally Comment,



has not protected it, whether deliberately or by unexplained omission, it can be freely copied.”<sup>100</sup> DeCosta argued that his character was not copyrightable under the *Sam Spade* theory. The court disagreed, explaining that in the *Sam Spade* case “the sequel . . . was not so similar as to infringe the copyright. That is far from saying that characters are inherently uncopyrightable.”<sup>101</sup> Applying this expansive interpretation of the copyright clause, the First Circuit found that Paladin was copyrightable and denied DeCosta the opportunity to succeed under state law.<sup>102</sup>

Although both the 1909 and 1976 Acts support the court’s conclusion that DeCosta’s character lacked copyright protection, the court stumbled upon the correct result only by committing two analytical mistakes. First, whether DeCosta could have copyrighted his character is uncertain at best. DeCosta’s cards may have been sufficiently original to be copyrightable under either the 1909 Act or the 1976 Act.<sup>103</sup> But it is unlikely that the image of a chess knight on a plain white card would qualify as a “fixation” of the Paladin character;<sup>104</sup> the card lacked even a bare representation of Paladin’s physical appearance, let alone any characterization elements. The court denied DeCosta protection because he did not take the affirmative step of registering either his photographs or his cards even though those actions would probably not have protected his character. Second, had DeCosta copyrighted his cards and photographs, those copyrights would have protected only the reproductions of the cards and photographs themselves, not reproduction of the Paladin character.<sup>105</sup>

But the Paladin character is what DeCosta reproduced. All of his appearances after he handed out his photos were arguably copies. That he might have protected his creation by copyrighting his photographs exposes the need for statutory recognition of the character category. Such a category would allow creators to focus on properly fixating their personas, and thereby securing protection.

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*Copyright, Pre-emption and Character Values: The Paladin Case as an Extension of Sears and Compco*, 66 MICH. L. REV. 1018 (1968).

100. *DeCosta*, 377 F.2d at 319.

101. *Id.* at 320 (footnote omitted).

102. *Id.*

103. 17 U.S.C. § 102(a) (1988) Although originality was left purposely undefined in the 1976 Act, it is possible that a generic chess knight on a plain white card could rise to a level of original expression sufficient to warrant copyright protection). *See, e.g., Mazer v. Stein*, 347 U.S. 201, 217 (1954).

104. 17 U.S.C. § 102(a) (1988) (the chess knight, even if original, does not “fix” DeCosta’s character which includes his cards, performance and physical appearance).

105. *Id.* § 102; Marks, *supra* note 16, at 60. It is interesting to note that if DeCosta had copyrighted the Paladin character, any unauthorized use of the business cards or photos would have been protected as well. Marks, *supra* note 16, at 60 n.93.

### *D. Conclusion*

There are many human audio/visual characters who, like Paladin, are created prior to any inclusion in a "copyrightable work." Although these "pure" characters are a valuable form of artistic expression, current copyright law ignores them.

Under the current law, the second expression of a character in the same medium as the original expression is a derivative work of that character's original expression. If the original expression is in a copyrightable work, then copying the character may infringe that work's copyright. The law, however, makes no specific provisions for the protection of fictional characters as entities apart from a copyrighted work. This void ignores the realities of the rapidly expanding world of entertainment. Popular characters will often make their way into presequels, sequels, remakes, spinoffs, and merchandise. The character alone is valuable independent of any "work" in which it appears. An original character expression should not be vulnerable to unfettered duplication merely because it has not appeared in a copyrightable "work."

This Part has examined three problems arising from the current inability of copyright law to shield fictional characters consistently from improper appropriation. The unique ability of characters to move and grow between works and among media underscores the need for protection of characters separate from any individual work in which they may appear. Finally, current law leaves the creator of a pure character that exists, independent of, or prior to, its incorporation into any work without a method for securing copyright protection. As illustrated by the case law cited above, this lack of express protection for characters has forced courts to enter murky legal territory searching for some magical standard of copyrightability, as opposed to straightforwardly and uniformly addressing the more pertinent question of infringement.

## II

### THE PROBLEMS WITH ALTERNATIVE PROTECTIONS

Other doctrines have addressed a number of the deficiencies of character protection under copyright. Some courts have turned to alternative doctrines, such as federal trademark, common law unfair competition theory, and state law right of publicity, to protect fictional characters. While these mechanisms can sometimes be useful, they often either offer inadequate protection or are misapplied. This Part discusses how courts have employed these varied alternatives and explores the successes and failures of these efforts.

### A. Trademark and Unfair Competition

Trademark protection reaches any "word, name, symbol or device . . . used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others."<sup>106</sup> Most trademark infringement actions require proof of a likelihood of consumer confusion as well as a showing of secondary meaning attributable to the mark.<sup>107</sup> Unlike a copyright, a properly renewed and continuously used trademark may last indefinitely.<sup>108</sup>

Federal trademark protection does not attach automatically when a character is created. Instead, it is contingent upon the registrant's use, or good faith intention to use, the mark in commerce.<sup>109</sup> Moreover, the scope of the trademark's protection depends upon factors such as the distinctiveness of the mark, the type of good identified, the financial investment involved, and the public awareness of the nexus between the good and its manufacturer. All of these factors bear on the key trademark infringement question: Is there a likelihood of confusion as to the source of the mark?<sup>110</sup> Trademark provides a legal home only for those well-known fictional characters whose names or visual images readily identify a single source of authorship and who have had significant continued exposure to the general public.<sup>111</sup> The doctrine thus offers only limited protection against the unauthorized copying of a character. For

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106. Lanham Act, § 45, 15 U.S.C. § 1127 (1988). Similarly, courts have indicated that in cases involving fictional characters the same facts that support an action under section 43(a) of the Lanham Act will support a claim for common law unfair competition. *See, e.g., Ideal Toy Corp. v. Kenner Prods.*, 443 F. Supp. 291, 309 (S.D.N.Y. 1977).

107. *See, e.g., Ideal Toy Corp.*, 443 F. Supp. at 305, 309. 15 U.S.C. § 1125(a) (1988) provides that:

[A]ny person who shall . . . use in connection with any goods or services . . . a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce . . . shall be liable in a civil action . . . by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.

108. 15 U.S.C. § 1058 (1988) provides that each certificate of registration shall remain in force for only ten years, and shall be cancelled after six years unless the registrant files an affidavit showing that the mark is still in use or explaining its nonuse. 15 U.S.C. § 1059 allows an indefinite number of renewals.

109. 15 U.S.C. 1051 (1988).

110. *See* 2 J.T. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 23:1 (2d ed. 1984).

111. Although trademark law does not provide adequate protection for characters, there are instances where its protection is sufficient. One early twentieth century case, illustrating the proper utilization of trademark and unfair competition protection, applied those doctrines to a title that also happened to be a character name. In *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y. 1934), the defendant used a character named Frank Merriwell in its film. The plaintiff had published over 1,200 stories revolving around a character of the same name. There were no other similarities between the two characters. The court held that the name "Frank Merriwell" had become exclusively associated with the plaintiff author, and therefore enjoined release of the defendant's motion picture. *Id.* at 197. Since copyright expressly denies protection to titles and names, 1 NIMMER ON COPYRIGHT, *supra* note 8, § 2.16, the application of unfair competition and

example, the public seldom associates a particular character with a particular author immediately; such association takes time to establish. In the interim, a court may deny trademark protection if the plaintiff cannot demonstrate a likelihood of consumer confusion. Indeed, some characters never achieve the level of recognition necessary to garner trademark protection, and others are ineligible for protection because they are identified with multiple sources.<sup>112</sup> When employed in the fictional character context, the trademark and unfair competition doctrines are stretched beyond their intended scope to fill holes in protection that are more appropriately handled under copyright. Neither of these doctrines adequately substitute for copyright protection. While either trademark or unfair competition law can occasionally shield the most well-known character's name and appearance, neither doctrine can provide full protection for fictional characters.

Fictional characters' uncertain copyright status has led some courts to apply trademark law to cases better suited for copyright protection.<sup>113</sup> Courts have sporadically extended trademark protection to character appearances, and even characterizations, without regard to whether the public would associate the particular use of the character with its creator.<sup>114</sup> The Second Circuit, for example, has held that the Lanham Act

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trademark is clearly appropriate when the character name is so intimately tied to the author. 15 U.S.C. § 1127 (1988) (titles and character names expressly protectable as service marks).

A title may be protected under unfair competition if it has developed a secondary meaning and there is a likelihood that its use on another work will lead to public confusion. See Kurtz, *Protection for Titles of Literary Works in The Public Domain*, 37 RUTGERS L. REV. 53, 59, 61; cf. Premier Pabst Corp. v. Elm City Brewing Co., 9 F. Supp. 754 (D. Conn. 1935) (court found that the sobriquet "Old Maestro" for composer who advertised Pabst's beer had become identified with the product, and thus enjoined defendant from calling his beer "Olde Maestro").

112. Since trademark law encompasses names and symbols, a character name is frequently held registerable as a trademark, on the rationale that the character's name also identifies the author who is analogous to the character's manufacturer. This reasoning is questionable in many character cases because actual secondary meaning for a character name accrues only to those characters who are readily associated with an identifiable source. For example, almost everyone knows that "Mickey Mouse" is a Disney character.

113. *Chaplin v. Amador*, 93 Cal. App. 358, 269 P. 544 (1928) (imitator of actor Charlie Chaplin held to have counterfeited Chaplin's character by imitating his dress, costumes, and mannerisms, thereby causing public deception).

114. *Lone Ranger, Inc. v. Cox*, 124 F.2d 650 (4th Cir. 1942) (court enjoined a person who had played "the Lone Ranger" in a motion picture from appearing as the same character in a circus when his appearance could cause confusion with the radio show "the Lone Ranger"); *Hospital for Sick Children v. Melody Fare Dinner Theatre*, 516 F. Supp. 67, 73 (E.D. Va. 1980) (court found that a musical production with characters "Peter Pan" and "Tinkerbell" infringed the copyrighted story of "Peter Pan or the Boy Who Would Not Grow Up") (This commentator expresses serious doubts that the general public associates "Peter Pan" with its original author, James Matthew Barrie, as the court so found); *Edgar Rice Burroughs, Inc. v. Manns Theatres*, 195 U.S.P.Q. (BNA) 159 (C.D. Cal. 1976) (court found that use of names "Tarz," "Jane," "Boy," and "Cleeta" in an X-rated film could cause likelihood of confusion to potential customers).

protects fictional characters' names, costumes, and physical appearances.<sup>115</sup> But the Lanham Act offers uncertain protections. Each claim is subject to the vagaries of the character's use, the rise and fall of the character's popularity, and the public's awareness of the character's creator. Sporadic judicial application of trademark law has masked the need for extending copyright protection to all fictional characters, especially those that are less recognizable.

For example, in *DeCosta*,<sup>116</sup> neither trademark nor unfair competition would have protected DeCosta because his personal appearances generated relatively little public awareness of his character. Unless DeCosta could have established secondary meaning and consumer confusion between his character and the one portrayed in the television show, trademark would not apply. Although CBS did not try to "pass off" its actor as Victor DeCosta, it copied the Paladin character nonetheless. Thus, this doctrine would not benefit a copied "pure" character who has had minimal public exposure, or even most minor characters that exist in "works." Moreover, trademark law ignores the possibility that a competitor's conduct may be fair at one time and foul at another. The public confusion requirement makes the *quantity* of the character's use dispositive. In contrast, under copyright the right is "built in" and determines the use allowed.<sup>117</sup>

Trademark can protect a fictional character only when the public identifies the character, or one of its elements, with one particular source.<sup>118</sup> Yet, as noted above, fictional characters are often associated with multiple sources.<sup>119</sup> For example, in *Universal City Studios v. Nintendo*,<sup>120</sup> the rights to King Kong were found to be divided among a number of parties.

RKO Pictures acquired rights to the King Kong story and eventually made the movie featuring the gorilla atop the Empire State Building.<sup>121</sup> Between 1933 and 1975, RKO issued numerous licenses for products to use the character's name and visage. Additionally, Universal Pictures and another film company argued over ownership of King

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115. *DC Comics, Inc. v. Filmation Assocs.* 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980); *see also* *United Features Syndicate v. Sunrise Mold Co.*, 569 F. Supp. 1475 (S.D. Fla. 1983) (holding that the likenesses of certain cartoon characters were protected under the Lanham Act as well as the doctrine of unfair competition).

116. *See supra* notes 86-105 and accompanying text.

117. Raskin, *Copyright Protection for Fictional Characters*, 2 *PERF. ARTS REV.* 587, 608 (1971).

118. *See e.g.*, *Frederick Warne & Co. v. Book Sales Inc.*, 481 F. Supp. 1191 (S.D.N.Y. 1979) (publisher required to establish a specialized secondary meaning for illustrations accompanying books to have a protectable trademark interest).

119. *See generally* Kurtz, *supra* note 5, at 485-89 (describing how characters have been associated in the public mind with their authors, producers, sponsors, and even with themselves).

120. 578 F. Supp. 911, 923 (S.D.N.Y. 1983), *aff'd*, 746 F.2d 112 (2d Cir. 1984).

121. *Id.* at 914-15.

Kong's remake rights.<sup>122</sup> Nintendo created the "Donkey Kong" video game, which features a carpenter rescuing a girl from a gorilla atop an unfinished structure.<sup>123</sup> Because Universal owned some rights but not others, the court held that the "vagueness of the image in which Universal claimed a trademark right violates the fundamental purpose of a trademark: to identify the source of the product and thereby prevent consumer confusion as to the source."<sup>124</sup> Because the King Kong character could not be traced to a single source of origin, no public confusion could exist and King Kong had no trademark protection.

Finally, confusion over the appropriate reach of copyright law has led to the inconsistent application of these alternative doctrines. Courts appear to disagree as to whether they should turn to other remedies when copyright law is deficient. Thus, in *Fisher v. Star*,<sup>125</sup> after finding copyright inapplicable to the characters themselves, the court protected the names and appearances of two comic strip characters under the doctrine of unfair competition. In contrast, the court in *Gruelle v. Molly-'Es Doll Outfitters, Inc.*<sup>126</sup> held that the defendant's Raggedy Ann and Raggedy Andy dolls were "deceptively similar . . . to the dolls of [plaintiff's] books, cartoons, and syndicated newspaper drawings."<sup>127</sup> Nevertheless, the court believed that only copyright could protect the doll's appearances and enjoined defendant's use of the names but not their appearances.<sup>128</sup>

In sum, trademark and unfair competition law may legitimately protect only a very narrow range of characters or character elements. Because these causes of action place increased burdens of proof on the plaintiff, they are of little use in the vast majority of cases and may provide little more than a false sense of security.

### B. Right of Publicity Misapplied

Some courts have used the right of publicity to protect authors from fictional character appropriation.<sup>129</sup> The right of publicity provides a person with a descendible right in the commercial exploitation of his or her name and likeness and prevents unauthorized exploitation by

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122. *Id.* at 915.

123. *Id.* at 917-18.

124. *Id.* at 924.

125. 231 N.Y. 414, 132 N.E. 133, *cert. denied*, 257 U.S. 654 (1921).

126. 94 F.2d 172 (3d Cir. 1937), *cert. denied*, 304 U.S. 561 (1938).

127. *Id.* at 175-76.

128. *Id.* at 176.

129. Note, *The Right of Publicity Run Riot: The Case of a Federal Statute*, 60 S. CAL. L. REV. 1179 (1987) ("The right of publicity is the right to be free from having one's name, likeness and identifying characteristics expropriated for commercial purposes without consent.").

others.<sup>130</sup> The doctrine's essential purpose is to protect well-known people from the unauthorized commercial exploitation of their names and likenesses. The doctrine, however, is not designed to protect character creations.

Some courts have nevertheless applied the right of publicity to certain fictional character creations. For example, in *Groucho Marx Productions v. Day and Night Co.*,<sup>131</sup> the heirs of the Marx Brothers sought to enjoin production of a satirical play featuring characters that had the trio's appearance and characterizations. Since human characterizations cannot be copyrighted apart from some "work," the court adopted a right-of-publicity rationale to protect the Marx Brothers characters from being recreated in the play. Rejecting the defendants' "fair use" claim,<sup>132</sup> the trial court found that the play "duplicat[ed] as faithfully as possible the performances of the Marx Brothers, albeit in a new situation with original lines."<sup>133</sup> Thus, the court concluded "the defendants have not rebroadcast Marx Brothers acts but have reproduced their manner of performances by imitating their style and appearance. . . . [The play] has infringed the plaintiffs' rights of publicity in the Marx Brothers characters."<sup>134</sup>

The trial court's holding exemplifies how the right to publicity doctrine is subject to misapplication. A right of publicity should apply to commercial exploitation of the nonfiction human being, not to fictional creations.<sup>135</sup> In this case, the court confused the creators with their characterizations, and, consequently, misapplied the right of publicity to the latter. The defendants' play did not appropriate the actors themselves, only their characters. Admittedly, the line is somewhat fuzzy in this instance because the actors and their characters are both human, and necessarily have similar likenesses.<sup>136</sup>

130. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278, 287 (2d Cir. 1981) (Mansfield, J., dissenting) (arguing the right of publicity), *cert. denied*, 456 U.S. 927 (1982); *Haelen Laboratories v. Topps Chewing Gum*, 202 F.2d 866 (2d Cir. 1953) (right of publicity is an exclusive privilege to export a public identity), *cert. denied*, 346 U.S. 816 (1953); *Allen v. National Video, Inc.* 610 F. Supp. 612, 621 (S.D.N.Y. 1985) (defining the right of publicity as a protection of the property interest of a celebrity's public identity). But see, *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 823-24, 603 P.2d 425, 431, 160 Cal. Rptr. 323, 329 (right of publicity must be exercised during one's lifetime and is not a descendible right). For historical background on the right of publicity, see Note, *Torts—The Right of Publicity—Protecting a Celebrity's Identity*, 52 TENN. L. REV. 123 (1985).

131. 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982).

132. *Id.* at 492-93 (the court saw the defendants as imitators "usurp[ing] a work for commercial gain," not commentators creating a "larger presentation").

133. *Id.* at 493.

134. *Id.* at 494 (footnote omitted).

135. See Note, *supra* note 129, at 1180.

136. *Groucho Marx Prods.*, 523 F. Supp. at 493 (describing defendant's actions as "the wholesale appropriation of the Marx Brothers characters"); see also *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975) (right of publicity invoked to protect unauthorized commercial use of Laurel and Hardy characterizations); *Lugosi v. Universal Pictures*, 25 Cal. 3d

Although it protected the Marx Brothers characters from wrongful appropriation, the strained application of the right-of-publicity doctrine in this case reveals the need for an effective remedy under copyright law. By first recognizing that the Marx Brothers characters were protected by copyright law, the court could have applied a standard two-part infringement analysis. Having found that the play copied the Marx Brothers' characterizations and that the play's characters were substantially similar to the Marx Brothers, the court could have found infringement. Such reliance on copyright is preferable because it is simpler and more uniformly applicable than is the relatively new state law right-of-publicity rationale.

As evidenced in the above Section, no existing alternative provides an adequate substitute for a specific provision of copyright law designated for fictional characters. Although trademark may provide some protection for highly recognizable characters associated with a single author, it leaves many new visual characters and almost all literary characters unprotected. Similarly, the state law right-of-publicity doctrine is useful because it prevents commercial exploitation of an actor's name, face, or voice. But this doctrine cannot be easily applied to audio/visual characters and is wholly inadequate for protecting literary or nonhuman characters.

The trend has been for courts to bend these alternative protections to fit character protection needs, or alternatively, to extend copyright intermittently. These inconsistent and, at times, erroneous applications should be replaced by a single, definitive statement of statutory inclusion under copyright.

### III

#### CREATING A NEW CATEGORY OF COPYRIGHT PROTECTION

Copyright provides insufficient protection for fictional characters. The threshold copyrightability requirement leads to muddled inquiries regarding delineation and infringement. Moreover, attaching copyrights only to the work and not to the character limits protection for characters that move into new works and new mediums and leaves pure characters unprotected. The inadequacy of alternate protections, such as trademark, unfair competition, and the right of publicity, compound the failure of copyright to provide adequate protection. Creating a separate category of copyright protection for fictional characters could solve these problems.

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813, 603 P.2d 425, 160 Cal. Rptr. 323 (Lugosi's portrayal of Dracula viewed as right of publicity rather than audio/visual character expression). Nevertheless, the defendant was guilty of character infringement.



The seven categories of protectable subject matter<sup>137</sup> listed in section 102(a) of the 1976 Copyright Act are "illustrative and not limitative."<sup>138</sup> The Act's drafters described these areas in general terms so that they would not bind future courts to rigid or outmoded concepts of a particular category's scope.<sup>139</sup> Congress has expanded the scope of copyrightable material when it has found evidence of a particular need. For example, in 1972, it established a separate category for sound recordings in response to increasing common law protection.<sup>140</sup> Similarly, the 1976 Act implicitly recognized the importance of performance arts by making special provisions for pantomimes and choreographic works.<sup>141</sup> These examples indicate that Congress may further broaden the Copyright Act to include a special category for fictional characters.

In the past, a number of scholarly and judicial proposals for a fictional character category have been advanced but ultimately rejected.<sup>142</sup> In his 1965 report, the Register of Copyrights explained why fictional characters have not been added to the list:

Proposals have been advanced for identifying fictional characters as copyrightable works in themselves under the bill. There are undoubtedly some characters that are developed in detail and with such breadth and depth that they emerge as separately identifiable parts of the copyrighted works in which they appear. Others, perhaps the large majority, cannot be said to represent independent creations apart from the particular literary or pictorial works depicting them. As is equally true in the case of detailed presentations of plot, setting, or dramatic action, we believe it would be unnecessary and misleading to specify fictional characters as a separate class of copyrightable works.<sup>143</sup>

While this reasoning may have been sound twenty-five years ago, it is inapplicable to the current world of entertainment. In light of the increasing judicial acceptance of independent character copyrightability, the proven economic value of a successful character in various media, and the technological explosion that can create unique visual characters,

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137. See *supra* note 15.

138. 17 U.S.C. § 102 note (1988).

139. *Id.*

140. Federal copyright protection of sound recordings was established in 1971 by the passage of Pub. L. No. 92-140, 85 Stat. 391 (1971) amending then 17 U.S.C. §§ 1(f), 5(n), 19, 20, 26, 101(e) (not external to the copyright Act of 1976); see also *Goldstein v. California*, 412 U.S. 546, 563, *reh'g denied*, 414 U.S. 883 (1973).

141. 17 U.S.C. § 102(a)(11) (1988).

142. See, e.g., Wincor, *Copyright and the Spin-off Hero*, *Variety*, Jan. 9, 1963, at 8; see also, *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir.), *cert. denied*, 298 U.S. 669 (1936); *Kurlan v. Columbia Broadcasting Sys.*, 40 Cal. 2d 799, 819, 256 P.2d 962, 975 (1953) (Carter, J., dissenting) ("Characters and characterizations which are products of the mind *should* be held to be protectable property interests") (emphasis in original).

143. Supp. Rep. of the Register of Copyright on the General Revision of U.S. Copyright Law: 1965 Revision Bill, 89 Cong. 1st Sess. 6 (1965).

explicit statutory protection for fictional characters is now necessary to assure consistency in adjudicating authorship and ownership rights. As one commentator notes: "Artists who create characters that stir the imagination ought to be in a class with people who own homes and common stocks; all of these are private property."<sup>144</sup> The creation of a separate category for copyright protection of fictional characters would assure that such rights were not infringed unfairly.

The commonly raised objections to creating a separate category of protection for fictional characters are insubstantial. The copyright categories enumerated in the statute are not mutually exclusive;<sup>145</sup> thus, fictional characters should not be limited to the protection they may arguably enjoy under an existing category. Furthermore, the Register's statement that separate fictional character protection is equivalent to separate protection for plot, setting, or dramatic action seems incorrect. Unlike the plot, setting, or dramatic action, the fictional character is the most movable component of an entertainment production. For example, the success of the James Bond film series reflects the popularity of the Bond character itself, not the popularity of any particular location or story line.

The benefits of establishing a category for fictional characters are readily apparent. First, the creation of a fictional character category would eliminate the confusion that results when courts must make a threshold determination as to whether a literary, human, cartoon, or hybrid character is a copyrightable component of a copyrighted work before examining the question of infringement. Second, such a category would also fill existing gaps in legal protection for characters that are created prior to inclusion in any "work." A separate copyright on these characters would make it easier to establish their legal status and to assure their creators of rights in the character independent of any accompanying plot or story.<sup>146</sup> Finally, creation of such a separate category would clarify any ambiguity as to whether alleged appropriation of characters should be governed by copyright law or some alternative federal or state law theory.<sup>147</sup>

#### *A. Shifting the Focus to Infringement*

Under the current Copyright Act, the technical problem of analyzing a character's copyrightability often preoccupies the courts. The resolution of this dilemma typically precedes, or in some cases preempts, any

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144. Wincor, *supra* note 142.

145. 17 U.S.C. § 102 note (1988).

146. Raskin, *supra* note 117, at 609.

147. *Id.* at 611.

evaluation of the infringement question.<sup>148</sup> Establishing a fictional character category would refocus courts' decisionmaking on the crucial analysis of infringement.

Under this Comment's proposed amendment, a character that meets the same minimum originality requirement as other copyrighted works would be protected by copyright. Courts would no longer need to make a preliminary finding of copyrightability before granting copyright protection. What the courts have been calling "copyrightability" should actually be an evaluation of which aspects of the character may or may not be freely copied; there should be no inquiry into whether the character deserves protection. The creation of a category for fictional characters would allow courts to return to the standard infringement test.

Similarly, courts should look at delineation solely for the purpose of determining infringement. A court employing a basic infringement analysis must first evaluate how much of a character is original expression. The court then compares this original expression to the expressive aspects of the allegedly infringing character to see if a protected expression has been copied. While all character creations may be copyrighted, only the unique aspects of those characters' expression are protected from copying, and only substantial copying of protected expressions will constitute an infringement.

For example, in the "Pink Panther" case,<sup>149</sup> both the Pink Panther and Ford's animated cat are undoubtedly "original works of authorship fixed in any tangible medium."<sup>150</sup> Thus, under the approach advocated by this Comment, they both should be protected by copyright; no evaluation of each character's "delineation" is needed to determine if the two cats are copyrightable. The "delineation" inquiry would merely serve as a survey of the unique expression aspects of the Pink Panther. The court would then compare this original expression to the expressive aspects of Ford's cat to make its infringement determination. The Pink Panther example illustrates how the court's analysis would necessarily shift if it were not required to make any ruling as to copyrightability.

Of course, the comparison proposed above would be easier if the original character were well delineated. It would be more difficult to compare similarities between literary characters whose expression consists only of a name and "word portraits." But this additional difficulty should not deter courts from attempting to draw that line. In the words of Judge Hand: "While we are as aware as anyone that the line, wherever it is drawn, will seem arbitrary, that is no excuse for not drawing it;

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148. *Id.*

149. *United Artists Corp. v. Ford Motor Co.*, 483 F. Supp. 89 (S.D.N.Y. 1980).

150. 17 U.S.C. § 102(a) (1988).

it is a question such as courts must answer in nearly all cases.”<sup>151</sup> Thus, courts should give copyright protection to literary characters, although it may be somewhat difficult for them to do so.

When considering the portrayals of pure characters, courts should give less weight to the visual appearance component because film and television characters present unique characterization aspects that contribute to the comparison. In fact, given the uniqueness of human features, the primary focus might be placed better on the characterization itself. When characterizations are impossible to compare, such as with a movie character and a three-dimensional doll, physical similarities should be the primary criteria for measuring potential infringement.<sup>152</sup>

### *B. Ensuring Protection in Other Media*

Those who believe a character's actions, dialogue, development, and “feel” in the context of the work in which it is embodied determine part of its expression have criticized the practice of determining infringement solely by comparing the similarity of characters. These scholars argue that a determination of substantial similarity cannot be divorced from context.<sup>153</sup> Granting a copyright in a character does not, however, mean that the context in which the character exists will subsequently be ignored for purposes of measuring infringement. If both the infringed and infringing characters appear in the same medium it would be fair to consider the “total concept and feel” of the two works in making a judgment about character infringement.<sup>154</sup> For instance, if the court were comparing two literary characters, the relationships, plot development, and setting of a book would be relevant to the infringement analysis.

By incorporating an examination of a character's relation to its work into the analysis of infringement, courts will ultimately have more flexibility in their decisionmaking. When characters in similar works are compared, the works themselves are necessarily part of the comparison. On the other hand, when a character in a film is compared with an image on a poster, only those elements common to both media should be compared. In some cases, a comparison of all elements in a film or television

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151. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931).

152. *See Ideal Toy Corp. v. Kenner Prods.*, 443 F. Supp. 291, 302 (S.D.N.Y. 1977) (comparison between “Star Wars” movie characters and “Star Team” dolls “made solely on basis of physical appearance”).

153. *Olson v. National Broadcasting Co.*, 855 F.2d 1451 (9th Cir. 1988) (court found that similarity of characters alone, without any other supporting similarities, in two television shows insufficient to find infringement).

154. *See Reyher v. Children's Television Workshop*, 533 F.2d 87, 91-92, (2d Cir.) (defendant's magazine did not infringe on plaintiff's storybook because the two works differed in setting, mood, and character developments), *cert. denied*, 424 U.S. 980 (1976); *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970).

program may reveal elements of expression that render the entire work infringed even though no individual character has been infringed. The proposed analysis of character context will allow for flexibility in these different situations. This method will serve the author's interests in protecting her characters and her works as a whole, as well as the public interest in encouraging a variety of artistic creations.

As discussed above, the current protection system requires that an artist place her character in a protectable work before she obtains protection. This presents a problem to the creator when she creates a character before she completes the work in which it appears. If another party places the character in a protected work first, the original creator will lose her rights to the creation.<sup>155</sup> This problem is more serious if the original work is never completed. In that case, a character is left in peril, unable to obtain protection, and sufficiently delineated to attract a third party who may want to copy it in the future.

The fictional character category resolves this problem. Once a character is eligible for protection separate from that given to the underlying work, its creator need not wait for creation of a work to obtain protection for the character: the protection would attach at the moment of the character's creation. Independent registration of a fictional character's first tangible expression would protect the character even if the "work" is never completed. Character registration would also allow a creator to bring a suit for infringement without reliance on a "work" copyright.<sup>156</sup>

Furthermore, the creation of a separate fictional character category would allow courts to consider cases of "pure" character infringement. Although cases involving infringement of "pure" characters would still entail a substantial similarity analysis, the proposed category would allow registration of individual portrayals, which would serve as *prima facie* evidence of copyright protection. Thus, comedians would be able to protect their creations of comedic persons without incorporating them into a specific work. In conclusion, the creation of a distinct category for fictional characters would eliminate the deficiencies that plague the current statute in this context.

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155. See, e.g., *Universal City Studios v. J.A.R. Sales*, 1982 Copyright L. Dec. (CCH) ¶ 25,460 (C.D. Cal. 1982) (enjoining the sale and distribution of the I.T. doll that infringed on the copyrightable E.T. character); see Brylawski, *E.T.: An Extraterrestrial Caught in a Copyright Dilemma*, 52 GEO. WASH. L. REV. 395 (1984) (describing the case background and proposing solutions to the apparent problems).

156. These claims may be statutorily correct under the current Act's definitions of compilations and derivative works. 17 U.S.C. § 103(b) (1988).

## IV

## THE IMPLICATIONS OF CREATING A SEPARATE CATEGORY

Although the creation of a separate category for fictional characters could solve many of the current problems of copyright protection, it is unclear exactly how such a scheme would function in practice. This Part speculates on the procedural aspects of securing protection once a fictional character category has been created. It examines the registration process as well as the implications of fictional character registration. Lastly, it discusses the limited role alternative protections would play under the proposed scheme.

*A. Authorship*

The current Copyright Act authorship provisions<sup>157</sup> should be sufficiently flexible to accommodate a subject matter category for fictional characters. Literary works and the characters within them may be created by one author, as in a book, or may be attributed to multiple authors, as in the development of some film and television screenplays. Cartoons present a stronger possibility of joint authorship because the character usually embodies both visual images and written speech.

If different authors contribute the graphic and written elements, the character likely will be considered a "joint work" for purposes of protection.<sup>158</sup> This is true even though the visual element is the dominant characteristic against which similarities will be measured in evaluating infringement.<sup>159</sup> If a cartoon character is prepared under contract, or in a traditional employer-employee situation, then the employer will be considered the author of the entire character for copyright purposes.<sup>160</sup>

The question of authorship becomes more complicated when a human performer gives her visual and personality characteristics to the character. A character embodies talents and traits selected by the performer,<sup>161</sup> such as the performer's own voice, appearance, mannerisms, and new expressions, that help define the character's overall personality. When the performer crafts all the character elements herself, authorship is clear.<sup>162</sup> Often, however, the performer will base a new character on one that has been previously created or expressed. The new expression

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157. *Id.* § 102(a).

158. *Id.* § 101. A "joint work" is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

159. *Warner Bros. v. American Broadcasting Co.*, 720 F.2d 231, 242 (2d Cir. 1983).

160. *See* 17 U.S.C. § 101 (1988) (definition of "work made for hire").

161. *Warner Bros.*, 720 F.2d at 243.

162. *See* *Chaplin v. Amador*, 93 Cal. App. 358, 269 P. 544 (1928).

elements of such a character still merit protection. Thus, a fictional television character should be considered a joint work of authorship consisting of the written expression of the writer and the appearance and characterization of the performer. It follows that if the written description is in the public domain, a performer's embodiment of the character, to the extent that it contributes additional expression, should be protectable under copyright.

Focusing on authorship of the character as distinct from authorship of the work creates the possibility of conflict between the owner of the character and the owner of the work over the right to control subsequent uses of the embodied performance. Similar problems have arisen with the treatment of the components that contribute to a film such as set designs and costumes.<sup>163</sup> If a producer wishes to retain the right to reuse the components he may specify in the artist's contracts that all contributory elements of the film, including characters and characterizations, are works for hire.

In some instances such provisions are necessary to establish ownership. The work-for-hire provisions of the 1976 Act provide that an actor's contribution to a film or television show is considered authorship for copyright purposes.<sup>164</sup> To establish a producer's undisputed authorship rights, actor-producer agreements must specify that the actor's performance is a work for hire.<sup>165</sup> If this provision is included, a producer retains the right to control the actor's embodied performance and any subsequent uses or exploitations of it.<sup>166</sup> The fictional character category would allow a character's author to retain the future rights to her creation even though she allows its inclusion in one project.

### 1. *Registration and Duration of a Fictional Character*

If a separate fictional character category were created, a mechanism for registering such characters would also be needed. The greatest challenge would be to determine how performers would secure copyright protection for original characterizations that they have not incorporated into a work. This is the "pure" character problem.<sup>167</sup>

Fortunately, the registration and deposit scheme under the 1976 Act provides the tools necessary to meet this challenge. Registration under the new Act can be made at any time during the subsistence of copyright by filing an application, depositing copies of the copyrighted item, and

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163. For a definition of "joint work," see *supra* note 158.

164. 17 U.S.C. § 101 (1988) ("work made for hire" paragraph (2)).

165. *Id.*

166. Comment, *The Twilight Zone: Meanderings in the Area of Performers' Rights*, 9 UCLA L. REV. 819, 828 (1962).

167. See *supra* notes 85-107 and accompanying text.

paying the required fee.<sup>168</sup> The deposit requirements that accompany registration are flexible. The Register of Copyrights may issue regulations that "require or permit, for particular classes, the deposit of identifying material instead of copies or phonorecords."<sup>169</sup> Registration is permissible, although not mandatory, under the 1976 Act and, thus, copyright protection exists without it.<sup>170</sup> Registration, however, is a necessary prerequisite for maintaining any infringement action.<sup>171</sup>

The addition of a fictional character category could be easily integrated into the current registration and deposit scheme. The First Circuit, in the *Paladin* case, recognized that Congress could provide for the registration of fictional characters: "[W]e cannot say that it would be impractical to incorporate into the copyright system a procedure for registering 'characters' by filing pictorial and narrative description in an identifiable, durable, and material form."<sup>172</sup> Furthermore, the flexible deposit requirements could provide a mechanism for allowing independent registration of pure characters. The creator of a pure character could register her character by submitting a videotape record of it to the Register of Copyrights. The Register could establish guidelines for the length and content of the videotapes, perhaps requiring that the tapes include specified length, specific samples of dialogue, mannerisms, facial expressions, music, costume, and other identifying aspects of the character's expression. This procedure could be tailored by the Register of Copyrights for characters who are in essence self-contained works of art. Fictional characters contained in "works" could be registered by simply adding a fictional character category to the registration form already used for the particular work.<sup>173</sup>

Under the current Act, copyright protection exists for the life of the creator plus fifty years.<sup>174</sup> This limitation makes it easier conceptually to view characters as separately copyrightable at the outset. The term of protection would not change even if a character's delineation became more detailed over time. Thus, it would no longer be necessary to determine at what point a character became "copyrightable."<sup>175</sup> A character who appears in a series of works would receive copyright protection for fifty years after the creator's death, regardless of which work in the series

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168. 17 U.S.C. § 408(a), (b) (1988).

169. *Id.* § 408(c)(1).

170. *Id.* § 408(a).

171. *Id.* § 411(a).

172. *DeCosta*, 377 F.2d at 320.

173. See 37 C.F.R. § 202.3 (1990) (Registration of Copyright).

174. 17 U.S.C. § 302(a) (1988).

175. The duration of a copyright under the 1909 Act, 28 years from publication plus renewal for 28 years, would have a character's copyrights expiring at different times depending on a determination of when the character became copyrightable.



gave it "well-developed" status. The registration of each stage of development would provide independent copyright protection of each work plus cumulative delineation of the characters in the works for purposes of evaluating infringement.

### *B. The Role of Alternative Protections*

The creation of a separate copyright category for fictional characters would limit, but not eliminate, the need for alternative protections. If the copyrighted character is not a well-developed expression, or if the allegedly infringing character reflects only a similarity of ideas, then a court could compare name and visual appearances to determine whether relief should be granted under either a trademark or unfair competition theory.

In some cases trademark or unfair competition theories may be preferable. For example, because copyright expressly excludes protection of names and titles,<sup>176</sup> these are best shielded under trademark or unfair competition doctrines. Short phrases of identifying speech or slogans may likewise merit protection under these theories when the proposed use is likely to cause confusion as to the source of authorship.<sup>177</sup>

Beyond these applications, these doctrines should be used sparingly. A character's visual image should be protected by copyright not trademark laws. Since courts already acknowledge that the visual image is the dominant expressive characteristic, it is unlikely that any copying of appearance would receive more protection under trademark than under copyright. Moreover, application of "secondary meaning" analysis to the character's visual image is inappropriate because the character's image relates to the character itself, not to the underlying product.<sup>178</sup> If a character has copyright protection from the start, the only necessary inquiry, outside of name copying, is whether the similarities between the expression of the infringed and infringing characters are substantial.

The establishment of a fictional character subject matter category should end any confusion as to the applicability of the right of publicity to character infringement cases. The right-of-publicity doctrine is an outgrowth of common law privacy rights that should be used to protect the likeness and characteristics of nonfiction individuals only. A separate category for fictional characters would lessen courts' incentive to stretch the state right-of-publicity law to cover human character portrayals.<sup>179</sup>

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176. 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 and applications for registration.

177. See *supra* note 118 and accompanying text.

178. *Fisher v. Star Co.*, 231 N.Y. 414, 132 N.E. 133, *cert. denied*, 257 U.S. 654 (1921).

179. *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1974). Furthermore, because of the life-plus-fifty copyright duration under the current Act, federal copyright protection of human characterizations does not die with the creator. Thus, had *Lugosi*

## CONCLUSION

Fictional characters have enjoyed steadily increasing copyright protection throughout this century. With cartoon characters leading the way, courts have slowly developed a distinct doctrinal vantage point from which to view character copyrightability. But the uncertainty of fictional characters' status in the copyright community has led to a patchwork legacy of confusing doctrine and the misapplication of alternative rationales.

Statutory recognition of the independent copyrightability of fictional characters would generate a much needed conceptual leap in establishing that fictional characters are *always* copyrightable. Under such an approach, courts could more easily develop a consistent approach towards protecting characters regardless of whether or not they are a part of any underlying work. It will also give authors a firmer understanding of the boundary lines of protection and lessen the chance that they will lose their creations in a maze of overlapping federal and state doctrines.

Moreover, the current Act's structure is well suited for incorporating fictional characters. The life-plus-fifty term of protection provides a set length of shelter and eliminates the need to determine when a work reaches a state of defined expression. Furthermore, there is no conflict between the status of published and unpublished characters. The registration provisions can be modified to accommodate character enlistment in multiple categories. Similarly, by incorporating some flexible procedures into the regulations, the registration of pure characters can also be accomplished.

Recognizing the character as a copyrightable expression from the outset will accomplish three goals. First, it will create a sturdy foundation from which courts can adjudicate future cases of character infringement. Second, it will lead to more consistent bargaining over ownership of rights between the performers and the producers of the work in which they appear. Finally, it will protect human characters from unauthorized copying by third parties. Obviously, the more an actor's likeness resembles the character portrayed, the less copyright protection it will receive. But, of course, "that is the penalty an author must bear for marking [his character] too indistinctly."<sup>180</sup>

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been decided under federal copyright law, rather than state right of publicity, it's very likely Lugosi's heirs would have been granted protection for his portrayal of Dracula.

180. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).