

NATIONAL LAW SCHOOL OF INDIA UNIVERSITY, BANGALORE



2018-2019

DISSERTATION SUBMITTED IN PARTIAL FULFILMENT OF THE
REQUIREMENT FOR THE DEGREE OF LLM (BUSINESS LAWS)

**PROTECTION OF FICTIONAL CHARACTERS
UNDER INTELLECTUAL PROPERTY LAW REGIME**

UNDER THE GUIDANCE OF
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CERTIFICATE

This is to certify that this Dissertation titled as “Protection Of Fictional Characters Under Intellectual Property Law Regime” submitted by **Sarika Munje, ID No. 840** in partial fulfilment of the Degree of Master of Laws (LLM) for the academic year 2018-19, of the National Law School of India University (NLSIU), Bangalore is the product of the bona fide research and study carried out by her under my guidance and supervision. This dissertation or any part thereof has not been submitted elsewhere for the award of any other degree in any other university.

Date:

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DECLARATION

I, Sarika Munje, do hereby declare that this Dissertation titled- “Protection Of Fictional Characters Under Intellectual Property Law Regime” is the outcome of bona fide research and study undertaken by me in partial fulfilment of the Degree of Master of Laws (LLM) for the academic year 2018-19, of the National Law School of India University (NLSIU), Bangalore, under the guidance and supervision of Prof. (Dr.) T. Ramakrishna.

I further declare that this dissertation is my own original work carried out as a Masters student of Business Laws, except to the extent that assistance from other in the Dissertation’s design and presentation are duly acknowledged. All sources used for the project have been fully and properly cited.

I also declare that this work has not been submitted either in part or in whole for any degree or diploma at any other university.

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ACKNOWLEDGEMENT

I would like to thank everyone who have helped and inspired me and who have been instrumental in the completion of this dissertation. I extend my gratitude to my respected teacher and guide, Prof.(Dr.) T. Ramakrishna for his valuable suggestions and guidance.

My deepest gratitude goes to my family for their love and support throughout my life, especially my parents- Mr Vivek Munje and Mrs Madhavi Munje and my brother Mr Sourabh Munje; this dissertation would have been impossible without them. I also express my gratitude to other faculty members, library staff and other staff members of NLSIU, Bangalore for their help and cooperation

I am deeply thankful to my friends for their support and inspiration, especially-Ajeta, Aditya, Prateek, Rohit, Shantnu and Shilpi. To everybody who has been a part of my life but I failed to mention, thank you very much. Above all, thanks to God Almighty for blessing my life and guiding me.

Thanking You,
Sarika Munje

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CHAPTER 1: INTRODUCTION

*“Writing fiction is the act of weaving
a series of lies to arrive at a greater truth.”*

— Khaled Hosseini

Whether it be Sherlock Holmes solving mysteries with his knack of observation or Harry Potter trying to save the wizarding world from Voldemort, fictional characters have played an important role in each of our lives. For those who are not ardent fans of books, these characters have entered their lives through comics, movies and gaming. Therefore, we are well aware of Mario trying to rescue princess or the Common Man struggling through the hopes and aspirations of an average Indian person or most recently the Marvel heroes striving to collect all infinity stones to save the world from the scheming of Thanos.

Fictional characters are a figment of their creators' imagination. They are the necessary elements of the plot or story which is manifested usually in the form of books and movies and with the changes in technology, they have recently found their way into gaming consoles in the form of avatars. The range of these characters has increased and now there are multitude of types of characters which might exist on their own. The text of the books, the script of the movies or the source code of the software programs are protected by copyright laws and these characters are granted protection to

the extent they are incorporated into the literal elements. The problem, however, arises when the non-literal elements of the characters require protection from being copied.

Because their authors spend considerable labor in the creation and by virtue of the fact that they are their creation, they should be able to reap the benefits arising from the popularity of their characters. These benefits range from the creation being attributed to them to the creators' ability to utilize the characters in future in the way they want along with the right to contest its use by any other person.

Such protection has been a subject of debate since the last century where the intellectual property right legislations in different states did not provide for the protection of these fictional characters as such but judiciary has come to their rescue and has interpreted these legislations to extend the protection to these expressions of the creator's imagination. Because the judicial interpretation has been varied with regard to the form of character to be granted protection and the approach to be used for determination of whether they merit protection, the position has been vague as regards to the protection of different types of fictional characters. The thesis looks at the way the courts have tried to extend the existing protection to these characters and analyze its shortcomings. Further an attempt has been made to suggest new modes of protection for these characters.

1.1 Statement of Problem

Fictional characters are unique creations of the mind which require protection as an intellectual property. In the absence of any specific legislation with regard to their protection, the judiciary has read their protection mostly under copyright laws and to a certain extent, the trademark laws and right to publicity.

But in the absence of an express protection for them, the courts have extended the existing laws to them while applying different rationale. This has led to an uneven protection being granted to similar forms of characters and an uncertainty as to their protection when the forms of characters are changed. The fictional characters in certain forms have still been accepted to merit protection under copyright, those developed in a literary work have remained far behind who still struggle with proving their worthiness to be granted protection. The court in each case decides whether the non-literal elements of the character are capable of protection or not thereby leading to a situation where the protection of fictional characters from unauthorized copying is not guaranteed to the creator.

1.2 Research Objectives

The research aims to achieve the following objectives:

1. To analyze what a fictional character is and what is the need for granting protection to it.
2. To determine the legislative position with regard to protection of fictional characters in different states under their intellectual property laws.
3. To analyze the judicial trend in granting protection to various forms of fictional characters by application of different intellectual property laws.
4. To undertake critical analysis of the approach of the judiciary towards determining whether the non-literal elements of fictional characters are capable of protection before their infringement is determined.
5. To determine the efficiency of the tests employed by the courts in determining copyrightability of a fictional character.
6. To undertake critical analysis of the judicial approach in determining the extent of protection to be granted to a character independent of the underlying work.
7. To analyze the level of protection granted to different forms of fictional characters and understand the rationale for differences, if any.
8. To determine if effective protection for fictional characters can be sought under other forms of intellectual property laws.
9. To determine if there is a need for amendment to the present intellectual property laws to provide protection to the fictional characters or a sui generis legislation for granting such protection.

1.3 Research Questions

1. Whether non-literal elements of fictional character are capable of protection under copyright regime independent of the work in which they appear?
2. Which is the better test out of the currently available-‘sufficient delineation’ test or ‘the story being told’ test to determine the copyrightability of non-literal elements of a fictional character?
3. Whether current intellectual property law provides the same treatment for granting protection to fictional characters in its various forms?
4. Whether there is a need for a separate legislation to ensure effective protection to different forms of fictional characters?

1.4 Research Hypothesis

The current intellectual property law regime does not provide an effective means of protection of non-literal elements of different types of fictional characters independent of the work in which they appear. Therefore, there is a need for a change in the current intellectual property law mechanism of protection of fictional characters.

1.5 Scope and Limitation

The research deals with the protection of fictional characters from unauthorized appropriation under the intellectual property laws. The fictional characters dealt with range from literary characters, to graphical and

audio/visual characters. In the determination of the protection, the research deals exclusively with copyright laws and trademark laws and right of publicity in countries like USA and India and their interpretation by the judicial organs of the country with regard to the non-literal elements of the characters.

1.6 Research Methodology

The researcher has undertaken a purely doctrinal method of research. It is descriptive and analytical in nature. The research is based on primary and secondary sources. Relevant material from primary sources is taken from statutory provisions of concerned legislation along with relevant judicial decisions. Secondary source materials is collected from scholarly articles, reports, journals and books.

The first stage of research involved a theoretical examination followed by critical analysis of primary sources that is available on protection of fictional characters under intellectual property law regime. The second stage involved analysis of the secondary sources. The final stage included providing constructive suggestions.

1.7 Chapterization

The researcher has divided the research work into five Chapters. In the first chapter, the researcher has discussed the meaning of fictional characters and the necessity for their protection in the form of an intellectual property.

In the second chapter, the researcher has studied the application of copyright law for the protection of fictional characters and the evolution of the judicial trend for protection of the non-literal elements of different forms of fictional characters.

In the third chapter, the other modes of protection available to the fictional characters have been analyzed in the form of trademark laws and rights of publicity.

In the fourth chapter, the researcher has undertaken a critical analysis of the application of the existing intellectual property laws and the drawbacks inflicted by such protection

In the fifth chapter, the researcher has undertaken an analysis of proposed solutions in the form of amendments to the current intellectual property laws for providing protection to the non-literal elements of different types of fictional characters. It is followed by the conclusion and suggestions.

1.8 Review of Literature

- Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection, David B. Feldman, California Law Review, Vol. 78, No. 3, pp. 687-720. (May, 1990).

The article discusses the increasing commercial and popular appeal which the fictional characters are gathering which goes beyond their role in the original work. Therefore, the author argues for a fair and uniform protection for these characters from unauthorized exploitation. It analyses the current legal protection available for fictional characters and the way it is applied by the courts. In order to remove the inconsistency and inadequacy of the current protection, the author provides that fictional characters should be protected by an express subject matter category in the copyright law.

- When Mickey Mouse Is as Strong as Superman: The Convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters, Stanford Law Review, Michael Todd Helfand, Vol. 44, No. 3, pp. 623-674 (Feb., 1992).

The article discusses the increasing creative and financial value of fictional literary and pictorial characters and argues that in their protection, the courts have merged different intellectual property laws. The convergence of copyright, trademark and unfair competition has led the courts to treat these protections as necessarily integrated thereby providing for an expansive

protection to the fictional characters. The author argues that this has led to an increasing uncertainty as the role of the public domain doctrine.

- Protecting the Performers: Setting a New Standard for Character Copyrightability, Mark Bartholomew, 41 Santa Clara L. Rev. 341 (2000).

The article deals with the protection of fictional characters, especially the characters which have been shaped through live performance. The author analyses the justifications available for intellectual property and tries to determine if fictional character can be considered to be a form of intellectual property to be governed by the intellectual property laws.

- Copyrightability of Characters, Sourav Kanti De Biswas, Journal of Intellectual Property Rights, Volume 9, pp 148-156 (March 2004).

The article discusses the intellectual property law protection to graphic and fictional characters with an emphasis on its copyrightability. The article provides the position in the Indian law with regard to the protection of characters and looks at issues of ownership of characters and the protection granted to characters when a part of it enters the public domain.

- The Legal Protection of Fictional Characters in Intellectual Property: Protecting Creativity, Property Rights or a Monopoly, Stephen Richard Donnelly, 2 King's Inns Student L. Rev. 21 (2012).

The article demonstrates the increasing importance of fictional characters with the help of statistics of movies showing sequels involving fictional characters being the highest grossing ones. The article provides for the meaning and types of characters. It deals with the copyright protection and the rights which are available under copyright. Further it explains the application of trademark laws and other related protections like passing off for protection of fictional characters. The author argues that the courts have used an interweaving of intellectual property laws which has led to an overprotection of characters.

- Have You Seen Sam Spade?: How Literary Characters Are Denied Proper Copyright Protection, Michael Heitmann, Law School Student Scholarship. 794 (2015).

The article undertakes an analysis of the two tests laid down by the judiciary for determining the copyrightability of non-literal elements of characters. The author compares the two tests and traces their development to understand the implication of application of each test. Further the disparity given rise to between literary and visual characters because of the drawbacks of the test applied is criticized. The article provides rationale for determining the superior of the two tests.

- An Overview of Legal Protection for Fictional Characters: Balancing Public and Private Interests, Amanda Schreyer, *Cybaris*: Vol. 6: Issue 1, Article 3 (2015)

The article discusses the protection available to fictional characters under copyright law and trademark laws with the various facets of these protection. It also provides for the exceptions to these protections which balances the rights of the author with that of the public as the latter can use the characters for certain purposes without obtaining authorization from the copyright owner.

- Fixing Copyright in Characters: Literary Perspectives on a Legal Problem, Zahr Said, *Cardozo Law Review*, Vol. 35, No. 2, Pp. 769-829 (2013).

The article deals with how a reader becomes attached to a character even beyond the work in which they appear which increases their value for the authors as well who can use them in subsequent works for benefitting from the character's popularity. The article traces the evolution of the protection granted to the fictional characters and the tests. The author analyses the problems besetting the application of copyright law especially with regard to threshold copyrightability of fictional character. It also traces the evolution of characters from flat to round through the literary history. The author criticizes the copyright regime for the problems which come up in application of copyright law to protection of fictional characters, specifically with regard to entanglement and fixation and considers alternatives for protection.

1.9 Mode of Citation

The researcher has followed a uniform mode of citation throughout the research work.

Chapter-II

What are Fictional Characters?

2.1 What is a fictional character?

Fictional character refers to an imaginary person which might be represented in a work of fiction but also includes characters which have been created independent of any work. They have been titled “cultural heuristics” which have the power to inspire, amaze, horrify and transport the reader.¹ The definition of a fictional character has been laid down in the following terms by different scholars. As per Leon Kellman, for fulfilment of the criteria of a fictional character, it must have one or more of the three elements which he laid down to be as follows:

1. It can be in the form of an idea which can be delineated in the form of a general concept.
2. It can be in the form of an “expression” which is in the form of meticulous elaboration of an idea. This elaboration can be in the textual form, that is, by verbal description or orally in a way which surpasses description. It can also be in a visual form which includes two-dimensional and three-dimensional manner of description, for example, in the form of drawing or dolls, statues or figurines. Another form of elaboration is by virtue of a living portrayal.

¹ Blakey Vermeule, *Why Do We Care About Literary Characters?* 52, Baltimore, John Hopkins University Press (2009).

3. It can be in the form of a name.²

The requirement of idea, as per this criterion, is fundamental and ever-present.

Further Brylawski states that “*a character is not a unitary concept, but two dissimilar parts: the name and the personality portrait, consisting of physical attributes and personality traits.*”³ Leonard Zissu, a commentator on character law and a leading attorney in character case law, provides a helpful starting definition though he defines character very broadly: “*A character comprises some or all of such elements as (and principally) the name, physical appearance and attributes, mannerisms, speech and expressions, habits, attire, setting and locale. His association with the other designated characters and his outlook or view of life (subjective indicia) may also be regarded as within the composite which denotes the character.*”⁴ Recognizing the name as a distinct element of fictional character is doctrinally necessary because such a small part of the character is not the proper subject matter of copyright.⁵

Similarly fictional character has been said to have three identifiable and legally significant components: the name, the physical or visual appearance

² Leon Kellman, *The Legal Protection of Fictional Characters*, 25 *Brooklyn L. R* 3 [1958].

³ E. Fulton Brylawski, *Protection of Characters – Sam Spade revisited*, 22 *Bull. Copyright Soc'y* 77, 78 (1974).

⁴ Leonard Zissu, *Whither Character Rights: Some Observations*, 29 *J. Copyright Soc'y* 121 (1981)

⁵ *Id.*

and the physical attributes or personality traits, also known as “characterization.”⁶

In light of the above definitions, it is necessary to lay down a working definition of a fictional character whose protection is being argued by the researcher. It is therefore laid down as follows:

“A fictional character is an imaginary living creation brought into existence by a human mind and communicated to others and has specific attributes, both physical and behavioural along with specific relations with its surroundings inclusive of the people belonging to such surroundings.”

The characters may be in the form of human beings, animals, inanimate objects which are depicted to have a life of their own or new creations altogether which fulfil the above requirements which can be reduced into following elements:

1. They should be fictional in nature. They may be completely fictional or inspired by real life characters but should have originated in the author’s mind.
2. The creation should be made in a form perceptible by others which may be communicated by oral, literal, graphical or visual manner.
3. They should be living, that is, they should be able to interact with their surroundings.

⁶ Marks, The Legal Rights of Fictional Characters, 25 Copyright L. Symp. (ASCAP) (1980).

4. They should have specific physical and behavioural attributes which makes them predictable and consistent which may evolve but should not change considerably.

2.2 Classification of Fictional Characters

Fictional characters can be majorly classified into four major categories.

2.2.1 Pure Characters

Pure characters are the characters which come into existence independently and not as incorporated in other copyrighted work. These comprise of stand-up comedians, street artists or stage performers.

They fulfil the above requirement of being a creation of the author's imagination, perceptible by live performance, living and interacting with their surroundings and having specific physical and behavioural attributes.

2.2.2. Literary Characters

Literary characters are the characters which are incorporated in literary work like novels, stories, scripts etc. which create the character. Examples of this are Sherlock Holmes, Hercule Poirot, Harry Potter which came into existence as a part of a literary work. They are a creation of the author's imagination and fulfil the first requirement. However, their perceptibility is a debatable issue whereby the readers perceive the characters through the text of the work which may be subjected to different interpretation by different readers

depending on a number of social, cultural, geographical factors. But this does not lead to a complete abdication of this requirement as there is still a perception of the characters by the readers. Further, they are living and interactive and have specific physical and behavioural attributes.

2.2.3. Graphical Characters

Graphical characters are characters which are visual and are generally in the form of cartoon characters. Mickey Mouse, Donald Duck are all examples of graphical characters. They are a creation of the author's imagination and are fictional. They are perceptible by vision and have certain physical traits. Their perception is relatively easier as compared to literary characters because of certainty in the representation which does not leave much to the receptor's imagination.

2.2.4. Audio/Visual Characters

Audio/visual characters are the characters which are found in live action. An example of this is James Bond in the movie series, or the range of superhero movies made by Marvel Studios and DC films like Iron Man, Captain America, Wonder Woman, Batman, Superman etc. These are the creation of an author's imagination which is fictional. They are perceptible by different senses like visual and aural. These, like graphical characters are easily and more definitely perceptible because of their movements in live action. They are much more interactive than the other form of characters mentioned

above. Their physical and behavioural attributes are also more easily observable than other forms of characters.

All the above characters therefore fulfil the requirement as laid down by the general definition of a fictional character although the level of protection granted to them is not the same. This difference majorly arises from the difference in the fulfilment of the requirement of perceptibility which is easier for pure, graphical and audio/visual characters and lesser for literary characters. Their interaction with the surrounding is more easily visible in the case of literary and graphical and audio/visual characters and not so much with regard to pure characters. But the level of differences in the fulfilment of these requirements do not mean that they do not fulfil them altogether. They fulfil each of the requirement in varying degrees.

E. M. Forster has further classified characters as flat and round.⁷ He defined flat characters as “*constructed round a single idea or quality: when there is more than one factor in them, we get the beginning of the curve towards the round. The really flat character can be expressed in one sentence*” These are easily recognizable and can be remembered easily. Even when circumstances are changed, they still continue to remain the same thereby

⁷ E.M. Forster, *Aspects Of The Novel*, Harmondsworth: Penguin Books, 67–68 (1955).

making them seem frozen in time. These characters do not have well defined physical or behavioural attributes.

Round characters, on the other hand, are not easy to predict or summarize or recognize at a glance. *“The test of a round character is whether the character is capable of surprising in a convincing way. If the character never surprises, it is flat. If it does not convince, it is flat pretending to be round. It has the incalculability of life about it—life within the pages of a book.”*⁸ Round characters are more complex and dynamic and therefore more surprising. Because of their constant evolution throughout the work, it becomes harder to remember them as compared to a flat character. These characters, as opposed to flat characters, have well-developed physical and behavioural attributes and their actions flow from these attributes which are subject to evolution. In the early literary history, characters were understood as stock tropes across many cultures and languages upon which minor variations could be undertaken.⁹ An example of flat and round character can be taken here to understand the difference.

Stieg Larsson’s description of Lisbeth Slander from the novel- “The Girl with the Dragon Tattoo” runs as follows.

⁸ Id.

⁹ Deidre Shauna Lynch, *The Economy Of Character: Novels, Market Culture, And The Business Of Inner Meaning*, University of Chicago Press (1998).

“[She] was a pale, anorexic young woman who had hair as short as a fuse, and a pierced nose and eyebrows. She had a wasp tattoo about an inch long on her neck, a tattooed loop around the biceps of her left arm and another around her left ankle. On those occasions when she had been wearing a tank top, Armansky also saw that she had a dragon tattoo on her left shoulder blade. She was a natural redhead, but she dyed her hair raven black. She looked as though she had just emerged from a week-long orgy with a gang of hard rockers. . . . She had simply been born thin, with slender bones that made her look girlish and fine-limbed with small hands, narrow wrists, and childlike breasts. She was twenty-four, but she sometimes looked fourteen. She had a wide mouth, a small nose, and high cheekbones that gave her an almost Asian look. Her movements were quick and spidery, and when she was working at the computer her fingers flew over the keys....Sometimes she wore black lipstick, and in spite of the tattoos and the pierced nose and eyebrows she was . . . well . . . attractive.”¹⁰

The above detailed description of a character which can be considered as round can be differentiated from the following description of Mrs Micawber from David Copperfield written by Charles Dickens.

¹⁰ Stieg Larsson, *The Girl with the Dragon Tattoo*. New York: Alfred A. Knopf (2008).

*“Mrs. Micawber comes from a well-to-do family that disapproves of her husband, who is kind-hearted but financially unstable. She constantly avers that she will “never leave Micawber!””*¹¹

Between the Renaissance and Eighteenth century, characters have faced an evolution both in terms of depth and complexity with Shakespeare being given its credit by a number of scholars.¹² The characters started to become more atypical, introspective and sophisticated.¹³ There was thus a shift from deductive to inductive character which started providing to the character a newly found individualizing aspect. Characters, by the eighteenth century, started assuming significant importance in both their works and literary market.¹⁴ The characters started dominating the title and the plotlines or were the focus of sketches which were detailed descriptions the novelists placed throughout their works. Works began to become popular which consisted only of compilation of character portraits.¹⁵ This growing interest in character correlated with the rise of the novel. The most close correlation is however with the psychological novel which is uniquely interested in exploring

¹¹ Charles Dickens, *David Copperfield*. New York:Modern Library (2000).

¹² Ian Watt, *The Rise Of The Novel: Studies In Defoe, Richardson And Fielding*, University of California Press, 15 (1957)

¹³ Harold Bloom, *The Anxiety Of Influence: A Theory Of Poetry*, Oxford University Press, 2d Ed. Xxvii–Xxviii (1997)

¹⁴ Blakey Vermeule, *Why Do We Care About Literary Characters?*, John Hopkins University Press, 52 (2009)

¹⁵ George Cruikshank, *Sketches By Boz by Charles Dickens with illustrations*, John Macrone (1836).

personalities.¹⁶ It can be seen in the works of authors like Anton Chekhov, Henry James and Edith Wharton who focused more on the character's inner self than the major plot events.¹⁷ It is with this growth that the readers have come to be closely associated with the characters. The experience of interaction with the characters has been equated with the emotions generated by the social interaction of the reader in the real world.¹⁸ The narrative techniques used by the author allows the reader to know the character by inviting the readers into their inner lives.¹⁹ This development posed the requirement that such well-developed be granted protection from misappropriation in some form.

2.3 Philosophical Rationale for Protection of Fictional Characters

Copyright law performs the function of protection of expression of an idea as opposed to the idea itself.²⁰ The question that arises with respect to protection of fictional characters lies within the zone that is created between an idea of a character that has not been expressed in any form, and an idea that has been completely developed in form and shape. The exact point in

¹⁶ W.J. Harvey, *Character And The Novel*, London: Chatto and Windus, 23 (1965).

¹⁷ Uri Margolin, *Characterization in Narrative: Some Theoretical Prolegomena*, 67 *Neophilologus* 1, 2 (1983)

¹⁸ Annie Murphy Paul, *Your Brain on Fiction*, N.Y. TIMES, , at SR6 (Mar.18, 2012).

¹⁹ Rita Felski, *Introduction*, 42 *NEW LITERARY HIST* .v,v-vi (2011)

²⁰ *Baker v. Selden*, 101 U.S. 99, 103-04 (1880).

this zone at which the protection should be granted between the idea that is undeveloped and where there is sufficient expression of the character is required to be established. If the standard for the protection is set too low, it would disincentivize the creators from making new creations as they will not be able to use the non-specific description of a character general in nature which has been given legal protection. On the contrary, if the standards are set too high, there would be no protection available to the creators from their creation being copied by the others. Therefore, a middle-ground is required to be found.²¹ The rationale on which this protection is being based should help in determining the level of protection to be granted for such creations of human mind. Their protection in the form of intellectual property is argued under different theories which justify intellectual property rights.

2.3.1. Utilitarian Theory

One of the justifications provided for intellectual property rights is that it maximizes benefit to the society by increasing its amount of creativity. It is based on Jeremy Bentham's utilitarian theory which proposes that the ultimate purpose of the government is "the greatest happiness of the greatest number."²² Basing the protection of fictional characters within the intellectual

²¹Mark Bartholomew, Protecting the Performers: Setting a New Standard for Character Copyrightability, 41 Santa Clara L. Rev. 341 (2000).

²² Jeremy Bentham, An Introduction To The Principles Of Morals And Legislation 14, J.H. Burns & H.L.A. Hart eds., The Athlone Press (1970).

property law regime, the question that needs to be posed is whether protection afforded to characters would maximize the happiness of the society. If it does, then it needs to be established where the line for protection of the characters should be set which would maximize the social good.

Not providing any protection to characters would lead to disincentivizing of the creators from creating original characters. It is accepted that if restrictions are placed on the secondary performers from using the original creation, it would restrict their innovative addition to the creation. But not placing any restriction on such use would lead to a discouragement of the creation of characters. Characters have been deemed to be “imperfect difficult goods” which require efforts for creation but their copying is relatively easy.²³ This allows the secondary artists to copy the original character without much efforts which would deprive the original artist of the rewards which he is entitled to receive benefits of because it would be at risk of copying by others. Creation of new characters may have certain incentives which might accrue to them because of the free market and encourage them to create new characters. Their development helps in popularization of the work that they are featured in which provides an incentive to the creators to develop characters for better sale of the protected works which would provide them with economic benefits. Therefore, it would be to their benefit even if the

²³ Robert S. Pindyck & Daniel L. Rubinfeld, *Microeconomics*, Pearson Education (US) 4th ed. 672-76, (1998).

characters by themselves are not copyrightable but rather are protected with reference to the work in which they were developed or featured.²⁴ But another view that has been held for long is that such popularization of work may not provide sufficient incentive to the creators because the commercial appeal that a character's role holds in the work is not limited to the work itself and is manifested far beyond it.²⁵ This can be seen in the way in which the movie studios aim at acquiring plot stories with characters which can be utilized into multiple profitable franchises.²⁶ Such is also the case with the performers which strive at creating a popularity for themselves which can yield audiences not just for one but subsequent performances.²⁷ This is based on the understanding that the artist would be incentivized to create new characters not only by a hugely profitable first sale but by the knowledge that the character would not be taken advantage of by others at a point when the character acquires its highest popularity and profitability.²⁸

This leads to an argument that there is a requirement for an independent protection for these characters in order to incentivize their creation which

²⁴ Cathy J. Lalor, Copyrightability of Cartoon Characters, 35 IDEA 497, 499 (1995)

²⁵ Melville B. Nimmer & David Nimmer, Nimmer On Copyright § 13.03[2] (2013)

²⁶ Matthew Gilbert, Sequels? Nice. Franchises? Now You're Talking. Hollywood Relies on Golden Names like Crichton, Grisham, Carrey, Bond, Spielberg, and Disney to Presell its Blockbusters, Boston Globe, N7.(May 25, 1997).

²⁷ CBS v. DeCosta, 377 F.2d 315, 316, 320 (1st Cir. 1967).

²⁸ Warner Bros. Pictures v. CBS, 216 F.2d 945, 950 (9th Cir. 1954)

would benefit the society. This argument has been accepted by the courts to some extent and have recognized some forms of characters to be subject-matter of protection under the copyright laws.²⁹

This understanding, however, poses another problem as to how much protection should be granted to a character for it to be beneficial to the maximum of the society. Such question becomes necessary in the scenario where the creator abandons its character. The social welfare maximization, as a principle on which the utilitarian theory functions, would require the copyright law to permit the use of the character to another which would provide maximum benefit to the society.³⁰ But the amount of benefit that such regime would confer on the society at large is not determinable. This has been advocated by George Priest who states that calibration of the law of intellectual property is supported only meagerly by economic theory.³¹ This is because of a lack of normative consensus as to the amount of welfare which flows from inventive activity unlike in other fields where an economic study is available and is useful. Therefore, the advantageous effects of intellectual property rights on the individual creators and performers might still be

²⁹ Nimmer & Nimmer, *supra* Note 25.

³⁰ Matthew A. Kaplan, *Rosencrantz and Guildenstern Are Dead, But Are They Copyrightable?: Protection of Literary Characters With Respect to Secondary Works*, 30 Rutgers L.J. 817, 821 (1999).

³¹ George L. Priest, *What Economists Can Tell Lawyers About Intellectual Property: Comment on Cheung*, in *Research In Law And Economics: The Economics Of Patents And Copyrights*, 21, J. Palmer ed. (1986)

gauged, it becomes difficult to determine their impact on the societal welfare as a whole and whether it provides the maximum utility or requires changes. While protection of characters has been accepted as desirable, the level of protection has yet not been uniformly agreed upon.³² Therefore there is a requirement to look at other philosophical justifications for intellectual property.

2.3.2. Personality Theory

Personality theory has been used as a philosophical justification for intellectual property. It is based on the philosophy propounded by Georg Hegel who defined property as a means for an individual to manifest its will on the external world.³³ Hegel was of the view that in order to have a concrete existence, an individual need to create a relationship with a thing which is external to it.³⁴ It is only by acting on an object that an individual actualizes itself.³⁵ In order to protect an object, this theory of property requires the individuals to continue acting upon it to save it from being appropriated by others. He believed that it is not sufficient to have a wish or a desire to obtain ownership right in property which is required to be achieved by an “external manifestation of the will in the property.” One of the ways in

³² Wendy J. Gordon, A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property, 102 YALE L.J. 1533, 1573 (1993).

³³ Justin Hughes, The Philosophy of Intellectual Property, 77 GEO. L.J. 287, 333 (1988).

³⁴ Georg Wilhelm Friedrich Hegel, Philosophy Of Right 40 (T.M. Knox trans., (1953).

³⁵ Id.

which this can be done is through imposition of a form on the good. *“When I impose a form on something, the thing's determinant character as mine acquires an independent externality and ceases to be restricted to my presence here and now and to the direct presence of my awareness and will.”*³⁶

This theory has been further built upon by Margaret Jane Radin who has provided for categories of property disputes based on their morality. This division is between personal property and fungible property. Personal property is attached to a person which, if lost, cannot be replaced with another property. On the other hand, fungible property can be perfectly replaced with other property or goods which is of equivalent market value.³⁷ She advocates for low levels of protection of fungible property because it has no impact on the personhood of the individual who owns it as it is held only for instrumental purposes. Strong property rights, according to her, should be available only for personal property which distinction has been supported by the social consensus whereby some property claims are enforced more intensely than other claims. In terms of intellectual property rights, this justification applies when an idea is expressed by an artist which leads to externalization of his personality on to the outer world. The expression of such property is fulfilled even after ownership is achieved and the owner

³⁶ Universal City Studios, Inc. v. Kamar Indus., Inc., 217 U.S.P.Q. 1162, 1166 (S.D. Tex. 1982).

³⁷ Margaret J. Radin, Property and Personhood, 34 STAN. L. REV. 957, 986-87 (1982).

ceases acting on it especially in the case of intellectual property where the people acknowledge and attribute the creation of a work to its author.³⁸ The affirmative act of personhood is continued by continued possession of the group of rights available for his expression.³⁹ The work adds to the personality of the author simply by being considered its author even when he refuses to continuously work on it or create sequels of the work. This attribution is discernible in the way royalty is paid to the creators for continuing sale of the work which reinforces the people's recognition of the work as a form of external manifestation of his personality.

Hegel explains that the most cherished property that a person holds is his own personality. While the personality of a person coexists with the person himself, it exists only with reference to the society. He states that- "*A person has a natural existence within himself and partly of such a kind that he is related to it as an external world.*"⁴⁰

The persona of an individual which is depicted in his public image is a reservoir of his personality. It requires to be worked upon for which some people exert more efforts than the others. The law seeks to protect it by providing the individual with an economic protection for most manifest external expression of his personality. This can be seen in the form of

³⁸ Id.

³⁹ Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 333 (1988).

⁴⁰ Hegel, *supra* Note 34.

protection afforded to celebrities in the nature of right of publicity which safeguards them from others appropriating their personas. As celebrities have an interest in protection of their public images, so do creators have such interest in the protection of the characters that they have created. Creators have a special affection with their creation in the form of characters⁴¹ and express their personality by way of these creations which cannot be replicated with other forms of tangible property. As has been mentioned by an author, “*Creators and owners often identify so closely with their characters, intermingling their own personalities with those of their creations, that they become quasi-parents.*”⁴² Flowing from this line of thought, it can be argued that characters do fall under the category of “personal property” as categorized by Radin and therefore can be subjected to protection. As compared to other “fungible objects”, a person has more interpersonal connection with the character that he creates. When such a creation is appropriated by someone else without the creator’s authority, the creator suffers not only an economic injury but also the personal connection as the creator loses the control over the projection of the character. This loss leads to the creator losing a part of his personality to the extent it was intertwined with the character. Copyright helps in the protection of the

⁴¹ Michael Todd Helfand, Note, When Mickey Mouse Is as Strong as Superman: The Convergence of Intellectual Property Law to Protect Fictional Literary and Pictorial Characters, 44 STAN. L. REV. 623, 627-28 (1992).

⁴² Id.

creators' personality by providing it protection in the form of property.⁴³ This line of argument provides a justification the Hegelian rationale for protection of characters under the intellectual property law regime. Since the utilitarian arguments as laid down before failed to provide a standard as to how much protection should be granted to such characters, looking at property in context of personhood advocates for a higher level of protection for such characters because of the personal attachment that the creator forms with its characters.

2.3.3. Labour Theory

John Locke was an English philosopher who based his rationale for property in labour. The U.S. Constitution and the Declaration of Independence cite some of his ideas⁴⁴ which are now being used for protection of intangible property rights.⁴⁵ Locke based his ideas on the basic principle of natural law that-"No one ought to harm another in his Life, Health, Liberty, or Possessions."⁴⁶ In addition to this, he believed that every individual is entitled to a right of ownership in that in which he has invested his labour. The

⁴³ *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 836 n.11 (1979).

⁴⁴ Thomas P. Peardon, Introduction to John Locke, *The Second Treatise Of Government* at vii, xx (Thomas P. Peardon ed., Bobbs-Merrill Co. 1952) (1694).

⁴⁵ *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 1002-03 (1984)

⁴⁶ John Locke, *Two Treatises Of Government*, pt. II, § 7, at 289 (Peter Laslett ed., 2d ed. 1967) (1698).

individual when uses materials available in the public domain and makes a new creation, then he has combined the material with his labour:

*“The labour of his body and the work of his hands, we may say, are properly his. Whatsoever then he removes out of the state that nature has provided, and left it in, he has mixed his labour with, and joined it to something that is his own, and thereby makes it his property.”*⁴⁷

In case the new creation is taken away by another person, he harms the creator and therefore violates the first principle. The individuals, therefore, require a legally enforceable property right in order to protect the benefits derived from the labour exerted. But the problem existed with regard to the question as to when can the labour be said to have been mixed with the material from the public domain and thereby lead to appropriation of such property on which he can claim an enforceable right.⁴⁸ This question has been answered in different ways. One view is that in order to appropriate labour, materials in the public domain should be changed in such a way “that makes [them] usable and thus more valuable to humanity.”⁴⁹ Locke has hinted at the proposition that property ownership should be provided only

⁴⁷ Id. at 305-06.

⁴⁸ Karl Olivecrona, Appropriation in the State of Nature: Locke on the Origin of Property, 35 J. HIST. IDEAS 211, 225 (1974)

⁴⁹ Wendy J. Gordon, A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property, 102 YALE L.J. 1533, 1573 (1993)

when it provides some benefits, or at least does no harm to the common good in the following words:

“Labour being the unquestionable Property of the Labourer, no Man but he can have a right to what that is once joynd to, at least where there is enough and as good left in common for others.”⁵⁰

However the use of the term “common good” provides scope for interpretation. It has been interpreted in narrow terms by Wendy Gordon in the following terms:

“Locke argues that one person's joining of her labor with resources that God gave mankind (“appropriation”) should not give that individual a right to exclude others from the resulting product, unless the exclusion would leave these other people with as much opportunity to use the common as they otherwise would have had.”⁵¹

When interpreted in such a way, Locke’s ideas pave the way for an understanding of the intellectual property law which provides for “individualized” public benefits.⁵² An example can be taken of Gordon who puts forward the argument that parodists should be granted more protection by the “fair use” doctrine and artists who arrive later at the cultural scene

⁵⁰ John Locke, *Two Treatises Of Government*, pt. II, § 7, at 289 (Peter Laslett ed., 2d ed. 1967) (1698) *supra* note 67, at 1562.

⁵¹ Gordon, *supra* Note 49.

⁵² Howard Abrams, *The Historic Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright*, 29 WAYNE L. REV. 1119, 1134 (1983)

should be allowed to make use of the existing creation if the prohibition of his use would be disadvantageous to him individually.⁵³ This interpretation however moves away from the personhood justification for property rights on which Locke's writings do not suffice. The common good requirement as mentioned by Locke can also be interpreted in the form of a concern for public welfare when taken as an aggregate. This requirement can be fulfilled if the public as a whole stands at an advantage by the property rights by being granted to the labourer as compared to a situation of absence of property rights.⁵⁴ There would thus be no clash between the Lockean labour justification and Hegelian personhood justification. Gordon has mentioned this in terms of appropriative labour which makes the labourer identify with its work psychologically.⁵⁵ This understanding is also reflected in the work of Karl Olivecrona who interprets Locke's theory to mean that he perceived the benefits arising out of the labour to be an extended form of his personality.⁵⁶ It took the help of Locke's following statement to support his belief- "*By Property I must be understood here, as in other places, to mean that Property which Men have in their Persons as well as Goods.*"⁵⁷ Locke has defined appropriation to mean use of labour in order to make the object "a

⁵³ Gordon, supra Note 49.

⁵⁴ C.B. Macpherson, *The Political Theory Of Possessive Individualism: Hobbes To Locke* 211-20 (1962).

⁵⁵ Gordon, supra Note 49.

⁵⁶ Olivecrona, supra Note 48.

⁵⁷ Locke, supra Note 46.

part of one's self." This he interpreted to mean that Locke had "unequivocally expressed the idea that the personality is extended to encompass physical objects."⁵⁸ Further appropriative labour could extend to intangible objects as well.

This leads to the view that Locke's philosophy supports the protection of artists from unauthorized copying of their creation because allowing it would mean allowing the taking away of the artist's personality which harms him. Therefore it can be concluded that Locke's theory about property ownership is in consonance with the views of Hegel and Radin. The fruits of one's labor can be considered to be an extension of his personality. In order to recognize the property right of the individual, appropriation is required which is done when a person infuses his personality into an object by using labour upon it. In the same way, the linkage of property ownership with personal expression in objects has also been argued by Hegel and Radin. Since the characters being talked about here are rich in personal expression, the artists who create them should be provided protection in order to ensure their continued actions on the outside world and which would avoid harm to them from misappropriation by other persons of their personal expression.⁵⁹ This theory

⁵⁸ Olivecrona, *supra* Note 48.

⁵⁹ Bartholomew, *supra* Note 21.

also requires a higher level of protection as was propagated by the personality theory.

Conclusion:

It can therefore be seen that fictional characters are creation of an artist's imagination which comprises of a number of elements and are of various types depending on the media that they are created in. The popularity and recognition that they achieve should benefit the creator of the character. As seen above, fictional characters fulfil, to certain extent, the various theories of justification of intellectual property and therefore can be considered to be an intellectual property under various theories of justification of intellectual property. Therefore their protection under the intellectual property law regime is justified. But the level of protection is different under different theories and therefore the degree of protection depends on the theory which is adopted for the protection of fictional character.

Chapter-III

Copyright Protection of Fictional Characters

3.1. Copyright Protection In USA

Under the US legal regime, Copyright Act of 1976 enumerates eight categories of copyrightable subject matter.⁶⁰ It specifically provides protection to a literary work if it is an original work of authorship that is fixed in any tangible medium of expression.⁶¹ It is a bundle of rights which is granted to encourage the “creation and dissemination of original expression.”⁶² It grants the author the exclusive right to copy, perform, distribute or display their works and to create derivative works.⁶³ Derivative works refer to the subsequent works of authorship which are based on preexisting works⁶⁴ or which include within themselves characters or component parts from preexisting works.⁶⁵ The author’s rights in their copyrighted work may be infringed by way of reproduction, display or performance of the work as it is

⁶⁰They are: (1) literary works; (2) musical works; (3) dramatic works; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. 17 U.S.C. § 102 (1994).

⁶¹ 17 U.S.C.A. § 102(a).

⁶² Neil Weinstock Netanel, Copyright and a Democratic Civil Society, 106 YALE L.J. 283, 285 (1996).

⁶³ 17 U.S.C. § 106(2).

⁶⁴ 17 U.S.C. § 101.

⁶⁵ King Features Syndicate v. Fleischer, 299 F. 533, 535 (2d Cir. 1924).

or their distribution without obtaining the authorization from the owner of the copyright. The Act does not explicitly mention characters as a subject-matter of protection but the eight categories are only illustrative and not exhaustive.⁶⁶ Further the Act provides that all component works of a copyrighted work are also protected.⁶⁷

The Register of Copyrights had, in a 1965 report, accepted that certain characters are developed enough in detail so as to merit copyright protection in them.⁶⁸ It maintained that the categories of literary and pictorial works were wide enough to include all such characters and granting them adequate protection without creating a specific category for them. Therefore, no amendments were made to the 1976 Copyright Act but this fact did not express the intent of the congress to remove characters from being granted protection under copyright.

The courts are not required to determine the independent copyrightability of a character when the character details in a work are borrowed as part of unauthorized copying or distribution of the entire preexisting work.⁶⁹ If the subsequent work appears to the court to be “substantially similar” to a pre-

⁶⁶ H.R. REP. No. 94-1476, at 53-57 (1976).

⁶⁷ 17 U.S.C. §§ 102, 103.

⁶⁸ Supp. Report Of The Register Of Copyright On The General Revision Of U.S. Copyright Law: 1965 Revision Bill, 89th Cong., 1st Sess. 6 (1965).

⁶⁹ Nimmer & Nimmer, supra Note 25.

existing work, then it will be found to be infringing the copyright of the owner unless defense is available to the alleged infringer in the nature of independent creation or fair use. On the contrary, if the character details laid down in one work are used in a subsequent work, such unauthorized use would fail to satisfy the substantial similarity test because the original and the subsequent work would not appear to be similar to prove copyright infringement. It is in such a scenario that the courts are required to analyze whether the characters are capable of protection independent of the work in which it appears.⁷⁰ The only similarity that the two works in such a case would have would be the character. The old character can then be said to have taken a life of its own in the new work.⁷¹

However, it fails to mention whether a character deserves protection outside of the work in which it has originally appeared. This question requires determination because these characters frequently transcend the works in which they appear first and their value and recognition is affected by the various works they appear in. Usually the characters begin their journey as literary creations which are then adapted by way of visual representation into movies, video games, or other forms of media. The Act also does not mention whether the protection is available from the stage of literal

⁷⁰ Nimmer & Nimmer, *supra* Note 25.

⁷¹ Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 432.

representation of these characters or they become protectible only on their visual representation.

3.1.1. Idea-Expression Dichotomy

The basic premise on which the Copyright law is based is that it is only the expression of an idea which is capable of protection and not the idea underlying it. This is known as the idea-expression dichotomy.⁷² This principle is based on the understanding that if the core ideas are protected, then it would lead to a scenario where future works on the same idea could not be created without infringing the previous work and the original author would get a monopoly over the idea. This monopoly goes against the basic tenets of the United States Constitution as provided under Article I, Section 8, Clause 8, which grants Congress the power “to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.” The difficulty that the courts, therefore, have had to face is with regard to distinguishing between a unique character capable of protection from a “stock character.”⁷³

This line becomes difficult for the court to draw and therefore leads to a struggle as to the protection to be granted to literary characters. The characters are made more memorable and connected to the audience because of their proximity to the underlying themes and universal truths. This

⁷² Baker v. Selden, 101 U.S. 99 (1879)

⁷³ Lewinson v. Henry Holt & Co., LLC, 659 F. Supp. 2d 547, 567 (S.D.N.Y. 2009).

allows the authors to make the characters more relatable to the readers and increase their popularity.⁷⁴ The challenge which the courts are required to address is the determination of the point at which the distinction should be made between the ideas that are not protectible and the original expression of the ideas. This idea-expression dichotomy requires a subjective determination that has led certain commentators to challenge the existence of such split in itself.⁷⁵ This ambiguity has led the courts to determine the protection to be granted based on the quality of the character because it enables the courts to determine how easily the character can be delineated from the idea upon which it was based.

In 1940, the court explained this difference between the idea and expression in the case of *Detective Comics v. Bruns Publication*.⁷⁶ The court held that a concept of a man having superhuman powers does not merit copyright protection as it is just an idea. But if this idea is developed with specific features as has been done in the case of 'Superman,' then it is an expression. The court therefore held the character of 'Wonderman,' to be infringing the copyright of Superman where the physical and emotional

⁷⁴ Michael Heitmann, "Have You Seen Sam Spade?: How Literary Characters Are Denied Proper Copyright Protection" *Law School Student Scholarship*. 794 (2015).

⁷⁵ Richard H. Jones, *The Myth of the Idea/Expression Dichotomy in Copyright Law*, 10 *Pace L. Rev.* 551 (1990).

⁷⁶ *Detective Comics, Inc. v. Bruns Publications, Inc.*, 111 F.2d 432 (2d Cir. 1940).

characteristics of Superman were copied. In this attempt of determination of protectability of characters, the courts have devised the following tests.

3.1.2. Sufficient-Delineation Test

One of the earliest cases in which the question arose as to the copyrightability of fictional characters was *Nichols v. Universal Pictures Corporations*.⁷⁷ Decided in 1930, this case predated the Copyright Act of 1976 and before this case, the question had not been raised whether a literary character could be protected outside the work in which they had originally appeared. The case was brought by the author of a play called “Abie’s Irish Rose” against the producers of the work “The Cohens and The Kellys.” The case dealt with the issue of not only the copyrightability of the work but also that of the characters contained in the work. In determining so, Judge Hand created the character delineation test which although was given in the form of obiter dicta but became an important instrument in assessment of copyrightability of characters.⁷⁸ In order to better appreciate the application of the test, it is necessary to understand the facts of the case in which it was laid down. The central point of determination for Judge Hand in the case was the comparison of the two main families in each work and not the plot of the works themselves.

⁷⁷ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930)

⁷⁸ David B. Feldman, *Finding A Home for Fictional Characters: A Proposal for Change in Copyright Protection*, 78 Cal. L. Rev. 687, 691 (1990).

In "Abie's Irish Rose," the love story of a Jewish boy and a Catholic girl is depicted who fall in love and get married which is objectionable by both their fathers on religious grounds. As the father of the boy has disapproved of his relationships before, he presents the Catholic girl as a Jew and that he is thinking about marrying her. The father agrees to the marriage and starts arranging for a Jewish wedding but meanwhile the girl's father, who is a Catholic and strictly against Jews, arrives. The rest of the play deals with the fathers trying to reconcile with the couple as they are desirous of meeting their grandchildren.

Similarly, in "The Cohens and the Kellys" the love story is between a rich Jewish girl and a poor Irish boy which was disapproved by the father of the girl because of the boy's low station. This story, however, have added characters, that is, their mothers and other family members who share the hatred amongst the families. In this play also the couple gets married secretly but the bone of contention among the fathers is with regard to a large inheritance instead of religion. The eventual reconciliation between the fathers takes place over the resolution of dispute over who properly owned the inheritance and not the presence of grandchildren as was shown in "Abie's Irish Rose." On the facts of the case, the plots of the two works appear similar. They both consist of characters belonging to different religion,

a controversial wedding and then dealing with the effect of the union on their families. The similarities, however, are largely superficial and it was not clear whether if any copying actually occurred, it would amount to copyright infringement. Therefore the question that was required to be determined by the court was what was the unprotectable idea behind the work and what was the protectable expression that is unique to each author.

The purpose of this character delineation test that was laid down in this case was to separate the non-protectable “stock characters” from the characters that were fully realized and could be granted protection under the Act. This distinction is based on the notion that stock characters loom closer to the underlying idea which can be utilized by any author.⁷⁹ Since such characters can be expressed in one particular way, that is the idea behind them and their expression merges, therefore, they are not protectible under copyright. The issue that arises then is that how well developed the character in question is as compared to the stock character on which they are based. Judge Hand states 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.”* This reflects the idea-expression dichotomy of the copyright law, which strives at balancing the protection of free speech as advocated by the First Amendment and the property interest lying with the author in the

⁷⁹ Heitmann, supra Note 74.

works and characters that they have created. In the current case, the court held that there was no infringement as the characters in both the works were “stock characters” as it was highly likely that the author of the latter work was aware of the stock figures and had not taken more than their prototypes which had continued for many decades. Since the plot of both the works were similar to other stories of forbidden love and the characters were delineated only enough to act as pieces used to achieve the author’s goal to communicate the story, they were held to be not sufficiently delineated. Therefore they were considered to be stock characters and not entitled to copyright protection. While the court held that the plots in the case did not infringe on one another and the characters were “stock characters,” characters may be granted protection independent of the plot if they were sufficiently delineated. While it seems to be a simple test, its consistent application has proven to be quite difficult. This is because determination of copyrightability requires an analysis of the complications of the character which requires the court to apply its subjective judgement. The judges are required to determine the intrinsic worth of a character which they are not best-suited for as they are not literary critics and they should not be required to act as one in order to apply a test to determine the copyrightability of a character outside of the work in which they first appeared. The task becomes all the more difficult in the absence of any factors to apply to the test. This leads to a subjective application of the test thereby leading to different

results. This case however became recognized by subsequent courts for first accepting that there should be copyright protection for characters which are especially distinctive.

Therefore if the author has provided an original expression which is unique in sufficient amount to be able to satisfy the idea-expression dichotomy, then it is capable of being protected.⁸⁰ Further the explanation provided by the courts with regard to “stock characters”⁸¹ provide a guideline as to the vague characters which the Act does not protect. It would only be the characters which have been sufficiently fleshed out and would be in addition to the universal constructs that could be claimed by the author to be his own artistic creation which would merit protection. An example can be given of protection of an international spy which would not get protected as it is a “stock character,” however Ian Fleming can claim such protection for the more developed character of James Bond.⁸²

3.1.3. The Story Being Told Test

The Nichols case was the starting point of development of copyright protection for literary characters which was followed by another case which had a far-reaching influence on the subject which was given by the Ninth

⁸⁰ Olson v. Nat'l Broad. Co., 855 F.2d 1446, 1452 (9th Cir. 1988).

⁸¹ Lewinson v. Henry Holt & Co., LLC, 659 F. Supp. 2d 547, 567 (S.D.N.Y. 2009).

⁸² Toho Co. v. William Morrow & Co., 33 F. Supp. 2d 1206, 1216 (C.D. Cal. 1998).

Circuit Court. This was the case of Warner Bros. Pictures v. Columbia Broadcasting System⁸³ which came to be popularly known as the Sam Spade case. The decision was related to the rights involved in novel, The Maltese Falcon. The case was a result of a contract dispute which took place between the author of The Maltese Falcon, Dashiell Hammett and Warner Brothers over who would get the right over the character of Sam Spade. The contract granted the right in the work to Warner Brothers of “certain defined and detailed exclusive rights... in moving pictures, radio, and television.” Warner Brothers were allowed to adopt the serial drama consisting of the famous character, Sam Spade, into new mediums of radio, movies and television. This rights of adoption was interpreted differently by the two parties which led to the creation of a new test to determine the copyrightability of literary character outside the work in which they appeared originally.

The central issue that came up before the court was about the right to use the character of Sam Spade as to whether it was granted by Hammett to Warner Brothers or did he it retain it for himself. The court decided that the assignment of the work did not include the characters as they “were vehicles for the story told, and the vehicles did not go with the sale of the story.” The court laid down the story being told test while coming to this decision.

⁸³ Warner Bros. Pictures v. Columbia Broadcasting System, 216 F.2d 945 (9th Cir. 1954)

This test is different from the character delineation test as the goal of this test is to determine the extent to which the character is intertwined with the plot of the story. The court clarified it by saying that “it is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection.” Therefore the test envisages that only if a character is so essential to the story that he is virtually inseparable from it can it be granted protection independent of the work in which it appears. This has fixed the bar very high. Only a few instances are available where the characters have been able to satisfy this test as was held in this case where Sam Spade was not granted protection.⁸⁴ Characters have been given protection under this test mainly under two areas. The first criteria is when the character’s name is in the title of the work.⁸⁵ This is a simple criteria as it satisfies the requirement that the character is so deeply engraved in the plot of the work that the author considers them to be synonymous. An example of this is the E.T character which came up for consideration in the case of Universal City Studios, Inc. v Kalmar Inds., Inc.⁸⁶ the court in this case examined the relationship between the title of the work and the character having the same name-E.T. and held that the character is more than mere vehicle for telling

⁸⁴ 27 No. 1 Corp Couns Quarterly ART 2.

⁸⁵ Bartholomew, supra Note 21

⁸⁶ Universal City Studios v. Kalmar Industries (1982 Copyright L Decisions (CCH) 25, 452).

the story and it actually consists of the story being told. This test is easy to be applied by the courts.

Another area where the character has been found to easily satisfy the test is where the work in question focuses on character development at the expense of the plot. Since it deals with the complexity of the character, this test relates back to the character delineation test as developed in Nichols case. The more the role a character has within the work, the more convenient it is to delineate the protectable character from a stock character. Once this delineation is done, the character earns copyright protection independently of the work in which it appears. The court recognized the protection to be granted to the character, Rocky, in the case of Anderson v. Stallone⁸⁷, under the story being told test. The court stressed that “all three Rocky movies focused on the development and relationships of the various characters... [they] did not revolve around intricate plots.”

The relationship established between the two tests in this case becomes important as they both attempt to solve the same question, although by different methods. The major question that both the tests strive to answer is whether the character is sufficiently developed so as to merit copyright protection independent of the work in which they first appear. The character

⁸⁷ Anderson v. Stallone, 11U.S.P.Q.2d 1161 (C.D.Cal.1989).

delineation test corresponds to the true copyright context because of its requirement of expression being detailed out of a stock character idea. The story being told test, however, was based on a contractual dispute and therefore is criticized for complicating matters for the courts. As in this case, the court held that Sam Spade was not capable of being independently protected outside of the work and therefore the author could not have conveyed the exclusive right to the character to Warner Brothers, the court allowed him to use the characters in future works. In reaching out a just result for the author, the court created a test difficult to be applied in future cases for protection of characters independent of the work.

#

The courts use the extrinsic, intrinsic and abstraction test in applying the story being-told test.⁸⁸ The extrinsic test requires the determination of whether a character is copyrightable within the context of the original work. The courts are required to undertake a comparative analysis of the specific, objective criteria present in the two works that is, their plot, theme, dialogue, setting and sequence of events. The intrinsic test determines the substantial similarity between the expression of the ideas by comparing the “total concept and feel” of the two works. The test is based on the observation of an “ordinary reasonable man.” Under abstraction, the courts are required to

⁸⁸ Metro-Goldwyn-Mayer v. American Honda Motor Co., 900 F. Supp. 1287 (C.D. Cal. 1995).

determine if the details of the work are left out generally so as to constitute the idea itself.⁸⁹

3.1.4. Visual Characters or Graphic Characters

As an extremely high standard was set by the story being told test, and being the binding law, courts were required to use creativity so as to extend protection to characters which did not constitute the story being told. As Sam Spade was a literary character which was not depicted visually, courts utilized this fact to grant a differential treatment to characters which had a visual depiction. The reason that was given for such different treatment was that the presence of a visual depiction of the character gives the character depth and complexity which led them to be far above the 'stock characters' which were not protectible.⁹⁰

This differentiation was first done in the case of *Walt Disney Productions. v. Air Pirates*,⁹¹ where the copyrightability of the famous Disney character, Micky Mouse was in question. The defendants had used the characters of

⁸⁹ Jasmina Zecevic, "Distinctly Delineated Fictional Characters That Constitute The Story Being Told: Who Are They and Do They Deserve Independent Copyright Protection?", *Vanderbilt Journal of Entertainment and Technology Law* 8.365 (2006).

⁹⁰ *Lewinson v. Henry Holt & Co., LLC*, 659 F. Supp. 2d 547, 567 (S.D.N.Y. 2009).

⁹¹ *Walt Disney Productions. v. Air Pirates*. 581 F.2d 751, 752 (9th Cir. 1978).

Disney in their adult comic books. The use was not sought to be hidden by the defendants in any way who went as ahead as referring to the characters by their names and portrayed them as “active members of a free thinking, promiscuous, drug ingesting counterculture.” The court was therefore required to evaluate how well the characters were developed so as to be granted protection outside of the work in which they originally appeared. As the Sam Spade case had laid down the law, the court was required to answer this question on the touchstone of the story being told test. It acknowledged the fact that characters, by themselves, are not copyrightable. However it tried to differentiate the case from the previous one by emphasizing that the former was a decision in the context of a contract dispute and therefore the restriction for the future use of a character which merely was vehicle for the story and did not really constitute the story being told would have been unreasonable. The court therefore refused to check whether Mickey Mouse constituted the story being told, in which case, the character might have lost protection outside of its work. The distinction on the basis of visual representation, therefore, helped grant protection to Mickey Mouse independently of the work in which it appeared originally.

The acknowledgement of the fact that the Sam Spade test was laid down in a case of contractual nature has been done in a number of other cases. In

Gaiman v. Macfarlane,⁹² the Seventh Circuit Court declared the decision to be wrong but understandable as in that case, not granting copyright to Sam Spade was favourable to the author. The court held that the Ninth Circuit in that case might not have foreseen the negative effect such decision would have on the right of the authors as it had a unique set of facts and therefore should not have given rise to a binding test for copyright protection of characters.

The court, in *Air Pirates* case, also discussed the difficulty that would arise in delineating a literary character. It held that while granting protection to a literary character would require it to embody more than an unprotected idea, the comic book characters easily satisfy this requirement. Therefore it exempted comic book characters from application of the Sam Spade test of story being told. The court had the alternative of attempting to harmonize the grant of protection to graphic characters with the story being told test. However it chose to distinguish graphic characters from literary characters while such distinction has nowhere been made under the Copyright Act. Graphic characters have thereby been given a special treatment whereby there is a presumption of them containing unique expressions that allows them to be delineated from stock characters. Such emphasis on visual representation of character was not to be seen in Judge Hand's character

⁹² Gaiman v. McFarlane, 360 F.3d 644 (7th Cir. 2004).

delineation test. Such a treatment is a misapplication of Judge Hand's test which was aimed at enabling the courts to separate stock characters from protectable characters. But it has led to creation of a distinction rule which favours one type of character over another type of character. While it should have been only one of the factors, it has become the only factor to provide copyright protection to the character independently of the work in which it appears.

This position is not favourable looking at the early images of the character of Mickey Mouse which were at stake in the *Air Pirates* case. The initial visual representation of the character in *Steamboat Willie* was quite simplistic having been drawn by hand in black and white. This crude representation shows the flaw of the reasoning the court adopted in the *Air Pirates* case presuming that visual characters were inherently distinct and had unique characteristics. This shows that the delineation of the visual depiction of characters from stock characters is not necessarily a simple task to achieve. Further such distinction between the visual characters and literary characters suggests the ambiguity that is inherent in description of literary characters.⁹³ It emphasises the fact that it is more difficult to differentiate them from stock characters because the readers have to picture them in their minds. An example of this can be taken of the character like Holden Caulfield in the

⁹³ *Gaiman v. McFarlane*, 360 F.3d 644, 660 (7th Cir. 2004).

work –‘Catcher in the Rye’ which is among the most popular literary characters in American history despite not being portrayed by any actor. The popularity of the character through generations, however, has been evidentiary of the fact that protection can be granted to literary characters as being sufficiently delineated. This view was also held by the court in the case of *Salinger v. Colting*⁹⁴ which upheld that the character was sufficiently delineated to be granted copyright protection independently of the work in which it appeared.

The question that the less stringent application of the story being told test for visual characters as was done in *Air Pirates* case therefore poses is that whether the strict application of the test is still necessary for literary characters. *Air Pirates* case limited the story being told requirement to word portraits.⁹⁵ Professor Nimmer is of the view that the reasoning given in the *Sam Spade* decision has also been undermined with regard to word portraits.⁹⁶

3.1.5. Sufficient Delineation Test or Story Being Told Test?

⁹⁴ *Salinger v. Colting*, 607 F.3d 68 (2d Cir. 2010).

⁹⁵ M. Nimmer, *The Law Of Copyright*, § 2–12, pg. 2–176 (1988)

⁹⁶ *Ibid.*

In light of the above discussion, it becomes necessary to determine which is a better test to apply which would grant similar level of protection to characters in different forms.

Anderson v. Stallone⁹⁷ was a case in which the court placed emphasis on the central question which is whether the character has a sufficiently unique expression to be able to qualify for copyright protection. It however, still placed a heavy emphasis on the ability of visual representation to delineate a character from stock character. It stated it in so many words:

“a graphically depicted character is much more likely than a literary character to be fleshed out in sufficient detail so as to warrant copyright protection. But this fact does not warrant the creation of separate analytical paradigms for protection of characters in the two mediums.”

The issue that was in question in the case was the protection of the characters that Sylvester Stallone had created for the Rocky movies. Stallone had announced his the broad plot ideas for Rocky IV in a public interview. The plaintiff, after this, crafted a treatment for the movie by making use of the Rocky characters and tried to sell it to the studio. The studio subsequently released a fourth movie that bore substantial similarity to the treatment. The screenwriter filed suit alleging that the studio appropriated his ideas. Thereafter, defendants filed a motion for summary judgment in plaintiff screenwriter's action alleging copyright infringement among other claims. In

⁹⁷ Anderson v. Stallone, 11 U.S.P.Q.2d 1161 (C.D. Cal. 1989)

the course of litigation, the court was required to determine the question of copyrightability of the Rocky characters. The court held that “as a matter of law that the Rocky characters are delineated so extensively that they are protected from bodily appropriation when taken as a group and transposed into a sequel by another author.” The treatment that was given to the Rocky characters was the same as the graphic characters in *Air Pirates* decision and the story being told test was not applied. The language used by Judge Hand articulating the character delineating test was used by the court for granting protection. The court in reaching the decision mentioned how it was an “unsettled state of the law” which required it to discuss both the story being told test and the character delineation test.

Therefore the trend seems to indicate that the story being told test leads to a differential treatment between literary characters and graphical characters which is not so in the character delineation test. While the visual representation helps a character to be more easily delineated from a stock character, the character delineation test requires that it should not be considered as the sole factor in making of such determination. A character is made copyrightable by the ‘characterization or personality portrait’ and the court is required to deliberate on what is the portrait’s ‘threshold of

delineation.⁹⁸ Therefore application of the character delineation test helps in providing the different forms of character a similar judicial attention towards copyrightability.

A recent example where the court applied the sufficient delineation test was *DC Comics v Towle*.⁹⁹ In this case, the court applied the test for determining whether “Bat-mobile” presented in the Batman comics was sufficiently delineated to be granted copyright protection. The court held that there existed traits and qualities in the vehicle which gave it a distinctive and iconic identity which allowed it to be copyrightable independently of the work in which it was incorporated.

The sufficient delineation test proves helpful even for protection of those characters which might not be the protagonist of the plot but are well-defined and detailed in expression. Therefore the story being told test would not be able to protect Hermione Granger or Ronald Weasley from the Harry Potter series by J.K. Rowling but the sufficient delineation test can provide them protection from unauthorized copying.

⁹⁸ Gregory S. Schienke, *The Spawn of Learned Hand-A Reexamination of Copyright Protection and Fictional Characters: How Distinctly Delineated Must the Story Be Told?*, 9 *Marq. Intell. Prop. L. Rev.* 63, 72 (2005).

⁹⁹ *DC Comics v Towle*, 802 F.3d 1012 (9th Cir. 2015).

3.2. Copyright Protection in India

In India, the Copyright Act, 1957 provides for protection of original literary, dramatic, musical and artistic work and producers of cinematograph films and sound recordings.¹⁰⁰ There is no separate category provided for protection of fictional characters. However, the number of cases in the Indian context are too less to be able to see a trend in protection of characters under this Act.

The only Indian case in which the issue of protection of character was recognized was in the case of Malayala Manorama v. VT Thomas.¹⁰¹ In this case, the court held that the characters of Toms Boban and Molly as created by the defendant were capable of being granted copyright protection independently of the work in which it appears . But no rationale was laid down for coming to this conclusion. They drew a distinction between the drawings which were made using the cartoon character and the character itself and opined that since the creation of the character had taken place before the defendant entered into employment with the plaintiffs who had no role to play in its creation, the plaintiff were entitled copyright only in the drawings in the form of comic strips which the defendant had created under employment of the plaintiff. The plaintiff could not use the character to create

¹⁰⁰ Copyright Act, 1957, Section 13.

¹⁰¹ Malayala Manorama v. VT Thomas, AIR 1989 Ker 49.

new comic strips by employing another artist after the employment of the defendant had been terminated.

Similarly, in the case of Raja Pocket Books v. Radha Pocket Books,¹⁰² the issue that arose was whether the character “Nagesh” was infringing upon the character of “Nagraj.” The court in this case did not go into the question of whether the character was copyrightable outside the work in which it appeared. It directly undertook a comparative analysis of both the characters. Finding substantial similarities between the two, the court came to the conclusion that the copyright was infringed.

In a recent judgement in the case of Arbaaz Khan Production Private Limited vs. Northstar Entertainment Private Limited and Ors.¹⁰³, the issue came up with regards to protection of a character.

The decision was given by a single judge bench of the Bombay High Court which acknowledged that characters in movies were capable of copyright protection without providing any rationale for the same. However it held that the character ‘Chulbul Pandey’ from the movie Dabangg was not infringed by the defendants by their character Sardar Gabbar Singh. The judge held that the characteristics of Chulbul Pandey were not distinctive enough in nature

¹⁰² Raja Pocket Books v. Radha Pocket Books, DRJ 1997 (40) 791.

¹⁰³ Arbaaz Khan Production Private Limited vs. Northstar Entertainment Private Limited and Ors.

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like his casual way of wearing uniform and the allegedly copied characteristics for the portrayal of Sardar Gabbar Singh was generic and therefore the injunction was not granted to the plaintiffs.

Thus the law in India is not sufficiently developed to protect fictional characters, especially with regard to pure and literary characters which have not been discussed by Indian courts so far, thereby making their protection uncertain.

3.3. Use of Characters without Permission

There are a number of instances where the copyright law provides for the use of the character without obtaining authorization from the copyright holder. These can be used in the form of defences if a challenge to the subsequent use is made by the copyright holder in the character.

3.3.1. Fair Use

The US copyright law provides an exception to the monopoly over the use of a copyrighted work. Section 107 of the Copyright Law,¹⁰⁴ makes it clear that a fair use does not constitute copyright infringement and is present when the work is used for, among other things, criticism, comment, news reporting, and teaching, scholarship or research.

Courts use the four-factor test when making a fair use determination which has been laid down by the provision itself:

¹⁰⁴ 17 USC §107

1. The purpose and character of the use;
2. The nature of the copyrighted work;
3. The amount and substantiality of the portion used; and
4. The effect on the market of the copyrighted work.

All the factors might not be equally important in all cases and therefore the court makes a case-to-case analysis to determine if the fair use exception can be taken.

The purpose of the use of the character is relevant because the fair use exception allows the use of a protected character if it is done for the purpose of criticism, comment, news reporting, and teaching which are all strong fair use factors. This factor also covers parody,¹⁰⁵ satire, and derivative work in the nature of transformative work.¹⁰⁶ The use of a character for commercial purposes would go against the alleged infringer for fair use determination. The impact on market is another important criteria. If the allegedly infringing work takes over the market of the copyright holder whereby the infringing character replaces the market for the original, then the court may not allow the fair use defence. The courts may permit the use of a character without conducting the fair use analysis if the material copied from the character is small enough. However the quality and not the quantity of the copying is

¹⁰⁵ Campbell v. Acuff-Rose Music, Inc., Supreme Court of the US, 1994. 510 US 569, 114 S. Ct. 1164

¹⁰⁶ Cariou v. Prince, 714 F.3d 694 (2d Cir. 2013)

what the courts would go into for determining fair use. The courts may also apply the de minimis principle to allow the copying.

In India, Section 52 of the Copyright Act, 1957 provides for a list of fair dealing exceptions which is an exhaustive list. If a said use of the character falls under any of the said purposes, then there is no requirement of obtaining permission from the owner of the copyright in the character for its use for that purpose. The purposes include research, study, criticism, review and news reporting, as well as use of works in library and schools and in legislatures.

3.3.2. Public Domain

Public domain refers to an area of law that is not protected by the intellectual property laws. The work in public domain is in the ownership of the public and any one can make use of the work without acquiring authorisation from anyone. The work enters the public domain when the term of the copyright protection granted to the character comes to an end. The term of copyright is determined by the legislations of the particular state. In US, there are three ways in which character would come within public domain automatically unless the owner itself dedicates the work to the public domain.¹⁰⁷

¹⁰⁷ 17 USC § 302.

- a. Characters published before January 1, 1923, are in the public domain due to copyright expirations. This includes characters like Alice, the Mad Hatter, the Red Queen and the March Hare from Alice's Adventure in Wonderland by Lewis Carrol, Peter Pan, Tinker Bell from Peter Pan by Barrie and Tom Sawyer from the Adventures of Tom Sawyer by Mark Twain.
- b. Characters published between 1923 and 1977 enter the public domain 95 years after their first publication date. Hence the characters published in 1923 just entered the public domain as of January 1, 2019 due to copyright expiration.
- c. The work could also have entered into the public domain if it was published in the above time-frame but fell within any of the following categories: If a character was published before 1964 and the copyright owner failed to renew the copyright; or if a character was published before 1978 without a proper copyright notice.

By virtue of this, Sherlock Holmes is now in public domain. In the case of *Klinger v. Conan Doyle Estate Ltd*,¹⁰⁸ the court held that as the work had come into public domain, the character included in such work were also in public domain and could be used by anyone in any other work. The only

¹⁰⁸ *Klinger v. Conan Doyle Estate Ltd*, 755 F. 3d 496 (7th Cir. 2014)

restriction is with regard to the additions and complexities of the character in the latter works which have not fallen in public domain and therefore cannot be made use of by the public without permission.

- d. Characters created after 1977 enter the public domain 70 years after the creator's death. Characters created by a corporation enter the public domain either 95 years after publication or 120 years after creation, whichever comes first.

In India, the term of protection in the case of original literary, dramatic, musical and artistic works is the lifetime of the author or artist, and 60 years counted from the year following the death of the author.¹⁰⁹

One of the instances where the copyright protection over a fictional character has been constantly extended is that of Mickey Mouse. The Copyright Act of 1976 provided for a protection term of copyright of 50 years after the life of the creator or 75 years for work of corporate authorship after creation. The Copyright Term Extension Act, 1998, also known as the Sonny Bono Copyright Term Extension Act extended the term of protection to the life of the author plus 70 years and 120 years for work of corporate authorship after creation. Works which were created before January 1, 1978 were provided increased protection of 20 years leading to a total of 95 years from the date

¹⁰⁹ Section 22, Copyright Act, 1957.

of their publication. This has led the protection to Mickey Mouse to be extended till 1st June 2024. This continued extension of protection of a character shows the ability of big production houses to lobby for continued protection which goes against the basic tenets of copyright.

3.3.3. Fan Fiction

Fan Fiction or Fan Work has been defined as “any work by a fan, or indeed by anyone other than the content owner(s), set in such a fictional world or using such pre-existing fictional characters.”¹¹⁰ These works use the characters of the pre-existing work in new settings and with new plotlines. Such work may be made with or without the authorization of the author. These works do not pose a problem when they are made with the authorization of the author, or are based on works which are no longer under copyright protection.

Authors like J K Rowling and Stephanie Meyer openly allow the fanfiction to thrive on their own official websites which helps them in gaining further popularity for their work and characters as the readers feel closely associated with them, having the power to create alternative plot endings and sharing it with other fans of the work.¹¹¹ As long as they are not made for

¹¹⁰ Aaron Schwabach, *Fan Fiction and Copyright: Outsider Works and Intellectual Property Protection*, 1st Edition (2011).

¹¹¹ *Id.*

commercial uses, the owners of the copyright do not feel threatened from fanfiction and therefore allow it. Therefore Warner Brothers who owned the copyright in the Harry Potter movie series brought action to avoid the commercial publication of works like “Harry Potter Goes to India” or “Harry Potter goes to China.” However, the authors are not so generous with their characters as the above examples might show. The same author allowing for alternate endings of the plotlines on her website, sued a fan for creation of a Harry Potter lexicon which was so detailed and accurate that Rowling herself was said to use it as a reference. It did not fulfil the fair use test as it was for commercial purpose, included direct references from the books including characters and dialogues, and would replace the market if Rowling wrote a similar encyclopaedia as a derivative work, which she intended to write.¹¹² Therefore fanfictions may land the fan in an infringement suit if the fans try to capture the market of the authors using their creations.

The determination of which works are not under copyright protection is a difficult one. The copyright laws of different countries provide for different terms of protection which, as seen above, are subject to extension even with retrospective effect. Therefore the characters available in public domain in different countries would vary. Further the fanfictions are mostly published on the internet which does not comply strictly with the national boundaries of

¹¹² Warner Brothers v. RDR Books, 575 F.Supp.2d 513 (S.D.N.Y. 2008).

these countries. It is also difficult to keep a track of the traits of the character that were developed later and hence may not have come under public domain while the character itself might have fallen in the public domain.¹¹³

Further the approach of the court towards application of the sufficient delineation test and the story being told test determines the protection that will be granted to a character. The protagonist characters are still likely to be held protectible under both the tests, like Harry Potter or Elizabeth Bennet in the novel *Pride and Prejudice* by Jane Austen, as being sufficiently delineated and being the story being told. But the protection of the secondary characters like Ron Weasley and Hermione Granger or Mr Fitzwilliam Darcy and Jane Bennet is not certain till these characters are unauthorizedly copied and copyright violation claimed and adjudicated upon by the court. The fanfiction therefore faces this uncertainty when creating their work from these pre-existing works.

3.3.4. The Scènes à faire Doctrine

Under this doctrine, copyright protection is denied to elements of which necessarily flows from a common idea and is based on the idea-expression dichotomy. It is commonly applied to fictional works, plots, incidents and

¹¹³ See *Klinger v. Conan Doyle Estate Ltd* at Note 107.

character traits.¹¹⁴ It imposes a limitation to copyright protection being granted to characters that are mere types like the clown or a jealous husband or a fire-breathing dragon.¹¹⁵ Therefore courts will not grant protection to stereotyped fictional characters which are common to a particular subject or topic. For example the portrayal of a witch or a wizard with magic wands and broomsticks and cauldrons will not be copyrightable.

Conclusion:

The copyright law has been applied by the courts in providing protection to the fictional characters. The judiciary has evolved various tests to determine the copyrightability of the characters. The sufficient delineation test requires the court to apply aesthetic judgement of the degree of the delineation that a character has within the copyrighted work and therefore forces the court to analyse the non-literal elements of the characters. The story being told test provides for proof of a higher standard. Therefore the former test is more applicable for granting similar protection to different forms of fictional characters. The copyright law provides for exceptions to the monopoly over fictional characters in the form of fair use and scenes a faire.

¹¹⁴ Marshall A. Leaffer, *Understanding Copyright Law*, New Providence, NJ : LexisNexis, [2014].

¹¹⁵ *Gaiman V. Mcfarlane*, 360 F.3d 644 (2004)

Chapter-IV

Other Forms of Protections for Fictional Characters

Copyright does not protect all the elements of a fictional character. Neither is the protection sufficient as seen in the previous chapter which has led the courts to extend protection to the fictional characters by borrowing elements from other intellectual property laws. Some of these have been discussed in this chapter.

4.1 Trademark

Trademarks and service marks perform the following functions:

- “1. To identify one seller's goods and distinguish them from goods sold by others.”
2. To signify that all goods bearing the trademark come from a single, albeit anonymous, source.
3. To signify that all goods bearing the trademark are of an equal level of quality, and
4. To serve as a prime instrument in advertising and selling goods.”¹¹⁶

¹¹⁶ J. Thomas Mccarthy, Trademarks And Unfair Competition, 3:1, At 104 (2d Ed. 1984 & Supp. 1988).

A fictional character cannot be granted trademark protection on its own but it may be protected when it is used to indicate the source of a product.¹¹⁷ In USA, both the common law and the federal law provide for trademark protection against the use of the same mark by a second comer, or a colourable imitation of a mark, which has the potential to cause consumer confusion, mistake, or deception.¹¹⁸ The most crucial element for proving a cause of action in trademark infringement is proof of consumer confusion. The courts balance a number of factors to determine whether the consumers have been confused or misled by the use of an allegedly infringing mark by a subsequent comer and in this determination apply the “likelihood of confusion test.”¹¹⁹ A related analysis which is undertaken is whether the original mark has acquired a secondary meaning so that the consumers are likely to wrongfully associate the second mark with the first one.

The advantage that trademark provides is that duration of its protection is potentially perpetual. The owner continues to own the rights in perpetuity¹²⁰ unless the mark is abandoned or otherwise has lost its indicative qualities

¹¹⁷ Pillsbury Co. v. Milky Way Prods., 8 Media L. Rep. (BNA) 1016 (N.D. Ga. 1981).

¹¹⁸ Lanham Act § 32, 15 U.S.C. § 1114 (1988).

¹¹⁹ Anthony F. Lo Cicero, Litigating Trademark Cases, in Practising Law Institute, Litigating Copyright, Trademark, And Unfair Competition Cases 1989, at 81

¹²⁰ For federally registered marks, registration may be renewed for periods of ten years. Lanham Act § 9, 15 U.S.C. § 1059 (1988).

because it has become generic or merely descriptive.¹²¹ This protection therefore extends not only to the owners of the trademark but also the consumers who rely on the identity of the entity which sponsors it or which produces it. This protection is independent of the protection granted under copyright law as both apply principles and seek to protect different aspects of a creative work. Therefore in the case of Tri-star Pictures, Inc. v. Del Taco, Inc¹²², the absence of copyright protection to the character of “Zorro” did not preclude the bringing of a claim of trademark infringement when the defendant used indicia related to Zorro to promote its restaurant chain.

Trademark law does not protect all elements of a character. Trademark protection is granted to only those elements of a character which are able to provide assistance to the public in associating the character with a specific source. Therefore in the case of D.C. Comics v. Filmation Associates,¹²³ the court held that trademark law could protect “names and nicknames as well as their physical appearances and costumes but not their physical abilities or personality traits.” Therefore the court denied the protection to the plaintiff’s characters- Aquaman and Plastic Man whose physical traits were copied by the defendant’s characters-Manta and Superstretch.

¹²¹ King-Seeley Thermos Co. v. Aladdin Indus, 321 F. 2d 577 (2d Cir. 1963)

¹²² TriStar Pictures, Inc. v. Del Taco, Inc., 59 U.S.P.Q.2d 1091 (C.D. Cal. 1999)

¹²³ DC Comics, Inc. v. Filmation Assocs., 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980)

4.4.1 Name of the Character

The trademark protection extends to the name of a character.¹²⁴ A leading case in this direction is *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.*¹²⁵ In this case, the court held that a secondary meaning had been established by the plaintiff and therefore they had acquired trademark rights in the name “Wyatt Earp” even when it was the name of a real person having historic significance. The court acknowledged the fact that the commercial value that the name had acquired was attributable to the plaintiff’s television program entirely along with the licensing system which made the name famous among the public consciousness. The name Wyatt Earp was held by the court to have acquired a secondary meaning by the plaintiff’s use which allowed it the right to stop the licensee-defendant from selling and promoting Wyatt Earp costumes after their license had expired. The court stated that the goodwill that the plaintiff’s radio and television shows had increased of the Wyatt Earp name would lead the consumers to believe that the costumes had come from the plaintiff, thereby misleading them.

¹²⁴ *Conan Properties, Inc. v. Conans Pizza, Inc.*, 752 Fed.2d 145 (5th Cir. 1985)

¹²⁵ *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.*, 157 F. Supp. 621 (S.D.N.Y. 1958)

4.4.2 Costumes of Characters

Another way of protection of characters is by way of protection of costumes worn by the character which can qualify for trademark protection.¹²⁶ This is because the use of a character's costume without obtaining the authorization from the owner can lead to the consumers to establish a connection between the character owner and the unauthorized user. Therefore in the case of *Dallas Cowboys Cheerleaders v. Pussycat Cinemas*,¹²⁷ the court dealt with the issue whether the unique costumes wore by its cheerleaders could be granted trademark protection. The court held that the "combination of white boots, white shorts, blue blouse, and white star-studded vest and belt is an arbitrary design which makes the otherwise functional uniform trademarkable." Similarly the costumes of characters like Batman¹²⁸ and Arthur the Aardvark¹²⁹ were held to be protectible as trademarks which were inherently distinctive.

4.4.3 Distinctive Visual Representation

¹²⁶ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979).

¹²⁷ *Ibid.*

¹²⁸ *Warner Bros. Inc. v. Rooding*, 1989 WL 76149

¹²⁹ *Brown v. It's Entertainment, Inc.*, 34 F. Supp. 2d 854 (E.D.N.Y 1999).

Trademark law also protects the visual representation of characters. The character of 'Conan the Barbarian' was upheld by the courts to have trademark protection. It therefore held the use of the character by the defendants for promotion of their chain of pizza restaurants named "Conans Pizza" to be infringing the trademark of the plaintiff.¹³⁰ The use of the character on menus, signs, promotional material and general décor featuring a barbarian like man who resembled the character, 'Conan' was held by jury to have a potential to confuse the consumers into believing that there was an association between the restaurant and the plaintiff's character.

The protection however is not wide ranging as it is only the distinctive elements of a character which may cause confusion as to the source of the competing character which are granted protection under trademark laws. If the competitor uses a similar or common characteristic traits, then it would not infringe the trademark. As in the case of copyright the stock elements cannot be granted protection, similarly, trademark law does not protect general traits and abilities of a character. As personality traits and physical abilities of a character are capable of being depicted in a multiple number of ways, it is not possible for them to be so consistent so as to act as a single identification of source.

¹³⁰ Conan Properties, Inc. v. Conans Pizza, Inc. 752 F.2d 145 (5th Cir. 1985).

Therefore trademark law cannot protect each of these. This was held in the case of *American Greetings Corp. v. Easter Unlimited, Inc.*¹³¹ where the display of messages on the chest of a teddy bear by the defendant was held to be not infringing the trademark of the plaintiff in “Care Bears” which were stuffed soft toys with symbols on their chests.

4.4.4 Other Indicia

If the identification of source of a character can be done by other indicia such as a prop, a slogan or a well-known saying if it is so connected to the character, then even such indicia can be granted trademark protection.¹³² Therefore trademark has provided protection to Bugs Bunny’s “What’s up, doc?”¹³³ and “E.T. phone home”¹³⁴ Further the court in *Warner Bros. v. Gay Toys*¹³⁵ held that the famous colour scheme and symbol used by the plaintiff on “General Lee” had acquired a secondary meaning and therefore its use by the defendant on their toy cars without obtaining authorization from the plaintiff would lead the

¹³¹ *Am. Greetings Corp. v. Easter Unlimited, Inc.*, 579 F. Supp. 607, 617 (S.D.N.Y. 1983).

¹³² *DC Comics, Inc. v. Filmation Assocs.*, 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980) (“[W]here the product sold by plaintiff is ‘entertainment’ in one form or another, then not only the advertising of the product but also an ingredient of the product itself can amount to a trademark protectable under § 43(a) because the ingredient can come to symbolize the plaintiff or its product in the public mind.”).

¹³³ *What’s Up, Doc?*, Registration No. 75,844,359.

¹³⁴ *Universal City Studios, Inc. v. Kamar Indus., Inc.*, 217 U.S.P.Q. 1162 (S.D. Tex. 1982).

¹³⁵ *Warner Bros., Inc. v. Gay Toys, Inc.*, 724 F.2d 327, 333 (2d Cir. 1983).

consumers to believe that the source of origin of the latter's cars was the same as Dukes of Hazzard.

4.2 Unfair Competition

Unfair competition is a common law cause of action which is a "thread of the same cloth" as trademark. The difference that the two has is that of degree of protection. As has been explained by Goldstein:

*"It embraces a broad continuum of competitive conduct likely to confuse consumers as to source of goods and services- from the appropriation of relatively nondistinctive symbols accompanied by acts of passing off, to the appropriation of distinctive symbols in which case confusion is presumed. Trademark law occupies only the last part of this continuum."*¹³⁶

The codification of unfair competition has been done on the federal level by the Lanham Act § 43(a), which specifically prohibits false and misleading designations, descriptions, or representations which are likely to cause confusion or mistake as to the source or association.¹³⁷

This protection is used frequently with statutory patent, trademark and copyright claims but every such claim does not lead to a presumption of violation of Section 43(a). Neither does the non-applicability of any other form of intellectual property preclude its protection. However given

¹³⁶ Paul Goldstein, Copyright: Principles, Law And Practice § 2.11.3, at 158 (1989).

¹³⁷ Lanham Act § 43(a), 15 U.S.C. § 1125 (1988).

its similarity to trademark infringement, the courts which apply this section also use the likelihood of confusion test and traditional rules of trademark for substantive purposes.¹³⁸

In the case of *Lone Ranger, Inc. v. Cox*¹³⁹, the defendants were barred from using any language that would lead the public to believe that a connection existed between the name 'Lone Ranger' and the defendant's circus as the plaintiff's radio program was distributed under the trade name of 'Lone Ranger.' Plaintiff had acquired the necessary association with the name and therefore the use of the title 'the Original Lone Ranger' for a performer in the defendant's circus would be a fraudulent misappropriation of the goodwill acquired by the plaintiff.

4.3 Right of Publicity

In addition to copyright and trademark, the character may also be capable of protection by way of right to publicity when an actor or a person adopts a character persona. This right gives the person holding it the right to control the exploitation of its identity.¹⁴⁰ The name,¹⁴¹ image, signature, general appearance, voice etc. may be considered to be the identity of the character or other persona. The appeals court in the case of *Wendt v. Host*

¹³⁸ J. Thomas McCarthy, *Trademarks And Unfair Competition* § 3:1 (2d ed. 1984 & Supp. 1988).

¹³⁹ *Lone Ranger, Inc. v. Cox*, 124 F.2d 650, 653 (4th Cir. 1942).

¹⁴⁰ *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983).

¹⁴¹ *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 726-27 (S.D.N.Y. 1978) ("the Greatest").

International, Inc.¹⁴² rejected the decision of the Ninth Circuit and held that there was a violation of right of publicity because of the physical likeness of the characters even if the plaintiff did not have copyright protection over the characters “Norm” and “Cliff” which they played on television as the defendant’s robots made use of the actors’ physical likeness. Additionally, if instead of the characters, there is a use of likeness of the actors who play the part of the characters, even then the right of publicity can be held to have been violated. But this protection can be taken for protection of a character by an actor only when the accused character evokes the persona of the actor by commercializing it without his consent.¹⁴³ The violation of right to publicity may not be upheld if it is the exploitation of a character played by the actor without the actor’s identity being exploited.¹⁴⁴ For example the portrayal by an M&M of a cowboy did not evoke the persona Burck himself but rather evoked the image of the character of the cowboy portrayed by Burck and therefore it was held to be not violative of the right of publicity as granted by Section 50 of the New York Civil Rights Law.

¹⁴² *Wendt v. Host International*, 197 F.3d 1284 (1999).

¹⁴³ *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 624–25 (6th Cir. 2000).

¹⁴⁴ *Burck v. Mars, Inc.*, 571 F. Supp. 2d 446, 454 (S.D.N.Y. 2008).

4.4 Passing Off

Passing off, as a common law tort can be used in cases where the trademark protection is not available due to lack of registration.¹⁴⁵ The fundamental elements which are required to be fulfilled for a successful claim under passing off are-

1. That the good or service had an established reputation.
2. The defendant indulged in misrepresentation to the public leading them or likely to lead them to believe that the goods or service that he is endorsing are that of the plaintiff.
3. The plaintiff suffered a damage to his goodwill due to such misrepresentation.

This examples of use of this action for protection of characters can be seen in Indian cases. In the case of WWE v. Savio Fernandes, the Delhi High Court granted the plaintiffs a permanent injunction. The defendants were found guilty of not only infringing the registered trademark-‘WWE’ but also was using the likeness of the wrestlers in its products constituting the action of passing off.¹⁴⁶

¹⁴⁵ Section 24 (2), The Trade Marks Act, 1999 (India)- “Nothing in this Act shall be deemed to affect right of remedial action against any person for passing off the goods or services of another person as his own.”

¹⁴⁶ World Wrestling Entertainment, Inc. v. Savio Fernandes & Ors., 2015 (62) PTC 573 (Del)

Conclusion:

There are other forms of protection in the form of trademark and right to publicity which is available to fictional characters in addition to copyright and even in cases such as names, logos, slogans etc. where copyright is not available. This protection is available when the characters are able to evoke and identify the source of a product or service.

Chapter V

Problems with the Existing Protection of Fictional Characters

5.1 Drawbacks of Copyright Protection

5.1.1 The Problem of Delineation by Application of the Tests

The Nichols Test or the sufficient delineation test has been interpreted by scholars and judges in the form of a two-step enquiry:

“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.”¹⁴⁷

The application of this enquiry has led to an inconsistency as the courts are often fixated with the issue of threshold copyrightability instead of deciding whether the second character copied the first character and then deciding whether the copying constituted copyright infringement. Because of this, the question of infringement between the works in question is never reached. This happened in the case of *Giangrasso v. Columbia Broadcasting System*,¹⁴⁸ where the court was required to determine if the radio play script

¹⁴⁷ M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 2.12, at 2-178 (1990).

¹⁴⁸ *Giangrasso v. Columbia Broadcasting System*, 534 F. Supp. 472, 477-478 (EDNY 1982).

had been infringed by the television episode in question. The court focused on the issue whether the characters depicted in each work were delineated and thereby denied copyright protection solely on this ground. In a traditional copyright case, the court would have held that the radio script's characters were protected and then proceeded to determine if the television characters had infringed the protected aspects of the radio characters. This has led to the denial of protection to the underlying work as well in addition to the character.

On the flip side, there have been instances where the courts have found the characters to have been sufficiently delineated and therefore granted them copyright protection and extended it to future works also. Therefore in the case of *Anderson v. Stallone*,¹⁴⁹ Rocky Balboa was given independent copyright protection and prohibited the use of the character in a new script. In this case because of the failure of the court to distinguish between the protection of the character and separate protection for the new script, the court overprotected the character, thereby leading to a situation where Anderson's plot ideas could be easily copied by Stallone without constituting infringement.

The higher standard required for protection of fictional characters leads to the effective elimination of the need to determine the infringement. Therefore the

¹⁴⁹ *Anderson v. Stallone*, 1989 Copyright L. Dec. (CCH) at 22,671.

courts require that when copyright infringement is claimed by artists in characters, they meet a higher standard of substantial similarity as compared to a standard claim of infringement.¹⁵⁰ Also there is no uniformity in the evaluation of the courts in determining whether the fictional characters are sufficiently delineated. This can be seen in the way in which Tarzan¹⁵¹ was granted protection but Sam Spade was not.¹⁵²

In determination of the copyrightability of characters, the courts require the satisfaction of either of the two main tests, that is the “distinctive delineation” test or the “story being told” test. The drawbacks involved in application of the two tests has already been seen above. In addition to these two formal tests, the courts often use a number of informal tests which leads to

¹⁵⁰ M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 2.12, at 2-178 (1990).

¹⁵¹ Edgar Rice Burrough’s description of Tarzan—“*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 Tarzan.*” *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 519 F. Supp. 388, (S.D.N.Y. 1981).

¹⁵² Dashiell Hammett’s description of Sam Spade’s physical appearance in the first paragraph of *The Maltese Falcon*—“*Samuel Spade’s jaw was long and bony, his chin a jutting v under the more flexible v of his mouth. His nostrils curved back to make another, smaller, v. His yellow-grey eyes were horizontal. The v motif was picked up again by thickish brows rising outward from twin creases above a hooked nose, and his pale brown hair grew down—from high flat temples—in a point on his forehead. He looked rather pleasantly like a blond satan.*” *Warner Bros Pictures Inc v Columbia Broadcasting Sys Inc* 216 F 2d 945, 104 US P Q 103 (9th Cir. 1954),

confusion and unpredictability and therefore the law in the field is inconsistent and unclear.¹⁵³

5.1.2 Character Entanglement

Apart from the tests to grant copyright protection to a character, the law is also not clear with regards to the scope of protection of a character as regards to its outer boundaries. This has been termed as the character entanglement problem. This deals with the question that which parts of an independent character belong to the text of the work and which to the character sought to be protected. Further which part would constitute plot and which constitutes style which, on its own, is not capable of protection¹⁵⁴ and which are the distinctive character elements which are capable of protection.¹⁵⁵

As the representation of characters by the authors has evolved from flat to round characters, the problem has arisen which makes it difficult to disentangle characters from the texts to be able to grant them protection. The new techniques of narration of the work like soliloquy, dramatic monologue, free indirect intercourse¹⁵⁶ gives the character a more real form, making them

¹⁵³ Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co., 900 F. Supp. 1287, 1295 (C.D. Cal. 1995)

¹⁵⁴ Steinberg v. Columbia Pictures Indus., 663 F. Supp. 706, 711 (S.D.N.Y. 1987).

¹⁵⁵ Id.

¹⁵⁶ H. Porter Abbott, *The Cambridge Introduction To Narrative* 67–82 (2d ed. 2008).

more human.¹⁵⁷ This however further complicates the disentanglement of a character from the text as the characters became more knitted into the text. In the case of *Salinger v. Colting*,¹⁵⁸ the court mentioned the complexity in a passing statement: “*It is difficult, in fact, to separate Holden Caulfield from the book.*” Because of the form of narrative used, the boundaries between the text and the character start becoming blurred which complicates the copyright law’s treatment of the character’s independent existence.

The difficulty then that the copyright law faces is that of determination of that part of the text which is associated with the character and therefore be treated as independent property that belong with them so that the independent character can be granted protection with the capacity of withstanding the substantial similarity analysis. Copyright law does not have any tool for deciding where the line should be drawn between protectible aspects of a character and the text and this is visible in the thin line of difference which may exist between narrative commentary and interior monologue of characters.

This problem is further magnified when understood in terms of the style of the writing used, which by itself is not copyrightable.¹⁵⁹ The relationship of

¹⁵⁷ Ian Watt, *The Rise Of The Novel: Studies In Defoe, Richardson And Fielding* 15 (1957).

¹⁵⁸ *Salinger v. Colting*,. 607 F.3d 68 (2d Cir. 2010).

¹⁵⁹ *Steinberg v. Columbia Pictures Indus.*, 663 F. Supp. 706 (S.D.N.Y. 1987).

the character which is imagined with their surrounding text determines whether style will be granted protection. If the characters are presented in such a way that the textual components also include stylistic features like the narrative devices, then the subsequent users who use the stylistic features in a future work may lead to them borrowing the character itself. If protection is granted to these stylistic features along with the characters by broadening their scope, it would lead to the subsequent authors being proscribed from using that particular style which is not protectible. Such broad scope of protection may prove to be unjustified.

5.1.3 Discrimination Between Different Types of Characters

Literary Characters

Copyright law requires the courts to not go into the determination of aesthetic value of the work.¹⁶⁰ However such consideration do creep in when character copyrightability is in issue in the following ways.¹⁶¹ Firstly aesthetic determinations are made by granting protection more easily to visual characters than literary characters. Secondly, copyright uses terminology like “word portraits” which have been given different treatments. While scholars believe that they are not protectible,¹⁶² the courts have granted protection to

¹⁶⁰ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

¹⁶¹ Robert A. Gorman, *Copyright Courts and Aesthetic Judgments: Abuse or Necessity*, 25 *Colum. J.L. & Arts* 1 (2001)

¹⁶² M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 2.12, at 2-178 (1990).

word portraits in certain cases.¹⁶³ Judge Posner has provided the distinction between a literary and a graphical character stating that “the description of a character in prose leaves much to the imagination, even when the description is detailed.”¹⁶⁴ He states that even if the literary character is well-defined, it depends much on the reader’s perception while no subjectivity lies in the case of graphical characters. The reception studies or reader response theory states that readers create or actualize the meanings in the text they read.¹⁶⁵ The active engagement theory of the reader with the character, as stated by Posner therefore does not conflict with the literary theory. However literary theories of interpretation and consumption in the contemporary media studies suggest that the consumers of film and television also undertake construction and decoding in order to deliver meanings.¹⁶⁶ Posner’s views might be justified in understanding the ease of the courts in recognizing infringement in case of visual characters which is not the case for literary characters. This is based on the logic that visual images are “transparent” as opposed to literary ones which are “opaque.” Tushnet argues that courts when dealing with copyright treats non-textual creative works such as

¹⁶³ *Salinger v. Colting*, 607 F.3d 68, 73 (2d Cir. 2010)

¹⁶⁴ *Gaiman*, 360 F.3d at 660-61.

¹⁶⁵ Robert H. Rotstein, *Beyond Metaphor: Copyright Infringement and the Fiction of the Work*, 68 CHI.-KENT L. REV. 725, 736–37 (1993).

¹⁶⁶ Michael Todd Helfand, *When Mickey Mouse is as strong as Superman: The convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters*, 44 Stan. L. Rev. 632, 625 (1992).

images in one of the two-ways- they either can be transparent or opaque. When images are transparent, interpretation is not required as they show the reality thereby giving obvious meaning. On the other hand, opaque images cannot be interpreted at all and cannot be analysed using words.¹⁶⁷ But when such ease is considered in an infringement analysis, it starts bordering the territory of trademark which protects symbols.¹⁶⁸

The reluctance to provide protection to 'word portrait' stems from the limited understanding of the term in the copyright regime. The term is used by the courts synonymously with unprotected ideas.¹⁶⁹ However there is a need to differentiate between 'word portraits' which are generic in nature and others which characters are expressed in detail as there is no standard understanding of the term "word portrait." The focus, however, should be on the idea-expression dichotomy which would shed light on the protected and unprotected elements of works covered by copyright instead of the form in which the fictional character is presented.

¹⁶⁷ Rebecca Tushnet, Legal Fictions: Copyright, Fan Fiction, and a New Common Law, 17 LOY. L.A. ENT. L. REV. 651, 655-60 (1997)

¹⁶⁸ Leslie A. Kurtz, The Independent Legal Lives of Fictional Characters, 1986 WIS. L. REV. 429, 432

¹⁶⁹ Nimmer. 2-12

Audio/Visual Characters

Characters which incorporate the attributes of both literary and cartoon characters to varying degrees are known as audio/visual characters.¹⁷⁰

Referred to as hybrid creations, these characters are usually found on films or television can have various degrees of delineation. However the courts are likely to provide protection to a character if it is more cartoonlike. An example of this can be taken in the case of *Ideal Toy Corp. v. Kenner Products*.¹⁷¹ The court in this case held the three-dimensional dolls of the “Star Team” characters violated copyright of the two-dimensional movie characters from the movie ‘Star Wars’ because of the similarity.

On the other hand, in the case of *Warner Brothers v. Film Ventures International*,¹⁷² the court did not find infringement when the movie ‘Beyond the Door’ portrayed the character of a devil-possessed woman which was substantially similar to the character in ‘The Exorcist.’ The court chose to apply the stringent ‘story being told’ test and did not hold the character copyrightable because the plot of the movie, ‘The Exorcist,’ was not “subordinated to the character.” It can therefore be seen that more than substantial similarities, it is the approach of the court with regard to the copyrightability of the character which determines the protection of a

¹⁷⁰ Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 *Wis. L. Rev.* 429, 436 (1986).

¹⁷¹ *Ideal Toy Corp. v. Kenner Products*, 443 F. Supp. 291 (S.D.N.Y. 1977).

¹⁷² *Warner Brothers v. Film Ventures International*, 403 F. Supp. 522 (C.D. Cal. 1975).

particular character. In light of the uncertainty as shown above, the authors who license their characters for use in other media face the risk of losing the control of their characters.

Pure Character

A further challenge is posed when a human character or a “pure” character is copied and transformed into an audio/visual character. Such “pure” characters may be created by street artists, stand-up comedians, or stage performers. The artist comes up with the character and performs it before it is placed in any “underlying work.” As the copyright law protects only “works,” the failure of a character to incorporate their performance in a protectable work denies them the protection in the character. An example of this is available in the case of *Columbia Broadcasting System v. DeCosta*.¹⁷³ DeCosta was a mechanic who made public appearances dressed as a cowboy. He printed business cards bearing the name “Paladin” which contained the image of a chess knight and words- “Have Gun Will Travel.” CBS started broadcasting a television series titled “Have Gun Will Travel” which had a character name Paladin who dressed similar to DeCosta and handed out similar cards bearing the image of chess knights and the title of the show. The court in this case upheld copyrightability of DeCosta’s character but held that since he had failed to obtain copyright protection for it,

¹⁷³ *Columbia Broadcasting System v. DeCosta*, 377 F. 2d 315 (1st Cir. 1967).

he would not be entitled to recover damages. It held that his public appearance were not sufficient to constitute publication which was necessary under the 1909 Act to be granted copyright protection.

Even though such pure characters are a valuable form of artistic expression, they are denied copyright protection because of their non-inclusion in a “work.”

5.1.4 Character Fixation

As suggested by Judge Posner, in the context of characters, literary images allow for a multitude of modes of recognition.¹⁷⁴ One line of argument that has been put forward in this chain of thoughts is that if the readers are required to conjure the literary character mentally, then they do not fulfil the fixation requirement of copyright.¹⁷⁵ There are more than one ways to read a character. The words by which a character is expressed might be fixed in words which can be copyrighted in the form of text. But the character of the text can be argued to lack the fixation requirement in order to qualify for an independent copyright protection. This is because the way in which a reader would interpret the verbal text to produce a mental image is relative to the reader and therefore not fixed.

¹⁷⁴ Gaiman v. McFarlane, 360 F.3d 644 (7th Cir. 2004).

¹⁷⁵ 17U.S.C. §102(a).

A work, to be considered as “fixed in any tangible medium of expression”¹⁷⁶ must be “sufficiently permanent or stable... to be perceived, reproduced, or otherwise communicated for a period of more than a transitory duration.”¹⁷⁷ Complexities in the fixation requirement arise as to the work which is fixed only for a temporary period or changes as a part of its nature or design. The courts have held that such changing works such as the ephemeral audio-visual display produced by videogames are copyrightable but emphasized on their repetitive nature of their transient displays.¹⁷⁸ Such repetition does not take place in the case of creation of visual image of the character which is different for each person.

Theories of reading and empirical evidence has shown that literary characters undergo changes in the minds of the readers. This evolution through reading would lead their existence to extend beyond the words on the page and would lead to the failure of the character to meet the requirement of fixation which is necessary for grant of copyright. An example in support of this argument is the case of Kelley v. Chicago Park District.¹⁷⁹ In this case, the question before the court was whether a garden could be

¹⁷⁶ 17U.S.C. §102(a).

¹⁷⁷ 17U.S.C. §101.

¹⁷⁸ Williams Elecs., Inc. v. Artic Int'l, Inc., 685 F.2d 870, 873–74 (3d Cir. 1982).

¹⁷⁹ Kelley v. Chicago Park District, 635 F.3d 290 (7th Cir. 2011).

considered to be fixed and therefore be considered a work of authorship meriting copyright protection. The Seventh Circuit Court refused to hold the garden to be fixed as its elements were “alive and inherently changeable, not fixed.” As opposed to the videogames, the garden was not repetitive and predictable. The same can be said about characters who are required to be made sense of by the reader. Hélène Cixous says:

“By definition, a “character,” preconceived or created by an author, is to be figured out, understood, read: he is presented, offered up to interpretation, with the prospect of a traditional reading that seeks its satisfaction at the level of a potential identification with such and such a “personage,” the reader entering into commerce with the book on condition that he be assured of getting paid back, that is, recompensed by another who is sufficiently similar to or different from him—such that the reader is upheld, by comparison or in combination with a personage, in the representation that he wishes to have of himself.”¹⁸⁰

*The fixation requirement is necessary for providing evidence of the creation and its infringement.*¹⁸¹

5.1.5 Problem with Over-Protection

¹⁸⁰ Hélène Cixous, *The Character of “Character”*, 5 NEW LITERARY HIST. 383, 385 (1974).

¹⁸¹ Zahr Said, *Fixing Copyright in Characters: Literary Perspectives on a Legal Problem* (April 7, 2013). *Cardozo Law Review*, Vol. 35, No. 2, Pp. 769-829 (2013).

Character protection is a way of filling the gap that exists in protection of work used by the court when the subsequent use of characters from an original copyrighted work extends beyond the limits of the substantial similarity analysis but the latter work makes use of the existing work to a considerable extent. In doing such an analysis, the plaintiff is required to prove that the defendants had indulged in copying “a substantial, legally protectable portion” of the plaintiff’s work.¹⁸² Since direct evidence of copying may not be available, the plaintiff may show

“(a) that defendants had access to the copyrighted material from which they allegedly copied and

*(b) that “substantial similarity” existed between plaintiffs’ and defendants’ works.”*¹⁸³

If the court was unable to find any substantial similarity between the overall work, it would then be required to look into the question that whether the characters are protectable as independent from the work and then go on to ask whether the subsequent work had made unauthorized use of the protected part of the underlying work’s character.¹⁸⁴ When the question of copyrightability of character is required to be determined, the courts usually begin with an examination of the degree to which the character is

¹⁸² Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co., 900 F. Supp. 1287, 1292 (C.D. Cal. 1995).

¹⁸³ Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp., 562 F.2d 1157, 1162–63 (9th Cir. 1977).

¹⁸⁴ Olson v. National Broad. Co., 855 F.2d 1446-1451(9th Cir. 1988).

developed¹⁸⁵ which would include the character's physical descriptions, linguistic tendencies, relationship with other characters etc. This is a deviation from the standard test for infringement mentioned above which is adopted for a different kind of infringement. The two can be distinguished as copying and creative reuse respectively.¹⁸⁶ In character jurisprudence, it is the creative reuse which plays an important role.¹⁸⁷ In discussing such cases, the courts usually get stuck with the discussion of the character as opposed to whether any infringement has occurred. This has led to expansion of copyright protection for certain characters.¹⁸⁸

This however goes against the basic tenet of copyright law which is built on utilitarian grounds¹⁸⁹ and therefore provides restriction on the rights of the copyright holders with respect to both duration and subject-matter. The restrictions serve the interest promulgated by the Constitution which is "to promote the Progress of Science and Useful Arts"¹⁹⁰ and therefore provide some protection to subsequent authors. After the monopoly ceases beyond

¹⁸⁵ *Ideal Toy Corp. v. Kenner Prods. Div. of Gen. Mills Fun Grp.*, 443 F. Supp. 291, 301 (1977).

¹⁸⁶ Pamela Samuelson, *Unbundling Fair Uses*, 77 *FORDHAM L. REV.* 2538, 2557 (2009)

¹⁸⁷ Said, Zahr, *Fixing Copyright in Characters: Literary Perspectives on a Legal Problem* (April 7, 2013). *Cardozo Law Review*, Vol. 35, No. 2, Pp. 769-829 (2013).

¹⁸⁸ Jessica Litman, *Copyright as Myth*, 53 *U. PITT. L. REV.* 235, 242 (1991)

¹⁸⁹ *Ibid.*

¹⁹⁰ U.S. Constitution. Art. I, § 8, cl. 8.

the limited duration, the rights in the work go back into the public domain,¹⁹¹ thereby balancing the rights of the initial and the subsequent author.¹⁹² One such way of balancing the rights of the author with that of the subsequent author is fair use which has been said to provide a “breathing space” for authors who are desirous of creating work of art by building on pre-existing building blocks.¹⁹³ In a famous case on fair use, *Campbell v. Acuff-Rose Music, Inc.*, the court held this balance to be an “inherent tension in the need simultaneously to protect copyrighted material and to allow others to build upon it.”¹⁹⁴

In line with this, the copyright protection for characters has its own internal limitations. The major issue is determination of the contours of copyright protection in characters as some uses of the protected characters may qualify as “fair use” while other characters would fail at the very beginning to be granted such protection as being stock characters. The scope and purpose which copyright serves becomes relevant here. As the characters’ lives extend beyond the works in which they are incorporated, they create inspiration for subsequent readers and authors and therefore lead to rise of powerful rights which impact substantially parties, including those other than

¹⁹¹ Paul Goldstein, *Copyright, Patent, Trademark And Related State Doctrines* 7– 8 (2d Ed. 1981).

¹⁹² *Warner Bros. v. Am. Broad. Cos.*, 720 F.2d 231, 245 (2d Cir. 1983)-

¹⁹³ Joseph P. Liu, *Copyright and Breathing Space*, 30 *COLUM. J.L. & ARTS* 429 (2007).

¹⁹⁴ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994).

the owner.¹⁹⁵ Therefore there is a requirement for balancing of the rights available for the author with that of the other stakeholders.

There has been certain criticism against granting protection to fictional characters itself by arguing that they are not “work” as they do not have instances and exist in the form of an abstract entity.¹⁹⁶ There is also an argument that the characters are not created from a scratch but are based on elements from other sources which are in the public domain. The DC character of Wonder Woman is based on the Greek myths of Amazons and Marvel’s characters- Thor and Loki come from the Norse Mythology and still they hold trademark protection on the name and likeness of these characters. Therefore, the characters should go back to the public domain to balance the legitimate interest of the authors with that of the future creators and the society at large.

As said by Jessica Litman-

“The elements that Walt Disney drew from the public domain belong to us, the public. The Disney Company has been hanging on to a particular combination of them for a time, but it has them on loan from us. Unless Disney is to pull up the bridge after itself, those elements, and their

¹⁹⁵ Said, Zahr, Fixing Copyright in Characters: Literary Perspectives on a Legal Problem (April 7, 2013). *Cardozo Law Review*, Vol. 35, No. 2, Pp. 769-829 (2013).

¹⁹⁶ Darren Hudson Hick and Reinhold Schmücker, eds., *The Aesthetics and Ethics of Copying*. Reviewed by Karen Gover, *Philosophy in Review* 37 (2):59-61 (2017)

combination in the unique character of Mickey Mouse, need to be returned to the public domain so that the Walt Disneys of tomorrow will have raw materials that they can use to draw new characters.”

5.2 Problems with Trademark and Unfair Competition

As seen before, trademark protection extends to 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.”¹⁹⁷ Trademark infringement requires proof of consumer confusion as well as attribution of secondary meaning. The federal trademark does not apply automatically when a character is created. It depends on the proof of use or the good faith intention to use the mark in commerce by the person desirous of registering it.¹⁹⁸ The infringement analysis in trademark requires the answer to the question- Whether there is a likelihood of confusion as to the source of the mark?¹⁹⁹ This requires the consideration of a number of factors like distinctiveness of the mark, type of good identified and awareness of the public of the nexus between the good and its manufacturer. In the context of fictional characters, only those well-known characters are able to avail trademark protection whose name or visual images lead to an identification of a single source of authorship and who have been significantly exposed to

¹⁹⁷ Lanham Act, § 45, 15 U.S.C. § 1127 (1988).

¹⁹⁸ 15 U.S.C. 1051 (1988).

¹⁹⁹ 2 J.T. McCarthy, Trademarks and Unfair Competition § 23:1, 2nd ed. (1984)

the general public. This is a limited protection granted to the fictional characters as the public may not be able to associate a particular character with its author immediately. Also the failure of the author to show likelihood of consumer confusion may lead the courts to deny trademark protection to them. Not all characters are as easily recognizable as Mickey Mouse is with Disney. The inadequacies of the copyright law has many times led the courts to resort to an extended interpretation of the trademark or unfair competition law to protect fictional characters while disregarding if the public would associate a particular use of the character with its creator.²⁰⁰ In other cases, the lack of publicity has caused the character to fall out of this protection.²⁰¹

Further the inconsistency over the extent of copyright protection has led to different application of these alternative remedies. In *Fisher v. Star*,²⁰² the court applied the doctrine of unfair competition to protect the two comic strip characters which it held to be not copyrightable on their own. However in the case of *Gruelle v. Molly-'Es Doll Outfitters, Inc.*,²⁰³ the court held that while the dolls- Raggedy Ann and Raggedy Andy were deceptively similar to the dolls featuring in the plaintiff's books and cartoons, but it was only copyright which could protect the appearance of the dolls and not trademark law.

²⁰⁰ *Lone Ranger, Inc. v. Cox*, 124 F. 2d 650. (4th Cir 1942).

²⁰¹ *Columbia Broadcasting System v. DeCosta*, 377 F. 2d 315 (1st Cir. 1967).

²⁰² *Fisher v. Star*, 231 N.Y. 414, 132 N.E. 133, cert. denied 257 U.S 654 (1921).

²⁰³ *Gruelle v. Molly-'Es Doll Outfitters, Inc.* 94 F. 2d 172 (3^d Cir. 1937), cert denied, 304 U.S. 561 (1938).

Therefore the range of characters which can be protected by trademark and unfair competition law is very narrow and that too is not consistent.

Right to publicity has been used by courts to provide protection to fictional characters²⁰⁴ although its essential purpose is the protection of famous people from a commercial exploitation of their names and likeness without their permission. This misapplication can be seen in the case of Groucho Marx Productions v. Day and Night Co.²⁰⁵ in which a satirical play which featured characters having resemblance in appearance and characterization of Marx Brothers was enjoined from being produced. The rationale was that the play infringed the right to publicity in the characters of Marx Brothers. This protection was granted by the court as the human characters were not copyrightable. The court erred in holding so because the right to publicity only applies to commercial exploitation of non-fiction human beings and not to fictional characters.

Conclusion:

The existing intellectual property laws have certain drawbacks in their application to fictional characters. The major problem arises with the inconsistency of providing protection to the non-literal elements of literal characters and the differential treatment accorded to different forms of

²⁰⁴ The Right of Publicity Run Riot: The Case of a Federal Statute, 60 S. Cal. L.Rev. 1179 (1987).

²⁰⁵ Groucho Marx Productions v. Day and Night Co., 523 F. Supp. 485 (S.D.N.Y 1981).

fictional character under copyright laws. The other protections like trademark and right to publicity are insufficient to protect all aspects of a character and require fulfilment of certain conditions like public recognizability before it can be granted protection.

Chapter VI

The Way Forward For Fictional Characters

As seen before, the protection afforded to different kinds of fictional characters under the current intellectual property law regime is insufficient and fraught with inconsistencies and limitations. Therefore, there is a need for looking at certain alternatives which can be considered for protection of fictional characters.

6.1 Creation of New Category Under Copyright Law

Problems arise in copyright protection of characters because of difficulty in their delineation and separation from the underlying works. Further problems come up when characters move between different mediums and different works and also when such characters are in the form of pure characters. These problems, as seen above, have not been able to be resolved with the help of alternate protections like trademark, unfair competition and the right of publicity. Therefore one of the solution to this problem could be the creation of a separate category of protection of fictional characters within the copyright law. While such a proposal had been advanced in past but was rejected. As explained by the 1965 Report of the Register of Copyrights, fictional characters had not been added to the list of protectable works because while some characters were developed in detail to be identified

separately from the underlying copyrighted work, the same could not be said of the large majority which could not be considered as independent creations. Further they equated fictional characters with detailed presentations of plot, setting or dramatic action.²⁰⁶ This reasoning was advanced in the last century which can be said to be incongruous in the current era of technology and entertainment especially when the copyrightability of character has largely gained acceptance. The emergence of new modes of fictional characters in different media along with the technological boom which has enhanced the ability to create unique characters makes it necessary to create a separate class of works for their protection.²⁰⁷ Further unlike the plot, setting and dramatic action, the fictional characters are easily movable components of a work.

6.1.1 Benefits and Drawbacks of the Measure

One of the arguments given against such a measure is that the categories provided in the copyright law are not mutually exclusive²⁰⁸ and therefore it will lead to limiting the protection which they may have enjoyed under an existing category. But the benefits that it would provide are also apparent. The creation of a separate category for fictional characters would remove the

²⁰⁶ Supp. Rep. of the Register of Copyright on the General Revision of U.S. Copyright Law: 1965 Revision Bill, 89 Cong. 1st Sess.(1965).

²⁰⁷ Wincor, Copyright and the Spin-off Hero, Variety, Jan. 9, 1963.

²⁰⁸ 17 U.S.C. § 102 note (1988).

necessity of threshold determination of copyrightability of fictional characters. This becomes necessary with the multitude of characters in the nature of literary, human, graphic, audio/visual etc. and would do away with the determination of copyrightability of the character within a copyrighted work before the analysis for infringement takes place. The courts would then not be required to make more than a preliminary finding of copyrightability before granting copyright protection. This would then leave the analysis of sufficient delineation only for the purpose of determination of infringement. The basic infringement analysis would require the court to determine the extent of original expression in a character and then compare it with the allegedly infringing character to see if protected expression has been copied. The character may be granted copyright but only substantial copying of protected expression would be considered to be an infringement.

The application of this theory would be difficult in the case of literary characters which have been given in the form of names and word portraits. But this difficulty should not act as a hindrance in granting them copyright protection. Characterizations should be given primacy when comparing characters especially in the cases of pure characters as opposed to physical comparison unless they are impossible to compare.

This measure also provides the benefit of ease of comparability when characters have been incorporated in different media. While it is easier to determine infringement by comparing the characters along with their context when the alleged infringement has taken place in the same medium but when the characters are incorporated in different medium, then only those elements are required to be compared which are common in both media. This would provide the courts with flexibility in determining infringement.

This would also allow for protection to be granted to independent characters who have not been incorporated into a copyrightable work. This would include human characters and also other forms of characters having independent existence without any plot or story.²⁰⁹ This can be useful in protection of characters when an infringing work incorporates the character before the creator and therefore is denied the benefit of its protection. This would ensure protection to a character when it is created. Further registration of the independent character would also allow the creator to claim infringement without placing reliance on the work in which it is required to be incorporated. This would also bring the different kinds of characters on the same plane.

The creation of a separate category will reduce the ambiguity with regard to application of copyright law, trademark law and other laws for protection of

²⁰⁹ Raskin, Copyright Protection for Fictional Characters, 2 Perf. Arts Rev. 587, 608 (1971).

fictional characters. The application of trademark laws and unfair competition would then be restricted only to the aspects of a character which are not covered by copyright, like the names, titles, slogans etc. The right of publicity would then not be required to be extended to fictional characters as they aim to protect the likeness and characteristics of non-fictional individuals only.

6.2 Sui Generis Mode of Protection-“CopyMarks”

There has been an advocacy for an inter-disciplinary approach for the protection of fictional characters. Supporters of this view believe that elements of a character which are not protectible by copyright law should be governed by trademark law. Problems arise however because of inconsistency between copyright and trademark especially with regard to the extent and duration of the protection. Even after the copyright term of a character comes to an end, the trademark protection may continue indefinitely. Further the problem may lie with respect to the non-literal elements of the character which are capable of protection under copyright but not accepted easily under the trademark law.

In the current era where the increased popularity of the fictional characters is commercialized by associating them with goods and services, there is a requirement for increased consistency between copyright and trademark law with respect to fictional characters. Since copyright protects the bundle of

rights of the owner and trademark protects the interests of both the mark holders and consumers, these protections are functionally different. Also the inconsistency in the determination of copyrightability of non-literal elements of the character as applied by the court would still prevail even if a different subject-matter category is created under the copyright law. As Gregory Schienke states, *“If an equitable application of the law is the reason for such creation, how could a pure character be included? In addition, unless there was a statutory definition for the “threshold of delineation” for fictional characters, what would prevent a person from asserting their assumed rights in stock characters?”*²¹⁰

A solution that was put forward and not discussed much is that of ‘Copymark’ as propounded by Gregory Schienke.²¹¹ The solution that he propounds lies between copyright and trademark as characters exist in these two legal worlds of trademark and copyright. In order to apply for the protection of “copymark,” the owner of the fictional character would have to prove the following:

1. The character originated in a work available for copyright registration,
2. The character has been in use in commerce,

²¹⁰ Gregory S. Schienke, *The Spawn of Learned Hand-A Reexamination of Copyright Protection and Fictional Characters: How Distinctly Delineated Must the Story Be Told?*, 9 Marq. Intellectual Property L. Rev. 63 (2005).

²¹¹ Id.

3. The character has been in use for a minimum of five years; and
4. The character is famous.

This protection would overcome the drawback of the copyright law with respect to the determination of whether the character is sufficiently delineated or constitutes the story being told. The only requirement for application of this protection is that the character must have originated in a work which is copyrightable. It would also provide the advantage of protecting the character independently of the work in which it was incorporated. Further the expiry of the term of copyright would not affect the commercial benefits to the owner of the copymark.

However, there are several disadvantages to this approach as well. The requirement that the character should originate in a work which is copyrightable would prevent the extension of this protection to pure characters. This would therefore require the addition of the subject-matter category for fictional characters within the copyright law, as proposed before. The minimum use of five years is also debatable as with the advent of technology, the speed at which information flows is unsurmountable. The characters achieve and lose popularity within a span of a few days and therefore it is required to be commercialized swiftly. The protection granted

after five years of use of the character may dilute the fame of the character and therefore not provide any advantage to the owner of the copymark.

The major problem, however, is its infinite protection in terms of duration. As the US Constitution has provided for the utilitarian rationale for copyright as promotion of science and useful arts, this protection prevents the protected work from coming into the public domain and therefore violates this aim. Further the trademark protection of fictional characters is argued against as acting as a restriction to the potentially aesthetic valuable works of arts. An example of this is the case of Tarzan who is out of copyright protection but has trademark protection owned by Edgar Rice Burroughs, Inc. which therefore cannot be used as opposed to Peter Pan who has started making appearances in different media. Therefore, there is a need to balance the interest of the author of the fictional character with that of the interest of the public at large which can be handled under this protection by limiting the term of protection as is done in copyright.

Conclusion:

There is a need for a change in the existing laws for granting effective protection to fictional characters. The changes can be within the copyright regime like addition of a new subject-matter category or a new regime

altogether like a copymark. The effectiveness of these measures would also vary and therefore would be required to be used in conjunction with each other with adequate restraints to ensure that the new regime is not muddled with the old problems of the existing regime.

CONCLUSION AND SUGGESTION

SUGGESTION

The solution to the dichotomous situation as posed by the different alternatives can be solved by adopting the following suggestion which the researcher believes would help in granting effective protection to the different forms of fictional characters.

1. There should be a creation of a separate subject-matter category for fictional characters within copyright law. The meaning of fictional character should be clearly laid down for the ease of application of this protection by the courts. The definition can be laid down as was given by the researcher above- “A fictional character is an imaginary living creation brought into existence by a human mind and communicated to others and has specific attributes, both physical and behavioural along with specific relations with its surroundings inclusive of the people belonging to such surroundings.” This should cover the fictional characters in various forms like pure characters, literary, audio-visual, and graphical characters. This would extend protection to even newly appearing forms of characters in different media like movies and gaming consoles.
2. Further the legislation should provide for the sufficient delineation test to be applied for determining that the fictional character is protected

only with regard to its expression and not the idea underlying it. This should be done by specifying that the test should be applied only for determining whether infringement has taken place of the expression of the fictional character.

The researcher does not agree with the sui generis mechanism of copymark, as proposed by George Schienke because of its duplicity of protection. Further as mentioned above, it provides for a perpetual protection for fictional characters which are well known and which come from copyrightable work. There are requirements of variations to be made to the model proposed by Schienke in order to enable it to provide protection to all forms of characters. The requirement of popularity goes against the protection of new born fictional characters which merit no less protection under copyright than a famous character. Further the requirement of its origin in copyright defeats the purpose of a sui generis protection. The existing different forms of protection granted by different intellectual property laws would protect the different aspects of the fictional character which cannot be provided by a single form of intellectual property law. The problem that arises with regard to uncertainty and that too with regard to different forms of fictional characters can be cured by adopting the above mentioned suggestions in the existing legal regime as opposed to by creation of a new form of protection altogether.

CONCLUSION

The fictional characters are artistic expressions of their authors. They attain a relation with their receptors, regardless of the form in which they appear. The association that a Potterhead has with the character Harry Potter as in the book is far more than their association with the character played by Daniel Radcliffe. Therefore, it becomes important to protect the non-literal elements of fictional character in their different forms. The protection is justified as they are a form of intellectual property which fulfils the justification under labor theory, personality theory and utilitarian theory. The problem only arises as to how this protection is to be granted in the absence of any law that squarely fits the box.

The courts have undertaken this feat by extending the application of copyright and trademark laws to the fictional characters. Different tests have been evolved to determine if a fictional character is copyrightable. The tests, however, provide different standards of protection. While sufficient delineation test is comparatively easy to satisfy, the story being told test restricts the application of the protection to only a few characters, even if they are sufficiently delineated. Further there is a difference in approach of the court with respect to non-literal elements of a character in a literary work and other graphical or visual work. The application of the tests is done strictly for the former and leniently for the latter, with pure characters left out of

protection altogether. The trademark laws are used by the courts to fill the gaps in the protection afforded to fictional characters by the copyright law. However, they are not sufficient to cover all the elements of the character, especially the non-literal elements. The right to publicity which is applied for characters is also misplaced as has been seen.

The problems with the current intellectual property regime in protection of fictional characters lie due to internal reasons. The non-inclusion of these characters as a separate category leaves them to the mercy of the court who apply the different tests inconsistently in each case. The courts are also faced with difficulties in deciding whether the characters are delineated enough to merit protection and especially so with respect to characters in literary works where the non-literal elements are required to be examined for this determination while separating them from the underlying text. This subjectivity is difficult to be removed but it can be reduced by certain changes in the current existing legal regime.

One of the solutions proposed in this research is the creation of a separate subject-matter category within the copyright law. Another is the creation of a sui generis mode of protection in the form of copymark. These measures, however, can only be beneficial if they address the existing issues with the current legal regime. The codification can work in favour of the fictional

characters if it provides in sufficient detail a framework for determining the protection to be granted to the fictional characters so that the only task that the courts are left with is determination of infringement without going into the threshold question of whether the non-literal elements of fictional characters are copyrightable. The certainty of protection would provide an incentive to the authors to create without the fear of unauthorized misappropriation of their fictional characters. Also, the inclusion of changes to the current protection should take into consideration the balance of interests between the author and the public. As the intellectual property law is based on the utilitarian ground of benefitting the public at large, the monopoly of the creators over their characters should be restricted.

Further the emphasis should be on protection of different forms of fictional characters which are increasing with the current advances of technology. Therefore, there should be adequate protection granted to Sherlock Holmes as is done to Mickey Mouse. The evolution of new forms of characters, especially pure characters and creation of characters in the new media, like movies and gaming consoles is also required to be considered by the legal framework mentioned above.

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