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THE METHUSELAH FACTOR: WHEN CHARACTERS OUTLIVE THEIR COPYRIGHTS

LESLIE A. KURTZ*

INTRODUCTION

Most fictional characters live briefly, then are forgotten along with the book, movie, or comic strip in which they appeared. Few will live to Methuselah's nine hundred years.¹ Some, however, will outlive the copyright in the works that embody them. Such characters tend to have great value, and those who have owned them will wish to protect these creations from use by others. What, then, is the legal status of fictional characters when the works embodying them enter the public domain?

Copyright lasts for a limited period,² after which the copyright owner loses all exclusive rights in a work, so that anyone may use it freely. The characters appearing in that work, however, can take on lives of their own, enabling them to be thought of and used outside their original contexts.³ They are agile creatures, capable of moving from one story to another, from one medium to another, from stories to merchandise and back again. They are not frozen in one form, but may change in appearance, personality, and relationships with other characters. Since they are capable of such independent existence, do they enter the public domain with the works that contained them?

Furthermore, fictional characters not only contain elements of creative expression, with qualities of development and individuali-

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1. A few live longer. The characters from *THE ILLIAD* and *THE ODYSSEY* have survived for thousands of years.

2. For works created on or after January 1, 1978, the duration of copyright ordinarily endures for a term consisting of the life of the author plus fifty years. 17 U.S.C. § 302(a) (1993). For the complex provisions regarding copyright duration in a variety of situations, see 17 U.S.C. §§ 302-304 (1993).

3. It should be recognized, however, that some characters are not easily extricated from a plot that contains elements of their life history, and the people, events, and surroundings that have formed them.

zation protectible under copyright, but also can serve as a form of identification and command public acceptance in the marketplace. Thus, they have been protected under the law of trademarks and unfair competition, which seeks to prevent confusion as to the source of goods and services. A key distinction between these doctrines and copyright is the role of time. Unlike copyright, unfair competition and trademark protection is not limited in term and can continue indefinitely.⁴ Given this durational difference, what happens when copyright ends? May others make use of the characters contained within works that are now in the public domain, or will such uses be forbidden under these other doctrines?

This article will consider what happens when characters outlive their copyrights. It will look first at some basic principles underlying copyright and the law of trademarks and unfair competition as they relate to characters. It will then consider the legal status of these characters when copyright protection ends. What principles govern their survival and what will they become? Who will control their later lives?

COPYRIGHT: LIMITED DURATION AND THE PUBLIC DOMAIN

Copyright protection can extend to characters, apart from any particular works in which they appear, but the nature of this protection has proved problematic. Courts have twisted themselves into knots trying to decide when a literary character has those qualities that entitle it to copyright protection. The inquiry ordinarily focuses on whether a character is sufficiently distinctive or well-developed to command protection, and whether such distinctive development has been copied.⁵ Courts have found less difficulty in protecting characters with a visual component, such as

4. Protection under the law of trademarks and unfair competition lasts as long as the use of a mark or other identifying feature is likely to create public confusion. See notes 32-39 *infra* and accompanying text.

5. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 2.12 (1993) [hereinafter NIMMER & NIMMER]. The source of this inquiry is an oft-quoted statement by Judge Learned Hand in *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (Characters may be protected independent of the plot, but "the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly."). A second, and much criticized, articulation of what is necessary before a literary character can be protected is found in the "Sam Spade" case, *Warner Bros. Pictures v. Columbia Broadcasting Sys.*, 216 F.2d 945, 950 (9th Cir. 1954), *cert. denied*, 348 U.S. 971 (1955) (finding a character is protected if it "constitutes the story being told," but not if it is "only the chessman in the game of telling the story."). For a detailed discussion of these approaches, see Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 86 WIS. L. REV. 429, 451-67 (1986).

cartoons, than in protecting literary characters, which exist as more abstract mental images.⁶ Visual characters are readily found protectible, and the focus quickly shifts to a comparison of the plaintiffs' and defendants' characters to see if the similarity between them is sufficient for infringement.

The primary purpose of copyright is to promote creativity and the dissemination of creative works, so that the public may benefit from the labor of authors.⁷ As Anthony Trollope put it, "[t]ake away from English authors their copyrights, and you would very soon take away from England her authors."⁸ United States copyright law provides authors with incentives by giving them the exclusive right to profit from and control certain specified uses of their works.⁹ This right, however, is not without costs. An incentive for one author provides a barrier to others. The exclusive rights granted by copyrights diminish the ability of new authors to make use of what has come before in creating their own works.¹⁰

Every artist builds on the creativity of the past, reshaping what already exists in the world. The mind cannot feed on itself, but must use what has been supplied to it from outside.¹¹ "Worldmaking as we know it always starts from worlds already on hand; the making is a remaking."¹² Human fabrications form a part of these worlds. We live and work within our culture, and the language and symbols that inhabit it. Moreover, freedom to imitate makes the creation of new works less costly and increases their availability to those who might otherwise be unable to afford them. To insist on absolute protection for copyright owners would stifle competition and raise the price of access to the consumer. Copyright strikes a balance between providing incentives to create and

6. See *Warner Bros. v. American Broadcasting Cos.*, 720 F.2d 231, 240 (2d Cir. 1983). It should be recognized, however, that the distinction between literary and visual characters is not always sharp. For example, Superman began as a cartoon but also appears, depicted by actors, in audiovisual works. Literary characters may take on some potentially protectible visual attributes when portrayed on stage or in a film.

7. See ROBERT A. GORMAN & JANE C. GINSBURG, *COPYRIGHT FOR THE NINETIES* 13-16 (4th Ed. 1993) (quoting REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 3-6 (1961)).

8. 1 ANTHONY TROLLOPE, *AN AUTOBIOGRAPHY* 142 (1883).

9. These include, with limitations, the rights of reproduction, distribution, performance, display, and the preparation of derivative works. 17 U.S.C. § 106 (1993).

10. See *Campbell v. Acuff-Rose Music, Inc.*, 114 S. Ct. 1164, 1169 (1994) (There is an "inherent tension in the need simultaneously to protect copyright material and to allow others to build upon it").

11. ALEXANDER LINDEY, *PLAGIARISM AND ORIGINALITY* 248 (1952).

12. NELSON GOODMAN, *WAYS OF WORLDMAKING* 6 (1978).

protecting the public domain¹³ from being stripped of the raw materials needed for new creations.

The limited duration of copyright reflects that balance and is an essential part of the basic copyright bargain. Authors are encouraged to create, but with the ultimate aim of making literature, music, and the other arts broadly available to the public.¹⁴ The copyright owner receives exclusive rights for a period of time in return for creating the work in the first place and enriching the public domain once the copyright term expires. We must be careful in using other legal doctrines in a way that undercuts that balance, clogging the channels of creativity and commerce and curtailing the ability of new authors to pursue their own works. As Judge Kozinski has said, “[o]verprotection stifles the very creative forces it’s supposed to nurture.”¹⁵

Fictional characters, like real people, are part of the world in which we live. Characters such as Sherlock Holmes, Bart Simpson, Superman, Tarzan, James Bond, and Mickey Mouse may be better known and more valuable than any particular work in which they appear. A character may be very real to an author. On his deathbed, “Balzac murmured, ‘Bianchon would have saved me’ — referring to the great physician of Paris he himself had created.”¹⁶ The same may be true of an author’s audience. Arthur Conan Doyle reported overhearing a group of French schoolboys who, when asked what they wanted to see first in London, unanimously asked to see Sherlock Holmes’ lodgings on Baker Street.¹⁷ So many books have been written about Holmes, he has been awarded his own Library of Congress number.¹⁸ Biographies and stories have been written about Sherlock Holmes,¹⁹ Dr. Watson,²⁰ Sherlock’s brother

13. For a discussion of the importance of the public domain, see generally Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965 (1990); David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147 (1981).

14. See *Twentieth Century Music v. Aiken*, 422 U.S. 151, 156 (1975).

15. *White v. Samsung Elecs. America, Inc.*, 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting from the order rejecting the suggestion for rehearing en banc.).

16. Vincent Starrett, *The Baker Street Irregulars*, in *THE BAKER STREET READER* 183, 183-84 (Philip A. Shreffler ed. 1984).

17. Arthur Conan Doyle, *Sidelights on Sherlock Holmes*, in *THE BAKER STREET READER*, supra note 16, at 14.

18. L.C.N. PR 4624, Holmes, Sherlock (Fictitious Character).

19. See, e.g. WILLIAM S. BARING-GOULD, *SHERLOCK HOLMES AT BAKER STREET: A LIFE OF THE WORLD’S FIRST CONSULTING DETECTIVE* (1962); VINCENT STARRETT, *THE PRIVATE LIFE OF SHERLOCK HOLMES* (1933).

20. S.C. Roberts, *Doctor Watson: Prolegomena to the Study of a Biographical Problem*, in *THE BAKER STREET READER*, supra note 16, at 55.

Mycroft,²¹ the villainous Professor Moriarty,²² and *the* woman, Irene Adler.²³ MTV's Butt-head even has his own E-mail address.²⁴

Shakespeare's characters have appeared in new guises. In *Rosencrantz and Guildenstern are Dead*,²⁵ Tom Stoppard used two of the minor characters from Shakespeare's *Hamlet* to explore the nature of tragedy in today's world. Paula Vogel wrote *Desdemona, a Play about a Handkerchief*, looking at Shakespeare's *Othello* through the eyes of its female characters.²⁶ Other classic characters have also found new uses. For example, Jean Rhys wrote a novel about the early life of the first Mrs. Rochester, the mysterious prisoner and setter of fires in *Jane Eyre*, illuminating her character and that of Rochester.²⁷ The novel *Mary Reilly* retells the story of Stevenson's Dr. Jeckyl and Mr. Hyde through the eyes of the doctor's maid.²⁸ Alice in Wonderland has been sent on an adventure through the alphabet.²⁹ Pictorial characters have also found interesting uses. In *The Man from Krypton*, the author used Superman to expound on religion.³⁰ Stephen Gould, in *The Panda's Thumb*, used Mickey Mouse as the basis for a discussion of biology and human evolution.³¹

Fictional characters help form the modern myths out of which we operate and are an important part of the cultural heritage on which an author can draw to create something new. They can encapsulate an idea, evoke an emotion, or conjure up an image. When a fictional character has entered the public domain, there are strong policy reasons for keeping it there, thus allowing others to make use of it.

TRADEMARK AND UNFAIR COMPETITION

The law of trademarks and unfair competition has also been a major source of protection for fictional characters. While copyright

21. R.C. Mitchell, *Portrait of Mycroft*, in *THE BAKER STREET READER*, *supra* note 16, at 73.

22. Edgar W. Smith, *The Napoleon of Crime: Prolegomena to a Memoir of Professor James Moriarty Sc.D.*, in *THE BAKER STREET READER*, *supra* note 16, at 79.

23. CAROL NELSON DOUGLAS, *GOOD NIGHT, MR. HOLMES* (1990).

24. Butthead@mtv.com.

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

26. PAULA VOGEL, *DESDEMONA, A PLAY ABOUT A HANDKERCHIEF* (1993).

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

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

29. GILBERT ADAIR, *ALICE THROUGH THE NEEDLE'S EYE* (1985).

30. JOHN WESLEY WHITE, *THE MAN FROM KRYPTON* (1978).

31. Stephen J. Gould, *A Biographical Homage to Mickey Mouse*, in *THE PANDA'S THUMB* 95 (1980).

is designed to protect the creative expression existing within a character,³² the law of trademarks and unfair competition has a different purpose. It is concerned with a character's capacity to symbolize a particular source of goods or services. For example, if the name or image of Mickey Mouse is used in a new cartoon or on a lunchbox, the public may identify it with Disney and believe that Disney is its source. Bart Simpson on a t-shirt will likely be identified with Twentieth Century Fox and Matt Groening.³³ Protected elements of fictional characters have included their names, appearances, costumes and distinctive key phrases associated with the character (for example, "E.T. Phone Home"³⁴ and "Hi, yo, Silver, away.")³⁵

Whether protection is sought under state laws of unfair competition³⁶ or under the federal trademark statute, the Lanham Act,³⁷ the critical legal issue is whether another's use of the character or its elements is likely to cause public confusion. This includes the classic situation where one seller passes off her goods as those

32. Sometimes courts extend copyright protection to character elements that should only be protected, if at all, under the law of trademarks and unfair competition. One court, for example, found infringement although nothing appeared to be taken from the plaintiff's character but the name "Hopalong Cassidy" and the general western setting. *Filmvideo Releasing Corp. v. Hastings*, 509 F. Supp. 60 (S.D.N.Y. 1981), *aff'd on other grounds*, 668 F.2d 91 (2d Cir. 1981). Another found the phrases "E.T. Phone Home" and "I Love You E.T." to be protected under copyright. *Universal City Studios v. Kamar Indus.*, 1982 Copyright L. Dec. (CCH) ¶ 25,452 (S.D. Tex. 1982).

33. Consumers need not be aware of the name of the source. It is sufficient if they assume that products bearing the mark come from a single though anonymous source. 1 J. THOMAS MCCARTHY, *TRADEMARKS AND UNFAIR COMPETITION*, § 3.03[3] (3d ed. 1994).

34. *Id.*

35. *Lone Ranger, Inc. v. Cox*, 124 F.2d 650, 652 (4th Cir. 1942); *Lone Ranger v. Curry*, 79 F. Supp. 190 (M.D. Pa. 1948).

36. The law of trademark has developed as part of the broader law of unfair competition. 1 MCCARTHY, *supra* note 33, § 2.02.

37. 15 U.S.C. §§ 1051-1127 (1994). Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), condemns false descriptions and designations of origin:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representations of fact, which — (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, . . . shall be liable in a civil action by a person who believes that he or she is or is likely to be damaged by such act.

Section 32 of the Lanham Act, 15 U.S.C. § 1114, protects registered marks. Although the abstraction that is a character cannot be a trademark, names and pictorial representations of characters may be registered as trademarks or service marks under §§ 1052 and 1053, if they are adopted and used to identify goods and services and distinguish them from those of another. Lanham Act § 45, 15 U.S.C. § 1127.

of another. If Smith puts out a new Donald Duck cartoon on videotape, people are likely to buy it in the mistaken belief that it was created by Disney. Public confusion, however, also includes confusion as to approval, authorization, or sponsorship. Many people seeing a new Sherlock Holmes story will know that Arthur Conan Doyle is dead and will not believe it was written by him, but they may well believe it was sponsored or authorized by the Doyle estate. It is also important that the character be distinctive.³⁸ The public must associate the character or its elements with a single source.³⁹ Because little known characters are not associated in people's minds with any particular source, protection is ordinarily limited to characters that have undergone some reasonable degree of circulation.

Although characters can be protected under the law of trademarks and unfair competition, they do not fit neatly within these doctrines, which often must be stretched to accommodate them. The line between a character and its label tends to be blurred. Frequently, a character is its own label. It identifies a source of an entertainment product and is the product itself. Furthermore, a character's ability to identify a single source may be no more than a convenient fiction. What is the source of a fictional character? Is it the author or publisher of a book; the director or producer of a film? What if a character appears in a book and a film? Is the source the book's author, the book's publisher, the film's director, or the film's producer? Characters have been found to be associated in the public mind with their authors,⁴⁰ their producers,⁴¹ their sponsors,⁴² the works in which they appear,⁴³ and even with

38. Ordinarily, courts have required secondary meaning, a mental association between a product and a single source of that product. Those few courts that do not require secondary meaning look to unique associations, distinguishing characteristics that enable consumer to distinguish the plaintiff's product from others. See Kurtz, *supra* note 5 at 475-476, n. 257.

39. Of course, different cartoon ducks may have different sources. Consider Donald Duck and Daffy Duck. Aside from the tandem piano scene in *WHO FRAMED ROGER RABBIT?*, these two characters have never come within quacking distance of each other, and each is attributable to a different source—Disney for Donald and Warner Brothers for Daffy.

40. *Gruelle v. Molly-Es Outfitters*, 94 F.2d 172, 176 (3d Cir. 1937), *cert. denied*, 304 U.S. 561 (1938); *Patten v. Superior Talking Pictures*, 8 F. Supp. 196, 197 (S.D.N.Y. 1934).

41. *Processed Plastic Co. v. Warner Communications, Inc.*, 675 F.2d 852, 856 (7th Cir. 1982); *Lone Ranger Inc. v. Cox*, 124 F.2d 650, 652 (4th Cir. 1942); *Universal City Studios v. J.A.R. Sales*, 1982 Copyright L. Dec. (CCH) ¶ 25,460, at 17,742 (C.D. Cal. 1982); *Universal City Studios v. Kamar Indus.*, 1982 Copyright L. Dec. (CCH) ¶ 25,452, at 17,683 (S.D. Tex. 1982); *Wyatt Earp Enters. v. Sackman, Inc.*, 157 F. Supp. 621, 625 (S.D.N.Y. 1958).

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

43. *Processed Plastic*, 675 F.2d at 856; *Lone Ranger*, 124 F.2d at 652; *J.A.R. Sales*, 1982 Copyright L. Dec. (CCH) ¶ 25,460, at 17,742; *Wyatt Earp Enters.*, 157 F. Supp. at 625.

themselves.⁴⁴ Courts are not very rigorous in applying trademark standards in character cases. There is a tendency to focus on the character itself, rather than on any information it provides about source or identification. When an easily identifiable character, or its elements, appears in unauthorized form, courts readily find infringement, with little inquiry, and assume the existence of likely confusion whenever a defendant exploits a market demand created by the plaintiff.⁴⁵ The concern is more with unjust enrichment than with unfair competition as ordinarily defined.

When a well-known character is used in a new story, such as a book, movie, or cartoon, the public may well be deceived into believing that they are getting the "real," or at least the "authorized," version of the character. Forbidding this sort of use may endow the character with consistent qualities,⁴⁶ at least in the sense of consistent storyline and character traits. It must be recognized, however, that the law of trademarks and unfair competition is being used to protect the expressive elements of a character as well as its ability to denote its source. The trademark owner gains exclusive rights not only to the features identifying the product, but to the product itself. Practically, this is not a major problem during the copyright period, when expressive as well as identifying elements are entitled to protection. But, it can become an important problem when copyright protection expires, if the owners of trademark and unfair competition rights seek to use them as an alternative means to protect a character as literary property.

When a character or its elements appears on merchandise, however, such as a mug, lunchbox, belt buckle and the like, the problem is different. One major function of trademarks is to signify that the goods bearing the mark are of consistent quality.⁴⁷ The quality may be high or low, but the mark provides a kind of a warranty that the goods bearing the mark will be of the same character. This consistency reduces consumer search costs—past experience becomes a good predictor of likely outcome—and encourages

44. *DC Comics v. Unlimited Monkey Business*, 598 F. Supp. 110, 115 (N.D. Ga. 1984) (finding Superman and Wonder Woman have acquired outstanding celebrity as unique distinctive marks "symbolizing the extensive goodwill associated with the public image of this hero and heroine.").

45. Kurtz, *supra* note 5, at 495-506. See David B. Feldman, *Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection*, 78 CAL L. REV. 687, 705-708 (1990); Michael Todd Helfand, Note, *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. 623, 643-653 (1992).

46. See notes 47-49 *infra* and accompanying text.

47. See 1 MCCARTHY, *supra* note 33.

expenditures on quality.⁴⁸ This warranty of consistent quality often does not really exist when fictional character marks appear on merchandise. A fictional character possesses what Umbreit calls "sentimental value," based on the fact that the article bears the symbol and people like the symbol.⁴⁹ Consumers buy Teenage Mutant Ninja Turtles clothing or "E.T. Phone Home" mugs not because the symbol indicates that the shirt is of a certain quality or the mug won't break, but because they want that picture or that phrase on their merchandise.

It might be possible to protect product differentiation without granting exclusive merchandising rights under the law of trademarks and unfair competition.⁵⁰ Merchants, authorized and unauthorized, could be permitted to sell shirts, mugs and the like, bearing character names and indicia (so long as these indicia are unprotected by copyright), with the source of each clearly marked. Only the original creators of the characters, or their licensees, would be permitted to call their goods authorized or official. Exclusive marketing rights are valuable to their owners, but they are also costly.⁵¹ Not every use of a character interferes sufficiently with economic expectations and incentives to justify a legal remedy.

In the present state of affairs, however, such a system is likely to cause consumer confusion as to the authorization or sponsorship of unauthorized goods. Several courts have noted that the public has come to expect the exploitation and licensing of well-known characters.⁵² In a 1983 survey, 91% of the people questioned agreed with the proposition that "no product can bear the name of a an entertainer, cartoon character or some other famous person unless permission is given."⁵³ This is borne out in informal polls that I have taken in my class. My students, who have grown up in a world where licensing is endemic, are overwhelmingly convinced that you cannot put the indicia of popular characters on merchan-

48. William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & Econ. 265, 269 (1987).

49. Kenneth B. Umbreit, *A Consideration of Copyright*, 87 U. Pa. L. Rev. 932, 940 (1939).

50. This is not the position courts are taking today; they vigorously protect the creators of characters and their licensees against the use of these characters by others.

51. See *BiRite Enters. v. Button Maker*, 555 F. Supp. 1188, 1194-95 (S.D.N.Y. 1983).

52. *Conan Properties v. Conans Pizza*, 752 F.2d 145 (5th Cir. 1985); *Warner Bros. v. Gay Toys*, 658 F.2d 76, 79 (2d Cir. 1981); *Universal City Studios v. J.A.R. Sales*, 1982 Copyright L. Dec. (CCH) ¶ 25,460, at 17,745 (C.D. Cal. 1982).

53. McCarthy, *supra* note 33, § 10.17. Out of 250 people surveyed, 91% agreed with the statement and 80% agreed at the strongest possible level.

dise without permission and, therefore, that goods bearing such indicia must be licensed. Indeed, they find it difficult to believe that there is a question.

This system of beliefs may not be inevitable, however, and the existence of confusion may be something of a bootstrap result. For many years, licensing has been increasing and courts have been granting exclusivity to those with rights to characters in the entertainment field. Naturally, people believe that this sort of use must be authorized. But what would happen if courts shifted course and stopped providing these exclusive rights? If others were permitted to offer unauthorized merchandise, so that a variety of versions competed for public acceptance, the perception that all such products are sponsored would be undercut. Mark owners would be encouraged to advertise their version as the genuine, official, authorized one. Newcomers could be required to use labelling and distinguishing language to make it clear that their version is not. Public perceptions could change.

In any event, if a character testifies only, in general terms, to its sponsorship or authorization, the policy underlying trademark protection, while present, is weaker than if it provides a guarantee of the quality of the product on which it appears. This is an important factor when the trademark goal of avoiding public confusion comes into conflict with the policy of allowing free use of what is in the public domain.

WHEN COPYRIGHT PROTECTION ENDS

Once a work has entered the public domain, copyright no longer forbids the copying of anything contained within it, including the characters.⁵⁴ But a character may appear in a variety of works and media, and may change and evolve with the passage of time. When the first work in which the character appeared goes into the public domain, is the character available for use in new stories and contexts, despite the fact that other works containing the same character still remain in copyright?

To the extent that these other works contain the same character, they are derivative of the first, and the copyright in a derivative work protects only the incremental additions of originality provided by the creators of that work.⁵⁵ Thus, others may make

54. 1 NIMMER & NIMMER, *supra* note 5, § 2.12.

55. Silverman v. CBS Inc., 870 F.2d 40, 49 (2d Cir.), *cert. denied*, 492 U.S. 907 (1989). See Burroughs v. Metro-Goldwyn Mayer, Inc., 683 F.2d 610, 631 (2d Cir. 1982) (Newman, J., concurring); 1 NIMMER & NIMMER, *supra* note 5, § 2.12.

use of the character as it appeared in the public domain original, but may be forbidden to use new traits, visual elements, bits of life story, or other character changes that were added in later copyrighted works.⁵⁶ It should not matter whether newcomers put the character into new stories, new media, or both. Copyright no longer protects that which lies within the public domain: the character as it originally appeared.

This issue was faced squarely in *Silverman v. CBS*,⁵⁷ a case in which CBS claimed copyrights in the *Amos 'n' Andy* radio and television programs. Silverman wrote a script for a Broadway musical comedy based on the characters Amos and Andy. Although the copyright had expired on the radio scripts, the television programs were still under copyright. The district court⁵⁸ found that the characters that were in the public domain in a literary work (the radio scripts) were protectible under the copyright in the audio-visual presentation. The visual representations of the characters in the television program went beyond the word portraits in the public domain scripts and were therefore protected. The duplication of the characters as they appeared on television would infringe the CBS copyrights. The district court appeared to protect all elements of the audio-visual characters, whether they were derived from the public domain scripts or not.

The court of appeals found this approach unjustified, stating that the CBS copyrights protected only additional expression beyond that contained in the public domain radio scripts.⁵⁹ The *Amos 'n' Andy* characters were sufficiently delineated in the public domain scripts to have been placed in the public domain along with the scripts.⁶⁰ Silverman was entitled to use this public domain material, but he was not entitled to use any further delineation of the characters contained in any script or program still protected by copyright.

This doctrine may have interesting consequences for characters that have evolved. When Mickey Mouse made his debut in *Steamboat Willie* in 1928, he was a "rambunctious, even a slightly

56. *Id.* See also Michael V.P. Marks, *The Legal Rights of Fictional Characters*, 25 COPYRIGHT L. SYMP. (ASCAP) 35, 84-85 (1980); Feldman, *supra* note 45, at 699; Helfand, *supra* note 45, at 654.

57. See *infra* notes 58-60 and accompanying text.

58. *Silverman v. CBS Inc.*, 632 F. Supp. 1344 (S.D.N.Y. 1986), *aff'd in part, vacated in part, and remanded*, 870 F.2d 40 (2d Cir.), *cert. denied*, 492 U.S. 907 (1989).

59. 870 F.2d at 50.

60. Apparently an insufficiently delineated character would not go into the public domain with the work. But then it would not be protected by copyright in the first place.

sadistic fellow.”⁶¹ Later, his behavior improved, as did his physical appearance. He became more youthful, developing “a larger relative head size, larger eyes, and an enlarged cranium.”⁶² Donald Duck also changed; his enlarged beak receded and his eyes grew larger.⁶³ The Peanuts characters have undergone changes over the years as well, with the heads becoming increasingly refined.⁶⁴ Superman has different powers today than in his earliest iteration. At first, he displayed extraordinary leaping ability, which later became the power of flight.⁶⁵ As the earliest versions of these characters enter the public domain, it will be interesting to consider the dissection of protected and unprotected elements.

Once it is clear that a character is no longer protected by copyright, should it be possible to prevent newcomers from making use of the character under the law of trademarks and unfair competition? Copyright and trademark laws are separate and independent, with different underlying rationales and objectives.⁶⁶ Therefore, the fact that a character is in the public domain for copyright purposes does not inevitably place it there for trademark purposes. A character, however, is more than an identifier of source. If others are forbidden to use fictional characters in the public domain, trademark law would provide an alternate means to protect them as literary property, and would make them unavailable for expressive purposes, perhaps indefinitely.

There has been some willingness to allow a form of mark-based protection for characters, even after copyright has expired. In *Frederick Warne & Co. v. Book Sales, Inc.*,⁶⁷ the original publisher of the Peter Rabbit books written by Beatrix Potter claimed exclusive trademark rights to the cover illustrations on seven of those books, all of which were in the public domain.⁶⁸ The defendant, who used these drawings to illustrate its book of Peter Rabbit

61. Gould, *supra* note 31, at 95. For a discussion of the development of Mickey Mouse, see ROBERT W. BROCKWAY, MYTH FROM THE ICE AGE TO MICKEY MOUSE 127-136 (1993).

62. Gould, at 96. Gould suggests that national symbols are not altered capriciously, and cites Conrad Lorenz for the proposition that babyish features tend to elicit strong feelings of affection in adult humans. He submits that “Mickey Mouse’s evolutionary road down the course of his own growth in reverse reflects the unconscious discovery of this biological principle by Disney and his artists.” *Id.* at 104.

63. *Id.*

64. DAVIS ENTERPRISE WEEKEND, May 23, 1985, at 6, col. 1.

65. Warner Bros. v. American Broadcasting Cos., 720 F.2d 231, 236 (2d Cir. 1983).

66. See II PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE, § 15.14.1.3 (1989 and 1993 Supp.); MCCARTHY, *supra* note 33, § 10:16.

67. 481 F. Supp. 1191 (S.D.N.Y. 1979).

68. These illustrations were originally created by Potter for plaintiff’s editions of the books.

stories, and as “corner ornaments” for many of the pages of each story,⁶⁹ contended that it was entitled to summary judgment because its illustrations were parts of copyrightable works now in the public domain.

The court disagreed, holding that a character that has acquired independent trademark significance, identifying the source or sponsorship of goods, should not be denied protection simply because it has fallen into the public domain under copyright.⁷⁰ The proper factual inquiry was not “whether the cover illustrations were once copyrightable and ha[d] fallen into the public domain,” but whether they had acquired secondary meaning identifying Warne, and whether there was a likelihood that the defendant’s use of them would cause public confusion.⁷¹ The court recognized that “trademark and unfair competition theories might serve to protect a character beyond the term of the copyright applicable to the underlying work,” but found that the question “need not be reached since plaintiff does not seek to establish exclusive trademark rights in the characters themselves but only to protect its limited right to use specific illustrations of those characters.”⁷²

Judge Nies, in her special concurrence in *In re DC Comics Inc.*,⁷³ noted the potential problem involved in allowing the registration of particular drawings of Superman, Batman, and the Joker as trademarks for three dimensional toy versions of the same characters. Recognizing the possibility that the doll design might be perpetually protected, Judge Nies said that it was not necessary to consider the issue during the copyright period; it could be addressed, if necessary, once the copyright expired.⁷⁴ She did state, however, that “if a copyrighted doll design is also a trademark for itself, there is a question whether the quid pro quo for the protection granted under the copyright statute has been given, if, upon expiration of the copyright, the design cannot be used at all by others.”⁷⁵

Indeed, to the extent that trademark would protect expressive elements—and that extent is substantial—prohibiting the use of

69. The defendant also used the “sitting rabbit,” a design which appeared in one of the original Peter Rabbit books, on the cover of its book. This design was the principal symbol of the plaintiff’s licensing enterprises, 481 F. Supp. at 1194. After Warne instituted its action, defendant changed to a rabbit design of its own creation. *Id.*

70. *Id.* at 1196.

71. *Id.* at 1198.

72. *Id.* at 1197, n.3.

73. 689 F.2d 1042 (C.C.P.A. 1982).

74. *Id.* at 1052.

75. *Id.* at 1052-1053, n.6.

characters from public domain works would protect that which copyright principles require should be granted to the public. This would effectively extend copyright protection beyond the period provided for by the statute, undercutting the basic copyright bargain.⁷⁶ There is a conflict between the policy underlying the limited duration of copyright, and that which allows trademark protection so long as a likelihood of public confusion endures. Some commentators have suggested that once copyright expires, anyone can copy the original work, but that the law of trademarks and unfair competition can be used to prevent new uses of the characters in new stories.⁷⁷ Another proposed solution is to allow the unauthorized creation of new works using the visual appearance and characterization of a character, but not its name.⁷⁸

The right to copy, however, cannot be used effectively if a newcomer must change the names of the central characters. The ability to use the characters in an evocative fashion would be lost. Furthermore, the exclusive rights lost at the expiration of copyright include the right to create derivative works, i.e., the right to use the characters in new stories. That is the nature of the public domain: anyone is entitled to use what lies within it. Indeed, allowing an author to create something new from that which already exists lies at the heart of the policy limiting the duration of protection for creative works.⁷⁹

Trademark concerns can be addressed without undercutting the interest in preserving the public domain by limiting the remedy available to the owner of mark-based rights in a character. Newcomers can be required to tailor their marketing and labelling, to use distinguishing language to minimize confusion.⁸⁰ For example, a new Sherlock Holmes story could be prominently marked with the name of its author and include the legend, "Not written by Arthur Conan Doyle or authorized by the Doyle estate." Of course, this remedy will be less effective in protecting against public confusion and facilitating consistent character traits than for-

76. See *supra* notes 14-15 and accompanying text.

77. Samuel W. Tannenbaum, *Protection of Fictional Characters in the Entertainment & Literary Fields*, 4 BEV. HILLS BAR J. 11, 18 (1970); Franklin Waldheim, *Characters—May They Be Kidnapped*, 12 BULL. COPYRIGHT SOC'Y U.S.A. 210, 217 (1965).

78. E. Fulton Brylawski, *Protection of Characters—Sam Spade Revisited*, 22 BULL. COPYRIGHT SOC'Y U.S.A. 77, 96 (1974).

79. See *supra* notes 11-15 and accompanying text. On the other hand, this sort of use is more likely to create public confusion than simple copying.

80. This is the approach that has been taken in cases involving the titles of public domain works. See Leslie A. Kurtz, *Protection for Titles of Literary Works in the Public Domain*, 37 RUTGERS L. REV. 53 (1984).

bidding the use of a character, and far less useful for those who seek to retain exclusive rights. Allowing exclusive rights, however, not only diminishes the creative pool from which all authors must draw, but does so for an unlimited period of time.

The same approach should be used when characters or their elements are used on merchandise. I have suggested that the interests protected by trademark tend to be weak in such cases.⁸¹ When the claim of mark-based rights is premised solely on the idea that the public will believe the products are authorized, and not on any warranty of consistent quality, the remedy of distinguishing language provides some protection against public confusion, while allowing competition in marketing goods adorned with the indicia of public domain characters.⁸²

This solution is likely to be of cold comfort to those who hold rights in characters under the law of trademarks and unfair competition. Not only does it provide them with less protection than a prohibition against copying, but it is likely to lead to a diffusion of source. Once a number of people have made use of the character, even with distinguishing language, the perception of a single source may be destroyed, and trademark rights may end altogether.⁸³ But this result is better than the alternative. One person's right is another's restraint, and the cultural heritage from which all may draw should not be indefinitely diminished.

Trademark concerns are the greatest with a character like Mickey Mouse, where the association with source is extraordinarily strong, not a convenient fiction at all. These characters may cease to exist as we know them, if they are given to the public for unrestricted use.⁸⁴ One commentator has suggested that with such

81. See *supra* notes 47-53 and accompanying text.

82. In the rare situation where some element of a public domain character functions solely as a mark—without depriving others of the ability to use characters in new stories or to ornament their merchandise—then the public domain status of the character is irrelevant and it would be appropriate to forbid the use of a confusingly similar mark.

83. Cf. *Universal City Studios v. Nintendo*, 578 F. Supp. 911 (S.D.N.Y. 1983), *aff'd on other grounds*, 746 F.2d 112 (2d Cir. 1984) (finding that the rights to the King Kong character and name had been so divided among different parties that the King Kong mark was incapable of indicating to consumers a single source of origin).

84. Of course, characters may cease to exist as we know them, even if they are not given to the public for unrestricted use. Copyright lasts for a long time. See *supra* note 2. By the time it expires, those who are claiming rights are not the original creators, who are no longer alive, but are heirs, assigns, companies for which the work was created, and the like. They do have a motive to protect the value of the character. They may be more likely to keep the character as we know it. But, they may not. Views of the character and its uses may differ. Once the original creator is gone, one voice is not necessarily better than a diversity of voices; one view need not be better than many.

characters, whose association with source is “‘hard wired’ in the public consciousness,” distinguishing language may be insufficient, and, if so, use of the character in recognizable form should be enjoined.⁸⁵ But the best known characters, such as Mickey Mouse and Sherlock Holmes, become cultural artifacts and are of great value in creating new works. It is the power of these characters to evoke, to encapsulate, that makes them so important to the public domain.

85. Helfand, *supra* note 45, at 671-672.