The Case of the Character Conundrum

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Even those without a passing familiarity of intellectual property law generally understand that if an author writes a book, a playwright composes a play, or a screenwriter pens a movie script, then that individual owns rights in that creative work. But, understanding whether that protection extends to the specific scenes or characters in a work can be challenging. Often, a character is the most important part of a story; imagine *Superman* without Superman, or the *Harry Potter* series without Harry Potter. Character protection has been challenged on several fronts in recent months, and artists are looking for alternative methods of protecting their beloved fictional creations.

An important, but often misunderstood, legal doctrine of copyright law is that copyright protects only the expression of an idea, and not the idea itself. This is referred to as the "idea expression dichotomy." For example, if an artist paints a landscape of the Golden Gate Bridge, he does not have the right to stop all others from painting the same landscape; that is merely an idea. However, he can stop others from copying the artistic expression that is captured in his painting of the Golden Gate Bridge. Likewise, if a scriptwriter pens a television series that centers on a detective solving crime, that does not prevent others from creating detective shows. The idea of a detective story, and the character of a detective in such a series, is an unprotectable idea. Similarly, while Disney cannot own the copyright to a "mouse" design, as that is an idea, it has rights to the Mickey Mouse character, which is Disney's expression of a mouse.

A related doctrine is referred to as scène à faire, which refers to the rule that there are certain elements or scenes in every creative work that are basically obligatory for a particular genre. Such elements of a creative work will not be protected when they are mandated by or customary to the genre. For example, let's say I write a Christmas story set in the North Pole, with elves making toys for a jolly fat man with red cheeks and a hearty laugh; I am not infringing on the countless other stories that contain those elements, because those elements are essentially "mandatory" in a story about Santa Claus. Similarly, if I make a western movie set in the wilderness of the American frontier that includes a small, dusty town with a jail and saloon, men riding horses wearing boots with spurs and carrying guns, I am not infringing on the many westerns already in existence. These elements are scène à faire, and therefore are not owned by anyone.

Thus, the idea expression dichotomy and the scène à faire doctrine serve as limitations on copyright protection. Accordingly, while the text or dialogue in a particular scene will be protected by copyright, individual scenes may not be separately protectable apart from the work as a whole. Whether a character will be considered simply an idea, or part of the scène à faire, will depend on how "complete" the character is. The more vague a character, the less likely it is to qualify for copyright protection.

Another limitation on copyright is that protection does not last forever. The last amendment to the Copyright Act, the Copyright Term Extension Act of 1998 ("CTEA"), extended copyright terms in the United States. Since the Copyright Act of 1976, copyright would last for the life of the author plus 50 years, or 75 years for a work of corporate authorship. The Act extended these terms to life of the author plus 70 years, and for works of corporate authorship, to

120 years after creation or 95 years after publication, whichever is shorter. Copyright protection for works published prior to January 1, 1978, was increased by 20 years to a total of 95 years from their publication date. The Walt Disney Company lobbied extensively on behalf of the CTEA, leading many to derisively refer to it as the "Mickey Mouse Protection Act," because it delayed the entry of the earliest Mickey Mouse movies into the public domain. Even with this extension, the original Mickey Mouse films, including elements of the character of Mickey itself, will become public domain works in 2023, and most of those in the intellectual property profession expect Disney to start lobbying for further extension of the Act soon.

It is important to understand that the CTEA was not retroactive, and those fictional characters that were already in the public domain as of the adoption of the Act remain in the public domain. For instance, the fictional character of Santa Claus is in the public domain and anyone can write a book, paint a picture, make a movie, or otherwise use Santa in a creative work without risk of infringing on a character copyright. This does not mean an author can copy another's creative expression of a Santa Claus story; but the idea, the scène à faire of a Santa story, and the character itself are fair game.

Often, a character, such as Harry Potter, appears in a series of stories. Readers of the novels, or viewers of the films, know that Harry's character evolved over the course of the series, and was not fully-developed until the series finale. Each book, and each film, is a separately copyrightable work and is protected accordingly. However, for the characters that appear in each of the installments, the question arises: At what point does copyright protection of Harry's character, as well as the other recurring characters, begin and end? This question was recently addressed with regard to the character of Sherlock Holmes.

In a Seventh Circuit case[1], the author of an anthology about Sherlock Holmes, which consists of stories *inspired by* the famous works of Sir Arthur Conan Doyle, challenged the Doyle estate's demand for a licensing fee to use the characters of Holmes and Dr. Watson. Doyle published his first Sherlock Holmes story in 1887, and his last in 1927; there were 56 stories in all, plus four novels. The Doyle estate conceded that 46 of the stories, and the four novels, have all fallen into the public domain. Even with the enactment of the CTEA, all works published in the United States before January 1, 1923, are in the public domain. Thus, the estate has copyright protection only for the final ten stories that were published between 1923 and 1927. The estate argued that until the final story was written the characters were not fully developed, and therefore the characters should remain protected until *all* of Doyle's works fall into the public domain. The estate further argued that to hold otherwise would discourage creativity because it may take a long time for an author to perfect a character, and if that author loses copyright in the original character there will be no incentive to improve upon or evolve the character.

The Court was not persuaded, and held that subsequent creative works involving the same characters as earlier works are derivative works of the original, and when the original story falls into the public domain, story elements, including characters, become fair game, and only original elements added in the later stories remain protected. For instance, in one of the later Holmes stories, readers learn that Holmes's attitude toward dogs has changed – he has grown to like them. Because that detail is contained in a story that remains protected by copyright, if the author of the

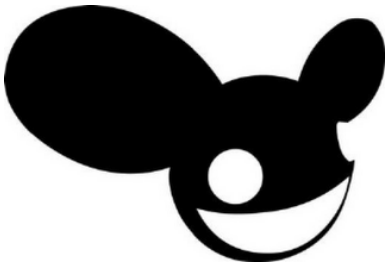
[1] *Klinger v. Conan Doyle Estate, Ltd*., 755 F.3d 496 (7th Cir. 2014).

anthology were to write a Sherlock Holmes story in which Holmes liked dogs, this could be an infringement of the Holmes character copyright. But, the growth of a character, and any alterations to that character, do not revive the expired copyrights in the original stories, or in the characters they contain.

With term and other limitations on copyright, authors are turning to alternative methods of protecting the fictional characters they create, such as trademark law. The primary purpose of trademark law is to identify the source of goods or services. In order to maintain trademark protection, however, the owner must actually use the mark in U.S. Commerce to identify the provider of particular goods or services. Because the Doyle estate had not used the Sherlock Holmes or Dr. Watson characters as trademarks, the estate was not able to rely on trademark law to protect the characters.

However, Disney, which as noted above risks losing rights to elements of the Mickey Mouse character in the next decade, has quite effectively used Mickey Mouse as a trademark to identify Disney as the source of everything from theme parks and major motion pictures to pencils and coffee mugs. There is little doubt that Disney has used Mickey Mouse as a trademark.

Recently, based on its trademark rights in the silhouette of Mickey's head, Disney has opposed very popular electronic music DJ Deadmau5's (pronounced "dead mouse"; Joel Zimmerman) effort to register the trademark in the design of the "mau5head" that he wears at all of his shows, puts on all of his merchandise, and which generally identifies him in the entertainment industry. Deadmau5 has created a fictional character that identifies his goods and services, and for over ten years has extensively used the design as a trademark throughout the world with no objection from Disney. Deadmau5 has registered trademarks for the design in several countries, but only recently applied for federal trademark registration in the U.S. for the following "mau5head" logo mark:



Disney challenged Deadmau5's application, and argues that consumers are likely to be confused as to the source of Deadmau5's goods and services. Disney argues that consumers will see Deadmau5's mark and think that the entertainment services or products sold bearing the mark are related to, sponsored by, affiliated with, or otherwise authorized by Disney, when they are not. As both a Disney and a Deadmau5 fan, I, personally, would not be confused. But, the 13-factor test for trademark infringement will look at factors such as the similarity of the goods and services offered under both marks (many of which overlap), the target audience (arguably, children for Disney, adults for Deadmau5), as well as the channels of trade for the goods and services offered in connection with the competing marks. Furthermore, for famous marks, and likely the Mickey Mouse character silhouette qualifies, an extra level of protection is granted to prevent against dilution of the mark, even if consumers are not confused. Disney is likely to claim that

Deadmau5's use of the "mau5shead" design will dilute the uniqueness of its Mickey Mouse mark. The litigation is likely to be very fact-based, and intellectual property practitioners, as well as Disney and Deadmau5 fans, will be watching this character design challenge closely.

With recent challenges such as these to intellectual property protection of characters, artists and authors are struggling to find ways to protect their creations. Although it may seem surprising to know that Sherlock Holmes – or at least most of the character's attributes – are now in the public domain, Article I, Section 8, Clause 8 of the United States Constitution, known as the Copyright Clause, empowers the United States Congress "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 Founding Fathers intended copyright protection to be for a "limited time" in order to encourage and inspire others to create new works.

While it may be tempting to accept the Doyle estate's argument that until the final story was written the characters of Holmes and Dr. Watson were not fully developed, if each new creative work containing a character renewed the copyright protection in that character, a copyright holder could actually own a copyright in a character forever by simply continuing to release new works containing the character. This would create a perpetual copyright, which would violate the U.S. Constitution, and discourage the development of new creative works.

Trademarks, however, are not limited in term by the Constitution, and can last forever if they continue to be used in commerce. This is why many creators are turning to trademark law to try and protect their fictional characters in perpetuity, or at least those attributes that are protectable. Limits on trademark protection, however, make protection of characters in this way challenging for many artists. Even given the character-driven stories (*e.g.*, *Harry Potter*), movies (*e.g.*, *Forrest Gump*), television shows (*e.g.*, *The Big Bang Theory*), and plays (*e.g.*, *Wicked*) that permeate society today, there are many characters that are not well-suited for trademark use. It would be unfeasible, and undesirable, to use every character in every fictional work to identify the source of goods or services; ponder Hannibal Lecter chili, a Dexter knife set, or a Forrest Gump toothbrush. Perhaps it is for the best that many of our beloved characters will simply inhabit their fictional worlds, amply and fairly protected under the copyright laws.

Encouraging new creative expression is a noble endeavor, and one which requires that works not remain protected in perpetuity. That protected works fall into the public domain is just as important to society as it is that we protect them until that point. Although it feels a bit sad that the characters of Sherlock Holmes and Dr. Watson are now in the public domain, if it inspires a new author to create new works with these beloved characters, the purpose of the copyright laws will have been served. Further, if a character is not used as a trademark, it should not be granted the robust protections of federal trademark law. Disputes regarding character trademarks should be limited to the tenets of trademark infringement, namely, whether consumers are confused as to the source of the goods or services. If consumers are not likely to be confused, characters should be able to be freely used as marks, without conflating the idea of perpetual trademark protection with the creative expression of a copyright. While the "case of the character conundrum" remains unsolved, recent challenges, such as those to the characters of Sherlock Holmes and Deadmau5, are helping to unravel the mystery.

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