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The Legal Protection of Fictional Characters

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THE LEGAL PROTECTION OF FICTIONAL CHARACTERS

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I. OVERVIEW

Although fictional characters have become an increasingly pervasive part of American culture, they still do not enjoy well defined legal protection against infringement. Since copyright law may not provide adequate protection for fictional characters, plaintiffs and courts must often rely on alternative doctrines, such as trademark or publicity rights, to secure protection for fictional characters. While these alternative doctrines may fill some of the voids left open by copyright law, they are often misinterpreted and inconsistently applied. In fact, even when correctly applied, these alternative doctrines still fail to adequately protect characters. This article will explore the availability and weaknesses of copyright law and alternative doctrines in protecting fictional characters, and briefly examines the argument for establishing a separate legal category specifically for fictional characters.

II. INTRODUCTION

In general, current copyright law protects the **EXPRESSION** of ideas, rather than the **IDEAS** themselves. The distinction, however, between an idea and its expression is often quite elusive, and there is still no definitive standard to distinguish an "idea" (i.e., a talking mouse character *type*) from an "expression" (i.e., the Mickey Mouse *character*). This difficulty in distinguishing an "expression" from an "idea" has been recognized by the courts. One example is the Second Circuit's conclusion that "any test will necessarily be vague . . . [and] [o]bviously, no principle can be stated as to when an imitator has gone beyond copying the 'idea' and has borrowed

its expression. Decisions must therefore inevitably be ad hoc."¹

Further difficulties arise in defining fictional characters as the characters, themselves, evolve and change. Fictional characters may consist of many different elements, and may change in physical appearance, personality and mannerisms. For instance, Mickey Mouse has "softened" over the years,² while Superman has become more "personable," attractive, and more interested in women.³

III. COPYRIGHT LAW AND PROTECTION

A. Background

The infringement of fictional characters is usually analyzed under copyright law. However, copyright law does not provide clear or consistent protection for fictional characters. In fact, the federal Copyright Act of 1976⁴ does not explicitly recognize fictional characters, nor include them in its list of exclusive rights.⁵ Even Nimmer's four volume treatise on copyright law devotes only one small section to fictional characters.⁶ Copyright is a legal device enabling authors to control the use of their intellectual creations.⁷ The primary purpose of copyright protection is to encourage creativity and the dissemination of creative works so the public may benefit from the labor of authors.⁸ The Copyright Act provides broad protection for original works fixed in a "tangible medium."⁹ The 1976 Amendment eliminated the actual "publication" requirement which the original 1909 Copyright Act estab-

1. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 498 (2d Cir. 1960). See also, Judge Learned Hand's opine that, "the line, wherever it is drawn, will seem arbitrary, [but] that is no excuse for not drawing it." *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930), cert. denied, 282 U.S. 902 (1931). See *infra* text accompanying notes 14-18.

2. See S. Gould, "A Biographical Homage to Mickey Mouse," in *The Panda's Thumb* 95 (1980).

3. G. Grossman, *Superman, Serial to Cereal* 8 (1977); See also D. Petrou, *The Making of Superman, The Movie*, (1978).

4. 17 U.S.C. § 102 et. seq (1988).

5. 17 U.S.C. § 106 at 113.

6. Melville B. Nimmer and David Nimmer, *1 Nimmer on Copyright*, § 2.12 at 2-171-2-178.20 (1991) [hereinafter *Nimmer*].

7. Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law 3-6 (1961)(quoted in A. Latman, R. Gorman & J. Ginsburg, *Copyrights for The Eighties* 11 (1985)).

8. *Id.* at 13. See also *Nimmer*, § 1.03[A]; *Rockford Map Publishers v. Directory Serv. Co.*, 768 F.2d 145, 148 (7th Cir. 1985)("The copyright laws are designed to give people incentives to produce new works.[citation omitted] They allow people to collect the reward for their contributions.").

9. 17 U.S.C § 102(a).

lished,¹⁰ but the Act still does not directly address fictional characters.

Copyright protection begins as soon as a work is fixed in any tangible medium of expression.¹¹ Copyright protects characters only when they appear as copyrightable components of preexisting works, but does not provide any express protection for the characters themselves.¹² Because the character does not have a "tangible existence," copyright law does not recognize nor protect the character outside the specific copyrighted work in which it appears.

B. *The Two-Part Test for Infringement*

Courts have adopted a two-part test to determine copyright infringement of a fictional character. This test requires courts to determine whether the character's expression is copyrightable; and, if it is, whether there is an infringement of this expression?¹³

Is the fictional character copyrightable? A character must first establish that it is able to be copyrighted in order to maintain a copyright infringement action. A character becomes copyrightable when the character, as originally conceived and presented, has been *sufficiently developed* (i.e., "distinctly delineated") to warrant copyright protection, outside or apart from the story in which it appears. The seminal case for this determination is *Nichols v. Universal Pictures Corp.*,¹⁴ where Judge Learned Hand ruled that characters may be protected "quite independently of the plot proper."¹⁵ Judge Hand also noted that "[i]t follows that the less developed the characters, the less they can be copyrighted; [and] that [this] is the penalty an author must bear for marking [the characters] too indistinctly."¹⁶ Judge Hand further noted that the point of infringement is difficult to identify, especially when the alleged plagiarist has taken an abstract work as a whole, rather than taking any specific block of a work: "[n]obody has ever been

10. *Id.* §§ 101-119. The original Copyright Act of 1909 required publication to protect a writing. Copyright Act, ch. 320 § 4, 35 Stat. 1075, 1076 (1909) (current version at 17 U.S.C. §§ 102, 103.).

11. 17 U.S.C. § 102(a) (emphasis added).

12. 17 U.S.C. §§ 102, 103. See *Nimmer*, § 2.12 n.2.

13. See *Nimmer*, § 2.12 at 2-173; See also, *Zambito v. Paramount Pictures*, 613 F.Supp. 1107, 1111-12 (E.D.N.Y. 1985), *aff'd*, 788 F.2d 2 (2d Cir. 1985); *Warner Bros. v. American Broadcasting Cos.*, 530 F.Supp. 1187, 1193 (S.D.N.Y. 1982), *aff'd*, 720 F.2d 231 (2d Cir. 1983).

14. 45 F.2d 119, 122 (2d Cir. 1930). (Nichols, the author of the play *Abie's Irish Rose* alleged her copyright had been infringed by Universal's movie *The Cohens and Kelleys*).

15. *Id.* at 122.

16. *Id.*

able to fix that boundary, and nobody ever can."¹⁷

Although the *Nichols* ruling extended copyright protection to the particular expression of a character, it did not protect the idea *itself*. Thus, copyright protection applies to a "distinctively delineated" character *expression*, but not when the similarity is found only in the idea or character *type*.¹⁸

This "distinctively delineated" test has become the general standard in character infringement cases. For example, in *Olson v. National Broadcasting Co.*,¹⁹ the Ninth Circuit held Olson's television series "Cargo" did not infringe upon NBC's "The A-Team," because the A-Team characters failed to achieve the level of delineation to warrant copyright protection.²⁰ The court did, however, acknowledge that copyright protection would apply *if* the characters in question had reached the required level of distinction. This was in reference to similar decisions by the Ninth Circuit (Disney cartoon characters), and the Second Circuit (Superman).²¹

The *Nichols* standard was also applied to afford protection for Tarzan, because the character was "sufficiently delineated by the author to be copyrightable."²² However, copyright law would not have protected Tarzan if the court had found he had not become "sufficiently delineated." Superman has likewise been found to "embody an arrangement of incidents and literary expressions original with the author,"²³ therefore warranting copyright protection.²⁴

Even a character which has become sufficiently developed may still be precluded from copyright protection by the "Scenes a faire" exception. "Scenes a faire" are "incidents, *characters*, or settings which are indispensable, or at least standard, in the treatment of a given topic."²⁵ The Ninth Circuit used this doctrine in

17. *Id.* at 121.

18. *Warner Bros. v. American Broadcasting Cos.*, 720 F.2d 231, 239 (2d Cir. 1983); *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977). See *Nimmer*, § 2.12 at 2-171.

19. 855 F.2d 1446 (9th Cir. 1988).

20. *Id.* at 1451.

21. *Id.* at 950.

22. *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 519 F.Supp. 388, 391, *aff'd*, 683 F.2d 610 (2d Cir. 1982).

23. *Detective Comics, Inc. v. Burns Publications*, 111 F.2d 432, 434 (2d Cir. 1940).

24. *Id.*

25. *Atari Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616 (7th Cir.), *cert. denied*, 459 U.S. 880 (1982)(quoting *Alexander v. Haley*, 460 F.Supp. 40, 45 (S.D.N.Y. 1978). See also, 3 *Nimmer* § 13.13(A).

deciding *Olson*,²⁶ finding "those similarities that do exist arose from unprotectable scenes a faire."²⁷

After establishing the copyrightability of a fictional character, the character's owner must then demonstrate an actual infringement, rather than just a general "borrowing of ideas, in order to receive copyright protection. In other words, "did the infringer copy such [specific] development, and not merely a broader and more abstract outline?"²⁸

Intentional copying may be very difficult to prove directly, and must usually be inferred by indirect evidence.²⁹ The primary test used to determine infringement is by comparing the degree of *substantial similarity* between the original character and the alleged infringer (rather than a pure copyrightable per se test).³⁰

Difficulties arise, however, in distinguishing the point where similarities become substantial enough to constitute copyright infringement. For instance, sufficient similarity in appearance alone has sometimes been found to warrant infringement of characters such as Sparky the horse,³¹ Betty Boop,³² Mickey Mouse,³³ Tarzan,³⁴ and the Peanuts characters.³⁵ Other cases, however, have further required a showing of similarity in character traits or personality, beyond mere physical appearance. For example, the Lincoln-Mercury cartoon cougar was found not to be an infringement upon United Artists' Pink Panther, because the two cat figures exhibited different character traits.³⁶ These examples typify the inconsistency and uncertainty of the standards used in determining the outcome of any fictional character infringement issue.

IV. ISSUES AND WEAKNESSES OF COPYRIGHT LAW

Although copyright law does provide fictional characters with

26. 855 F.2d 1446.

27. *Id.* at 1453.

28. *See Nimmer*, § 2.12.

29. *Id.* *See also*, *Ideal Toy Corp. v. Kenner Prods.*, 443 F.Supp. 291, 302 (S.D.N.Y. 1977) ("the proper focus . . . lies not on the quality of the original characters but on establishing whether the allegedly infringing characters can be said to be "copied" from the original.").

30. *Nimmer*, § 2.12.

31. *King Features Syndicate v. Fleisher*, 299 F.2d 533 (2d Cir. 1924).

32. *Fleisher Studios v. Freundlich, Inc.*, 73 F.2d 276 (2d Cir.), *cert. denied*, 294 U.S. 717 (1934).

33. *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978).

34. *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 519 F. Supp. 388 (S.D.N.Y. 1981).

35. *United Features Syndicate v. Sunrise Mold Co.*, 569 F. Supp. 1475 (S.D. Fla. 1983).

36. *United Artists v. Ford Motor Co.*, 483 F. Supp. 89, 91 (S.D.N.Y. 1977).

a base of protection, it still leaves many voids in preventing infringement. This section reviews these major weaknesses.

1. Separating Characters From Their Work

Fictional characters are generally viewed as components of the works in which they appear. This view leaves a major gap in protecting characters outside of their original work, as any character may appear in numerous works and may also come into existence before being included in its copyrighted work.

The seminal case in this area is *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*,³⁷ (hereinafter "*Sam Spade*"). Dashiell Hammett, author of the *Sam Spade* novels, had assigned the entire copyright of *The Maltese Falcon* to Warner Brothers, but still continued to use the character Sam Spade, and assigned the right to use the character to other parties (including CBS). Warner Brothers charged that CBS's use of Sam Spade in their 1946 "The Adventures of Sam Spade" radio show infringed upon Warner's copyright. Warner claimed that it had sole proprietorship to the Sam Spade character as part of its *Maltese Falcon* copyright.

The Ninth Circuit rejected Warner's claim and held that the Sam Spade character was not protectable, because a "character may only be protected under copyright law if the character constitutes the story being told, but if the character is the chessman in the game of telling the story, he is not within the area of the protection afforded by copyright."³⁸ Warner's rights in Sam Spade did not include the right to use the character in future stories, because, even if Hammett had assigned his complete rights in the copyright to Warner, "such assignment did not prevent the author from using the characters . . . in other stories. The characters were vehicles for the story told, and the vehicles did not go with the sale of the story."³⁹ The court reasoned that the author was not trying to prevent infringement by Warner Brothers, but was merely fighting to retain his right to use his own character.⁴⁰ As a result, Warner retained its exclusive rights to *The Maltese Falcon* (even against the original author) and the author retained his right to use his character in other works, so long as these uses did not infringe on the particular original work which had been copyrighted to

37. 216 F.2d 945 (9th Cir. 1954), cert. denied, 348 U.S. 971 (1955).

38. *Id.* at 950.

39. *Id.*

40. *Id.* at 948.

Warner. Thus, the Ninth Circuit replaced Judge Hand's "independent character" standard in *Nichols*⁴¹ with its new "story being told" standard. Although this standard protects authors' rights to reuse their characters, it may have the adverse affect of excluding virtually any character from copyright protection, as it essentially relegates fictional characters to the public domain. According to this court, a character cannot receive copyright protection unless the character itself is the story. Professor Nimmer interprets this ruling as denying copyright protections for all fictional characters, because it "envisage[s] a 'story' devoid of plot wherein character study constitutes all, or substantially all, of the work."⁴²

The "story being told" standard has been widely used to determine copyright cases. For example, when Universal brought suit against a manufacturer of merchandise bearing the inscriptions, "E.T. Phone Home,"⁴³ the court found that the E.T. character was a central component of the movie (*E.T. - The Extra-Terrestrial*), being "a unique and distinctive character about whom the movie revolves,"⁴⁴ thus entitling Universal to relief. Using *Sam Spade* language, the court concluded E.T. was "more than a vehicle for telling the story, and actually constituted the story being told."⁴⁵ The "story being told" standard has also been used to deny protection for fictional characters. The character Jessica in the film *Beyond the Door*, for instance, was found not to infringe upon the Regan character in *The Exorcist*, because the story was not subordinated to the Regan character.⁴⁶

2. Extending the Character into Subsequent Works

Another void in copyright law may occur when a character is used in a series of works. When part of a series enters the public domain, the characters appearing in that work may be copied even when subsequent parts of the series are still protected by copyright.⁴⁷ This problem becomes readily apparent when characters

41. See *supra* text accompanying notes 14-18.

42. *Nimmer*, § 2.12 at 2-175.

43. *Universal City Studios v. Kamar Indus.*, 1982 Copyright L. Decisions (CCH) ¶ 25,452 (S.D. Tex. 1982).

44. *Id.* at ¶ 17,684.

45. *Id.* at ¶ 17,685. For additional discussion, see Brylawski, "E.T.: An Extraterrestrial Caught in a Copyright Dilemma," 52 *Geo. Wash. L. Rev.* 395 (1984).

46. *Warner Bros. v. Film Ventures Int'l.*, 403 F. Supp. 522, 525 (C.D. Cal. 1975).

47. See *Nimmer*, § 2.12 at 2-178. See also *Kurlan v. Columbia Broadcasting System*, 256 P.2d 962 (Sup. Ct. Cal. 1953); *DeCosta v. Columbia Broadcasting Sys., Inc.* 520 F.2d 499 (1st Cir. 1975).

cross mediums. When a character appears in a movie based on a public domain novel, for instance, the character may be entitled to protection for any new traits or elements added in the movie, but would not be protected as to elements included in the original novel.⁴⁸ This was clearly demonstrated in *Silverman v. CBS*,⁴⁹ where CBS alleged a musical play infringed upon its Amos n' Andy characters. The court permitted the play to use the character traits which had been developed during CBS's early radio scripts that had entered the public domain, but protected the traits which had been added in the later scripts and television programs that were still under copyright protection.⁵⁰

3. Visual Characters v. Literary Characters

No clear distinction exists between the legal protection for purely literary characters and characters which have become "visualized." This has resulted in inconsistent and confusing rulings with visual characters tending to receive far more protection than literary characters. The Copyright Act defines "audio-visual" works as "works that consist of a series of images which are intrinsically intended to be shown . . . in films or tapes."⁵¹ Cartoon characters are the most prevalent visual characters. The readily identifiable visual image inherent in cartoon characters makes it easier to identify these characters as "expressions." This provides courts with a higher degree of comfort (whether using the *Nichols* or the "story being told" test) in determining copyrightability and granting protection for cartoon characters.

A leading case in cartoon character protection is *Walt Disney Productions v. Air Pirates*,⁵² where the court found the Mickey Mouse character to be protectable apart from the stories in which he appeared. Although Air Pirate's mouse had a completely different name and personality, and appeared in different situations than Mickey Mouse, the Ninth Circuit concluded that the visual similarities of the two characters were still substantial enough to constitute infringement. Also, the court found that "copying a comic book character's *graphic image* constitutes copying to an extent sufficient to justify a finding of infringement."⁵³ *Air Pirates*

48. *Nimmer*, § 2.12 at 2-178.

49. 870 F.2d 40 (2d Cir.), *cert. denied*, 109 S. Ct. 3219 (1989).

50. *Id.* at 50.

51. 17 U.S.C. § 101 (1988).

52. 581 F.2d 751 (9th Cir. 1978).

53. *Id.* at 756 (emphasis added).

exemplifies how courts may look only to the graphic similarities, ignoring character traits and personalities, to determine infringement of cartoon characters.

In *Sid & Marty Krofft Television v. McDonald's Corp.*,⁵⁴ McDonald's commercials featuring "McDonaldLand" characters (Ronald McDonald et al.) were found to so closely resemble the total concept and "feel" of Krofft's *Puff'n'Stuff* television show as to constitute infringement. The *Krofft* decision represents an important landmark in character protection, as the court delved deeper than mere visual images, recognizing that characters develop personalities and interaction in particular ways that transcend mere physical appearances.⁵⁵ *Krofft* further demonstrates an increased scrutiny into character persona as the court looked beyond the individual characters themselves and considered the entire setting of the television show and commercials.

Krofft's recognition of a character's personality has been further extended. In *Warner Bros., Inc. v. American Broadcasting Co.*,⁵⁶ Warner Brothers claimed ABC's *Great American Hero* television character infringed upon Warner's Superman character. The court acknowledged that although Superman was sufficiently developed to warrant copyright protection, ABC's "Hero" did not capture the "total concept and feel" of Superman in order to justify injunctive relief.⁵⁷ In *Ideal Toy Corp. v. Kenner Products*,⁵⁸ Kenner claimed Ideal's "Star Team" toys infringed upon Kenner's "Star Wars" characters. The court observed that, although the Star Wars characters possessed physical traits and character, Kenner's toys had not developed a character, and thus any comparison had to be made solely on physical appearances.⁵⁹

Literary characters, however, are more difficult to define than visual characters, and thus present a more difficult legal challenge. There are no clear-cut guidelines as to which standards or tests to apply. No matter which of these tests are applied, further difficulties arise in defining whether a character is "distinctively delineated" or "the story being told" when the character has not yet appeared in an identifiable visual form. Courts, therefore, often find it easier to simply deny copyright protection for a literary charac-

54. 562 F.2d 1157 (9th Cir. 1977).

55. *Id.* at 1167.

56. 530 F. Supp. 1187 (S.D.N.Y. 1982), *aff'd* 720 F.2d 231 (2d Cir. 1983).

57. *Id.* at 241-243.

58. 443 F. Supp. 291 (S.D.N.Y. 1977).

59. *Id.* at 301. Any physical similarities which did exist were found not substantial. *Id.* at 303.

ter altogether, rather than interpreting unclear guidelines or trying to create new standards.

Literary character protection was brought to light in *Nichols*,⁶⁰ with Judge Hand's much-cited quote, "the less developed the characters, the less they can be copyrighted: that is the penalty an author must bear for marking them too indistinctly."⁶¹ Although very few infringement cases concern strictly literary characters, the literary aspects of a character are sometimes used to determine a case. The author's literary works in his Tarzan character, for example, were found to have been infringed upon by the defendant's X-rated film *Tarz & Jane & Boy & Cheeta*,⁶² but not infringed by a later MGM Tarzan movie.⁶³

Infringement of literary characters is generally determined under two criteria: first, which components are to be considered in distinguishing a character from the literary work in which it appears, and second, which character traits are used to distinguish expressions from ideas.

4. Determining Copyrightability

The lack of express copyright protection for fictional characters complicates the infringement inquiry by forcing the court to determine whether or not the infringed character is copyrightable. Courts are left to interpret and apply unclear principles regarding delineation and infringement, which often leads to murky standards and inconsistent rulings.

5. Pure Characters

Copyright law may provide little or no protection for the creators of a "pure character" (a character who does not appear in an incorporated work). Because the 1976 Copyright Act protects "works," but not characters,⁶⁴ a performer who creates and develops characters such as "Wayne and Garth," "Pee Wee Herman," "Ernest," or the "Church Lady" may not have any copyright protection in that character unless and until it has been incorporated

60. 45 F.2d 119 (2d Cir. 1930). See *supra* text accompanying notes 14-18.

61. *Id.* at 121.

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

63. *Burroughs v. Metro-Goldwyn-Mayer*, 519 F.Supp. 388 (S.D.N.Y. 1981), *aff'd*, 683 F.2d 610 (2d Cir. 1982)(holding the copyright in the literary work *Tarzan of the Apes* did not protect the plot alone, "leaving the characters free for public exploitation." *Id.* at 391). Using the first prong of *Nichols*, the court found that Tarzan was sufficiently well developed and distinctively delineated the works of Burroughs to be copyrightable. *Id.*

64. 17 U.S.C. § 102 (1988).

into an underlying work. This was evidenced in *Columbia Broadcasting System v. DeCosta*,⁶⁵ where actor Victor DeCosta sued CBS for infringing upon his pure character "Paladin" in CBS' television series *Have Gun Will Travel*.⁶⁶ Although CBS clearly copied even small details of the DeCosta's Paladin,⁶⁷ DeCosta was still denied relief because his pure character had never been incorporated into any "work."⁶⁸

6. Characters Not Widely Known

No matter how blatant an infringer's copying, the creator of a character may still be precluded from recovery if the character is not "sufficiently developed" to warrant copyright protection under the *Nichols* two-prong test.⁶⁹ Under the *Nichols* standard, a character's original creator may have no protection against an infringing author who places a copy of that same (copied) character in a copyrighted work before the original author does.⁷⁰ Even if the *Sam Spade*⁷¹ test is used (rather than the *Nichols* test), the character would still be vulnerable to infringement because a character cannot receive copyright protection unless the character is *itself* the "story being told."⁷²

V. ALTERNATE LEGAL GROUNDS FOR PROTECTION

Because copyright law leaves the major voids discussed above, plaintiffs, as well as courts, may need to rely upon alternative doctrines of law, such as trademark or dilution, to "find" legal protection for fictional characters. This may result, however, in inappropriate applications of these alternative doctrines to fit character protection needs. Furthermore, the entire purpose for relying on these alternatives in the first place may still not be met, as these

65. 377 F.2d 315 (1st Cir. 1967).

66. *Id.* at 316.

67. The CBS character, like DeCosta's character, was also named "Paladin," was a "good guy" wearing a black outfit, had a mustache, was based out of San Francisco, used a chess knight as a "trademark," and handed out business cards bearing the chess knight and the inscription, "have Gun Will Travel. Wire Paladin, San Francisco." *Id.* at 317.

68. *Id.* at 321. *See also* *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Bright Lighting, Inc.*, 376 U.S. 234 (1964).

69. *See supra* text accompanying notes 14-24.

70. *See* *Universal City Studios v. J.A.R. Sales*, 1982 Copyright L. Dec. (CCH) ¶ 25,460 (C.D. Cal. 1982)(enjoining the sale and distribution of Defendant's "I.T." doll that infringed on the copyrightable E.T. character)(discussed in *Brylawski, E.T.: An Extraterrestrial Caught in a Copyright Dilemma*, 52 GEO. WASH. L. REV. 395 (1984)).

71. 216 F.2d 945. *See supra* text accompanying notes 37-46.

72. *Id.* *See also*, *Nimmer*, § 2.12 at 2-175.

other doctrines may also fail to provide adequate protection for fictional characters.

1. Trademark and Unfair Competition

Trademark and unfair competition are the primary alternatives to copyright law for finding protection of fictional characters. Trademark law is governed by the federal Lanham Act,⁷³ which reaches any “word, name, symbol or device used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.”⁷⁴ The Act requires the registrant to use the trademark in commerce, but does not attach automatically when the character is created.⁷⁵

Trademark law primarily protects against using “a false designation of origin, or any false description or representation.”⁷⁶ When applied to character protection, trademark law focuses on the extent to which a character symbolizes or is associated with its author, rather than the development of the character emphasized in copyright. As with copyright, trademark also relies upon a two-prong test to determine infringement: First, the character must achieve a “secondary meaning” (“does the public associate the character’s name with the particular product being sold?”) and, if so, the creator must show a likelihood of consumer confusion (“is the use of the character’s name by another likely to deceive and confuse the public as to the source of the goods?”)⁷⁷

Trademarks may protect fictional characters who have acquired a “secondary meaning” with one particular source, including Mickey Mouse,⁷⁸ The Lone Ranger,⁷⁹ Mutt and Jeff,⁸⁰ and even a television character based upon a historical figure, Wyatt Earp.⁸¹

This protection may, however, fall short for characters which are associated with more than one source, as evidenced by *Univer-*

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

74. *Id.*

75. *Id.* at § 1051.

76. *Id.* at § 1125(a).

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

78. *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1977).

79. *Lone Ranger v. Curray*, 79 F. Supp. 190, 196 (M.D. Pa. 1948).

80. *Fisher v. Star*, 231 N.Y. 414 (1921).

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

sal City Studios v. Nintendo Co.,⁸² where Universal alleged that Nintendo's "Donkey Kong" video game infringed upon Universal's trademark in King Kong. The court found King Kong could not acquire a secondary meaning because the rights to King Kong were divided among numerous owners and not clearly associated with Universal.⁸³ Furthermore, even if King Kong had acquired the requisite secondary meaning associated with Universal, trademark protection was still precluded because there was no likelihood of consumer confusion.⁸⁴ The court, therefore, denied Universal's claim holding "that the vagueness of the image in which Universal claimed a trademark right violates the fundamental purpose of a trademark: to identify the source of the product and thereby prevent consumer confusion as to the source."⁸⁵

Trademark and unfair competition offer several advantages over copyright law for licensed character protection. Protected "ingredients" are broader under a trademark than a copyright regime and may include a character's name (Tarzan),⁸⁶ physical appearance and costumes (Superman),⁸⁷ phrases associated with a character ("Phone home,"⁸⁸ "Hi-yo Silver, Away!"),⁸⁹ and even the "marks, symbols, and design elements" of a television series car (The Dukes of Hazard's "General Lee").⁹⁰

Another advantage over copyright law is that an unfair competition claim will not be precluded by the author's failure to obtain (or retain) a trademark registration,⁹¹ whereas failure to obtain a copyright could relegate the author's work into the "public domain," thus precluding copyright protection.⁹² A trademark can also preserve a character indefinitely (as compared to the "life plus

82. 578 F. Supp. 911, 923 (S.D.N.Y. 1983), *aff'd* 746 F.2d 112 (2d Cir. 1984).

83. *Id.* at 925. (King Kong has not only been widely merchandised by numerous owners, but the merchandizing covered the use of different King Kong images, from the original 1933 movie, its *Son of King* sequel and the 1976 remake. *Id.* at 914.

84. *Id.* at 929.

85. *Id.* at 924.

86. *Edgar Rice Burroughs, Inc. v. Mann*, 195 U.S.P.Q. (BNA) 159 (C.D. Cal. 1976) (the source of the movie, *Tarz & Jane & Boy & Cheeta* was likely to be confused with the publicly-recognized name "Tarzan").

87. *DC Comics, Inc. v. Filmation Assoc.*, 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980).

88. *Universal City Studios v. Kamar Indus.*, 1982 Copyright L. Decisions (CCH) ¶ 25,452 (S.D. Tex. 1982).

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

90. *Warner Bros. v. Gay Toys*, 658 F.2d 76, 78 (2d Cir. 1981); *Processed Plastic Co. v. Warner Comm., Inc.*, 675 F.2d 852 (7th Cir. 1982).

91. *See Brylawski*, "Protection of Characters - Sam Spade Revisited," 22 *Bull. Cr. Soc.* 77, 98 (1974).

92. 17 U.S.C. § 301(b) (1988).

fifty years" copyright protection), although trademark protection may be lost by actual abandonment or through public treatment of the trademark. Trademark may also provide a broader scope of remedies, as it allows for damage awards and injunctive relief.⁹³

Although trademark and unfair competition does fill in some of the gaps left open by copyright law, it also leaves several major voids; primarily in that a character is not protected unless it has acquired a "secondary meaning." This may shelter the well-established character, but it leaves a major void in protecting new characters, unsuccessful works, most literary works, or even well established characters which the public does not associate with a single source (as with King Kong⁹⁴). Even if the character does develop wide recognition public association with the source, the author or owner may be denied trademark protection if it cannot be demonstrated that a likelihood of consumer confusion exists. Trademark and unfair competition thus places increased burdens of proof on the creator and may still not protect many characters or character elements. Trademark protection may therefore be of limited use in many cases, and may even have the adverse result of creating a false sense of security.

2. Right of Publicity

When trademark and unfair competition law does not adequately fill the voids left in copyright law, authors may turn to the right of publicity doctrine to protect their fictional characters.⁹⁵ Right of publicity is an outgrowth of the common law right of privacy doctrine, which provides protection from commercial exploitation of one's own names and likeness, and prevents unauthorized exploitation by others. Although primarily intended to protect public *figures* from unauthorized commercial exploitation of their names and likenesses, right of publicity has been applied to fictional characters. Right of publicity was relied upon, for example, to protect the Marx Brothers characters from being recreated in a musical play.⁹⁶ The court acknowledged that copyright law would not protect human characteristics apart from some pro-

93. See *Restatement 2d, Torts* § 729; David Nimmer, "Copyright and Quasi-Copyright Protection for Characters, Titles, and Phonograph Records" 59 TRADEMARK REP. 63 (1969).

94. See *supra* text accompanying notes 81-84.

95. See "The Right of Publicity Run Riot: The Case of a Federal Statute," 60 S. CAL. L. REV. 1179 (1987).

96. *Groucho Marx Prods. v. Day and Night Co.*, 523 F.Supp. 485, 492-3 (S.D.N.Y.), *rev'd on other grounds*, 689 F.2d 278, 287 (2d Cir. 1981).

tected "work", but found the play "infringed the plaintiff's *rights of publicity* in the Marx Brothers characters."⁹⁷

Right of publicity was also relied upon (although unsuccessfully) in *Lugosi v. Universal Pictures*,⁹⁸ where the court held that Bela Lugosi's heirs were not entitled to protection for Lugosi's portrayal of Dracula. The court focused more on Lugosi than on his Dracula expression, thus exemplifying how the right of publicity may be misinterpreted when applied to fictional characters by confusing the creator with the character.

3. Misappropriation

Protection for fictional characters has also been found under the misappropriation doctrine. Misappropriation may fill the major void left open by trademark law, as it does not require any "likelihood of public confusion" to extend protection to a character.

The misappropriation principle was established in *International News Service v. Associated Press*,⁹⁹ where the Supreme Court held that INS's actions taking AP's early news bulletins and then selling this news to AP's own competitors "misappropriated" AP's news gathering work and that INS had "appropriat[ed] to itself the harvest of those who have sown."¹⁰⁰

An action for misappropriation generally requires three elements.¹⁰¹ First, the "thing" allegedly appropriated (the "quasi-property") must be created by a substantial investment of time, effort, and money.¹⁰² Second, the defendant must appropriate this "thing" at little or no cost, thus "attempting to reap where it has not sown."¹⁰³ Third, the plaintiff must be injured by the misappropriation, ordinarily by a diversion of profits.¹⁰⁴ The standards as to what constitutes the "appropriation" of this work, and how to measure the plaintiff's damages, still remain undefined.¹⁰⁵

Misappropriation has been used in some character protection cases, but has been applied inconsistently and sporadically. Courts

97. *Id.* at 494 (footnote omitted) (emphasis added).

98. 603 P.2d 425 (Sup. Ct. Cal. 1974).

99. 248 U.S. 215 (1918).

100. *Id.* at 239-40.

101. For a discussion of the three requisite elements, and the misappropriation doctrine in general, see L.J. McCarthy, *Trademarks and Unfair Competition*, § 10:25 (2d ed. 1984); Abrams, "Copyright, Misappropriation, and Preemption: Constitutional and Statutory Limits of State Law Protection" 1983 Sup. Cr. Rev 509, 513 (1983).

102. *Id.*

103. *Id.*

104. *Id.*

105. *Id.*

often refer to "misappropriation" as one of its three main elements, yet decide the case on copyright or trademark grounds.¹⁰⁶

4. Dilution

Another means of "finding" character protection is through "dilution." This consists of the diminution or "whittling away" of the value of a name or mark's hold on the public mind.¹⁰⁷ The dilution theory assumes that a unique mark should be protected as a property right and, as with misappropriation, does not rely upon the "public confusion" requisite of trademark infringement.¹⁰⁸

Several states have enacted specific anti-dilution statutes. New York, for example, prohibits "acts resulting in a likelihood of injury . . . or dilution of the distinctive quality of a mark or trade name," regardless of whether such mark is registered or not.¹⁰⁹ The New York statute, however, only provides for injunctive relief while monetary damages must be sought under other grounds.¹¹⁰ Dilution has been used to protect the names, likenesses, and other identifying traits of fictional characters, including Superman and Wonderwoman,¹¹¹ the Peanuts characters,¹¹² and Tarzan.¹¹³ Dilution has, however, also been used to deny relief for alleged infringement of characters, including Superman (by ABC's "The Great American Hero"),¹¹⁴ King Kong (against Nintendo's Donkey

106. See *Conan Properties v. Conan's Pizza*, 752 F.2d 145 (5th Cir. 1985) ("the defendant appropriated and used [plaintiff's Conan character] without [plaintiff's] authority." *Id.* at 155-56) (emphasis added); *Lone Ranger v. Cox*, 124 F.2d 650 (4th cir. 1942); *Universal City Studios v. Kamar*, 1982 Copyright L. Decisions (CCH) ¶ 25,452 (S.D. Tex. 1982); *Superior Models, Inc. v. Tolkien Enters.*, 211 U.S.P.Q. (BNA) 587 (D. Del. 1981) (finding "misappropriation" of *The Hobbit* characters).

107. See Frank Schecter, "The Rational Basis of Trademark Protections," 40 *Harv. L. Rev.* 813 (1927).

108. *Id.*

109. N.Y. Gen. Bus. Law § 368-d (McKinney 1984).

110. *Id.*

111. *DC Comics v. Unlimited Monkey Business*, 598 F.Supp. 110 (N.D. Ga. 1984) (finding defendant's costumes presented a "clear likelihood of dilution of the distinctive quality of plaintiff's trademarks and trade names." *Id.* at 115) (emphasis added).

112. *United Features Inc. v. Sunrise Mold Co.*, 569 F.Supp. 1475 (S.D. Fla. 1983) (defendant's molds were "likely to dilute the distinctive quality of plaintiff's proprietary rights in the names and likenesses and good will of [the Peanuts] characters." *Id.* at 1479) (emphasis added).

113. *Edgar Rice Burroughs, Inc. v. Mann*, 195 U.S.P.Q. (BNA) 159 (C.D. Cal. 1976) (defendant's use of the title "Tarz & Jane & Boy & Cheeta" for an X-rated film would dilute the value of plaintiff's strong mark Tarzan) (emphasis added).

114. *Warner Bros.*, 720 F.2d 231 (concluding the Great American Hero series could not "blur or tarnish [Superman's] marks.") *Id.* at 248

Kong),¹¹⁵ and Godzilla (against Sears' "Bagzilla").¹¹⁶

VI. CONCLUSION

Fictional characters have become an increasingly important element of modern culture, yet they are generally ignored by current laws, and, even if covered, are seldom provided with adequate protection against infringement. Copyright law does not specifically address fictional characters, leaving courts to wrestle with ambiguous and uncertain standards. Even when copyright protection does exist, it may extend only to the protected "work" in which the character appears and not to the character itself. This ignores the reality that characters may be independently valuable apart from any "work" in which they appear and results in many voids in legal protection, especially for works which have not yet been copyrighted, literary characters, pure characters, and even for characters in copyrighted works which migrate to new works and other mediums.

Authors of characters may therefore turn to other bodies of law, such as trademark law, the right of publicity doctrine, or the dilution theory to "find" legal protection for their characters. These alternatives, however, also fail to specifically address fictional characters and are often applied inconsistently and incorrectly, especially as they are extended beyond their conceptual purpose to reach characters.

Trademark and unfair competition require a character to acquire a "secondary meaning" with a widely-recognized source in order to receive protection and further requires a showing of a "likelihood of public confusion." Right of publicity may provide protection against commercial exploitation of an actor's name, face, or voice, but it is not easily applied to, nor does it provide for the adequate protection of fictional characters. Even when recognized, the right of publicity may not be considered a descendable right, and may terminate upon the creator's death. Misappropriation is open-ended and loosely defined, and often confused with other doctrines. Dilution is also loosely defined, is not recognized in all states, and does not usually provide for any monetary relief. Another danger of relying upon these uncertain doctrines is that *over extending* character protection may remove too much from

115. Universal City Studios, 746 F.2d 112 (*see supra* notes 82-85).

116. Toho Co. v. Sears Roebuck & Co., 645 F.2d 788 (9th Cir. 1981) (finding Sears's use of "Bagzilla" (trash bags) did not "tarnish, degrade, or dilute the distinctive quality of Godzilla.") *Id.* at 793.

the public domain and unnecessarily limit competition.

The need for a separate category of law expressly for fictional character protection would seem appropriate and the call for such an amendment to the Copyright Act is gaining support. This separate category would eliminate much of the confusion and inconsistency resulting from the current lack of express character protection. Creating this express category would establish a clear foundation on which to decide such cases, allow for more consistent bargaining of ownership rights of characters, and protect human characters and "pure characters" from unauthorized infringement.

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