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THE STORY OF A CHARACTER: ESTABLISHING THE LIMITS OF INDEPENDENT COPYRIGHT PROTECTION FOR LITERARY CHARACTERS

SAMUEL J. COE*

INTRODUCTION

A work of literary fiction does not easily adapt itself to the legal framework of intellectual property. Every story involves a complex arrangement of plot, setting, dialogue, tone, and characters. Copyright law allows an author to protect the expression of his ideas within a work to ensure the unique arrangements of these literary elements are not exploited by another party, while leaving the ideas themselves in the public domain.¹ This protection provides a financial incentive for authors to contribute new artistic creations to the cultural landscape, while leaving future authors free to incorporate similar ideas into their own creations.² The distinction between expression and idea is often blurred, however, when copyright infringement claims focus on one particular element of a literary work: the fictional character.

When copyright law attempts to isolate and protect a character outside the context of its greater literary work, several problems arise. For example, picture a well-known fictional character such as James Bond. Originating in the popular spy-novels of Ian Fleming, James Bond has continued on to enormous commercial success and world-wide recognition through several Hollywood films.³ One court decision has even discussed the “various character traits that are specific to Bond—i.e., his cold-bloodedness; his

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1. Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 546 (1985).

2. *Id.*

3. Originally created in 1953, Fleming featured the character in twelve novels and two short story collections. The Bond character has since been featured in twenty-two films, becoming the second-highest grossing film series in history. See Preet Banerjee, *Highest Grossing Movies of All Time*, WHEREDOESALLMYMONEYGO.COM (Aug. 9, 2009), <http://wheredoesallmymoneygo.com/highest-grossing-movies-of-all-time/>.

overt sexuality; his love of martinis ‘shaken, not stirred;’ his marksman-ship; his ‘license to kill’ and use of guns; his physical strength; his sophistication.”⁴ These traits define the character of Bond, but traits such as these are rarely illustrated without the accompanying literary context. If James Bond is removed from international adventure and placed in a supermarket or an office-building with no villains to fight or women to seduce, would he still be the same character? A fictional character does not exist within a vacuum; some context is essential.

Courts have established two contrasting methods to determine whether a literary character deserves copyright protection independent from the context of the work in which it appears. The first approach has been articulated as the “distinctly delineated” test, which asks whether a character has been sufficiently developed within the author’s expression to merit independent copyright protection.⁵ This abstract test has proven difficult to apply, leading courts to often focus on whether the character is worthy of independent protection, rather than whether the alleged infringing party has actually copied the author’s original expression of ideas.⁶ The alternative method for determining whether a character should receive copyright protection is known as the “story being told” test, which limits copyright protection to those characters which embody the story in which they appear.⁷ This approach has received much criticism for being too restrictive,⁸ but it maintains the primary focus on the entire literary work, rather than its individual components. While other similar methods have been developed by federal circuits to evaluate pictorial characters,⁹ courts are still forced to choose between or combine these opposing copyright tests for literary characters, leaving them subject to inconsistent and unreliable protection.¹⁰

The uneven scope of protection given to characters under these two tests also influences how courts compare alleged character copies in copyright infringement claims. To support a claim of infringement, there must

4. *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1296 (C.D. Cal. 1995).

5. See Jasmina Zecevic, *Distinctly Delineated Fictional Characters that Constitute the Story Being Told: Who Are They and Do They Deserve Independent Copyright Protection?*, 8 VAND. J. ENT. & TECH. L. 365, 370 (2006) (discussing the evolution of the “distinctly delineated” test).

6. See Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 438 (1986).

7. See Kathryn M. Foley, Note, *Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide*, 41 CONN. L. REVIEW 921, 929–32 (2009) (discussing the evolution of the “story being told” test).

8. See MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.12 (Matthew Bender & Co. ed. 2009).

9. *Id.*

10. See Kurtz, *supra* note 6, at 462–63.

be substantial similarity between the author's original work and the alleged copy.¹¹ Courts generally compare the objective elements of the two works, such as plot, setting, and characters, as well as a more subjective comparison of the overall impression of each work.¹² However, when a literary character becomes the "work" that is allegedly being infringed, the reader is asked to consider the narrow similarity between two characters, rather than the overall impression of how those characters' accompanying stories compare. The test for substantial similarity is inherently resistant to the comparison of two characters outside the context in which they are presented to the reader. While a cartoon or comic-book character may be easily identifiable by itself, literary characters are born of the story that surrounds them.¹³ In other words, one cannot determine if James Bond has been copied without considering the story the James Bond copy appears in.

Because of the inconsistent consideration of context in the current circuit split, literary characters are often overprotected to the point where future authors are restricted from using similar character types in artistic expressions that ultimately bear little resemblance to the original work.¹⁴ Such an expansive application of copyright protection actually runs contrary to the goals of intellectual property by withholding ideas from being used in new literary compositions.¹⁵ A resolution is required that protects an author's right to retain reasonable control of his literary creations, while permitting future authors to use these influences and ideas for their own artistic expressions. The "story being told" test meets both criteria. Following this approach, copyright protection will be reserved for dominant character portraits, leaving remaining character expressions under the shelter of protection provided for the greater work in which they appear. This arrangement will resolve the difficulty courts have experienced when applying the expansive "distinctly delineated" test, while ensuring that copyright protection remains focused on the statutory "literary work," leaving component ideas free to use in new literary creations.

Part I of this note examines the inherent goals of intellectual property and the statutory foundation of copyright law. Part II discusses the historical approach to literary characters in copyright law and the development of the "distinctly delineated" and the "story being told" tests. Part III demon-

11. *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1297 (C.D. Cal. 1995).

12. *Id.*

13. *See Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 755 (9th Cir. 1978).

14. *See Kurtz, supra* note 6, at 456-57.

15. *See Warner Bros. Pictures, Inc. v. Columbia Broad. Sys., Inc.*, 216 F.2d 945, 950 (9th Cir. 1954).

strates the shortcomings of the “distinctly delineated” test and the dangers of over-protecting literary characters. Part IV identifies several benefits to limiting the scope of independent protection for literary characters. Part V presents an argument that the “story being told” test and the underlying copyright of the greater literary work are the only protection required for the promotion of copyright interests.

I. GOALS OF COPYRIGHT LAW & STATUTORY FOUNDATION

An author’s right to control the use of his literary creations is based on the constitutional recognition that intellectual property rights are required to encourage the creation of the arts.¹⁶ By granting a limited monopoly in a new creation, “an important public purpose may be achieved.”¹⁷ The primary purpose “is not to reward the labor of authors,” but to promote the “[p]rogress” of intellectual contributions to society.¹⁸ As the Supreme Court has stated, intellectual property rights provide special incentives which are “intended to motivate the creative activity of authors and inventors.”¹⁹

In copyright law, these special incentives come in the form of a bundle of exclusive rights to the owner of a copyrighted work.²⁰ These rights include the right to publish, copy, and distribute the work, as well as the right to prevent other authors from exploiting copies of that work.²¹ While a great amount of legal control is granted for a copyrighted work, this protection only extends to the original expression of ideas within that work, not the ideas themselves.²² The idea/expression dichotomy is one of the most important pillars of copyright law, marking the border between what is eligible for copyright protection and what must remain in the public domain. Accordingly, “copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.”²³ As the Supreme Court has summarized, “copyright is intended to increase and not to impede the harvest of knowledge.”²⁴

16. U.S. CONST. art. 1, § 8 (“The Congress shall have Power . . . To Promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . .”).

17. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

18. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991).

19. *Sony*, 464 U.S. at 429.

20. 17 U.S.C. § 106 (2006).

21. *Id.*

22. *Id.* § 102(b).

23. *Feist*, 499 U.S. at 349–50.

24. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 545 (1985).

To be eligible for copyright protection, an author's work must be an "original work[] of authorship."²⁵ The originality requirement is satisfied when a work is "independently created" by an author and contains "some minimal degree of creativity."²⁶ While some minimal amount of creativity can be found in most works, it becomes far more difficult to determine when an author's use of existing artistic influences begins to violate the "independent" creation requirement. Future authors are clearly prohibited from making interchangeable copies of previous works, but the idea/expression dichotomy recognizes that some level of appropriation is natural in the creative process. As Justice Story remarked long ago,

In truth, in literature, in science and in art, there are, and can be, few, if any, things, which, in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before.²⁷

Every author is influenced by some previous works and the reflections of those influences will always be found to some extent within his or her own creations. As Arnold Weinstein, a literature professor, recently declared, "The concept of authorship as a controlling authority is intellectually bogus Literature constantly reworks older things -- authors send their characters out into the world."²⁸ Copyright law is built on the understanding that some flexibility is inherent to the concept of originality.

In furtherance of these principles, one of the specific categories of artistic creation selected for protection under copyright law is "literary works."²⁹ The Copyright Act defines "literary work" as a written expression of words or numbers, such as that found in "books, periodicals, [or] manuscripts," thus keeping the focus on the overall completed product in which the work is "embodied."³⁰ A completed piece of literature may contain any combination of the traditional narrative elements found in written stories, including plot, setting, characters, and any number of supplemental features and stylistic touches, all working together to animate the overall story.

Recognizing the potential for future authors to seek greater protection for their works by dissecting them into smaller pieces, the drafters of the Copyright Act have declined to provide categorical protection for charac-

25. 17 U.S.C. § 102(a).

26. *Feist*, 499 U.S. at 345.

27. *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C. Mass. 1845).

28. Julie Steinberg, *Literature: Holden Caulfield, Grumpy Old Man?*, WALL ST. J., Jul. 9, 2009, at D7.

29. 17 U.S.C. § 102(a)(1).

30. *Id.* § 101.

ters themselves. The Copyright Office Code of Regulations explicitly states that “[w]ords and short phrases such as names, titles, and slogans” are not subject to copyright protection, leaving character names outside the scope of protection.³¹ Proposals to extend categorical protection for fictional characters continue to be rejected by legislators. As the Register of Copyrights explained in a 1965 report:

Proposals have been advanced for identifying fictional characters as copyrightable works in themselves under the bill. There are undoubtedly some characters that are developed in detail and with such breadth and depth that they emerge as separately identifiable parts of the copyrighted works in which they appear. Others, perhaps the large majority, cannot be said to represent independent creations apart from the particular literary or pictorial works depicting them. As is equally true in the case of detailed presentations of plot, setting, or dramatic action, we believe it would be unnecessary and misleading to specify fictional characters as a separate class of copyrightable works.³²

This statement illustrates that the administrator charged with advising Congress on copyright policy and procedure³³ has thoroughly considered the implications of granting characters copyright protection and decided instead to rely on the protection of the greater work in which they appear.

Commentators who argue that a new category of protectable subject matter should be added for fictional characters³⁴ focus on the fact that those listed in the Copyright Act are “illustrative and not limitative.”³⁵ While the drafters of the Act intended to provide courts with some flexibility in the scope of these categories, Congress has primarily recognized new categories to include different mediums of expression.³⁶ Adding a new category for fictional characters would redefine the existing category of “literary works,” rather than recognize any new category of artistic expression. The work of written literature is one of the oldest recognized forms of intellectual property and the character’s role in that medium has not changed from the inception of copyright law. Accordingly, literary characters remain

31. 37 C.F.R. § 202.1(a) (2010).

32. H. COMM. ON THE JUDICIARY, 89TH CONG., SUPPLEMENTARY REP. OF THE REGISTER OF COPYRIGHTS ON THE GEN. REVISION OF U.S. COPYRIGHT LAW: 1965 REVISION BILL 6 (Comm. Print 1965).

33. See 17 U.S.C. § 701(b)(1).

34. See David B. Feldman, *Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection*, 78 CAL. L. REV. 687, 711 (1990) (discussing several scholarly and judicial proposals for a fictional character category).

35. H.R. REP. NO. 94-1476 (1976).

36. See Feldman, *supra* note 34 (“For example, in 1972, it established a separate category for sound recordings in response to increasing common law protection. Similarly, the 1976 Act implicitly recognized the importance of performance arts by making special provisions for pantomimes and choreographic works.”) (footnote omitted).

inextricably linked to the greater “literary work” structure and must be considered in relation to this category of protection.

The fundamental goal of copyright is to incentivize the “progress” of creative works available to society. To serve that end, copyright law ensures authors that the original expression they produce will not be unfairly exploited after it is presented to the public. Conversely, copyright law also recognizes that providing too much protection will actually disable future authors from using existing influences in the production of new works. The continued reluctance to create a separate category of copyright for characters themselves illustrates that Congress has determined this protection should focus on the greater works in which characters appear, rather than the characters themselves. Since copyright law does not allow an author to monopolize ideas or prohibit others from using all of the elements employed within a work, it is essential to maintain the integrity of a literary work when claims of infringement arise.

II. HISTORICAL APPROACH TO LITERARY CHARACTERS

The basic principle that a literary character may warrant independent copyright protection was first suggested by the Second Circuit in *Nichols v. Universal Pictures Corp.*³⁷ In *Nichols*, a playwright brought an infringement claim against the makers of the motion picture “The Cohens and The Kellys,” which had a similar premise to his play “Abie’s Irish Rose.”³⁸ Both works portray the marriage of a young couple and resulting conflict between their Irish-Catholic and Jewish families, yet the court found too many differences between the story, theme, and characters to support an infringement claim.³⁹ In that opinion, Judge Learned Hand rather casually advanced the idea that characters may be entitled to copyright protection “independently of the ‘plot’ proper.”⁴⁰ He went on to reason that “the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”⁴¹

This statement prompted the development of the “distinctly delineated” test in the Second Circuit, whereby sufficient development of any literary character may entitle it to independent copyright protection.⁴²

37. 45 F.2d 119, 121 (2nd Cir. 1930).

38. *Id.* at 120–21.

39. *Id.* at 122.

40. *Id.* at 121.

41. *Id.*

42. See NIMMER & NIMMER, *supra* note 8.

Subsequent decisions divide the “distinctly delineated” test into a two-part analysis.⁴³ The first step determines whether the character has been originally conceived and sufficiently delineated to warrant independent copyright protection.⁴⁴ The second step incorporates the substantial similarity analysis, looking to the alleged infringing work to determine if there has been substantial copying of the original character or “merely a broader and more abstract outline.”⁴⁵ This “distinctly delineated” analysis provides a broad scope of protection, yet no solid guidelines for how to measure a character’s development or a benchmark for the point at which a character transcends a general idea into the realm of protectable expression.⁴⁶

The Ninth Circuit declined to follow this reasoning and developed the “story being told” test for determining whether a character is entitled to independent copyright protection.⁴⁷ In *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*, the court reasoned that if Congress had intended for characters to have copyright protection outside the work they appear in, then Congress would have made such a provision.⁴⁸ That case involved an author, Dashiell Hammett, who granted Warner Brothers the exclusive rights to his classic detective novel, “The Maltese Falcon.”⁴⁹ Warner Brothers later brought suit when Hammett used the novel’s main character, Sam Spade, in subsequent detective stories.⁵⁰ The court ruled in favor of Hammett, stating that the “characters were vehicles for the story told, and the vehicles did not go with the sale of the story.”⁵¹ Although the author had assigned his rights to the literary work, copyright protection did not extend to the component character of Sam Spade.

In reaching this decision, the court noted that there are certain circumstances in which a character could warrant independent copyright protection.⁵² As the court declared, “It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright.”⁵³ Thus, the Ninth Circuit limited the scope of

43. *Id.*

44. *Id.*

45. *Id.*

46. *See Zecevic, supra* note 5, at 372–73.

47. *Warner Bros. Pictures, Inc. v. Columbia Broad. Sys., Inc.*, 216 F.2d 945, 950 (9th Cir. 1954) (explicitly noting that the issue was given consideration by the Second Circuit in *Nichols*, yet proceeding to take the more restrictive approach).

48. *Id.*

49. *Id.* at 948.

50. *Id.*

51. *Id.* at 950.

52. *Id.*

53. *Id.*

copyright protection available for literary characters to instances in which the character closely reflects the work itself. In fashioning this “story being told” test, the court recognized that over-protection of characters “would effect the very opposite of the [copyright] statute’s purpose which is to encourage the production of the arts.”⁵⁴ Since the *Nichols* decision, the Ninth Circuit has granted broader protection for most visually-depicted characters,⁵⁵ but the “story-being told” test remains the standard for literary characters and continues to be employed in the analysis of many fictional characters in other mediums.⁵⁶

While literary characters may not seem as popular or influential as they used to be, the majority of fictional characters, whether they are presented in film or television, are still usually first conceived in written depictions. Written characters are crucial to the process of storytelling, allowing each reader to interpret them in his own unique way. This intangible nature is what gives them their artistic value, while making them elusive to any rigid copyright regime. The two major tests that have been articulated to confront this issue of character copyright protection have each been criticized and applied inconsistently by courts. A resolution is required between the two methods to ensure that courts do not overlook the basic interests of copyright in their attempts to protect literary characters independent from their original works.

III. SHORTCOMINGS OF THE “DISTINCTLY DELINEATED” TEST AND THE RISK OF OVER-PROTECTION

One of the practical problems with the “distinctly delineated” test is its unreliable judicial application and tendency to over-protect literary characters.⁵⁷ The Second Circuit standard asks judges to assume the role of literary critic in their analysis of characters within a work.⁵⁸ In trying to measure the development of a character, the court often isolates the character and disregards the importance of context.

54. *Id.*

55. In *Walt Disney Productions v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978), the court determined that cartoon characters are entitled to independent copyright protection. In reaching its decision, the court reasoned that “while many literary characters may embody little more than an unprotected idea, a comic book character, which has physical as well as conceptual qualities, is more likely to contain some unique elements of expression.” *Id.* at 755 (citation omitted). When characters are depicted in graphic representations, the distinction between idea and expression is easier to identify and copyright protection is more generally available for pictorial characters than “word portraits.” NIMMER & NIMMER, *supra* note 8.

56. See *Olson v. Nat’l Broad. Co.*, 855 F.2d 1446, 1451–52 (9th Cir. 1988); NIMMER & NIMMER, *supra* note 8.

57. See Zecevic, *supra* note 5, at 372.

58. Kurtz, *supra* note 6, at 440.

The earlier James Bond example⁵⁹ illustrated the importance of context in character development, and an even more reductive demonstration is found in *Burroughs v. Metro-Goldwyn-Mayer, Inc.*⁶⁰ In that case, the court held that the character of Tarzan was protectable under the “distinctly delineated” test and provided the following justification: “Tarzan is the ape-man. He is an individual closely in tune with his jungle environment, able to communicate with animals yet able to experience human emotions. He is athletic, innocent, youthful, gentle and strong. He is Tarzan.”⁶¹ This description provides only a faint outline of the character and no indication of how such broad character traits achieved the legal status of protectable expression. If a character of this general type is independently protected by copyright, the use of a similar character type in new artistic creations is significantly limited. Tarzan himself would likely be an infringement following such an approach due to his general similarity to the jungle-boy character of Mowgli in Rudyard Kipling’s “The Jungle Book.”⁶²

By focusing on how developed a character is, the “distinctly delineated” test has tended to disregard the overall dissimilarity between the character’s greater work and the allegedly infringing work. This problem is illustrated in *Filmvideo Releasing Corp. v. Hastings*, a case that involved an infringement claim over the use of the cowboy character Hopalong Cassidy.⁶³ The court ruled that the character as first portrayed in the Hopalong Cassidy books was sufficiently delineated for protection and that any use of the character would constitute infringement “irrespective and independent of the similarity of the story line.”⁶⁴ By finding infringement in the plaintiff’s use of the character in a Hopalong Cassidy film, the court disregarded the clear differences between the book and film versions of the character.⁶⁵ In the original books, the character was a vulgar and violent sort of ruffian, while the film version was more of a reserved, clean-living western hero.⁶⁶ The only real similarity remaining between the characters was the name and the general western genre setting, both insufficient to support an infringement claim.⁶⁷ By isolating the character from the context of the story,

59. See *supra* INTRODUCTION.

60. 519 F. Supp. 388 (S.D.N.Y. 1981).

61. *Id.* at 391.

62. Rudyard Kipling’s “The Jungle Book,” featuring Mowgli, was first published in 1894, many years before Edgar Rice Burroughs introduced Tarzan in the 1914 novel “Tarzan of the Apes.”

63. *Filmvideo Releasing Corp. v. Hastings*, 509 F. Supp. 60 (S.D.N.Y. 1981), *aff’d in relevant part*, 668 F.2d 91 (2d Cir. 1981).

64. *Id.* at 66.

65. Kurtz, *supra* note 6, at 459.

66. *Id.*

67. *Id.* at 460.

the court undermined the traditional infringement comparison, completely disregarding further consideration of the differences between the overall impressions of each story.

The problematic separation of character from context under the “distinctly delineated” test was also recently illustrated in *Salinger v. Colting*.⁶⁸ In that case, J.D. Salinger, the recently deceased author of the well-known novel “The Catcher in the Rye,” filed suit against a foreign author claiming, *inter alia*, that the protagonist of the author’s new novel “60 Years Later” was an infringement of the Holden Caulfield character from “Catcher.”⁶⁹ The court held that there was sufficient similarity between Holden Caulfield and Colting’s “Mr. C” character to support the finding of infringement:

Most notably, Defendants have utilized the character of Holden Caulfield, reanimated as the elderly Mr. C, as the primary protagonist of *60 Years*. Mr. C has similar or identical thoughts, memories, and personality traits to Caulfield, often using precisely the same or only slightly modified language from that used by Caulfield.⁷⁰

The court declined to follow the defendant’s fair use defense, reasoning that the extent of similarity went beyond that found in a parody or any other “transformative” use of Salinger’s work.⁷¹ The fact that one character is an old man and the other is a rebellious youth is deemed insufficient to distinguish them.

While the court reached a finding of character infringement, the court’s additional finding of substantial similarity between the two overall literary works illustrates that context is essential for the evaluation of a literary character. Throughout its opinion, the court looks to elements of the greater literary work to compare the two characters, yet ultimately disregards this context by giving Holden Caulfield independent protection.⁷² Aside from the similar protagonists, the court also acknowledges that Colting’s dialogue, setting, tone, supporting characters, and general plot create a work that “largely mirrors that of *Catcher*.”⁷³ The elderly protagonist is arguably the most dissimilar element of the infringing novel, yet the court designates him as an independent infringement. If a character can be redrawn as a significantly older individual, with different physical traits and life-experiences, yet still qualify as an infringement without reference to the surrounding story, it becomes increasingly difficult to draw the essen-

68. 641 F. Supp. 2d 250 (S.D.N.Y. 2009), *vacated on other grounds*, 607 F.3d 68 (2d Cir. 2010).

69. *Id.* at 254.

70. *Id.* at 263.

71. *Id.*

72. *Id.* at 264.

73. *Id.*

tial line between idea and expression. The court's ultimate conclusion illustrates that the copying of the Holden Caulfield character was not enough; it was the copying of the overall Holden Caulfield story that resulted in infringement. The court's separation of the character from its context only provides superfluous protection in the overall consideration of the greater literary works being evaluated.

The *Salinger* decision illustrates the inherent conflict between the Second Circuit's approach to character copyright protection and the traditional analysis of substantial similarity. The court cites *Castle Rock Entertainment, Inc. v. Carol Publishing Group, Inc.* for the "ordinary observer" test,⁷⁴ which states that "works are substantially similar where 'the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them and regard [the] aesthetic appeal'" as the same in each work.⁷⁵ This "ordinary observer" standard asks the court to consider the aesthetic appeal of the entire work, yet the "distinctly delineated" test asks it to narrow its focus to the single character's role within that work, regardless of how small it may have been in the overall aesthetic impression. *Castle Rock* also states another test employed by the Second Circuit when comparing works from the same genre and media: the "total concept and feel" test.⁷⁶ When works are in the same genre, such as two novels, this test analyzes the "similarities in such aspects as the total concept and feel, theme, characters, plot, sequence, pace, and setting" of each work.⁷⁷ By considering all these elements of a literary work, the substantial similarity analysis implicitly recognizes that a potentially infringing character must be considered in relation to the surrounding work before infringement can be found. Therefore, the "distinctly delineated" test asserts that a character can be protected independent from its story, yet the corresponding test for infringement takes the contradictory position that a character cannot be copied without copying some aspect of its story.

While the *Salinger* court may have reached the appropriate decision given the overall similarity of the two works, its assessment of the Holden Caulfield character opens the door for an expansive new area of potential infringement. By granting the Holden Caulfield character protection as an independent work within "The Catcher in the Rye," without establishing the boundaries of that character, the overall impression of the greater work has been undermined. Any infringement analysis will now focus on alleged

74. *Id.* at 254.

75. *Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc.*, 150 F.3d 132, 139 (2d Cir. 1998).

76. *Id.* at 140.

77. *Id.*

similarity with Holden Caulfield, rather than similarity with “The Catcher in the Rye.” Future authors are prevented from continuing Holden Caulfield’s story in any form, even one that produces a substantially different story. A future author may choose to portray a similarly rebellious and alienated teenage character and place him in an early historical or even science-fiction story, yet such characters would also be at risk because the surrounding story elements would be outside the infringement analysis. This isolated protection of the character significantly impairs the production of future works, essentially creating two works that can be infringed from the original single literary work.

The analysis of a character’s development under the “distinctly delineated” test takes the focus away from the overall impression of the work by attempting to separate the development of a character from the development of the story. Both the Tarzan and Hopalong Cassidy cases illustrate the problems that occur when attempting to identify a character independent from its surrounding story. In isolating characters from their context, courts have a tendency to outline mere character “types” and neglect a reasoned comparison of how similar a potentially infringing character actually is. In addition, the *Salinger* case illustrates that once an original character has been deemed as sufficiently “delineated,” courts have a tendency to further expand that protection to variations of the character that can differ greatly from the original character. Therefore, the “distinctly delineated” test puts judges in a very difficult position. As the First Circuit once stated, “Although we may not be qualified literary critics, [judges] are fitted by training and experience to compare literary works and determine whether they evidence substantial similarity.”⁷⁸ The Second Circuit’s approach, however, asks judges to create a new test of character similarity, outside the traditional comparison of story similarity. To encourage further artistic creation and ensure that protection is limited to expression, rather than ideas, courts must consider a literary character in relation to its surrounding context.

IV. BENEFITS OF LIMITING INDEPENDENT CHARACTER PROTECTION

The *Salinger* case illustrates how the over-protection of literary characters can often run contrary to the underlying copyright goal of promoting new artistic works. In reaching its conclusion, the court follows an expansive interpretation of when a new literary work can be deemed a “derivative” of an existing work. Copyright law provides that within the exclu-

78. O’Neill v. Dell Publ’g Co., 630 F.2d 685, 690 (1st Cir. 1980).

sive bundle of rights granted to an author is the right to create derivative works,⁷⁹ which generally means the freedom to create a new work based upon the original work.⁸⁰ While adaptations of novels into films or a re-recording of an existing song in a new music form are obvious derivative works, the issue becomes far more difficult when the dispute is centered on one literary character being “based” off another. As discussed earlier, the idea/expression dichotomy and the influence of the cultural marketplace upon artistic creation make it difficult to determine whether an author bases a character on protected expression or an unprotected idea. The Supreme Court has recognized that the “licensing of derivatives is an important economic incentive to the creation of originals.”⁸¹ However, the potential value of derivative works must not be used as an excuse to extend control over the elements of a literary work that are outside the scope of copyright protection. The legal standard for determining whether a work is “derivative” must focus on the greater literary work that has been given protection, not the component ideas within it.

By relying on economic incentives for the creation of new works, courts often compromise the underlying copyright goals they are claiming to promote. The *Salinger* court states that its decision is consistent with the underlying copyright goal of promoting the arts “because some artists may [have] further incentiv[e] to create original works due to the availability of the right *not* to produce any sequels.”⁸² While it is reasonable that authors may be discouraged from creating new works if others could make a sequel without their authorization, this reasoning does not extend to all uses of characters. Sequels typically contain most, if not all, the characters from an original work, as well as similar themes, plotting, and other elements from the original. Authors are not entitled to control every element within their works just because they intend to use it again in a sequel, regardless of how much an incentive that may be for them to create new works. Copyright law does not allow authors to stockpile every character or literary element contained in their works, such a position limits the production of new artistic works. By imposing a monopoly on literary characters, especially the abstract, aged variations of characters, like the one examined in *Salinger*, courts significantly limit the building blocks available to future authors.

It is important to remember that the underlying purpose of copyright law is to promote the generation of new artistic works, not to allow current

79. 17 U.S.C. § 106(2) (2006).

80. *Id.* § 101.

81. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 593 (1994).

82. *Salinger v. Colting*, 641 F. Supp. 2d 250, 268 (S.D.N.Y. 2009).

copyright holders to squeeze every drop of value from the popularity of ideas presented in their existing works. Judge Learned Hand recognized this important distinction in the *Nichols* decision itself.⁸³ In concluding that no infringement existed between the two works in that case, he recognized that only the author's expression is entitled to copyright protection, regardless of how valuable the ideas within that expression may be: "Though the plaintiff discovered the vein, she could not keep it to herself."⁸⁴ While J.D. Salinger and his heirs can prevent others from copying Holden Caulfield's character, they have no control over every new portrayal of similar rebellious young characters. The history of entertainment illustrates these changing trends in character types. Copyright law encourages authors to use existing character ideas in new works and the entertainment business illustrates these trends in popular character types, from spies and pirates to vampires and werewolves. These characters are always bound to be similar to each other, but the literary work in which they appear is what outlines the protection provided by copyright. By limiting the scope of character protection and keeping the focus on the overall literary work, new works are encouraged without sacrificing any of the author's rights in his existing expression.

The *Salinger* court's decision also illustrates that the fair use defense is often insufficient to protect the transformative use of literary characters.⁸⁵ The fair use doctrine allows for the use of existing copyrighted works in such formats as critical reviews, academic scholarship, and parody,⁸⁶ the latter being a new work which, "at least in part," comments on the original author's work.⁸⁷ In determining whether a new work may be deemed a parody and not an infringement, courts put great emphasis on whether the new work is transformative, that is whether the new work merely "supersede[s] the objects' of the original creation" or "instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message."⁸⁸ The fair use doctrine acknowledges the importance of transformative works, but does not provide courts with much guidance to identify these works.

Courts have primarily recognized fair use when characters are used in new genres aimed at different audiences. This kind of transformative use can provide valuable social and political commentary, as found in *Suntrust*

83. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930).

84. *Id.*

85. *Salinger*, 641 F. Supp. 2d at 268.

86. 17 U.S.C. § 107 (2006).

87. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 (1994).

88. *Id.* at 579 (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841)).

*Bank v. Houghton Mifflin Co.*⁸⁹ In that case, an author used large portions of “Gone with the Wind” without infringement, writing them from the perspective of a minor character from the original story to comment on the contemporary racial dynamics of the original.⁹⁰ The transformative nature of a parody can also provide cultural commentary by recasting a popular work in a comedic nature, such as James Bond inspiring the Austin Powers series of films.

While these character uses often result in profound transformations, there are also far more subtle ways to comment upon and transform a character which the fair use doctrine has been reluctant to recognize. Whether James Bond is placed in a comedic situation or a court-room drama, the author is using the idea of the character to create a new expression. As the Supreme Court stated, “the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works.”⁹¹ However, the *Salinger* decision illustrates that the more independent protection given to literary characters, the less room for transformative use remains.⁹² Future authors should not have to criticize or make fun of Holden Caulfield if they simply want to continue the character’s development in a transformative new story. Because fair use provides little protection for authors who want to use character ideas with similar artistic “purpose” in mind,⁹³ over-protecting those character ideas significantly impairs authors’ abilities to make new contributions to a popular existing genre.

In rejecting the fair use defense, the *Salinger* court puts a great deal of emphasis on the adverse impact that Colting’s novel would have on the original “Catcher in the Rye.”⁹⁴ The Supreme Court has stated that evidence of “substantial harm” to the market weighs against fair use, meaning the harm of “market substitution.”⁹⁵ The *Salinger* court reasons that since an author may wish to leave the future of a character’s story in the imagination of his readers, an unauthorized “sequel” like Colting’s will harm the “potential market” for derivative works.⁹⁶ However, the potential harm identified by the court is not really market substitution because the focus is put on the author, rather than the market. It is extremely unlikely that a consumer would ever purchase “60 Years Later” instead of “Catcher in the

89. 268 F.3d 1257 (11th Cir. 2001).

90. *Id.*

91. *Campbell*, 510 U.S. at 579.

92. *Salinger v. Colting*, 641 F. Supp. 2d 250, 268 (S.D.N.Y. 2009).

93. *See Campbell*, 510 U.S. at 578–79.

94. *Salinger*, 641 F. Supp. 2d at 267–68.

95. *Campbell*, 510 U.S. at 593.

96. *Salinger*, 641 F. Supp. 2d at 268.

Rye” or that its availability would have any adverse impact on the public’s desire for a sequel from Salinger. In fact, the subsequent use of characters in new stories would logically have the reciprocal effect of increasing the exposure and demand for the original work they appear in. Many commentators have noted this effect in the modern proliferation of online “fan fiction” sites, in which new uses of existing characters promotes their popularity and encourages further production.⁹⁷ The *Salinger* court operates under the unrealistic assumption that most readers would accredit one author’s use of a character to a different author. If one author were attempting to pass his literary characters off as those of another writer, or causing general consumer confusion regarding who is behind a certain literary work, the original author would have a remedy in trademark and unfair-competition law.⁹⁸ However, once one author creates the market for a certain kind of character, copyright law should provide the same measure of limited control over that market that it gives an author over the character idea itself.

As the duration of copyright protection continues to expand, limited recognition for literary characters also ensures that free expression is not suppressed. In *Eldred v. Ashcroft*, the Supreme Court recently held the expansive twenty-year extension of copyright terms under the Copyright Term Extension Act was not a violation of the constitutional requirement that intellectual property rights only last for “limited times.”⁹⁹ The Court reasoned that the idea/expression dichotomy and the fair use doctrine act as “built-in First Amendment accommodations” within copyright law.¹⁰⁰ As the public domain continues to shrink in response to pressure from existing copyright holders, these copyright safeguards must be maintained to ensure there is still freedom for artists to make new contributions without fear of infringement lawsuits. Setting stringent standards for the independent copyright of literary characters will promote these principles by leaving the component ideas of a literary work in the public domain for new authors to build upon.

97. See Aaron Schwabach, *The Harry Potter Lexicon and the World of Fandom: Fan Fiction, Outsider Works, and Copyright*, 70 U. PITT. L. REV. 387 (2009); Debora Halbert, *Mass Culture and the Culture of the Masses: A Manifesto for User-Generated Rights*, 11 VAND. J. ENT. & TECH. L. 921 (2009).

98. See Kurtz, *supra* note 6, at 474–506 (discussing various case examples in which Trademark and Unfair Competition laws have protected characters from appropriation).

99. *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

100. *Id.* at 219.

V. ADVANTAGES OF THE “STORY BEING TOLD” TEST

The Ninth Circuit’s development of the “story being told” test illustrates how context can be incorporated in the determination of copyright protection for literary characters. Rather than attempting to isolate a character and consider its development independent from the greater development of the story, this approach requires a court to consider them together. When a character’s role in a particular literary work is so dominant that it embodies the development of the story, only then is independent protection warranted.¹⁰¹ The “story being told” test provides a reliable model that courts can apply in both the determination of whether a character should be protected and the subsequent substantial similarity analysis for infringement claims. This approach maintains the focus on the entire “literary work,” leaving the building blocks free for future authors to use in accordance with the idea/expression dichotomy and copyright law’s underlying goal of artistic progress.

Critics have argued that the “story being told” test makes it very difficult to grant independent protection for a literary character,¹⁰² but a higher standard does not equal a flawed standard. The very fact that characters have been expressly excluded from categorical copyright protection illustrates that a story’s characters were not intended to have protection outside the literary work in most circumstances. Professor Nimmer argues that this standard “seems to envisage a ‘story’ devoid of plot, wherein character study constitutes all, or substantially all, of the work.”¹⁰³ He continues that there would only be “rare examples” of such a character, concluding that this would effectively exclude all literary characters from independent protection.¹⁰⁴ However, the application of this test in the Ninth Circuit illustrates that this is not an insurmountable standard to satisfy. As the court stated in *Warner Bros.*, a character must be more than a “chessman” or a “vehicle[.]” for the story.¹⁰⁵ This conceptual basis provides a far more accessible model than that left by Judge Learned Hand’s elusive contention that a character must be somehow sufficiently “developed” for protection. There are many scenarios in which literary characters will sufficiently constitute the story in which they appear.

101. See *Warner Bros. Pictures, Inc. v. Columbia Broad. Sys., Inc.*, 216 F.2d 945 (9th Cir. 1954).

102. See NIMMER & NIMMER, *supra* note 8.

103. *Id.*

104. *Id.*

105. *Warner Bros.*, 216 F.2d at 950.

The James Bond example illustrates how a well-known, primary character can satisfy the “story being told” test.¹⁰⁶ In *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co.*, the producer of several James Bond films brought an infringement claim against Honda’s use of a Bond-like character in one of its car commercials.¹⁰⁷ The commercial in question featured a debonair, tuxedo-clad man driving a sports car with a glamorous woman while they are being chased by a helicopter and a menacing villain.¹⁰⁸ The court starts its analysis by outlining the several Bond character traits discussed earlier, traits that have been developed over the many books and films that he has appeared in.¹⁰⁹ This initial identification of the character is quite similar to how courts begin the “distinctly delineated” test. However, after identifying the superficial traits of the Bond character, the court goes on to evaluate his role in the greater works he has appeared in and how that context further defines the character.¹¹⁰ The court notes how the character is often presented in a dangerous chase setting, flirting with women, and using witty dialogue.¹¹¹ These contextual story elements influence how the character relates to the story and ultimately become part of the character as he is conceived in the minds of readers and viewers. Concluding that Bond is the actual “story being told,” the court reasons that “audiences do not watch Tarzan, Superman, Sherlock Holmes, or James Bond for the story, they watch these films to see their heroes at work. A James Bond film without James Bond is *not* a James Bond film.”¹¹² This practical, common-sense approach illustrates that famous and dominant characters, especially those developed through a series of progressive depictions, are more likely to pass the “story being told” test. Much like a Hollywood “star vehicle,” characters in these situations are not vehicles to tell the story; the story is a vehicle to showcase the famous character.

Famous and repeatedly portrayed characters are not the only ones that satisfy the “story being told” test. In *Bach v. Forever Living Products*, the author of the children’s book “Jonathan Livingston Seagull” brought an infringement claim against a beauty product company’s use of the title character and his story in its advertising, promotional, and training materials.¹¹³ The story is a little-known tale of an ambitious, anthropomorphic

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

107. *Id.*

108. *Id.* at 1292.

109. *Id.* at 1296.

110. *Id.* at 1297–98.

111. *Id.* at 1298.

112. *Id.* at 1296.

113. *Bach v. Forever Living Prods. U.S., Inc.*, 473 F. Supp. 2d 1127, 1129 (W.D. Wash. 2007).

seagull, and the defendants not only used an identically named seagull as their logo, they explicitly summarized and used the story of the character's arduous rise to greatness as an allegory for how the business sought to operate.¹¹⁴ Despite the character's relative obscurity, the court found the character satisfied the "story being told" test and was therefore entitled to protection from infringement, even infringement in such a different form of media.¹¹⁵ As the court states, "He is the title character in a book that is entirely about *his* development from an ordinary seagull to an extraordinary one."¹¹⁶ The court follows a comprehensive approach to the character, looking to how it is related to the plot, setting, and other characters of the story.¹¹⁷ Finding that so many aspects of the literary work are closely tied to the Jonathan Livingston Seagull character, the court concluded that he was entitled to independent protection.¹¹⁸ Therefore, a character does not have to be as famous or repeatedly portrayed as James Bond to constitute the "story being told."

The "story being told" test can also be applied to prohibit the unauthorized use of a greater ensemble of characters that accompany a primary character. In *Anderson v. Stallone*, a writer sought copyright protection for a screenplay that he had written using Rocky Balboa, Adrian Balboa, Apollo Creed, and Paulie Pennino, in the hopes that the story would be used as the fourth installment of the "Rocky" film franchise.¹¹⁹ Since the writer did not have permission to use these characters, the court found the screenplay to be an unauthorized derivative work that was not entitled to protection because of the pervasive use of these "central" characters.¹²⁰ In reaching its conclusion, the court determined the characters satisfied the "story being told" test because the three prior "Rocky movies focused on the development and relationships of the various characters. The movies did not revolve around intricate plots or story lines."¹²¹ The court did not need to "reach the issue of whether any single character alone, apart from Rocky," would be entitled to independent protection.¹²² Few viewers of the "Rocky" films would be likely to argue that any of the supporting characters constitute the "story" of Rocky by themselves, but when these support-

114. *Id.*

115. *Id.* at 1136.

116. *Id.*

117. *Id.*

118. *Id.*

119. *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431, at *1 (C.D. Cal. Apr. 25, 1989).

120. *Id.* at *8.

121. *Id.*

122. *Id.*

ing characters accompany Rocky, it is far easier for courts to identify the “story being told” within that ensemble. When this group of characters is transplanted together in a new work, substantial similarity between the two works will often be an easy conclusion to reach. The supporting characters act as contextual support for the primary character, and the more context that is borrowed along with the primary character, the more likely there will be infringement between the two overall stories.

The *Anderson* court’s flexibility to provide protection for a pair or ensemble of characters within the “story being told” test illustrates an important evolution of the standard from its original conception. In the original *Warner Bros.* case, Sam Spade was reproduced by the author along with other characters from “The Maltese Falcon.”¹²³ The court brushes over this fact, but there is an important difference between declining to find one character constitutes the story being told and finding that no combination of characters could. This recognition is necessary to maintain the focus on the entire work and what elements sufficiently compose the “story being told.”

In *Olson v. National Broadcasting Co.*, the Ninth Circuit faced a claim of infringement that addressed alleged ensemble character infringement more directly.¹²⁴ In that case, the author of an adventure television pilot brought an infringement claim against the television series “The A-Team.”¹²⁵ The court declined to find infringement due to the minimal similarity between the plot and setting, as well as the mere “loose correspondences among the characters of the two works.”¹²⁶ The court noted that the *Warner Bros.* decision declined to give protection to the Sam Spade group of characters, but the decision does not specifically address whether the “A-Team” characters may together constitute the “story being told.”¹²⁷ The *Anderson* and *Olson* decisions reflect a movement towards the collective analysis of characters and an important step towards recognizing protection for ensembles which embody the greater “story,” however many characters that may take to compose. This approach will protect authors from the appropriation of groups of characters that may not be entitled to protection individually, yet ultimately constitute the “story being told” when they are together. It will also allow more peripheral characters, such as Clubber Lang from “Rocky III” or B.A. Baracus from “The A-Team,” to enter the public domain for future authors to portray in new stories independently

123. *Warner Bros. Pictures, Inc. v. Columbia Broad. Sys., Inc.*, 216 F.2d 945, 948 (9th Cir. 1954).

124. *Olson v. Nat’l Broad. Co.*, 855 F.2d 1446 (9th Cir. 1988).

125. *Id.*

126. *Id.* at 1451.

127. *Id.* at 1453.

from their original ensembles, rather than remaining unutilized and locked in copyright.

By removing the highly subjective initial inquiry of how “developed” a character is, the Ninth Circuit’s approach allows courts to focus on the big picture of the literary work, rather than a catalog of character traits that appear within it. A standard that asks courts to protect characters at a level below the “story being told” is bound to pick apart abstract elements of an author’s written expression. Lists that rely on superficial similarities are unreliable and misleading when trying to gauge how a character is ultimately conceived by a reader.¹²⁸ The *Olson* court even noted the futile nature of infringement claims “based upon comparisons as tenuous as those concerning the tennis shoes worn by characters in the two works.”¹²⁹ The court decisions analyzing James Bond and Jonathan Livingston Seagull did not stop their determination of independent protection with a listing of character traits, they went on to consider how important those character traits are to the overall literary works. All fictional characters, especially those portrayed in “word portraits,” need the story to exist, but protection should be limited to those characters which are essential for the story to exist.

Once independent protection has been granted, the “story being told” test complements the analysis of copyright infringement by asking whether there is substantial similarity between the stories, not just the characters. The Ninth Circuit employs a two-part test to determine whether one work is substantially similar to another.¹³⁰ The first step, or “extrinsic test,” is an objective comparison of “virtually every element that may be considered concrete in a literary work,” such as the plot, themes, dialogue, mood, setting, pace, and characters in the two works.¹³¹ When these concrete elements are all closely tied to one character, there is obviously a strong likelihood of character infringement. The second step of the analysis, or the “intrinsic test,” is a subjective assessment of whether an “ordinary, reasonable audience” would find the works substantially similar in “total concept and feel.”¹³² The mechanics of this substantial similarity analysis are practically identical to the substantial similarity test employed by the Second Circuit, yet it works with the test for character copyright protection in a

128. See *Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984) (observing the unreliability of lists which rely on random similarities).

129. *Olson*, 855 F.2d at 1450 n.3.

130. *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002).

131. *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990).

132. *Cavalier*, 297 F.3d at 822 (quoting *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994)).

much different way. Because the “distinctly delineated” test isolates a character from the story, it conflicts with the substantial similarity analysis and results in a comparison of only the characters involved, thus neglecting to compare the overall impression of the stories they appear in. The “story being told” test, on the other hand, is basically asking the same questions as the substantial similarity analysis. Under the “story being told” test, a finding of substantial similarity between the characters is equivalent to substantial similarity between the stories.

The court’s finding of character infringement in the James Bond case illustrates this harmony between the “story being told” test and the substantial similarity analysis. Once the character’s relationship to the story is used to grant independent protection, those same contextual elements are used in the comparison of the allegedly infringing character. The court first notes that Bond and the Honda commercial character are “similar in the way they look and act—both heros [sic] are young, tuxedo-clad, British-looking men with beautiful women in tow and grotesque villains close at hand; moreover, both men exude uncanny calm under pressure, exhibit a dry sense of humor and wit, and . . . are attractive.”¹³³ The court focuses on the similarity between both the personal traits of the two characters and the similarity between the supporting characters, plot, setting, and theme which frame the two in their respective stories.¹³⁴ It is not enough to have a character in a tuxedo, or even a British spy character, but the car-chase setting, the evil villain in pursuit, and the witty, flirtatious dialogue between the protagonist and his female companion all work together to produce the substantial similarity between the characters. The court grants the injunction against the Honda commercial and finds it a likely character infringement because it is essentially an overall James Bond story in abbreviated form.

This harmonization of the “story being told” test with the substantial similarity analysis also allows for a dominant character, worthy of independent copyright protection, to be used freely by other authors in dissimilar stories. As discussed earlier, an author may choose to place a James Bond character in a romantic comedy, a court-room drama, or a mundane office story and it would likely vary from a traditional James Bond story in many contextual elements and the overall “concept and feel.” Even if the author is not intending to make a parody, whether he is building off the idea of a character or explicitly attempting to remind the reader of that

133. *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1298 (C.D. Cal. 1995).

134. *Id.*

character, the resulting creative expression is new and different, furthering the ultimate copyright goal of artistic progress.

One significant illustration of such a situation comes from the contemporary use of Sherlock Holmes, a famous literary character noted by many as the model candidate for protection under the “story being told” test.¹³⁵ Sherlock Holmes was created by Sir Arthur Conan Doyle in the late nineteenth century and has enjoyed great popularity and notoriety since then.¹³⁶ As first portrayed, he is a highly inquisitive, anti-social, and drug-addicted detective who uses his powers of observation and deduction to solve crimes alongside his trusted companion, Watson, in Victorian-Era London. There have been many modern adaptations of Sherlock Holmes that follow this traditional story form, including the recent 2009 film “Sherlock Holmes.” The character has also been explicitly cited as the inspiration for the protagonist in the medical television series “House” by the show’s creator.¹³⁷ Dr. Gregory House, played by Hugh Laurie, shares many character traits with Holmes, including the detached anti-social nature, the keen observation skills, the methodical approach to every situation as a puzzle to solve, the drug addiction, and the dependence on a trusted companion. Even the name “House” was created as a “phonetic homage” to Sherlock Holmes.¹³⁸ Even with all these similarities, Dr. House’s role as a doctor in a modern American setting produces a significantly different artistic “concept and feel” than the original Holmes stories. Since Sherlock Holmes is now in the public domain, the creators of “House” do not need to fear a character infringement suit. However, with the ever-growing length of copyright durations and the shrinking public domain, new stories like this are increasingly threatened by the over-protection of character copyrights. By permitting such uses of characters in new and original stories, the “story being told” test furthers copyright law’s goal of promoting new artistic works, while protecting the actual expression embodied in authors’ existing literary works.

CONCLUSION

As one commentator stated, “The art of storytelling has been around for thousands of years. And for thousands of years storytellers have been using the characters in stories they hear to create new stories.”¹³⁹ Copyright

135. See Kurtz, *supra* note 6, at 465.

136. Sherlock Holmes first appeared in 1887, in Sir Arthur Conan Doyle’s “A Study in Scarlet.”

137. See David Mermelstein, *Gems, Jerks Infiltrate Primetime*, VARIETY (June 15, 2005), <http://www.variety.com/article/VR1117924498?refCatId=1945>.

138. *Id.*

139. JULIE E. COHEN ET AL., COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 287 (2d ed. 2006).

law is designed to incentivize this process of artistic creation, but providing expansive copyright protection for characters impairs far more creation than it encourages. The inconsistent protection courts currently give literary characters requires a solution that advances the underlying copyright goal of artistic progress. The “story being told” test complements the traditional infringement analysis, thus ensuring authors retain control over their existing expression, while providing freedom for new authors to build upon those stories and ideas in the creation of new literary works.

