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Samantha S. Peaslee

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# IS THERE A PLACE FOR US?: PROTECTING FAN FICTION IN THE UNITED STATES AND JAPAN

Samantha S. Peaslee\*

## I. INTRODUCTION

Susan sits down at her computer, a stack of her favorite books next to her, and begins to write. Dumbledore<sup>1</sup> and Gandalf<sup>2</sup> are sitting calmly in the Leaky Cauldron,<sup>3</sup> wondering about the mysterious stranger that called them there. As they wait, Captain Kirk,<sup>4</sup> Professor X,<sup>5</sup> and George Clooney<sup>6</sup> join them at the table,

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\* Samantha Peaslee is a J.D. Candidate at the University of Denver's Sturm College of Law and M.A. in International Studies Candidate at the University of Denver's Josef Korbel School of International Studies. She would like to thank Professor Alan Blakley, Alex Jennings, Cheyenne Moore, and Alicia Guber for their editorial assistance and Professor K.K. DuVivier for her support and mentoring. She would also like to thank Andy, her friends, and her family for putting up with her prattling about fan fiction as well as for helping her "research."

1. Dumbledore is a character in J.K. Rowling's Harry Potter series. This series is the most popular to turn into fan fiction on Fanfiction.net, with 676,000 stories. *Books Harry Potter*, FANFICTION.NET, <https://www.fanfiction.net/book/Harry-Potter/> (last visited Nov. 8, 2014).

2. Gandalf is a character created by J.R.R. Tolkien. He appears in the Lord of the Rings series and the Hobbit. These two have a combined 57,200 fan fictions on Fanfiction.net. *Books Lord of the Rings*, FANFICTION.NET, <https://www.fanfiction.net/book/Lord-of-the-Rings/> (last visited Nov. 8, 2014); *Books Hobbit*, FANFICTION.NET, <https://www.fanfiction.net/book/Hobbit/> (last visited Nov. 8, 2014).

3. The Leaky Cauldron is a pub in J.K. Rowling's Harry Potter series.

4. Captain Kirk is a character in the Star Trek series. He appears in both new Star Trek films, as well as many of the series. The Star Trek universe has a combined 56,200 fan fictions on Fanfiction.net. *Movies Star Trek: 2009*, FANFICTION.NET, <https://www.fanfiction.net/movie/Star-Trek-2009/> (last visited Nov. 8, 2014); *TV Shows StarTrek: Deep Space Nine*, FANFICTION.NET, <https://www.fanfiction.net/tv/StarTrek-Deep-Space-Nine/> (last visited Nov. 8, 2014); *TV Shows StarTrek: Enterprise*, FANFICTION.NET, <https://www.fanfiction.net/tv/StarTrek-Enterprise/> (last visited Nov. 8, 2014); *TV Shows StarTrek: Other*, FANFICTION.NET, <https://www.fanfiction.net/tv/StarTrek-Other/> (last visited Nov. 8, 2014); *TV Shows StarTrek: The Next Generation*, FANFICTION.NET, <https://www.fanfiction.net/tv/StarTrek-The-Next-Generation/> (last visited Nov. 8, 2014); *TV Shows StarTrek: The Original Series*, FANFICTION.NET, <https://www.fanfiction.net/tv/StarTrek-The-Original-Series/> (last visited Nov. 8, 2014); *TV Shows StarTrek: Voyager*, FANFICTION.NET, <https://www.fanfiction.net/tv/StarTrek-Voyager/> (last visited Nov. 8, 2014).

5. Professor X is a character in Marvel's X-Men series. X-Men has a total of 27,800 fan fictions between the comics and the movies on Fanfiction.net. *Comics X-Men*, FANFICTION.NET, <https://www.fanfiction.net/comic/X-men/> (last visited Nov. 8, 2014); *Movies X-Men: The Movie*, FANFICTION.NET, <https://www.fanfiction.net/movie/X-Men-The-Movie/> (last visited Nov. 8, 2014); *Movies X-Men*, FANFICTION.NET, <https://www.fanfiction.net/movie/x-men/> (last visited Nov. 8, 2014).

all with the same mysterious note, calling them together to ask them for help. Suddenly, a tall, beautiful woman walks into the Leaky Cauldron with a more normal-looking girl next to her, looking distraught. The beautiful woman introduces herself as Mary Sue, and then announces dramatically that she and her friend need the help of these men to save the world.

Hypothetical Susan is one of thousands of fans who write fan fiction. Although fan fiction is not a new phenomenon,<sup>7</sup> the Internet has made writing and reading fan fiction more accessible and popular.<sup>8</sup> Now, certain databases are devoted exclusively to fan-written works that reimagine books, movies, television shows, comics, and even real people.<sup>9</sup>

With the overwhelming number of fan fiction written and posted on the Internet, the owners of the original works cannot help but take notice. With the rise of Internet fan fiction came the simultaneous rise of cease and desist letters to fans and website operators.<sup>10</sup> A small minority of owners, such as Anne Rice,

6. George Clooney is an actor, director, and producer. He is the subject of 17 stories on Fanfiction.net. *Story George Clooney*, FANFICTION.NET, <https://www.fanfiction.net/search.php?keywords=george+clooney&ready=1&type=story> (last visited Nov. 8, 2014).

7. *Wide Sargasso Sea* was a 1966 novel that retold *Jane Eyre* from the viewpoint of Rochester's mad wife Bertha. See *Wide Sargasso Sea (Penguin Modern Classics)*, AMAZON.CO.UK, [http://www.amazon.co.uk/gp/product/0141182857/ref=as\\_li\\_ss\\_tl?ie=UTF8&camp=1634&creative=19450&creativeASIN=0141182857&linkCode=as2&tag=thesolipsocia-21](http://www.amazon.co.uk/gp/product/0141182857/ref=as_li_ss_tl?ie=UTF8&camp=1634&creative=19450&creativeASIN=0141182857&linkCode=as2&tag=thesolipsocia-21) (last visited Sept. 21, 2014) (describing *Wide Sargasso Sea* as Jean Rhys's "grand attempt to tell what she felt was the story of *Jane Eyre*'s 'madwoman in the attic,' Bertha Rochester"). *Rosencrantz and Guildenstern are Dead* is a play based on Shakespeare's *Hamlet* from the viewpoint of two minor characters. See *Rosencrantz and Guildenstern are Dead*, AMAZON.COM, [http://www.amazon.com/Rosencrantz-Guildenstern-Are-Dead-Stoppard/dp/0802132758/ref=sr\\_1\\_1?ie=UTF8&qid=1411357706&sr=8-1&keywords=rosencrantz+and+guildenstern+are+dead](http://www.amazon.com/Rosencrantz-Guildenstern-Are-Dead-Stoppard/dp/0802132758/ref=sr_1_1?ie=UTF8&qid=1411357706&sr=8-1&keywords=rosencrantz+and+guildenstern+are+dead) (last visited Sept. 21, 2014) (describing *Rosencrantz and Guildenstern are Dead* as "the fabulously inventive tale of *Hamlet* as told from the worm's-eye view of the bewildered Rosencrantz and Guildenstern, two minor characters in Shakespeare's play"). Star Trek fanzines were common throughout the 1990s, providing a place for Trekkies to disseminate their fan fiction. See *FanZines: Introduction*, STAR TREK FANZINES, <http://www.stos.net/stos/eng/zines.php> (last visited Sept. 21, 2014). See also Michelle Chatelain, *Harry Potter and the Prisoner of Copyright Law: Fan Fiction, Derivative Works, and the Fair Use Doctrine*, 15 TUL. J. TECH. & INTELL. PROP. 199, 199-200 (2012); Meredith McCordle, *Fan Fiction, Fandom, and Fanfare: What's all the Fuss?*, 9 B.U. J. SCI. & TECH. L. 433, 441 (2003).

8. Chatelain, *supra* note 7, at 200; Anupam Chander & Madhavi Sunder, *Everyone's a Superhero: A Cultural Theory of 'Mary Sue' Fanfiction as Fair Use*, 95 CAL. L. REV. 597, 600 (2007); Ernest Chua, *Fan Fiction and Copyright: Mutually Exclusive, Coexistent or Something Else? Considering Fan Fiction in Relation to the Economic/Utilitarian Theory of Copyright*, 14 MURDOCH U. E LAW J. 215, 215 (2007).

9. Chatelain, *supra* note 7, at 200 (providing the example of Fanfiction as one of the databases). See FANFICTION, <http://www.fanfiction.net> (last visited May 12, 2014) (linking to millions of fan fiction stories in nine categories). See generally, HARRY POTTER FANFICTION, [www.harrypotterfanfiction.com](http://www.harrypotterfanfiction.com) (last visited May 12, 2014) (providing fan fiction that is exclusively for Harry Potter fan fiction and contains over 80,000 stories); ONE DIRECTION FANFICTION, <http://onedirectionfanfiction.com> (last visited May 12, 2014) (providing a site devoted to fan fiction about the pop band One Direction; it contains over 48,000 stories).

10. McCordle, *supra* note 7, at 441.

expressly forbids fiction based on their works, going to the extent of sending regular cease-and-desist letters to the managers of fan fiction databases as well as authors.<sup>11</sup> Overall, these cease and desist letters do not seem to curb the increased popularity of fan fiction, nor have they led to any court cases.<sup>12</sup> Some owners choose to forbid only select fan fiction, such as homosexual depictions of heterosexual characters, commercial fan fiction, or fan fiction that strictly copies large portions of works.<sup>13</sup> Other owners of original works have either explicitly or implicitly approved fan fiction.<sup>14</sup> J.K. Rowling, for example, has generally tolerated non-commercial and web-based fan fiction based on her characters.<sup>15</sup> Paramount, which owns the Star Trek franchise, ultimately decided not to pursue legal action against fan-writers, even when it does not approve of the fan fiction.<sup>16</sup>

Owners of original novels, television stories, or movies (“rights owners” or “owners”) are adamant against fan fiction because it is almost certainly a violation of an owner’s intellectual property rights. However, Internet fan fiction raises unique issues for these owners. Despite most intellectual property rights being territorially bound, activities on the Internet generally are not. When the original work is from one country, the fan-writer in another, and the fan fiction is on the Internet, it creates a unique conundrum for both the rights owners and the fan-writers in attempting to determine the legality of the fan-writers’ actions and each party’s respective rights. This difference is made especially poignant when the countries involved are civil and common law nations.<sup>17</sup>

This paper will take the hypothetical case from the first paragraph of this paper and attempt to determine what would happen if any of the rights owners sued Susan under either U.S. or Japanese intellectual property law. As the two countries

11. Chander & Sunder, *supra* note 8, at 618; Chatelain, *supra* note 7, at 201. Anne Rice’s site includes an “important message” on fan fiction: “I do not allow fan fiction. The characters are copyrighted. It upsets me terribly to even think about fan fiction with my characters. I advise my readers to write your own original stories with your own characters. It is absolutely essential that you respect my wishes.” *Anne’s Messages to Fans*, ANNERICE.COM, <http://annerice.com/ReaderInteraction-MessagesToFans.html> (last visited Sept. 14, 2014).

12. Chander & Sunder, *supra* note 8, at 618; Chatelain, *supra* note 9, at 201.

13. Tiffany Lee, *Fan Activities from P2P File Sharing to Fansubs and Fan Fiction: Motivations, Policy Concerns and Recommendations*, 14 TEX. REV. ENT. & SPORTS L. 181, 183, 185 (2013) (providing the example that Paramount does not allow strict copying of its works). See also *Paramount Pictures Corp. v. Carol Publ’g. Grp.*, 11 F. Supp. 2d 329, 333 (S.D.N.Y. 1998). See also McCardle, *supra* note 7, at 441 (explaining Lucasfilms is well known for having sent a cease-and-desist letter to a fanzine that published pornographic fan fiction of Star Wars.).

14. McCardle, *supra* note 7, at 449-50; Lee, *supra* note 13, at 184.

15. Chander & Sunder, *supra* note 8, at 611; Darren Waters, *Rowling Backs Potter Fan Fiction*, BBC NEWS, <http://news.bbc.co.uk/2/hi/entertainment/3753001.stm> (last updated May 27, 2004, 12:11 PM).

16. Chander & Sunder, *supra* note 8, at 611. The first clash between fan fiction authors and copyright owners occurred in June 1977 when Paramount sent a cease and desist letter to a Star Trek fanzine, but then dropped the case when it learned the fanzine was not a professional publication. McCardle, *supra* note 7, at 441.

17. Robert C. Bird & Lucille M. Ponte, *Protecting Moral Rights in the United States and the United Kingdom: Challenges and Opportunities under the U.K.’s New Performances Regulations*, 24 B.U. INT’L L.J. 213, 213 (2006).

that are arguably the largest producers of fan fiction,<sup>18</sup> as well as two examples of different cultural and legal mentalities in regards to intellectual property, examining the reactions of these two states may have very real impacts on fans and rights owners in the future.

Part II will define types of fan fiction before Part III discusses the choice of law analysis in which rights owners must engage before determining whether to apply U.S. or Japanese intellectual property law. The next three sections will go through the intellectual property laws in both the United States and Japan as they apply to potential issues raised by fan fiction: Part IV will discuss copyright law, Part V will discuss trademark law, and Part VI will discuss moral rights. The conclusion will suggest the best ways for each country to legally address fan fiction.

## II. WHAT IS FAN FICTION?

Fan fiction cannot be considered one cohesive category. Meredith McCardle points out that “the various forms fan fiction can take are wildly different and do not lend themselves to orderly classification.”<sup>19</sup> Even within sub-classifications of fan fiction, individual characteristics may distinguish one particular story from another, making it more or less infringing. This section will outline the basics of fan fiction that are necessary to understand the legal distinctions throughout this paper.

### A. Basic Fan Fiction

Fan works are a general category that includes any creation of a fan based upon an identifiable segment of popular culture.<sup>20</sup> These include fan art (fan depictions of original characters or settings),<sup>21</sup> fan videos (as simple as music video montages or as complicated as full reenactments of popular movies or stories),<sup>22</sup> and fan subs (fan-translated videos that were originally in a language different from that of the target fan audience).<sup>23</sup>

Professor Rebecca Tushnet has defined fan fiction as “any kind of written creativity that is based on an identifiable segment of popular culture, such as a

18. Actual statistics of how much fan fiction each country produces are currently unavailable.

19. McCardle, *supra* note 7, at 437. Meredith McCardle is a particularly intriguing source on the legal aspects of fan fiction as she is a former attorney who is now a young adult fiction author.

20. Rebecca Tushnet, *Legal Fictions: Copyright, Fan Fiction and a New Common Law*, 17 LOY. L.A. ENT. L. J. 651, 655 (1997).

21. *See, e.g.*, DEVIANTART, <http://www.deviantart.com/browse/all/fanart/> (last visited May 14, 2014).

22. *See, e.g.*, *A New Hope: Uncut*, STAR WARS UNCUT, <http://www.starwarsuncut.com/newhope> (last visited Sept. 21, 2014) (a compilation of fan videos of Star Wars Episode IV: A New Hope).

23. *See, e.g.*, DOKI FANSUBS, [doki.co](http://doki.co) (last visited Sept. 21, 2014). *See generally* Sean Kirkpatrick, *Like Holding a Bird: What the Prevalence of Fansubbing can Teach us about the use of Strategic Selective Copyright Enforcement*, 21 TEMP. ENVTL. L. & TECH. J. 131 (2003).

television show, and not produced as ‘professional’ writing.”<sup>24</sup> Others have defined fan fiction as “fiction written by a fan for the Internet about a person, fictional character, or universe of which the person is a fan.”<sup>25</sup> The Oxford English Dictionary (“OED”) defines it as “fiction written by a fan of, and featuring characters from, a particular TV series, movie, etc.”<sup>26</sup> This paper will use the OED definition, as it includes both commercial and non-commercial aspects, while Professor Tushnet’s definition limits fan fiction to those works written only for non-commercial reasons.

All fan fiction builds some sort of new story from the original.<sup>27</sup> Some of the simplest fan fiction fills in narrative gaps in the source material or conveys the source material from the viewpoint of a different character.<sup>28</sup> A Harry Potter novel told from Hermione’s perspective would fit into this category. Other times, the fan fiction will act as a prequel or sequel.<sup>29</sup> Fan fiction about James Potter (Harry’s father) or Harry’s children would fall into this category. Alternate universe fan fiction is another popular category. In alternate universe fan fiction, the characters from canon are presented in an environment very different to the original, such as moving Harry Potter to the United States or India.<sup>30</sup> Crossover fan fiction is also very popular; Susan’s story in the introduction is an example of crossover fiction. Crossover fiction is when the characters, storylines, or settings from multiple canons are combined in a single fan work.<sup>31</sup>

One popular reason for creating fan fiction is to create relationships (called “shipping”) between characters. When the fan work involves a heterosexual relationship between two characters that may or may not be romantically linked in the original, the work is called gen/het (general/heterosexual) fan fiction.<sup>32</sup> If Harry and Hermione fall in love in a fan fiction story, that is gen/het fiction. All of these genres of fan fiction are generally inoffensive to owners (as long as the works are not for profit).

24. Tushnet, *supra* note 20, at 655. Professor Tushnet has written a number of works on fan fiction and the law, but also on intellectual property law in general. See also McCardle, *supra* note 7, at 434; Chua, *supra* note 8, at 216.

25. Christina Z. Ranon, *Honor Among Thieves: Copyright Infringement in Internet Fandom*, 8 VAND. J. ENT. & TECH. L. 421, 422 (2006).

26. *Fan fiction*, OXFORD DICTIONARIES, [http://www.oxforddictionaries.com/us/definition/american\\_english/fan-fiction](http://www.oxforddictionaries.com/us/definition/american_english/fan-fiction) (last visited May 14, 2014).

27. Chatelain, *supra* note 7, at 200-01.

28. *Id.*

29. *Id.* at 201.

30. McCardle, *supra* note 7, at 436. See also ‘Potter in Calcutta’ Banned, BBC NEWS (Apr. 30, 2003), [http://news.bbc.co.uk/2/hi/south\\_asia/2988673.stm](http://news.bbc.co.uk/2/hi/south_asia/2988673.stm).

31. Chatelain, *supra* note 7, at 201. See, e.g., *Book Crossovers FanFiction*, FANFICTION.NET, <http://www.fanfiction.net/crossovers/book/> (last visited May 12, 2014).

32. McCardle, *supra* note 7, at 436.

### B. *Slash Fiction*

The other type of relationship-based fan fiction is “slash” fiction. Slash fiction features two characters that are usually heterosexual in canon engaged in a homosexual relationship.<sup>33</sup> This type of fan fiction is responsible for most of the ire from otherwise tolerant intellectual property owners. Part of this is because slash fiction carries with it “a slough of misconceptions.”<sup>34</sup> The key misconception is that slash fiction is pornography under another name.<sup>35</sup> Most slash fiction, however, centers on the relationship itself, not the sexual relationship between the two characters.<sup>36</sup> One example of slash fiction would be if, in Susan’s story, Gandalf and Dumbledore fell in love and got married. While many rights owners do not perceive slash as harmful, some consider this a perversion of their original characters.<sup>37</sup>

### C. *Mary Sue*

Original character fan fiction is common as well. Original character fan fiction involves inserting a new, fan-invented character into the owner’s plot. Susan’s fan fiction has two original characters: Mary Sue and her friend. But while the friend is a generic original character, generally considered harmless and occasionally necessary to the plot, Mary Sue is “the much loathed and widely ridiculed ‘Mary Sue.’”<sup>38</sup>

Mary Sue originally referred to a character created by Trekkie Paula Smith in her fan fiction—the first woman to control a Star Trek spaceship.<sup>39</sup> While some scholars view Mary Sue as a social commentary character, fans often view her with more scorn.<sup>40</sup> Mary Sue has come to stand for an author inserting oneself into a story, but as a character who is “typically perfect in nearly every way imaginable. Beautiful, intelligent, and quick-witted, these characters usually come equipped with a certain disregard for rules and normally wind up stealing the heart of a main canon character.”<sup>41</sup> In Susan’s fan fiction, “Mary Sue” likely represents Susan’s perception of what she would like to be, while the friend may be a more realistic version of Susan herself or just a necessary extra. Most of fandom is scornful of the Mary Sue, yet she is still the most easily identifiable character in fan fiction.<sup>42</sup>

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33. *Id.*

34. *Id.* at 443.

35. *Id.* Another misconception is common in China, where the belief reins that writing and reading slash fiction “promotes homosexuality.” Aja Romano, *For Young Women in China, Slash Fiction is a Dangerous Hobby*, DAILY DOT (Apr. 18, 2014), [http://www.dailydot.com/geek/in-china-20-people-women-arrested-for-writing-slash/\(explaining that as a result of this belief, authorities have arrested some young twenty-year-olds for writing slash fiction\)](http://www.dailydot.com/geek/in-china-20-people-women-arrested-for-writing-slash/(explaining%20that%20as%20a%20result%20of%20this%20belief,%20authorities%20have%20arrested%20some%20young%20twenty-year-olds%20for%20writing%20slash%20fiction)).

36. McCardle, *supra* note 7, at 443.

37. *Id.* at 464.

38. *Id.* at 436.

39. Chander & Sunder, *supra* note 8, at 597.

40. *Id.* at 608.

41. McCardle, *supra* note 7, at 436.

42. *Id.* at 437.

#### D. Doujinshi

While some might believe that *doujinshi* (sometimes transliterated as *dojinshi*) is merely the Japanese word for fan fiction, it has developed into its own category. *Doujinshi* “traditionally refers to works such as poetry or short stories for distribution within a specific association or society,”<sup>43</sup> but currently is understood to mean “manga or anime featuring characters not originally created by the author.”<sup>44</sup> The distinguishing feature of *doujinshi*, besides it now being specific to manga and anime, is that fans typically sell their *doujinshi* at special conventions.<sup>45</sup> While regular fan fiction is not necessarily non-profit, very little fan fiction is as inherently commercial as *doujinshi*.

#### E. Real Person Fiction

Real person fiction is a relatively new phenomenon. Now some fan fiction databases have sections for “Celebrities & Real People” or “Music & Bands.”<sup>46</sup> While the volume of these databases is not as substantial as the fan fiction databases, some fan fiction sites designed for single bands or actors are just as extensive as regular fan fiction.<sup>47</sup> While many of these works would not traditionally infringe intellectual property, the broadening scope of trademark law may protect the people who are subjects of these fictions. This article will not discuss real person fiction in depth, nor will it discuss the fate of George Clooney in Susan’s fan fiction, but it is important to note this rising phenomenon in the discussion of fan fiction.

Regardless of the type of fan fiction, all of it could potentially infringe intellectual property rights. Determining whose rights are infringed, how much infringement occurred, the type of infringement, and potential defenses, might be dependent on the type of fan fiction.

### III. CHOICE OF LAW IN FAN FICTION DISPUTES

If an owner of an original work, such as J.K. Rowling, Paramount, or Marvel, discovers Susan’s fan fiction on the Internet and chooses to sue her, the owner would need to first determine the law under which it had a claim. The choice of law can be crucial—it may make a difference as to whether Susan has infringed any rights in the first place or whether she has any defenses under that law. Although some international tactics do govern intellectual property, intellectual

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43. Mariko A. Foster, *Parody’s Precarious Place: The Need to Legally Recognize Parody as Japan’s Cultural Property*, 23 SETON HALL J. SPORTS & ENT. L. 313, 315 (2013); Salil Mehra, *Copyright and Comics in Japan: Does Law Explain Why All the Cartoons My Kid Watches are Japanese Imports?*, 55 RUTGERS L. REV. 155, 164 (2002).

44. Foster, *supra* note 43, at 315. See also Mehra, *supra* note 43, at 164; Kirkpatrick, *supra* note 23, at 147.

45. Kirkpatrick, *supra* note 23, at 147.

46. See, e.g., ARCHIVE OF OUR OWN, archiveofourown.org (go to “Fandoms” drop down menu; then “Celebrities & Real People” and “Music & Bands” hyperlinks) (last visited Mar. 6, 2014).

47. See, e.g., ONE DIRECTION FAN FICTION, <http://onedirectionfanfiction.com> (last visited May 15, 2014) (containing almost 50,000 fan fictions based solely on the band).



property is still a domestic issue, so even if infringement takes place in multiple countries, individual national laws must be used, not international laws.

Choice of law for Internet activities such as fan fiction is more difficult in this territorial system. The Internet allows “[a]cts that potentially violate exclusive copyrights [and other intellectual property rights to] instantaneously and simultaneously occur in several countries.”<sup>48</sup> If the use of a work protected by intellectual property implicates laws of multiple jurisdictions, choice of law determines which rules apply.<sup>49</sup>

Whether a right to be infringed exists is often the easy determination in a case such as Susan’s. The law that applies to the *existence of a right* is the one under which the intellectual property is registered.<sup>50</sup> If the Harry Potter series, Star Trek series, and X-Men series are protected by registered copyright or trademark, the applicable law is any (or all) of the intellectual property laws of the state in which it is protected. The Berne Convention—the international convention on intellectual property—also extends protection to works registered in one signatory state under the laws of other signatories.<sup>51</sup>

The more difficult choice of law issue is what law is applicable to the *infringing act*. Typically, intellectual property choice of law follows a strictly territorial approach,<sup>52</sup> meaning the courts must look to the location of where the alleged acts occurred to decide questions relating to infringement.<sup>53</sup> The Internet makes this strict territorial application difficult.<sup>54</sup> Often, the infringement occurs in multiple places, by way of the Internet, requiring a court to apply the copyright laws of each country in which infringement occurred.<sup>55</sup>

In our example, assume Susan is in Japan. The owners of the protected portions of her work have existing rights wherever their intellectual property is registered—so probably both the United States and Japan. Therefore, either law could apply in determining the existence of intellectual property rights. The next question is which law is applicable to Susan’s infringing acts. Writing fan fiction in Japan potentially infringes the owners’ reproduction and derivative works rights in Japan. Then Susan uploads her fan fiction onto Fanfiction.net. This could infringe upon the authors’ distribution rights—but where? Susan is in Japan, the servers for Fanfiction.net are at an unknown location in the United States,<sup>56</sup> and the

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48. Andreas P. Reindl, *Choosing Law in Cyberspace: Copyright Conflicts on Global Networks*, 19 MICH. J. INT’L L. 799, 800 (1998).

49. *Id.* at 802.

50. *Itar-tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 89 (2d Cir. 1998); AMERICAN LAW INST., *INTELLECTUAL PROP.: PRINCIPLES GOVERNING JURISDICTION, CHOICE OF LAW, AND JUDGMENTS IN TRANSNATIONAL DISPUTES* §301(1)(a) (2008).

51. Berne Convention for the Protection of Literary and Artistic Works, art. 2(6), Sept. 9, 1886, S. TREATY DOC. NO. 99-27, 828 U.N.T.S. 223 (amended Sept. 28, 1979) [hereinafter *Berne Conv.*].

52. Reindl, *supra* note 48, at 803.

53. *Id.*

54. *Id.* at 800.

55. *Id.* at 806.

56. *Terms of Service*, FANFICTION.NET, <http://www.fanfiction.net/tos/> (last updated Mar. 5, 2009).

people who read Susan's fan fiction are in various locations throughout the world. Distribution probably occurs in the location of the server, but an argument could be made that distribution occurs wherever the readers are located. The protected works are then protected wherever they are registered (probably both Japan and the United States), but infringement definitely occurred in Japan, probably occurred in the United States, and may have occurred in even more countries.

Based on this, it is easy to understand why "applying strictly territorial choice of law rules to global digital networks creates formidable problems."<sup>57</sup> Unfortunately, this is still the first hurdle that those seeking to prosecute fan fiction—and possibly even those seeking to protect it—must pass.

Assuming the rights owners have determined the choice of law and find they have multiple options, they may want to consider the cultural implications of the laws under which they would like to sue, as well as the venue in which they would like to bring suit. Comparing the United States and Japan as societies, the United States is generally more litigious.<sup>58</sup> The United States also has extensive discovery processes and strong remedies for rights owners who prove infringement.<sup>59</sup> Moreover, the U.S. legal system emphasizes the economic purposes of intellectual property law which are designed to provide an incentive for people to create.<sup>60</sup> Japan, on the other hand, is a more communicative, less litigious society. The Japanese prefer not to go straight to court, but instead to "first go through the process of conciliation and apology. . . ."<sup>61</sup> Once a suit is filed, no discovery is available and the process is very slow, often resulting in limited or ineffectual damages.<sup>62</sup> Additionally, Japan's intellectual property law emphasizes the importance of intellectual property as cultural property and the creative rights of authors rather than the economic bases for protection.<sup>63</sup> These factors make it more likely that rights owners—who typically want strong remedies and extensive discovery—are more likely to want U.S. law to apply and U.S. courts to hear their claims based on cultural-legal differences alone. Whether the law makes that the better option is a different question.

#### IV. COPYRIGHT AND FAN FICTION

When one thinks of fan fiction, the first category of intellectual property that comes to mind is copyright. The Berne Convention protects "literary and artistic

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57. Reindl, *supra* note 48, at 807.

58. See generally Geoffrey R. Scott, *A Comparative View of Copyright as Cultural Property in Japan and the United States*, 20 TEMP. INT'L & COMP. L.J. 283 (2006).

59. *Id.* at 359.

60. Bird & Ponte, *supra* note 17, at 247; Michael B. Gunlicks, *A Balance of Interests: The Concordance of Copyright Law and Moral Rights in the Worldwide Economy*, 11 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 601, 603 (2001).

61. Kirkpatrick, *supra* note 24, at 149; Lee, *supra* note 13, at 186; Richard V. Burgujian, *Enforcement of Intellectual Property Rights in Japan*, in Robert Bae, *Intellectual Property in the Pacific Rim Countries: Rights and Remedies*, 91 AM. SOC'Y INT'L L. PROC. 395, 397 (1997).

62. Burgujian, *supra* note 61, at 395-97; Kirkpatrick, *supra* note 23, at 149.

63. Foster, *supra* note 43, at 332; Scott, *supra* note 58, at 312.

works”<sup>64</sup> by authors who are nationals of one of the signatories to the Berne Convention.<sup>65</sup> As this category includes books and other writings, dramatic works, and cinematographic works,<sup>66</sup> it encompasses the majority of works on which fan fiction is based. Since both the United States and Japan are signatories to the Berne Convention,<sup>67</sup> they are both bound to provide protection to works that fall within these categories.

The Berne Convention sets forth the minimum standards that each signatory must provide to protected works. These include the right of reproduction of protected works,<sup>68</sup> the right of authorizing adaptations, arrangements, or alterations of works (called the derivative right in the United States),<sup>69</sup> and the right to control distribution of protected works.<sup>70</sup> The Berne Convention generally provides these rights for the duration of the life of the author plus fifty years.<sup>71</sup> It also allows states to provide some exceptions to these protections through fair or free use.<sup>72</sup>

Ultimately, however, copyright protection is a matter of domestic legislation. So it is important to look at the protections within the United States and Japan itself to determine whether fan fiction generally infringes copyright in either of these states.

#### A. *United States*

Determining whether a work infringes an owner’s copyright requires a two-part inquiry.<sup>73</sup>

The first question is always whether the original work is copyrightable subject matter.<sup>74</sup> If it is, the second question is whether the fan work infringes the owner’s rights.<sup>75</sup>

### 1. Is the Original Work Copyrightable Subject Matter?

In the United States, copyright protection is available to “original works of authorship fixed in any tangible medium of expression.”<sup>76</sup> While some categories

64. Berne Conv., *supra* note 51, art. 1.

65. *Id.* art. 3(1)(a).

66. *Id.* art. 2(1).

67. *Berne Convention for the Protection of Literary and Artistic Works*, WIPO-ADMINISTERED TREATIES, <http://www.wipo.int/treaties/en/ip/berne/> (follow “Contracting Parties” hyperlink) (last visited May 14, 2014).

68. Berne Conv., *supra* note 52, art. 9(1).

69. *Id.* art. 12.

70. *Id.* art. 14(1).

71. Berne Conv., *supra* note 51, art. 7(1). Note that certain works have different durations. *Id.* art. 7(2), (3).

72. Berne Conv., *supra* note 51, arts. 9(2), 10, 10bis.

73. *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1292 (C.D. Cal. 1995); Kathryn M. Foley, *Protection Fictional Characters: Defining the Elusive Trademark-Copyright Divide*, 41 CONN. L. REV. 921, 926 (2009).

74. *Metro-Goldwyn-Mayer*, 900 F. Supp. at 1296; Foley, *supra* note 73, at 927.

75. *Metro-Goldwyn-Mayer*, 900 F. Supp. at 1297; Foley, *supra* note 73, at 927.

76. 17 U.S.C. § 102(a) (2014).

of protection are enumerated, such as literary works, dramatic works, motion pictures, and other audiovisual works,<sup>77</sup> works that meet the first criteria that do not otherwise fit within categories may also be included. The main limitation of copyright is that it will only protect expressions, not ideas.<sup>78</sup> The original works from which Susan took her story were the *Harry Potter* series, *The Lord of the Rings* trilogy, *Star Trek*, and *X-Men*. As a whole, all of these are protected as literary or audiovisual works, and are therefore protected subject matter.

Fan fiction considers another issue in copyrightable subject matter. While full original works can be copied in fan fiction, fans more commonly take only the characters or settings and build their own works from those elements. For example, the only aspect of *The Lord of the Rings* in Susan's story is Gandalf. Therefore, another issue is whether characters are independently copyrightable<sup>79</sup>—if so, owners may have an easier time showing infringement.

Fictional characters have entered the intellectual property spotlight lately as they have become such valuable assets for rights owners.<sup>80</sup> The case law regarding characters, unfortunately, remains rather confusing.<sup>81</sup> Two tests have emerged to determine whether characters are copyrightable: the “story being told” test and the sufficient delineation test.

The “story being told” test emerged in the famous “Sam Spade case” in the Ninth Circuit.<sup>82</sup> In that case, the Ninth Circuit claimed that Detective Sam Spade was not subject to copyright protection independent of his story, the *Maltese Falcon*, because he was “only the chessman in the game of telling the story.”<sup>83</sup> If, however, Sam Spade had truly constituted the “story being told” rather than serving as a pawn in the story, he would have been entitled to independent protection.<sup>84</sup> Since the “Sam Spade case,” the “story being told” test has not been used effectively. Courts have criticized the test,<sup>85</sup> refused to adopt the test,<sup>86</sup> or distorted the test to support the desired result.<sup>87</sup> Therefore, the second test, the sufficient delineation test, should apply when determining whether a character is copyrightable.

The sufficient delineation test was articulated by Judge Hand in *Nichols v. Universal Pictures Corp.*<sup>88</sup> In that case, Judge Hand decided that a fictional

77. *Id.* § 102(a)(1), (3), (6) (2014).

78. *Id.* § 102(b) (2014).

79. See McCardle, *supra* note 7, at 445-47.

80. See Foley, *supra* note 73, at 923, 937 (“[L]icensing of Walt Disney characters alone generates nearly \$20 billion a year in retail sales.”); Michael Todd Helfand, *When Mickey Mouse is as Strong as Superman: The Convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters*, 44 STAN. L. REV. 623, 623, 626 (1992).

81. Tushnet, *supra* note 20, at 659.

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

83. *Id.* at 950.

84. *Id.* See also Foley, *supra* note 73, at 929.

85. Foley, *supra* note 73, at 929.

86. *Id.* at 930.

87. *Id.*

88. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

character could be protected “independently of the plot” in limited situations.<sup>89</sup> The situations in which he determined characters could be protected were when the characters were sufficiently delineated or developed to qualify as protectable expression rather than a mere compilation of ideas.<sup>90</sup> Further cases have used the sufficient delineation standard to determine that the more highly detailed the characters are, the more protection they deserve.<sup>91</sup>

While pictorial representations of characters were previously considered easier to delineate sufficiently than literary characters,<sup>92</sup> literary characters that are more than “mere delineation[s]” of basic ideas have been granted protection.<sup>93</sup> Judge Posner even determined that “no more is required for a character copyright” than a specific name and appearance.<sup>94</sup>

Based on the “story being told” test, none of the characters in Susan’s fan fiction would be entitled to independent copyright protection, because none of them constitute the story being told. Under the sufficient delineation test, on the other hand, Gandalf, Dumbledore, Captain Kirk, and Professor X would all be entitled to copyright protection, as all four of them are very detailed, in-depth characters.<sup>95</sup> As courts are more likely to apply the sufficient delineation test, Susan uses copyright protected characters in her fan fiction.

## 2. Do the Fan Works Infringe upon the Copyright Owners’ Rights?

Once a work or character is copyrighted, owners have certain rights relating to the copyrighted work. Fan fiction potentially infringes upon three of these: the right to reproduction,<sup>96</sup> the right to distribution,<sup>97</sup> and the right to authorize derivative works.<sup>98</sup>

Violating the right of reproduction means that the infringing work copies protected elements from the original work. When taking a character’s name, image, and personality, infringement based upon reproduction can be assumed. In

89. *Id.*; Foley, *supra* note 73, at 927.

90. Helfand, *supra* note 80, at 631; Nichols, 45 F.2d at 121 (“[T]he less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”).

91. *Anderson v. Stallone*, 11 U.S.P.Q.2d 1161, 1166 (C.D. Cal. 1989). *See also Chatelain, supra* note 7, at 205.

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

93. *Detective Comics, Inc. v. Bruns Publ’ns.*, 111 F.2d 432, 433-34 (2d Cir. 1940) (deciding that when “the pictorial representations and verbal descriptions of Superman are not a mere delineation of a benevolent Hercules, but embody an arrangement of incidents and literary expressions original with the author, they are proper subjects of copyright and susceptible of infringement . . .”).

94. *Gaiman v. McFarlane*, 360 F.3d 644, 660 (7th Cir. 2004). *See also Foley, supra* note 73, at 932.

95. Additionally, as inanimate objects such as the Batmobile have been considered to be copyrightable, locations such as the Leaky Cauldron can also be assumed to be copyrightable if they are sufficiently delineated.

96. 17 U.S.C. § 106(1) (2012).

97. *Id.* § 106(3).

98. *Id.* § 106(2).

many fan fiction cases, fans admit to copying the characters and therefore violating the reproduction right; they then allege a defense to immunize themselves from liability for that copying.

Fan authors also typically concede infringements upon the owner's right to authorize derivative works. Creating a derivative work is using elements of a protected work to create a new work—essentially the definition of fan fiction.<sup>99</sup> In *Nichols*, the Court said that copying a character in this way, by moving it out of the original plot, would likely be sufficient to establish copyright infringement.<sup>100</sup> As with infringements of the reproduction right, most fans concede this and justify it by using defenses to infringement.

Finally, “when [a] fan fiction author . . . uploads his story onto the Internet and allows the public to access it, [he] has violated the owner's third exclusive right in distribution.”<sup>101</sup> A fan infringes upon the distribution right merely by distributing copies of an owner's work without obtaining consent. By distributing works that already infringe the reproduction or derivative rights, it is assumed that the owner has not consented to that distribution.

Therefore, fan fiction is a *prima facie* infringement on an owner's copyright rights. Susan's fan fiction, which copies Dumbledore, Gandalf, and the others, creates a derivative work with them, then is distributed on the internet, is also infringing. However, Susan may be able to allege that she is protected by various defenses that immunizes her from liability for these violations.

### 3. Do Fans have any Defenses from Liability for Copyright Infringements?

In U.S. Copyright Law, some uses of copyrighted materials are permitted.<sup>102</sup> Fan fiction writers can use copyrighted characters in their stories if: (1) the copyright owner explicitly or implicitly permits fan fiction or (2) “the fan fiction constitutes fair use of the copyrighted work.”<sup>103</sup> While very few authors have explicitly consented to fan fiction, implied consent is a very strong defense in certain fandoms.<sup>104</sup> If rights owners know about the fan fiction and allow it to continue, in all likelihood, the fan can show that the owner impliedly consented.<sup>105</sup> However, impliedly consenting to some types of fan fiction does not protect all possible versions of fan fiction. For example, J.K. Rowling is unopposed to most fan fiction, but she has brought suit before when the fan in question sells his or her work.<sup>106</sup>

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99. See Chatelain, *supra* note 7, at 205-06; McCardle, *supra* note 7, at 449.

100. Nichols, 45 F.2d at 121; Foley, *supra* note 73, at 933-34.

101. McCardle, *supra* note 7, at 448-49.

102. Chua, *supra* note 8, at 219.

103. Chander & Sunder, *supra* note 8, at 612.

104. McCardle, *supra* note 7, at 449-50.

105. *Id.* at 449.

106. Chander & Sunder, *supra* note 8, at 611.

Fair use is another viable defense for most fan fiction authors. Four factors interact to determine whether a fan can take advantage of the fair use defense:

- (1) the purpose and character of the use . . . ;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion [of the copyrighted work] used [in the infringing work] in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.<sup>107</sup>

Generally, the more transformative the fan work is, the more likely it is fair use under the first factor.<sup>108</sup> Fan fiction is often not only transformative, but also non-commercial in nature. When fans create work without any desire to profit, the first factor weighs very heavily for fair use.<sup>109</sup> When, on the other hand, fans attempt to sell their fan fiction rather than merely posting it online, as *doujinshi* writers do, this may weigh against fair use.<sup>110</sup>

As to the second factor, creative works are typically more strongly protected than factual works and published works are afforded less protection than unpublished ones.<sup>111</sup> While most original works that fan fictions take from are published, they are also very creative, so this factor will almost always weigh in favor of the rights owner.

The third factor, the amount and substantiality of the portion of the copyrighted work used in the infringing work, is why the question of whether characters can be copyrighted is so important. If characters are a mere portion of a copyrighted work, they are a less substantial amount of the copyrighted work than if they are independently copyrightable subject matter. For example, when Susan used Dumbledore in her work, if Dumbledore is copyrightable, she copied the entirety of Dumbledore and, depending on how important of a role he plays in her fan fiction, possibly a very substantial portion of him. If, however, Dumbledore is not copyrightable, Susan copied a very small, probably less substantial, portion of the *Harry Potter* series in copying Dumbledore. Therefore, the determination on whether characters are independently copyrightable will ultimately decide the third fair use factor.

The fourth factor, the effect of the infringing work on the potential market of the original work, will be the hardest for a rights owner to move in his or her favor. The key here is “whether the infringing work ‘usurps’ the market of the original by serving as a substitute for the original author’s work.”<sup>112</sup> Being non-commercial helps the fan, as does the fact that fan fiction also almost never substitutes for the original.<sup>113</sup> In fact, fan fiction often does quite the opposite—it usually helps

107. 17 U.S.C. § 107; *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994).

108. Chatelain, *supra* note 7, at 208.

109. *Acuff-Rose*, 510 U.S. at 578; Chatelain, *supra* note 7, at 208.

110. *Acuff-Rose*, 510 U.S. at 585; Chatelain, *supra* note 7, at 208.

111. Chatelain, *supra* note 7, at 209 (citing *Blanch v. Koons*, 467 F.3d 244, 256 (2d Cir. 2006)).

112. *Id.* at 211.

113. Chua, *supra* note 8, at 223.

encourage readers to return to the original works.<sup>114</sup> Fan authors are rarely, if ever, attempting to replace the existing work about which they care so much. Owners that attempt to argue for this factor may find themselves up against the uncomfortable reality that fan fiction can actually help their original work remain popular and relevant.

While no court has dealt with fan fiction yet, it is likely that fans will prevail on a fair use defense—which is one possible reason that no owners have brought suit against fan fiction writers in the United States. However, Japanese Copyright Law may result in a different outcome, giving owners a different venue in which they could attempt to uphold their rights.

### B. Japan

Copyright regulations in Japan and the United States closely resemble each other, but there are some key differences that could prove important for rights owners and fans when dealing with fan fiction.<sup>115</sup>

#### 1. Is the Original Work Copyrightable Subject Matter?

Similarly to U.S. Copyright Law, Japan's Copyright Law protects "production[s] in which thoughts or sentiments are expressed in a creative way and which falls within the literary, scientific, artistic or musical domain[.]"<sup>116</sup> including novels and cinematographic works.<sup>117</sup> As in the United States, the original works upon which Susan based her fan fiction would be protected in Japan. Because Japan is a civil law country, the statute embodying its Copyright Law is the full extent of the law; however, court cases can still be informative as to how the statute is interpreted. For example, the Japanese Supreme Court decision in *K.K. Matsudera v. King Features Syndicate, Inc.*, in which the court determined that fictional characters could receive copyright protection, indicates that characters may also be protected in Japan.<sup>118</sup> However, as the courts provided no test, the extent to which characters receive protection in Japan is uncertain.<sup>119</sup> Additionally, since *K.K. Matsudera* only involved graphic characters,<sup>120</sup> literary characters may receive less independent copyright protection in Japan than in the United States. Therefore, while the *Harry Potter* series, *The Lord of the Rings* trilogy, *Star Trek*, and *X-Men* receive copyright protection in Japan, the characters within them may not get their own protection.

114. See Lee, *supra* note 13, at 187; Tushnet, *supra* note 20, at 669.

115. Mehra, *supra* note 43, at 166.

116. Chosakukenhō [Copyright Law of Japan], Law No. 43 of 2012, art. 2, para. 1(i) (Japan) (translated by Yukifusa Oyama et al. 2013) [hereinafter Japanese Copyright Law].

117. Japanese Copyright Law, art. 10(1)(i), (vii).

118. Mehra, *supra* note 43, at 173; *K.K. Matsudera v. King Features Syndicate, Inc.*, Saikō Saibansho [Sup. Ct.] July 17, 1997, 1992 (o) no. 1443, translated at [http://www.courts.go.jp/app/hanrei\\_en/detail?id=317](http://www.courts.go.jp/app/hanrei_en/detail?id=317) (Japan).

119. See *K.K. Matsudera*, 1992 (o) no. 1443.

120. Saikō Saibansho [Sup. Ct.] July 17, 1997, 1992 (O) no. 1443, <http://www.softic.or.jp/en/cases/popeye.html> (Japan).



## 2. Do the Fan Works Infringe upon the Copyright Owners' Rights?

The Japanese Copyright Law provides rights to owners of copyrightable works similar to those in the U.S. Copyright Act. In Japan, the owner is entitled to the right of reproduction,<sup>121</sup> the right of distribution,<sup>122</sup> and the right of derivative works.<sup>123</sup> Despite the right of distribution being limited to cinematographic works,<sup>124</sup> these works function in the same way as copyright infringements in the United States, so fans (and Susan) would still be liable for prima facie copyright infringement in Japan.

## 3. Do Fans have any Defenses from Liability for Copyright Infringements?

The defenses for fans in Japan are different from those in the United States. As a practical matter, rights owners do not crack down on fan works in Japan. Most animation studios are "small tightly woven families functioning on extremely tight budgets"<sup>125</sup> that do not have the resources to engage in legal disputes.<sup>126</sup> Additionally, fan works in Japan "make up an enormous and visible industry that has matured alongside the industry of original content production," making fandom more acceptable to owners.<sup>127</sup> Therefore, approval by authors is a particularly strong and often used defense in Japan.

Non-Japanese owners bringing suit in Japan may encounter other defenses that prevent them from proving infringement. Japan does not have an explicit fair use provision like the United States, but it does contain a "laundry list" of permitted use of copyrighted material.<sup>128</sup> Surprisingly, *doujinshi* is not included as a permitted use, but non-profit uses are included.<sup>129</sup> Not only does the Japanese Copyright Law allow for a limited amount of private use copying,<sup>130</sup> but it also has an exception that allows non-profit organizations to present a work already made public if that organization does not charge fees to view the work.<sup>131</sup> While neither of these fits fan fiction perfectly, as fan works are disseminated on the Internet and change aspects of the original rather than merely perform it, Japanese courts could choose to determine that the free posting of fan fiction on the Internet falls into these exceptions.

Based on this, rights owners may decide to bring copyright infringement cases against fans in Japan when possible, despite the cultural difficulties, because the

121. Japanese Copyright Law, art. 21.

122. *Id.* art. 26.

123. *Id.* arts. 27-28.

124. *Id.* art. 26.

125. Kirkpatrick, *supra* note 23, at 146 (citing ANTONIO LEVI, *NEW MYTHS FOR THE MILLENNIUM: JAPANESE ANIMATION, ANIMATION IN ASIA AND THE PACIFIC* (John A. Lent, ed. 2001)).

126. *Id.*

127. *Id.* at 146-47; Lee, *supra* note 13, at 185.

128. Mehra, *supra* note 43, at 175-76.

129. Japanese Copyright Law, arts. 30, 38.

130. *Id.* art. 30.

131. *Id.* art. 38.

law is more likely to find for the owners. While infringement would occur in both countries, the United States' strong fair use defense would probably impede finding infringement, while no such explicit defense exists in Japanese law.

## V. TRADEMARK AND FAN FICTION

An entire story may not be covered by trademark, but that is part of what makes trademark ideal for owners looking to protect their characters if copyright claims fail. While some courts have commingled trademark and copyright analyses recently, trademark can provide strong protections for rights owners looking to protect characters used in fan fictions. Unlike copyright, which can be protected in a country as long as both that country and the original country are Berne Convention signatories, trademark often requires registration of the particular mark in the country in which protection is sought.<sup>132</sup> For this section, the paper will assume that all of the rights owners in Susan's story have registered the elements in question in both the United States and Japan.

### A. *United States*

The trademark issue in relation to fan fiction is becoming increasingly important, particularly due to slash fiction.<sup>133</sup> Many character owners have expressed concern about slash fiction ruining the reputation of their characters, a claim that is irrelevant in copyright considerations.<sup>134</sup> Since owners that sleep on their rights by not acting when others use their characters can lose the right to bring future cases, an increasing number of rights owners are bringing trademark claims to defend their characters.<sup>135</sup> As with copyright, one must first look at whether elements in fan fiction are protected by trademark, then at whether the fan's use of those elements infringes on the owner's rights.

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132. In the United States, an owner can obtain a common law trademark through use only, but most countries require registration. U.S. Patent and Trademark Office, *Frequently Asked Questions about Trademarks*, [http://www.uspto.gov/faq/trademarks.jsp#\\_Toc275426680](http://www.uspto.gov/faq/trademarks.jsp#_Toc275426680) (last modified Apr. 23, 2013). International applications are now available through the Madrid Protocol, but owners still have to choose in which countries their marks are valid—they do not have a “global” registration. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, June 27, 1989, World Intellectual Property Organization, *available at* [http://www.wipo.int/wipolex/en/wipo\\_treaties/text.jsp?file\\_id=283484](http://www.wipo.int/wipolex/en/wipo_treaties/text.jsp?file_id=283484). See Natalie Hanlon-Leh, Kathleen S. Herbert & Adam Lindquist Scoville, *A Brand New World: International Trademark Registration and the Madrid Protocol*, 32 COLO. LAW. 89 (2003).

133. McCardle, *supra* note 7, at 464.

134. *Id.*

135. Helfand, *supra* note 80, at 626-27. See, e.g., *Conan Props., Inc. v. Conans Pizza, Inc.*, 752 F.2d 145 (5th Cir. 1985) (regarding the owner of trademark of fictional character “Conan the Barbarian” who brought an action against restaurant alleging infringement of its trademark); *Fleischer Studios, Inc. v. A.V.E.L.A. Inc.*, 772 F. Supp.2d 1155 (C.D. Cal. 2009) (bringing of an action by a studio against licensor over use of “Betty Boop” cartoon character); *DC Comics v. Kryptonite Corp.*, 336 F.Supp.2d 324 (S.D.N.Y. 2004) (regarding the comic book publisher suit against manufacturer of bicycle locks, claiming trademark ownership of the term “kryptonite”).

### 1. Is the Element Protected by Trademark?

The Lanham Act, the federal trademark statute in the United States, defines a trademark as “any word, name, symbol, or device, or any combination thereof— . . . used . . . to identify and distinguish” the goods or services of one person from those of another, even if the source is unknown.<sup>136</sup> Therefore, the story from which a fan writer copies is not protected by trademark, but elements within the story, such as characters, phrases, titles, or places can be.<sup>137</sup>

If elements are inherently distinctive, they can become a trademark. Inherently distinctive marks make consumers regard those particular symbols as an indication of the producer.<sup>138</sup> To date, no court has found a fictional character to be inherently distinctive and the case law indicates that no character ever could be.<sup>139</sup> Therefore, rights owners must show acquired distinctiveness or secondary distinctiveness to receive trademark protection for elements of their works.<sup>140</sup> Unlike inherent distinctiveness, secondary distinctiveness “requires actual use of the mark for a period of time sufficient to create public recognition.”<sup>141</sup> For the characters in Susan’s story—Dumbledore, Gandalf, Captain Kirk, and Professor X—continuous actual use by their owners as well as their fame likely fulfill this first requirement of trademark protection.

However, being famous and used is not enough to receive trademark protection. The element also must serve “as an indicator of source.”<sup>142</sup> Courts have generally stated that a mark must indicate only a *single* source of goods.<sup>143</sup> However, this is a practical impossibility for fictional characters.<sup>144</sup> Take Dumbledore as an example—while many would attribute Dumbledore to J.K. Rowling, he is also the intellectual property of Warner Brothers, Bloomsbury Publishing, and Scholastic.<sup>145</sup> This is not an unusual situation for fictional characters. While initial court cases determined this prevented characters from being valid trademarks,<sup>146</sup> modern courts have recognized that the identification of

136. 15 U.S.C. § 1127 (2014).

137. *Id.*; Helfand, *supra* note 80, at 627.

138. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211-13 (2000); Foley, *supra* note 73, at 940-41.

139. Foley, *supra* note 73, at 942.

140. *Id.* at 940.

141. *Id.* at 941.

142. 15 U.S.C. § 1127; Foley, *supra* note 73, at 942. *See also Ex parte Carter Publ'ns*, 92 U.S.P.Q. (BNA) 251 (Dec. Comm'r Pat. 1952); *Pillsbury Co. v. Milky Way Prods.*, 8 Media L. Rep. (BNA) 1016 (N.D. Ga. 1981); Helfand, *supra* note 80, at 636.

143. Foley, *supra* note 73, at 942. *See, e.g., Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112 (2d Cir. 1984).

144. Foley, *supra* note 73, at 942-43.

145. Daniel Goldblatt, *Warner Bros. and J.K. Rowling Team Up for New 'Harry Potter'-Themed Film Series*, VARIETY (Sept. 12, 2013), <http://variety.com/2013/film/news/harry-potter-jk-rowling-warner-bros-1200608921/>; *Harry Potter*, BLOOMSBURY, <http://harrypotter.bloomsbury.com> (last visited May 15, 2014); *Harry Potter*, SCHOLASTIC, <http://harrypotter.scholastic.com> (last visited May 15, 2014).

146. *Frederick Warne & Co. v. Book Sales Inc.*, 481 F. Supp. 1191, 1197 (S.D.N.Y. 1979).

a single source is “often no more than a convenient fiction”<sup>147</sup> and allow trademark protection of characters anyway.<sup>148</sup>

Based on these elements, most characters and even some locations, such as the Leaky Cauldron or the Starship Enterprise, are protected by trademark. Therefore, Susan has used trademarks in her story.

## 2. Does the Fan’s Use of the Trademarked Element Infringe the Owner’s Rights?

Trademark guarantees rights owners a “limited monopoly” over the use of a properly trademarked element.<sup>149</sup> However, this monopoly does not guarantee an owner control over every instance in which its image is affected negatively.<sup>150</sup> It does protect owners from situations in which the use of a mark is likely to cause confusion as to the “origin, sponsorship, or approval of . . . goods, services, or commercial activities.”<sup>151</sup> To determine whether consumers are likely to be confused or misled by the fan use, courts typically balance a number of factors.<sup>152</sup> In character trademark cases, many courts ignored the balancing of factors entirely and just looked at the fame of the character.<sup>153</sup> The assumption courts use to justify this method is that with famous characters, “consumers are likely to believe that the creators of the first work created, or at the very least, authorized the second work.”<sup>154</sup> In cases with less well-known characters, courts are unlikely to find trademark infringement.<sup>155</sup> Courts have justified this dichotomy by explaining that rampant licensing of well-known fictional characters has created a public expectation that by displaying elements of a fictional character, the person using the character has at least received permission from the owner.<sup>156</sup>

Therefore, even though most consumers of fan fiction would understand that the owners of the characters or locations did not concede to the fan’s use of their intellectual property, the current case law implies that courts might find fan fiction infringes trademark anyway, simply because the characters used are well-known.

147. Foley, *supra* note 73, at 942-43 (citing Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 485 (1986)).

148. Foley, *supra* note 73, at 944; Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 443-44. See, e.g., *Edgar Rice Burroughs, Inc. v. Manns Theatres*, 195 U.S.P.Q. (BNA) 159, 162 (C.D. Cal. 1976).

149. Foley, *supra* note 73, at 939.

150. Lee, *supra* note 13, at 184.

151. 15 U.S.C. § 1125(a)(1)(A) (2014); Foley, *supra* note 73, at 940.

152. Helfand, *supra* note 80, at 636-37.

153. Foley, *supra* note 73, at 947 (citing *Prouty v. Nat’l Broad. Co.*, 26 F. Supp. 265, 265-66 (D. Mass. 1939)).

154. *Id.*; Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 489 (1986). See *Lone Ranger Inc. v. Cox*, 124 F.2d 650, 652 (4th Cir. 1942); *DC Comics, Inc. v. Unlimited Monkey Bus.*, 598 F. Supp. 110, 115-16 (N.D. Ga. 1984).

155. Foley, *supra* note 73, at 947. See *DeCosta v. Columbia Broad. Sys., Inc.*, 520 F.2d 499, 514-15 (1st Cir. 1975).

156. Foley, *supra* note 73, at 949. See *Conan Props., Inc. v. Conans Pizza, Inc.*, 752 F.2d 145, 150 (5th Cir. 1985); *Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 79 (2d Cir. 1981).

If courts follow this process, Susan is unquestionably liable for trademark infringement for all of the characters and protectable elements in her story.

Even when courts do not find trademark infringement, owners may still have a dilution claim. Dilution claims “can lie even where copyright law would allow a depiction of a character under fair use and no trademark violation exists because consumers are not confused as to source,”<sup>157</sup> making it the ideal tool for owners who would like to stop particular “offensive” types of fan fiction. A dilution claim can take one of two forms: “[t]he first is a ‘blurring’ or ‘whittling down’ of the distinctiveness of the mark” and “[t]he second is a “tarnishment” of the mark.”<sup>158</sup> The second, tarnishment, is most likely to be claimed by owners in fan fiction cases. Tarnishment occurs “when a defendant uses the mark in a way that ‘creates an undesirable, unwholesome or unsavory mental association’ with the mark.”<sup>159</sup> In fan fiction, owners claiming tarnishment are most likely to target slash fiction or pornographic fan fiction.

However, “[a] court will entertain a claim for tarnishment or dilution only when the defendant’s use of the mark is in a commercial setting.”<sup>160</sup> This would mean that *doujinshi* is considered unfavorable to the original artist and might be liable for a dilution claim, but most free fan fiction would not. Even though this claim initially seems ideal for owners, it is ultimately a legal dead end for most owners seeking to pursue a suit against fan-writers.

### 3. Are there any Defenses to a Trademark Claim that Fans can Use?

While trademark does have fair use defenses, they are not applicable to fan fiction.<sup>161</sup> However, the First Amendment also allows individuals to claim it as a defense to unauthorized trademark use when the use is not purely commercial. The test for this defense (the *Rogers* test) determines whether (1) there is some artistic relevance to the use of the trademark and (2) the use of the trademark is explicitly misleading as to the source of the work.<sup>162</sup> Art and parodies often fall into these categories,<sup>163</sup> as would non-commercial fan fictions. Commercial fan fiction would not meet the threshold requirement for this defense of a work that is “not purely commercial.”

157. Helfand, *supra* note 80, at 639.

158. McCardle, *supra* note 7, at 465 (citing *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1039 (N.D. Ga. 1986)).

159. *Id.*

160. *Id.* (citing *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987)).

161. Statutory fair use, defined in Lanham Act § 33(b)(4), is when one uses a mark only in its descriptive sense and not as a trademark (e.g. John is a *super man.*). Nominative fair use is a common law defense that allows people to use a mark when talking about someone else’s product (e.g. “*Superman* grosses \$1 billion” as a newspaper headline). See *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302 (9th Cir. 1992). Both of these are complete defenses to trademark, but neither is really applicable to fan fiction, as it relates to the fan’s new product.

162. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2nd Cir. 1989); *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008).

163. See, e.g., *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2nd Cir. 1989); *Mattel Inc., v. Walking Mtn. Productions*, 353 F.3d 792 (9th Cir. 2003).

In fan fiction, it should be easy for fan authors to argue that they meet the first part of the *Rogers* test. Using trademarked characters in a piece of fan fiction that reimagines the original work or critiques the original work does have artistic relevance. The second part of the test may be more difficult. While works on a site such as fanfiction.net are unlikely to make anyone think that they were written by the original author, stand-alone works of fan fiction might explicitly mislead others. If a short story describing Dumbledore's exploits before the days of Harry Potter were to be sold on a website, or even made available without being attached to a fan fiction site, eager readers may be misled to believe that J.K. Rowling herself wrote this work. In this instance, the First Amendment defense would be unavailable to the fan author.

To avoid explicitly misleading their audience, many fan authors include a disclaimer at the beginning of their fan fiction that their work is purely fan work and was neither written nor authorized by the owner.<sup>164</sup> While these disclaimers are not legally binding, they would negate consumer confusion, making an infringement claim more difficult for owners. This may not help if courts continue to assume that any use of a famous character infringes upon an owner's trademark, but it cannot hurt fans to continue to use such disclaimers.

The only other real defense to a trademark claim is abandonment. Trademark owners can perpetually renew trademarks as long as they are used.<sup>165</sup> However, once use of the trademark stops, trademark law no longer protects the element.<sup>166</sup> This is generally an unhelpful defense in fan fiction, though—most fan fiction is about current popular culture in which the owner renews its trademark rights. Moreover, as a practical matter, an owner that has abandoned its trademark is unlikely to bring an infringement claim.

### *B. Japan*

As in the United States, the Japanese Trademark Act protects elements registered in the country. However, the existing law is fairly unclear on what would happen in a fan fiction trademark case.

#### **1. Is the Element Protected by Trademark?**

In Japan, “any character(s), figure(s), sign(s) or three-dimensional shape(s), or any combination thereof, or any combination thereof with colors” may be a valid mark if it is “used in connection with the goods [or services] of a person who produces, certifies or assigns the goods [or services] as a business.”<sup>167</sup> These marks may be registered based on use or, with otherwise generic marks, when “consumers are able to recognize the goods and services as those pertaining to a

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164. *Lec*, *supra* note 13, at 184.

165. 15 U.S.C. § 1058 (2012); *Foley*, *supra* note 73, at 939.

166. *Helfand*, *supra* note 80, at 646-47.

167. *Shōhyō-hō*, [Trademark Act], Act No. 127 of 1959, art. 2(1) (Japan).

business of a particular person.”<sup>168</sup> In that sense, obtaining a trademark in Japan is easier than in the United States.

Whether characters can be trademarked in Japan remains unclear (the word “character” in the trademark act is understood to refer to Japanese characters, such as Kanji, not animated characters from fictional works). It appears that no cases have been decided on the matter and no articles have discussed it. However, based on the language of the Trademark Act and its similarity to the U.S. Trademark Act, as well as the extensive use and popularity of manga and anime characters, it seems unlikely that Japan would forbid the trademark of fictional characters. The only potential complication is that the Trademark Act does not list “words” or “names” as protected marks, but those could be included as “characters” or “signs.” Therefore, animated characters or pictorial representations of characters may be capable of being trademarked, but descriptions, names, and other literary representations might not be protected by trademark. This may pose a key problem to obtaining trademark protection in Japan for owners.

## **2. Does the Fan’s Use of the Trademarked Element Infringe the Owners’ Rights?**

The effective registration of a trademark in Japan gives owners the same rights as holding a trademark in the United States—the owner can prevent infringement and dilution. An owner has the exclusive right to use that mark in connection with the designated goods or services.<sup>169</sup> That exclusive right includes the request to affix an indication to marks that would cause confusion.<sup>170</sup> This “request” provision is a reflection of the non-litigious Japanese society and reiterates the idea that adding a disclaimer to fan fiction may prevent trademark liability for the fan in Japan.

Acts that constitute infringement of the trademark are enumerated in Article 37 of the Japanese Trademark Act. The infringing uses most applicable to fan fiction are:

the possession of products indicating the registered trademark . . . for the purpose of using the registered trademark . . . in connection with the designated goods or designated services, or goods or services similar thereto [and] the manufacture or importation of products indicating the registered trademark . . . for the purpose of using or causing to be used the registered trademark . . . in connection with the designated goods or designated services or goods or services similar thereto.<sup>171</sup>

If fan fiction itself were a “product,” downloading or writing fan fiction with someone else’s trademarked elements would infringe the owner’s trademark rights without needing to show fame or indication of source. Based on these articles, it

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168. *Id.* art. 3(2).

169. *Id.* art. 25.

170. *Id.* art. 24-4.

171. *Id.* art. 37(v), (vii).

would be much easier for an owner to show trademark infringement under Japanese law than U.S. law.

Dilution in Japanese trademark law is more complicated. Currently, the Japanese judiciary and legislature are at odds with each other; so despite Japanese statutes not recognizing dilution *per se*, Japanese courts have found dilution to be present, essentially making judge-made law in a civil law country where that should not be possible.<sup>172</sup>

One other possibility for an owner seeking a remedy in Japan is an unfair competition claim. Fame is a key aspect in Japan's unfair competition law. The Unfair Competition Prevention Act determines that 'unfair competition' means:

the act of using the Goods or other Appellations . . . which is identical with, or similar to, another party's Goods or Other Appellation that is well-known among the consumers, . . . and causes confusion with the goods or business of that other party's [or] the act of using Goods or Other Appellations of another that are identical with, or similar to, another person's famous Goods or Other Appellations. . . .<sup>173</sup>

"Goods or Other Appellations" are "name[s] connected with a person's business, trade name, trademark, mark, the container or package of goods, or any other appellation of goods or businesses."<sup>174</sup> This provision looks similar to how the U.S. courts have dealt with trademark infringement of characters—if the owner can show fame, the fan is liable for unfair competition. Fame here generally requires nationwide fame,<sup>175</sup> but that would be simple to prove for characters such as Dumbledore and Gandalf. Therefore, fans like Susan may be liable for unfair competition in Japan simply by using an owner's trademarked character in their stories.

With trademark, then, it would be more difficult for owners to decide where to bring suit. While the United States boasts greater protection for famous characters and while Japan has no discernable protection for characters, non-commercial uses would be more difficult to recover from in the United States, while simple use could be used to find a fan liable in Japan. Owners might simply decide to pursue the case in the United States, with a friendlier court system for rights owners, than risk not having a protectable character in Japan. Of course, since marks must be registered to bring suit, the protectability of characters is something an owner would know long before fan fiction cases come to pass.

172. Kenneth L. Port, *Trademark Dilution in Japan*, 4 NW. J. TECH. & INTELL. PROP. 228, 230 (2006).

173. Port, *supra* note 172, at 229 (citing Fusei kyoso boshibo [Unfair Competition Prevention Act], Law No. 47 of 1993, art. 2-1).

174. *Id.*

175. *Id.* at 235.



## VI. MORAL RIGHTS AND FAN FICTION

If copyright and trademark are an owner's economic protections, moral rights are an author's artistic protections. Moral rights do not protect all of the owners in the same way that other intellectual property rights do; instead, moral rights only protect the original author of the work. Therefore, J.K. Rowling can bring a moral rights claim against Susan for her use of Dumbledore, but Warner Brothers or Bloomberg cannot.

Moral rights exist because of the idea that "[t]he creation of an artistic work is not merely a product that can be bought or sold but, rather, is a direct embodiment of the author's personality, identity, and even her 'creative soul.'"<sup>176</sup> Practically speaking, moral rights allow authors to object to how their works are used once the works leave their hands.

Moral rights are internationally recognized and protected. The Berne Convention recognizes the right of the author "to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation."<sup>177</sup> These rights, typically called the right of attribution and the right of integrity respectively, remain with the author even after the transfer of economic rights and persist after his death.<sup>178</sup>

Theoretically, all members of the World Trade Organization and all signatories to the Berne Convention should abide by these moral rights. However, the United States managed to draft the final version of TRIPs to exclude Article 6bis from the adherence requirement,<sup>179</sup> so U.S. law still does not recognize moral rights, despite most nations going above and beyond TRIPs.<sup>180</sup> The United States claims it still protects moral rights in various ways,<sup>181</sup> but likely not to the satisfaction of authors who are not pleased by fan fiction.

A. *United States*

The moral rights provision of the Berne Convention contributed to the United States' long avoidance of becoming a member.<sup>182</sup> Once the United States became a member, its Congress determined that it would require specific legislative enactments to become law, thereby avoiding establishing formal moral rights obligations.<sup>183</sup> Yet the United States claims that it still recognizes moral rights

176. Bird & Ponte, *supra* note 17, at 217 (citing Ilhyung Lee, *Toward an American Moral Rights in Copyright*, 58 WASH. & LEE L. REV. 795, 801 (2001)).

177. Berne Conv., *supra* note 51, art. 6bis(1).

178. *Id.* art. 6bis(2); Bird & Ponte, *supra* note 17, at 224.

179. Monica Kilian, *A Hollow Victory for the Common Law? Trips and the Moral Rights Exclusion*, 2 J. MARSHALL REV. INTELL. PROP. L. 321, 321 (2003) (citing Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Apr. 15, 1994, 1867 U.N.T.S. 154).

180. Kilian, *supra* note 179, at 321-22.

181. Bird & Ponte, *supra* note 17, at 252 (citing 134 CONG. REC. S10320-10326, 10323 (daily ed. May 10, 1988) (statement of Sen. Kastenmeier), 142 Cong Rec S 10320, at \*S10,323 (LEXIS)).

182. *Id.* at 248.

183. *Id.* at 251.

under other property and economic rights or under state tort law.<sup>184</sup> However, “[e]fforts to address moral rights issues through statutes, such as the Lanham Act, and alternative legal theories, such as defamation, unfair competition, and invasion of privacy, were often shot down in the courts, blocking meaningful judicial recognition and protection of moral rights.”<sup>185</sup>

Some courts recognize moral rights through “American analogues.”<sup>186</sup> Often, this depends on state law. At least fourteen states have some sort of moral rights protection, often those of integrity and attribution that are included in the Berne Convention.<sup>187</sup> State property and contract law also include some implicit moral rights. Gunlicks points out that an author has an absolute property right until he or she chooses to part with it.<sup>188</sup> While this is true, it undermines the basic tenets of U.S. intellectual property law—that creative works should be encouraged so that they may be available to the public.<sup>189</sup> If authors choose not to publish works out of fear of mutilation or misattribution, the intellectual property laws are not fulfilling their function.

Arguably, contract law is the ideal place to preserve an author’s moral rights. However, the inalienability of moral rights generally contradicts the notions supporting freedom of contract.<sup>190</sup> Yet freedom of contract also allows authors to preserve their moral rights; “there exists an implied covenant of good faith and fair dealing” in every contract, meaning that a party must refrain from actions that harm or destroy the other party, and that unreasonable or unfair use of an author’s work would violate the contract in which the author consented to use of the work.<sup>191</sup> Additionally, authors are expected to reserve rights to themselves in contracts if they do not wish for the publisher to have them.<sup>192</sup> While this would theoretically preserve an author’s moral rights, not only is this often untrue in practice, where the author is in an inferior bargaining position, it also does not bind the fan, only the publisher. Therefore, in the United States, the fan can create fan

184. *Id.* at 252 (citing 134 CONG. REC. S10320-10326, 10323 (daily ed. May 10, 1988) (statement of Sen. Kastenmeier), 142 Cong Rec S 10320, at \*S10, 323 (LEXIS)).

185. *Id.* at 253-54 (internal citations omitted). See also Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1, 25-27 (1985).

186. Ilhyung Lee, *Toward an American Moral Rights in Copyright*, 58 WASH & LEE L. REV. 795, 805-06 (2001).

187. Bird & Ponte, *supra* note 17, at 254-55 (providing the corresponding state statutes as: Cal. Civ. Code §§ 980-90 (2014); Conn. Gen. Stat. § 42-116 (2014); 815 Ill. Comp. Stat. 320/1-8 (2014); La. Rev. Stat. Ann. § 51:2151-56 (2014); Me. Rev. Stat. Am. Tit. 27. §§ 303(1)-(5) (2014); Mass Gen. Laws Ann. ch. 231, § 85S (West 2006); Nev. Rev. Stat. Ann. §§ 597.720-60 (2014); N.J. Stat. Ann. § 2A:24A1-8 (West 2006); N.M. Stat. Ann. §§ 13-4B1 to -3 (2006); NY Arts & Cult. Aff. Law §§ 11.01-14, 13.01-13.19 (Consol. 2006); 73 Pa. Cons. Stat. §§ 2101-10 (2014); RI Gen. Laws §§ 5-62-2 to -12 (2014); S.D. Codified Laws § 1-22-16 (2014); Utah Code Ann. § 9-6-409 (2014)).

188. Gunlicks, *supra* note 60, at 619.

189. Bird & Ponte, *supra* note 17, at 248.

190. Kilian, *supra* note 179, at 325.

191. Gunlicks, *supra* note 60, at 618 (quoting *Kirke La Shelle Co. v. Paul Armstrong Co.*, 188 N.E. 163, 167 (N.Y. 1933)).

192. Kilian, *supra* note 179, at 328 (quoting Lee, *supra* note 184, at 813); Gunlicks, *supra* note 60, at 634.

fiction that alters the author's work, sometimes directly contrary to the author's wishes, and if no copyright or trademark exists, the author is out of luck.

### B. Japan

Civil law nations typically protect both economic intellectual property rights and moral or personal rights.<sup>193</sup> Japan is no exception. Japan protects three rights: the right of divulgence, the right of authorship, and the right of integrity.<sup>194</sup>

The right of divulgence encompasses "the right to control if and when a work is made public."<sup>195</sup> It encompasses the idea "that only the creator of the work knows when the work is complete and therefore ready to be . . . reviewed by the public."<sup>196</sup> This helps protect authors from publishers pushing publication before the author is ready. While important, it has less applicability to fan fiction.

The right of authorship is similar to the right of attribution in the Berne Convention. It is "[t]he right to determine whether to disclose the name of the author, to include an author's name on his work, to exclude the name of one not an author, and to determine whether any name disclosed should be a true name or a pseudonym."<sup>197</sup> The right of authorship also requires that derivative works must indicate the name of the original author.<sup>198</sup> Authors could have a claim against fans when they write fan fiction that does not appropriately attribute the characters to the author, but most fan fictions are very explicit about giving the authors credit, so this claim is unlikely to arise.

The right of integrity is the most applicable to fan fiction. The right of integrity includes "[t]he right to control distortions, mutilations and modifications of the work."<sup>199</sup> This has been read to mean "that any unauthorized change to an author's work is an infringement of the author's right to integrity."<sup>200</sup> As Japan does not have fair use protections, this means that any sort of transformation of a work, even if for non-commercial or parody purposes, would violate the author's right to integrity.

193. Bird & Ponte, *supra* note 17, at 213-14 (citing Monica E. Antezana, Note, *The European Union Internet Copyright Directive as Even More than it Envisions: Toward a Supra-EU Harmonization of Copyright Policy and Theory*, 26 B.C. INT'L & COMP. L. REV. 415, 421-22 (2003)).

194. Japanese Copyright Law, *supra* note 116, arts. 18-20.

195. Scott, *supra* note 58, at 340 (citing Japanese Copyright Law, *supra* note 116, art. 18).

196. Bird & Ponte, *supra* note 17, at 220.

197. Scott, *supra* note 58, at 340 (citing Japanese Copyright Law, *supra* note 116, art. 19).

198. Foster, *supra* note 43, at 337 (citing JAPANESE COPYRIGHT LAW: WRITINGS IN HONOUR OF GERHARD SCHRICKER 45 (Peter Ganea, Christopher Heath & Hiroshi Saitō eds., 2005)).

199. Scott, *supra* note 58, at 340 (citing Japanese Copyright Law, *supra* note 117, art. 20).

200. Foster, *supra* note 43, at 337-38 (citing JAPANESE COPYRIGHT LAW: WRITINGS IN HONOUR OF GERHARD SCHRICKER 46 (Peter Ganea, Christopher Heath & Hiroshi Saitō eds., 2005)).

The Japanese Supreme Court in the Mad Amano case has supported this conclusion.<sup>201</sup> In that case, an artist called Mad Amano used another artist's photograph of skiers on an alpine slope to create a parody of the work.<sup>202</sup> The Supreme Court decided that Mad Amano's work was a modification of the original photograph, infringing the author's moral right of integrity.<sup>203</sup> The Court clarified that if Mad Amano had merely "quoted" the artist's photo, where his new work was the major part and the original work was only a minor part, it might be permitted, but in this case, change was not enough as the photo was the major part and its "essential characteristics" were still evident.<sup>204</sup>

Based on the Mad Amano case, if authors wanted to sue fan writers for fan fiction, they could do so under the right of integrity and likely prevail. Susan's work might be considered a "quote" by the Japanese Supreme Court, with her borrowed characters only a minor part of her overall work. If this were the case, she would be free from liability under the Mad Amano case. However, the more likely outcome is that a Court would decide that because she used the "essential characteristics" of each of the characters, her fan fiction is a violation of the right of integrity under Japanese law.

Therefore, if an author wanted to sue fans for their fan fiction, Japan would be the preferable venue, if only for the ability to find infringement of the author's moral rights.

## VII. CONCLUSIONS

If J.K. Rowling wanted to sue Susan, where could and should she go? As mentioned in Section III, she must first have an existing right in the applicable law. If she has registered copyrights and trademarks in both Japan and the United States, either is appropriate. Next, it gets complicated, as Susan is in Japan, but published her fan fiction on fanfiction.net, where it has been read in both the United States and Japan. In this case, Rowling is free to choose between the two countries because infringement has taken place in both.

Now that Rowling must make a decision, the cultural and legal comparisons between the two countries play an important role. Culturally, Rowling would probably prefer to bring suit in the United States, where she could recover more money or get a more assured injunction and where the stigma against litigation would not be present. However, if suing for copyright infringement, Rowling

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201. *Id.* at 333-35 (citing Saiko Saibansho [Sup. Ct.] Mar. 28, 1980, Sho 54 (o) no. 923, 415 Hanrei Taimuzu [Hanta] 100, available at [http://www.courts.go.jp/hanrei/pdf/js\\_20100319121451062181.pdf](http://www.courts.go.jp/hanrei/pdf/js_20100319121451062181.pdf) (Japan) [hereinafter *The Mad Amano Case*]; Tokyo Koto Saibansho [Tokyo High Ct.] May 19, 1976, Sho 47 (ne) no. 2816, 226 Hanrei Taimuzu [Hanta] 194, available at <http://www.courts.go.jp/hanrei/pdf/BA4D7DCD0AC151CE49256A76002F89AE.pdf> (Japan); Tokyo Chiho Saibansho [Tokyo Dist. Ct.] Nov. 20, 1972, Sho 46 (wa) no. 273, 289 Hanrei Taimuzu [Hanta] 77, available at <http://www.courts.go.jp/hanrei/pdf/7805A1DAB05D83AC49256A76002F8A63.pdf> (Japan)).

202. Foster, *supra* note 43, at 333 (citing *The Mad Amano Case*, *supra* note 198).

203. *Id.* at 335 (citing *The Mad Amano Case*, *supra* note 198).

204. *Id.* at 335 (quoting *The Mad Amano Case*, *supra* note 198).

would prefer Japan, where a fair use defense would not prevent her from winning the suit. On the other hand, if suing for trademark infringement (assuming she had a registered trademark for Dumbledore and the Leaky Cauldron in both countries), she may have no preference, as character infringement in the United States is as easy to find as unfair competition in Japan. Finally, if wanting to allege an infringement of her moral rights, Rowling would also prefer to bring the suit in Japan, where moral rights not only exist, but also are strong enough that any alteration is sufficient to find infringement. Perhaps it is this set of contradictory circumstances and the lack of guarantee as to where infringement has taken place over the internet that helps contribute to a lack of fan fiction lawsuits.

Practically, fan fiction puts owners and fans alike in a difficult situation. While many owners would prefer not to alienate their fans and appreciate the publicity, they would also like to control the images of their characters, deciding with whom they are in relationships, whether they drink or smoke, and even the types of clothes they wear. Various solutions could make this situation easier on both parties.

First, the U.S. Congress and Japanese Diet could amend their intellectual property acts to clarify their national legal positions on fan fiction. Professor Tushnet recommends that the law draw lines that resemble current norms,<sup>205</sup> but even law that would clarify small issues such as whether characters receive protection, the extent of moral rights, or whether non-commercial fan fiction or *doujinshi* are permitted uses would help.

Second, TRIPs or the Berne Convention could deal with fan fiction. While this is a much heavier burden and much more difficult to coordinate, an international agreement might be the best way to coordinate between fair use protections on one hand and strong moral rights on the other. States like the United States and Japan, which have one but not the other, are unlikely to effectively make a decision about the appropriate way to balance these two concepts.

Third, owners could coordinate to authorize particular types of fan fictions but not others. The Japanese anime and manga industries already support *doujinshi*, and many American studios, such as Paramount, allow inoffensive fan works. While many owners are moving in this direction, it seems unlikely to get the consent of some of the stricter holdouts, such as Anne Rice. Additionally, different owners may have different ideas about what is "inoffensive"—while all owners are likely in agreement that commercial fan fiction is undesirable, different owners probably have different perceptions about slash fiction or pornographic fan fiction.

Based on all of this, the ultimate question should be whether it matters. Should Susan stop writing her fan stories if Rowling can sue her and win in either the United States or Japan under certain laws? No. The practical matter is, as long as Susan is not trying to sell her works, Rowling likely will not do that. Should

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205. Tushnet, *supra* note 20, at 654.

Rowling start going after fans that write distasteful stories about her characters? No—she does not want to isolate her fans. Will existing suits move over to Japan, as the laws are more favorable to intellectual property rights owners there? That depends. If owners move over to Japan, there is a chance that the culture surrounding lawsuits will change. On the other hand, the culture may dissuade owners from doing so, meaning no lawsuits will occur.

Ultimately, intellectual property is becoming less territorial and more international. Fan fiction and similar fan works are only increasing and it would be best for the law to move with them rather than fight against them. To do this, international conversations need to be had in order to create international solutions, so fans can continue to elaborate on the characters they love without hurting the ones who created them.

