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INTELLECTUAL PROPERTY—MICKEY MOUSE'S INTELLECTUAL PROPERTY ADVENTURE: WHAT DISNEY'S WAR ON COPYRIGHTS HAS TO DO WITH TRADEMARKS AND PATENTS

KAITLYN HENNESSEY*

This Article explores the copyright and trademark laws underlying Disney's characters in light of Mickey Mouse's looming copyright expiration. The Article maps the history of copyright extension from the Copyright Act of 1909 (the governing law when Mickey Mouse came to be) to the "Mickey Mouse Protection Act" (the current governing law on copyright expiration), finding further extension of copyright protection to be unlikely and, ultimately, unappealing. This Article takes the position that further extension is unlikely given that the political climate for such reform has changed and that the policy tensions underlying extended protection weigh in favor of limiting copyright protection to current terms. The Article analogizes between continued copyright extension and recent patent reform, highlighting the danger of inhibiting creativity and innovation—the very things that Walt Disney built his legacy on.

INTRODUCTION

When Walt Disney was still getting started in the entertainment industry, his distributor, Charles Mintz, encouraged him to create a new cartoon character that he could pitch to Universal Studios.[1] Walt did just that, and in 1927, Oswald the Lucky Rabbit made his debut in the cartoon

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1. BOB THOMAS, WALT DISNEY: AN AMERICAN ORIGINAL 83 (Disney Editions 1994).

short *Trolley Troubles*.[2] America quickly fell in love with Oswald, and the character became Walt's greatest success to date.[3] The celebration was short-lived for Walt, however. In 1928, upon approaching Mintz about negotiating a renewal of their contract, Walt was informed that many of his animators had signed over to work for Universal.[4] Further, Mintz told Walt that, per their original contract, Oswald belonged to Universal—not to Disney.[5] Refusing to abandon his own studio and work for Universal, Walt left the negotiation without a new contract and without the rights to the rabbit he had created.[6]

As the story goes, it was on the train ride home from this meeting that Walt came up with the idea for none other than Mickey Mouse.[7] From his experience with Oswald, Walt had learned an important lesson: to always make sure that he owned the rights to all of the characters that he and his company created.[8] In the decades since, the Walt Disney Company (hereinafter "Disney") has upheld this practice by pushing for extended copyright protection of its characters, including the big cheese himself—Mickey Mouse.[9]

Though Disney has been successful in protecting its characters under copyright law so far, expiration of such protection is fast approaching. The last time copyright protection was extended was when the Copyright Term Extension Act was signed into law in 1998.[10] It extended the copyright protection of works published in 1923 or later for another

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2. *Id.* at 84.

3. *Id.* at 84–85.

4. *Id.* at 85–87.

5. *Id.* at 86.

6. *Id.* at 87. *But see The Unbelievable History of Oswald the Lucky Rabbit*, OH MY DISNEY, https://ohmy.disney.com/insider/2016/09/05/oswald-the-lucky-rabbit/ [https://perma.cc/W44V-KHD3]. In 2006, former Walt Disney Company CEO, Bob Iger, traded ESPN sportscaster Al Michaels to NBC in exchange for the rights to Oswald, bringing the lucky rabbit home after nearly 80 years. *Id.*

7. *See* THOMAS, *supra* note 1, at 88 ("The birth of Mickey Mouse is obscured in legend, much of it created by Walt Disney himself. He enjoyed telling the tale of how he dreamed up the mouse character on the train trip back from the Oswald disaster . . . .").

8. *See* Zachary Crockett, *How Mickey Mouse Evades the Public Domain*, PRICEONOMICS (Jan. 7, 2016) [hereinafter *15 Years Ago*], https://priceonomics.com/how-mickey-mouse-evades-the-public-domain/ [https://perma.cc/22F4-45RU].

9. *Id.*

10. *See* Timothy B. Lee, *15 Years Ago, Congress Kept Mickey Mouse out of the Public Domain. Will They Do It Again?*, WASH. POST (Oct. 25, 2013, 9:00 AM), https://www.washingtonpost.com/news/the-switch/wp/2013/10/25/15-years-ago-congress-kept-mickey-mouse-out-of-the-public-domain-will-they-do-it-again/ [https://perma.cc/SN25-AJPM].

twenty years.[11] Congress has not extended copyright protection again since, and as a result, "[a]s the ball dropped over Times Square," kicking off 2019, "copyrighted works published in 1923 fell into the public domain. . . . [It was] the first time this [had] happened in 21 years."[12]

Having been created in 1928, Mickey Mouse's copyright protection is set to expire January 1, 2024—less than four years from now. Though this may be alarming to some die-hard Disney fans, the copyright expiration Mickey Mouse faces in 2024 is not a total expiration of all the rights vested in the mouse. It is, however, the beginning of a steep expiration slope not just for Mickey, but for the company's entire cast of characters. Further, while Mickey may be able to seek some refuge from the public domain through trademark law, this protection will likely be unavailable for the majority of Disney's characters.

This Article explores the relevant copyright and trademark laws underlying Disney's characters in light of Mickey Mouse's looming copyright expiration, as well as the policy tensions underlying the potential for any future copyright extension. The analysis looks to analogies between continued copyright extension and recent patent reform, highlighting the danger of inhibiting creativity and innovation—the very things that Walt Disney built his legacy on.

I. COPYRIGHT LAW

Copyright is a form of legal protection that gives the creator of a work[13] the exclusive right to use and distribute the work for a period of time (dictated by statute) until it falls[14] into the public domain.[15] A work of authorship gains copyright protection the moment it is created.[16]

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11. Timothy B. Lee, *Mickey Mouse Will Be Public Domain Soon—Here's What That Means*, ARS TECHNICA (Jan. 1, 2019, 12:10 PM) [hereinafter *What That Means*], https://arstechnica.com/tech-policy/2019/01/a-whole-years-worth-of-works-just-fell-into-the-public-domain [https://perma.cc/H649-47TY].

12. *Id.*

13. Copyright Act of 1976, 17 U.S.C § 102 (2018). A "work" for purposes of copyright protection includes literary works, musical works, choreographic works, graphic works, motion pictures, and sound recordings. *Id.*

14. The term "fall" (as opposed to "enter") is used throughout this Article to reflect a lack of willingness or desire on the part of authors for their works to join the public domain, rather than to imply that the authors' works entered the public domain because the authors were careless in any way or unaware of the works doing so.

15. *Copyright: Everything You Need to Know*, UPCOUNSEL, https://www.upcounsel.com/copyright [https://perma.cc/6H8H-Y5J6].

16. *Copyright in General (FAQ)*, COPYRIGHT.GOV, https://www.copyright.gov/help/faq/faq-general.html#what [https://perma.cc/TRR6-WBM8].

A. *The Road to the Mickey Mouse Protection Act*

At the time that Mickey Mouse was created in 1928, the Copyright Act of 1909 was the governing law on copyrights in the United States.[17] The Act granted federal copyright protection to original works that were (1) published and (2) had a notice of copyright affixed to them, for a period of twenty-eight years from the date of publication, with the option for renewal for another twenty-eight years of protection.[18] Upon either the close of twenty-eight years (if there was no renewal of the copyright) or of fifty-six years (representing the initial twenty-eight year protection term and an additional twenty-eight year protection term upon renewal), the work would fall into the public domain. As a result, Mickey Mouse could only be protected until as late as 1984. Aware of this deadline and committed to protecting a character that had not only become the mascot of the company, but also a huge source of revenue, Disney began lobbying Congress.[19]

Disney's lobbying efforts paid off. Congress passed the Copyright Act of 1976, which displaced the 1909 Act, codified the fair use doctrine, adopted a protection term for new copyrights based on the date of the author's death, and extended protection for certain existing copyrights.[20] The 1976 Act extended copyright protection for already-published corporate copyrights, such as Mickey Mouse, from fifty-six years to seventy-five years.[21] Works published prior to 1922 immediately entered the public domain, and works published after 1922 were entitled to the full seventy-five years of protection.[22] As a result, Mickey Mouse's copyright protection was extended until 2003.

As 2003 drew nearer, Disney again began lobbying Congress. The Copyright Term Extension Act (CTEA) of 1998, also known

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17. *Copyright Act of 1909*, COPYRIGHT.GOV, https://www.copyright.gov/history/1909act.pdf. Prior to the Copyright Act of 1909, there was the Copyright Act of 1790 and the Copyright Act of 1831. The 1790 Act afforded creative works protection for up to twenty-eight years–fourteen initial years and an additional fourteen upon renewal. The 1831 Act extended the protection period to a max of forty-two years.

18. 1909 Copyright Act: An Act to Amend and Consolidate the Acts Respecting Copyright, Pub. L. No. 60-349, 35 Stat. 1075 (1909), available at https://www.copyright.gov/history/1909act.pdf.

19. Crockett, *supra* note 8. Disney also has several other characters that are not far behind Mickey Mouse for copyright expiration, including Pluto, Goofy, and Donald Duck. *Id.* For the company, extending copyright protection is more than protecting one character. *Id.* Disney relies heavily on its intellectual property, consisting of hundreds of characters, all of which are time-stamped for eventual copyright expiration. *Id.*

20. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified at scattered sections of Title 17 U.S.C).

21. Crockett, *supra* note 8.

22. *Id.*

(legitimately) as the "Sonny Bono Act" and (jokingly) as the "Mickey Mouse Protection Act," extended corporate copyrights from seventy-five years to ninety-five years.[23] This brings us to Mickey Mouse's current copyright protection, which, as mentioned, is set to expire on January 1, 2024.

B. *Mickey's Copyright Protection Post Protection Act*

Not all of Mickey's copyrights, however, expire in 2024. The Mickey copyright that will expire in 2024 is that of his original incarnation, as he appeared in *Steamboat Willie*.[24] Disney will still own copyrights to later incarnations of the mouse.[25] So, in 2024, you would have the right to create works that utilize the original Mickey (black and white with no gloves and stylistically different than the Mickey we know today), but not "modern Mickey" (in full color, with gloves, as he appears nowadays).[26] You'll have to wait an additional year, until 2025, to utilize a Mickey with gloves, as that is when the first Mickey-with-gloves copyright will expire.[27] If you want to utilize Sorcerer Mickey, you'll have to wait until 2036, as this particular Mickey first appeared in the 1940 film, *Fantasia*. The use of other, more subtle, changes to Mickey will require careful attention so as not to run afoul of Disney's still-existing copyrights before they too fall into the public domain.[28]

With a history of successful lobbying for copyright extensions behind him, some may be left to wonder whether Mickey Mouse will ever fall into the public domain. The fact that Congress has left the copyright expirations under the CTEA in place (rather than extending them again) and the fact that works covered by the most recent extension have, as of this year, officially begun moving into the public domain, seem to be good indications that Mickey's 2024 copyright expiration is an inevitable one. Further, as will be discussed below, the political climate for copyright extension has changed and the need for continued innovation and creativity is an important public policy concern that weighs in favor of no longer extending copyright protection terms.

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23. Sonny Bono Copyright Term Extension Act, Tit. I, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified at 17 U.S.C. §§ 302–04).

24. *What That Means*, *supra* note 11.

25. *Id.*

26. *Id.*

27. *Id.*

28. *Id.*

C. *How Live Action Remakes (Don't) Affect Current Copyrights*

Relatedly, and contrary to popular belief, Disney releasing live-action remakes[29] (or any remakes, for that matter) of existing movies does not extend copyright protection for the original works.[30] In fact, the remakes have no bearing on the copyright expiration of their original, animated counterparts.[31] As Jonathan Bailey notes in his article, *Why Disney's Remakes Don't Extend Its Copyright*, "[y]ou can't extend the copyright of a previous work by publishing a new one, you just create a new work with a new term."[32]

As an example of how this works, Bailey breaks down the legal relationship between Disney's 1941 animated *Dumbo* film and its 2019 live-action remake *Dumbo* film.[33] Regardless of the remake (and barring any change in the law), the copyright protection associated with the 1941 *Dumbo* will expire on January 1, 2037.[34] According to Bailey, this means that as of that date,

> you'll be able to make copies, distribute, sell, or create derivative works based on the original Dumbo. What you won't be able to do is anything that [is] exclusive to the new film. Any new character elements introduced will not be usable and you will not be able to make copies of it (outside the boundaries of fair use) without a license.[35]

While a remake of an existing film does not extend the copyright term of the existing film, it is not to say that there are not other copyright-related reasons for creating such remakes, two of which Bailey points out.[36] First, as the copyright protection of Disney's older works will begin to expire in the near future, the clock is ticking on Disney's ability to use the works exclusively, which may be particularly relevant to the creation and success

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29. Such remakes include *The Jungle Book* (2016) (based on the 1967 animated film of the same name), *Beauty and the Beast* (2017) (based on the 1991 animated film of the same name), *Aladdin* (2019) (based on the 1992 animated film of the same name), *The Lion King* (2019) (based on the 1994 animated film of the same name), and *Dumbo* (2019) (based on the 1941 animated film of the same name).

30. *See* Jonathan Bailey, *Why Disney's Remakes Don't Extend Its Copyright* (Apr. 9, 2019), https://www.plagiarismtoday.com/2019/04/09/why-disneys-remakes-dont-rest-its-copyright/ [https://perma.cc/AX4R-WYQP].

31. *Id.*

32. *Id.*

33. *Id.*

34. *Id.*

35. *Id. See also* Sonny Bono Copyright Term Extension Act, Tit. I, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified at 17 U.S.C. §§ 302–04).

36. *Id.*

of sequels or the use of the works in larger universes.[37] For example, if someone else were to produce a film about Tinkerbell (once she had fallen into the public domain), it could impact Disney's decision to produce any future films featuring the fairy, could create inconsistencies and confusion in regards to the established Tinkerbell universe Disney has already developed with its many films about her, and could detract from the popularity of the character and the Disney-produced films featuring her.

Second, Disney may be trying to create the new, definitive versions of each work so as to continue exercising some control over the underlying properties after the original works fall into the public domain.[38] Universal Pictures successfully achieved a similar feat with its 1931 *Frankenstein* film.[39] When Universal released the film, the Frankenstein book had long since fallen into the public domain.[40] While the book continued to exist in the public domain after the film's release (allowing others to use the work and build upon it), the film created an iconic version of the monster[41] that Universal has the exclusive right to use until January 1, 2027.[42] As will be touched on below, Disney, too, has taken from the public domain and created iconic versions of no-longer-protected works, with its versions subsequently receiving both protection and notoriety. Examples of this include *Snow White and the Seven Dwarfs*, *Aladdin*, *Cinderella*, *Hercules*, *Mulan*, *Sleeping Beauty*, and *Tarzan*. The difference between both Universal's and Disney's public-domain inspired creations and Disney's recent remakes is that, with the former, neither Universal nor Disney was the creator of the original works that had since fallen into the public domain. The situation Disney now finds itself in is trying to create new, definitive versions of works it previously authored, many of which became the definitive versions of other (no longer protected) works, and all of which have yet to fall into the public domain. However, without changing the plots or characters of its original films in significant ways, Disney is doing little more than bringing its own originals to life in new ways—which is amazing for audiences to experience and still brings in money at the box office, but does very little to establish anything truly new for the company in terms of intellectual property.

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37. *Id.*

38. *Id.*

39. *Id.*

40. *Id.*

41. *See id.* The *Frankenstein* book was not particularly descriptive of the monster, leaving its depiction open to interpretation. *Id.* Most have come to associate the physical appearance of the monster with the version Universal created. *Id.*

42. *Id.*

While the nuances of different Mickey incarnations and remaking existing works can get a little fuzzy, one thing seems clear: Disney's copyrighted works are headed toward the public domain and will eventually get there. However, while the expiration of Mickey Mouse's copyrights is likely inevitable, Disney does own several trademarks for the mouse, and importantly, trademarks (unlike copyrights) do not expire.[43]

II. TRADEMARK LAW

A trademark is "a word, phrase, symbol, and/or design that identifies and distinguishes the source of the goods of one party from those of others."[44] A trademark gives the owner of the mark the exclusive right to use the mark in connection with goods or services (as opposed to a copyright, which gives the owner the exclusive right to make copies of the work, distribute the work, perform or display the work, and make derivative works based on the original work). Mickey Mouse himself is a trademark of Disney. If (or when) Mickey Mouse's copyright protection comes to an end, Disney will still be able to protect him, to some extent, through trademark law.[45]

A. *Dual Protection Under Copyright and Trademark Law*

In *Frederick Warne & Co. v. Book Sales, Inc.*, the United States District Court for the Southern District of New York found that "[d]ual protection under copyright and trademark laws is particularly appropriate for graphic representations of characters. A character deemed an artistic creation deserving copyright protection . . . may also serve to identify the creator, thus meriting protection under theories of trademark and unfair competition."[46] This case concerned illustrations of the popular character Peter Rabbit, who had since fallen into the public domain.[47] The court held that, "[t]he fact that a copyrightable character or design has fallen into the public domain should not preclude protection under the trademark

43. *What That Means*, *supra* note 11. Note, however, that a trademark can be abandoned through non-use. Lanham Act § 45, 15 U.S.C. § 1127 (1988).

44. *Trademark, Patent, or Copyright?*, USPTO (Dec. 13, 2011), https://www.uspto.gov/trademarks-getting-started/trademark-basics/trademark-patent-or-copyright [https://perma.cc/N3RN-PPHB].

45. *See generally* Irene Calboli, *Overlapping Trademark and Copyright Protection: A Call for Concern and Action*, 2014 U. ILL. L. REV. SLIP OPINIONS 25, https://illinoislawreview.org/wp-content/uploads/2014/10/Calboli.pdf [https://perma.cc/DC9Z-E73G].

46. Frederick Warne & Co. v. Book Sales Inc., 481 F. Supp. 1191, 1196–97 (S.D.N.Y. 1979).

47. *Id.* at 1196.

laws so long as it is shown to have acquired independent trademark significance, identifying in some way the source or sponsorship of the goods."[48] Although the Supreme Court, in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, agreed that creative works can be protected as trademarks when they identify the origin of the producer of the tangible goods, it cautioned against "'misuse or overextension' of trademark and related protections into areas traditionally occupied by . . . copyright."[49]

B. *Trademarking the World's Most Iconic Character*

The first Mickey Mouse trademark registration was filed in May of 1928.[50] It covered "Mickey Mouse" as a word mark and was held by Walt himself.[51] The mark was later held by the Walt Disney Company and is currently held by Disney Enterprises, Inc. (a subsidiary of the Walt Disney Company).[52] It was initially subject to renewal every twenty years, but has since become subject to the ten-year renewal requirement.[53] Having last been renewed in 2008, the mark came up for renewal again in 2018.[54] Since the first Mickey Mouse trademark registration, Disney has acquired various Mickey Mouse trademarks across many different Nice classes.[55] In addition to nineteen trademark registrations for the words "Mickey Mouse," Disney also has trademark registrations for Mickey's visual appearance for animated and live-action motion picture films.[56] The Mickey Mouse trademarks that Disney owns give Disney the exclusive right to use the registered marks as they appear and are described in the

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48. *Id.*

49. Dastar Corp. v. Twentieth Century Fox Film Corp., 123 U.S. 2041, 2048 (2003).

50. Mickey Mouse—Trademark Details, JUSTIA TRADEMARKS, https://trademarks.justia.com/712/66/mickey-71266717.html [https://perma.cc/D8KN-9QW6].

51. *Id.*

52. *Id.*; *Subsidiaries of the Walt Disney Company*, SEC.GOV, https://www.sec.gov/Archives/edgar/data/1001039/000119312511321340/d232174dex21.htm.

53. *Mickey Mouse—Trademark Details*, JUSTIA TRADEMARKS, https://trademarks.justia.com/712/66/mickey-71266717.html [https://perma.cc/D8KN-9QW6].

54. *Id.*

55. Trademark Search Results for "Mickey Mouse", JUSTIA TRADEMARKS, https://trademarks.justia.com/search?q=mickey+mouse&ewms=27&bwms=5&mwms=1&fts=5&page=1 [https://perma.cc/LP3T-WJDQ]. *See also Nice Classification*, WIPO, https://www.wipo.int/classifications/nice/en/ (last visited Mar. 21, 2020) (explaining the Nice classifications).

56. Stephen Carlisle, *Mickey's Headed to the Public Domain! But Will He Go Quietly?*, NSU COPYRIGHT NOVA (Oct. 17, 2014), http://copyright.nova.edu/mickey-public-domain/ [https://perma.cc/SW3A-LVBA]. Carlisle notes that the 2004 trademark registration for the visual representation of Mickey Mouse is much more similar to the original, *Steamboat Willie* Mickey than to the Mickey we see today. Further, this registration states that "color is not a claimed feature of the mark," reinforcing the idea that the registration is for the black and white Mickey, rather than the red shorts-and-yellow-shoes Mickey. *Id.*

registration in connection with the products and services they are registered for.[57] Disney also has the right to license or assign the marks to others.[58] Importantly, the registered marks create a presumption of ownership and provide Disney with the right to legal action against anyone who infringes them.[59] Causes of action for trademark infringement may include dilution, false advertising, and unfair competition (among other claims).[60]

Regardless of the many registered trademarks that Disney has for Mickey Mouse, he would meet the requirements for dual protection under *Frederick Warne & Co.* with "flying colors, should he need to."[61] As mentioned, the Court in *Frederick Warne & Co.* ruled that a trademark could protect a character if the character had obtained "secondary meaning."[62] Put differently, "one who encounters the character must immediately associate it with the source."[63] As copyright attorney Stephen Carlisle points out, "Disney has made Mickey Mouse so prominent in all of their corporate dealings, that he is effectively the pre-eminent symbol of the Walt Disney Company. There can be little doubt that anyone seeing the image of Mickey Mouse (or even his silhouette), immediately thinks of Disney."[64]

C. *Dual Protection for Other Disney Characters? Pooh Out of Luck*

While Disney may be able to protect Mickey through trademark law as a result of his acquired secondary meaning, the approach will likely fall short for many of the company's other characters. Take, for example, Winnie-the-Pooh ("Pooh"). Created in the mid-1920s,[65] Pooh has become a beloved character and has received copyright protection until 2021.[66]

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57. *See* Brett Melson, *6 Benefits of Registering Your Trademark*, DELAWAREINC.COM (Mar. 12, 2018), https://www.delawareinc.com/blog/six-benefits-of-registering-your-trademark/ [https://perma.cc/M95H-XWSP].

58. *Id.*

59. *Id.*

60. *Trademark Violations: Causes of Action and Remedies*, Articles, DANIEL S. KAPLAN (2007), http://www.dskaplanlaw.com/images/articles/Trademark_Violations_Causes_of_Action_April2007.pdf.

61. Crockett, *supra* note 8.

62. Carlisle, *supra* note 56.

63. *Id.*

64. *Id.*

65. *See* Christopher Klein, *The True Story of the Real-Life Winnie-the-Pooh*, HISTORY (Oct. 13, 2016), http://www.history.com/news/the-true-story-of-the-real-life-winnie-the-pooh [https://perma.cc/9EHU-G6MJ].

66. Note that this means that Pooh will face the public domain before Mickey Mouse does.

Although Disney does have several trademarks for Pooh (just as for Mickey), Pooh's origin undermines his likelihood of receiving dual protection under *Frederick Warne & Co*.[67] "Remember, the Court's rationale for extending trademark protection to a copyrighted character lies in the assumption that '[a] character deemed an artistic creation deserving copyright protection . . . may also serve to identify the creator.'"[68] The issue is that Pooh was created by author A.A. Milne and originally illustrated by Ernest H. Sheppard.[69] Pooh's copyright was sold to comic book pioneer Stephen Slesinger in the 1930s, with the rights to Pooh being licensed to Disney by Slesinger's family after his death in 1953.[70] Thus, Disney is not the "creator" of Pooh.[71] In fact, Disney is not technically the creator of many of its characters, including Snow White, Aladdin, Cinderella, Hercules, Mulan, Sleeping Beauty, and Tarzan (to name a few), who were all to be found in the public domain.[72] While one may argue that many people associate Pooh with Disney, the fact remains that "the only elements that Disney owns as a matter of being the 'creator' [of Pooh] are the elements they have added," such as his red shirt.[73] Extending dual protection to Pooh for his limited ties to Disney as a source would likely be the "misuse or over extension of trademark law and related protections into areas traditionally occupied by . . . copyright" that the Supreme Court cautioned against.[74] Other Disney characters like Pooh, who are not technically Disney characters so far as creation is concerned, may only be protected under copyright law to the extent of Disney's original takes on them and until their expiration, whenever that may be. As a result of the "secondary meaning" requirement under *Frederick Warne & Co.*, many of them may not find refuge from the public domain under trademark law.

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67. Carlisle, *supra* note 56.

68. *Id.*

69. *Id.*

70. Andrew Clark, *Disney Wins Winnie the Pooh Copyright Case*, GUARDIAN (Sept. 30, 2009), https://www.theguardian.com/business/2009/sep/30/winnie-the-pooh-disney-law-suit [https://perma.cc/4BKR-9UGP].

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

72. *See* Crockett, *supra* note 8. Despite the fact that many would associate Snow White with Disney, the company could not prevent rival works about the character. For example, in 2012, Universal Studios produced *Snow White and the Huntsmen*. *Snow White and the Huntsmen,* IMDB, https://www.imdb.com/title/tt1735898/[https://perma.cc/PQT8-BD5R].

73. Carlisle, *supra* note 56.

74. Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 34 (2003).

D. *Limiting Dual Protection*

Mickey Mouse, unlike many of his other Disney pals, undoubtedly qualifies for dual copyright-trademark protection under *Frederick Warne & Co.* Unfortunately, while the court in *Frederick Warne & Co.* was open to extending such protection to characters even if they had fallen into the public domain, the Supreme Court in *Dastar* explicitly refused to allow causes of action under section 43 of the Lanham Act related to expired copyrights for fear that it would "create a species of mutant copyright law."[75] Specifically, the Court refused to allow a cause of action under section 43(a) of the Lanham Act,[76] which provides general theories of liability for false representation and false advertising related to the use of one's trademark.[77] Section 43(a)(1)(A) protects against confusion or deception as to the origin, sponsorship or approval of goods, services or commercial activities, whereas section 43(a)(1)(B) protects against the misrepresentation of the nature, characteristics, qualities, or geographic origin of the goods, services or commercial activities through commercial advertising or promotion.[78] "Thus, while 43(a)(1)(A) protects against customer confusion regarding the source of artists' works, 43(a)(1)(B) protects against third parties misrepresenting artists' works through commercial activity."[79] In making its decision, the Supreme Court focused on the meaning of the word "origin." The Supreme Court stated:

> [R]eading the phrase "origin of goods" in the Lanham Act in accordance with the Act's common-law foundations (which were *not* designed to protect originality or creativity), and in light of the copyright and patent laws (which *were*), we conclude that the phrase refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods.[80]

This holding prevented Fox from prevailing on its section 43(a)(1)(A) claim against Dastar (as Dastar was the "origin" of the products it sold), but the Court specifically suggested that Fox could pursue a false advertising claim under section 43(a)(1)(B).[81] As such, Disney could not

75. *Id.*

76. *Id.*

77. 15 U.S.C. § 1125 (2018).

78. *See* B. Brett Heavner, *Protecting Artists' Works by Using the Lanham Act*, NAT'L L.J. (Dec. 3, 2007), available at https://www.finnegan.com/en/insights/protecting-artists-works-by-using-the-lanham-act.html [https://perma.cc/WX45-9CBH].

79. *Id.*

80. *Dastar Corp.*, 539 U.S. at 37.

81. *See* Heavner, *supra* note 78.

use section 43(a)(1)(A) in a suit against a party using Mickey Mouse in their own work (once he falls into the public domain), but could potentially use section 43(a)(1)(B) against a party for false advertising related to Mickey.

The current case law ultimately means that, although Mickey Mouse may benefit from dual copyright-trademark protection for the time being, the means for protecting him under trademark law will become more limited when his copyright protection expires. Further, it is important to remember that, although there is some overlap and entanglement, copyrights and trademarks are different. They protect different things (works versus marks), provide for different uses (display, distribute, perform versus use to identify source of product or service), and have causes of action for infringement with different elements. Even if all of Disney's characters were protected to the full extent of trademark law, it would not be the same as being protected to the full extent of copyright law.

E. *Where Current Copyright and Trademark Law Leaves Disney*

So, what is Disney to do? The company could try to change the law. It could attempt to have *Dastar* overruled or amended via further lobbying efforts, new case law, or otherwise. This could be beneficial to intellectual property law as a whole if it helped to further explain the specifics of when dual protection may be utilized and to what extent. Such an approach would likely be time consuming and expensive, although a cost-benefit analysis that takes into account the value of Disney's protected works might be persuasive enough. Unfortunately, if such an approach were too time consuming, many works could fall into the public domain before they might be saved by such a change and, assuming any new law on the issue would not apply retroactively, the effort would be for naught (at least as far as those earlier works go). Further, as will be discussed below, there are policy concerns tied to further copyright extension and the political climate for such extension is changing.[82] Looking to recent patent reform as a comparison may provide some guidance so far as public policy is concerned, although there are concededly points of distinction.

III. COMPARISON TO PATENT REFORM

While copyright and trademark law have become somewhat tangled, patent law has been less so entwined as a result of its more distinct nature. "A patent is a limited duration property right relating to an invention,

82. *What That Means*, *supra* note 11.

granted by the United States Patent and Trademark Office in exchange for public disclosure of the invention."[83] Patent protection, unlike trademark protection, is not indefinite, and, unlike copyright protection, does not attach automatically. In fact, it is no simple task to acquire a patent. And, since the enactment of the America Invents Act (AIA) in 2011, it is also no simple task to sustain a patent.

Arguably, copyright extension and patent reform are on opposite ends of the law-change spectrum. Aside from concerning two different areas of intellectual property law, they also have had opposite effects on their respective practice areas. The patent reform has effectively weakened patents. Through its change from a "first to invent" system to a "first to file" system, patent reform supplementation of existing inter partes re-examination with "post-grant review" proceedings,[84] and its elimination of "the opportunity for a defendant in a patent infringement action to assert best mode as an invalidity/unenforceability defense to alleged patent infringement," the AIA has left current patent holders more vulnerable and potential filers weary.[85] Thus, it disincentivizes individuals from filing. On the other hand, Disney's (and others') war on copyrights is really a war *for* copyrights. The company's efforts have served to strengthen copyrights in the hands of their creators by keeping them protected and out of the public domain for increasing amounts of time. Thus, it incentivizes, rather than disincentivizes, the creation and registration of creative works.[86]

There are, however, similarities. The AIA is analogous to the CTEA in that its enactment was largely influenced by large corporations.[87]

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83. *Trademark, Patent, or Copyright?*, USPTO, https://www.uspto.gov/trademarks-getting-started/trademark-basics/trademark-patent-or-copyright (last visited Mar. 23, 2019).

84. *See* Dale L. Carlson, *Scrap the Patent Reform Bill; Congress Should Start All Over, Making Sure that Patent Law Continues to Reward the First True Inventor, Not the First to File*, 32 NAT'L L.J. 39 (Mar. 15, 2010).

85. *See* Dale Carlson, *As Time Goes By: Of Babies and Bathwater*, N.Y. INTELL. PROP. L. ASS'N NEWSLETTER, Nov. 2013, at 29, https://www.wiggin.com/wp-content/uploads/2019/09/27329_as-times-goes-by-of-babies-and-bathwater-nyipla-newsletter-october-november-2013-carlson.pdf [https://perma.cc/GVT6-3VLS].

86. *But see 15 Years Ago*, *supra* note 10 ("To suggest that the monopoly use of copyrights for the creator's life plus 50 years after his death is not an adequate incentive to create is absurd . . . . The real incentive here is for corporate owners that bought copyrights to lobby Congress for another 20 years of revenue—not for creators who will be long dead once this term extension takes hold.").

87. *See* Jennifer L. Case, *How the America Invents Act Hurts American Inventors and Weakens Incentives to Innovate*, 82 U. MO. KAN. CITY L. REV. 29, 30–31, 62 (2013) (raising the fact that large corporations' lobbying efforts were a motivator behind the AIA and that the predecessor to the AIA failed to include testimony from "startup companies or individual inventors").

Further, both raise an important public policy concern: each, in one way or another, effectively limits the public's access to works in favor of the interests of large corporations, which in turn serves to stifle creativity and innovation.

The changes made to the patent system under the AIA place greater power in the hands of large corporations who can afford to squash small patent filers, produce increasingly advanced technologies, and defend their existing patents.[88] Small businesses and individual patent filers face an uphill battle in obtaining and maintaining patents. Aside from the difficulties of successfully registering a patent application in the first place, they must also be able to endure potentially unlimited attacks by anyone who wants to challenge their patent. Be it a lack of funds or an unwillingness to go through the hassle, many small inventors may simply choose not to publicize their inventions at all. This will have the effect of limiting innovation and advancement in the economy over time. The public will be cut off from benefiting from, and building upon, potentially ingenious inventions.

Though current copyright law extends protection to works regardless of whether the author is an individual or a corporation, individuals are left without the ability to build upon a huge amount of existing works made popular by large corporations. In addition, individuals are left without the money and resources to match the lobbying efforts of large corporations in favor of extended copyright protection (although, as will be discussed below, some large companies are beginning to oppose the extension of copyright terms).

IV. THE POLICY TENSIONS UNDERLYING CURRENT COPYRIGHT LAW

Historically, three arguments for copyright extension have been advanced: (1) lengthy copyrights are necessary to incentivize the creation of new works; (2) copyrighted works are an important source of income—not just to copyright holders, but to the United States at large; and (3) copyrights were originally intended to provide income for two generations of descendants—since human lifespan has increased since the original copyright bill in 1790, the copyright term should be appropriately elongated.[89] Copyright scholar Dennis Karjala has condemned these arguments, contending that "[t]he extensions are corporate welfare, plain

88. *See generally* Richard A. Campbell, *Impact Analysis of the Leahy-Smith America Invents Act* (2016), https://scholarworks.gvsu.edu/cgi/viewcontent.cgi?article=1007&context=lib_seniorprojects [https://perma.cc/9LC9-HWYD].

89. Crockett, *supra* note 8.

and simple—and they have caused a lot of harm to the general public."[90] Karjala further contends that copyright extensions have limited the public's freedom to make derivative works, serve only to boost corporate profits for an elongated period of time, and create a wealth transfer from the United States public to current copyright holders through the continued payment of extended copyright royalties.[91] "These copyright owners are in most cases large companies and, in any case, may not even be descendants of the original authors whose works created the revenue streams that started flowing many years ago."[92]

Indeed, while Congress may have been persuaded to extend copyright protection more than once in the past, "the political climate for copyright legislation has changed radically."[93] There now exists a "well-organized, grassroots lobby against copyright expansion."[94] As tech-policy reporter Timothy B. Lee explains, "[t]he rise of the Internet and its remix culture means that a lot of people now benefit from a growing public domain in ways that weren't true in 1998. That includes big companies like Google, but it also includes grassroots communities like Wikipedia editors and Reddit users."[95]

Just as recent patent reform has had the effect of preventing the public from building upon one another's inventions, so too will copyright extension prevent the public from building upon one another's creative works. As one law professor noted, "[n]o work created during [our] lifetime[s] will, without conscious action by its creator, become available for [us] to build upon."[96]

CONCLUSION

A recent irony many have been quick to note is that, if not for Disney's prior successful efforts to extend copyright protection, Spiderman would have already fallen into the public domain and Disney would not have needed to license the character from Sony. While true, ignored is the fact that Disney's efforts have served to protect countless other characters in its collection, including Mickey Mouse (who, arguably, is a bigger star than Spiderman – sorry, Spidey!). And while some may

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90. *Id.*
91. *Id.*
92. *Id.*
93. *What That Means*, *supra* note 11.
94. *Id.*
95. *Id.*
96. James Boyle (@thepublicdomain), TWITTER (Aug. 7, 2009, 8:48 AM), https://twitter.com/thepublicdomain/statuses/3179305900 [https://perma.cc/J7Y3-B86A].

find it ironic that Disney has pushed for copyright extension when many of its own works are based on works in the public domain, it is not ironic at all, but rather, it is the point. Disney is well aware that others can and will use works that have fallen into the public domain and it knows that its works will be no exception when the time comes.

In terms of copyright protection, Disney (and others) may continue pushing for further extensions and may ultimately continue to get them, so long as Congress goes along for the ride. However, in light of the changing political environment surrounding copyright extension, this seems unlikely. And, in light of the analogies that can be drawn to the effects of recent patent reform, it may be for the best that Congress does not do so. Disney may ultimately have to rely on its trademarks, though as discussed, the current case law on the issue is not helpful for characters who have not established sufficient secondary meaning and provides limited protection to characters who have since fallen into the public domain. We will have to wait and see where Disney and the law go on this issue. Although extending copyright protection indefinitely and protecting all of Disney's characters forever, through one channel of law or another, may seem impossible, it was Walt Disney himself who once said: "It's kind of fun to do the impossible."[97]

While the Disney fan inside me would love to see Disney characters be copyright protected indefinitely—perhaps by a Disney exception to copyright expiration—the reality is that indefinite copyright protection, for one or for all, will undermine the ideals of a public domain that promotes and enhances the innovation of and access to creative works. Walt himself was always creating and innovating—in fact, he created a separate organization, Walt Disney Imagineering (WDI), specifically to develop new concepts for his various projects.[98] At least, until further developments on the issue or the expiration of their copyright protection, Mickey Mouse and all his friends will remain in the "House of Mouse" and out of the public domain. And, with just under four years until Mickey Mouse's first copyright is set to expire, Disney still has time to surprise us before the clock strikes midnight!

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97. DEREK WALKER, ANIMATED ARCHITECTURE 10 (1982) (quoting Walt Disney).

98. JIM KORKIS, WALT'S WORDS 131 (Bob McLain ed., 2016) (WDI currently holds over a hundred different patents).