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Sherlock Holmes and the Mysteries of Copyright

*Evgenia Kanellopoulou**

A. INTRODUCTION

Recent litigation in America has brought the fictional character of Sherlock Holmes and his creator, Sir Arthur Conan Doyle, front and centre once again. And even though the case does not touch on Scots Law, it would be more than appropriate to address the issues raised by this case against a picturesque, seemingly mysterious, foggy Edinburgh background. Sir Arthur Conan Doyle would have wanted it this way, make no mistake about it.

B. PRELUDE¹

Leslie Klinger, an American lawyer and the author of numerous publications deriving from Sherlock Holmes, filed a lawsuit against the Conan Doyle Estate. He sought a declaratory judgment, regarding a forthcoming Sherlock Holmes story he wants to publish. Mr Klinger² claims that his story does not infringe upon the original works of Sir Arthur Conan Doyle, and he insists that the characters of Sherlock Holmes and Doctor John Watson, along with their specific traits and characteristics, are in the public domain.

Despite the fact that Sir Arthur Conan Doyle died in 1930, there are ten Sherlock Holmes stories still enjoying copyright protection in the United States. Even though the stories were published as a book in 1927, they had their copyright protection restored in 1981 by Dame Jean Conan Doyle.³ This allowed the Conan Doyle Estate to declare that:⁴

...The facts are that Sir Arthur continued creating the characters in the copyrighted Ten Stories, adding significant aspects of each character's background, creating new history about the dynamics of their own relationship, changing Holmes's outlook on

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¹ *Klinger v Conan Doyle Estate Ltd*, No. 1:13-cv-01226, (N.D. Ill. 14 February 2013).

² Klinger is a technical advisor on Sherlock Holmes matters in Hollywood.

³ Copyright Act of 1976 s304: the author of a work that had passed into the public domain in the US, or his heirs, were entitled to restore the work to copyright in the United States under certain conditions. In 1981, Dame Jean Conan Doyle applied for registration of the copyright of a collection of Sherlock Holmes stories first published as a book in 1927. These stories will enter the public domain in 2023. In the United Kingdom, all of the works of Sir Arthur Conan Doyle entered the public domain in 1980. This amounts to the life of the author plus fifty years.

⁴ *Klinger v Conan Doyle Estate*, No. 1:13-cv-01226, (N.D. Ill. 10 September 2013) – The estate's response in opposition to Klinger's motion for summary judgment pursuant to the United States Federal Rules of Civil Procedure, r56.

the world, and giving him new skills. And Sir Arthur did this in a non-linear way. Each of the Ten Stories is set at various points earlier in the two men's lives—and even late stories create new aspects of the men's youthful character. In other words, at any given point in their fictional lives, the characters depend on copyrighted character development.

Naturally, the Estate's response was that both Sherlock Holmes and Doctor Watson remain under copyright protection, as the characters continue to evolve in the ten copyrighted stories by being given new additional traits.⁵ The reality is that, with regard to American copyright law, two copyright specific questions arise pursuant to this case: (1) Are the main elements of the aforementioned characters in the public domain, despite the existence of the ten copyrighted stories; and (2) can the copyright of all works in a series be extended until the final work enters the public domain? The fictional guesswork brings the case closer to home. One cannot help but wonder what a UK court would have to say about conferring copyright protection on the fictional characters.

C. FOLLOWING THE CLUES

The ability to copyright fictional characters has been recognised in America since the 1930's, following a series of judicial tests. The first test introduced by the court in *Nichols v Universal Pictures Corp.*⁶ was the character delineation test. The test touches on the basics of copyright law by addressing the idea / expression dichotomy as it constitutes its logical extension: "It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly."⁷ This means that a sufficiently delineated character ceases to constitute the non-copyrightable idea; the character instead becomes the expression of the idea. Subsequently, stereotypical characters with common features - the authoritative father or the fair maiden - remain outside copyright protection.

The Ninth Circuit introduced the 'story-being-told' test in *Warner Bros Pictures, Inc. v Columbia Broadcasting Systems.*⁸ This was a case involving the Maltese Falcon character,

⁵ After the time of writing, and, more specifically, on 23 December 2013 the United States District Court for the Northern District of Illinois ruled that the elements of the characters appearing in works currently in the public domain are free to be used. However, no permanent injunction was granted. The Conan Doyle Estate appealed to the Seventh Circuit Court of Appeals on 21 January 2014. Hence, the questions that arise remain relevant.

⁶ *Nichols v Universal Pictures Corp.* 45 F.2d 119 (2d Cir.1930).

⁷ *Ibid* at 221.

⁸ *Warner Bros Pictures, Inc. v Columbia Broadcasting Systems* 216 F. 2d 945 (9th Cir. 1954).

Detective Sam Spade. Despite concluding that the story, rather than the characters as such, was subject to copyright protection in this specific case, the court opined that it might be the case that the actual fictional character “constitutes the story being told.” Thus, a character around which the story evolves, albeit not sufficiently delineated, can attract copyright protection. It is most common, though, for courts within the Ninth Circuit to employ both tests, when it comes to addressing issues of the intellectual property rights associated with fictional characters. Such was the case in affording copyright protection to the famous characters Rocky Balboa, Adrian, and Apollo Creed, in *Anderson v Stallone*.⁹ The characters were found to be both sufficiently delineated and constituting the story being told.

Addressing an issue closer to the Sherlock Holmes case, a problem arises where the fictional character seems to evolve on a story-by-story basis. So-called “dynamic characters” might not appear delineated enough in a single story to pass the delineation test; changes are introduced to the character over time, additional elements are added from story to story. The court in *Metro-Goldwyn-Mayer v American Honda Motor Co.*¹⁰ was faced with the above scenario when called to provide a ruling on the copyright protection of the James Bond fictional character. Indeed, six different actors have portrayed the world famous spy in films spanning over six decades at the time of writing. Notwithstanding, the court found that the character of James Bond bears unique characteristics and “specific qualities that remain constant despite the change in actors”.¹¹ James Bond is both a delineated character and constitutes the story-being-told. Besides:¹²

Audiences do not watch Tarzan, Superman, Sherlock Holmes, or James Bond for the story; they watch these films to see their heroes at work. A James Bond film without James Bond is not a James Bond film.

In consequence, a dynamic character might not be sufficiently delineated in a single story, but should the character evolve “too much” over the course of time, then he becomes the “story-being-told” per the homonymous judicial test.

⁹ *Anderson v Stallone* 11 USPQ2d 1161 (C.D. Cal. 1989).

¹⁰ *Metro-Goldwyn-Mayer v American Honda Motor Co* 900 F. Supp. 1287 (C.D. Cal. 1995).

¹¹ *Ibid.*

¹² *Ibid.*

D. TALES FROM THE PUBLIC DOMAIN

American courts give copyright protection to fictional characters and to “dynamic” evolving characters. It follows that the next logical question is: What happens to dynamic characters that first appeared in works currently in the public domain, should they continue to appear and evolve in works still enjoying copyright protection?

The court in *Silverman v CBS Inc.* addressed this issue.¹³ The court concluded that if a character is delineated enough to enjoy copyright protection at first instance, only the further delineation of that character in copyrighted works is subsequently protected.¹⁴ Character elements in works already in the public domain stay there, and cannot enjoy copyright protection.

This view was upheld in *Pannonia Farms, Inc. v USA Cable*.¹⁵ This was another copyright case centred on the fictional characters of Sherlock Holmes and Doctor Watson. Although the plaintiff lacked standing and the motion was denied, the court concluded, nonetheless, that the characters had been delineated in works already in the public domain. This meant that any copyright protection would have been restricted to those elements present in the works under copyright protection.

The overarching issue of copyright status was not properly addressed by the court in *Pannonia Farms*. Therefore, Leslie Klinger’s plea was of a wider utility, not only for Sherlock Holmes and Doctor Watson, but other fictional characters partially in the public domain yet still under copyright protection. “It is a matter of simple logic that characters may be distinctly delineated for purposes of copyright infringement before all their stories have been told or character traits developed”, claims Klinger. “Otherwise, characters in [a] continuing series would never be protected until the entire series was complete.”¹⁶ It is evident that a character is required to be sufficiently delineated in order to attract protection in the first place. The contrary would mean that continuous sequels could guarantee that the fictional characters in stories remain under copyright protection forever.

This is not the first time that the broader issue of accessing the public domain in American copyright law is under the limelight. More than fifteen years have passed since the

¹³ *Silverman v CBS Inc.* 870 F.2d 40 (2d Cir. 1989).

¹⁴ A J Thomas and J D Weiss, “Evolving standards in copyright protection for dynamic fictional characters” (2013) 29 Communications Lawyer 9 ff.

¹⁵ *Pannonia Farms, Inc. v USA Cable* 426 F.3d 650 (2d Cir. 2005).

¹⁶ A Tohala and T Ohta, “A ‘Sherlockian civil war’ in the US? Klinger v Conan Doyle Estate” (2013) Bristows LLP, available at <http://www.bristows.com/articles/a-sherlockian-civil-war-in-the-us-klinger-v-conan-doyle-estate-by-Tom-Ohta-and-Aida-Tohala#sthash.nNnb2xoS.dpuf>.

Copyright Term Extension Act 1998¹⁷ and more than ten years since *Eldred v Ashcroft*.¹⁸ Many American scholars have commented on the impact perpetual copyright term extension could have, not only in terms of accessing the public domain, but also in terms of balancing copyright and freedom of speech.¹⁹ In addition, the Supreme Court’s decision to uphold the restoration of copyright protection for foreign works that have fallen in the public domain in *Golan v Holder*²⁰ highlights the fact that the “outer limits” of the public domain are less than certain; works can easily cross the threshold of protection. A favourable decision in *Klinger*, apart from securing the uninhibited publication of Mr Klinger’s Sherlock Holmes fiction, signals a much needed victory, albeit a small one, for the public domain.

E. “SPECULATIVE” UK CASE

With the American perspective established, it would be interesting to “investigate” the treatment of fictional characters under copyright law of the United Kingdom.

The Copyright, Designs and Patents Act 1988 (hereafter “CDPA”), confers copyright protection on an exhaustive list of works²¹, contrary to its American counterpart.²² Regarding the CDPA, the only category of work that appears similar to a standalone literary character²³ is indeed the category of literary works under section 3(2) of the 1988 Act.²⁴ Subsequently, does the standalone character represent a substantial part of the work in order to constitute the expression of an idea for the purposes of the 1988 Act, and thus satisfy the aforementioned American delineation test?

¹⁷ The “Sonny Bono Act” extending copyright protection for an additional twenty years. See more at: E Chemerinsky, “Balancing copyright protection and freedom of speech: Why the Copyright Extension Act is unconstitutional” (2002) 36 Loyola of Los Angeles LR 83.

¹⁸ *Eldred v Ashcroft* 537 U.S. 186 (2003), where the constitutionality of the Copyright Term Extension Act was challenged yet determined.

¹⁹ *Pannonia Farms, Inc. v USA Cable* (n 15)

²⁰ *Golan v Holder* 565 U.S. (2012), where section 514 of the Uruguay Round Agreements Act 1994 was found to be compatible with the “limited times” language as per the Copyright Clause of the US Constitution: “To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”

²¹ CDPA 1988 s1(1)(a)-(c). Copyright is a property right which subsists in accordance with this Part in the following descriptions of work—(a) original literary, dramatic, musical or artistic works, (b) sound recordings, films, both F1 and broadcasts, and (c) the typographical arrangement of published editions.

²² 17 U.S. Code s.102 (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.

²³ It should be noted that visual characters are protected as drawings. Thus, our analysis focuses solely on literary characters not accompanied by a visual representation.

²⁴ U Klement, “Copyright protection of unauthorised sequels under the Copyright, Designs and Patents Act 1988” (2007) 18(1) Entertainment LR 13.

More pointedly, courts in the United Kingdom traditionally do not favour the dissection of a story, in terms of conferring protection to only a section of the story.²⁵ Sir Hugh Laddie, a leading academic in intellectual property and High Court judge, said in *Hyperion v Warner Music* that “if the copyright owner is entitled to redefine his work so as to match the size of the alleged infringement, there would never be a requirement for substantiality”.²⁶ This means that the substantiality factor, a test used to determine whether a substantial part of a protected work has been copied, could easily blur the line between what is protected and what is not. To illustrate, should a standalone fictional character constitute a substantial part of a story for the purposes of copyright protection, where an author, having assigned her rights, would be precluded from using the same character in additional works?²⁷

Furthering the argument, Sir Laddie went on to add that “...Tarzan is not Tarzan if he was not previously raised by apes...the subject of copyright protection is the work in which the character appears and not the character itself”.²⁸ For courts in the United Kingdom, all the characteristics, including the traits that make a fictional character delineated, belong to the story itself. As an effect, all issues regarding substantiality would have to be measured against the story as a whole. This would include the plot, the scenes and, of course, the characters.²⁹ Additionally, it should be noted that Sherlock Holmes and Doctor Watson did make a brief appearance in the United Kingdom courts in 1990.³⁰ Lord Vinelott noted that, despite the fact that several common law jurisdictions do so, the United Kingdom does not recognise the conferral of copyright protection to the characters themselves.³¹

F. CONCLUSION

To conclude, it is clear that conferring copyright protection to fictional literary characters is non-justiciable in the United Kingdom, as the principle of substantiality would trigger conceptual discrepancies in determining subsistence of copyright and infringement.³² Thus, according to the standpoint of the courts in the United Kingdom, the character-building elements belong to the story writ large, rather than to the character.

²⁵ *Ibid.*

²⁶ *Hyperion v Warner Music* (1991, unreported) cited in L Bentley and B Sherman, *Intellectual Property Law* (2002) 160 ff.

²⁷ Klement (n 20).

²⁸ *Hyperion v Warner Music* (n 26).

²⁹ Klement (n 20).

³⁰ *Tyburn Productions Ltd v Conan Doyle*, [1991] Ch. 75.

³¹ A McGee and G Scanlan, “Copyright in character, intellectual property rights and the Internet: Part 1” (2005) 16(8) *Entertainment LR* 209.

³² Klement (n 20).

For the *post – Infopaq* reader, though, the early 1990’s rulings might appear antiquarian. As the digital environment has brought the larger conceptualisation of copyright under scrutiny, the fate of fictional characters might still be relevant. In a world where the reproduction of ten words surrounding a search word is found to infringe upon the exclusive copyrights of a rights holder³³, the principle of substantiality seems to take on a whole new dimension. However, the Court of Justice of the European Union, in *Infopaq*, calls upon member states to define what constitutes the expression of an author’s intellectual creation. More pointedly, the court wants clarity on what is original and by extension protected.³⁴ Hence, it is hard to imagine the courts of the United Kingdom departing from their original stance, should a relevant case arise. Nevertheless, *Infopaq* has opened the door for having basic copyright concepts reconsidered in light of European Union harmonisation, and the outcome of a future, similar case of copyrightable subject matter might turn out to be surprising.³⁵

Looking back at the contemporary stories written alongside the works of Sir Arthur Conan Doyle’s crime fiction, it is easy to spot a resemblance between the stories of Sherlock Holmes and those of his literary nemesis Arsène Lupin, the gentleman thief. Maurice LeBlanc’s character was “introduced” to Sherlock Holmes in the short story “Sherlock Holmes Arrives Too Late” in June 1906. Yet, the character needed to be re-introduced as “Herlock Sholmes” when the story was collected in book form, because of objections raised by Sir Arthur Conan Doyle.³⁶ This comes hardly as a surprise, given the traditional relationship between an author and his characters. This dates as far back as the eighteenth century.

As a matter of fact, eighteenth century authors in the United Kingdom tended to have paternal, or custodial, relationships with their characters regarding “unauthorised” uses. This was akin to legal wrongs against a person, despite the absence of relevant provisions in the Statute of Anne.³⁷ This comportment on the part of the authors bears similarities with the stance in civil law jurisdictions, most notably France, where fictional characters enjoy separate copyright protection to this day, provided that they constitute original works

³³ Case C-5/08 *Infopaq International v Danske Dagblades Forening* [2009] ECDR 16.

³⁴ *Ibid.* at para 51.

³⁵ More on “originality” post-*Infopaq* can be found at A Rahmatian, “Originality in UK copyright law: The old ‘skill and labour’ doctrine under pressure” (2013) 44 *International Review of Intellectual Property and Competition Law* 4.

³⁶ As per Maurice LeBlanc’s biographer and other informal sources.

³⁷ Copyright Act 1710; E F Judge, “Kidnapped and counterfeit characters: eighteenth – century fan fiction, copyright law, and the custody of fictional characters” in R McGinnis (ed) *Originality and Intellectual Property in the French and English Enlightenment* (2009) 22 ff.

themselves.³⁸ It appears that *Infopaq* sets a standard closer to the reasoning employed, *inter alia*, by France to confer copyright protection to free standing characters. Does the application of these standards in the United Kingdom signal recognition of copyright protection in areas traditionally outside the reach of copyright, provided that works or parts thereof represent the author's individual creation? What could be the fate of literary characters against this legal backdrop?

Once again, and in light of the *post – Infopaq* harmonisation efforts, one can only speculate on the extent to which the originality requirement will be accepted by the courts in the United Kingdom. It appears that the fate of a literary character is uncertain in both space and time. The United States confers protection to fictional characters, but simultaneously risks the provision of uninhibited access to works in the public domain by keeping its limits in flux. The courts in the United Kingdom seem to employ the same reasoning as their American counterparts. This is done in order to rule against the possibility of protecting the same characters. Whereas the favourable court ruling in *Klinger v Conan Doyle Estate* does aid the characters of Sherlock Holmes and Dr Watson in entering new adventures, copyright history serves as a primer. This history points to a literary world with closer links to author's rights than the current state of the law in the United Kingdom.

³⁸ Court of Appeal of Paris (4th chamber, A section), 8 September 2004 – *Publicis Conseil and Luc Besson v the companies Gaumont and SFR*: “it is possible for a fictional character, on condition that it constitutes an original work, to be protected and its reproduction without its originator's authorisation, particularly if it is immediately identifiable, to constitute copyright infringement.”