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## Distinctly Delineated Fictional Characters That Constitute The Story Being Told: Who Are They And Do They Deserve Independent Copyright Protection?

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# Distinctly Delineated Fictional Characters That Constitute The Story Being Told: Who Are They And Do They Deserve Independent Copyright Protection?

Jasmina Zecevic\*

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Usually copyright law protects a fictional character within the context of the work in which the character appears. In these cases, infringement is found if the alleged infringer had access to the copyrighted work and there is substantial similarity between the copyrighted work and the allegedly infringing work.<sup>1</sup> Access is easy to

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prove if the original work is widely available to the public. Substantial similarity, however, is much more difficult to determine. One limiting principle is that copyright protection extends only to the expression of an idea and not to the idea itself.<sup>2</sup>

In determining whether there is substantial similarity between the expression of ideas in two different works, courts have sometimes used the “extrinsic” test, where the plot, characters, setting, dialogue and other details of the two works are compared.<sup>3</sup> Other courts have turned to a more “intrinsic” test, where “[t]he two works involved . . . [are] considered and tested, not hypercritically or with meticulous scrutiny, but by the observations and impressions of the average reasonable reader and spectator.”<sup>4</sup> Another test, articulated by Judge Hand, is the “abstraction test,” where details of a work are gradually left out so that the work becomes more and more general.<sup>5</sup> At some point the work is so general that to protect it would translate into protecting the copyright owner’s ideas rather than his expression.<sup>6</sup>

As is evident by the number of different tests used, it is often difficult to determine if an allegedly infringing work has taken enough of the expression of the original to satisfy the “substantially similar” standard of copyright infringement. The problem is further complicated when we consider whether literary characters deserve separate and independent protection.

The issue of separate protection for literary characters arises when the character is removed from the original work, so that the character leads a new and independent life in a separately written piece. Characters that are capable of leading independent lives are those who are especially memorable, such that they stay in a reader’s imagination long after the original storyline is forgotten. An author seeking to write a new adventure for Superman, Tarzan, or Sherlock Holmes, must be aware of the legal considerations involved. When the character is separated from his original copyrighted work, the determination of the legal protection to which the character itself is entitled is difficult to determine.

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1. Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp., 562 F.2d 1157, 1164 (9th Cir. 1977).

2. Mazer v. Stein, 347 U.S. 201, 217-18 (1954); Baker v. Selden, 101 U.S. 99, 102-03 (1879).

3. Twentieth Century-Fox Film Corp. v. Stonesifer, 140 F.2d 579, 582 (9th Cir. 1944).

4. *Id.* (footnotes omitted).

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

6. *Id.*

A few years ago the topic of character protection arose when the estate of Vladimir Nabokov sued Pia Pera, the author of *Lo's Diary*, for copyright infringement.<sup>7</sup> *Lo's Diary* makes extensive use of Lolita and Humbert, the main characters of Nabokov's 1955 copyrighted novel, *Lolita*.<sup>8</sup> Unlike *Lolita*, which is told from Humbert's point of view, *Lo's Diary* tells the story from Lolita's point of view.<sup>9</sup> The parties ultimately settled,<sup>10</sup> presumably in part because of the uncertainty regarding protection of literary characters. However, *Lo's Diary* is not the only work where authors have borrowed characters from other novels. For instance, a novel by Valerie Martin retells the story of Dr. Jekyll and Mr. Hyde from the point of view of Mary Reilly, the doctor's maid.<sup>11</sup> Another example is Tom Stoppard's use of two minor characters from Shakespeare's *Hamlet* in the play *Rosencrantz and Guildenstern are Dead*.<sup>12</sup> Finally, a novel, *Wide Sargasso Sea*, was written about Mrs. Rochester, the mysterious crazed first wife from the novel *Jane Eyre*.<sup>13</sup>

On one hand, characters could be copyrighted separately so that the same character or a substantially similar character could not appear in a new work without the author's permission. This approach would clearly limit the building blocks, or raw material, that other authors have to work with in a way that would likely hinder creativity. On the other hand, characters could be denied copyright protection altogether, such that the copyright in the original work would not extend to the characters. In this case, an author could labor for months developing a memorable character that would bring joy to generations of readers, only to have that character copied and placed in any story the copier pleases. Such treatment may prove to offer too little incentive for original authors to exert the effort needed to create extraordinary characters.

It is clear that there is a need to strike a balance between giving authors enough incentive to create remarkable characters and leaving enough raw materials in the public domain upon which authors can build. Courts have tried to formulate tests for

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7. Ralph Blumenthal, *Nabokov Son Files Suit To Block a Retold 'Lolita'*, N.Y. TIMES, Oct. 10, 1998, at B9.

8. *Id.*

9. *Id.*

10. David D. Kirkpatrick, *Court Halts Book Based on 'Gone With the Wind'*, N.Y. TIMES, April 21, 2001, at A1.

11. See Valerie MARTIN, *MARY REILLY* (Doubleday 1990).

12. See TOM STOPPARD, *ROSENCRANTZ AND GUILDENSTERN ARE DEAD* (Grove Press 1967).

13. See JEAN RHYS, *WIDE SARGASSO SEA* (Norton 1966).

determining when a character deserves independent copyright protection that keep in mind the need for balancing, but much uncertainty still exists regarding the protection of literary characters.

Part I of this paper discusses the characteristics that make literary characters especially difficult to protect. Part II describes the historical treatment of literary characters and the two main tests used to determine whether they are entitled to independent copyright protection. Part III demonstrates that the two tests currently used are not adequate tools for determining when copyright law protects literary characters. Part IV explores the possibility of using trademark and unfair competition laws to offer partial protection to fictional characters. Part V presents an argument that literary characters do not need independent protection because they are already sufficiently protected by the copyright in the original work when supplemented by the protection offered by trademark and unfair competition laws. Part V also argues that the tests created for determining when fictional characters are protected adds nothing of value that is not already found in the substantial similarity test.

#### I. WHY ARE LITERARY CHARACTERS SO DIFFICULT TO PROTECT?

Literary characters are especially hard to protect because they have a “tangible existence only in the specific words, pictures, and sounds created by [their] author.”<sup>14</sup> Each reader uses these descriptions to come up with their own mental image of the character.<sup>15</sup> Different readers interpret the author’s description of a character in unique ways; they fill in the gaps left by the author and make judgments and presumptions about the character using their own individual sets of values. “An independent character, therefore, is difficult to define or grasp clearly, since no two minds will conceive of it in precisely the same way.”<sup>16</sup>

Defining a particular character is also difficult because authors – or good authors, at least – do not simply list all of the characteristics of their fictional characters at the beginning of a work. A character develops throughout the book, through its interactions with others, as well as through its accomplishments, failures and reactions to difficult situations. Because descriptions of characters are often scattered

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14. Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 430 (1986).

15. *Id.* at 430-31.

16. *Id.* at 431.

throughout a work and continuously change and build, a character's complete identity can be very difficult to grasp and clearly define.

Determining whether a literary character is independently entitled to copyright protection poses a more difficult problem than determining whether a literary work as a whole should receive such protection. While neither determination is easy, at least an entire literary work has distinct and definable elements, such as a beginning, middle and end, which can be compared to another work. Furthermore, an entire work has a plot that follows a specific sequence, a set of characters, a setting, and a mood—all elements that can be compared. The description of a character, on the other hand, is scattered throughout the book and the mental image of the character continuously changes and develops within the reader's mind as the story unfolds. As a result, when comparing two characters to see if one substantially infringes another, it is difficult to articulate exactly what is entitled to copyright protection. When one cannot clearly define or limit a character, a comparison of that character with a potentially infringing one is especially difficult.

In contrast, graphically depicted characters do not suffer from the same elusiveness as non-graphically depicted literary characters and have therefore received different treatment. In a long line of cases, courts found that cartoon characters are protected by copyright even when elements of plot are not copied.<sup>17</sup> Graphic characters are not treated differently because they are more deserving of protection, but rather because "it is far simpler to make visual comparisons than to compare abstractions."<sup>18</sup>

## II. HISTORICAL TREATMENT OF LITERARY CHARACTERS

Despite the difficulty inherent in establishing independent legal protection for literary characters, courts have articulated two main tests for determining when a character deserves independent copyright protection. The first test was termed the "distinctly delineated" test and the second test has been referred to as the "story being told" test.<sup>19</sup>

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17. See *Warner Bros., Inc. v. Am. Broad. Cos.*, 720 F.2d 231, 240 (2d Cir. 1983); *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 619 (7th Cir.1982); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 754 (9th Cir. 1978).

18. Kurtz, *supra* note 14, at 451.

19. *Warner Bros. Pictures Inc. v. Columbia Broad. Sys.*, 216 F.2d 945, 950 (9th Cir. 1954) (discussing analysis in *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930)).

The possibility of protecting literary characters seemingly originated in *Nichols v. Universal Pictures Corp.*<sup>20</sup> The plaintiff in that case was the author of the play *Abie's Irish Rose*, which is about a Jewish boy marrying an Irish-Catholic girl.<sup>21</sup> The play follows the conflict which the couples' union causes within their religious families, but ultimately has a happy ending. The plaintiff alleged that the defendant's motion picture *The Cohens and the Kelleys* infringed upon her play.<sup>22</sup> The defendant's movie is about a Jewish girl and an Irish-Catholic man who marry and the trouble that their marriage causes within their families.<sup>23</sup> The movie also ends happily with the families reconciling.<sup>24</sup>

In the course of his decision, Judge Hand mentioned the possibility that characters could be protected "independently of the 'plot'" even though such a case had not previously arisen.<sup>25</sup> He explained that:

If *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's "ideas" in the play, as little capable of monopoly as Einstein's Doctrine of Relativity, or Darwin's theory of the Origin of Species. 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.<sup>26</sup>

This analysis by Judge Hand gave rise to the "distinctly delineated" test.

The "distinctly delineated" test rests on the principle that the more developed a character is, the more it embodies protectable expression and less a general idea.<sup>27</sup> Courts since *Nichols* have developed a two-part test from Judge Hand's discussion, which has become the standard employed in character infringement cases.<sup>28</sup> The first question under the test is "whether the character was created

20. 45 F.2d 119.

21. *Id.* at 120.

22. *Id.*

23. *Id.*

24. *Id.*

25. *Id.* at 121.

26. *Id.*

27. See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.12 (Matthew Bender & Co. ed. 2004) [hereinafter NIMMER].

28. See *id.*; Gregory S. Schienke, *The Spawn of Learned Hand – A Reexamination of Copyright Protection and Fictional Characters: How Distinctly Delineated Must the Story Be Told?*, 9 MARQ. INTEL. PROP. L. REV. 63, 68-69 (2005).

with enough delineation to afford copyright protection.”<sup>29</sup> Only if the character is sufficiently developed so that it constitutes more than just an idea, and therefore is worthy of copyright protection, should one move on to the next step. The second question is whether “the alleged infringer cop[ied] such development and not merely a broader and more abstract outline.”<sup>30</sup> To establish an infringement there must be actual copying of expression rather than copying of ideas or using a general type of character.<sup>31</sup>

The Ninth Circuit formulated the second major standard for determining whether characters deserve independent copyright protection in *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System*.<sup>32</sup> In that case an author, Hammett, composed a mystery detective story called *The Maltese Falcon*, whose main character was a detective named Sam Spade.<sup>33</sup> Hammett then granted Warner Brothers exclusive rights to use *The Maltese Falcon* story in movies, radio and television.<sup>34</sup> Hammett later used Sam Spade as the main character in new stories, and Warner Brothers complained that it had acquired the exclusive right to use the writing, *The Maltese Falcon*.<sup>35</sup> Warner Brothers argued that the license included the individual characters, their names and the title.<sup>36</sup> Hammett argued that the exclusive use of the characters and their names was not granted in the license, and that he could therefore use them in subsequent stories.<sup>37</sup>

The Court held that Hammett did not grant the rights to the characters in the license to Warner Brothers and that Hammett could use the Sam Spade character in subsequent stories.<sup>38</sup> The Court explained that the argument set forth by Warner Brothers was “unreasonable, and would effect the very opposite of the statute’s purpose which is to encourage the production of the arts.”<sup>39</sup> The Court went on to reason, however, that “[i]t is conceivable that the character

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29. Mathew A. Kaplan, Note, *Rosencrantz and Guildenstern Are Dead, But Are They Copyrightable?: Protection of Literary Characters With Respect To Secondary Works*, 30 RUTGERS L.J. 817, 823 (1999); see also NIMMER, *supra* note 27, §2.12.

30. NIMMER, *supra* note 27, §2.12.

31. *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954) (footnotes omitted) (“protection is given only to the expression of the idea – not the idea itself”).

32. 216 F.2d 945 (1954).

33. *Id.* at 948.

34. *Id.*

35. *Id.* at 948.

36. *Id.*

37. *Id.*

38. *Id.* at 949.

39. *Id.* at 950.



really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright."<sup>40</sup> The Court concluded that even if Hammett had assigned the complete rights to Warner Brothers he could still use his characters in subsequent stories because "[t]he characters were vehicles for the story told, and the vehicles did not go with the sale of the story."<sup>41</sup>

This test, which became known as the "story being told" test, greatly narrowed the protection available for literary characters.<sup>42</sup> In fact, the standard excluded "virtually any character from copyright protection, because it 'seems to envisage a story devoid of plot wherein character study constitutes all, or substantially all, of the work.'"<sup>43</sup> The standard has been criticized and many courts have declined to use it, distorted its meaning to avoid its consequences, or ignored it and applied the *Nichols* test instead.<sup>44</sup> Despite this stringent standard, courts have found certain characters, such as Rocky and James Bond, to constitute the "story being told."<sup>45</sup> In both these cases, however, the court also included an analysis under the "distinctly delineated" test.<sup>46</sup>

If the two main standards used to determine when literary characters are entitled to copyright protection seem vague and confusing, that is because they are. The following section outlines some of the problems with both the "distinctly delineated" and the "story being told" standard.

### III. SHORTCOMINGS OF THE "DISTINCTLY DELINEATED" AND "STORY BEING TOLD" TESTS IN DECIDING WHICH CHARACTERS TO PROTECT

The "distinctly delineated" standard is difficult to apply for three main reasons: the test is vague and asks judges to assume the role of literary critic; judges often apply it incorrectly, which leads to overprotection; and it does not necessarily protect the most developed characters.<sup>47</sup> The "distinctly delineated" test clarifies that more-

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40. *Id.*

41. *Id.*

42. NIMMER, *supra* note 27, §2.12.

43. Kurtz, *supra* note 14, at 455 (quoting NIMMER, *supra* note 27, §2.12).

44. *Id.*

45. See *Anderson v. Stallone*, No. 87-0592 WDK, 1989 U.S. Dist. LEXIS 11109, at \*20-23 (C.D. Cal. Apr. 25, 1989); see also *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1296 (C.D. Cal. 1995).

46. See *MGM*, 900 F. Supp. at 1296; *Anderson*, No. 87-0592 WDK, 1989 U.S. Dist. LEXIS 11109, at \*20-23 .

47. Kurtz, *supra* note 14, at 457-59.

developed characters deserve more protection.<sup>48</sup> However, beyond this notion, the test does not provide much guidance. Courts have not explained what exactly makes a character “distinctly delineated” enough to warrant protection. Judges are left to act as literary critics and decide on their own which fictional characters deserve protection and which lack sufficient development. As one commentator has noted, “[w]hat makes a fictional character worthy of protection seems to require Justice Stewart’s ‘I know it when I see it’ test.”<sup>49</sup>

The problem with trying to clearly articulate the reasons why a certain character is considered “distinctly delineated” is demonstrated in *Burroughs v. Metro-Goldwyn-Mayer, Inc.*<sup>50</sup> The court there held that the character “Tarzan” was distinctly delineated and sufficiently developed so as to be copyrightable.<sup>51</sup> The court’s description of Tarzan, however, does not actually convey what makes the character sufficiently developed or distinctly delineated. The court’s description was as follows: “Tarzan is the ape-man. He is an individual closely in tune with his jungle environment, able to communicate with animals yet able to experience human emotions. He is athletic, innocent, youthful, gentle and strong. He is Tarzan.”<sup>52</sup> The problem with this description is that it seems like more of a general character type, which can apply equally as well to other literary characters, such as Kipling’s “Mowgli” from *The Jungle Book*.<sup>53</sup>

The *Burroughs* case demonstrates that a comparison of two works would offer a more convincing and less arbitrary argument for why “Tarzan” should be protected. However, the judge in that case had no other characters with which to compare “Tarzan.” Unfortunately, the issue in that case was not infringement, but whether a grant of the right to use the character arose under copyright.<sup>54</sup> In order to determine whether a grant of a nonexclusive license to use the “Tarzan” character was a right under copyright, and therefore subject to the termination provisions of the Copyright Act, the court had to determine whether “Tarzan” was “sufficiently delineated to be copyrightable.”<sup>55</sup>

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48. See NIMMER, *supra* note 27, §2.12.

49. Schienke, *supra* note 28, at 80.

50. 519 F. Supp. 388 (S.D.N.Y. 1981).

51. *Id.* at 391.

52. *Id.*

53. *Id.*; see Kurtz, *supra* note 14, at 458.

54. *Burroughs*, 519 F.Supp. at 391.

55. Kurtz, *supra* note 14, at 458 n.167.

The *Burroughs* case is still illustrative of the difficulty in trying to determine whether or not a character is sufficiently developed. As one commentator has noted, “[a]ttempting to determine the extent of a character’s development, without making comparisons, leads to abstract and fruitless speculation.”<sup>56</sup> Inevitably, a description of a character used to demonstrate why that character is distinctly delineated ends up reading like a description of a general type and “covers the pattern of many characters.”<sup>57</sup> The presence of these inherent problems with attempting to designate a character “distinctly delineated” or “well developed” leads to the conclusion that this test is not helpful or proper for determining when literary characters deserve independent protection.

Perhaps, because of the lack of guidance, courts have begun overprotecting characters by considering only whether they are copyrightable, and not whether there has been actual infringement. By considering whether a character is sufficiently delineated to receive copyright protection, and then automatically finding infringement without comparing the two works to determine whether one is substantially similar to the other, these courts seem to concentrate exclusively on the first part of the *Nichols* test. For instance, in another case involving “Tarzan,” the court found that defendant’s adult movie entitled *Tarz & Jane & Boy & Cheeta* infringed upon the plaintiff’s literary work.<sup>58</sup> The court began by explaining that the characters were distinctly delineated, but then automatically, without further analysis, found the defendant’s characters to be substantially similar, and therefore infringing.<sup>59</sup>

Another example of a court concentrating solely on the copyrightability of a character is the “Hopalong Cassidy” case.<sup>60</sup> The “Cassidy” character portrayed in the book was tough, confrontational, and prone to violence, cursing, and tobacco-chewing.<sup>61</sup> The “Cassidy” character in the movie, however, was more of a cleaned up version, appearing kind and sentimental and without the cursing.<sup>62</sup> Despite this lack of similarity between the two characters, the court held that

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56. *Id.* at 463-64.

57. *Id.* at 464.

58. *Edgar Rice Burroughs, Inc. v. Manns Theatres*, No. 76-3612, 1976 U.S. Dist. LEXIS 11754, at \*10 (C.D. Cal. Dec. 20, 1976).

59. *Id.* at 9-10.

60. *Filmvideo Releasing Corp. v. Hastings*, 509 F. Supp. 60 (S.D.N.Y. 1981).

61. Kurtz, *supra* note 14, at 459 (describing expert witness testimony as to a description of the book version of Cassidy).

62. *Id.*

the “Hopalong Cassidy” character in the book was distinctly delineated, and that the use of the character would be copyright infringement “irrespective and independent of the similarity of the story line.”<sup>63</sup> The court further held that the “Cassidy” character in the motion picture was “substantially similar to the character ‘Hopalong Cassidy’ in the books, and [that] both characters exhibit the same basic traits.”<sup>64</sup> As one commentator noted, the movie “Cassidy” and the book “Cassidy” shared little similarity beyond their name and cowboy background, but Judge Werker got around this lack of similarity and “simply described the movie Cassidy as Mulford’s Cassidy ‘turned inside out.’”<sup>65</sup>

These cases demonstrate that courts in an infringement action sometimes determine only whether a character is copyrightable or distinctly developed without also comparing the original and allegedly infringing characters. One author described this truncated analysis as courts using “the ‘magically expedient’ phrase of ‘well developed’ to arrive [at and] solidify their reasoning.”<sup>66</sup> The magic words “well developed” or “distinctly delineated,” however, do not tell us anything about whether the two characters are substantially similar, or whether enough of the original was taken to constitute copyright infringement.

Apart from being employed in a way that is susceptible to overprotection of characters, the “distinctly delineated” test is also flawed because it does not necessarily offer protection for the most developed characters. In fact, “[t]he most well-rounded characters, those that are the most fully human, may be the most inextricably bound to their context.”<sup>67</sup> For instance, it is questionable whether a reader would be able to recognize the character of Raskolnikov in a new story, despite the fact that *Crime and Punishment* centers on the character’s internal conflict, thoughts, and feelings of alienation and self loathing to a degree that makes Raskolnikov seem very real.<sup>68</sup> Instead, the “flatter character,” the one that does not change through

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63. *Filmvideo*, 509 F. Supp. at 66.

64. *Id.* at 64.

65. Francis Nevins, *Copyright + Character = Catastrophe*, 39 J. COPYRIGHT SOC’Y U.S.A. 303, 313 (1992).

66. Schienke, *supra* note 28, at 81.

67. Kurtz, *supra* note 14, at 464.

68. See ETIENNE BENSON & WENDY CHENG, SPARKNOTE ON CRIME AND PUNISHMENT, <http://www.sparknotes.com/lit/crime/characters.html> (last visited Mar. 21, 2006).

experiences but is always consistent, is the character that is the most recognizable when removed from the original work.<sup>69</sup>

An example of a “flatter character” that receives copyright protection is Sherlock Holmes. Sherlock Holmes has been described as a very limited and predictable character, to the extent that he is almost formulaic.<sup>70</sup> Sir Arthur Conan Doyle, the author of the Sherlock Holmes novels, had grown tired of Holmes “because his character admits of no light or shade.”<sup>71</sup> However, Sherlock Holmes is one of those characters that is considered well-developed and thus deserving of copyright protection.<sup>72</sup> As Kurtz pointed out, “[a] more rounded character, however, is remembered in connection with the scenes ‘through which she passed and as modified by these scenes – that is to say, we do not remember her so easily because she waxes and wanes and has facets like a human being.’”<sup>73</sup>

Because determining which characters are developed enough to deserve protection is so difficult, a test allowing judges to reach decisions based on the magic words “well developed” does not seem to be a desirable solution. As one commentator pointed out, “[t]here is no reason to credit judges with the ability to function as literary or artistic critics of last resort.”<sup>74</sup> Although the “distinctively delineated” test was initially developed to include a comparison of the original character and the potentially infringing one in order to determine whether they are substantially similar, courts in general have selectively ignored this second part of the *Nichols* test.

All of the criticisms of the “distinctly delineated” test apply equally well to the “story being told” test. The “story being told” test offers a distinction between a character that “constitutes the story being told” and one that is “only the chessman in the game of telling the story . . . .”<sup>75</sup> However, according to one scholar, “[w]hat this distinction is supposed to mean, how any court could conceivably use it to divide protected from unprotected characters, and what gives a federal judge the aesthetic credentials to draw this line, are matters

69. Kurtz, *supra* note 14, at 464.

70. *Id.* at 465.

71. *Id.* (quoting Conan Doyle, *Sidelights on Sherlock Holmes*, in *THE BAKER STREET READER* 12, 14 (Philip A. Shreffler ed., 1984)).

72. *Id.*

73. *Id.* at 465 (quoting Doyle, *supra* note 71, at 106). “A round character is capable of surprising in a convincing way. If it never surprises, it is flat. If it does not convince, it is a flat pretending to be round.” *Id.* (quoting Doyle, *supra* note 71, at 118).

74. *Id.* at 438.

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

on which Judge Stephens maintains a sphinxlike silence.”<sup>76</sup> The result is that the test is applied inconsistently, not at all, or in combination with the “distinctly delineated” test.<sup>77</sup> However when the test is applied, the results are unpredictable and confusing.

#### IV. TRADEMARK AND UNFAIR COMPETITION

As explained above, the tests for determining protection of literary characters under copyright law are confusing, difficult to apply, and often yield unpredictable results. The difficult application of the “distinctly delineated” and “story being told” tests has led legal scholars to examine alternate grounds for offering protection to literary characters. Trademark and unfair competition are the primary alternatives to copyright suggested by scholars.<sup>78</sup> For instance, Gerald Jagorda has pointed out, “[w]here the concept of copyright is intended to protect the creative expression existing within a character, trademark and unfair competition laws are concerned with a character’s capacity to symbolize a particular source of goods or services.”<sup>79</sup> The critical issue under both state unfair competition laws and the federal trademark laws is whether the alleged infringer’s use of a character is “likely to cause public confusion.”<sup>80</sup> Unfair competition encompasses the narrower law of trademark,<sup>81</sup> which protects against “any false designation of origin, false or misleading description of fact, or false or misleading representation of fact” that is “likely to “cause confusion, or to cause mistake, or to deceive as to the

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76. Nevins, *supra* note 65, at 315.

77. See *Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990) (court not considering the “story being told” test in this character infringement case); *Anderson v. Stallone*, No. 87-0592 WDK, 1989 U.S. Dist. LEXIS 11109 (C.D. Calif. Apr. 25, 1989) (noting that the distinctly delineated test is “simple in theory but elusive in application” and that the Ninth Circuit has cast doubt on the reasoning of the “story being told” test, deciding in the end to apply both tests because of the unsettled state of the law); see also David B. Feldman, *Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection*, 78 CAL. L. REV. 687, 691 (1990) (explaining that the test was never widely accepted or used).

78. Kenneth E. Spahn, *The Legal Protection of Fictional Characters*, 9 U. MIAMI ENT. & SPORTS L. REV. 331, 342 (1992).

79. Gerald Jagorda, *The Mouse That Roars: Character Protection Strategies of Disney and Others*, 21 T. JEFFERSON L. REV. 235, 243 (1999).

80. Leslie A. Kurtz, *The Methuselah Factor: When Characters Outlive Their Copyrights*, 11 U. MIAMI ENT. & SPORTS L. REV. 437, 442 (1994).

81. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 2.02 (3d ed. 1994).

affiliation, connection, or association of such person with another person, or as to the origin . . . .”<sup>82</sup>

Two questions must be answered to determine if infringement under trademark law and unfair competition has taken place.<sup>83</sup> The first is whether the character has achieved “secondary meaning” or in other words, whether “the public associate[s] the character’s name with the particular product being sold.”<sup>84</sup> The second question is whether there is a likelihood of confusion or whether “the use of the character’s name by another [is] likely to deceive and confuse the public as to the source of the goods.”<sup>85</sup>

There are several advantages to trademark and unfair competition protection over copyright protection for literary characters. First, trademark and unfair competition offer protection of the name, appearance, costumes, and key phrases of a character; all things left unprotected by copyright.<sup>86</sup> Another significant advantage is that “[t]he fact that a copyrightable character or design has fallen into the public domain [does] not preclude protection under the trademark laws so long as it is shown to have acquired independent trademark significance . . . .”<sup>87</sup> Therefore, trademark and unfair competition protection may extend well beyond the copyright term, as long as the character keeps its secondary meaning, and a likelihood of public confusion would exist if another author created or used the same or a similar character.

Unfair competition and trademark laws have been used by courts to support protection of various aspects of fictional characters. In one case, the name and appearance of Charlie Chaplin were found to be protected by these doctrines.<sup>88</sup> The defendant appeared in films dressed and acting like the “Charlie Chaplin” character, but under the name “Charlie Aplin.”<sup>89</sup> The court found that the defendant’s purpose

82. 15 U.S.C. § 1125(a)(1) (2000).

83. Spahn, *supra* note 78, at 342.

84. *Id.* (citing MCCARTHY, *supra* note 81, § 23:1 (2d. ed 1984); NIMMER, *supra* note 27, § 2.16; *see also* Universal City Studios, Inc. v. Nintendo Co., 746 F.2d 112, 115 (2d Cir. 1984); Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem Mfg., 510 F.2d 1004, 1012 (5th Cir. 1975); Sunbeam Furniture Corp. v. Sunbeam Corp., 191 F.2d 141, 144 (9th Cir. 1951); Tomlin v. Walt Disney Prods., 96 Cal. Rptr. 118, 123 (1971).

85. Spahn, *supra* note 78, at 342.

86. Kurtz, *supra* note 14, at 481; *see, e.g.*, Lone Ranger, Inc. v. Cox, 124 F.2d 650, 652 (4th Cir. 1942) (protecting “Hi, yo, Silver, away”).

87. Frederick Warne & Co. v. Book Sales, Inc., 481 F. Supp. 1191, 1198 (S.D.N.Y. 1979).

88. Chaplin v. Amador, 269 P. 544, 546 (Cal. Ct. App. 1928).

89. *Id.* at 545.

was to deceive the film-going public into believing it was paying to see Charlie Chaplin to secure a larger audience, and enjoined the defendant from further imitating the plaintiff.<sup>90</sup> In another case, a defendant was enjoined under the law of unfair competition from using the name of famous author Frank Merriwell, even though the defendant did not copy any of the plaintiff's stories.<sup>91</sup> The court found that the name "has become descriptive, and is closely identified in the public mind with the work of a particular author," so that the defendant's use of the name could mislead the public.<sup>92</sup>

A character's name was also protected in a case where a radio host known as "the Old Maestro" advertised the plaintiff's beer and malt beverages.<sup>93</sup> The defendant started using the name "Old Maestro Brew" for its own beer.<sup>94</sup> The court found that the radio audience knew that the Old Maestro's radio show was sponsored by the plaintiff and associated the defendant's use of the name "Old Maestro Brew" with both the plaintiff's products and the radio host.<sup>95</sup> The court therefore enjoined the defendant from using the name because it was likely to cause confusion.<sup>96</sup>

Similarly, the name "Tarzan" was protected, not only in copyright, as mentioned above, but under trademark law, in the case where the defendant advertised an X-rated film by the name *Tarz & Jane & Boy & Cheeta*.<sup>97</sup> The court held that by using the name the defendant could mislead the public about the source or origin of the film and cause the public to mistakenly think the defendant's movie was authorized or produced by the plaintiff.<sup>98</sup>

The appearance and costumes of characters have also been protected under trademark and unfair competition laws. For example, in a case where the plaintiff owned the copyrights and trademarks relating to the characters "Superman" and "Wonder Woman," the defendant was enjoined from using similar characters in his

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90. *Id.* at 546.

91. *Patten v. Superior Talking Pictures*, 8 F. Supp. 196, 197 (S.D.N.Y. 1934).

92. *Id.*

93. *Premier Pabst Corp. v. Elm City Brewing Co.*, 9 F. Supp. 754, 756 (D. Conn. 1935).

94. *Id.*

95. *Id.*

96. *Id.* at 761.

97. *Edgar Rice Burroughs, Inc. v. Manns Theatres*, No. 76-3612, 1976 U.S. Dist. LEXIS 11754, at \*10 (C.D. Cal. Dec. 20, 1976).

98. *Id.*



business.<sup>99</sup> The defendant operated a singing telegram company that featured characters named "Superstud" and "Wonderwench," who dressed in costumes similar to the original characters and carried balloons depicting Superman and Wonder Woman.<sup>100</sup> The court found that the public was likely to be confused as to the source and sponsorship of the singing telegram service.<sup>101</sup> The court also found that the defendant was benefiting from the good will created by the plaintiff's mark.<sup>102</sup>

Although trademark and unfair competition have been effectively used to protect elements of fictional characters, there are some disadvantages to this form of protection. In order to receive such protection, a character must acquire "secondary meaning;" the public must identify the character with a single source, and there must be a likelihood of public confusion if another author were to use the same or a similar character.<sup>103</sup>

The requirement that a character acquire "secondary meaning" leaves new, unsuccessful, or simply less well known literary characters unprotected.<sup>104</sup> The only characters that receive protection under trademark and unfair competition law are ones that are known to the public and have "undergone some reasonable degree of circulation."<sup>105</sup> For instance, the names of cartoon characters "Ziggy"<sup>106</sup> and "Melvin the Monster"<sup>107</sup> were not protected under trademark and unfair competition against the defendants' use of identical names in their work. Because the characters were not well known to the public and had almost no circulation, the public did not associate those characters with a particular source and thus there was little likelihood of confusion regarding the defendants' use of the names.<sup>108</sup>

Similarly, the rodeo character "Paladin" was not extended protection because he was not widely known and therefore could not have acquired secondary meaning.<sup>109</sup> The plaintiff, De Costa, made

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99. DC Comics, Inc. v. Unlimited Monkey Bus., Inc., 598 F. Supp. 110, 119-20 (N.D. Ga. 1984).

100. *Id.* at 114.

101. *Id.* at 115.

102. *Id.*

103. Spahn, *supra* note 78, at 344.

104. *Id.*

105. Kurtz, *supra* note 80, at 443.

106. Pellegrino v. Am. Greetings Corp., 592 F. Supp. 459 (D.S.D. 1984).

107. Gantz v. Hercules Publ'g Corp., 182 N.Y.S.2d 450 (Sup. Ct. 1959).

108. Kurtz, *supra* note 14, at 481.

109. DeCosta v. Columbia Broad. Sys., Inc., 520 F.2d 499, 513 (1st Cir. 1975).

public appearances at rodeos where he entertained children by dressing up in a cowboy costume as a character named Paladin.<sup>110</sup> He carried with him a business card inscribed with a chess knight and the phrase "Have Gun Will Travel, Wire Paladin, N. Court St., Cranston, R.I."<sup>111</sup> He wore all black and had a St. Mary's medal affixed to his hat.<sup>112</sup> The plaintiff dressed up as "Paladin" solely to entertain people.<sup>113</sup> Years after the plaintiff began appearing as "Paladin," defendants produced a television show that copied the "Paladin" character, including the name, appearance, and the use of a card with the phrase "Have Gun, Will Travel, Wire Paladin, San Francisco."<sup>114</sup> The court acknowledged that the defendants had copied, but found there was no likelihood of confusion as to the source of the television show.<sup>115</sup> The original Paladin was therefore denied relief despite the high degree of copying. The only issue the court found relevant to its analysis was that there was no likelihood of public confusion.<sup>116</sup>

Even characters that are well known may not be protected if they are associated with more than one source. In order to obtain protection a literary character must be associated with a single source.<sup>117</sup> In many cases, however, association with a single source is a "convenient fiction" for literary characters, as they have often been associated with their authors,<sup>118</sup> producers,<sup>119</sup> sponsors,<sup>120</sup> and even with themselves.<sup>121</sup>

For instance, the character "King Kong" was denied protection under trademark or unfair competition because it was not associated

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110. *Id.* at 502.

111. *Id.*

112. *Id.*

113. *Id.* at 511.

114. *Id.* at 509.

115. *Id.* at 515.

116. *See id.*

117. Kurtz, *supra* note 80, at 442.

118. *See, e.g.,* Gruelle v. Molly-'Es Doll Outfitters, Inc., 94 F.2d 172, 176 (3d Cir. 1937); Patten v. Superior Talking Pictures, Inc., 8 F. Supp. 196, 197 (S.D.N.Y. 1934); Fisher v. Star Co., 132 N.E. 133, 139 (N.Y. 1921).

119. Processed Plastic Co. v. Warner Commc'ns, Inc., 675 F.2d 852, 856 (7th Cir. 1982); Wyatt Earp Enters. v. Sackman, Inc., 157 F. Supp. 621, 625 (S.D.N.Y. 1958); *see also* Kurtz, *supra* note 14, at 485.

120. Premier-Pabst Corp. v. Elm City Brewing Co., 9 F. Supp. 754, 761 (D. Conn. 1935); *see also* Kurtz, *supra* note 14, at 485.

121. DC Comics, Inc. v. Unlimited Monkey Bus., 598 F. Supp. 110, 115 (N.D. Ga. 1984); *see also* Kurtz, *supra* note 14, at 485.

with a single source in the public mind.<sup>122</sup> Universal sued Nintendo alleging that its game "Donkey Kong" infringed Universal's trademark in the name "King Kong."<sup>123</sup> The rights in "King Kong" were divided between RKO, which owned rights in the first King Kong movie, DDL, which owned the rights in a 1976 remake, Cooper, the son of the author, who owned rights in the book, and Universal, which obtained its rights from Cooper.<sup>124</sup> The court explained that "[e]xactly what shred of the King Kong character and name Universal owns is far from clear," and that the "vagueness of the image in which Universal claims a trademark right violates the fundamental purpose of trademark: to identify the source of a product and thereby prevent consumer confusion as to that source."<sup>125</sup> Therefore, the court found that because of the extensive merchandising and "the competing property interests in King Kong," the character "no longer signifies a single source of origin to consumers and thus is not a valid trademark."<sup>126</sup>

Similarly, in *Frederick Warne & Co. v. Book Sales, Inc.*, the plaintiff was the publisher of the Peter Rabbit books written and illustrated by Beatrix Potter.<sup>127</sup> The plaintiff sued the defendant for trademark infringement of the illustrations of Peter Rabbit.<sup>128</sup> The defendant had used a few of the illustrations in his own book about Peter Rabbit. The plaintiff claimed that while a number of Potter's volumes were no longer protected by copyright, the illustrations had acquired a secondary meaning and identified the publishing company.<sup>129</sup> The court found that "it would not be enough that the illustrations in question have come to signify Beatrix Potter as author of the books; plaintiff must show that they have come to represent its goodwill and reputation as Publisher of those books."<sup>130</sup> Therefore, before a party can seek protection through trademark or unfair protection laws, it must be sure that the character is associated with one source and that source is the plaintiff himself.

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122. *Universal City Studios, Inc. v. Nintendo Co.*, 578 F. Supp. 911, 923-24 (S.D.N.Y. 1983) (citing *Processed Plastic*, 675 F.2d at 856, for the proposition that the mark must "derive[] from a single source").

123. *Id.* at 913.

124. *Id.* at 914-16.

125. *Id.* at 924.

126. *Id.* at 923.

127. 481 F. Supp. 1191, 1193 (S.D.N.Y. 1979).

128. *Id.*

129. *Id.* at 1193-94.

130. *Id.* at 1195.

Trademark and unfair competition are also unavailable as a means of protection when there is little likelihood of public confusion as to the source of the potentially infringing character. Such confusion does not require the public to be tricked into buying something that it believes is something different.<sup>131</sup> The public need only believe that a single source either approved the new work, is in some way associated or connected with the new work, or sponsored the new work.<sup>132</sup> The public may not even “be aware of the name of the source” as long as “they assume that products bearing the mark come from a single, though anonymous source.”<sup>133</sup> This aspect of public confusion is particularly important in the movie industry, because most people cannot identify a specific movie with a production company, but can recognize that a single source for a character exists.<sup>134</sup>

The King Kong case discussed above is a good example of a case where the court held the original and potentially infringing characters were not similar enough for the public to be confused as to source or association.<sup>135</sup> The court found that even if King Kong possessed a secondary meaning associated with Universal, there would still remain the question of whether consumers were likely to confuse Donkey Kong and King Kong.<sup>136</sup> The court explained that Universal must show that “there exists a likelihood that an appreciable number of ordinary prudent purchasers will be misled, or simply confused, as to the source of the goods in question.”<sup>137</sup>

After comparing the two characters, the court found that Donkey Kong and his environment “create a totally different concept and feel,” and that “at best, Donkey Kong is a parody of King Kong.”<sup>138</sup> While King Kong “fights with dinosaurs, giant snakes, airplanes and helicopters” and dies a “tragic and bloody death,” Donkey Kong’s

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131. Kurtz, *supra* note 14, at 477.

132. *Id.* (citing MCCARTHY, *supra* note 81 § 24:3(B) (2d ed. 1984) (likelihood of confusion “denotes any type of confusion, including: confusion of source; confusion of affiliation; confusion of connection; or confusion of sponsorship”).

133. Kurtz, *supra* note 14, at 477 (citing Processed Plastic Co. v. Warner Commc’ns, Inc., 675 F.2d 852, 956 (7th Cir. 1982) and 3 A. R. CALLMAN, THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES §19.25 (4th ed. 1983)).

134. Kurtz, *supra* note 14, at 477 n.263.

135. See Universal City Studios, Inc. v. Nintendo Co., 578 F. Supp. 911, 928-29 (S.D.N.Y. 1983).

136. *Id.* at 926.

137. *Id.* (internal quotations omitted) (quoting Lever Bros. Co. v. Am. Bakeries Co., 693 F.2d 251, 253 (2d Cir. 1982)).

138. *Id.* at 928.

obstacles include “pies, cement tubs, birthday cakes, and umbrellas.”<sup>139</sup> The video game character, Donkey Kong, was described as “farcical,” “childlike,” “nonsexual,” “comical,” and therefore much different than the “ferocious” King Kong who goes on “rampages, chases people, crushes them underfoot, or throws them to the ground.”<sup>140</sup> The court held that even if King Kong possessed a secondary meaning associated with Universal there was no likelihood of confusion and granted the defendant summary judgment.<sup>141</sup>

Trademark and unfair competition laws can offer protection of the author’s good will and give the author a say in how his character will be used, even if the character is not sufficiently copied for a finding of copyright infringement.<sup>142</sup> However, in many ways the scope of protection offered by trademark and unfair competition laws is far more limited than copyright protection. Whereas copyright protection typically requires showing ownership, access, and substantial similarity,<sup>143</sup> trademark and unfair competition require a showing of secondary meaning, association with a single source, and likelihood of public confusion.<sup>144</sup> As evidenced by the cases discussed above, any of these three requirements can make it difficult to retain control through trademark or unfair competition laws.

#### V. DO WE EVEN NEED A SEPARATE TEST FOR CHARACTERS?

In examining the protection available for fictional characters, two points become clear. One is that the “distinctly delineated” and “story being told” tests are generally unhelpful because they are vague and offer little guidance for determining when the copyright in a character is infringed. Second, when the tests are applied in a helpful manner, they essentially reiterate the substantial similarity test, to be discussed below, and do not offer anything new to the analysis. Because the unhelpful parts are best ignored and the helpful parts are already included in the substantial similarity test, no need exists for separate tests for literary characters and thus no such test should be used.

As mentioned in the introduction to this article, there is a need for a balance between giving authors the chance to profit from and

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139. *Id.*

140. *Id.*

141. *Id.* at 928-29.

142. Kurtz, *supra* note 14, at 495.

143. NIMMER, *supra* note 27, § 13.01.

144. *See* MCCARTHY, *supra* note 81, §§ 15:5, 15:8, 23:1.

control the use of their characters and the need to leave enough creative "building blocks" in the public domain for new authors. After reviewing the current state of copyright, trademark, and unfair competition laws as applied to literary characters, the proper balance would be reached if a character received protection only within the context of the original work in which it appeared and also by trademark and unfair competition laws. Separate protection for literary characters would not offer authors any additional incentive to create and would remove an excessive amount of material from the public domain.

*A. Protection within the Original Work Using the Substantial Similarity Test*

Literary characters should receive copyright protection, but only because the substantial copying of a character may infringe the original copyrighted work in which the character appears, not because fictional characters deserve independent protection. Courts have developed a variety of tests to determine when one work is substantially similar to another.

The first step in the analysis is to separate the ideas inherent in the character from the expression of those ideas. As applied to characters, this first step would involve deciding whether the character is just a general type, i.e. an idea, or whether the character evokes enough expression to be protectable. This analysis is precisely what some courts have performed as part of the "distinctly delineated" or "well developed" test.<sup>145</sup> The first step, however, does not deserve a separate name because it has always been part of the substantial similarity test. It is a basic principle of copyright law that in order to find copyright infringement, one must "determine whether there has been copying of the expression of an idea rather than just the idea itself."<sup>146</sup> The determination by itself is only useful in eliminating those characters who are so clearly a general type and not worthy of protection that a full analysis would be a waste of time. This step does not help us with characters that are more than a general type, and for these more expressive characters a comparison is needed.

The two-part extrinsic/intrinsic test articulated in *Krofft* works well to determine whether a character is protected by copyright within

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145. See, e.g., *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

146. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977).

the context of the original work.<sup>147</sup> The “extrinsic test” compares “specific, objective criteria of two works on the basis of an analytic dissection of the following elements of each work – plot, theme, dialogue, mood, setting, pace, characters, and sequence of events.”<sup>148</sup> The outcome of the extrinsic test “may often be decided as a matter of law.”<sup>149</sup>

The second/intrinsic part of the *Krofft* analysis “requires that the trier of fact then decide ‘whether there is substantial similarity in the expressions of the ideas so as to constitute infringement.’”<sup>150</sup> This “intrinsic” part asks whether the “total concept and feel” of the two works is substantially similar.<sup>151</sup> The intrinsic test relies on the observations of the “ordinary reasonable person.”<sup>152</sup> The *Krofft* test permits a finding of infringement only if both the extrinsic and intrinsic tests are satisfied.<sup>153</sup>

The amount of protection offered to a character within the original work in which it appears is sufficient because it is extremely hard to completely separate a character from “trailing elements of plot.”<sup>154</sup> All characters are bound by their time, place, history, experiences, and relationships with other characters.<sup>155</sup> Professor Kurtz gives the example of placing Tarzan in the city for a new story.<sup>156</sup> Even though Tarzan is in a completely new setting and involved in a different story, he would not be Tarzan if “he was not previously raised by apes,” if he did not grow up in the jungle, and if he was not good with animals.<sup>157</sup> Therefore, if one is to copy a character and capture that character’s persona in a substantially similar way, it is almost impossible not to copy elements of the original work.

If the new author included a description of Tarzan’s history, the jungle where Tarzan grew up, his relationships with the animals, and the development of his various skills, these descriptions would most likely be enough to constitute substantial similarity with the

147. *See id.* at 1165.

148. *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1297 (C.D. Cal. 1995) (citing *Shaw v. Lindheim*, 919 F.2d 1353, 1359 (9th Cir. 1990)).

149. *Krofft*, 562 F.2d at 1164.

150. NIMMER, *supra* note 27, § 13.03[E][3] (quoting *Krofft*, 562 F.2d at 1164).

151. *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984).

152. *Krofft*, 562 F.2d at 1164.

153. *Metro-Goldwyn*, 900 F.Supp. at 1297.

154. Kurtz, *supra* note 14, at 431.

155. *Id.*

156. *Id.*

157. *Id.*

original work, thereby offering protection for Tarzan's character. On the other hand, if the second author copies only the idea of a man growing up with animals, but produces a very different character, the intrinsic part of the test would act as a check to overprotection. Therefore, if the city Tarzan had a vastly different "concept and feel" about him, there would be no infringement because the application of the intrinsic part of the test would not find substantial similarity. At this point in the analysis, the *Krofft* test accomplishes precisely what it is supposed to: it allows for protection of the expression of ideas but not of the ideas themselves.

One possible problem occurs when the new author uses only the name Tarzan, relying on the character's popularity to conjure in the consumers' minds a mental image of the character. Copyright law cannot protect a character's name and would offer no relief. Because the public is generally familiar with the Tarzan character, the new author would not have to include a description of Tarzan's history, relationships, jungle origins, or special skills in order to convey Tarzan's persona to the reader. Therefore, there may not be enough substantial similarity of expression between the original and new use of the character to constitute infringement. However, the name of the character, his dress, a famous phrase the character utters, or anything that conjures up the mental image of the character can most likely be protected by trademark and unfair competition laws.

#### *B. Trademark and Unfair Competition to Supplement Copyright in Original Work*

As described in the cases mentioned earlier, trademark and unfair competition laws can protect a character's name, appearance, and catch phrase.<sup>158</sup> Therefore, trademark and unfair competition laws may offer the original author protection if a new author started writing stories about an established character like Tarzan. But what about the additional requirements of trademark law: the need for a finding of secondary meaning and likelihood of confusion?

If the character has not acquired secondary meaning, then it is not eligible for trademark protection because the same concerns or compelling reasons to offer protection are not present. When a character does not have secondary meaning, the character is most likely not well known and will not automatically create a mental image in a reader's mind. Therefore, the new author would either

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158. See *supra* text accompanying note 86.



have to copy the original author's expression that created the character, in which case copyright would offer relief, or create his own description of the character, in which case there would be no substantial copying.

If the character is well known or has secondary meaning, the courts are very likely to find there is likelihood of confusion. When the "Tarzan" name was used in the title of an X-rated movie, the court found the use likely to cause confusion as to source or origin of the movie.<sup>159</sup> Furthermore, the court found that a disclaimer, which explained that the movie was in no way associated with the plaintiff, was not enough to prevent the confusion and ordered the defendant to stop using the name.<sup>160</sup> This example makes clear both that authors can gain substantial protection for their literary characters through trademark, and that potential infringers will not be able to get away with copying by simply including a disclaimer. In fact, even trademark seems to overprotect characters, as it is unlikely the public would think Edgar Rice Burroughs, after writing some twenty-six novels about Tarzan, decided to venture into the adult movie industry.

*C. Protection within the Original Work through the Krofft Test  
Together with Trademark and Unfair Competition Laws as Applied to  
the Cases*

In many character infringement cases, when two works are compared they are often described in a limited fashion, so that a full analysis of plot, mood, setting, dialogue, and various other elements is difficult to accomplish. For instance, in *Burroughs*, the defendant's X-rated film *Tarz & Jane & Boy & Cheeta* was found to utilize characters which were substantially similar to those contained in the plaintiff's copyrighted works.<sup>161</sup> The court did not compare the two works, but simply found that "characters which are distinctly delineated in copyrighted works are protected by the copyright in those works," and that the advertising and distribution of the defendant's movie would infringe the plaintiff's copyright in the literary works.<sup>162</sup>

There are certain things that can be easily presumed about an X-rated movie without the benefit of a court description or personal

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159. *Edgar Rice Burroughs, Inc. v. Manns Theatres*, No. 76-3612, 1976 U.S. Dist. LEXIS 11754, at \*8-9 (C.D. Cal. Dec. 20, 1976).

160. *Id.* at \*9; see also Kurtz, *supra* note 14, at 481 n.282.

161. See *Burroughs*, 1976 U.S. Dist. LEXIS 11754, at \*9-10.

162. *Id.*

familiarity, so that a comparison can be carried out despite lack of information. The first step of the test is to determine whether the character of Tarzan in the original work is merely a stock character, or whether the author's overall description of Tarzan contains enough expression for the character to be copyrightable. This standard is set relatively low because it is meant to eliminate those characters that are clearly of a general type. Tarzan has been the main character of twenty-six novels,<sup>163</sup> in the course of which his childhood, history, relationships, characteristics and skills have been outlined in detail. It is, therefore, safe to assume that Tarzan is not just an idea, but is composed of copyrightable expression.

The analysis of why Tarzan is more than just an idea is not any better articulated than the explanation of why Tarzan is "well-developed," which was offered by the court in *Burroughs v. Metro-Goldwyn-Mayer*<sup>164</sup> and criticized earlier in this article.<sup>165</sup> However, the description in *Burroughs* was criticized because that description was the entirety of the test used to determine whether a character was copyrightable. The case was used to illustrate the problem of fitting a character into a category, either "well-developed" or "not well-developed," and then using this determination to find infringement.<sup>166</sup> In contrast, the test proposed here treats the question of whether a character is more than an idea as only the first step in a longer analysis, and is meant only to eliminate those characters that are clearly of a general type. The proposed test recognizes both that the idea/expression dichotomy is difficult to apply and cannot be the sole basis of a test, and that it is useful in eliminating characters which are purely ideas and therefore not protectable by copyright.

Next, the two-part, extrinsic/intrinsic test articulated in *Krofft* is applied.<sup>167</sup> The extrinsic test calls for a comparison of plot, theme, dialogue, mood, setting, pace, characters and sequence of events.<sup>168</sup>

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163. *Id.* at \*4.

164. 519 F. Supp. 388 (S.D.N.Y. 1981).

165. *See supra* text accompanying notes 50-55.

166. As noted earlier in the article, the judge in this specific case had nothing to compare because the issue was not infringement but rather termination of a license. *See supra* text accompanying note 55. The case is nonetheless illustrative of the speculation that goes into deciding and describing when a character is well-developed so as to underscore the point that courts should not automatically find infringement when they find a character copyrightable.

167. *See Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

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

Because the movie in the Tarzan example is X-rated, it is doubtful that the movie stays true to the plot of any of the Tarzan literary works or attempts to follow the same sequence of events. More likely, the movie borrows the general idea of a man rescuing a woman in the jungle, and then adds numerous events and acts not present in the original works. The theme and mood, considering the different purposes and audiences of the two works, are likely different. Further, it is fair to assume that the movie did not borrow the literary works' dialogue in its entirety, if at all, and instead, probably substituted its own dialogue. Similarly, while the literary works describe in detail the beauty and wilderness of the jungle, the movie may use this setting in a minimal way. Finally, because an X-rated movie is not likely to focus on developing the characters, no more than the idea of Tarzan was likely taken.

Because the extrinsic test would undoubtedly fail, there is no need to move on to the intrinsic part of the test. However, in the event that *Tarz & Jane & Boy & Cheeta* does closely follow the sequence of events, dialogue, and theme of the literary works, and takes time to develop the characters, the intrinsic test should be applied. The intrinsic test calls for the trier of fact to determine whether the "total concept and feel" of the two works is substantially similar. Again, taking into consideration the vastly different purposes of the two works and the non-sexual nature of the literary work, as opposed to the highly sexualized nature of the X-rated movie, the two works likely have a drastically different concept and feel.

Therefore, under the proposed test, the defendant's X-rated movie would not infringe the plaintiff's copyright. However, the name Tarzan would be protected under trademark and unfair competition laws, and as described earlier, was in fact protected in the actual case. The court went too far, however, when it found that the movie infringed the plaintiff's copyright, since the defendant cannot even remedy the problem by changing the title and character names. If the court had used the test proposed in this article, then the defendant would have had to change the names in the movie. However, because the two works are not substantially similar and should not be protected by copyright, the defendant would be able to distribute the movie once any likelihood of confusion is removed.

The desirability of allowing the defendant to distribute his X-rated film once he was no longer infringing plaintiff's trademark may escape some readers, but the principle of balancing between authors' rights and the needs of the public domain must apply equally to various kinds of works. The characters of an original work that are

found to be distinctly delineated could just as easily be infringed by a second work that has great artistic value. Even in the case of an X-rated movie, the defendant's creativity may offer raw material and building blocks to others within the movie industry, as well as enrichment of the lives of a certain segment of the public.

The proposed test would also yield better results in the "Hopalong Cassidy" case.<sup>169</sup> The court in that case found that the character of Cassidy and a few others from the book "were sufficiently delineated, developed and well known to the public to be copyrightable. The use of these characters for the purposes intended by Filmvideo therefore would constitute infringement with respect to the above numbered films irrespective and independent of the similarity of the story line."<sup>170</sup> Despite reading the books and viewing the movies, the court could only explain the similarity in character as the movie Cassidy being "Cassidy turned inside out."<sup>171</sup> Other similarities the court noted included names of characters, names of towns, and the same general setting.<sup>172</sup> As previously described, the two characters did not seem especially similar, apart from sharing a name and a western setting. Thus, the *Krofft* test should be applied to determine whether Filmvideo should have been enjoined from using the twenty-three movies it developed.

"Hopalong Cassidy" has been described in detail in twenty-six novels<sup>173</sup> and is therefore likely to be more than a simple stock character. Since Cassidy likely encompasses protectable expression, the next step is to apply the extrinsic test, relying on the court's descriptions as well as the description provided by an expert witness for Filmvideo.<sup>174</sup>

The Court found that eleven of the movies infringed the copyrights in the books because there was substantial similarity between the storylines.<sup>175</sup> For the rest of the movies, however, the Court did not find substantial similarity between the storylines, but found that the use of the "Hopalong Cassidy" characters alone would constitute copyright infringement irrespective of the plot.<sup>176</sup>

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169. Filmvideo Releasing Corp. v. Hastings, 509 F. Supp. 60 (S.D.N.Y. 1981).

170. *Id.* at 66.

171. *Id.* at 65.

172. *Id.* at 63.

173. *Id.* at 61.

174. See Kurtz, *supra* note 14, at 459 (outlining the testimony of an expert witness for Filmvideo regarding a description of Cassidy's character in the book as contrasted with the Cassidy in the movie).

175. *Filmvideo*, 509 F. Supp. at 65.

176. *Id.*

Therefore, for those remaining twelve movies, there is no substantial similarity in plot, dialogue, or sequence of events, as these elements can all be said to constitute the storyline.

The setting, theme, mood and pace of the movies and the books are most likely sufficiently similar. The setting of both sources is the Old West and the theme is one of action and adventure.<sup>177</sup> The mood is light-hearted and both the books and movies are quickly paced. However, the Old West and the types of locales that existed in that time, as well as the “genre of action-adventure,” are precluded from copyright protection by the “scenes a faire” exception.<sup>178</sup> Included under the “scenes a faire” exception are “incidents, characters, or settings which are indispensable, or at least standard, in the treatment of a given topic.”<sup>179</sup>

The Ninth Circuit has held that when two works both emphasize action and adventure, and therefore share the same general theme, mood, and pace, then “those similarities that do exist ar[i]se from unprotectable scenes a faire, [and] there exists no substantial similarity of protectable expression . . . .”<sup>180</sup> Likewise, in the Cassidy case, the similarity that does exist between the original and potentially infringing works is not similarity of protectable expression, but rather similarity of general elements, without which an action-adventure movie set in the Old West would not be possible.

The court in the Cassidy case also noted that the names of some of the characters and towns were taken from the books and included in the movies.<sup>181</sup> The name of a town or character cannot be protected under copyright law,<sup>182</sup> but use of a character’s name is considered one factor in determining whether the development of a character was copied.<sup>183</sup> “If the character’s development [was] not

177. *Id.* at 61.

178. *Olson v. Nat’l Broad. Co.*, 855 F.2d 1446, 1451 (9th Cir. 1988) (finding that the theme, mood and pace are all common to the genre of action-adventure television series and movies and therefore do not demonstrate substantial similarity and citing *Berkic v. Crichton*, 761 F.2d 1289, 1293-94 (9th Cir. 1985) (denying protection to “familiar scenes and themes [which] are among the very staples of modern American literature and film”); *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir. 1986) (denying protection to “‘stock’ themes commonly linked to a particular genre”).

179. *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616 (7th Cir.).

180. *Olson*, 855 F.2d. at 1451, 1453.

181. *Filmvideo*, 509 F. Supp. at 64.

182. 37 C.F.R. § 202.1(a) (2005) (providing that “[w]ords and short phrases such as names, titles and slogans’ are not subject to copyright . . .”).

183. Kurtz, *supra* note 14, at 460.

copied, however, using the name is not a basis for finding copyright infringement.”<sup>184</sup>

The analysis thus leads us to compare the “Cassidy” described in the books to the “Cassidy” portrayed in the movies. The book Cassidy is described as “a foulmouthed, tobacco-spitting, violence-prone young tough, who . . . is involved in countless battles, chases, and confrontations . . . [and] grows into a hard-bitten, middle-aged gunman and sometimes peace officer.”<sup>185</sup> The movie Cassidy avoids alcohol, does not swear, rides on a white horse, is kind and sentimental, and is so “sanitized from [the author’s] conception of the character that [the author] made constant complaints to the film-makers who generally responded . . . by ignoring his diatribes and sending him a box of cigars.”<sup>186</sup> Clearly, the cleaned-up movie version of Cassidy is not substantially similar to the rough version of Cassidy described in the books.

As for the extrinsic elements of the two works, at least twelve of the movies consisted of original storylines, dialogue, sequences of events, and contained vastly different main characters. Although the movies have a theme, pace and mood similar to those in the book, these elements are “scenes a faire,” without which any story that employed the specific genre of the Old West adventure, whether in book or movie form, could not be produced. Therefore, under the extrinsic elements step of the *Krofft* test, the two works are not substantially similar.

Next, under the intrinsic elements step of the *Krofft* test, the jury must decide whether the book and movie version have the same “total concept and feel.” Because the court already determined that the storylines are different, and that the theme, mood, and pace are common to many western adventure stories, the only element that could give the movies the same feel as the book is the characters. It is doubtful that a jury would have recognized the “inside out” Cassidy from the movies as the same Cassidy from the book. Also, the jury probably would not infer that the differences in the movie version of Cassidy are simply an expression of hidden qualities in the book version of Cassidy that are never explicitly described. The jury is

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184. *Id.*

185. Kurtz, *supra* note 14, at 459 (quoting Francis M. Nevins, *The Doctrine of Copyright Ambush: Limitations on the Free Use of Public Domain Derivative Works*, 25 ST. LOUIS U. L.J. 58, 68 (1981), describing expert witness testimony which gave a more complete description of Cassidy as described in the book).

186. *Id.* at 459-460 (citing Nevins, *supra* note 185, at 68).

more likely to determine that the different storylines and characters have created a different "total concept and feel."

Therefore, under the proposed test, at least twelve of the movies would not be found to infringe the copyright in the book. However, the plaintiff would be able to protect the "Hopalong Cassidy" name under trademark and unfair competition laws. As a result, the defendant would be forced to use different names for the main character, but the public would still get the benefit of the twenty-three movies. This result is more desirable than a finding of copyright infringement, because it more closely serves the purpose of copyright law, which is to provide the public with access to as many works as possible, while leaving artists with enough incentive to create. Allowing a movie that does not copy the names, storyline or characters from another work, but instead uses only the same "scenes a faire," is unlikely to offend artists to such an extent that they will lose all incentive to create.

The test proposed in this paper is not easy to administer. It requires reading, viewing or listening to both the original work and the allegedly infringing work, which in some cases is no simple task.<sup>187</sup> Furthermore, the test requires a jury to consider the two works in order to determine if they have the same concept and feel. On the other hand, the "distinctly delineated" and "story being told" tests are fairly easy to administer. A judge can decide whether a character is well-developed based on the number of works in which the character has appeared, the popularity of the character, or a variety of other factors that do not involve dissecting and comparing various elements of each work or letting a jury consider the matter.

The difference between the approaches is that there is a much lower likelihood of error with the proposed test than with either the "distinctly delineated" test or the "story being told" test. The test proposed in this article is composed of several steps that take into consideration both the difficulty in determining whether two works are substantially similar and the question of whether the alleged infringer has copied more than just an idea. The test works well because it allows the court to both compare various aspects of the two works, step by step, and examine the works as a whole while evaluating how the total work appears to the ordinary observer. The

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187. See, e.g., *Filmvideo Releasing Corp. v. Hastings*, 509 F. Supp. 60, 62 (S.D.N.Y. 1981) (despite reaching a decision that has since been criticized in many law review articles, the judge in the Hopalong Cassidy case read all twenty-six novels (8363 pages) and viewed twenty-three motion pictures (almost twenty-seven hours of viewing)).

test may be complicated, but only because it is designed to fairly and accurately further the purposes of copyright law.

*D. Appropriate Balance Achieved with Copyright in the Original Work*

In recent years, the balance between giving new authors enough incentive to create and leaving enough building blocks in the public domain seems to have tilted against the public domain.<sup>188</sup> This trend of offering increasing amounts of protection for fictional characters may have been influenced by the exceptional earning power of fictional characters. Fictional characters are at the center of a multibillion-dollar industry, a fact that offers strong motivation for authors to fight to preserve their monopoly in any way they can.

For instance, *Forbes* reported in a list of the top ten highest-earning fictional characters that Mickey Mouse made \$5.8 billion in 2003.<sup>189</sup> Winnie the Pooh, born in 1926, made \$5.6 billion in 2003.<sup>190</sup> Harry Potter, a relatively new addition to the world of famous characters, made \$2.8 billion the same year.<sup>191</sup> In fact, J.K. Rowling, who was on welfare before she wrote the Harry Potter books, is now the first author to qualify for a spot on *Forbes*'s billionaire list.<sup>192</sup>

Although the earnings figures of these characters are impressive, earnings potential is not a compelling argument under the current copyright scheme to support recognition of independent protection for fictional characters. After all, would J.K. Rowling forgo writing the Harry Potter books if she knew she would "only" earn \$10 million as opposed to the \$147 million she earned in 2003?<sup>193</sup> Authors already have enough incentive to create by virtue of their monopoly in the original work. Because literary works must contain interesting and real characters in order to be successful, authors would gain no more incentive to create such characters if those characters received independent protection. The bargain authors have struck with the public is already more than fair. Offering characters independent protection will not make more of the arts available to the public, but instead will only stifle further creativity.

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188. Kurtz, *supra* note 14, at 429.

189. Vanesa Gisquet & Lacey Rose, *Top Earning Fictional Characters: Top Characters Gross \$25B*, *FORBES*, Nov. 1, 2004, at 58.

190. *Id.*

191. *Id.*

192. *Id.*

193. *Id.*



## VI. CONCLUSION

Literary characters are protected within the copyright of the original work in which they appear, but the law is less clear when a character is separated from the original work and leads an independent life. The two main tests articulated by courts to deal with the phenomenon of protecting an independent character have not been particularly helpful. The tests, which employ magic words such as “distinctly delineated” or “story being told,” are mainly used to give a decision that has already been reached additional validity.

A better alternative is to rely on the copyright protection in the original work, as it is generally difficult to copy a character without copying a substantial amount of the original author’s expression. The substantial similarity test is well suited for determining when enough has been taken from the original so as to constitute infringement. Furthermore, trademark and unfair competition laws protect a character that is so well known that an infringer need only mention the character’s name, without copying its expression, to be liable to the author.

The first step of the proposed test is whether a character is a general type, i.e. an idea, or whether the character is developed enough to constitute protectable expression. This part of the test is only a way of eliminating characters that are obviously a general type with little expression so that a lengthy analysis would be unnecessary. The second part of the test is to apply the extrinsic/intrinsic test articulated in *Krofft* to determine if a character is protected by copyright within the context of the original work. As discussed above, protecting a character within the original work is sufficient because it is extremely difficult to separate a character from its work. The only gap in protection occurs when an infringer uses only the name, phrase, dress or recognizable element that immediately brings the character to mind, but this gap is successfully filled by trademark and unfair competition law.

The proposed test offers an in-depth analysis that compares various elements of two works and thereby compares the original and allegedly infringing character. Most importantly, however, the proposed test does not overprotect characters because granting fictional characters independent protection is not in accordance with the purpose of copyright law. Doing so would limit creativity and the dissemination of new works to the public. Authors throughout time have borrowed from each other and used these building blocks to create new inspiring and enriching works. Offering independent

protection to fictional characters would limit the pool of raw material and would do a great disservice to the public. The main concern of copyright law is to promote the progress of the arts, not to secure an everlasting source of revenue for the creator of a fictional character.

