

How to Protect a Literary Character Through Copyright and Trademark

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Abstract

This paper is about finding the best practices in which to protect a literary character as an individual and help authors keep the rights to their characters when the characters are taken out of the original work. It focuses on the basic copyright and trademark laws, how they apply to a literary character, what is afforded to the character for protection, and the lack of protection by the courts. The research help facilitate ideas and advice on how to better protect a literary character before and after the process of copyrighting or trademarking the work.

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Chapter 1

Introduction

Presented is a paper on intellectual property and how an originator can protect their creations when the creations are literary characters. Through copyright and trademark, literary characters must be clearly delineated and defined as recognizable and unique independent characters in order to be used outside the context of the original work. The best practices to protect your character are careful delineation in verbal and written description, the use of images, and the use of other identifying attributions. These guidelines will help originators keep their rights and protect the rights of their literary characters.

Statement of the Problem

This study discusses the trends in protecting literary characters through copyright and trademark. The distinction between Copyright and Trademark have become blurred in the ability to protect characters, and more importantly, lacking in protecting literary characters from infringement and proper licensing for the creator to hold all rights to their literary character.

Literary characters are at a disadvantage when graphic characters have more protection because of their visual representation. Literary characters are described in words and up to the audience to visualize these characters. Creating the available path, for writers to consider properly detailing a character; creators will be able to have full access to exercising their rights when given the opportunity to outsource that character.

The value of giving detailed description to a character will benefit not only the character's potential future in business, but will benefit the creator in owning all rights to the character in multiple visual business avenues.

Background of the Stated Problem

Copyright¹ is a person's exclusive right to reproduce, publish, or sell his or her original work of authorship. Works of authorship include literary, musical, dramatic, artistic and architectural work. The Copyright Act of 1976 protects published or unpublished works that are in fixed in a tangible form of expression. The Act does not protect ideas. The length of the protection for work is the creator's lifetime plus another fifty years after the creator's death.

Trademark² is any word, name, symbol or device used by a person; and/or which a person has an intention to use in commerce to identify and distinguish their goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown. In 1946 Congress enacted the Lanham Act, which provided a nation system of trademark registration to protect the owners of federally registered marks against the use of similar marks confused consumers or diluted the original mark.

Graphic characters can be copyrighted and trademarked, but literary characters are harder to distinguish and define outside of the average and unoriginal idea of a character based upon the work. The answer is in the detail and recognition of the character outside of its original setting of the literature in order to protect that character, and the author's intellectual property, if the character ever leaves the page.

¹ Findlaw.com copyright and Copyright Act of 1976 definition

² Findlaw.com trademark and Lanham Act definition

Purpose of Study

The purpose of the paper is to find a set of best practices for protecting the literary character as copyrighted or trademarked entity.

Definition of Terms

These are the terms that will be covered in the paper.

Copyright:³ Copyright is a person's exclusive right to reproduce, publish, or sell his or her original work of authorship. The copyright exists when fixed in tangible form and protects creativity.

Trademark:⁴ Trademark includes any word, name, symbol, or device, or any combination thereof—1. Used by a person, or 2. Which a person has a bona fide intention to use in commerce and to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Character: A character comes from the mind of a person who has created the character as fixed in tangible form in published or unpublished works.

Infringement:⁵ The unauthorized use of copyrighted or patented material or of a trademark, trade name, or trade dress. This involves uses of one by the infringer that is

³ *Copyright Duration:* The author's life plus an additional 70 years. For a 'joint work prepared by two or more authors who did not work for hire,' the term lasts for 70 years after the last surviving author's death. For works made for hire and anonymous and pseudonymous works, the duration of copyright is 95 years from first publication or 120 years from creation, whichever is shorter. Loving, Bill. *Intellectual Property and Commercial Speech in the Digital Age*. 2013. PDF.

⁴ *Trademark Duration:* The registration is valid as long as you timely file all post registration maintenance documents. As long as the trademark serves to identify the business or product or service to the consuming public, the trademark can last. Loving, Bill. *Intellectual Property and Commercial Speech in the Digital Age*. 2013. PDF.

⁵ Infringement of a copyright involves the copying of a material and substantial portion of the protected work. If the alleged infringer denies copying, the copyright holder may be able to prove infringement with circumstantial evidence of the infringer's access to the protected work and of similarities between the works. Findlaw.com infringement definition.

the same as that of the owner or so similar that it is likely to deceive or cause confusion or mistake on the part of the average purchaser.

Convergence Phenomenon:⁶ A phenomenon, starting in the 1970's, which resulted in the courts converging their views on copyright, trademark and unfair competition claims as though each were coequal and necessarily interrelated.

Extrinsic, Intrinsic, and Abstraction Tests:⁷

Extrinsic- Used to determine whether a character is protected by copyright within the context of the original work. It “compares specific, objective criteria of two works on the basis of the analytic dissection of the following elements of each work- plot, theme, dialogue, mood, setting, pace, characters, and sequence of events.”

Intrinsic- Used to determine whether there is substantial similarity in the expressions of the ideas so as to constitute infringement. The test asks whether the “total concept and feel” of the two works are substantially similar and relies on the observations of the “ordinary reasonable person.”

Abstraction- Articulated by a judge, to determine where details of a work are gradually left out so that the work becomes more and more general. At some point the work is so general that to protect it would translate into protecting the copyright owner's ideas rather than their expression.

⁶ Helfand, Michael T. “When Mickey Mouse Is as Strong as Superman: The convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters.” *Stanford Law Review* 44.3 (1992): 623-74. *JSTOR*. Web. 14 Apr. 2014.

⁷ Zecevic, Jasmina. “Distinctly Delineated Fictional Characters That Constitute The Story Being Told: Who Are They And Do They Deserve Independent Copyright Protection?” *Vanderbilt Journal of Entertainment and Technology Law* 8.365 (2006): 1-35. *LexisNexis Academic*. Web. 12 Apr. 2014.

Organization of Study

This is a qualitative research paper derived from literary sources and legal sources. In view, the application of copyright and trademark show that careful delineation in verbal and written description, the use of images, and the use of other identifying attributions are the best practices to protect a literary character.

Chapter 2

Literature Review

The Courts Subjective Concept of Copyrighting and Trademarking Characters¹

Granting fictional characters copyright has been judged on a case-by-case, court-by-court, basis. Since there is so much uncertainty and variable outcomes, one attempted response to correct these outcomes is a two-part test some courts use in determining whether a character has been infringed upon. The Distinct Delineation Standard, or character delineation, helps determine whether the character is copyrightable. The distinct delineation inquiry emerged from the case of *Nichols v Universal Picture Corp.* The plaintiff, Nichols, accused Universal for using similar characters from her play, for their film. The judges main concern was making sure fictional characters were protected under their original work, but the ideas of characters could be left for the public domain to be able to use without penalty. Judge Learned Hand determined for a character to be protected independently from the original plot, they would have to be a distinct delineation. He explained the more indistinct the character is written, the less protection the character will receive, thus, putting it in the category of an idea of expression. In this specific case, he concluded the characters were not similar, then making distinct delineation equally as undefined as before.

The second part of the test is called “the story being told test.” This attempted response to the outcome came from the Ninth Circuit court. The Ninth Circuit court argued that if the character is a foil within the story and is not a prominent part of relaying the

¹ Foley, Kathryn M. "Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide." *Connecticut Law Review* 41.3 (2009): 921-61. *LexisNexis*. Web. 10 Apr. 2014.

story, then the character is not copyrightable and able to be used by other outside parties for other uses. This decision came from the case *Warner Brothers v. Columbia Broadcasting Systems*. The author of *The Maltese Falcon*, Dashiell Hammett, gave the rights to the characters of the book to Warner Brothers. Eventually, Hammett also gave the rights to CBS with the exclusive right of a character named Detective Sam Spade. Warner sued CBS, and the courts found that Detective Sam Spade didn't carry the story, allowing CBS the rights to use the character without fringing upon Warner's rights. "The story being told" decision is not accepted by the majority of courts and even the Ninth Circuit have stepped back from using it on other cases. The test limits certain cases and fails to help in other cases, making it the less adopted way to prove character copyrightability.

Changes to Limitations of Copyright and Trademark for Literary Characters²

A character's identity is upheld in three different parts: their name, their visual appearance, physical traits, and personality traits. These traits are called, "characterization," which makes up the character as a whole. Characterization will define whether the character is round or flat, holds more complexities and individuality than the average character with a one-dimensional generalized idea of expression. Characterization determines a character's ability to be copyrighted. Courts have given literary characters the least amount of protection because they do not believe in just a name or verbal imagery of characters as concrete evidence of being a distinguishable entity. Creators are now fighting for protection of the individuality of the characters outside of their works, some characters being created without a plot. In the case *United Artists v. Ford Motor Co.*, a pink

² Feldman, David B. "Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection." *California Law Review* 78.687 (1990): 687-720. Web. 12 Apr. 2014.

panther had been used in a Ford commercial. The United Artists claimed their copyright had been infringed upon because it was the same Pink Panther being used. United Artists argued that the Pink Panther was a “qualitatively substantial” character to the film, even though it only appeared in the introductory film credits. This forced the court to determine the length of appearance of the character instead of focusing on if it could have affected the potential infringement of the initial character. Creators argue there should be a specific and independent category formulated for fictional characters in order for distinguishable independent characters are able to receive copyright protection while unrelated to any other type of artistic medium.

Trademark is dependent on the distinctiveness and ability to identify the mark of the product it sells in whatever market that an average consumer can identify. The Federal Trademark Protection Act only applies when the mark, in question, might be confusing to the consumer in identifying the source of the mark. However, trademark only provides legal protection for well known fictional characters who have well known names, appearances, and have been circulated in the public for a long period of time. Neither trademark nor unfair competition law can fully protect fictional characters, where stricter and more specified copyright laws could better protect these characters. But, copyright laws now sometimes force courts to use trademark laws in order to make a decision that might not be right for the character, in turn, possibly giving the wrong decision and leaving the character’s right vulnerable.

Character Merchandizing³

Character merchandizing is furthering a fictional character and giving the opportunity for consumers to buy products related or promoted by the character and distinctly the character's lifestyle. If the consumer has a desire or bond with the character, character merchandising- also called personality merchandising- allows the consumer to buy products to be able to live vicariously through the character. The character provides the product valuable attention because of the connection and association with the character. This form of merchandising has been a new method of selling products aside from celebrity endorsements. A few examples of character merchandising are The Simpsons. The Simpsons have been a long running television show and a multi-billion dollar merchandizing business. The characters of the Simpsons have featured on board games; Jeopardy, The Game of Life, Monopoly, and Sorry. There is a Universal Studios Simpsons ride; tchotchkes such as shirts, figurines, watches...etc.; Duff Beer; a movie made and then marketed on special edition gaming systems, and lastly there was a special edition Ben and Jerry's ice cream flavor distributed. Other examples are Disney's Mickey Mouse and Sanrio's Hello Kitty. This modern way of promoting goods benefits the characters by providing a service or product, which promotes the characters image to consumers.

E-Rights⁴

With emerging technology the creator's rights are evolving, and yet just as confusing

³ Scott, Geoffrey R., and Karen E. Maull. "Kryptonite, Duff Beer And The Protection of Fictional Characters And Products In The Global Community." *Monash University Law Review* 38.1 (n.d.): 228-82. *EBSCO*. Web. 12 Apr. 2014.

⁴ Allen, Moira. "Know Your E-Rights." *Writer (Kalmbach Publishing Co.)* 115.8 (2002): 18. *MAS Ultra -School Edition*. Web. 14 Apr. 2014.

as before. Protecting your material is important when publishing online and understanding what the print publications are asking for you to give over. Electronic publications is publishing anything online, put on a CD-ROM, or any other type of form that is available electronically. Publishing electronically means the material can be accessed online, anywhere, for an indefinite period of time. When electronic publishers are asking for your material, they are asking for a one-time right; it means the material being given to them cannot have been published in any other electronic form. Some electronic publishers will ask for a specific date, or time period, in which to keep your work live or active. If electronic publications ask for nonexclusive rights, that means the original work can be published elsewhere online or in print. Most electronic publications ask for archival rights, either indefinitely or for a specific period of time- be sure to ask for the archive removed before giving any other rights to the same material to another electronic publisher. It is amateur and usually looked down upon to post any of your work on your own website, it devalues the work. Only post material that has already been published elsewhere. Be aware of selling any electronic rights to print publishers because then the bought work will not be allowed to possibly be used electronically by the originator.

Chapter 3

Copyright

The Process

A creator has an idea of a character in their mind. The idea of the character becomes processed in the creator's mind until it is time to write down these thoughts. The second that pen, pencil, eyeliner, lipstick, touches a piece of paper, napkin, skin- the creator has a copyright over their intellectual property. In order for a literary character to have the utmost best protection from other people stealing or using it for profit, is to detail every miniscule part of this character. The goal is to be able to make sure the reader does not have any wiggle room to imagine a character that is not specifically, exactly, precisely what the creator has created and defined on the page.

Two Types of Characters

There are two types of literary characters: flat and round.

A flat character gives very little detail as to how to guide a reader to imagine exactly the character the author depicts. For example: "He was tall with dark brown hair, green eyes, a thin face, and big feet. His voice was deep and when he smiled you could see his teeth weren't perfect. He had a tattoo of his girlfriends face on his arm." Already the reader starts to fill in the spaces that are missing from the description and begin to create their own image of the character that wasn't what the author had in mind.

A round character gives every little detail, helping the reader imagine a person with attributes so well defined, it doesn't give much room for the reader to put their own touches on the character. "He was at least six foot three, with dark brown short ringlets that flopped around whenever he walked or the wind blew. The greasy ringlets would stay

in place whenever he ran his paint stained bony skeleton fingers through his hair. He had green eyes with a smattering of yellow flecks in the iris; where the white of his eyes would be, was replaced by countless thin red lines as if it were a road map leading behind his sockets. His gaunt, sunken face was so pale, the freckles lining the bridge of his nose looked like a smattering of black heads that wouldn't scrub clean. He constantly chewed on his ashen purple chapped lips and the inside of his small mouth. It was rare when he smiled, but when he did it revealed off white, coffee stained teeth- the two front teeth protruding farther than the rest of the set in his mouth. He alternated the same three baggy black long sleeve shirts whenever he left the house to hide the track marks and scabs lining his arms, hoping it would help him to stop picking at himself. The self-inflicted portrait tattoo of his ex-girlfriend on the top of his right forearm had become infected since he couldn't leave the scabbing alone. He had stopped shaving his arms for over a month and the portrait has become a Sasquatch with his arm hair covering the distorted and discolored face. When he spoke his voice was so deep, it echoed in the entire space, shaking the ground at everyone's feet; it surprised anyone who saw his lanky, frail frame and expected a meek unintelligible response." Extreme description takes more work, more knowledge of the character, better understanding of their physical and personality traits, but gives a higher chance of being able to protect the character through copyright.

Literary characters are harder to protect because of the lack of physical visual representation, like graphic characters. Graphic characters have their own challenges, but are more accepted by the courts as a copyrighted entity because they are able to see the delineation, or lack there of, when someone else is trying to use the original work (or similar parts) for a personal fiscal gain.

Copyright

Copyright¹ is a person's exclusive right to reproduce, publish, or sell his or her original work of authorship. The copyright exists when fixed in tangible form and protects creativity. Works of authorship² that can be protected under copyright are: literary, musical, dramatic, artistic, and architectural work. This paper will solely focus on literary work. The Copyright Act of 1976³ protects published or unpublished works that are in fixed in a tangible form of expression that can be perceived. The Act does not protect ideas, process, systems or discovery. The Act also revised the duration of protection for the work. For the purposes of this topic, the copyright duration of an author's original work is the author's life plus an additional 70 years after they pass away. An author already has a copyright once the material has become fixed in tangible form. However, if the material is not filed for copyright protection with the United States Copyright Office, there are only so many ways to legally protect the work.

The general consensus is that a literary character cannot be filed for copyright protection because there is usually not enough substance to allow for a court to distinguish a verbal representation. Even though a literary work can be protected under copyright laws, it does not necessarily mean the characters within the work are copyrighted and protected from others using those characters. The decision in *Warner Brothers v. Columbia Broadcasting Systems*⁴, the author of *The Maltese Falcon*, Dashiell Hammett, gave the rights to the characters of the book to Warner Brothers. Eventually, Hammett also gave the rights

¹ Loving, Bill. *Intellectual Property and Commercial Speech in the Digital Age*. 2013. PDF.

² Findlaw.com works of an authorship

³ See footnote ¹

⁴ Foley, Kathryn M. "Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide." *Connecticut Law Review* 41.3 (2009): 921-61. *LexisNexis*. Web. 10 Apr. 2014.

to CBS with the exclusive right of a character named Detective Sam Spade. Warner sued CBS, claiming that they owned the rights to all the characters, including Detective Sam Spade. The courts found that Detective Sam Spade was not a unique, leading character and did not carry the story's plot. This allowed CBS the rights to use the character without infringing upon Warner's rights.

Infringement

For the amount of blood, sweat and tears that goes into creating a piece of work, anything that could potentially seem similar feels like it is our idea being ripped out of our hands. Infringement⁵ of a copyright is the unauthorized copying of a material and/or copying a substantial portion of the protected work. If the alleged infringer denies copying, the copyright holder may have to be able to prove infringement with circumstantial evidence of how the infringer could have received access to the protected work and what in particular does the creator believe the infringer had copied. If the court finds that there are no similarities between the works, more specifically the characters, the accused infringer will have the ability to use that work as their own.

The distinct delineation inquiry emerged from the case of *Nichols v Universal Picture Corp.*⁶ The plaintiff Nichols, accused Universal for using similar characters from her play, for a film produced by Universal. The judges main concern was making sure fictional characters were protected under their original work, but the ideas of characters could be left for the public domain to be able to use without penalty. Judge Learned Hand determined for a character to be protected independently from the original plot, they

⁵ Findlaw.com infringement definition.

⁶ Foley, Kathryn M. "Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide." *Connecticut Law Review* 41.3 (2009): 921-61. *LexisNexis*. Web. 10 Apr. 2014.

would have to be a distinct delineation. He explained the more indistinct the character is written, the less protection the character will receive, thus, putting it in the category of an idea of expression. Therefore, the more distinct the character is written, the more protection the character will receive, lessening the opportunity for infringements because of the potential legal repercussions.

The courts have multiple tests used in order to determine if first, the character is copyrightable, and second, there was infringement of the character. All decisions are made by a case-by-case, court-by-court basis. In order to determine whether the character is copyrightable, the courts use a test called the Distinct Delineation Standard, or character delineation, first used in the *Nichols v Universal Picture Corp.* case. The second test, determining infringement of a character, is called the “Story Being Told” test. Under the “Story Being Told” there are three facets: extrinsic, intrinsic and abstraction tests.⁷ The extrinsic test is used to determine whether a character is protected by copyright within the context of the original work. It compares the specificities and criteria of both works on the basis of dissecting both works to delineate the plot, theme, dialogue, mood, setting, pace, characters and chronology of events. The intrinsic test is used in determining if there is “substantial similarity in the expressions of the ideas” to see if there was any infringement. This portion questions the “total concept and feel” of both works and “relies on the observations of the ‘ordinary reasonable person’” in being able to identify the similarities or differences of expression. The abstraction test is determined by a judge who analyzes how much of the details of the original work are included in the secondary work, and how general the information is in both works. Sometimes this results in not being able to

⁷ Foley, Kathryn M. "Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide." *Connecticut Law Review* 41.3 (2009): 921-61. *LexisNexis*. Web. 10 Apr. 2014.

protect the copyright owner's work because it becomes so generalized as an expressed idea rather than a descriptive work.

Fair Use⁸

The less distinct the character is, puts the character in the category of an expression of idea. An expression of an idea means that it is available in the public domain and is fair use by anyone. The public domain⁹ is where the rights to a general tangible expression of an idea belongs to a community, the work being unprotected by copyright or patent and can be appropriated by anyone. Fair use is using material that is copyrighted, but does not mean an infringement of the copyright because the work does not diminish the value of the original work or the fiscal earnings that should be pocketed by the creator. The factors utilized by the courts to determine if a copyrighted work is considered fair use are: the purpose of the use, the character of the use (as in being commercial or educational in nature), the nature of the copyrighted work, and the amount of work used.

Fan Fiction¹⁰

Fan Fiction is a subculture in which fans of literature write stories that involve personal creative labor added to a copyright holder's story and characters by borrowing characters and settings from an original work. Fan Fiction is noncommercial work and fan authors do not fiscally benefit from original copyrighted work. Fan fiction is not a type of professional writing because there is no monetary gain. Fan fiction spans genres including comedy, drama, melodrama, adventure, and mystery. There has no been a court case where

⁸ Findlaw.com fair use definition

⁹ Findlaw.com public domain definition

¹⁰ Tushnet, Rebecca. "Using Law and Identity to Script Cultural Production: Legal Fictions: Copyright, Fan Fiction, and a New Common Law." *Loyola of Los Angeles Entertainment Law Journal* 17.651 (1997): 1-35. *LexisNexis*. Web. 12 Apr. 2014.

a judge has been able to rule in favor or against fan fiction as apart of infringement. If anything, since there is no monetary value for the authors, the ruling might be in favor of fan fiction as a promotional¹¹ work for the original source since the original source of work must be cited.

Character Licensing: Tarzan¹²

In *Edgar Rice Burroughs, Inc. v. Metro-Goldwyn-Mayer, Inc.*, Burroughs wrote the Tarzan screenplay and sold the rights to MGM to produce a motion picture. In the contract, Burroughs stated any remakes of the original motion picture must be substantially similar to the original production. When MGM made the second motion picture, Burroughs sued for violating the contract. Burroughs alleges the second motion picture is not substantially based on the first picture; the second motion picture has material changes and material departures from the original story- such as changes to the, “script, continuity, character, personalities, plot, structure, motivation, events, time, sequence, credit, copyright and incidents, and eliminations from and additions” to the second film.

The lower courts reviewed both the first and second films to see no dissimilarity. The courts found no discrepancies in the contract between Burroughs and MGM. This is how: Burroughs signed the rights to MGM giving them the right to make the first motion picture based on the original story that Burroughs wrote, the ability to remake and reissue the first film, and to reproduce any additional motion pictures so long as they are based on the original story- for the entire duration of the copyright which includes any films further

¹¹ De Kosnik, Abigail. “Should Fan Fiction Be Free?” *Cinema Journal* 48.4 (2009): 118. Web. 12 Apr. 2014.

¹² *Edgar Rice Burroughs, INC., Plaintiff and Appellant v. Metro-Goldwyn-Mayer, INC., Defendant and Respondent*. 1. Court of Appeal of California, Second Appellate District, Division One. 5 July 1962. *LexisNexis*. Web. 12 Apr. 2014.

produced based on Tarzan. This gave MGM the right to unlimited reproductions of the original film for an indefinite period of time because of the allowances Burroughs thought he was using to protect his story. The contract permits MGM to update the original story to fit the future audience better in order to help make the storyline more clear and relevant- so long as it does not detract from the original story. An update includes modernizing clothes, updating the social customs, changing dialogue, changing the mood and tempo of the storyline, updating film techniques (such as changing the picture to color), and give it the feel of how people live their life in that particular future that the film would be remade.

One of the cases used to determine the court's findings, was *Manners v. Famous Players-Lasky Corp.* where the language of the contract stated that any changes of the material could not be altered without the approval of the author. However, in this case as well, it was the right of the motion picture production company to make necessary changes to better explain the plot.

The conclusion of the Tarzan license case was determined that there was no infringement of the contract and the two films produced were similar in original content based on the perception of the ordinary reasonable person.

The E-book & Publishing Agreements¹³

When entering into a contractual agreement, consider the best options for your work and for your characters. There is a rise in E-book sales over bound books, an E-book

¹³ Buchwald, Naomi Reice, Judge. "HARPERCOLLINS PUBLISHERS LLC, Plaintiff, - against - OPEN ROAD INTEGRATED MEDIA, LLP, Defendant." *UNITED STATES DISTRICT COURT SOUTHERN DISTRICT OF NEW YORK* (2014): n. pag. 14 Mar. 2014. Web. 9 June 2014.

being technology that allows a full text of a book to be accessed digitally through any electronic device. In the 2014 case *Harpercollins Publishers LLC, v. Open Road Integrated Media, LLP*, Harpercollins entered into a contract with Jean Craighead George to publish her children's book "Julie of the Wolves." This contract was written and signed in the early 1970's giving George 50% and Harpercollins the other 50% of royalties. Since then, technological advances have been made in the publishing industry. Open Road recently asked George if they could publish the e-book version of "Julie of the Wolves." George went to Harpercollins asking to see what they would give her in royalties if they were to publish the e-book. Open Road offered 50% while Harpercollins offered 25%, and assuming she had the e-book rights, George, unbeknown to Harpercollins, signed over the e-book rights to Open Road. The e-book was published and Harpercollins sued Open Road for infringement. In the 1971 contract between George and Harpersollins, it gives the publishing house to use the work, with the author's permission for, "retrieval and information systems, and/or whether through computer, computer-stored, mechanical or other electronic means now known or hereafter invented." The contractual language mention any "electronic means now known or hereafter invented," awarded the plaintiff because the statement was so broad it covered what would be considered the e-book.

There are many things to consider when entering into a contract but there are a few tips to consider for benefiting the work in the long run. You want the right to be able to reprint in whole or excerpts into other mediums such as newspapers, magazines, or anthologies. The word, "print" is heavily connoted with the idea of physically being printed onto paper, so make sure all forms of the idea of print are spelled out, or encompassed in a broad term to cover every basis. Make sure there is a "Reserved Rights" clause, which

allows the author to reserve the rights to their work that is currently existing or any other works going to be produced in the future, including the rights to sell to a motion picture company.

Ensure Your Character is Copyrightable¹⁴

It all lays within the author's ability to be excruciatingly, verbally detail oriented when creating a character. Make sure the character is so important to the story, that the story is useless without this character(s). The character must be every ounce uniquely distinct from a typical idea of expression to receive any consideration for the character to be copyrighted.

The character must be distinctly delineated. In the case of *Anderson v Stallone*, the court used the character delineation test to protect the character Stallone created for the motion picture "Rocky." Anderson wrote a story based on the character Rocky and tried to sell it to Stallone, thinking it was the next Rocky IV. Stallone sued Andersen for infringement, even though Andersen claimed Rocky, as a character, was not copyrightable. The court ruled in favor of Stallone because Rocky, the character, had an immense amount of detail and could be separated from the average idea of a character. In turn, the character Rocky is protected and cannot be used in other mediums to be profited on by another.

Any an all types of visual representation of the character will help define the physical attributes of the character, which will in turn help solidify the verbal details of the character in reader's minds. The more an ordinary reasonable person is able to process and

¹⁴ Biswas, Sourav Kanti De. "Copyrightability of Characters." *Journal of Intellectual Property Rights* 9 (2014): 148-56. Web. 12 Apr. 2014.

imagine the character as the author intended the character to be imagined, the more protection for the character and protection from infringement.

Chapter 4

Trademark

Trademark¹

Trademark is a “word, name, symbol or device, which is used in trade with goods” to identify the source of the product or service being offered and the ability distinguish what is being offered from the products others are selling. A “Trade Name”² is any name used by an individual to distinguish their business, a trademark for their product, or service mark for services. For example, IBM is used in their company name, produced on their products and identifies their computer services. Trademark relies on the ability of having a recognizable character that is uniquely associated with the product, service or business; so long as an ordinary reasonable person does not confuse your trademark, trade name, or trade character with another business- you have a valid trademark. The only catch is: you must be selling something in a market where the mark is in front of people’s faces. The protection given to a trademark has an indefinite duration³ if the trademark has been renewed and still is being used in commerce.

Trade Characters⁴

There are eight different types of trade characters: animate, inanimate, non-trademarked, trademarked, fictional, real, trade, celebrity. For the purpose of this paper, the focus will be on fictional trade characters. When the fictional literary character is used

¹ Findlaw.com trademark definition

² Loving, Bill. *Intellectual Property and Commercial Speech in the Digital Age*. 2013. PDF.

³ "The Protection Afforded Literary and Cartoon Characters Through Trademark, Unfair Competition and Copyright." *Harvard Law Review* (1954): 349-63. Web. 12 Apr. 2014.

⁴ Phillips, Barbara J. "Defining Trade Characters and Their Role In American Popular Culture." *The Journal of Popular Culture* 29.4 (1996): 143-58. Print.

to promote a product, they must be looked at as the spokesperson. The consumer is relying on them to advertise a product they might want to be or a service they will want to use. The character is not only a spokesperson but the representative of the product. For example the Marlboro cowboy; he is not a real non-fictional man, he is a fictional person. Yet, his character reaches more than just the average male consumer; advertising studies have shown that he attracts women and minorities to the product as well. The character should be relatable as if they were non-fictional. A trade character communicates through their personality and adds emotional appeal to the business.

Another example of a trade character is Mickey Mouse, one of the most lucrative trademarked characters ever. Mickey Mouse is a mouse that walks on two white pillow-like shoes, wears matching white gloves, and wears little red pants with two yellow buttons. Mickey couldn't be a copyrighted character because of how simplistic the detail is, however, put the image of Mickey on a Disney product and everyone can associate who the mouse is and where he belongs. Mickey Mouse is 61 years old and has been effectively protected under trademark law.

Trademark Protection⁵

In order to have a trademark, you need to have a business that sells goods or services. Trademark infringement is when other people or businesses are using the same mark as you to identify all types of other products or services and no longer can the ordinary reasonable person distinguish what you sell versus the other company. Once you lose the unique identification of your business, there is no protecting it. For example, Refrigerator used to be a brand name for, well, refrigerators. This is exactly the point: the

⁵ Foley, Kathryn M. "Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide." *Connecticut Law Review* 41.3 (2009): 921-61. *LexisNexis*. Web. 10 Apr. 2014.

name became so generic to identify any and every icebox, that Refrigerator lost its business and could not protect their brand.

There has not been a case where a court has found a fictional character essentially distinct enough. The courts request from the person, or business, to provide evidence of secondary meaning to determine if there is a proper trademark. A secondary meaning is when a product might not have an inherently distinct name, logo, symbol, etc. but the general consumer is able to identify the product from the logo, symbol, name, etc. However, secondary meaning limits trademark protection for fictional characters that have been circulated in consumer markets and have obtained recognition. In order to remotely try to protect an already circulated fictional character, there must be an immense amount of evidence that there is enough distinction of the character by proving the average reasonable consumer can identify the character and what the product or service the character represents.

Another issue of protection is the “single source” written in the Lanham Act that requires the trademark to have to indicate only one product can be used for this fictional character representation. Fictional characters might be associated with a multitude of sources starting first with their author, producers, artists, for example. The fictional character as a trademark then becomes obsolete and cannot be protected by trademark laws.

If the fictional character has been circulated, has secondary meaning and is a single source for a product, then the courts decide what parts of the fictional character is the part to be trademarked. Some of the options are, “character names, nicknames, costumes, and even key phrases associated with a character.” After the chosen piece of the fictional

character is determined as a recognizable trademark, the owner needs to show that the potential infringing mark of another person's business mark can confuse the general public, making sales drop.

Most courts hesitate to use protection for fictional characters that are not well known in new fiction. In the case of *De Costa v. Columbia Broadcasting Systems*, Victor De Costa created a character named Paladin, who would perform as the character Paladin at agricultural events. De Costa put out business cards for his performance of Paladin with the phrase, "Have Gun will Travel." De Costa kept up this fictional persona performance for over ten years. CBS decided to air a show titled, "Have Gun Will Travel," featuring the character Paladin who wore almost the same exact outfit that De Costa would wear during a performance. De Costa sued CBS for trademark infringement and unfair competition. However, the courts found that the Paladin character's recognition is limited to a particular audience; therefore, there would not be any confusion as to who was sponsoring the character at these agricultural events and who would be sponsoring the character on the television series. Usually trademark holders in this same position are not awarded with full protection if the character isn't exactly identical to the original work. The courts will decline protection to trademark infringements if the similarities are only vague physical or personality characteristics.

Best Practices

Start by making sure the name of your potential business is not already taken by another business, product, or service. Once you have a name make sure it is more than a name. The name needs to be able to see the character and distinguish it from all other characters. There needs to be real identification between businesses and their marks. A

good example of this is Apple's half bitten apple. The half bitten apple was only going to become distinct once the products of the Apple company were in circulation and recognizable by the consumers. Apple has had different designs since their start, but the half bitten apple is still a distinguished logo because of the products sold. No other half bitten apple can be confused with Apple's apple. Your logo must be uniquely associated with your business. Perhaps, you create a website that sells basic goods with your logo, with a character from your story, a certain phrase the characters says. There are plenty of ways to start selling products; it is only a matter of keeping up circulation with a uniquely distinct brand.

Chapter 5

Conclusion

Summary

This paper on intellectual property was to exhibit the protection allowed to literary characters and the limitations of protection for how an originator can protect their literary characters through copyright and trademark. There are basic ideas to start the process of protection of literary characters such as careful description and the ability of delineation. Through these basic ideas and complex laws, there is a reason to keep pushing the boundaries to protect literary characters as individuals.

Discussion

Through researching literary sources and legal sources, it is obvious that the courts are unable to set a certain code, or specific laws, concerning copyrightability of literary characters and distinction of marks in trademarking literary characters. The cases are all based on subjective decisions using loose or faulty ideas that sometimes do not benefit the creator at all. Some cases reflected the ability of benefiting from a literary character as apart of an entire work and not as an individual. One author suggests a set of dedicated, solid rules that pertain solely to copyright without blurring the lines between the copyright and trademark convergence phenomenon.

Recommendations for Practice

Looking at the trends, court cases, and literary sources the best practices for potentially copyrighting a character are:

1. Create the literary character with as much ornate detail to describe everything from their toenails to their personality ticks. Create the literary character with the

intention of not letting the reader fill informational or imagery gaps with their own perception of the character.

2. File the entire work for copyright protection and try to file for the character as a separate copyright. If you are denied, edit the character again and again until the character can be accepted for their distinctness.

3. Make sure the character is an essential part of the story. If a court decides to use the “story being told” test, then your character will be protected because the story would be nothing without that distinct character.

4. Create a type of visual physical representation of the literary character. This will help give more protection to the character because there will be a valid image to be able to associate with the character.

The aforementioned are things that must be present for any case involving copyright infringement in protecting your literary character.

The best practices for trademarking your character:

1. Create a whole new character, or use a foil character from the work that is not relatively important to the story. That character can be the face of any product you sell that is related to the original work. This character might potentially enable the laws “single goods” issue for the products or business services.

2. The fictional character must be uniquely distinct and able to be delineated from any other business’s product, logo, symbol, name, etc. Make sure before creating any type of business, there is no competition, or similarity between your business and another business.

3. Show face in the market as soon and as much as possible. The more a consumer is face to face with your branding, the better the business, product, service, goods, will be recognized by the average reasonable consumer and gain more protection.

4. Make sure the character has one discernible trait that can be relied upon if the entire fictional character cannot be trademarked. As shown by research, courts do not accept physical or personality traits as a trademarked entity.

Research Conclusion

Creators deserve to protect their essential characters in works. By following the above steps and keeping in mind the essential practices of detailing and distinguishing these literary characters from the rest of general ideas of expression and goods, authors are doing more work for a better pay off in the future.

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