



## IT'S ELEMENTARY: WHY WE NEED A NEW COPYRIGHT STANDARD, WITH STATUTORY GUIDANCE, FOR CHARACTERS IN A SERIES

Heather Schubert\*

### INTRODUCTION

Sherlock Holmes is, without a doubt, one of the most well-known and quoted characters of literary history, and has had a recent resurgence in contemporary entertainment.<sup>1</sup> Since Sir Arthur Conan Doyle's first work featuring Sherlock Holmes and his partner John Watson, *A Study in Scarlet*, was published in 1887, the novel's copyright term has since expired and the novel has been in the public domain for years.<sup>2</sup> This means today's authors and creators are free to incorporate any part of the first novel they would like to use in creating new works. So, does this public domain material include the entire character of Sherlock Holmes? Are authors today allowed to do what they want with Sherlock Holmes and adapt him to their creations? To many copyright academics and lawyers, the obvious answer is "yes."

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\*Heather Schubert, Managing Research Editor, *Rutgers Journal of Law & Public Policy*; J.D. Candidate May 2015, Rutgers University School of Law – Camden; M.L.I.S., May 2012, University of Pittsburgh.

<sup>1</sup> However, Sherlock Holmes, as written in Sir Arthur Conan Doyle's novels, never actually utters the phrase, "It's elementary, my dear Watson." 'Elementary, My Dear Watson,' SNOPE.S.COM, <http://www.snopes.com/quotes/signature/elementary.asp> (last updated July 2, 2006); Karl Smallwood, *Sherlock Holmes Never Said "Elementary, My Dear Watson," TODAY I FOUND OUT*, <http://www.todayifoundout.com/index.php/2013/08/sherlock-holmes-never-said-elementary-dear-watson/> (last visited Feb. 1, 2015).

<sup>2</sup> See U.S. COPYRIGHT OFFICE, DURATION OF COPYRIGHT 15A.0811 (2011), available at <http://www.copyright.gov/circs/circ15a.pdf>.

However, the Conan Doyle Estate disagrees. In a recent lawsuit, the Conan Doyle Estate argued that the character of Holmes, and other key characters in the series, did not complete their character development until the end of the entire series; thus, as complex literary characters, the copyright on the entire character should not enter the public domain until the last work in which the character appeared has entered public domain.<sup>3</sup>

This recent Holmesian lawsuit has highlighted a small area of copyright law that can have a huge impact: what copyright standard should apply to characters in a series, especially when the series spans a time where a shift in copyright term law led to works of the series entering the public domain in different years. There is currently a judicially created standard used among courts that have encountered this niche area of copyright law: the character-derivative standard. However, this note argues that the character-derivative standard is not the best solution for determining these series character problems. Character copyright law is relatively recent; the major cases in the topic are from the mid-twentieth century. The latter half of the twentieth century saw significant changes to copyright term lengths, which directly impacted character copyright. In addition, the recent decades have seen a drastic increase in series character entertainment throughout the many forms of media today. All of these factors emphasize the need for a legislative amendment to the copyright statute, both to create a character-specific section and to put into effect a more efficient standard for series characters: this note's proposed "first-expression" standard.

To understand the necessity of a new legislatively created standard, an explanation of copyright law, the current standard for character copyrightability and series characters, and possible alternatives is essential. Part I of this note lays out a brief overview of copyright law in general: its constitutional origin and the basic requirements. Then, it explains the two judicially created standards for copyrightability of a character: the generally followed "sufficient development" standard and the lesser followed "story being told" test. Lastly, Part I illuminates

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<sup>3</sup> See *infra* note 80 and accompanying text. Currently, there are still ten Sherlock Holmes stories being protected by copyright law; thus, if the character development is not complete until the last work in the series, they argue that the character of Holmes should not be in the public domain until that last work has entered as well. See *infra* Part III (for a complete explanation on this lawsuit).

the intricate difficulty with characters that span a series where the works enter the public domain at various years, beginning with the complexity of the copyright term extensions from the late-twentieth century and the problems included in applying these terms to series characters.

Part II explains the current judicially created standard for series characters, the character-derivative test and will detail the many difficulties in applying and following this standard. Parts III and IV describe two possible alternative standards that copyright holders and commentators have argued: (1) the Conan Doyle Estate's "completedness" argument from the brief in their recent lawsuit with lawyer-author Leslie S. Klinger, and (2) the possibility of refraining from any copyright protection for characters at all, pointed out by commentator Francis M. Nevins. Ultimately both of these alternatives have their own difficulties in realistic implementation.

Part V suggests an alternative solution to the series character problem: a "first-expression" standard where the term for a character's copyright begins with the work in which it is first expressed, and any elements of the character that appear in later works are irrelevant for character copyright term purposes. Once the first work with the character enters the public domain, the entire character (including any future series character elements) is free for the public to use. Part V explains the policy rationales for why the first-expression standard is the best solution compared to the current standard and any possible alternatives. Finally, Part V concludes by emphasizing why statutory guidance is necessary for any future character copyright law.

Although it encompasses a small area of copyright law, the increased popularity in series character entertainment creations and the upcoming entries of many works into the public domain show this is a pivotal time to make solid and efficient changes to character copyright law. The first-expression standard added to the copyright statute is the best possible solution because it is conceptually similar to the way series characters are treated with the current Copyright Statute of 1976, follows the original constitutional goals of intellectual property law, and would be more efficient for authors, companies, and the public.

## I. COPYRIGHTABILITY OF A CHARACTER

### A. BRIEF OVERVIEW OF COPYRIGHT LAW

To discuss the copyrightability of a character, a brief section on copyright law basics is needed. The origin of copyright law comes from the Constitution: Article I, Section 8, Clause 8 grants Congress the authority, “to promote the progress of Science and the useful Arts, by securing for limited times to authors or inventors the exclusive right to their respective writings and discoveries.”<sup>4</sup> To have copyright protection today, the copyright statute details the basic requirements: a work must be fixed in a tangible medium of expression,<sup>5</sup> and the expression must have a “modicum of creativity.”<sup>6</sup> These two basic and easy-to-satisfy requirements mean that only *expressions* of ideas, not the ideas themselves, are protected by copyright.<sup>7</sup>

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<sup>4</sup> U.S. CONST. art. I, § 8, cl. 8. Congress first implemented this constitutional clause into law in 1790. Laurie Richter, *Reproductive Freedom: Striking a Fair Balance Between Copyright and Other Intellectual Property Protections in Cartoon Characters*, 21 ST. THOMAS L. REV. 441, 456 n.67 (2009).

<sup>5</sup> 17 U.S.C. § 102(a) (1990). The statute provides:

Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings, and (8) architectural works.

*Id.*

<sup>6</sup> See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991).

<sup>7</sup> 17 U.S.C. § 102(b). “[I]n no case does copyright protection for an original work of authorship extend to any idea . . . regardless of the form in which it is described, explained, illustrated, or embodied in such work.” *Id.*

## B. THE JUDICIALLY CREATED COPYRIGHT OF A CHARACTER

Although the basic requirements of copyright are easy to state, they are difficult to apply to a specific character in a novel or movie. The copyright statute clearly defines various types of works that are protected and plainly describes the situations in which a work does not have copyright protection.<sup>8</sup> However, the copyright statute is completely silent on the topic of characters. The copyright statute does not define “character” in the definitions section,<sup>9</sup> and the statute never expressly states how a character should be protected or if a character in a work should even be protected at all.<sup>10</sup> Therefore, various cases and court rulings over the past century have created a right to copyright protection for specific characters in a work. Even though the statute never mentions copyright protection for a specific character, the courts have found<sup>11</sup> — and most scholars seem to agree — that the protection for distinctive characters falls within the broad authority given to Congress in to promote the progress of intellectual property.

However, the courts have found that, unlike an underlying novel or movie, a character is not given automatic copyright protection as soon as it is created in a work. Instead, the character needs to be “sufficiently developed to command copyright protection.”<sup>12</sup> Courts have created a few different tests to determine whether a character has met a level of

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<sup>8</sup> See *id.* §§ 101, 102(b).

<sup>9</sup> See *id.* § 101.

<sup>10</sup> Even the go-to Nimmer Copyright treatise only has a small section on the topic of characters. See MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.12 (2014).

<sup>11</sup> See *infra* Part I.C-D.

<sup>12</sup> NIMMER & NIMMER, *supra* note 10, at § 2.12. This goes along with the general policy considerations for copyright and wanting to protect expressions but not ideas. If every single character in a book or movie was protectable by copyright, it would be very difficult to create new works that did not infringe upon any previously created characters (because even mundane characters like “a taxi driver” would then be protectable). By requiring characters to be distinct and creative enough to merit protection, copyright law rewards authors for creating unique characters.

distinctiveness to be protected by copyright. Unfortunately, they have not developed a bright line for what is or is not enough to be protected. Instead, whether a character is sufficiently developed, and thus qualified for copyright protection, is determined on a case-by-case basis.<sup>13</sup> The most common test courts use to determine whether or not a character is unique and distinctive enough to deserve copyright protection is whether or not the character has been *sufficiently developed*. A secondary test courts use is whether or not the character in question constitutes part of the *story being told*. The next two sections will detail these two tests and the cases from which they originated.

### C. THE SUFFICIENT DEVELOPMENT<sup>14</sup> STANDARD

One of the first and most well-known cases to analyze the copyrightability of a character was *Nichols v. Universal Pictures Corp.*<sup>15</sup> Nichols, the author of the play *Abie's Irish Rose*, alleged infringement of her play's characters by Universal in their latest film, *The Cohens and the Kellys*.<sup>16</sup> Both the play and the movie involved a love story between a Jewish girl and an Irish boy whose fathers disapproved of a marriage between the two, although eventually the fathers came around and reconciled with the children.<sup>17</sup> Nichols argued that Universal copied her characters, including the couple at issue and the angry and

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<sup>13</sup> Christine Nickles, *The Conflicts Between Intellectual Property Protections When a Character Enters the Public Domain*, 7 UCLA ENT. L. REV. 133, 139 (1999).

<sup>14</sup> Also called the distinct delineation test, the character-delineation test, or the sufficient delineation test. See 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. INTELL. PROP. L. REV. 63, 68-70 (2005); Kenneth E. Spahn, *The Legal Protection of Fictional Characters*, 9 U. MIAMI ENT. & SPORTS L. REV. 331, 333-35 (1992); Andrew J. Thomas & J.D. Weiss, *Evolving Standards in Copyright Protection for Dynamic Fictional Characters*, 29 COMM. LAW 9, 9-10 (2013).

<sup>15</sup> 45 F.2d 119 (2d Cir. 1930).

<sup>16</sup> *Id.* at 120.

<sup>17</sup> *Id.* at 120-21.

judgmental fathers of different religions.<sup>18</sup> However, Judge Learned Hand found that Nichols' characters lacked the distinct features and characteristics needed to warrant protection: "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>19</sup> Thus, Judge Hand, in his own distinct terminology<sup>20</sup> found that Nichols stock characters of a "low comedy Jew and Irishman" were equivalent to ideas, not distinct expression, and therefore were not protectable.<sup>21</sup>

This Learned Hand sufficient development/distinct delineation test, while being a Second Circuit decision, is followed by the majority of the circuits and has become the general standard for character copyrightability in character infringement cases.<sup>22</sup> In applying the sufficient development standard, courts look at three identifiable and legally significant components to determine whether or not a character is sufficiently developed: the name, physical/visual appearance, and personality traits/characterization.<sup>23</sup> The more developed these three components are, the more likely a character will be

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<sup>18</sup> *Id.*

<sup>19</sup> *Id.* at 121.

<sup>20</sup> Judge Hand refers to the lovers in the story as "no more than stage properties" and the fathers as "grotesque hobbledehoy[s], used for low comedy of the most conventional sort, which any one might borrow, if he chanced not to know the exemplar." *Id.*

<sup>21</sup> *Nichols*, 45 F.2d at 121.

<sup>22</sup> Spahn, *supra* note 14, at 334; *see also* *Olson v. Nat'l Broad. Co.*, 855 F.2d 1446, 1451-53 (9th Cir. 1988) (holding that Olson's television series "Cargo" did not infringe upon NBC's "The A-Team" because the A-Team characters failed to meet the level of delineation sufficient for copyright protection). When used for character infringement, the test is two-part: (1) the original character's expression needs to be sufficiently delineated to be copyrightable, and (2) the infringing character's expression needs to be substantially similar to that of the original character to find infringement. Schienke, *supra* note 14, at 68-69 (citing David B. Feldman, Comment, *Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection*, 78 CALIF. L. REV. 687, 691 (1990)).

<sup>23</sup> Feldman, *supra* note 22, at 690.



protected.<sup>24</sup> In circuits that apply the sufficient development test, the same three factors are used consistently to analyze a character's development. However, the Ninth Circuit still holds on to their own established test as well: a character is protectable by copyright if he constitutes the "story being told."

#### D. SECONDARY: STORY BEING TOLD TEST

A few decades after the Learned Hand sufficient development test was articulated in the Second Circuit, the Ninth Circuit took a different approach to determining the copyrightability for a character in *Warner Bros. Pictures v. Columbia Broadcasting Systems*.<sup>25</sup> Writer Hammett granted exclusive rights to Warner Brothers to use *The Maltese Falcon* in its moving pictures, radio, and television.<sup>26</sup> However, Hammett later assigned the rights to the characters in *The Maltese Falcon*, including Sam Spade, to CBS.<sup>27</sup> Of course, Warner sued CBS, asserting Warner owned the copyright to the characters.<sup>28</sup> The court agreed that characters are copyrightable, and that the "purpose [of copyright protection] would not be furthered if an author sold the future rights to the characters whenever he sold a story."<sup>29</sup> The basic holding of the case is that the characters were *not* sold when he sold the story

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<sup>24</sup> For example, most people know who Sherlock Holmes is, but they do not recall the character of one of his lesser-discussed villains or, even better, the witness of one of the crimes whom Sherlock interviewed. *See also* *Detective Comics v. Bruns Publ'ns*, 111 F.2d 432, 433-34 (2d Cir. 1940) (finding that although Superman and Wonder Woman both were heroes with super-strength, speed, and defeated against evil, the specific feats of Superman, like stopping bullets, flying, and jumping over tall buildings, in addition to his unique costume and visual depiction, made him a sufficient delineation and unique expression and not just a "mere delineation of a benevolent Hercules").

<sup>25</sup> 216 F.2d 945 (9th Cir. 1954) (called by many academics and courts as "the Sam Spade case").

<sup>26</sup> *Id.* at 948.

<sup>27</sup> *Id.*

<sup>28</sup> *Id.* at 948-49.

<sup>29</sup> Feldman, *supra* note 22, at 694.



to Warner Brothers. However, the court went further and seemed to create a new test for determining copyrightability of characters: “[I]t is conceivable that the character 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 copyright.”<sup>30</sup> Then, the court applied its “story being told” test to Sam Spade and the Maltese Falcon characters and determined they were merely “vehicles for the story told,”<sup>31</sup> and therefore were not protected.<sup>32</sup>

The Ninth Circuit followed *Warner Bros. Pictures* with *Walt Disney Products v. Air Pirates*.<sup>33</sup> Here, the Ninth Circuit appeared to limit the Sam Spade story being told test to literary characters, whereas the comic book characters have a distinctive visual image that allows for the separation of the character’s expression from the ideas. Disney sued Air Pirates for producing a comic that included the traditional Disney characters but in promiscuous and drug-ingesting scenes.<sup>34</sup> The court distinguished between literary characters and comic book visual characters: unlike literary characters, comic book characters have a distinctive visual image that allows for the separation of the character’s expression from the ideas.<sup>35</sup> After

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<sup>30</sup> *Warner Bros. Pictures*, 216 F.2d at 950.

<sup>31</sup> *Id.* (assuming chessmen and vehicles are the same thing).

<sup>32</sup> *Id.* Gregory S. Schienke points out that there is much debate about what exactly Judge Stephens meant, whether it was clearly articulated that he was applying this newly created story being told test to the ruling, whether that portion of the opinion was just dictum, or whether it was provided by the court as an alternate rationale for the holding. Schienke, *supra* note 14, at 71-72.

<sup>33</sup> 581 F.2d 751 (9th Cir. 1978), *cert. denied*, 439 U.S. 1132 (1979).

<sup>34</sup> *Id.* at 753.

<sup>35</sup> Feldman, *supra* note 22, at 696; *see also* Schienke, *supra* note 124, at 72-74. Schienke discusses defining and classifying fictional characters into four different groups: (1) pure characters not appearing in an incorporated work, (2) literary characters arising from novels or scripts with description and action creating the character, (3) visual characters found in live-action movies, and (4) cartoon characters, used in reference to all line drawings of a perceived simplicity. Schienke, *supra* note 14, at 72-74. For purposes of this note, it is not necessary to delve further into the distinctions between the different types of fictional characters.

finding that comic book characters are distinguishable from literary characters, the court ruled that the “Warner Brothers language does not preclude protection of Disney’s characters.”<sup>36</sup> However, this reasoning is questionable and the effect of the *Air Pirates* ruling is uncertain.<sup>37</sup> This reading of the Sam Spade rule does not explain the necessity for applying different standards to different types of characters: literary or visual.<sup>38</sup> Thus, courts within the Ninth Circuit sometimes employ both the sufficient development test and the story being told test to determine copyrightability of characters.<sup>39</sup>

### E. THE PROBLEM WITH CHARACTERS IN A SERIES

Although the requirements for character copyright protection are not explicitly laid out in the copyright statute, the courts have created these two tests to apply when faced with a copyrightability or character infringement situation. However, this note focuses on one niche area of character copyright that makes for some particularly complicated litigation and interesting academic debate: the problem with the copyright terms for a character in a series when some of the works with the character are in the public domain and some are still protected by copyright.<sup>40</sup> This unique situation is only possible for works in a series that span a few specific decades in the mid-twentieth century. However, there are many the well-known

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<sup>36</sup> *Walt Disney Prods.*, 581 F.2d at 755.

<sup>37</sup> Thomas & Weiss, *supra* note 14, at 11.

<sup>38</sup> *Id.* One argument is that a visually depicted character is more likely to be sufficiently delineated than a purely literary character, but this argument does not support the rationale for needing a separate story being told test instead of using the sufficient development test.

<sup>39</sup> *Id.* (citing *Anderson v. Stallone*, No. 97-0592 WWDK (Gx), 1989 U.S. Dist. LEXIS 1109, at \*20-21 (C.D. Cal. Apr. 26, 1989) (holding that the characters from various *Rocky* movies, such as Rocky Balboa, Adrian, and Apollo Creed, were both sufficiently delineated and constituted the story being told to warrant copyright protection)).

<sup>40</sup> Francis M. Nevins, Jr. calls this “The Series Character Conundrum.” Francis M. Nevins, Jr., *Copyright + Character = Catastrophe*, 39 J. COPYRIGHT SOC’Y U.S.A. 303, 334-37 (1992).

characters that fall into this unique copyright term situation with well-established and powerful estates and corporations as copyright holders.<sup>41</sup> As these well-known characters and their works continue to be stuck in this split-term situation, other authors and creators continue to seek the use of the potential public domain characters and elements, emphasizing the importance of finding an efficient solution to this problem.

### 1. Copyright Term Extensions

The first step in analyzing this unique problem is understanding the many changes to copyright law and the term lengths of copyright protection that have been extended throughout the centuries. The First Congress implemented the copyright provision of the U.S. Constitution in the Act of May 31, 1790 with a copyright term of fourteen years from the date of publication, renewable for an additional fourteen years if the author survived the first term.<sup>42</sup> The Act of February 3, 1831 increased the original term to twenty-eight years from the date of publication, but left the renewable term at fourteen years.<sup>43</sup> The twentieth century brought many changes to copyright law, and most importantly for this note, continued this pattern of term extension. First, the Copyright Act of March 4, 1909 allowed for an original copyright term of twenty-eight years, with an optional renewal period of another twenty-eight years.<sup>44</sup> Then, a major change to copyright terms came with the Copyright Act of 1976: works were now protected for the life of the author plus an additional fifty years after the author's death.<sup>45</sup> In addition, this Act increased the renewal term for

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<sup>41</sup> Three well-known characters in this “conundrum” include: Sherlock Holmes, Hopalong Cassidy, and Tarzan. *Id.* at 334.

<sup>42</sup> Richter, *supra* note 4, at 456 n.67.

<sup>43</sup> *Id.*

<sup>44</sup> *Id.*; see also The Copyright Act of 1909, Pub. L. No. 60-349, ch. 320, § 23, 35 Stat. 1075 (1909), available at <http://www.copyright.gov/history/1909act.pdf>.

<sup>45</sup> Richter, *supra* note 4, at 457 n.70 (citing Caren L. Stanley, *A Dangerous Step Toward the Over Protection of Intellectual Property: Rethinking Eldred v. Ashcroft*, 26 HAMLINE L. REV. 679, 699 (2003)). In addition to this significant

works copyrighted before 1978 that had not already entered the public domain from the original extension term length of twenty-eight years to forty-seven years, resulting in a total copyright term length of seventy-five years for all works copyrighted prior to 1978 that had not already entered the public domain.<sup>46</sup> Lastly, the Copyright Term Extension Act

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change to term lengths, Congress also drew distinctions between works created by individuals, anonymous persons, pseudonym works, and works made for hire. *Id.* For the latter three types of works, the copyright term length was now seventy-five years from the date of publication, or one hundred years from the date of creation, whichever occurred first. *Id.*

<sup>46</sup> 17 U.S.C. §§ 301-05 (1998). The copyright statute details these explicitly depending on whether the works were created, published, or copyrighted before, during, or after 1978, and in addition, which term the copyrighted work was in at the time (the first twenty-eight-year term from the Copyright Act of 1909 or the renewal term possible after the first term).

*See id.* § 303(a):

Duration of copyright: Works created but not published or copyrighted before January 1, 1978:

(a) Copyright in a work created before January 1, 1978 but not theretofore in the public domain or copyrighted, subsists from January 1, 1978, and endures for the term provided by section 302. In no case, however, shall the term of copyright in such a work expire before December 31, 2002; and, if the work is published on or before December 31, 2002, the term of copyright shall not expire before December 31, 2047.

*See id.* § 304:

Duration of copyright: Subsisting copyrights:

(a) Copyrights in their First Term on January 1, 1978 – (1)(A) Any copyright, in the first term of which is subsisting on January 1, 1978, shall endure for 28 years from the date it was originally secured.

(B) In the case of –

(i) any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or

(ii) any work copyrighted by a corporate body (otherwise than as an assignee or licensee of the individual author) or by an

(CTEA) of 1998<sup>47</sup> extended these terms: for works by individuals, the term was extended an additional twenty years for a total of life of the author plus seventy years after death; for works of corporate authorship the term was extended to ninety-five years after publication or one hundred-twenty years after creation, whichever occurs first; and for the complicated variety of works in 17 U.S.C. §§ 303 and 304, their terms were also extended another twenty years for a total of ninety-five years.<sup>48</sup> As of 2014, all works created prior to 1923 are now in the public domain.<sup>49</sup> For works created, published, and copyrighted

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employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of 67 years.

(C) In the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work

(i) the author of such work, if the author is still living,

(ii) the widow, widower, or children of the author, if the author is not living,

(iii) the author's executors, if such author, widow, widower, or children are not living, or

(iv) the author's next of kin, in the absence of a will of the author, shall be entitled to a renewal and extension of the copyright in such work for a further term of 67 years.

See also U.S. COPYRIGHT OFFICE, *supra* note 2.

<sup>47</sup> Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998), available at <http://www.copyright.gov/legislation/s505.pdf>. Also called the Sonny Bono Copyright Term Extension Act, the Sonny Bono Act, or the Mickey Mouse Protection Act. Lawrence Lessig, *Copyright's First Amendment*, 48 UCLA L. REV. 1057, 1065 (2001).

<sup>48</sup> U.S. COPYRIGHT OFFICE, COPYRIGHT BASICS 1.0512, available at <http://www.copyright.gov/circs/circ01.pdf>.

<sup>49</sup> These works would still fall under the Copyright Act of 1909 and thus their terms have clearly expired. See NIMMER & NIMMER, *supra* note 10, §

between 1923 and 1978 and beyond, there are a variety of potential copyright term lengths the works could have. The next section details this problem more fully, as applied to series characters.

## 2. Applying the Term Extensions to the Series Character Problem

To fully understand the series character copyright term problem and its importance in today's ever expanding market for adaptations, remakes, and spin-offs, one last review of copyright term minutia is needed. For most, if not all, series works in existence today, there are three possibilities for their copyright terms:

- (1) The entire series is in the public domain.<sup>50</sup>
- (2) The entire series is still protected by the Copyright Statute.<sup>51</sup>
- (3) While some works in the series are in the public domain, some works in the series are still currently protected by copyright.

The first possibility is what happens with series completed before 1923. Because all of the works in the series were completed by that date, they have all fallen into the public domain with no chance of further term renewal. The second possibility is just as simple. For works in a series that was begun on or after January 1, 1978, the entire series follows the 1976 Copyright Act term (and the CTEA extension): ALL the works in

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9.11[B][1] (discussing that works first published through the end of 1922 remain unprotected today).

<sup>50</sup> Nevins, *supra* note 40, at 335. "There clearly can be no legal challenge to another's use of a series character when all that character's adventures are in the public domain." *Id.*

<sup>51</sup> *Id.* "The series character problem can never arise when all of a particular character's exploits postdate January 1, 1978, as is the case, for example, with law professor Jeremiah Healy's Boston private eye John Francis Cuddy, who debuted in 1984." *Id.*

the series by the same author will be protected under copyright for the life of the author plus fifty (now seventy) years.<sup>52</sup> The works will then all enter the public domain at the same time, at the end of the calendar year seventy years after the author's death.<sup>53</sup> The third possibility is where it can get complicated and the litigation begins. Term extensions and retroactive term extension amendments to the 1976 Copyright Act created a variety of different scenarios depending on date of creation, publication, and renewal.<sup>54</sup> Thus, it is very possible to have early works in a series that have fallen into the public domain and later works in the same series that are still protected by copyright, splitting your character into a public domain character and character elements that are still protected by copyright.<sup>55</sup> This somewhat understated problem becomes much clearer when one needs a spreadsheet, a tree-diagram, or a flowchart just to be able to calculate term expirations.<sup>56</sup> As a brief example, below is a short excerpt of a chart created to help facilitate the understanding of when, after all of the past

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<sup>52</sup> 17 U.S.C. § 305 (1998).

<sup>53</sup> *Id.* "All terms of copyright provided by sections 302 through 304 run to the end of the calendar year in which they would otherwise expire." *Id.*

<sup>54</sup> *See supra* Part I.E.1.

<sup>55</sup> The Sherlock Holmes series by Conan Doyle is a perfect example. The first work was published in 1887, clearly early enough to have fallen into the public domain. However, the later works, the last in 1927, are still protected by American copyright law today. *See* Nevins, *supra* note 40, at 335-36 n.160 (citing NIMMER & NIMMER, *supra* note 10, at § 9.01[C] n.81 and accompanying text). The Conan Doyle Estate was recently in litigation with a writer over the use of the Sherlock Holmes and Watson characters. *See infra* Part III "Alternate I: The Conan Doyle Completedness Standard," for more on this litigation.

<sup>56</sup> *See Copyright Flowchart*, SUNSTEIN KANN MURPHY & TIMBERS LLP, <http://sunsteinlaw.com/practices/copyright-portfolio-development/copyright-pointers/copyright-flowchart/> (last visited Feb. 1, 2015); *Tree-view Chart on Copyright Law*, COPYRIGHTDATA.COM, <http://chart.copyrightdata.com/#top> (last visited Feb. 1, 2015).



century's copyright law changes, a work will enter the public domain.<sup>57</sup>

Copyright Term and the Public Domain in the United States 1 January 2014 <sup>4</sup>		
Never Published, Never Registered Works <sup>2</sup>		
Type of Work	Copyright Term	What was in the public domain in the U.S. as of 1 January 2014 <sup>2</sup>
Unpublished works	Life of the author + 70 years	Works from authors who died before 1944
Unpublished anonymous and pseudonymous works, and works made for hire (corporate authorship)	120 years from date of creation	Works created before 1994
Unpublished works when the death date of the author is not known <sup>4</sup>	120 years from date of creation <sup>4</sup>	Works created before 1994 <sup>4</sup>
Works Registered or First Published in the U.S.		
Date of Publication <sup>6</sup>	Conditions <sup>2</sup>	Copyright Term <sup>3</sup>
Before 1923	None	None. In the public domain due to copyright expiration
1923 through 1977	Published without a copyright notice	None. In the public domain due to failure to comply with required formalities
1978 to 1 March 1989	Published without notice, and without subsequent registration within 5 years	None. In the public domain due to failure to comply with required formalities
1978 to 1 March 1989	Published without notice, but with subsequent registration within 5 years	70 years after the death of author. If a work of corporate authorship, 95 years from publication or 120 years from creation, whichever expires first
1923 through 1963	Published with notice but copyright was not renewed <sup>8</sup>	None. In the public domain due to copyright expiration
1923 through 1963	Published with notice and the copyright was renewed <sup>8</sup>	95 years after publication date
1964 through 1977	Published with notice	95 years after publication date
1978 to 1 March 1989	Created after 1977 and published with notice	70 years after the death of author. If a work of corporate authorship, 95 years from publication or 120 years from creation, whichever expires first
1978 to 1 March 1989	Created before 1978 and first published with notice in the specified period	The greater of the term specified in the previous entry or 31 December 2047
From 1 March 1989 through 2002	Created after 1977	70 years after the death of author. If a work of corporate authorship, 95 years from publication or 120 years from creation, whichever expires first
From 1 March 1989 through 2002	Created before 1978 and first published in this period	The greater of the term specified in the previous entry or 31 December 2047
After 2002	None	70 years after the death of author. If a work of corporate authorship, 95 years from publication or 120 years from creation, whichever expires first
Anytime	Works prepared by an officer or employee of the United States Government as part of that person's official duties. <sup>41</sup>	None. In the public domain in the United States ( <a href="#">17 U.S.C. § 105</a> )

<sup>57</sup> *Copyright Term and the Public Domain in the United States*, COPYRIGHT.CORNELL.EDU (Jan. 1, 2014), <http://copyright.cornell.edu/resources/publicdomain.cfm>. The chart was first published in: Peter B. Hirtle, *Recent Changes to the Copyright Law: Copyright Term Extension*, ARCHIVAL OUTLOOK (Jan./Feb. 1999); see also Peter B. Hirtle, *When is 1923 Going to Arrive and Other Complications of the U.S. Public Domain*, SEARCHER (Sept. 2012), <http://www.infotoday.com/searcher/sep12/Hirtle--When-Is-1923-Going-to-Arrive-and-Other-Complications-of-the-U.S.-Public-Domain.shtml> (for further explanations on the chart and complications hidden in it).

Although this sounds like a trivial, logistical problem, this split-statute character problem can have big implications, as shown by recent litigation. Split-statute characters are incorporated in all different forms of media today including comic, books, television, and movies. This next section will explain the current widely used standard, explore a few alternatives, and ultimately discuss this note's proposal for a more efficient and policy-based solution.

## II. THE CHARACTER-DERIVATIVE STANDARD

### A. THE BASICS OF THE STANDARD

The character-derivative standard is the most used standard for determining the copyright protection for characters in a series that has works with varying copyright term expiration dates. The basic idea is: “a copyright on a character that is a derivative of a public domain character applies only to the original aspects of the derivative work.”<sup>58</sup> Put differently, each sufficiently distinct element of a character in a later work in the series is treated as a derivative work (just as the movie adaptation of a novel still under copyright is a derivative work) because the character that appears throughout the series is the underlying work upon which the later works are based.<sup>59</sup> Courts require that these derivative elements of the character pass the

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<sup>58</sup> Nickles, *supra* note 13, at 153.

<sup>59</sup> 17 U.S.C. § 101 (2010). The Copyright Act defines “derivative work” in as:

A work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed or adapted. A work consisting of editorial revision, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a derivative work.

*Id.* The public is generally free to make derivative works by altering materials in the public domain, but the derivative work made cannot infringe upon an existing valid copyright. Thomas & Weiss, *supra* note 14, at 12 (citing Warner Bros. Entm't v. X One X Prods., 644 F.3d 584, 589 (8th Cir. 2011)).

same bar for copyrightability as non-derivative original works of expression.<sup>60</sup> If an author uses the same character in a series of works where some works are in the public domain and other works remain protected, anyone can copy the elements of the character that have entered the public domain, but the elements still protected cannot be copied.<sup>61</sup> That is,

just as copyright in a derivative work will not protect public domain portions of an underlying work as incorporated in the derivative work, so copyright in a particular work in a series will not protect the character as contained in such series if the work in the series in which the character first appeared has entered the public domain.<sup>62</sup>

The origin of the character-derivative standard and the most cited case applying it is *Silverman v. CBS Inc.*<sup>63</sup> In *Silverman*, CBS owned pre-1948 radio scripts of the television and radio show *Amos 'n' Andy*; a playwright wanted to use the characters from the pre-1948 scripts for his musical.<sup>64</sup> The playwright argued that because the pre-1948 scripts were in the public domain, so were the characters expressed in those scripts.<sup>65</sup>

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<sup>60</sup> Nickles, *supra* note 13, at 154 (citing *Dr. Seuss Enters. v. Penguin Books U.S.A.*, 924 F. Supp. 1559, 1565-66 (S.D. Cal. 1996); *Conan Props. v. Mattel, Inc.*, 712 F. Supp. 353, 358-60 (S.D.N.Y. 1989); *Harvey Cartoons v. Columbia Pictures Indus.*, 645 F. Supp. 1564, 1569-71 (S.D.N.Y. 1986)).

<sup>61</sup> NIMMER & NIMMER, *supra* note 10, § 2.12 (citing *National Comics Publ'ns, Inc. v. Fawcett Publ'ns*, 191 F.2d 594 (2d Cir. 1951)). Nimmer further explains: "once copyright in the first work that contained the character enters the public domain, then it is not copyright infringement for others to copy the character in works that are otherwise original with the copier, even though later works in the original series remain protected by copyright." *Id.* (citing *Columbia Broad. Sys., Inc. v. DeCosta*, 377 F.2d 315 (1st Cir. 1967), *cert. denied*, 389 U.S. 1007 (1967)).

<sup>62</sup> *Id.* (citing *Siegel v. Warner Bros. Entm't Inc.*, 690 F. Supp. 2d 1048, 1059 (C.D. Cal. 2009)).

<sup>63</sup> 870 F.2d 40 (2d Cir. 1989).

<sup>64</sup> *Id.* at 42.

<sup>65</sup> *Id.* at 43.

However, CBS argued that Silverman's musical infringed upon their post-1948 scripts and the characters contained.<sup>66</sup> The court found that CBS did have valid copyrights in their post-1948 scripts, but because the pre-1948 works were already in the public domain, CBS only had copyright protection for the elements of expression that were unique to the post-1948 derivative works.<sup>67</sup> The court further explained that this element-derivative principal "is fully applicable to works that provide further delineation of characters already sufficiently delineated to warrant copyright protection."<sup>68</sup> Therefore, Silverman could use the characters as they were expressed in the pre-1948 scripts, but he could not use any developments of the character in the post-1948 works that were still under copyright.<sup>69</sup>

There are countless cases and academic research that support the generally accepted character-derivative standard.<sup>70</sup> However, this note argues that the character-derivative standard is popular only because other viable options have not been

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<sup>66</sup> *Id.*

<sup>67</sup> *Id.* at 49-50.

<sup>68</sup> *Id.* at 50.

<sup>69</sup> *Silverman*, 870 F.2d at 50.

<sup>70</sup> See Thomas & Weiss, *supra* note 14, at 12. In addition, the character-derivative standard has been applied to a variety of types of characters and entertainment situations. For example, in *Warner Bros. Entertainment, Inc., v. X One X Productions*, a film memorabilia company licensed merchandise based on images from movie posters, including *The Wizard of Oz*. 644 F.3d 584, 590 (8th Cir. 2011). The movie posters had entered the public domain due to lack of copyright notice, but the films were still protected under copyright. *Id.* at 592-94 (emphasis added). In determining whether the merchandise infringed the copyright of a particular character, the court uniquely applied the character-derivative standard to characters that could have elements present in the posters and/or the film itself. *Id.* at 602. Any merchandise that combined the movie poster images (because the posters were already in the public domain) with other phrases or images of the characters from the films that were not present on the posters was found to be infringing (because the films were still protected by copyright). *Id.* at 602. For example, a t-shirt with an image of Judy Garland (from the movie poster) with the phrase "There's no place like home" (a phrase only in the movie and not on the posters) was found to be infringing. *Id.* at 603.

sufficiently analyzed. Due to the historically short length of copyright terms and the lack of variety of media, it has not been an important issue as to which elements of a character are still protected under copyright. Today, with the mess of copyright term extensions and the renewed interest in well-known characters for a variety of books, movies, and video games, this niche topic in copyright law is ripe for discussion.

## B. POLICY IMPLICATIONS FOR THE CHARACTER-DERIVATIVE STANDARD

There are numerous policy implications for the character-derivative standard that are already obvious to many creators, scholars, and courts, and they will just continue to be a problem if the character-derivative standard is followed. Putting any arguments and analysis as to the copyrightability of characters aside, the obvious problem is: what do you do when a character in a series has some works that start to enter the public domain and some still protected by copyright? If an author wants to use an original character whose first works are now in the public domain, they are free to do so, provided they refrain from using elements of that same character that are present only in the later works still protected. However, how do writers know which parts of a character are distinct enough to warrant copyright protection, which elements are in the public domain, when the works still protected join the public domain, and if they could be subject to litigation?

It gets very complicated to determine exactly which elements of the character were created in the earlier books and which are from the later books.<sup>71</sup> If a creator wants to use a particular character or element from a series, one answer is to read each and every novel or creation that includes that character or

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<sup>71</sup> This issue can get even more complicated when one remembers that not all elements of a character are protectable from copyright. When an author writes a second book with their same distinct character from the first, the new elements of the character must be distinct and unique enough to be classified as a derivative work (of the actual character) to deserve copyright protection. See Nickles, *supra* note 13, at 154 (citing *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 924 F.Supp. 1559, 1565-66 (S.D. Cal. 1996)); see also *Conan Props. v. Mattel, Inc.*, 712 F.Supp. 353, 358-60 (S.D.N.Y. 1989); *Harvey Cartoons v. Columbia Pictures Indus.*, 645 F.Supp. 1564, 1569-71 (S.D.N.Y. 1986).

character element in the series to figure out which characters and elements are free to use in the public domain and which are still part of copyrighted material. In addition, the creator also needs to consider that a particular derivative element of a character might not legally pass the threshold for originality needed to warrant copyrightability. If the element is not copyrightable, then they are free to use it anyway because it does not meet copyrightability requirements. These levels of characters, derivative elements, and copyrightability for the elements are already legally complicated topics that many creators will not understand. However, in addition to the research needed above, the creator also needs to research when the copyrighted elements they wish to use join the public domain to be able to freely use them. As shown in the chart above, it can get extremely complicated.

These levels of research make it very difficult for an author who wishes to use character or character elements in their new work to sufficiently vet the character or elements. Instead, many authors resort to paying the copyright holder a license fee to feel safe from potential litigation, even if they legally might not need to pay a fee because the characters or elements are already in the public domain. In addition, this convoluted copyright research could also easily deter creators from using characters and elements of that character when they are legally in the public domain but hidden under complicated term extensions and unnecessarily high license fees. This deterrence on innovation is the opposite of what the constitutional copyright clause sought to achieve: “[t]o promote the Progress of Science and useful Arts.”<sup>72</sup> Although the character-derivative test has precedent in case law, courts are ignorant in noticing the adverse effect of the judicially created standard on character innovation.

There are a few potential alternatives to solve all of these policy implications and difficulties applying the character-derivative standard to series characters: the Conan Doyle “completedness” standard, the legislative abolishment of copyright protection for characters, and this note’s proposed “first-expression” standard. The former two standards, although not the best solution, are useful for comparison so as

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<sup>72</sup> U.S. CONST. art. I, § 8, cl. 8.

to understand why the proposed first-expression standard is the best and only option for series character copyright terms.

### III. ALTERNATE I: THE CONAN DOYLE “COMPLETEDNESS” STANDARD

The first alternative to the character-derivative standard for series characters is the “completedness” argument, made by the Conan Doyle Estate this past year, in response to an author’s request for declaratory judgment that all elements of the characters used by the author are in the public domain.<sup>73</sup> Although this alternative is scarcely supported, it is an interesting and useful theory to explore.<sup>74</sup>

#### A. THE KLINGER-CONAN DOYLE ESTATE COMPLAINT

Although all of the Sherlock Holmes stories are in the public domain in the United Kingdom, a few still remain under copyright protection in the United States.<sup>75</sup> Lawyer and

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<sup>73</sup> *Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879 (N.D. Ill. 2013).

<sup>74</sup> The *Klinger* lawsuit has been closely followed by copyright professionals and character copyright enthusiasts. See Miri Frankel, *Is Sherlock Free of Copyright in the US? Not Just Yet*, THE IPKAT (Sept. 20, 2013, 10:20 PM), <http://ipkitten.blogspot.com/2013/09/is-sherlock-free-of-copyright-in-us-not.html>, for brief summaries of the original issue; Eleonora Rosati, *A “Sherlockian Civil War” in the US? Klinger v. Conan Doyle Estate*, THE IPKAT (Oct. 2, 2013, 2:19 PM), <http://ipkitten.blogspot.com/2013/10/a-sherlockian-civil-war-in-us-klinger-v.html>; Miri Frankel, *Breaking News: Sherlock is (Partly) Free of Copyright in the US*, THE IPKAT (Dec. 28, 2013, 9:00 AM), <http://ipkitten.blogspot.com/2013/12/breaking-news-sherlock-is-partly-free.html>. In addition, Klinger has started his own website for updates on the lawsuit. FREE SHERLOCK!, <http://free-sherlock.com/> (last visited Feb. 1, 2015).

<sup>75</sup> The only Sherlock Holmes stories that remain under copyright protection in the United States by the Conan Doyle Estate are ten of the stories published in *The Case-Book of Sherlock Holmes*. *Klinger*, 988 F. Supp. 2d at 883. All earlier Sherlock Holmes works besides these ten were published prior to 1923 and so thus have passed into the public domain. *Id.* Although still currently protected by copyright, the last *Case-Book* stories will enter the public domain at various times leading up to 2023. *Sherlockian.Net: Copyright*, SHERLOCKIAN.NET, <http://www.sherlockian.net/acd/copyright.html> (last visited Feb. 1, 2015).



Holmesian scholar Leslie S. Klinger, along with his co-editor Laurie R. King, put together a collection of short stories called *In the Company of Sherlock Holmes*, a sequel to *A Study in Sherlock*, an anthology of new and original short stories by contemporary authors.<sup>76</sup> In collecting the contemporary stories for the sequel, one of the contributing authors informed Klinger of his intention to use a particular character from a story still under copyright protection in the United States.<sup>77</sup> When the contributing author reached out to the Conan Doyle Estate in regard to the still-copyrighted character, the Conan Doyle Estate demanded Klinger license the entire book (instead of just the singular character from the particular story) and threatened to stop major book distributors from selling the book if he did not comply.<sup>78</sup> In response, Klinger took preemptive measures and asked for a declaratory judgment that his list of Sherlock Holmes characters, character traits, and other story elements are in the public domain and are thus free to use in his publication without a licensing fee.<sup>79</sup> Klinger's argument is that all of the Sherlock Holmes character elements at issue, even though they might appear in the ten stories still protected by copyright, *first* appeared in pre-1923 works that are now in the public domain and are therefore free to use without needing to pay for licensing.<sup>80</sup>

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<sup>76</sup> *Klinger*, 988 F. Supp. 2d at 883.

<sup>77</sup> *Id.* at 883-84. The work in question is the 1926 Holmes *Case-Book* story "The Three Gables," and the relevant character is Langdale Pike. *Id.*

<sup>78</sup> Alex Heimbach, *Is Sherlock Holmes in the Public Domain?*, SLATE (Mar. 26, 2013), [http://www.slate.com/blogs/browbeat/2013/03/26/is\\_sherlock\\_holmes\\_in\\_the\\_public\\_domain\\_a\\_new\\_lawsuit\\_will\\_decide.html](http://www.slate.com/blogs/browbeat/2013/03/26/is_sherlock_holmes_in_the_public_domain_a_new_lawsuit_will_decide.html). For their previous book, *A Study in Sherlock*, Klinger and his co-editor, Laurie King, paid the estate a \$5,000 licensing fee. *Id.* Klinger said this time "enough was enough," due to the estate's threats and history of aggressive copyright protection claims. *Id.*

<sup>79</sup> *Id.*

<sup>80</sup> Memorandum of Law in Support of Plaintiff's Motion for Summary Judgment Pursuant to FRCP 56 at 6, *Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879 (N.D. Ill. 2013) (No. 1:13-cv-01226), 2013 WL 3948511. Their motion rightly cited the Nimmer treatise and a variety of cases to support the history of courts using the character-derivative standard and that the public is

The Conan Doyle Estate responded with their own brief and an interesting argument: the Holmes and Watson characters were created *throughout the entire canon* and *only completed* in the final copyrighted story of the series, and thus the copyright protecting the last stories should extend to the Holmes and Watson characters and the story elements pertaining to those characters.<sup>81</sup> It is a very creative argument used to get around the fact that most of the author's works have reached the public domain while a few are still left protected for ten more years. Although the two characters of Sherlock Holmes and his best friend and crime solving sidekick are very well-known, the Conan Doyle Estate makes a valid point: Sir Arthur added distinctive "attributes, dimensions, background, and both positive and negative change in the characters until the last story."<sup>82</sup>

The estate points out two important rationales for why this completedness standard should be accepted and applied to Holmes and others in the canon: first, the characters are so complex that the additions in the later works complete their character development as a whole; and second, the later published works, still protected by copyright, are even more important because the stories in the series were not written or published in a linear way.<sup>83</sup>

In arguing why their characters are so complex and should not be considered complete until the end of the series, the Conan Doyle Estate brings up a character theory followed by various commentators. The theory suggests there are two different types of characters: flat entertainment characters and

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free to use the elements of a character from works that have fallen into the public domain. *Id.* (quoting NIMMER & NIMMBER, *supra* note 10, at §9.11[B][1]).

<sup>81</sup> Conan Doyle's Response in Opposition to Plaintiff's Motion for Summary Judgment Pursuant to FRCP 56 at 4, *Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879 (N.D. Ill. 2013) (No. 1:13-cv-01226), 2013 WL 5538322.

<sup>82</sup> *Id.*

<sup>83</sup> *Id.* at 5-6. In addition, the estate goes on to explain that the last ten copyrighted stories in question are set at various points throughout the two character's lives, some before and some after, revealing aspects of their characters as young men and aiding in the character development. *Id.*

complex literary characters.<sup>84</sup> Their brief argues that the *Silverman* character-derivative holding followed by every circuit in the country<sup>85</sup> is only “factually appropriate for . . . flat entertainment characters created complete in the first few stories featuring them.”<sup>86</sup> The Conan Doyle Estate’s argument is that literary characters continue to develop throughout the canon from their complex backgrounds, maturing emotions, thoughts, relationships, and actions; therefore, the *Silverman* character-derivative standard should not apply to literary characters like Holmes and Watson.<sup>87</sup>

Interestingly, the *Silverman* standard has already been mentioned in a prior Holmesian case. In *Pannonia Farms, Inc. v. USA Cable*, the issue was whether or not the plaintiff in an infringement claim actually owned the Conan Doyle Estate copyrights.<sup>88</sup> The court held that the plaintiff did not own the copyrights and then in dictum stated that the *Silverman* rule applied to Sherlock Holmes.<sup>89</sup> The Conan Doyle Estate argues that this dictum was applied without the benefit of the actual copyright owner’s factual development on the creation of the character or the proper legal issues.<sup>90</sup> Although this is an interesting flat character versus complex character argument, it was not successful for the Conan Doyle Estate. Ultimately, Chief Judge Ruben Castillo, in his December 23, 2013 *Klinger v. Conan Doyle Estate* memorandum opinion and order, found the *Pannonia Farms* ruling persuasive because of its factual

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<sup>84</sup> *Id.* at 8.

<sup>85</sup> See *supra* notes 63-69 for the *Silverman* ruling and explanation.

<sup>86</sup> Conan Doyle’s Response in Opposition to Plaintiff’s Motion for Summary Judgment Pursuant to FRCP 56, *supra* note 81, at 9. “Flat characters do not continue to change in each new story; they merely find themselves in different scenarios bringing about changes in dialogue, not character.” *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> No. 03-7841, 2004 WL 1276842 (S.D.N.Y. June 8, 2004).

<sup>89</sup> *Id.* at \*6, \*9.

<sup>90</sup> Conan Doyle’s Response in Opposition to Plaintiff’s Motion for Summary Judgment Pursuant to FRCP 56, *supra* note 81, at 9.

similarity and cogent analysis of case law; therefore, he applied the *Silverman* character-derivative standard to the literary character of Sherlock Holmes and ruled that all pre-1923 story elements are in the public domain and free for public use.<sup>91</sup> He also emphasized that “courts do not distinguish between elements that ‘complete’ a character and elements that do not; instead, the case law instructs that the ‘increments of expression’ contained in copyrighted works warrant copyright protection.”<sup>92</sup>

## B. POLICY IMPLICATIONS FOR THE COMPLETEDNESS STANDARD

There are two important policy problems with the Conan Doyle Estate’s completedness argument. Chief Judge Castillo pointed out the first problem in his Memorandum Order: although the Conan Doyle Estate argues that the *Silverman* standard should only be applied to flat characters, the estate does not offer a bright-line rule, a workable legal standard to determine when characters are flat or complex, and fails to provide any case law to support its argument.<sup>93</sup> Even if a court adopted the completedness standard, how would we determine which characters are flat and should be considered complete in the first work of the series compared to the complex characters who develop over time? It is impossible to create a bright-line

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<sup>91</sup> *Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879, 890 (N.D. Ill. 2013).

<sup>92</sup> *Id.* at 891 (citing *Silverman*, 870 F.2d 40, 50 (2d Cir. 1989)). Ultimately Chief Judge Castillo ruled that the story elements in the post-1923 works still under copyright constituted enough “original expression” to meet the low threshold of originality required; thus, the post-1923 story elements in question are still protected by copyright. *Id.* On June 16, 2014, Judge Posner, writing for the United States Court of Appeals for the Seventh Circuit, upheld and affirmed the lower court’s decision when the Conan Doyle Estate appealed. *Klinger v. Conan Doyle Estate, Ltd.*, 755 F.3d 496 (7th Cir. 2014). The Conan Doyle Estate then filed a petition for writ of certiorari, which was denied by the Supreme Court on November 3, 2014. *Conan Doyle Estate, Ltd. v. Klinger*, 135 S.Ct. 458 (2014).

<sup>93</sup> *Klinger*, 988 F. Supp. 2d at 890. The estate’s proposed *Silverman* distinction for flat/complex characters actually runs counter to prevailing case law. *Id.*

rule on figuring out which characters are which. The only rule the Conan Doyle Estate seems to suggest is that flat entertainment characters do not change in each new story and complex literary characters do. What about a three-hour play or musical in which we follow a main character throughout a variety of plot twists and character development? Is that not considered complex enough for the completedness standard? This would be yet another complicated case-by-case decision for a judge, meaning still more litigation on character copyright. Following the Conan Doyle Estate's argument for a completedness standard does nothing to simplify or ease the policy of applying copyright law to characters, whether they be simplistic or complex.

The second obvious policy question about the Conan Doyle Estate's proposed completedness standard is, realistically and logistically, how do we know when the character's development finished, and thus the character's copyright term is allowed to begin for the sake of future artists wanting to use the character?<sup>94</sup> If we were to believe the argument that the Holmes character was not developmentally complete until the end of the series, is the general rule then that every complex literary character is not complete until the very end of the series? It would seem very possible that there would be characters that do not show up in the last works of a series and therefore their characters would be developmentally complete in the last works in which they appear. If a creator wanted to use a character in that series, they would need to thoroughly research the series to figure out which works the characters appeared in, when they stopped appearing in the series, whether all of the appearances added to the development of the character, and keep track of all of the dates of those relevant works for use when finally in the public domain. This shows again that the completedness standard makes copyright protection for a series character much more complex than it needs to be. Because of the lack of case law supporting the completedness argument and the major policy implications in applying the alternate standard, it ultimately is nowhere near the perfect solution to the series character copyright problem.

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<sup>94</sup> Chief Judge Castillo did not mention this issue in his memorandum since he found for the character-derivative standard instead of for the completedness argument. *See generally Klinger*, 988 F. Supp. 2d 879.

#### IV. ALTERNATE II: LEGISLATIVE ABOLISHMENT OF COPYRIGHT PROTECTION FOR CHARACTERS

One possible, and sufficiently plausible, solution for this “series character conundrum” is to refrain from giving characters copyright protection at all. Although this argument has little discussion in the copyright community, this argument would make for an efficient solution to the issue of character copyrightability and character infringement. The basics of this alternative standard are simple to explain: just as Congress has extended and amended the copyright statute many times in the past century, Congress could pass an amendment to the copyright statute clarifying that characters, in any form, are not protectable by copyright. Nevins points out how simple and quick it would be for the legislature to make this change in copyright law: all Congress would need to do would be to add “the characterization of a fictitious character” to the list of elements in 17 U.S.C. § 102(b) that are not protected by copyright.<sup>95</sup>

##### A. RATIONALE FOR ABOLISHMENT

An abolishment of judicial protection of character copyrightability would not mean the abolishment for the protection of the work in which the character is embodied. The novel would still be protected under copyright, and the character, as part of the novel, would still be relatively protected within the novel from infringement. The courts already have their own sufficient and successful copyright infringement tests in place, differing among the circuit courts. When faced with an infringement case in which a character is involved, the courts can simply include the character within their comparison analysis of the entire work. This statutory abolishment would give a bright-line rule for all circuits to follow, preventing future litigation and expediting any lawsuits that still occur. In

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<sup>95</sup> Nevins, *supra* note 40, at 343-44. Currently 17 U.S.C. § 102(b) states: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such a work.” 17 U.S.C. § 102(b).

addition, it would make for a clear copyright term expiration for creators and copyright holders to follow. Interestingly, this would still leave intact the idea of character-derivativeness: the elements of a character would be protected in the later copyrighted works if the works in a series have varying copyright dates. However, since the legal principal of character copyrightability would be abolished, this element-protection would just coincidentally have the same effect as the character-derivative rule. Characters themselves would not have distinct copyright protection so courts would not have to undergo a complete character copyrightability analysis.

## B. DIFFICULTIES IN IMPLEMENTATION

Unfortunately, this abolishment alternative has little support as well. As commentator Mark Bartholomew points out, even though 17 U.S.C. § 102 does not explicitly list characters in its list of copyrightable categories, the eight categories listed are meant to be “illustrative and not limitative.”<sup>96</sup> In addition, Bartholomew emphasizes a 1965 report in which the Register of Copyrights recognized that “some characters are developed in

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<sup>96</sup> Mark Bartholomew, *Protecting the Performers: Setting a New Standard for Character Copyrightability*, 41 SANTA CLARA L. REV. 341, 361 (2001) (quoting H.R. Report No. 94-1476, at 53-57); see 17 U.S.C. § 102 (2010):

(a) Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . .  
Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.



enough detail to be copyrightable in themselves.”<sup>97</sup> Bartholomew’s statutory analysis points out that due to the illustrative list in section 102 and the 1965 report, the lack of an explicit mention of characters in the copyright statute should not be read as congressional intent to preclude characters from protection.<sup>98</sup>

One can argue that congressional intent of the original statute does not matter if Congress decides to update copyright law to exclude characters from copyright protection. However, there is simply too much support for character copyright protection from creators, entertainment companies, and estates of famous authors to allow a congressional abolishment of character copyright law.

## V. ALTERNATE III: THE PROPOSED “FIRST-EXPRESSION” STANDARD

The character-derivative standard creates complications with series characters and numerous opportunities for litigation to determine: (1) whether a character is copyrightable; (2) whether the later elements of the character were distinct enough for copyright protection; and (3) whether another work has infringed on that character and/or those particular elements. It also has an obvious policy problem of implementation: without a definitive decision from court, it makes it difficult for authors and creators to know which elements of a character are in the public domain and free to use and which are not, whether they need to pay for a license, and if they can afford the license they might need. For many creators, this apprehension can and does lead to lack of use and ultimately the stifling of creativity: the opposite of the goal of copyright law. The Conan Doyle completedness standard has its own complications in applying to works in a series if the author is still alive, and the abolishment alternative is too controversial with lack of support to use as a realistic alternative. Therefore, this note proposes a

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<sup>97</sup> Bartholomew, *supra* note 96, at 361 (quoting Supp. Rep. of the Register of Copyright on the General Revision of U.S. Copyright Law: 1965 Revision Bill, 89th Cong., 1st Sess. 6 (1965)).

<sup>98</sup> *Id.* at 362.

solution more efficient and more appeasable than any of these three options: a “first-expression standard.”

### A. THE BASICS OF THE STANDARD

The first-expression standard would work relatively simply: the copyright term for a character begins at the same time as the work in which the character is first expressed, and any subsequent works with the same character and new elements are irrelevant to the copyright term of the character. For example, the Sherlock Holmes character would be copyrighted in the work of first-expression, or the first book in the series.<sup>99</sup>

The most efficient means of implementation is a congressional amendment to the current copyright statute, as opposed to another judicial ruling. Congress can simply include a section within the statute regarding the copyright of characters, explicitly stating that the copyright for a character in a work has the same starting copyright term as the work in which it is found, and there is not further copyright protection for additional elements of the same character.<sup>100</sup>

### B. RATIONALE FOR FIRST-EXPRESSION STANDARD

The first-expression standard is unquestionably easier to apply and follow than the character-derivative test, both by the courts in any character copyright litigation and by future

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<sup>99</sup> The first work in which Sherlock Holmes was introduced was Conan Doyle’s *A Study in Scarlet* in 1887. Memorandum of Law in Support of Plaintiff’s Motion for Summary Judgment Pursuant to FRCP 56, *supra* note 80, at 1.

<sup>100</sup> Although this distinction is not necessary for works created by individuals after 1978 (since all works in a series created after 1978 have the same copyright expiration term: life of the author plus now seventy years), the amendment will be immensely helpful for clarification of works over split terms like the Holmes situation, for works made for hire and other works that might have differing copyright dates for the works in the entire series. Although this would be, in a sense, a retroactive change to the copyright protection of prior works, Congress has previously done so with changes to copyright law, so this first-expression amendment would just be following precedent of retroactivity. See *supra* Part I.E.1 (detailing Congress’s twentieth century amendments to the Copyright Statute that retroactively extended copyright terms for works already created).

authors and creators when determining if a character or character element is available for use. For series that are stuck in the magic years where some works are in the public domain and some are still protected by copyright, this would conclusively give courts a starting date to follow in the infringement cases and authors a clear answer as to which characters they are able to use without needing a license or having to worry about litigation.

Applied to the Holmes situation, Sherlock Holmes, his partner Watson, and many other characters in the series would be considered in the public domain, as they already are. However, with this standard, there would not be any unnecessary litigation over whether authors are using the correct elements of the characters in the series. Therefore, the first-expression standard would greatly lower potential litigation and judicial resources. In addition, using this standard would support the original constitutional intellectual property clause: it would still give creators of characters a limited, though significant, time of copyright and then a clear date as to when other authors are allowed to use the characters for further creativity to enrich the public domain.<sup>101</sup> To allow for elements of a character to have continued protection even after the original character is in the public domain would go against the original meaning of the IP clause. In addition, it would give vastly long protections to individual characters for no necessary reason except for more opportunity to license and litigate.<sup>102</sup>

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<sup>101</sup> Richter points out that the CTEA “denie[d] access to creative works for a longer period of time, [while] copyright owners endure no additional obligations; as such, it provides unnecessary windfall to greedy copyright owners, resulting in harm to the general public because we are stripped of creative artistic ideas.” Richter, *supra* note 4, at 460. The first-expression standard, in an amendment to the copyright statute, would mitigate part of this public creative loss by clarifying a complicated problem in character copyright law and thus stimulating creativity for the public domain. See also John Mace, *Sherlock Holmes and Copyright Law: Elementary, My Dear Watson*, CAMPBELL L. OBSERVER (Feb. 3, 2014), <http://campbelllawobserver.com/2014/02/sherlock-holmes-and-copyright-law-elementary-my-dear-watson/>, for a brief discussion on applying the property theory the Tragedy of the Commons to the current copyright regime, emphasizing how “society would greatly benefit from an expansion of the public domain’s contents.”

<sup>102</sup> See Memorandum of Law in Support of Plaintiff’s Motion for Summary Judgment Pursuant to FRCP 56, *supra* note 80, at 11 (alleging that the Conan

The first-expression standard is also consistent with this past century's precedent of judicially created copyright protection for characters. An amendment distinguishing the copyright term beginning for series characters does not have to be the end of the judicial tests of basic character copyrightability: the sufficient development standard and the story being told test would still exist and remain important when analyzing the copyrightability of a character overall. If an amendment was added with the first-expression standard, there would still be an opportunity for judicial analysis on whether the character in question merited copyright protection; then, after it was found to be protectable, the courts can simply turn to the first-expression standard to eliminate further complication and litigation on the elements of the character in question.

Supporters of a more complicated copyright protection for series characters, and thus opponents of a first-expression standard, argue that stronger protection is needed because having parts of their character in the public domain and parts still protected creates the possibility for an endless amount of different personalities of the first original character.<sup>103</sup> This might seem like a policy problem until one considers the constitutional purpose of copyright law: "to *promote the progress* of Science and the useful Arts, by securing *for limited times* to Authors . . . ."<sup>104</sup> Copyright law is not meant to give indefinite protection to creative works.<sup>105</sup> Instead, it works in a

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Doyle Estate continued to assert its copyrights and extract license fees for the use of the characters from other creators during this litigation).

<sup>103</sup> This was one of the arguments of the Conan Doyle Estate in their brief: "Plaintiff's position would create multiple personalities out of Sherlock Holmes: a 'public domain' version of his character attempting to only use public domain traits, next to the true character Sir Arthur used." Conan Doyle's Response in Opposition to Plaintiff's Motion for Summary Judgment Pursuant to FRCP 56, *supra* note 81, at 7.

<sup>104</sup> U.S. CONST. art. I, § 8, cl. 8 (emphasis added).

<sup>105</sup> Chief Judge Castillo agreed, in response to the Conan Doyle Estate's "multiple personality" argument. Not only does it follow case law to allow for split personality, but also: "[t]he effect of adopting Conan Doyle's position would be to extend impermissibly the copyright of certain character elements of Holmes and Watson beyond their statutory period, contrary to the goals of the Copyright Act." *Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879, 890 (N.D. Ill. 2013).

successful duality: authors get exclusive rights for limited times to reap the benefits of their hard creative work, and in return, society gets the freedom to use their work however it deems fit after the exclusive right term is up. The first-expression standard would actually serve to clarify the “split personality” problem of characters: instead of having a complicated timeline of some elements of the character being in the public domain and some not, *all elements of the character* would enter the public domain once the term of the first-expression work had matured. Instead of retaining some elements of the character under copyright protection and complicating the creation process for future authors, the owners of the original character would not have to worry about tracking their character elements. Every part of it would be in the public domain and available for use by others. There are countless stories, movies, songs, and other works of art that would not be possible without having a rich and constantly growing public domain. The small risk of having “multiple personalities” of one original character, decades and decades after the original character was created, is a small price to pay for the unknowing potential of what a new author or artist can create with it.<sup>106</sup>

### C. WHY STATUTORY GUIDANCE IS NEEDED

If the first-expression standard is implemented, it would make much more sense to do so by legislative action, not by judicial adoption. An amendment to the copyright statute would be an automatic change for works throughout the entire country, without worrying about inconsistent standards between the various circuits. Although the legislative abolition of character protection would not be a popular solution, it is efficient and simple to put into effect. Similarly, an amendment putting the first-expression standard into effect is just as easy. If Congress wanted to follow case law precedent and leave the analysis up to the courts as mentioned above, all that would be needed is a section granting copyright protection to characters and explicitly stating the rule for characters in a series. Doing so would keep

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<sup>106</sup> Nickles, *supra* note 13, at 152. “[T]he more characters that are available, the larger the storehouse of knowledge from which an author can draw in creating his own story.” *Id.*

the responsibility of the sufficient development standard test in the hands of the judges.

A number of scholars and judicial opinions have suggested the addition of a specific section in the copyright statute explicitly giving copyright protection to characters.<sup>107</sup> Adding a section to the statute giving clear protection to characters, while also clarifying the first-expression rule for all characters in a series, would solve many of the inconsistencies with the current judicially created character copyright law, eliminate unnecessary litigation, and ensure a richer public domain for creators.

Characters are one of, if not the only, areas of creative works not explicitly discussed in the entire lengthy and complicated copyright statute.<sup>108</sup> So much creative power, money, and litigation is involved in major characters, yet we leave these case-by-case decisions of whether a character in question is copyrightable and if another character has infringed up to the judiciary with no statutory guidance.<sup>109</sup> Courts grant copyright protection to characters but are unable to explain consistently how the decision was reached.<sup>110</sup> An amendment that grants basic copyright protection to sufficiently developed characters and gives instruction to apply the first-expression standard to

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<sup>107</sup> Feldman, *supra* note 22, at 711-12. “In light of the increasing judicial acceptance of independent character copyrightability, the proven economic value of a successful character in various media, and the technological explosion that can create unique visual characters, explicit statutory protection for fictional characters is now necessary to assure consistency in adjudicating authorship and ownership rights.” *Id.*

<sup>108</sup> The most current complete PDF of copyright law from the U.S. Copyright Office is 366 pages and a 2 megabyte file. THE COPYRIGHT OFFICE, CIRCULAR 92, COPYRIGHT LAW OF THE UNITED STATES AND RELATED LAWS CONTAINED IN TITLE 17 OF THE UNITED STATES CODE (Dec. 2011), *available at* <http://www.copyright.gov/title17/circ92.pdf>.

<sup>109</sup> Gregory Schienke rightly equates this case-by-case lack-of-guidance determination to Justice Stewart’s “I know it when I see it” test to decide if something is pornographic or not: “I shall not today attempt further to define the kinds of material I understand to be embraced within that shorthand description [“obscene”]; and perhaps I could never succeed in intelligibly doing so. But I know it when I see it . . . .” Schienke, *supra* note 14, at 80 n.114 (quoting *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart, J., concurring)).

<sup>110</sup> Schienke, *supra* note 14, at 80-81.

series characters with split copyright terms would help clarify or eliminate steps for the judiciary. Gregory Schienke worries that without a statutory definition for the “threshold of delineation” needed for character copyrightability, there would be situations of artists asserting assumed rights in stock characters.<sup>111</sup> However, this worry is easily mitigated by including specific and clear wording within the amendment.

## CONCLUSION

Copyright law has evolved into a detailed and complicated statute, yet nowhere in the statutory language is a section on character copyright. Cases have cumulated throughout the twentieth century and given us a judicially created standard for both the copyrightability of a character and the standard for elements of a character in a series. However, as the end of the public domain freeze draws near and famous character elements are becoming desired by new creators, the judicial standards are neither the most efficient nor the most constitutional solutions to the series character copyright term problem. The *Klinger v. Conan Doyle Estate* lawsuit highlights this predicament and has brought the series character problem to light.

This note’s proposed first-expression standard is the clearest legislative resolution to both the issues of character copyrightability and the series character term expirations. When considering which of the possibilities is best between the current standards and possible alternatives, it’s elementary: the first-expression standard is similar conceptually to the way series characters are treated with the current Copyright Statute of 1976; would follow the original constitutional goals of intellectual property law; and would be more efficient for authors, corporations, and the public.

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<sup>111</sup> Schienke, *supra* note 14, at 83.