

Sherlock Holmes and Newt Scamander: Incorporating Protected Nonlinear Character Delineation into Derivative Works

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INTRODUCTION

Author J.K. Rowling published a book in 2001 under the pseudonym Newt Scamander with an “About the Author” section that provided a brief outline of the fictional author.¹ Prior to this brief biographical section, fans of the Harry Potter universe had only been introduced to the character of Scamander in passing as the author of a required textbook that the main characters purchased.² Rowling subsequently announced that she would pen the screenplays for a trilogy of films featuring this very minor character as the lead.³ Although Rowling is (ostensibly) the sole author of the Harry Potter books and the companion book, *Fantastic Beasts and Where to Find Them*, she will likely be considered a joint owner of the copyright in the film she is writing.⁴ It is foreseeable, therefore, that the copyright in the books and the films might expire at different times, if one of the joint creators of the film dies after Rowling.⁵ This, then, would result in the question of when the character of Newt Scamander enters the public domain. If Scamander was a copyrightable character when introduced in the Harry Potter series and companion book, can a portion of his character enter the public domain when those books expire, while the rest of his character remains protected until the expiration of the film’s copyright? This is further complicated by the fact that this development is nonlinear, meaning that the films will focus on Scamander’s youth and young adulthood, while the books only refer to the character after he has already died.

This Note focuses on copyright protection of literary characters featured in multiple works, some of which are in the public domain but others of which remain

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1. See *Newton Scamander*, HARRY POTTER WIKI, <http://perma.cc/N59F-NVBU> (last visited Mar. 31, 2015) (providing general background information about the character).

2. *Id.*

3. Nick Clark, *JK Rowling to Write New Harry Potter-Inspired Film Series Based on Fantastic Beasts and Where to Find Them*, INDEPENDENT (Sept. 12, 2013), <http://perma.cc/9TSQ-GUYD>.

4. See 1 MELVILLE & DAVID NIMMER, NIMMER ON COPYRIGHT § 6.05 (rev. ed. 1978–date) [hereinafter NIMMER ON COPYRIGHT] (“A motion picture is a joint work consisting of a number of contributions by different ‘authors,’ including the writer of the screenplay, the director, the photographer, the actors, and, arguably, other contributors such as the set and costume designers, etc.”).

5. See 17 U.S.C. § 302(b) (2012).

protected. In multiple work circumstances, new character elements are often revealed in these still-copyrighted later works that fundamentally change the way we think of and write about the earlier version of the character. This Note proposes a test for how derivative works featuring such characters should be analyzed for infringement. There are two instances this Note will focus on: first, where the character is not copyrightable in the initial instance in which the character appears in a work, and second, where the character develops over time in a way that changes the reader's perception of the character in a fundamental way.

Generally, once a work enters the public domain, all of the characters appearing in that work also enter the public domain, while plot points written about in subsequent works remain protected if still subject to copyright.⁶ However, it is common for writers to reveal "prequel" details in later works, which can make it difficult for creators of derivative works to know what they may include, where their characters that have only partially entered the public domain.⁷ As one party argued in *Klinger v. Doyle*—a case that focuses on this issue and that will be a focus of this Note—characters can become as dynamic as human beings; one cannot simply forget knowledge of traits about them or important experiences they have had when writing a new work.⁸ In *Klinger*, the court ruled in favor of a Sherlock Holmes aficionado who claimed that the characters of Holmes and Dr. Watson should be in the public domain, despite the fact that later stories revealing new information about earlier versions of those characters remain subject to copyright protection.⁹

With that background in mind, this Note will focus on the breadth and boundaries of character copyright protection in connection with characters featured in a series of works, only some of which are in the public domain. Particular attention will be paid to instances where the protected works are prequel in nature. Specifically, this Note addresses the amount of protection to which a character should be entitled once the initial work in which that character appears enters the public domain, and argues that limited copyright protection should be available to creators of certain types of dynamic recurring characters beyond the copyright expiration of the first work in which the character appears, even when the

6. See, e.g., *Silverman v. CBS Inc.*, 870 F.2d 40, 49 (2d Cir. 1989) (holding that the titular characters in *Amos 'n' Andy* were sufficiently delineated to deserve copyright protection, but that the characters entered the public domain upon expiration of the copyright of the first work in which they appeared and only any "incremental expressions" added to their characters later in the series remained protected).

7. "Prequel" details means facts that are revealed later in the series that occurred earlier in the fictional timeline of the series than when they appear.

8. Defendant's Response in Opposition to Plaintiff's Motion for Summary Judgment Pursuant to FRCP 56 at 2, *Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879 (N.D. Ill. 2013) (No. 13 Civ. 01226), 2013 WL 5538334, at *2 [hereinafter *Doyle's Response to Klinger's Motion for Summary Judgment*] ("Plaintiff suggests that Holmes and Watson can be dismantled into partial versions of themselves. But a complex literary personality can no more be unraveled without disintegration than a human personality.").

9. *Klinger v. Conan Doyle Estate, Ltd.*, 755 F.3d 496, 503 (7th Cir. 2014), cert. denied, 135 S. Ct. 458 (2014); see, e.g., Dennis S. Karjala, *Harry Potter, Tanya Grotter, and the Copyright Derivative Work*, 38 ARIZ. ST. L.J. 17, 34 (2006).

derivatives created do not explicitly refer to plot disclosed in the still-copyrighted works featuring the character.

Part I of this Note will provide an overview of copyright in fictional characters more generally, including a summary of the two tests that are primarily used today to establish character copyright. Part II of this Note will briefly review the legal regime surrounding the creation and protection of derivative works, namely works in a series and sequels, including a review of case law concerning the protection of fictional characters in a series. Specific attention will be given to the recent case *Klinger v. Doyle*, which focuses on the protection of fictional characters written about in a nonlinear fashion, where the earlier works debuting the characters have entered the public domain, but later works that remain protected reveal important character details. Finally, the Note will offer a suggested framework for approaching characters developed over the course of a series in a nonlinear fashion and will argue that this framework would be effective given specific goals of the Copyright Act.

I. BACKGROUND ON CHARACTER COPYRIGHT

A. CHARACTER COPYRIGHT GENERALLY

Characters are not copyrightable per se, even in cases where the plot of the story in which the characters appear is protected by copyright.¹⁰ Rather, fictional characters are only guaranteed copyright protection apart from the work in which they appear if they are sufficiently delineated; the more detailed the character, the more copyright protection it will be accorded.¹¹ To be clear, the actions the character undertakes will still comprise a copyrightable plot, so long as the plot fulfills the low threshold requisite for originality, though the character as distinct from the plot might not. So, the character's voice, likeness, traits, emotions and habits might not be independently copyrightable from the situations in which the character appears in the works. The majority of courts favor the following two-part test for determining whether character copyright has been infringed:¹² first, the plaintiff's character must be sufficiently delineated to be subject to copyright protection, and second, the defendant must have copied such delineation.¹³

There is no bright line rule to determine whether or not a character is sufficiently delineated to command protection in accordance with the first prong of the majority test. However, case law has revealed some guiding principles to consider. As a

10. 1 NIMMER ON COPYRIGHT, *supra* note 4, § 2.12.

11. See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931) ("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."). However, note that the Copyright Office will not register copyright in characters per se, despite the case law. U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 313.4(H) (3d ed. 2014), available at <https://perma.cc/B4E9-4HLG?type=pdf>.

12. 1 NIMMER ON COPYRIGHT, *supra* note 4, § 2.12.

13. See, e.g., *Warner Bros. Inc. v. Am. Broad. Cos.*, 530 F. Supp. 1187 (S.D.N.Y. 1982), *aff'd*, 720 F.2d 231 (2d Cir. 1983).

preliminary matter, as in other areas of copyright law, the character must be sufficiently original to command protection in the first place. This is in line with the principle that “scenes à faire,” or stock scenes that are common in many works, are not subject to copyright protection because they are insufficiently distinct.¹⁴ In the same vein, “hackneyed character types,” or stock characters that commonly appear in many works, such as a bartender who is a good listener or a bumbling police officer, are likewise not protectable.¹⁵ When an author copies an outline of a character or uses a well-known character type rather than creating a more idiosyncratic, dynamic character, it is more analogous to copying ideas—which are not subject to copyright protection—than it is to creating expression of those ideas—which do qualify for such protection.¹⁶ Thus, the more detailed authors make their plots and the more idiosyncratic they make their characters, the more likely they will cross the threshold from idea into expression, and therefore the more likely their works will earn higher levels of copyright protection.¹⁷ Second, cartoons and graphic representations of characters, in contrast with “word portraits” of characters, are more likely to command higher copyright protection because courts have stated that readers are more likely to have more varied interpretations of characters when reading descriptions of characters than when viewing visual representations of characters.¹⁸

14. See, e.g., *Alexander v. Haley*, 460 F. Supp. 40, 45 (S.D.N.Y. 1978) (describing scenes à faire as “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic. . . . This is not, and could not be, an offense to any author. Nobody writes books of purely original content.”); see also *Blakeman v. Walt Disney Co.*, 613 F. Supp. 2d 288, 314 (E.D.N.Y. 2009) (holding that “a modern, tightly-contested presidential race between an incumbent Republican and a Democratic challenger, campaign staffers and candidates pandering to voters, speeches, and a debate” were not protectable under the scenes à faire doctrine); Leslie A. Kurtz, *Copyright: The Scenes A Faire Doctrine*, 41 FLA. L. REV. 79, 99 (1989) (“As the abstraction of an old and hackneyed scene is unlikely to be original, and the value to be derived from protecting it is, in any event, low, it may be preferable to conclude that such a scene is not protectable.”).

15. See, e.g., *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1266 (11th Cir. 2001) (stating that characters that “naturally flow from a common theme” are more akin to ideas than to expressions, and since ideas are not copyrightable such characters are therefore not subject to copyright protection); *Benjamin v. Walt Disney Co.*, No. Civ. 05-2280(GPS), 2007 WL 1655783, at *7–8 (C.D. Cal. June 5, 2007) (holding that “30-year-old females that have escaped their humble past to pursue their dreams of working and living in the big city,” and that “estranged husbands” and “dream fiancés” were all noncopyrightable stock characters).

16. *SunTrust*, 268 F.3d at 1266; see also 1 MICHAEL D. SCOTT, *SCOTT ON MULTIMEDIA LAW* § 6.04 (rev. ed. 2014) [hereinafter *SCOTT ON MULTIMEDIA LAW*]; see, e.g., *Mazer v. Stein*, 347 U.S. 201, 214 (1954) (holding that while ideas are not copyrightable, the expression of those ideas “whether meticulously delineating the model or mental image or conveying the meaning by modernistic form or color, is copyrightable.”).

17. *SunTrust*, 268 F.3d at 1266 (“[A]s plots become more intricately detailed and characters become more idiosyncratic, they at some point cross the line into ‘expression’ and are protected by copyright.”).

18. See *Gaiman v. McFarlane*, 360 F.3d 644, 660 (7th Cir. 2004) (“A reader of unillustrated fiction completes the work in his mind; the reader of a comic book or the viewer of a movie is passive. That is why kids lose a lot when they don’t read fiction, even when the movies and television that they watch are aesthetically superior.”); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 754 (9th Cir. 1978), cert. denied, 439 U.S. 1132 (1979) (holding that Mickey Mouse and other Disney characters were protectable apart from the stories in which they appeared).

This test has been criticized as a vague standard that puts judges in the role of literary critics. Critics argue that this means the test is often applied incorrectly, such that while some characters are overprotected, other characters deserving protection do not obtain it.¹⁹ Moreover, while the test states that the more developed a character is, the more copyright protection that character deserves, courts do not provide much guidance for what exactly makes a character so developed.²⁰ As one law review article commented, “What makes a fictional character worthy of protection seems to require Justice Stewart’s ‘I know it when I see it’ test.”²¹

Standing in contrast to the other circuits which use the majority test described above, the Ninth Circuit narrowed the protection available to literary characters in *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*, in which it argued in favor of the so-called “story being told” test.²² When applying this test, a character does not earn copyright protection unless the character is more than a “chess man in the game of telling the story.”²³ This is a very high standard, which “lends some support to the position that characters ordinarily are not copyrightable.”²⁴ However, other courts and Professor Nimmer reject this test as unworkable and regard it as dictum because the *Warner Bros.* case could have been decided on alternative contractual grounds considered earlier in the opinion.²⁵ Moreover, while this standard technically remains good law in the Ninth Circuit, *Walt Disney Productions v. Air Pirates* limited the test, holding that it does not apply to graphic representations.²⁶ In fact, *Air Pirates* states, “[W]hile many

19. See Jasmina Zecevic, *Distinctly Delineated Fictional Characters that Constitute the Story Being Told: Who Are They and Do They Deserve Independent Copyright Protection?*, 8 VAND. J. ENT. & TECH. L. 365, 373 (2006) (criticizing the “distinctly delineated” standard).

20. *Id.*

21. 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, 80 (2005) (referring to *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart, J., concurring) (with regard to determining a standard for what qualifies as “obscene,” stating, “I shall not today attempt to further define the kinds of material I understand to be embraced within that shorthand description; and perhaps I could never succeed in intelligibly doing so. But I know it when I see it.”)).

22. Professor Nimmer argues that with the “story being told” test the Ninth Circuit created a rule that is not only irreconcilable with the test that Judge Hand created, but one that if implemented would also annihilate copyright protection of characters generally. 1 NIMMER ON COPYRIGHT, *supra* note 4, §2.12 (“There may be rare examples of such works, but for most practical purposes, such a rule if followed would effectively exclude characters from the orbit of copyright protection.”).

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

24. *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 755 (9th Cir. 1978), (“[I]t is difficult to delineate distinctively a literary character. . . . When the author can add a visual image, however, the difficulty is reduced.” (internal citations omitted)).

25. See, e.g., *Goodis v. United Artists Television, Inc.*, 425 F.2d 397, 406 (2d Cir. 1970) (observing that the test “would be clearly untenable from the standpoint of public policy, for it would effectively permit the unrestrained pilfering of characters”); *Columbia Broad. Sys., Inc. v. DeCosta*, 377 F.2d 315, 320 (1st Cir. 1967) (stating that the holding of *Warner Bros.* did not hold that characters are “inherently uncopyrightable”); 1 NIMMER ON COPYRIGHT, *supra* note 4, § 2.12; see also 1 SCOTT ON MULTIMEDIA LAW, *supra* note 16, § 6.04 (“The ‘story being told’ inquiry has been criticized as being too difficult to achieve, and the sufficient delineation test has been criticized as being too unclear.”).

26. *Air Pirates*, 581 F.2d at 751.

literary characters may embody little more than an unprotected idea, a comic book character, which has physical as well as conceptual qualities, is more likely to contain some unique elements of expression.”²⁷ This suggests that the *Air Pirates* court is interpreting the “story being told” test as more similar to the delineated characters test than the *Warner Bros.* opinion initially suggests, because any character that “embod[ies] . . . more than an unprotected idea” and “contain[s] some unique elements of expression” could be copyrightable.²⁸ However, the *Air Pirates* court did not explicitly overrule *Warner Bros.*, so the relationship between the two seemingly irreconcilable standards remains unresolved.

B. INFRINGEMENT OF COPYRIGHTED CHARACTERS

As in other areas of copyright law, the test for determining whether or not copyright in a protected character has been infringed is substantial similarity.²⁹ In making a determination of substantial similarity, courts consider the visual similarities between the characters, as well as similarities of nonphysical traits and attributes.³⁰ However, the mere fact that a character reminds the reader or viewer of a different character is not equivalent to substantial similarity.³¹ Courts have considered several factors in determining whether or not to find copyright infringement of characters, including: (1) how central to the story the character is,³² (2) how character-driven the story is, compared with plot-driven,³³ and (3) how significant and recognizable the character’s traits are to an audience.³⁴ These

27. *Id.*

28. See 1 NIMMER ON COPYRIGHT, *supra* note 4, § 2.12 (“From this it would seem to follow that a literary character may achieve separate copyrightability even if it does not meet ‘the story being told standard’ provided the character is sufficiently developed and finely drawn so as to cross the line from ‘idea’ to ‘expression.’”).

29. See, e.g., *Hogan v. DC Comics*, 48 F. Supp. 2d 298, 310 (S.D.N.Y. 1999) (“Substantial similarity is generally a question of fact for a jury. Summary judgment is appropriate on this issue, however, where ‘the similarity concerns only noncopyrightable elements of plaintiff [sic] work or no reasonable trier of fact could find the works substantially similar.’” (internal citations omitted)).

30. *Warner Bros., Inc. v. Am. Broad. Cos.*, 720 F.2d 231, 241 (2d Cir. 1983) (holding that the cartoon character of Superman was protectable).

31. *Id.*

32. See, e.g., *Universal City Studios, Inc. v. Kamar Indus., Inc.*, No. H-82-2377, 1982 WL 1278, at *4 (S.D. Tex. Sept. 20, 1982).

33. See, e.g., *Anderson v. Stallone*, No. 87-0592(WDKGX), 1989 WL 206431, at *6 (C.D. Cal. Apr. 25, 1989).

34. *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1296 (C.D. Cal. 1995) (holding that James Bond is a protectable character because he “is a unique character whose specific qualities remain constant despite the change in actors” and because audiences watch Bond, Tarzan, Superman and Sherlock Holmes not for the story “but to see their heroes at work”); see also *Stallone*, 1989 WL 206431, at *7 (holding that Rocky and the other characters in the films were copyrightable because the “physical and emotional characteristics of Rocky Balboa and the other characters were set forth in tremendous detail in three Rocky movies” and because Rocky is associated with “specific character traits ranging from his speaking mannerisms to his physical characteristics”); *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1267 (11th Cir. 2001) (holding that the copyrighted characters in *Gone With the Wind* were copied in the parody *The Wind Done Gone*, even though in the derivative work the characters were “vested with a new significance” and inverted, with

factors are likewise useful in determining whether and how much copyright protection characters should get in the first instances. Moreover, although the character's original name being used in the defendant's work is not decisive in determining whether or not there was infringement, it is a factor courts consider.³⁵

The Second Circuit has instructed the following when determining whether or not character copyright has been infringed:

What the character thinks, feels, says and does and the descriptions conveyed by the author through the comments of other characters in the work episodically fill out a viewer's understanding of the character. At the same time, the visual perception of the character tends to create a dominant impression against which the similarity of a defendant's character may be readily compared, and significant differences readily noted.

Ultimately, care must be taken to draw the elusive distinction between a substantially similar character that infringes a copyrighted character despite slight differences in appearance, behavior, or traits, and a somewhat similar though non-infringing character whose appearance, behavior, or traits, and especially their combination, significantly differ from those of a copyrighted character, even though the second character is reminiscent of the first one. Stirring one's memory of a copyrighted character is not the same as appearing to be substantially similar to that character, and only the latter is infringement.³⁶

Thus, the sheer fact that there are some differences between the allegedly infringing character and the allegedly copied character does not mean that no infringement has taken place.³⁷ However, courts generally have been unlikely to find infringement of characters, even where there are many similarities, and the standard to find that there has been infringement is high. For example, the Southern District of New York did not find infringement in a case where both characters—each named “Nicholas Gaunt”—were half-human, half-vampire “white males who appear to be in their early twenties . . . [with] thin-to-medium builds, pale skin, dark messy hair and a slovenly appearance.”³⁸ The court held that while sharing a name is “a significant similarity,” it is not sufficient to establish substantial similarity. In declining to find substantial similarity, the court looked to the differences in the characters' origin stories, face shapes, clothing styles and interactions with other characters.

strong characters becoming weak and the like, to make a political statement about the original work).

35. See, e.g., *Metro-Goldwyn-Mayer*, 900 F. Supp. at 1291 (holding that there could be infringement of the character of James Bond in an advertisement, even though the advertisement never referred to the character by name).

36. *Warner Bros., Inc. v. Am. Broad. Cos., Inc.*, 720 F.2d 231, 241–42 (2d Cir. 1983) (holding that a superhero character was not substantially similar to Superman because their similarities went no further than characteristics attributable to “the genre of superheroes”).

37. See *id.* at 243 (“An infringement claim would surely be within the range of reasonable jury fact issues if a character strongly resembled Superman but displayed some trait inconsistent with the traditional Superman image.”).

38. *Hogan v. DC Comics*, 48 F. Supp. 2d 298, 312 (S.D.N.Y. 1999).

C. LAW GENERALLY WITH REGARD TO DERIVATIVE WORKS

One or more preexisting works that are “recast, transformed or adapted” in any way are considered derivative works and, so long as they meet the low threshold of originality and do not infringe the underlying work, are independently copyrightable.³⁹ Any “distinguishable variation” from the underlying work is typically considered sufficiently original to warrant copyright protection.⁴⁰ Copyright owners have the exclusive right to create derivative works based on their copyrighted works.⁴¹ Generally, in order to qualify as a derivative work, the work must exist in a “concrete or permanent form” and substantially incorporate protected material from the preexisting work.⁴² The touchstone for whether or not a work is a derivative is substantial similarity; a work is not considered derivative if it merely borrows ideas rather than the expression of the work or if the changes made are trivial.⁴³

Creation of a protected derivative work does not create additional protection for the underlying work.⁴⁴ Furthermore, where the creator of a derivative work does not have the right to use the underlying copyrighted material, she might lack any rights in the work she created, insofar as the new work relies on the copyrighted material.⁴⁵ Several courts, and Professor Nimmer, have suggested that creating a subsequent work in a series using the same characters is equivalent to creating a derivative work.⁴⁶

D. COPYRIGHT LAW PERTAINING TO CHARACTERS IN A SERIES

The Copyright Act states that a work is created when it is fixed “for the first

39. 17 U.S.C. § 101 (2012).

40. 1 NIMMER ON COPYRIGHT, *supra* note 4, § 3.01.

41. 17 U.S.C. § 106(2) (2012).

42. *See, e.g.*, *Micro Star v. Formgen Inc.*, 154 F.3d 1107, 1110 (9th Cir. 1998) (holding that MAP files burned onto a CD-ROM qualify as existing in a concrete or permanent form).

43. *See, e.g.*, *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976) (holding that an Uncle Sam bank modeled after a public domain bank was not protectable because the variations made from the public domain version were merely trivial).

44. 17 U.S.C. § 103(b) (2012) (“The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.”); 1 NIMMER ON COPYRIGHT, *supra* note 4, § 3.04 (“If the underlying work is in the public domain, a copyright in the derivative or collective work does not render the underlying work protectable. Thus, the copyright in a derivative or collective work merely protects against copying or otherwise infringing the particular compilation or arrangement of a collective work, or the original contribution contained in the derivative work.”).

45. *See, e.g.*, *Anderson v. Stallone*, No. 87-0592(WDKGX), 1989 WL 206431, at *17 (C.D. Cal. Apr. 25, 1989) (holding that plaintiff’s unauthorized use of defendant’s copyrighted characters could not be the basis for a finding of substantial similarity to establish infringement).

46. 1 NIMMER ON COPYRIGHT, *supra* note 4, § 2.12; *e.g.*, *Salinger v. Colting*, 641 F. Supp. 2d 250, 267 (S.D.N.Y. 2009) (holding that a work that continues a previous character’s story is a derivative work, and citing Nimmer’s treatise for the proposition that subsequent works in a series are a type of derivative work), *vacated on other grounds*, 607 F.3d 68 (2d Cir. 2010).

time,” but where there are multiple parts or versions of a work fixed at different times, each individual fixed part constitutes a separate work.⁴⁷ Because of this, when an author creates multiple works published within a series—featuring the same characters, fictional world, etc.—in certain circumstances, the works published later will enter the public domain after the earlier works.⁴⁸ Therefore, when an author uses the same character in multiple works in a series, any elements revealed in works that are in the public domain are free for the public to use, while elements revealed in works still subject to copyright protection may not be used without a license.⁴⁹ This standard is consistent with the law for derivative works generally. Just as creators of derivative works are not granted protection for any aspects of their work that have been borrowed from the public domain, creators of series featuring the same characters in multiple works do not increase the scope of protection over those characters once the work in which they initially appear enters the public domain.⁵⁰

While in theory this makes sense, there are practical problems with implementing this standard. Literature, movies and other works of art are not always explicit in their references, and it might not always be clear whether or not certain elements are being borrowed. Professor Nimmer relies heavily on *Silverman v. CBS*, discussed in more detail below, when explaining this rule.⁵¹ However, *Silverman* dealt only with characters that were sufficiently delineated in the original work to immediately earn copyright protection, but that were not further delineated over the course of the series. This leaves open two other possible cases that Nimmer does not seem to consider: (1) characters that are not sufficiently delineated in the original work to be deserving of very much or any copyright protection, but that become sufficiently delineated over the course of the series and (2) characters that become increasingly delineated over the course of the series. For the most part, courts seem to agree with Nimmer that “flat” characters enter the public domain when the copyright of the first work in which the characters appear expires.⁵² However, this Note argues that courts should consider

47. 17 U.S.C. § 101 (2012).

48. This can happen either under the pre-1976 Copyright Acts, or under the current Copyright Act where there are multiple works in a series published by varying authors—e.g., the earlier work is published by a single author, but the later work is a joint work.

49. See 1 NIMMER ON COPYRIGHT, *supra* note 4, § 2.12 (“[O]nce the 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.”); Kathryn M. Foley, *Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide*, 41 CONN. L. REV. 921, 935–37 (2009) (discussing the case law surrounding when fictional characters appearing over the course of a series enter the public domain); see also 1 NIMMER ON COPYRIGHT, *supra* note 4, § 2.12 (“Clearly anyone may copy such elements as have entered the public domain, and no one may copy such elements as remain protected by copyright.” (internal citations omitted)).

50. See 1 NIMMER ON COPYRIGHT, *supra* note 4, § 2.12; see also *Silverman v. CBS Inc.*, 870 F.2d 40, 49 (2d Cir. 1989).

51. See *infra* Part I.F.

52. “Flat” characters are characters that, while delineated enough to warrant copyright protection, are not so delineated over the course of the series as to warrant increased copyright protection over the

increased delineation in copyright infringement cases when characters are sufficiently developed over the course of the series and such delineation is copied in a nonexplicit way, at least when such development is done in a nonlinear way.⁵³

**E. GRADUAL DEVELOPMENTS IN VISUAL WORKS:
*HARVEY CARTOONS V. COLUMBIA PICTURES INDUSTRIES, INC.***

In *Harvey Cartoons v. Columbia Pictures Industries, Inc.*, the Southern District of New York analyzed the point at which characters appearing in multiple works with copyrights expiring at different times enter the public domain.⁵⁴ In that case, Harvey, the former publisher of the *Casper, The Friendly Ghost* comic books, sued Columbia Pictures for copyright infringement over the use of a ghost in the *Ghostbusters* logo.⁵⁵ In the comic book series, Casper occasionally appeared with the “Ghostly Trio,” a group of ghosts with “knotted foreheads and evil or mischievous facial features.”⁵⁶ Harvey claimed that one of the ghosts, named “Fatso,” was used in the *Ghostbusters* logo, but Columbia claimed that the ghost depicted in the logo was simply a generic ghost.⁵⁷ Further, Columbia argued and the court ultimately agreed that Fatso had already entered the public domain and therefore could be freely copied.⁵⁸

Unnamed ghosts with knotted foreheads appeared in the earliest Casper comic books published in February 1950, the chubbiest of which was dubbed Fatso in an October 1954 issue.⁵⁹ In the following month’s issue, Fatso “developed facial features and expressions nearly identical” to those of the later Fatso.⁶⁰ None of the Casper issues printed before 1956 retained valid copyright registrations by the time the motion picture *Ghostbusters* was released.⁶¹ The court held that there were not sufficient changes to Fatso in the later, still-protected comic book issues to warrant further protection of the character.⁶² Applying these facts to the law surrounding derivative works, the court held that the entirety of the Fatso character had entered the public domain.⁶³ Quoting the Second Circuit, the court stated, “[A] derivative

course of the series. See, e.g., *Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879, 890 (N.D. Ill. 2013); *Silverman*, 870 F.2d at 49–50.

53. See *Silverman*, 870 F.2d at 49 (“The fundamental copyright principle applicable to this case is that a copyright affords protection only for original works of authorship and, consequently, copyrights in derivative works secure protection only for the incremental additions of originality contributed by the authors of the derivative works.”).

54. *Harvey Cartoons v. Columbia Pictures Indus., Inc.*, 645 F. Supp. 1564 (S.D.N.Y. 1986).

55. *Id.* at 1566.

56. *Id.*

57. *Id.*

58. *Id.*

59. *Id.* at 1567.

60. *Id.*

61. *Id.*

62. *Id.* (“The ‘Fatso’ character in plaintiff’s later issues contains refinements and embellishments, but is otherwise nearly identical to its predecessor character, which appeared in the [public domain] issues, except that the storylines have changed.”).

63. *Id.* at 1570–71.

copyright is a good copyright only with regard to the original embellishments and additions it has made in the underlying work.”⁶⁴

Because the underlying work featuring Fatso’s predecessor character had entered the public domain, the fact that the character appeared in derivative works—i.e., later comics in the series—did not mean that Fatso as a character remained protected by copyright. However, the court was careful to point out that in this case the derivative works only added new storylines, which were protectable, and did not add revelations about the character of Fatso.⁶⁵ Therefore, any similarities between the *Ghostbusters* logo and Fatso concerned non-copyrightable elements, and there was no infringement.⁶⁶ Since Harvey only alleged that the visual aspects of Fatso were copied, any such revelations would not have changed the outcome of this case. However, this reasoning does suggest that if the later, still-copyrighted Casper comic book issues had featured any revelations with regard to the character of Fatso, those revelations might have been copyrightable if more than Fatso’s visual depiction were borrowed. For example, if the later Casper works revealed the way Fatso died before becoming a ghost or demonstrated that he had an especially cruel temper when around children for some specific reason, these elements about the character would have been copyrightable, although Fatso’s traits introduced in the public domain works would not have been. This holding is in accordance with the law of derivative works generally, which allows copyright only for any additions to the underlying work, but does not expand copyright in the underlying work itself.⁶⁷

F. SILVERMAN AND THE INCREMENTAL EXPRESSION TEST

This notion of obtaining further copyright protection in subsequent works in a series only for the additions made to characters was further reinforced in *Silverman v. CBS*. In that case, Silverman was seeking a declaratory judgment that the titular characters and names from the *Amos ‘n’ Andy* radio program were in the public domain, despite the fact that subsequent radio and television works in the series were still subject to copyright protection.⁶⁸ The Second Circuit was tasked with deciding whether or not there was valid copyright in the characters using an “incremental expression” test. This test paralleled the test used for derivative works, whereby protection in later works is only secured for “the incremental additions of originality contributed by the authors of the derivative work.”⁶⁹ Although the court ruled that the characters of Amos and Andy entered the public domain when the first script entered the public domain, the court was careful to point out that “any further delineation of the characters contained in the [protected]

64. *Id.* at 1570 (quoting *Filmvideo Releasing Corp. v. Hastings*, 688 F.2d 91, 92 (2d Cir. 1981)).

65. *Id.* (“[T]he fact that the latter issues of ‘Casper’ comic books remain copyrighted does not serve to protect the contents of the issues with expired copyrights.”).

66. *Id.* at 1571.

67. *See* 17 U.S.C. § 103(b) (2012).

68. *Silverman v. CBS Inc.*, 870 F.2d 40, 43 (2d Cir. 1989).

69. *Id.* at 49.

radio scripts and the television scripts and programs, if it is ultimately determined that these last items remain protected by valid copyrights[,]“ remain protected.”⁷⁰ This meant that CBS maintained copyrights in any “increments of expression” added to the *Amos ‘n’ Andy* radio scripts and television programs for which the copyrights had not expired “beyond what is contained in the [public domain] scripts.”⁷¹ However, this does not mean that every visual addition added in the television programs was protected; for example, the race of the characters and other physical features “adequately described” in the public domain scripts were not protected.⁷² Therefore, the public, including Silverman, was free to copy any story or character elements contained in the public domain works, but could not copy any “increments of expression” added in the protected works, including dialogue.⁷³

Taking on a similar issue, *Pannonia Farms, Inc. v. USA Cable* focused on copyright ownership in the central characters of the Sherlock Holmes canon. Despite receiving a demand letter from the plaintiff, defendant USA Cable aired an unlicensed film titled *Case of Evil* featuring the characters of Sherlock Holmes and Dr. Watson.⁷⁴ Although the court resolved the case based on plaintiff’s lack of standing to sue under the Copyright Act because the plaintiff did not properly own the rights to the characters, it nonetheless reviewed the facts for potential infringement using the *Silverman* incremental expression test. Defendant claimed it properly used only the public domain version of the Holmes and Watson characters and did not otherwise draw from the protected stories. Following the *Silverman* court’s logic, *Pannonia Farms* held that every element of a story, delineated characters included, enters the public domain when the story’s copyright expires.⁷⁵ When there are subsequent works, only any new increments of expression—that is, story elements adding to those that already appeared in the underlying work—are granted protection.⁷⁶

Although it was not specifically addressing characters appearing over the course of a series, the Eighth Circuit in *Warner Bros. Entm’t, Inc. v. X One X Productions* held that an author or artist is permitted to create a derivative work based on an underlying work that has entered the public domain, even when later copyrighted works add new story or character elements. However, the creator of the derivative work may only borrow expression from the public domain works, and may not borrow expression that appears solely in the later, still-copyrighted works.⁷⁷ In *Warner Bros. v. X One X*, publicity posters from *The Wizard of Oz* and *Gone With the Wind* films featuring some of the main characters had entered the public

70. *Id.* at 50.

71. *Id.* at 49–50.

72. *Id.* at 50.

73. *See id.*

74. *Pannonia Farms, Inc. v. USA Cable*, No. 03 Civ. 7841(NRB), 2004 WL 1276842, at *1 (S.D.N.Y. June 8, 2004).

75. *Id.* at *9.

76. *Id.*

77. *Warner Bros. Entm’t, Inc. v. X One X Prods.*, 644 F.3d 584, 596–97 (8th Cir. 2011) (“Nevertheless, this freedom to make new works based on public domain materials ends where the resulting derivative work comes into conflict with a valid copyright.”).

domain, but the actual films had not.⁷⁸ The court held that “[t]he isolated still *images* included in the publicity materials cannot anticipate the full range of distinctive speech, movement, demeanor, and other personality traits that combine to establish a copyrightable character.”⁷⁹ Therefore, the only aspect of the characters that had entered the public domain was the exact image appearing in the publicity materials that had entered the public domain.⁸⁰ Although this case does not deal with characters in a series in the traditional sense, the focus on an earlier incarnation of a character that does not represent the entirety of the character appearing in subsequent works is significant.

G. BACKGROUND AND RULING IN *KLINGER V. CONAN DOYLE ESTATE, LTD.*

In *Klinger v. Conan Doyle Estate, Ltd.*, Klinger—a Sherlock Holmes expert and writer of stories that incorporated several story elements and characters from the famous Sir Arthur Conan Doyle canon—was granted a declaratory judgment that the characters of Holmes and Dr. Watson were in the public domain. The district court held, and the Ninth Circuit affirmed, that the characters are available for all to use without a license, despite the fact that Doyle’s final ten Sherlock Holmes stories remain under copyright protection.⁸¹ Doyle wrote the Holmes canon (four novels and fifty-six short stories) over a period of forty-one years, and the last ten of these stories remain protected until 2022. The district court held that the characters of Holmes and Watson entered the public domain upon copyright expiration of the first story in the series.⁸² The Doyle estate argued that Klinger and any other writer seeking to use such elements must obtain a license from the estate to use these two characters, because the characters were so dynamic that they retained copyright protection until the final Sherlock Holmes story entered the public domain.⁸³ The primary arguments in *Klinger* focused on the tenability of maintaining copyright protection over characters when they become more delineated over the course of a series of books or movies. The courts focused specifically on whether a character enters the public domain when the work featuring the first appearance of the character enters the public domain, if the character is increasingly developed in a nonlinear fashion over later works in the series which are still subject to copyright.

1. *Klinger v. Doyle* District Court Opinion

In granting the declaratory judgment placing Sherlock Holmes in the public domain, the Northern District of Illinois applied the *Silverman* “increments of

78. *Id.* at 591–95.

79. *Id.* at 598.

80. *Id.*

81. *Klinger v. Conan Doyle Estate, Ltd.*, 755 F.3d 496, 503 (7th Cir. 2014), *cert. denied*, 135 S. Ct. 458 (2014).

82. *Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879, 889–90 (N.D. Ill. 2013).

83. *See id.* at 888.

expression” framework, and drew from *Pannonia Farms*’ application of that framework.⁸⁴ In so doing, the court held that although the characters of Holmes and Watson are rightly in the public domain, any “increments of expression” added in the protected (post-1923) works may not be used without a license,⁸⁵ including “storylines, dialogue, characters and character traits newly introduced” in the later works.⁸⁶ Therefore, “characters and story elements first articulated in public domain works are free for public use, while the further delineation of the characters and story elements in protected works retain their protected status.”⁸⁷ This holding denied Klinger’s contention that the post-1923 story elements—i.e., the story elements that were contained in the works still subject to copyright protection—were also in the public domain.⁸⁸ Klinger had claimed that the post-1923 story elements were in the public domain because “they are events, not characteristics” and ideas, plots, dramatic situations and events are not subject to copyright protection.⁸⁹ The court disagreed, holding that the post-1923 story elements “consist of a character, character trait, and storyline, which are copyrightable increments of expression.”⁹⁰

Although it ultimately failed, the Doyle estate attempted to draw a distinction between “flat” characters—created essentially in full the first time they appear in a fictional work and simply placed into new scenarios with no character development—and dynamic characters—developed over the course of the works, not merely to further the plot.⁹¹ The Doyle estate argued that the *Silverman* incremental expression test should only apply to “flat” characters and should not apply to more “dynamic” characters.⁹² Doyle then argued that unlike the Sherlock Holmes characters, the Amos and Andy characters could be considered “flat” because their development did not add sufficient delineation to the characters to warrant further protection, while the Sherlock Holmes characters should be considered “dynamic” because they had added sufficient delineation to warrant continued protection.⁹³ Doyle argued that the character development added in the later works, including the changing dynamics of Holmes’ relationship with Watson, Holmes’ evolving worldview and new skills Holmes acquired, distinguished the character development here from that in *Silverman*.⁹⁴

84. *Id.* at 889.

85. *Id.* at 893.

86. *Id.* at 889 (citing *Pannonia Farms, Inc. v. USA Cable*, No. 03 Civ. 7841(NRB), 2004 WL 1276842, at *9 (S.D.N.Y. June 8, 2004)).

87. *Id.* at 890.

88. *Id.* at 893.

89. *Id.*

90. *Id.*

91. A flat character is one “that is two-dimensional, without the depth and complexity of a living person; the opposite of a *round character*.” Doyle’s Response to Klinger’s Motion for Summary Judgment, *supra* note 8, at 9. Their personalities remain consistent from story to story; they simply find themselves in a unique situation each story. *Id.*

92. *Klinger*, 988 F. Supp. 2d at 890 (N.D. Ill. 2013).

93. *Id.*

94. Doyle’s Response to Klinger’s Motion for Summary Judgment, *supra* note 8, at 2.

More importantly, Doyle emphasized the fact that the author added character development in a “non-linear way.”⁹⁵ Essentially, Doyle argued that when characters are highly dynamic and the reader learns crucial information about the characters in a later work, a writer cannot help but be informed by this information in his writing of that character. However, the district court rejected this novel argument, finding that Doyle “fail[ed] to offer a bright line rule or workable legal standard for determining when characters are sufficiently developed to warrant copyright protection through an entire series,” and also failed to provide case law supporting its position.⁹⁶ “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.”⁹⁷ Therefore, according to the court, the test should not assess how delineated or dynamic the character becomes over the course of the series; rather, each new protectable element gains protection in its own right, regardless of whether it further delineates a character. The court held that works in a series featuring the same character or characters are equivalent to derivative works because they are subsequent works featuring material from a pre-existing work.⁹⁸ As with derivative works, the court held that the threshold level of originality required for added incremental expression is low.⁹⁹

2. *Klinger v. Doyle* Circuit Court Opinion

On appeal, the Conan Doyle estate challenged the district court opinion on two alternative grounds: first, on lack of subject matter jurisdiction because there is no actual case or controversy between the parties, and second, if there is jurisdiction, the estate is entitled to judgment on the merits because copyright in “a complex character . . . whose full complexity is not revealed until a later story, remains under copyright until the later story enters the public domain.”¹⁰⁰ After rejecting the subject matter jurisdiction argument, Judge Posner agreed with the district court that copyright protection of fictional characters should not extend beyond the expiration of copyright because of alterations to the character in subsequent works.¹⁰¹ The court also cited *Silverman* to support this holding and rejected outright the notion that prequel works that make a character “rounder” should extend copyright protection, stating that the appeal “borders on the quixotic.”¹⁰² Notably, Judge Posner did not believe that any actual knowledge of the contents of the books was necessary to resolve the dispute because Klinger averred that his

95. *Id.*

96. *Klinger*, 988 F. Supp. 2d at 890.

97. *Id.*

98. *Id.* at 891–92.

99. *Id.*

100. *Klinger v. Conan Doyle Estate, Ltd.*, 755 F.3d 496, 498 (7th Cir. 2014) (internal quotation marks omitted).

101. *Id.* at 500.

102. *Id.* at 503 (“The resulting somewhat altered characters were derivative works The alterations do not revive the expired copyrights on the original characters.”).

book would contain no material from the still-copyrighted stories.¹⁰³

The court cited several different policy reasons to support its rejection of the Doyle estate's argument. First, the opinion expressed caution about extending the copyright term because doing so reduces the number of works available in the public domain, "and so the greater will be the cost of authorship, because authors will have to obtain licenses from copyright holders for more material."¹⁰⁴ The court also cautioned that if the defendant's proposed rule were implemented, authors would be encouraged to continue to write stories involving old characters rather than creating new ones, thereby discouraging creativity.¹⁰⁵

II. WHY A FRAMEWORK IS NECESSARY

In light of the current law on character copyright explained above, this Note will propose a test for determining when courts may consider extending some copyright protection to authors who expand on characters in later works when some part of the character has already entered the public domain. This test will be particular to prequel facts, and will implement a sliding scale based on: (1) how copyrightable the public domain version of the character is, based on Learned Hand's formulation that the more delineated the character is, the more protection is granted to it, and (2) the amount, both qualitative and quantitative, the character is changed in the copyrighted work. This test will be applied to the allegedly infringing portrayal of the character to determine the extent to which the character changes have been borrowed. A character that exists in a less delineated version in the public domain, and a character that is much more developed in the still-copyrighted work, will be more likely to earn increased copyright protection, even where the new elements are not explicitly referenced in the allegedly infringing work.

A. APPLYING THE CURRENT COPYRIGHT REGIME

There are two instances that demonstrate the extreme versions of the proposed test. First, there is the situation in which a character is barely copyrightable in the first instance, but then becomes copyrightable in later works. The second is a situation in which the public domain version of the character is already quite developed, but a crucial fact about the character's history is revealed in the still-copyrighted work.

The first scenario, in which a public domain character is not very copyrightable—or may not be copyrightable at all—but then is expanded upon greatly in later works, seems to be somewhat akin to the *Warner Bros. v. X One X* case discussed above.¹⁰⁶ In that case, the court held that public domain physical representations of characters did not allow anything about the characters to enter

103. *Id.* at 500.

104. *Id.* at 501.

105. *Id.*

106. *Warner Bros. Entm't, Inc. v. X One X Prods.*, 644 F.3d 584 (8th Cir. 2011); *see supra* text accompanying notes 77–80.

the public domain except for the pictures themselves.¹⁰⁷ Applying those facts to a situation in which a character lacking delineation enters the public domain but is later developed much more fully, it would seem that nothing would enter the public domain beyond the scant details provided in the public domain work. This is also in line with the incremental expression test discussed in Part I.¹⁰⁸ In such a scenario, it would be easier to determine whether or not the elements revealed in later works were borrowed because of how little is known about the character initially.

However, the more details revealed about the character in the public domain work, the more difficult this standard would be to implement. To demonstrate the latter situation described above—where a public domain character is extremely delineated and copyrightable, but then a copyrighted work fundamentally changes the reader’s perception of the character—consider the following hypothetical: There is a public domain work in which John, a depressed inspector, is the main character in a detective novel where John investigates his own brother’s murder. In a copyrighted work, it is revealed that John himself murdered his brother. If a third party writes fan fiction incorporating John the public domain inspector, but does not mention that John has murdered his brother, the author has not infringed according to the incremental expression test. However, what if the fan fiction writer gives public domain John moments depicting meaningful looks at two boys playing in the park or has John purposely follow false leads in the investigation of his brother’s murder? Essentially, one can imagine a fan fiction writer being able to write a story using the delineated public domain John in a more interesting, exciting way influenced by the crucial element learned in the copyrighted work without explicitly referencing it. Although not explicit, these plots would nonetheless borrow the incremental expression added in the copyrighted work because they would derive some of their appeal from what readers *know* about John, independent of what the fan fiction writer tells them.

B. CRITIQUE OF *KLINGER V. DOYLE*

Perhaps the dispositive issue in *Klinger* was not necessarily whether further delineation in a nonlinear fashion warrants increased copyright protection,¹⁰⁹ but rather the fact that such nonlinear delineation likely does not apply to the characters of Holmes and Watson. Although Holmes is dynamic enough that courts have unsurprisingly found the character deserving of copyright protection generally, he is in many ways a quintessential “flat” character.¹¹⁰ Even Sir Arthur Conan Doyle, the creator of Holmes, admitted that he grew tired of writing about

107. *Warner Bros. v. X One X*, 644 F.3d at 598.

108. See *supra* text accompanying notes 68–73.

109. *Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879, 890 (N.D. Ill. 2013); see also *supra* text accompanying notes 91–105.

110. See Zecevic, *supra* note 19, at 376 (stating that Holmes is an example of a “flatter character” who has been described as “a very limited and predictable character, to the extent that he is almost formulaic”).

Holmes “because his character admits of no light or shade.”¹¹¹ Therefore, had the court been asked to analyze a series with truly dynamic characters that actually became increasingly delineated with prequel facts later in the series, it might have ruled differently.

Furthermore, the Doyle estate could have requested higher scrutiny over Klinger’s work to determine if it was noticeably inspired by copyright-protected facts about Holmes and Watson, even if it did not reference the copyrighted facts explicitly. However, the Doyle estate instead requested protection over the entirety of the two characters.¹¹² Allowing such unmitigated protection over every version of a character, even after works that properly introduce the characters enter the public domain, is an unworkable standard that would fly in the face of the Copyright Clause’s “limited Times” restriction.¹¹³ If such protection were granted, in theory, the rights to a character could be continuously signed away, and new stories continuously created, that could allow copyright protection to exist forever. This would not only be undesirable from the perspective of the constitutional goal of “promot[ing] the Progress of Science and useful Arts” by stifling the creation of derivative works, it would violate the clause by allowing copyright that is not “limited” in duration.¹¹⁴

C. POTENTIAL ISSUES THAT MIGHT ARISE WITHOUT A NEW TEST

A situation is easily foreseeable in which an author creates a character that is not sufficiently delineated to be copyrightable, but then the author expands on the character in later works such that the character becomes sufficiently delineated to deserve copyright protection. If the original work does not have copyright protection and the later works are protected by copyright, it might be difficult to apply the incremental expression test. It is common, for example, for a background character in an earlier work to move closer to the forefront of a later work in the series.¹¹⁵ For works in a series with copyrights that expire at different times, it is not necessarily easy to distinguish the increments of expression from the earliest incarnation of the character. In the Casper case discussed above, it is likely that the initial character of Fatso—the one that did not have a name or a recognizable facial expression—would not have been subject to protection, while the later one would.¹¹⁶ This was not necessary to discuss in the case, but it is easy to see how this could have been an issue had the *Ghostbusters* film been released earlier, when some of the comics were still subject to copyright protection.

111. Arthur Conan Doyle, *Sidelights on Sherlock Holmes*, in *THE BAKER STREET READER* 11, 14 (Philip A. Shreffler ed., 1984).

112. See Doyle’s Response to Klinger’s Motion for Summary Judgment, *supra* note 8, at 3.

113. U.S. CONST. art. I, § 8, cl. 8 (“The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . .”).

114. See *id.*

115. As in the Newt Scamander example mentioned in the Introduction, above.

116. See *Harvey Cartoons v. Columbia Pictures Indus., Inc.*, 645 F. Supp. 1564, 1567 (S.D.N.Y. 1986); see also *supra* text accompanying notes 54–66.

An example of where this exact issue could reasonably come into play, given the profitability of the enterprise, is the character of Newt Scamander in the Harry Potter series and subsequent film franchise. Scamander is first mentioned in the Harry Potter series simply as the author of a textbook the Hogwarts students must buy, *Fantastic Beasts and Where to Find Them*, then further detailed in the “About the Author” section of the spinoff novel with the same title penned by J.K. Rowling.¹¹⁷ Even with these subsequent details, Scamander was a relatively flat character possibly lacking sufficient detail to earn high levels of copyright protection. However, Warner Brothers recently announced that Rowling would write a screenplay focusing on Scamander as the main character.¹¹⁸ The books in which Scamander initially appears cite Rowling as the sole author, so the copyright will expire (as the Copyright Act currently stands) seventy years after Rowling’s death.¹¹⁹ However, it is likely that the film will be considered a joint work or a work for hire for which the copyright could expire at a different time than would the copyright in the novels.¹²⁰ Since this new franchise will focus on Scamander as the main character, it is likely that he will become sufficiently delineated as a result of the films to command higher copyright protection than Rowling would have otherwise received for the character based on the cursory descriptions she provides of him in her books. Moreover, the version of Scamander in the Harry Potter novels and spinoff is an older, accomplished man, while the films will focus on the character in his younger, more adventurous years—meaning that facts are revealed about Scamander in a nonlinear fashion. Although Scamander might also be protected under trademark,¹²¹ the likelihood of financial success for such films suggests that the rights holders would seek the highest amount of copyright protection possible for the character. In many years, if the copyright in the Harry Potter novels expires before the copyright in the films, it is easy to see how a Scamander fan fiction author might have difficulty determining which aspects of his character she may include in her story; Rowling provided enough about him that the reader could imagine him as a young man, but likely will include more elements in the upcoming films that, even if not expressly referenced, will shape him even further in the minds of readers.

It was also announced that Rowling would produce a play based on Harry

117. J.K. ROWLING, *FANTASTIC BEASTS AND WHERE TO FIND THEM* 45–46 (2001).

118. H. Shaw-Williams, *Harry Potter Spinoff Movie: ‘Fantastic Beasts and Where to Find Them,’* CHRISTIAN SCIENCE MONITOR (Oct. 1, 2013), <http://perma.cc/39PE-D8HS> (announcing that Warner Brothers secured the trademarks for the spinoff).

119. 17 U.S.C. § 302(a) (2012) (“Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and 70 years after the author’s death.”).

120. See 17 U.S.C. § 302(b) (2012) (“In the case of a joint work prepared by two or more authors who did not work for hire, the copyright endures for a term consisting of the life of the last surviving author and 70 years after such last surviving author’s death.”); 1 NIMMER ON COPYRIGHT, *supra* note 4, § 6.05 (“A motion picture is a joint work consisting of a number of contributions by different ‘authors,’ including the writer of the screenplay, the director, the photographer, the actors, and, arguably, other contributors such as the set and costume designers, etc.”).

121. Shaw-Williams, *supra* note 118.

Potter's life before finding out he is a wizard.¹²² The same issues in terms of copyright expiration of joint works, compared with independent works of authorship, apply as with *Fantastic Beasts and Where to Find Them*. Here, there will also be an increased appreciation and more nuanced understanding of the character of Harry Potter that derivative writers will be privy to once the books enter the public domain.¹²³ Even where authors of derivative works do not specifically reference any increments of expression added in this later play, it is easy to see how such information could influence the way they write in subtle ways even if they do not explicitly reference the new information. The test would be whether this subtle influence is sufficient for a court to find substantial similarity between the increments added in the later copyrighted works and the allegedly infringing work.¹²⁴

III. POSSIBLE SOLUTIONS AND A SUGGESTED FRAMEWORK

The *Silverman* court held that a writer may use public domain material without permission so long as she is careful to avoid using any expression that only appears as an addition in a later work that is still subject to copyright protection.¹²⁵ Specifically, the Second Circuit stated that such a writer may not use additional character delineation introduced in works that remain protected by valid copyrights.¹²⁶ Because series and sequels can be categorized as derivatives, it seems logical that the *Silverman* court's incremental test paralleled the test that is used to determine the extent of protection over derivative works; but the *Silverman* holding failed to consider nonlinear additions. Although it is true that these works are only fictionally nonlinear—that is, they are in fact presented in an objective sequence—such fictional nonlinear elements can change or increase the delineation of a character such that a fan fiction writer could borrow these elements without explicitly referencing them in a way that could still satisfy the substantial similarity test. For example, using again the above hypothetical of the public domain inspector John character, who the reader finds out in a later copyrighted work has killed his own brother,¹²⁷ an entire fan fiction story could be written in which John is inspecting a different murder and is convinced the victim's brother committed the act. Without explicitly referencing that John has killed his own brother, such a work could conceivably be found to infringe the incremental elements added in the

122. Haley Blum, *J.K. Rowling to Produce Harry Potter Stage Play*, USA TODAY (Dec. 20, 2013), <http://perma.cc/MAU3-8SFP>.

123. The same issues could possibly apply to a character description supplied on Pottermore, an online interactive website created by Rowling. See *About Us*, POTTERMORE, <https://perma.cc/G32M-GMUQ?type=source> (last visited Apr. 30, 2015).

124. Note that subconscious infringement has been found in the music context. See *Bright Tunes Music Corp. v. Harrisongs Music, Ltd.*, 420 F. Supp. 177 (S.D.N.Y. 2011) (holding that defendant's plagiarism of plaintiff's song was "infringement of copyright . . . no less so even though subconsciously accomplished").

125. *Silverman v. CBS, Inc.*, 870 F.2d 40, 50 (2d Cir. 1989).

126. *Id.*

127. See *supra* Part II.A. Applying the Current Copyright Regime.

copyrighted work.

Moreover, while the *Klinger* court criticized the Doyle estate for failing to suggest a workable test or bright line rule to determine when characters written over the course of a series should be protected, the *Silverman* test is just as murky with respect to nonlinear additions as any that the Doyle estate might have suggested.¹²⁸ As the Doyle estate argued in *Klinger*, the current incremental expression test is not adequate when the creator of a derivative work is influenced by prequel information about a character introduced in a work that remains protected, when the derivative work creator does not mention that information explicitly. This is especially problematic because it is extremely common for authors to use prequels and flashback sequences to develop characters in a nonlinear fashion.

As stated above, courts have already held that fictional characters are entitled to copyright protection separate from the storylines of the works in which they appear if they are sufficiently delineated.¹²⁹ But the Ninth Circuit has gone so far as to suggest that characters that are too tied to the plot—which would include nearly all fictional characters—do not deserve copyright protection.¹³⁰ These tests are murky, and it is not immediately clear how to reconcile them with the *Silverman* incremental expression test when dealing with nonlinear character development. However, this section will propose a solution in the form of a test.

The main test used to determine whether or not fictional characters deserve copyright protection in the first instance could be adjusted to create a standard to determine the narrower question of when copyright protection should extend to characters appearing over the course of a series. This Note proposes that the current two-part test used by a majority of courts—first, that the character must be sufficiently delineated, and second, that the alleged infringer must have copied that delineation, and not simply a loose outline of the character¹³¹—should be applied to subsequent nonlinear delineation. Therefore, in the context of a series in which the earlier works have entered the public domain and later works remain protected by copyright, the court should first look to whether or not there has been sufficient *further* delineation in the copyrighted works to warrant increased additional protection. This test would only be satisfied: (1) where the increased delineation was deemed to have fundamentally changed the character as initially perceived, to the point where it would be difficult for a creator of a derivative work to ignore

128. In fact, the test for copyrightability in general is no more workable than would be a test for delineation over the course of the series. If copyright law does not demand a bright-line test to determine the extent of copyright over fictional characters generally, it only follows that it would not demand one to determine the extent of increased protection of fictional characters after further delineation in subsequent works.

129. See, e.g., *Anderson, v. Stallone*, No. 87-0592(WDKGX), 1989 WL 206431, at *6 (C.D. Cal. Apr. 25, 1989) (holding that the characters over three “Rocky” films “constitute expression protected by copyright independent from the story in which they are contained . . .”).

130. *Warner Bros. Pictures v. Columbia Broad. Sys.*, 216 F.2d 945, 949 (9th Cir. 1954) (though, as discussed above, this test has not retained much support even within the Ninth Circuit).

131. See, e.g., *Warner Bros, Inc. v. Am. Broad. Cos.*, 530 F. Supp. 1187 (S.D.N.Y. 1982), *aff’d*, 720 F.2d 231 (2d Cir. 1983).

these character developments in writing a work featuring the character, and (2) where such increased delineation was borrowed in a nonexplicit way in the allegedly infringing work. In this way, just as Learned Hand stated in *Nichols* that less copyright protection for less developed characters “is the penalty an author must bear for marking them too indistinctly[.]”¹³² here only additions that sufficiently develop the character will warrant increased protection. Courts could also look to the following factors when applying this test: how copyrightable the character is in the first instance; the number of elements the original author adds in subsequent works that substantially change the character; and whether or not the defendant’s work could have been written without the details provided in plaintiff’s later work.

If the first prong is met, just as in the majority test to determine if characters are subject to copyright protection generally, the court would determine whether or not this further delineation was copied. This is not as straightforward as it might be in the general character copyright context because it might not be so clear that such delineation was copied. The court would have to determine if the way the character was written in the allegedly infringing work was clearly and fundamentally influenced by the increased delineation found in the first prong. This would not be an easy standard to meet.¹³³

The test this Note proposes is self-evidently not a bright line test or one that is easy to articulate in definite terms, but it is no less workable than the *Nichols* test, which has guided courts for generations, nor does it ask judges to serve as literary critics more than the *Nichols* test does. It rewards creators who properly increase how dynamic and delineated their characters are over the course of a series by providing backstory, thereby incentivizing them to create more detailed subsequent works for readers to access. It also ensures that writers are not granted a perpetual monopoly over their characters, and provides a stringent standard to ensure that the public is not robbed of the opportunity to create derivative works. This is particularly true given the fact that for all other cases that do not involve nonlinear character development, the incremental expression test would continue to apply.

A. THE FRAMEWORK WILL BE EFFECTIVE IN HELPING TO BALANCE BOTH PUBLIC AND PRIVATE INTERESTS

It is not technically a goal of the Copyright Act to ensure that authors profit from their work, but it is a goal of the Act to incentivize creation so that the public can enjoy creative works.¹³⁴ The instrumentalist approach to copyright views the basic goal of copyright law as the growth of culture; exclusive rights are necessary in order to incentivize creation in order to so grow culture.¹³⁵ However, it is

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

133. It is necessary for the standard to be high so that authors would not easily be able to exploit the exception, therefore possibly extending their copyright beyond what the Copyright Act intended.

134. See, e.g., *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985); 122 CONG. REC. 2834 (1976) (statement of Sen. McClellan).

135. See, e.g., William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*,

important to ensure that the law does not inhibit cultural growth, such as the creation of derivative works that might be even better than the original, because copyrights on the underlying works are too strong, too broad or too long.¹³⁶ To that end, it is important to protect both of these interests—the public’s interest in enjoying new creative works and the creators’ private interests of profiting from creating them—by striking a balance that does not over- or under-protect creators’ works. This holds particularly true for ensuring that fictional characters enter the public domain at a time that benefits both the public and the creator for many reasons. For authors, characters can be extremely profitable, even and especially as distinguished from the stories in which they appear. Many profitable books, movies and other avenues of expression with memorable characters have resulted in franchises that bring in huge amounts of money, only part of which comes from sales of the initial work. Figurines, costumes and videogames based on the characters, rather than the series as a whole, bring in profits for whoever has the rights to charge for them.¹³⁷ On the other side, there is a large market for fan fiction and other types of derivative works, and the Copyright Act attempts to incentivize derivative creations as well, so long as they are created after acquiring the proper rights.¹³⁸

It is important to ensure that the public has the right to use fictional characters for such endeavors within a reasonable amount of time, but also that the public is not granted such broad rights as to deprive the creation of characters of the requisite profitability for writers to incentivize creation. The test suggested above would ensure that these important interests would be balanced. If authors do not add expression that fundamentally changes an existing character, or the derivative work’s writer does not allow this fundamental change to influence the way she writes about the character, then the amount of protection already afforded by the Copyright Act is sufficient. However, if the character does not become fully developed, or developed at all, until later in the series, the author deserves increased protection. This will serve to ensure that authors remain incentivized to further develop their characters in new works, but also that the public will be entitled to use public domain versions of characters, in accordance with *Silverman* and the law surrounding derivative works.

B. THE FRAMEWORK WILL HELP TO PROTECT AUTHORS’ MORAL RIGHTS AND THEREFORE INCENTIVIZE CREATION

Although the United States does not technically guarantee creators of literary works any moral rights, as are available in other countries, it remains an important

18 J. LEGAL STUD. 325 (1989).

136. See Karjala, *supra* note 9, 34–35 (discussing the balancing of public and private interests in the context of the ideal time and scope of authors’ control over the use of fictional characters they create).

137. See, e.g., *Harvey Cartoons v. Columbia Pictures Indus., Inc.*, 645 F. Supp. 1564, 1566 (S.D.N.Y. 1986).

138. See 17 U.S.C. § 102 (2012).

facet of copyright law that certain creative works may not be misappropriated or destroyed while they remain protected so as to ensure that authors are encouraged to create.¹³⁹ “One potential argument concerning the right of copyright owners to control the use of popular characters in new works is that of debasement, in the sense that whatever is created in the takeoff stories is actually something different from the original, diluting its cultural quality.”¹⁴⁰ Therefore, it is important to balance the interests of the original creator in ensuring her characters are not used in a way that she would not approve of for some period of time, but also for the public to be able to use characters in new, interesting ways that the author might not have thought to use herself. This is another area where the proposed test would help serve the purposes of the Copyright Act and copyright law in general. Although creators and copyright holders evidently have an interest in maintaining their characters, this need for protection cannot and need not last forever. The test ensures, however, that it lasts for a reasonable period of time.

IV. CONCLUSION

As readers of book series and watchers of long-running television shows know, characters in character-driven works become more to the reader or viewer than characters; they become fully realized dynamic individuals. Characters can develop from vague ideas into complex, emotionally developed, physically conceptualized, life-like works of authorship. It is common in works that run over a series for an author to flash back and write prequels such that the reader learns details about the past life of a character much later in the series. When a character is so delineated and the reader learns crucial prequel information about the character, a derivative work writer could foreseeably have a difficult time putting such details out of her mind when writing about the character. In such cases, when the original work is in the public domain but the prequel work remains under copyright, the current framework for copyright protection of characters and the *Silverman* incremental expression test do not achieve the necessary balance of appropriate protection. This Note concludes that an alternative scheme that requires closer scrutiny into how much the protected prequel work influenced the derivative work would better achieve these goals. It would ensure that there were sufficient incentives for the creator to continue creating and adding to her characters in a dynamic way, while not so widening the protection that the public would be completely denied access to the work.

139. See 17 U.S.C. § 106A (2012).

140. Karjala, *supra* note 9, at 35–36.