“So Tarzan, Zorro, and Mickey Mouse went to a bar” - Trademark protection of public domain characters

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Abstract:

The aim of my thesis is to examine whether trademark protection can be used to protect fictional characters that have already fallen into the public domain. I will also deal with possible requirements or limitations to that protection and discuss whether the attempts to prolong the limited copyright protection through trademark registrations have succeeded and if they have precluded the use of certain characters in new works entirely.

Legal dogmatics and the functional analysis of the comparative law are utilized as the main methodologies for this thesis, but I have also tried to include law and economics features to my research. The materials and references include United States, European Union and national European legislation and case law supplemented with legal literature and, because the nature of the subject of this thesis, some more unconventional pop culture sources.

During the research I will find that European courts, both national and EUIPO, have adapted more critical approach to registering trademarks on fictional characters, but at the same time the situation in the United States is still in a flux. I find it very likely that the trademark protection of public domain characters will be clarified through litigation and legal interpretation rather than changes on legislation.

Keywords: Trademark, Copyright, Public domain

CONTENTS

1 INTRODUCTION 1

1.1. Fictional characters and IPR protection 1

1.2. Research question and its limitations 3

1.3. Methodology and references 4

1.4. Outline of this thesis 6

2 COPYRIGHT PROTECTION OF CHARACTERS 8

2.1. Copyright in general 8

2.2. Copyrightability of characters in the United States 9

2.2.1. Tests determining whether characters merit copyright protection 10

2.2.2. Application of the copyrightability tests 11

2.2.3. Special cases 12

2.2.4. Boundaries of copyright protection 13

2.3. Copyrightability of characters in Europe 15

2.3.1. Copyrightability of characters in the United Kingdom 15

2.3.2. Copyrightability of characters in continental Europe 17

2.4. Fair use 18

3 PUBLIC DOMAIN 21

3.1. Public domain in copyright law 21

3.2. Public domain in trademark law 24

4 TRADEMARK PROTECTION OF CHARACTERS 27

4.1. Trademark in general 27

4.2. Trademark protection of characters in the United States 29

4.2.1. Acquired distinctiveness 30

4.2.2. Single source requirement 31

4.2.3. Protected elements 34

4.2.4. Likelihood of confusion 35

4.2.5. Dilution of famous marks 37

4.2.6. Comedy III Productions, Inc. v. New Line Cinema 39

4.2.7. Dastar Corp. v. Twentieth Century Fox 42

4.3. Trademark protection of characters in Europe 46

4.3.1. National case law and registration practices 47

4.3.2. The European Union case law 50

4.4. Trademark fair use 53
4.4.1. The European Union 53
4.4.2. The United States 54
5 ESTIMATING THE FUTURE OF CHARACTER PROTECTION 59
5.1.1. Zorro's Ride into Terror 59
5.1.2. The Curious Case of Mickey Mouse 60
5.1.3. More general cases potentially effecting the future 63
6 CONCLUSIONS 66
REFERENCES 68

1 INTRODUCTION

1.1. Fictional characters and IPR protection

Fictional characters, just like the stories they spring from, can be protected with different kinds of intellectual property rights (IPR), if certain conditions are met. But as some forms of IPR, like copyright, are designed to last only for a limited time and others, like trademarks, can be renewed indefinitely, the different kinds of protections might prevent fictional characters from ever entering the public domain – being free for all to use and build upon without having to get permission, which is exactly the reasoning behind restricted duration of copyright protection. Attempts to continue copyright protection with trademarks might thus violate the very essence of copyright protection, granting exclusivity but only for a limited time.

As many fictional characters can still be financially relevant or even profitable to their right holder after entering the public domain, i.e. the expiration of their limited, although already prolonged, term of copyright protection, it is natural that practically perpetual term of trademark protection starts to attract the attention of copyright right holders and even third parties. Because of this, several fictional characters from Amos 'n' Andy all the way to Zorro have already been a subject to trademark claims after their copyright protection has expired and they have entered the public domain.[1]

The trademark claims are understandable. Similar to copyright, trademark gives the owner an exclusive right to use and licence the protected right prohibiting unauthorized use of the original work and can even prevent others from creating entirely new derivative works leaning on existing fictional characters without the permission and a hefty licencing fee from the right holder. But can some well-known characters be protected for eternity – and should that even be possible?

Cases alleging infringement based on trademark protection on public domain characters has been brought to court, inter alia, by the Edgar Rice Burroughs, Inc., that holds the rights to the Tarzan and John Carter of Mars characters.[2] Most recent case dealing with trademarked fictional characters, which also gave a spark to write this thesis, covers however the character Zorro, originally created by pulp writer Johnston McCulley in 1919

[1] Silverman v. CBS Inc., 870 F.2d 40, 49 (2d Cir.), cert. denied, 492 U.S. 907 (1989), https://www.ravellaw.com/opinions/a30cb782e0747beb4843d5476d339d48 (accessed 29 April 2016).
[2] *Edgar Rice Burroughs, Inc.*, http://www.edgarriceburroughs.com/ (accessed 29 April 2016).

novel *The Curse of Capistrano*, later published as a book under the title *The Mark of Zorro*.[3] The European Union's Office for Harmonization in the Internal Market (OHIM), which have now changed its name to the EU Intellectual Property Office (EUIPO), declared Community Trade Mark (CTM) for ZORRO invalid because of the lack of distinctive character.[4] Trademark registration is necessary for providing legal certainty on that particular exclusive right, which helps e.g. claiming infringement and licencing the mark, but each trademark is registered only for certain goods and services on certain geographical area, so Zorro Productions, Inc., that claims to control "the worldwide trademarks and copyrights in the name, visual likeness and the character of Zorro", still has ongoing legal dispute concerning United States trademarks with Robert W. Cabell, author of *Z - the Musical of Zorro*, in California District Court.[5] The OHIM decision has also been appealed, so it is not yet final.[6]

As mentioned before, copyright protection lasts only for a limited time and with copyright terms for a lot of famous early twentieth century pop culture characters coming to an end, many right holder corporations have started to trademark their characters to get exclusivity even if the original content itself falls into the public domain.[7] For example, if Mickey Mouse enters the public domain in January 1, 2024 as planned, he is still protected with the trademarks registered by the Disney Enterprises, Inc.[8]

If public domain characters, as well as characters whose copyright protection has not yet expired, are all granted trademark protection at least in some jurisdiction, it will be much harder and more expensive to commercially make derivative works with old classic characters, even when the copyright protection eventually expires. And who wouldn't like to read a story about John Clayton, Don Diego de la Vega, and a certain famous rodent visiting a drinking establishment?

Because copyright laws are not uniform globally, some characters are already in public domain in Europe but not in the United States and vice versa. In this thesis I will focus on analysing the European Union *acquis communautaire* as well as some national cases on the subject and the comparison with the United States legislation and case law will

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[3] Sullivan 2013 and Beale 2005.
[4] OHIM Cancellation Division, Cancellation No 7924 C, Robert W. Cabell v. Zorro Productions Inc.
[5] *About Zorro Productions*, http://www.zorro.com/about/ (accessed 29 April 2016). See also Gardner 2015 and chapter 5.1.1.
[6] Correspondence for EUTM 005399787, https://euipo.europa.eu/eSearch/#details/trademarks/005399787 (accessed 29 April 2016).
[7] For copyright term durations, see chapter 3.1.
[8] Crockett 2016.

reflect the challenges of the current situation, especially if there is case law for same character on both jurisdictions. For instance the character Popeye entered the public domain in Europe 1 January 2009, 70 years after the author Elzie Segar's 1938 death, but because he was made as "work for hire"[9] and was first published in 1929, current US copyright law protects the character for 95 years after the initial copyright, until 2024.[10] The Hearst Corporation and its subsidiary King Features Syndicate, Inc., who hold the copyright to Popeye comics, also own several trademarks for POPEYE and protect their brand very aggressively.[11]

The European Union and the United States also have very different approaches to registering a trademark on a well-known fictional character as both EUIPO and the national European courts have declared several such registrations invalid but there are many valid trademarks on characters in the United States.[12] Because of the intrinsic differences between the European Union and Unites States, I have decided to exclude other possible jurisdictions from this thesis.

1.2. Research question and its limitations

The main research question for my thesis is to examine whether trademark protection can actually be used to protect fictional characters that have already fallen into the public domain because their copyright protection has expired. And if it can used, what are the requirements for the protection and are there some limitations to the protection? Should characters and right holders be granted trademark protection in the first place or could this preclude, or at least make it much harder and more expensive, to use certain old classic characters in new commercially relevant derivative works as copyright is designed to be in force for a limited time only?

Even though public domain can refer to expiration of any intellectual property rights, enabling the use without any permission, I will mainly deal the term with its application

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[9] See footnote 101.

[10] 'Popeye's copyright to expire in January', *The Telegraph*, 30 December 2008, http://www.telegraph.co.uk/culture/4017251/Popeyes-copyright-to-expire-in-January.html (accessed 29 April 2016).

[11] See e.g. AFC Enterprises, Inc. v. The Hearst Corporation et al, case number 1:11-cv-04150, District Court for the Northern District of Georgia, Atlanta Division, https://www.unitedstatescourts.org/federal/gand/179699/9-1.html, (accessed 29 April 2016).

[12] For EUIPO see e.g. footnote 4 and OHIM Board of Appeal decision of case no. R 1856/2013-2, Yves Fostier v. Disney Enterprises, Inc., 25 February 2015, "PINOCCHIO"; and for national examples see e.g. chapter 4.3.1.

to copyright, both for the title of this thesis and for the research itself. I will however quickly glance to the public domain of trademark on its own separate section because of some interesting articles on the subject and because it affects the trademark protection of characters.

For convenience, I will refer to registered right identifying the brand owner of a particular product or service as "trademark" regardless of country of origin and use "trade mark", i.e. two separate words, only when referring to certain official terms such as Community Trade Mark (CTM), European union trade mark (EUTM), or when quoting source using that form.[13]

It also important to notice that The Office for Harmonisation in the Internal Market (OHIM) was renamed as the EU Intellectual Property Office (EUIPO) as from 23 March 2016 according to Regulation (EU) No 2015/2424 of the European Parliament and the Council amending the Community trade mark regulation, published on 24 December 2015, and all CTMs and CTM applications became European Union trade marks (EUTM) and European Union trade mark applications on that date.[14] For the sake of clarity, I will refer to OHIM and CTMs when specifically discussing European Union cases decided before 23 March 2016.

1.3. Methodology and references

I have chosen legal dogmatics and the functional analysis of the comparative law as the main methodologies and theoretical background for this thesis, but because of the underlying economic reasons behind the trademark registrations of certain copyright protected fictional characters, I will also try to include law and economics features to my research.

I share Kaarlo Tuori's view on legal dogmatics mainly focusing on the interpretation and systematization of legislation and court decisions, so even though Raul Narits, professor of Comparative Jurisprudence of University of Tartu, sees dogmatics as "scientific processing of all legal material" conceptually and systematically evaluating also the

[13] "Trademark" is correct term in the United States and Philippines, but it is becoming more common in the United Kingdom and other English-speaking countries even though the more correct way to spell it in those countries would be "trade mark". Canada uses "trade-mark". See Ronkainen 2012.

[14] Office of Harmonization in the Internal Market (Trademarks and Designs), "EU Intellectual Property Office – new name for the EU's largest intellectual property agency", Press Release 24.12.2015.

underlying values, not just the law and its application, I will only focus on the latter two to gain understanding on the current legislative situation.[15]

Professor of European Private Law and academic director of the Maastricht European Private Law Institute (MEPLI) in Maastricht University, Jan M. Smits sees that it's important to deal only with the present law when using a doctrinal approach and refer to past legislation only as a part of this prevailing old system.[16] I will however also deal with *de lege ferenda* in addition to preferred *de lege lata* point of view. Applicable cases has been chosen either because of their general significance or because they especially deal with the researched topic, but I will try to concentrate on the *acquis* and US case law with only some representative national European examples. These national examples are primarily chosen because of the same character being subject to a litigation in different jurisdictions with different outcomes.

I will also employ the comparative law to support legal dogmatics in conducting research in this thesis. I have selected functional microcomparison that studies actual problems and their solutions rather than macrocomparison concentrating more on methods resolving and deciding legal problems.[17] And even though some legal scholars see functional legal analysis just like the one I am using as Eurocentric or North America centred, I see no problem as that is how I have chosen to limit the research anyway. [18] I will also acknowledge the five basic principles of comparative law method identified by John C. Reitz, Professor from the University of Iowa College of Law, as they might affect my research on the background.[19]

As it at least seems that the economic reasons have influenced the registration of specific characters as trademark, with all the licencing agreements and cease and desist letters flying around, I will try to include some law and economics approach to my thesis as well - especially because some law and economics scholars have suggested indefinitely renewable copyright, which would undermine the need to circumvent public domain with trademark protection entirely.[20] Behavioural theory predicting how people respond to legal notices or evaluate the risks of possibility of unlicensed use can also be seen as relevant in situation where the trademark registration isn't always made in good faith or

[15] Tuori 2006 p. 1 and Narits 2007 p. 19.
[16] Smits 2015 p. 7.
[17] Zweigert–Köntz 1998 p. 5 and 34.
[18] Husa 2007 p. 4-5.
[19] Reitz 1998 p. 618-627.
[20] Landes–Posner 2002 p. 41.

the legal basis for the protection is uncertain.[21] It is however important to understand that intellectual property law shouldn't be seen just as a sole determinant of economic activity but as one of the many determinants of economic activities on the creative sectors of economy.[22]

I have tried to include all the relevant legal articles on the subject as references as long as they offer something new to the research. Because some of the cases I have chosen to include, such as the United States branch of the ZORRO trademark dispute with Zorro Productions, Inc. and Robert W. Cabell, are explained only in articles from entertainment magazines or websites, I have decided to use also some more unconventional sources in addition to traditional legal references. The arguments and decisions of such cases are however taken from the original case text whenever possible.

1.4. Outline of this thesis

Thesis starts with a quick overview on copyright and especially on copyrightability requirements for fictional characters both in the United States and in the European Union (chapter 2). This is done via both relevant case law and legislation.

As copyright protection of character will eventually expire, I will deal with public domain in next chapter (chapter 3). As mentioned before, I will focus on the public domain resulting from the expiration of the term of copyright, but will dip into the public domain of trademark as well.

Even though the characters enter the public domain, as presented in chapter 3, they may still be captured by the trademark protection and the main chapter of this thesis (chapter 4) focuses on that. I will write about the requirements for the protection as well as some landmark cases redefining these requirements such as the Supreme Court's *Dastar* ruling and Ninth Circuit Court of Appeals' ruling in *Comedy III* in the United States and similarly some decision made by EUIPO officials.[23] I will focus especially on the requirements for the trademarks originating from fictional characters, both from

[21] Cooter–Ulen 2007 p. 4.
[22] Merges 2014 p. 4.
[23] Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003), https://supreme.justia.com/cases/federal/us/539/23/case.html (accessed 29 April 2016); Comedy III Productions, Inc. v. New Line Cinema, 200 F. 3d 593 (9th Cir. 2000), https://www.law.cornell.edu/copyright/cases/200_F3d_593.htm (accessed 29 April 2016).

characters still protected by copyright and characters that have already fell into the public domain.

The next chapter (chapter 5) looks to the future. As a plethora of famous characters is entering the public domain in the upcoming years, the possibility to prolong the exclusive right to the character with a carefully executed trademark registration will definitely gain the right holders' attention. I will especially cover the case of Disney's Mickey Mouse. This chapter will slightly overlap with the final, concluding chapter (chapter 6) that will compile the findings of this thesis, showing that the problems presented here might not be so crucial after all or can at least be fixed.

2 COPYRIGHT PROTECTION OF CHARACTERS

2.1. Copyright in general

Copyright protection grants the creator of an original work an exclusive right to reproduce and distribute that work, or license others to reproduce and distribute it, for a limited time. The Berne Convention administered by the World Intellectual Property Organization (WIPO) sets a minimum sets of standards for the protection of the rights of the creators of copyrighted works in the 169 contracting parties of the Convention.[24] According to the Convention, protection of authors includes "every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression" without any formality requirements.[25] On the other hand, the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), administered by the World Trade Organization (WTO), includes a number of provisions related to the enforcement of intellectual property rights.[26]

All countries in Europe have their own national laws on copyright, even though the European Union has tried to harmonize the union legislation with a number of regulations such as the 2001 InfoSoc Directive and the 2004 Enforcement Directive.[27] The Finnish Copyright Act, for example, states that "[a] person who has created a literary or artistic work shall have copyright therein, whether it be a fictional or descriptive representation in writing or speech, a musical or dramatic work, a cinematographic work, a photographic work or other work of fine art, a product of architecture, artistic handicraft, industrial art, or expressed in some other manner".[28]

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[24] WIPO-Administered Treaties, Contracting Parties, Berne Convention, http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=15 (accessed 29 April 2016).

[25] Article 2 of Berne Convention for the Protection of Literary and Artistic Works, as amended on September 28, 1979, http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=283698#P85_10661 (accessed 29 April 2016).

[26] Agreement on Trade-Related Aspects of Intellectual Property Rights, World Trade Organization, https://www.wto.org/english/tratop_e/trips_e/t_agm0_e.htm (accessed 29 April 2016).

[27] Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society, http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32001L0029&from=EN (accessed 29 April 2016); and Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32004L0048R(01)&from=EN (accessed 29 April 2016).

[28] Section 1 of the Copyright Act (404/1961), unofficial translation by the Ministry of Education and Culture, http://www.finlex.fi/fi/laki/kaannokset/1961/en19610404.pdf (accessed 29 April 2016).

Across the Atlantic Sea, Article I, Section 8, Clause 8 of the United States Constitution empowers the United States Congress 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".[29] Congress has expressed this power in federal copyright law providing exclusive rights to "original works of authorship fixed in any tangible medium of expression".[30] The US copyright law has been amended several times, but amendments relevant to this study are the Copyright Act of 1909, the Copyright Act of 1976, the Copyright Renewal Act of 1992, and the Copyright Term Extension Act (CTEA) of 1998.[31]

2.2. Copyrightability of characters in the United States

Fictional characters are protected as component parts of the copyrightable works, e.g. literary characters as elements of the stories in which they appear, but some characters can themselves be copyrightable, provided that they are original and included in a larger copyrighted work. And the original expression of a character contributed to a copyrighted work doesn't need to be separable from the work as a whole as long as it has "some original expression" - it can even be made by a co-author if it is independently copyrightable.[32] In the United States case law originality is even considered as a "constitutional requirement", or "indispensable prerequisite", for copyrightability, but as characters may also represent concepts rather than just be expressions of the work, they may sometimes be problematic to protect with copyright.[33]

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[29] Article I of the United States Constitution, https://www.law.cornell.edu/constitution/articlei#section8 (accessed 29 April 2016).

[30] 17 U.S. Code § 102 - Subject matter of copyright: In general, https://www.law.cornell.edu/uscode/text/17/102 (accessed 29 April 2016).

[31] An Act to Amend and Consolidate the Acts Representing Copyright, Pub.L. 60–349 (1 July 1909), http://www.legisworks.org/congress/60/publaw-349.pdf (accessed 29 April 2016); an Act for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes, Pub. L. 94-553 (Oct. 19, 1976), http://copyright.gov/history/pl94-553.pdf (accessed 29 April 2016); an Act to amend title 17, United States Code, the copyright renewal provisions, and for other purposes, Pub.L. 102–307 (26 June 1992), http://uscode.house.gov/statutes/pl/102/307.pdf (accessed 29 April 2016); and an Act to amend the provisions of title 17, United States Code, with respect to the duration of copyright, and for other purposes, Pub.L. 105–298 (27 October 1998), https://www.gpo.gov/fdsys/pkg/PLAW-105publ298/html/PLAW-105publ298.htm (accessed 29 April 2016).

[32] Gaiman v. MacFarlane, 360 F.3d 644, 658 (7th Cir. 2004), https://casetext.com/case/gaiman-v-mcfarlane (accessed 29 April 2016). This case dealt with a joint ownership of the characters Angela, Count Nicholas Cogliostro, and Medieval Spawn in McFarlane's *Spawn* comics.

[33] Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991), https://supreme.justia.com/cases/federal/us/499/340/case.html (accessed 29 April 2016); and North Coast Industries v. Jason Maxwell, Inc., 972 F.2d 1031 (9th Cir. 1992), http://law.justia.com/cases/federal/appellate-courts/F2/972/1031/178471/ (accessed 29 April 2016).

2.2.1. Tests determining whether characters merit copyright protection

Only characters that are described sufficiently distinctively and have consistent identifiable traits qualify for copyright protection separate from the works in which they appear. Judge Learned Hand stated in case *Nichols v. Universal Pictures Corp.* that "the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctively" – fictional characters must thus be sufficiently delineated to be merited a copyright protection.[34] This test of fictional characters being "sufficiently delineated" has often been cited by US courts, also by Judge Hand himself in the Second Circuit panel in *Detective Comics*, to determine whether a character can be entitled to a level of protection.[35] Several other US courts have also held, inter alia, characters like Tarzan[36], Freddy Krueger and his glove[37], Jonathan Livingston Seagull[38], and even the Batmobile[39] as sufficiently delineated to merit copyright protection according to these same standards.[40]

Another oft-cited test to determine copyrightability of characters is the "story being told" test originating from the Ninth Circuit case in 1954 covering the character of Sam Spade from *The Maltese Falcon* stories. In this case Circuit Judge Stevens concluded that characters are within the area of the protection afforded by the copyright if they "really constitute the story being told" rather than being "only the chessman in the game of

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[34] Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930) p. 3, http://cyber.law.harvard.edu/people/tfisher/IP/1930%20Nichols.pdf (accessed 29 April 2016).

[35] Detective Comics, Inc. v. Bruns Publications, Inc., 111 F.2d 432 (2d Cir. 1940) https://casetext.com/case/detective-comics-v-bruns-publications (accessed 29 April 2016). This case dealt with a Bruns Publications character Wonderman infringing the expression of Superman, but Superman has also been a subject of infringement cases including Captain Marvel (National Comics Publications v. Fawcett Publications, 191 F.2d 594 (2d Cir. 1951), http://law.justia.com/cases/federal/appellate-courts/F2/191/594/91314/ (accessed in 29 April 2016), infringement found); and The Greatest American Hero (Warner Bros. Inc. v. American Broadcasting Companies, Inc., 720 F.2d 231 (2d Cir. 1983), https://www.law.cornell.edu/copyright/cases/720_F2d_231.htm (accessed in 29 April 2016), DC Comics' claims dismissed), inter alia. See also Schreyer 2015 p. 58.

[36] Burroughs v. Metro-Goldwyn-Mayer, Inc., 519 F. Supp. 388, 391 (S.D.N.Y. 1981), http://law.justia.com/cases/federal/district-courts/FSupp/519/388/1426704/ (accessed 29 April 2016).

[37] New Line Cinema Corp. v. Easter Unlimited, Inc., 1989 U.S. Dist. LEXIS 17340 (E.D.N.Y. 19 July 1989) (Freddy Krueger) and New Line Cinema Corp. v. Russ Berrie & Co., 161 F. Supp. 2d 293 (S.D.N.Y. 2001), http://law.justia.com/cases/federal/district-courts/FSupp2/161/293/2388504/ (accessed 29 April 2016) (Freddy Glove).

[38] Bach v. Forever Living Prods. U.S., Inc., 473 F. Supp. 2d 1127, 1136 (W.D. Wash. 2007), https://casetext.com/case/bach-v-forever-living-products-us-2 (accessed 29 April 2016).

[39] DC Comics v. Towle, 802 F.3d 1012 (9th Cir. 2015), cert. denied, 577 U.S. --- (2016), http://www.frosszelnick.com/sites/default/files/cases_pdf/13-55484.pdf (accessed 29 April 2016).

[40] Rosenblatt 2015 p. 575.

telling the story". The Ninth Court concluded that he characters were merely vehicles for *The Maltese Falcon* story being told.[41]

2.2.2. Application of the copyrightability tests

Several courts have declined to use the "story being told" test and it is criticized for potentially relating a vast majority of fictional characters to the public domain.[42] Even the Ninth Circuit itself has later significantly limited the scope of the "story being told" test introduced in *Warner Bros* as it acknowledged in the *Air Pirates* case, concerning Mickey Mouse, that its previous decision "lends some support to the position that characters ordinarily are not copyrightable" and explains that when an author adds a visual image to a literary character, giving it "physical as well as conceptual qualities", the character is more likely to contain some unique elements of expression.[43] Thus "story being told" test shouldn't be used to visual characters and the defendants' use of Disney's famous graphic characters in underground magazines placing them in "adult" situations in *Air Pirates* constituted a copyright infringement.[44]

Later the Ninth Circuit addressed the impact of its *Air Pirates* decision on the "story being told" test in the *Olson* case where it stated that copyright protection could be afforded to characters visually depicted in a television series or in a movie - reaffirming the distinction between visual characters and purely literary characters - and that "cases subsequent to Warner Brothers have allowed copyright protection for characters who are especially distinctive".[45] The court however explicitly declined the opportunity to "resolve the issue left open in Air Pirates --- whether the Warner Bros. statements should be considered dicta" and therefore didn't overrule the test introduced in *Warner Bros*, referring to the "sufficiently delineated" test as merely one of the "more lenient standards adopted elsewhere".[46] The Ninth Circuit has however later observed both tests in *Rice v.*

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[41] Warner Bros. Pictures v. Columbia Broadcasting System, 216 F.2d 945, 950 (9th Cir. 1954), https://casetext.com/case/warner-bros-pictures-v-columbia-broadcasting (accessed 29 April 2016).
[42] Foley 2009 p. 929-930 and Schreyer 2015 p. 59.
[43] Walt Disney Productions v. Air Pirates, 581 F.2d 751, 754 (9th Cir. 1978), https://casetext.com/case/walt-disney-productions-v-air-pirates-2 (accessed 29 April 2016).
[44] Foley 2009 p. 930-931 and Schreyer 2015 p. 61.
[45] Olson v. National Broadcasting Co., 855 F.2d 1446, 1451-52 n.6 (9th Cir. 1988), http://openjurist.org/855/f2d/1446/olson-v-national-broadcasting-company-inc-mca-and-mca-olson (accessed 29 February 2016). The plaintiff Olson alleged that the characters of the NBC television series *The A-Team* infringed his copyright in the characters of a pilot television script *Cargo*, but the Ninth Circuit found that the characters of *Cargo* failed to qualify for copyright protection under both the "story being told" test and the "sufficiently delineated" test.
[46] Foley 2009 p. 931.

Fox Broadcasting Co. where it stated that "especially distinctive" characters or the "story being told" receive protection apart from the copyrighted work.[47]

The US District Court for the Central District of California has also relied on both "sufficiently delineated" and "story being told" tests on several occasions such as *Anderson v. Stallone*, where it found that the characters Rocky, Adrian, Apollo Creed, Clubber Lang, and Paulie "are one of the most *highly delineated* group of characters in modern American cinema" (emphasis added) and "constituted the story being told".[48] Similarly in *MetroGoldwyn-Mayer v. American Honda*, the District Court found that James Bond character was a copyrightable character under both the "story being told" and the "character delineation" tests.[49] In the latter case the court held that Honda's advertisements copied certain spy thriller elements stemming from MGM's *James Bond* movies rather than the original character from Ian Fleming's novels, meaning that the public's best-known version of James Bond, a movie character, had a copyright separate from the original novels.[50]

2.2.3. Special cases

The US courts seem to make a distinction between the copyrightability of sheer literary characters and characters also depicted graphically or visually, e.g. in comic books, television, or film. Latter usually involve pictorial as well as textual expression, making it easier for the character to be sufficiently delineated rather than leaving the details of the character's appearance as abstract mental images in a prose depiction.[51] Literary characters may however later become graphically or visually depicted characters when portrayed in comic books, theatre stage or audiovisual works.[52]

Aforementioned *Batmobile* case is extremely interesting as the Ninth Circuit found Batmobile "sufficiently delineated" to merit copyright protection regardless of

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[47] Rice v. Fox Broadcasting Co., 330 F.3d 1170 (9th Cir. 2003), http://law.justia.com/cases/federal/appellate-courts/F3/330/1170/565152/ (accessed 29 April 2016).
[48] Anderson, 11 U.S.P.Q.2d, http://www.kentlaw.edu/faculty/rwarner/classes/legalaspects_ukraine/copyright/cases/anderson_v_stallone.html (accessed 29 April 2016).
[49] MGM, Inc. v. American Honda Motor Co., Inc., 900 F.Supp. 1287 (1995), http://cyber.law.harvard.edu/people/tfisher/IP/1995%20MGM%20Abridged.pdf (accessed 29 April 2016).
[50] Rosenblatt 2015 p. 589.
[51] Kurtz 1994 p. 438–439.
[52] Kurtz 1994 p. 439.

defendant's argument that Batmobile is merely a car.[53] The Ninth Circuit had however already extended the copyright protection to automotive characters in *Halicki,* where it reviewed, but did not resolve (as it remanded the case back to District Court), whether or not the character Eleanor, a car that appeared as a 1971 Fastback Ford Mustang in the 1974 film *Gone in 60 Seconds* and as a 1967 Shelby GT-500 in 2000 film by Walt Disney Production, was entitled to copyright protection.[54] The Ninth Circuit noted that the Eleanor character could be seen as more akin to a comic book character than a literary character and that Eleanor displays "consistent, widely identifiable traits" because in both films, the movie characters have difficulty stealing that particular car.[55]

In *Batmobile* case the District Court had already noted that even though "the Batmobile is not identical in every comic book, film, or television show", its name and widely identifiable key characteristics have remained consistent.[56] The lower court also found that the Batmobile is entitled to copyright protection as a "pictorial, graphic, and sculptural work" regardless that the replicas defendant manufactures may be "useful articles" as cars because its incarnations were "entirely distinguishable from an ordinary automobile".[57] After the affirmative decision of the Ninth Circuit, the United States Supreme Court denied defendant's petition for certiorari on 7 March 2016.[58]

2.2.4. Boundaries of copyright protection

It is important to notice that publishing a sequel or other work with same copyrightable elements cannot elongate copyright protection for the elements of the original work. Authors or right holders cannot thus maintain eternal copyright protection to a character simply by producing new works featuring that character.[59] For example in *Siegel v. Warner Bros* the District Court for the Central District of California explained that "the

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[53] DC Comics v. Towle, 802 F.3d 1012 (9th Cir. 2015), cert. denied, 577 U.S. --- (2016), http://www.frosszelnick.com/sites/default/files/cases_pdf/13-55484.pdf (accessed 29 April 2016).
[54] Halicki Films, LLC v. Sanderson Sales & Marketing, 547 F 3d (9th Cir 2008), https://casetext.com/case/halicki-films-v-sanderson (accessed 29 April 2016).
[55] Ibid.
[56] DC Comics v. Towle, 989 F. Supp. 2d 948, 965 (C.D. Cal. 2013), http://www.americanbar.org/content/dam/aba/administrative/litigation/materials/2015_intellectual_property_lit/materials/dc_comicsv_towle.authcheckdam.pdf (accessed 29 April 2016). See also Schonhofen 2016 p. 13.
[57] Ibid.
[58] Weinberger, James D. et al., 'DC Comics v. Towle', *Fross Zelnick Lehrman & Zissu, P.C.*, http://www.frosszelnick.com/dc-comics-v-towle (accessed 29 April 2016). James D. Weinberger, Roger L. Zissu, and Leo Kittay of Fross Zelnick Lehrman & Zissu, P.C. represented DC Comics in the case.
[59] Rosenblatt 2015 p. 580.

copyrightable aspects of a character --- are protected only to the extent the work in which that particular aspect of the character was first delineated remains protected, but not in the subsequent sequels in which that attribute is later repeated or used".[60] Similarly the District Court for the Southern District of New York allowed toymaker Mattel to replicate Conan the Barbarian in *Conan Properties v. Mattel* even though the newer works featuring the character remained protected.[61]

In *Silverman v. CBS* the Second Circuit held that the Amos 'n' Andy characters were in the public domain since copyright had expired on early episodes of the radio show and "CBS copyrights in the post-1948 radio scripts programs, and whatever rights it may have in the television scripts and programs --- provide protection only for the increments of expression beyond what is contained in the pre-1948 radio scripts, which are in the public domain".[62] Thus plaintiff Silverman was not entitled to use any further delineations of the public domain characters contained in any script or program still protected by copyright for his Broadway musical comedy script.[63]

The term of copyright protection of the character elongating from derivative works based on the character was also the case in *Leslie Klinger v. Conan Doyle Estate, Ltd.* concerning the character Sherlock Holmes invented by Sir Arthur Conan Doyle.[64] In this case the United States Court of Appeals for the Seventh Circuit held that the alterations made to the characters of Holmes and Dr. Watson in Conan Doyle's later, derivative works, such as Holmes's changed attitude toward dogs and Watson's two marriages, do not revive the expired copyrights on the characters with elements appearing in the original public domain stories.[65] Thus the plaintiff obtained a declaratory judgment

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[60] Siegel v. Warner Bros. Entm't, 690 F. Supp. 2d 1048, 1058–59 (C.D. Cal. 2009), http://www.plainsite.org/dockets/24ddxffcm/california-central-district-court/siegel-v-warner-bros-entertainment-inc/ (accessed 29 April 2016). This case concerned the contractual arrangements surrounding the published works of Superman and protected elements of the character.

[61] Conan Props. v. Mattel, Inc., 712 F. Supp. 353, 357–61 (S.D.N.Y. 1989), http://law.justia.com/cases/federal/district-courts/FSupp/712/353/1475694/ (accessed 29 April 2016).

[62] See footnote 1 and Rosenblatt 2015 p. 580.

[63] Kurtz 1994 p. 447.

[64] Leslie Klinger v. Conan Doyle Estate, Ltd., 755 F.3d 496 (7th Cir. 2014) https://casetext.com/case/klinger-v-conan-doyle-estate-ltd (accessed in 29 April 2016). The ownership of copyright to the character Sherlock Holmes has also been a subject of litigation in Plunket v. Doyle, 2001 WL 175252 (S.D.N.Y. 2001); Pannonia Farms, Inc. v. USA Cable, 426 F. 3d 650 (2d Cir. 2005) (http://caselaw.findlaw.com/us-2nd-circuit/1254762.html, accessed 29 April 2016); and Pannonia Farms, Inc. v. Re/Max International, 407 F. Supp. 2d 41 (D.D.C. 2005) (https://www.courtlistener.com/opinion/2357362/pannonia-farms-inc-v-remax-intern-inc/, accessed 29 April 2016).

[65] Rosenblatt 2015 p. 582-583. As a curiosity, in *Nash v. CBS, Inc.*, the United States Court of Appeals for the Seventh Circuit stated that the "inventor of Sherlock Holmes controls that Character's fate while the copyright lasts" even though the case was about television series episode hinting that John Dillinger survived

allowing him to use material in the first 50 of Sherlock Holmes Canonical stories no longer protected by the copyright while the "story elements" that appear exclusively in last ten of the Conan Doyle's stories remain protected by copyright and can be licenced.[66]

Traditionally the Conan Doyle Estate, Ltd., (CDE) has tried to prohibit any use of the characters of Holmes and Watson as well as Mrs. Hudson, Professor Moriarty, and others from the Canon in any derivative work without paying a license. In *Klinger* the Seventh Circuit opinion affirmed that as long as authors avoid using elements appearing exclusively in the copyrighted stories, such vigorous demands are contrary to law.[67] The court stated that spectre of nearly perpetual copyright looms once one realizes that the CDE was seeking 135 years of copyright protection for the character depicted in the first Sherlock Holmes story in 1887.[68] It is also important to bear in mind that all 60 of the Canonical Sherlock Holmes stories have been in public domain outside the Unites States for some time now since Arthur Conan Doyle died 86 years ago.[69]

2.3. Copyrightability of characters in Europe

Fictional character can be protected under copyright law in Europe if it is an original expression of an author. Fictional characters are however not protected directly and explicitly in the European Union legislation as the protection derives indirectly either as an 'artistic work' or as a literary work. The legislation leaves room for the courts to judge every case separately, but European Union case law has been quite scarce when compared to the United States.

2.3.1. Copyrightability of characters in the United Kingdom

Traditionally the copyrightability of fictional characters in the United Kingdom, which is a common law country, has been very limited, which can be seen in *Kelly v. Cinema Houses Ltd,* where Justice Maugham of the High Court of Justice (Chancery Division) stated that even fictional characters such as Falstaff, Tartuffe, or Sherlock Holmes would probably not attract copyright protection.[70] Lord Justice May agreed that there is no

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the shooting outside the Biograph, a theory also proposed in plaintiff's books. Nash v. CBS, Inc., 899 F.2d 1537, 1541 (7th Cir. 1990), https://casetext.com/case/nash-v-cbs-inc-3, accessed 29 April 2016.

[66] Leslie Klinger v. Conan Doyle Estate, Ltd., 755 F.3d 500 (7th Cir. 2014). See also Rosenblatt 2015 p. 583.

[67] Ibid.

[68] Leslie Klinger v. Conan Doyle Estate, Ltd., 755 F.3d 503 (7th Cir. 2014).

[69] Leslie Klinger v. Conan Doyle Estate, Ltd., 755 F.3d 501 (7th Cir. 2014).

[70] Kelly v. Cinema Houses Ltd [1928-35]. See Kamina 2002 p. 103-104 and McCutcheon 2007 p. 141-142.

copyright in fictional characters in *O'Neill v. Paramount Pictures Corp* and more recently Justice Vinelott of the Chancery Division held that the claim to copyright in the characters of Sherlock Holmes and Dr Watson was unjustifiable in English law due to the lack of recognition of such a concept, affirming the traditional negative view on copyright of literary fictional characters.[71]

Cartoon characters, however, can be awarded protection as drawings. This was the case in *King Features Syndicate Inc. v. O & M Kleeman Ltd*, where the defendants had produced merchandise materials resembling the character Popeye.[72] The House of Lords stated in this case that the defendants' reproduction based on a number of drawings of the character, albeit indirectly, was an infringement of the artistic copyright in those drawings and therefore of the character.[73] The courts and academic writers in England have however chosen to view the *King Features Syndicate Inc.* case only restricted to its facts, determining that English law will still recognise copyright in fictional characters only if they exist as artistic works.[74]

In *Mirage Studios v. Counter-Feat Clothing Company Ltd* Vice-Chancellor Browne-Wilkinson granted the plaintiff an interlocutory injunction even though the defendants' drawings of humanoid turtle characters were not direct copies of the plaintiff's drawings of Teenage Mutants Ninja Turtles.[75] The reproduction of the concept of a humanoid turtle had however damaged the plaintiff's goodwill in his licensing business and thus the injunction was primarily based on the law of passing off.[76] In *Bolton v. British International Pictures Ltd* the court held that reuse of two comic telephone repairmen stage characters in a later play constituted an infringement.[77] The British Broadcasting Company, on the other hand, failed to obtain summary judgment on its claim for copyright infringement on T-shirts depicting the Teletubbies characters in *BBC*

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[71] O'Neill v.Paramount Pictures Corp. [1983] CAT 235, see Kamina 2002 p. 103.
Tyburn Productions Ltd v Conan Doyle [1991] Ch. 75, http://swarb.co.uk/tyburn-productions-ltd-v-conan-doyle-chd-1990-2/ (accessed 29 April 2016).
[72] King Features Syndicate Inc. v. O & M Kleeman Ltd [1941] AC 417, HL, http://swarb.co.uk/king-features-syndicate-inc-v-o-and-m-kleeman-ltd-hl-1941/ (accessed 29 April 2016).
[73] Erickson et al. 2015 p. 17. See also Turner–Lewis 2008.
[74] Turner–Lewis 2008.
[75] Mirage Studios v. Counter-Feat Clothing Company Ltd, [1991] FSR 145.
[76] Preiss 2013 p. 2.
[77] Bolton v. British International Pictures Ltd [1936], see Kamina 2002 p. 31.

Worldwide Ltd v. Pally Screen Printing Ltd so the copyrightability of fictional characters in the United Kingdom is still quite unclear.[78]

2.3.2. Copyrightability of characters in continental Europe

In France characters from an audiovisual work are undoubtedly copyrightable independently from the copyright of their original work and this relates to both cartoon or otherwise drawn characters as well as characters from a novel or a script.[79] Similar applications has also been seen in Belgium, Finland, and several other European civil law countries. [80]

In Germany the Federal Court of Justice (Bundesgerichtshof, BGH) has found in the *Alcolix* and *Asterix Persiflagen* cases that the graphically portrayed characters, such as comic characters Asterix and Obelix, are copyright protected.[81] In *Alcolix* the parodying characters Alcolix and Obenix were found infringing as they had several similar visual and behavioural features than the original characters by Albert Uderzo and René Goscinny, causing attenuation of Asterix and Obelix.[82] The *Asterix Persiflagen* had some distinctions but the applied injunction was nevertheless affirmed.[83]

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[78] Erickson et al. 2015 p. 17. BBC Worldwide Ltd v Pally Screen Printing Ltd [1998] FSR 665, see Preiss 2013 p. 4. See also Mitchell v. British Broadcasting Corporation (BBC) [2011] EWPCC 42 (21 December 2011) (http://www.bailii.org/ew/cases/EWPCC/2011/42.html, accessed 29 April 2016), where the Patents County Court concluded that BBC's Kerwhizz characters did not infringe Mr Mitchell's Bounce Bunch characters.

[79] Kamina 2002 p. 104. For cartoon and otherwise drawn characters see eg. Paris Court of Appeal, 4th chamber, 2 December 1990 (Dalloz 1991, 532 or Revue Internationale du Droit d'Auteur, January 1992, 295) (Tintin); Paris Court of Appeal, 9 January 1986, *Juris-Data*, No. 020012 (Maya the Bee); Paris Court of Appeal, 14 February 1980 (the Pink Panther); and Rennes Court of Appeal, 16 October 1984 (ET). Also cases concerning Donald Duck and Felix the Cat. For characters from novel or script see Tribunal of First Instance of Paris, 21 January 1977 and 22 March 1978 (Dalloz 1979 p. 99) (Tarzan).

[80] Kamina 2002 p. 104. For Belgium see Tribunal of First Instance of Brussels, 15 February 1996 (Tintin); Tribunal of First Instance of Brussels, 17 October 1996 (Blake and Mortimer); and Brussels Court of Appeal, 24 March 1994 (Lucky Luke). For Finland see Opinion 2006:16 of the Copyright Council, 13.10.2006, http://www.minedu.fi/export/sites/default/OPM/Tekijaenoikeus/tekijaenoikeusneuvosto/tekijaenoikeusneuvoston_lausunnot/2006/liitteet/TN_2006-16.pdf (accessed 29 April 2016). Alternatively the Copyright Council found in its opinion 1993:25 that Laurel and Hardy characters were not original and independent enough to be copyright protected. (http://www.minedu.fi/export/sites/default/OPM/Tekijaenoikeus/tekijaenoikeusneuvosto/tekijaenoikeusneuvoston_lausunnot/1993/Liitteet/TN_1993-25.pdf, accessed 29 April 2016)

[81] Geller 2010 p. 558.

[82] Bundesgerichtshof, 11 March 1993, I ZR 263/91, https://www.jurion.de/Urteile/BGH/1993-03-11/I-ZR-263_91 (accessed 29 April 2016). See also Geller 2010 p. 558.

[83] Bundesgerichtshof, 11 March 1993, I ZR 264/91, https://www.jurion.de/Urteile/BGH/1993-03-11/I-ZR-264_91 (accessed 29 April 2016). See also Geller 2010 p. 558.

On the other hand the BGH had earlier declined copyright protection of the character of Sherlock Holmes and have also later decided that super market chain could advertise and sell costumes featuring some external characteristics of the image of literary figure Pippi Longstocking, or Pippi Langstrumpf as she is known in Germany, without the consent of the right holder as long as the character as a whole wasn't exploited.[84] I will return to the matter of copyrightable features of characters later on.

2.4. Fair use

Even if the copyright protection is still in force, some works can be used without permission from the author if the use fulfils certain prerequisites. This broadens the possibilities to make good use of fictional characters, but doesn't solve all the problems stemming from the use of different intellectual property protections.

In the United States, the *fair use* doctrine states that the use of copyrighted work, including characters, "for purposes such as criticism, comment, news reporting, teaching, scholarship, or research" is not an infringement of copyright even if the copyright holders might not be willing to license or approve it.[85] According to the 17 U.S. Code § 107, the US Courts should consider the following four factors when determining whether the use of a work in any particular case is fair or not; 1) "the purpose and character of the use", including whether the use is commercial or for non-profit educational purposes; 2) "the nature of the copyrighted work"; 3) "the amount and substantiality of the portion used in relation to the copyrighted work as a whole"; and 4) "the effect of the use upon the potential market for or value of the copyrighted work".[86]

Predicting whether the use of copyrighted work is deemed as fair or not is difficult because of the multiple factors and thus the adapter may face a risk of litigation.[87] The *fair use* case law is also rather varying as *The Wind Done Gone* was considered as fair use of *Gone With The Wind's* characters, story lines, and settings, but later the *60 Years*

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[84] Bundesgerichtshof, 15 November 1957, I ZR 83/56, https://www.jurion.de/Urteile/BGH/1957-11-15/I-ZR-83_56 (accessed 29 April 2016); and Bundesgerichtshof, 17 July 2013, I ZR 52/12, https://openjur.de/u/669060.html (accessed 29 April 2016). See also Geller 2010 p. 558.
[85] 17 U.S. Code § 107 - Limitations on exclusive rights: Fair use, https://www.law.cornell.edu/uscode/text/17/107 (accessed 29 April 2016).
[86] 17 U.S. Code § 107. See also Rosenblatt 2015 p. 590.
[87] Rosenblatt 2015 p. 590-591.

Later: Coming Through the Rye was found infringing of the copyright in J.D. Salinger's *The Catcher in the Rye*.[88]

The United Kingdom law has a doctrine called *fair dealing*, governed by Sections 29 and 30 of Copyright, Designs and Patents Act 1988, that provides similar exception than the US *fair use* doctrine.[89] *Fair dealing* enables the unlicensed use of a copyrighted work, provided that it is accompanied by a sufficient acknowledgement, in non-commercial research or private study, for criticism or review, for the purpose of reporting current events, or for the purpose of caricature, parody or pastiche.[90]

Civil law jurisdictions in the European Union doesn't usually have doctrines like *fair use* or *fair dealing*, but they do have other limitations and exceptions to the exclusive copyright. [91] These exceptions and limitations, as well as similar doctrines in the common law jurisdiction, are however subject to a three-step test that was initially set out in the Berne Convention but has been transplanted into the TRIPS as well as number of other international agreements. The Berne Convention states that an exception or limitation to the exclusive right of authorizing the reproduction a copyrighted work is permissible only "in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author".[92]

It is important to note that the *fair use* or *fair dealing* doctrines or other limitations and exceptions to copyright protection doesn't usually legitimize the commercial derivative use of an existing copyrighted character or other work nor apply to a situation where the copyright protection of the work has expired and the character has entered the public

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[88] Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001), https://casetext.com/case/suntrust-bank-v-houghton-mifflin-co-4 (accessed 29 April 2016). Salinger v. Colting, 607 F.3d 68 (2d Cir. 2010), http://cyber.law.harvard.edu/people/tfisher/IP/2010_Salinger.pdf (accessed 29 April 2016).

[89] Copyright, Designs and Patents Act 1988, http://www.legislation.gov.uk/ukpga/1988/48/part/I/chapter/III/crossheading/general (accessed 29 April 2016).

[90] Ibid.

[91] With the exception of Poland, which has a system of free private use. See Act on Copyright and Related Rights of 4 February 1994 articles 23 to 35, Journal of Laws of 1994, No. 24, Item 83, http://portal.unesco.org/culture/en/files/30304/11420011803pl_copyright_2005_en.pdf/pl_copyright_2005_en.pdf (accessed 29 April 2016).

[92] Article 9 of Berne Convention for the Protection of Literary and Artistic Works, as amended on September 28, 1979, http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=283698#P140_25350 (accessed 29 April 2016).

domain. Because of this they, in my opinion, offer no help to cases where a trademark is used to protect a character, regardless of validity of copyright protecting that character.

This was seen in *Original Appalachia Artworks Inc. v. Topps Chewing Gum, Inc.*, where the United States District Court for the Northern District of Georgia held that use of Garbage Pail Kids tarnished the marks associated with *Cabbage Patch Kids* products, despite of defendant's fair use defence.[93] Even if the court had determined that the defendant's use constituted permissible fair use under copyright, an injunction would nevertheless have been issued based on the finding of a likelihood of confusion and thus trademark infringement.[94]

There are also separate *fair use* doctrines for trademarks, but more on those later in chapter 4.4.

[93] Original Appalachia Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 1034, 1036 (N.D. Ga. 1986), http://law.justia.com/cases/federal/district-courts/FSupp/642/1031/2398262/ (accessed 29 April 2016).
[94] Foley 2009 p. 953-954.

3 PUBLIC DOMAIN

3.1. Public domain in copyright law

Public domain can be portrayed as the basis for art, science, and self-understanding, from which we make new inventions and create new cultural works.[95] It is something we can freely utilize without asking anyone's permission. And just like other cultural works, characters can also be used to create new works after they have entered the public domain. And these new works can eventually be exploited to create more new works, carrying on the cultural continuum.

Works in the public domain are those that doesn't fulfil the requirements for intellectual property rights, whose exclusive rights have expired, or whose author or right holder has decided to waive his/her exclusive rights. Usually public domain can refer to non-existence, expiration, or waiver of any intellectual property rights, but in this thesis I will focus on copyright and trademarks.

As stated before, copyright protection has its limitations and lasts only for a certain period of time. Copyright law encourages authors to produce original works by affording them an exclusive copyright protection, also benefiting the public, but by limiting the duration of copyright the interests of authors are balanced with the ones of the public.[96] The term of protection varies in different countries based on the type of work, whether the work has been published or not, and whether the work was created by an individual or a corporation. International treaties, such as the Berne Convention, also set minimum terms for copyrights for their signatory countries.

In European Union the Copyright Term Directive replaced the former Copyright Duration Directive harmonizing the term of copyright protection and consolidated all the amendments made before it.[97] With the addition of Directive 2011/77/EU, term of protection for a work is now 70 years from the death of the author (*post mortem auctoris*, pma) regardless of when the work was first lawfully published, which is longer than the

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[95] Boyle 2008 p. 39.
[96] Schreyer 2015 p. 54.
[97] Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights (codified version), http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2006:372:0012:0018:EN:PDF (accessed 29 April 2016); and Council Directive 93/98/EEC of 29 October 1993 harmonizing the term of protection of copyright and certain related rights, http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:31993L0098&from=en (accessed 29 April 2016).

50 years pma term required by the Berne Convention.[98] If the author is anonymous or pseudonymous, the copyright protection term lasts 70 years from the date of first lawful publication.[99]

For performers, film producers, and broadcasting organisations the protection for related rights lasts 50 years from the date of performance or fixation, lawful publication, lawful communication to the public, or the first transmission of a broadcast and for phonogram producers the Directive 2011/77/EU extended the term of protection for related rights from 50 to 70 years from the date of fixation, first lawful publication, or first lawful communication to the public.[100]

In the United States the term of protection is generally 70 years pma, but if the work was a "work for hire", copyright persists for 120 years after creation or 95 years after publication, whichever is shorter.[101] All works created before 1923 are already in the public domain, but the term of protection for works created after 1923 and before 1978 is generally a lot more complicated and will not be discussed here. Intellectual Property Officer for the Cornell University Library, Peter B. Hirtle, maintains an excellent chart "Copyright Term and the Public Domain in the United States" that walks through the different rules for copyright duration.[102]

Law and economics scholars William M. Landes and Richard A. Posner have suggested indefinitely renewable copyright, challenging the common proposition that economic efficiency requires limited duration of copyright protection.[103] According to them, a system of higher registration and renewal fees and a relatively short initial term of copyright protection with a right of indefinite renewal would cause large number of copyrighted works to return to the public domain quite soon after they were created,

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[98] Directive 2011/77/EU of the European Parliament and of the Council of 27 September 2011 amending Directive 2006/116/EC on the term of protection of copyright and certain related rights, http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:265:0001:0005:en:PDF (accessed 29 April 2016).
[99] Council Directive 93/98/EEC, Article 1.
[100] Council Directive 93/98/EEC, Directive 2011/77/EU.
[101] 17 U.S. Code § 101 defines a "work made for hire" as "a work prepared by an employee within the scope of his or her employment; or a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire." 17 U.S. Code § 101 – Definitions, https://www.law.cornell.edu/uscode/text/17/101 (accessed 29 April 2016).
[102] Copyright Term and the Public Domain in the United States, http://copyright.cornell.edu/resources/publicdomain.cfm (accessed 29 April 2016).
[103] Landes–Posner 2002 p. 1.

because copyright's average expected life is relatively short and copyright registration and renewals are highly responsive to economic incentives.[104]

Because of the limited term of copyright protection, several fictional characters such as Alice, Ben-Hur, Conan the Barbarian, Don Quixote, Felix the Cat, Hercule Poirot, the Musketeers, Oliver Twist, Tarzan, Tom Sawyer, Van Helsing, the Wizard of Oz, Zorro, and several others are already in the public domain.[105]

In *Warner Bros. v. X One X Productions* the United States Court of Appeals for the Eighth Circuit found that the use of public domain marketing materials from the films *Gone with the Wind* and *The Wizard of Oz* as well as animated short films featuring *Tom & Jerry* infringed the existing, undisputed copyright of the films and the film characters, because defendant's use placed the marketing images in new contexts.[106] Exact reproductions of an entire items of publicity material were not even challenged, but combining extracted images from the public domain materials in new composite works created "a new increment of expression that evokes the film character in a way the individual items of public domain material did not" and, therefore, infringed Warner Brothers' copyrights.[107]

Recasting two-dimensional images in three-dimensional form, as the defendant did with figurines, also created a new increment of expression violating plaintiff's copyrights.[108] Because of *Warner Bros. v. X One X Productions*, authors and companies utilizing public domain material really need to carefully determine the nature and scope of the materials in the public domain and under the copyright protection - which properties and characteristics of fictional characters are already conveyed by the public domain material and which added by the copyrighted material?[109]

As an exception to the aforementioned rules on the duration of copyright term of protection, some countries have legislation granting certain works a perpetual copyright protection. For example in the United Kingdom a perpetual crown copyright is held for

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[104] Landes–Posner 2002 p. 38 and 41.
[105] Famous Public Domain Characters, http://free-universe.myartsonline.com/literature.html (accessed 29 April 2016), see also Dayal–Lustbader 2014.
[106] Wagner 2011. Warner Bros. Entm't v. X One X Productions, No. 10-1743 (8th Cir. July 5, 2011), http://media.ca8.uscourts.gov/opndir/11/07/101743P.pdf (accessed 29 April 2016).
[107] Warner Bros. Entm't v. X One X Productions, No. 10-1743 (8th Cir. July 5, 2011) p. 25. See also Wagner 2011.
[108] Warner Bros. Entm't v. X One X Productions, No. 10-1743 (8th Cir. July 5, 2011) p. 26.
[109] Ibid.

the Authorized King James Version of the Bible and royalties for public performances, commercial publications, or communications to the public of the play *Peter Pan* by Sir James Matthew Barrie are required to be paid for Great Ormond Street Hospital for Sick Children in London even though the copyright for the play has expired already on 31 December 1987 in the United Kingdom.[110] In Finland the Ministry of Education and Culture has the right to prohibit an action that publicly violates cultural interests of a literary or artistic work, regardless whether the copyright is in force or not, or whether the copyright has ever even existed.[111]

3.2. Public domain in trademark law

Even though I will mainly deal the term public domain with its application to copyright, both for the title of this thesis and the research itself, it is necessary to also talk about the public domain in trademark law as it also concerns the use of fictional characters - whether they are protected by copyright or trademarks, before moving to specifics of trademark protection.

The public domain material is usually defined as unencumbered by intellectual property right protection, which is often directly tied to the duration of the protection. However, unlike copyright or patent law, trademark law doesn't contribute to the enrichment of the public domain through a limited term of protection rather than the public domain is achieved through the limiting doctrines to trademark protection and assertion of exclusive rights, such as the definition of the trademark mark and the doctrines on trademark use.[112]

Signs that are in public domain consist of, in particular, signs that are generally excluded from the trademark protection, which Professor of Intellectual Property, VU University Amsterdam, Martin Senftleben describes as absolute exclusion, as well as signs that cannot be validly protectable as trademarks because they do not satisfy the basic protection requirement of distinctiveness for a trademark protection, which can be

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[110] Section 301 of the Copyright, Designs and Patents Act 1988 - Provisions for the benefit of the Hospital for Sick Children, http://www.legislation.gov.uk/ukpga/1988/48/section/301 (accessed 29 April 2016). See also Mishra 2011 p. 291.

[111] Section 53 of the Copyright Act. The Finnish Ministry of Education and Culture has however expressed this right only once, in 1962, when it prohibited the publication of new Finnish adaptations or abridgements of novels *Alice in Wonderland*, *Tom Sawyer*, *Little Women*, *Heidi*, *Heidi Grows Up*, *The Last of the Mohicans*, and *Robinson Crusoe* because they were so bungled and incompetent (KKO 1967-II-10 in Finnish, http://www.mlang.name/arkisto/KKO-1967-II-10.html, accessed 29 April 2016).

[112] Senftleben 2013 p. 2 and Lee 2014 p. 3.

described as relative exclusion.[113] Thus the question of the public domain signs is usually a question concerning whether the sign used is protected or a question of eligibility of protection, i.e. whether the sign used can even be protected as a trademark under the trademark law.[114]

But it can also be a question whether the sign is available to be used. The broader perspective of public domain definitions, focusing on the freedom of use of trademarks, offers two additional tools to enrich the public domain. Firstly there is relative freedom of use, which means all forms of use that render the trademark owner incapable of exerting control over the use of her trademark because of inherent limits of exclusive rights for private, religious, cultural, educational, or political purposes. Secondly the absolute freedom of use, which means all forms of use exempt from the control of the trademark owner because of the adoption of limited exceptions.[115]

Thus, the public domain in a trademark context can be understood consisting of all signs that are not or cannot be protected as trademarks and additionally all forms of use of trademark protected signs that fall outside the scope of the exclusive rights of the trademark owner.[116] It is important to notice that trademarks can be used without the consent of the right holder if they are not used to identify the source, but I will return to this a bit later.[117]

However, the effect of trademark protection on the public domain depends on the different layers of protection laid down at the national level. This is because trademarks are registered within nations or a bundle of nations and a mark recognized in some countries or trademark registries might be determined as generic and thus not eligible for trademark protection in others. Reasons for trademark being considered as generic include disuse, failure to assert trademark rights, or common usage by the public without regard for its intended use. [118]

Great example of disuse causing the abandonment of exclusive rights was seen *Silverman v. CBS*, where the Second Circuit found that CBS had abandoned its mark after 21 years of non-use without intent to resume within the reasonably foreseeable

[113] Senftleben 2013 p. 18 and Lee 2014 p. 9.
[114] Ibid.
[115] Senftleben 2013 p. 15-16 and 18. See also Senftleben 2015 p. 2.
[116] Senftleben 2013:2 p. 823.
[117] Schreyer 2015 p. 76-78.
[118] Senftleben 2013 p. 13-14 and Senftleben 2013:2 p. 782.

future.[119] On the other hand in *Crash Dummy Movie v. Mattel Inc.*, the Court of Appeals for the Federal Circuit found that Mattel had provided enough evidence, like discussions with a prospective distributor and ongoing research and development into future toys using the mark, to prove its intent to use the CRASH DUMMIES mark despite of the three years of non-use.[120]

Even though the public domain legislation makes the utilization of fictional characters easier, the legislation is still too much in a flux. The existing safety measures cannot effectively prevent some character's failure to enter the public domain and the scope of trademark protection for public domain characters should be narrowed either through legislation or its applications.

[119] Silverman v. CBS, 870 F.2d 40 (2d Cir. 1989). See also footnote 1 and chapter 2.2.
[120] Crash Dummy Movie, LLC v. Mattel, Inc., 601 F.3d 1387 (Fed. Cir. 2010), https://www.courtlistener.com/opinion/1998/crash-dummy-movie-llc-v-mattel-inc/ (accessed 29 April 2016). See also Schreyer 2015 p. 78.

4 TRADEMARK PROTECTION OF CHARACTERS

4.1. Trademark in general

Copyright is designed to protect the creative expression of a work, e.g. a fictional character, providing exclusivity for works of authorship, but the situation is different with trademarks as they concern with a sign's, which can also be a fictional character, capacity to symbolize a particular source of goods or services to prevent confusion over brands or other source identifiers.[121] Copyright protection depends on character's originality, but the same character may be entitled to trademark protection only if it is able to identify the single source or origin of a product or service, regardless of the originality.[122]

Trademark's inherent distinctiveness - ability to act as a single source identifier for the applicable goods or services - is important as it allows consumers to make assumptions about the quality or source of goods and services represented by the familiar mark.[123] And as the scope of trademark protection is primarily built to guarantee the consumers' ability to make informed choices when selecting certain goods, not on the theory of granting rewards and incentives for the author, the owners of a trademark can only prevent others from using their mark in commerce for identifying similar products or services, which would confuse the public, still permitting any other use.[124] This makes the scope of trademark protection obviously narrower than the scope of copyright protection, which provides the author or right holders a long list of exclusive rights to protect the original creation, preventing anyone from using, copying, modifying, distributing, performing, or displaying the protected work.[125] This narrower scope of protection is also one of the reasons for the longer term of protection for trademarks.

Characters, just like other recognizable symbols of particular work or concept, can be registered as trademarks if they are distinctive enough to identify the single source of a particular goods or services. And as characters are often identified with their original work, they can indeed act quite well as a single source identifiers. But it is not the trademark registration or recognition of the character that provides the perpetual rights

[121] Kurtz 1994 p. 441-442, Rosenblatt 2015 p. 592.
[122] Schreyer 2015 p. 54-55.
[123] Lee 2001 p. 185.
[124] Calboli 2014 p. 27, Rocchi 2014.
[125] Rocchi 2014.

in that character.[126] Instead, the seemingly indefinite protection of the character is in force only as long as the trademark owner continues to use the character's trademark for its single source identifying purpose.[127] Thus the firms have incentive to capitalize their trademarked character, successfully embodying their good will and reputation, by introducing new and improved products with the same character.[128]

It is also important to remember the implication of trademark protection. Even though words, symbols, and even characters that are already in the public domain can also be used for trademark protection if nobody else isn't already using them as trademarks, they still don't leave the public domain if the trademark protection is granted.[129] In contrary, they remain available for the use of the public for any other purpose than as trademarks for a competitor's products or services.[130] Several public domain characters like Zorro[131], John Carter of Mars, Tarzan, Peter Rabbit[132], Betty Boop[133], and even Fatso from *Casper the Friendly Ghost* have thus been granted trademark protection.[134] Additionally even the United States Supreme Court ruled in *Dastar* that public domain work will not violate the trademark of the underlying work.[135]

Edgar Rice Burroughs' aforementioned characters Tarzan and John Carter of Mars are great examples of the difficulties stemming from the requirements for trademark protection. Even though earliest incarnations of both characters have entered the public domain because the copyright on novels *Tarzan of the Apes*, *The Return of Tarzan*, *A Princess of Mars*, and *The Warlord of Mars* has already expired, there has been a number of both copyright and trademark cases brought by the Edgar Rice Burroughs Inc. (ERB) to prevent the use of the characters.[136] Unfortunately ERB decided to settle its case against the comic book company Dynamite Entertainment few years ago, as the decision

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[126] See e.g. In re DC Comics, Inc., 689 F.2d. 1042, 1052 (C.C.P.A. 1982) (Nies, J., concurring), https://casetext.com/case/in-re-dc-comics-inc (accessed 29 April 2016).
[127] Id. at 1052. Schreyer 2015 p. 55-56.
[128] Landes–Posner 2002 p. 39–40.
[129] Rocchi 2014.
[130] Rocchi 2014.
[131] See footnote 5.
[132] See chapter 4.2.1.
[133] See chapter 4.2.2.
[134] Rosenblatt 2015 p. 568. For Fatso see Harvey Cartoons v. Columbia Pictures Indus., Inc., 645 F. Supp. 1564 (S.D.N.Y. 1986), http://law.justia.com/cases/federal/district-courts/FSupp/645/1564/1498885/ (accessed 29 April 2016).
[135] See later chapter 4.2.7.
[136] Anders 2012, Gousse 2012, Knight 2012. See also Burroughs v. Metro-Goldwyn Mayer, Inc., 683 F.2d 610, 631 (2d Cir. 1982), https://casetext.com/case/burroughs-v-metro-goldwyn-mayer-inc-3 (accessed 29 April 2016).

would certainly have clarified the trademark protection of those characters and the legal uncertainty of Tarzan's fictional trip to the bar depicted in the title of this thesis ensues.[137] In the Dynamite Entertainment case ERB originally accused Dynamite of trademark infringement and unfair competition over the *Warlord of Mars* and *Lord of the Jungle* comic series, both based on a public domain material, as it found Dynamites versions of the characters "pornographic", causing "irreparable injury" to the associated brands ERB controls.[138]

4.2. Trademark protection of characters in the United States

In the United States the federal trademark statute of law, the Lanham Act,[139] was originally enacted by the U.S. Congress in 1946 based on its power to "regulate commerce with foreign nations, and among the several states, and with the Indian tribes".[140] The Lanham Acts protects "any word, name, symbol, or device any combination thereof" that is "used by a person, or which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown".[141] Federal trademark protection is available for both registered and unregistered marks, but there are greater remedies available for registered marks.[142]

The trademark protected elements of character must fulfil the requirements of distinctiveness and single source indication before they can be registered. As regards to enforcement, the trademark owner must show that there is likelihood of confusion for the use to be infringing. I will discuss these elements separately, but trademark cases, like *Sony v. Fireworks*, usually deal with all of these.[143] In this Zorro-related case the District Court for the Central District of California could not assess whether there was a likelihood of confusion between plaintiff's and defendant's marks to find trademark

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[137] Johnston 2014, McMillan 2014.
[138] McMillan 2014, Gousse 2012, Johnston 2014, and Knight 2012.
[139] 15 U.S. Code Chapter 22, § 1051 et seq, https://www.law.cornell.edu/uscode/text/15/chapter-22 (accessed 29 April 2016).
[140] Article 1, Section 8, Clause 3 of the United States Constitution, the Commerce Clause, https://www.law.cornell.edu/constitution/articlei#section8 (accessed 29 April 2016).
[141] 15 U.S.C. § 1127, https://www.law.cornell.edu/uscode/text/15/1127 (accessed 29 April 2016).
[142] Foley 2009 p. 940.
[143] Sony v. Fireworks, 137 F. Supp. 2d 1177, 1198 (C.D. Cal. 2001), vacated, 2002 WL 32387901 (C.D. Cal. 2002), http://law.justia.com/cases/federal/district-courts/FSupp2/137/1177/2472491/ (accessed 29 April 2016).

infringement by the defendants, as the plaintiffs could not define to what they were claiming as trademark rights, nor they could prove that character had acquired secondary meaning as a source identifier.[144]

4.2.1. Acquired distinctiveness

In order to be able to identify and distinguish goods or services from those manufactured or sold by others, trademark must be distinctive, which can be either inherent or acquired through prior use of the mark establishing secondary meaning.[145]

The framework for evaluating the acquired distinctiveness of fictional character was laid down in *Fisher v. Star Co.*, regardless that the case was ultimately decided on state unfair competition grounds.[146] The New York Court of Appeals found that the cartoon characters Mutt and Jeff originally created by the plaintiff Harry C. Fisher had been "published and became well known as distinct characters" and because of this secondary meaning of the characters, defendant's imitating strips by another cartoonist exploiting the characters "would be unfair to the public and to the plaintiff".[147]

After *Fisher* the courts have continued to analyse the distinctiveness of fictional characters according to similar standards, requiring that to achieve acquired distinctiveness characters must be well-known as distinct characters.[148] In *Frederick Warne & Co., Inc. v. Book Sales Inc.* the plaintiff was looking for trademark protection of character illustrations in children's books written and illustrated by Beatrix Potter. [149] The U.S. District Court for the Southern District of New York found that even though the illustrations were "capable of distinguishing Warne's books from those of others" they were not inherently distinctive but could have acquired distinctiveness through widespread use and recognitions, which plaintiff had to prove.[150] It is important to also notice that even Warne himself conceded that the seven works in question were already in the public domain, but the court didn't see this as problem and stated that it should not preclude protection under the trademark law as long as "it is shown to have acquired

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[144] Ibid. See also Schreyer 2015 p. 54.
[145] 15 U.S.C. § 1052(f). See also Foley 2009 p. 940.
[146] Fisher v. Star Co., 231 N.Y. 414 (1921), http://www.courts.state.ny.us/reporter/archives/fisher_star.htm (accessed 29 April 2016). See also Foley 2009 p. 941.
[147] Fisher v. Star Co., 231 N.Y. 432, 433 (1921).
[148] Foley 2009 p. 941.
[149] Frederick Warne & Co., Inc. v. Book Sales Inc., 481 F. Supp. 1191 (S.D.N.Y. 1979), http://law.justia.com/cases/federal/district-courts/FSupp/481/1191/2397442/ (accessed 29 April 2016).
[150] Id. at 1195.

independent trademark significance, identifying in some way the source or sponsorship of the goods".[151] Case was eventually settled, but it has been later argued that the U.S. trademarks registered in the cover illustrations of Beatrix Potter would actually be invalid.[152]

Even though the U.S. courts have consistently required a showing of acquired secondary meaning through widespread use and recognition when considering the question of distinctiveness for a fictional character, no court has yet expressively eliminated the possibility that a fictional character could ever be inherently distinctive and the Court of Appeals for Second Circuit even instanced cartoon characters as inherently distinctive in *Pirone v. Macmillan Incorporated.*[153] With the heavy evidentiary burden to analyse acquired distinctiveness, courts are however forced to ensure that character's source identifying capacity, even as sources of expressive goods such as fiction, is properly examined, ensuring that the creative use of fictional characters isn't restricted to excess.[154]

4.2.2. Single source requirement

According to the Lanham Act, trademark protection only applies to words and symbols identifying the source of particular goods or services.[155] The courts in the United States have however interpreted this in a way that requires trademark to indicate only a *single* source, which can prove to be troublesome for fictional characters as they are often simultaneously associated with a number of different sources, for example their

[151] Id. at 1196.
[152] See also *In re Frederick Warne & Co.*, 218 U.S.P.Q. (BNA) 345 (T.T.A.B. 1983), where the Trademark Trial and Appeal Board found that the illustration, whose trademark registration was contested, was merely describing the frog character Jeremy Fisher, aiding the story of the book, and not acting as an identification of the publisher Warne. Liebler 2006.
[153] "Thus a photograph of a human being, unlike a portrait of a fanciful cartoon character, is not inherently "distinctive" in the trademark sense of tending to indicate origin", Pirone v. MacMillan, Inc., 894 F.2d 579 (2nd Cir. 1990) at 15, http://openjurist.org/894/f2d/579/pirone-v-macmillan-incorporated (accessed 29 April 2016). The case was about trademark claims made by daughters of the baseball legend George Herman "Babe" Ruth against three photographs in a calendar published by the defendant.
[154] Foley 2009 p. 942 and Rosenblatt 2015 p. 596.
[155] 15 U.S.C. § 1127.

authors[156], their publishers[157], their producers[158], their sponsors[159], and even with themselves[160].[161] The single source identification requirement has therefore generated a number of trademark claims regarding fictional characters.[162]

The aforementioned *Frederick Warne & Co., Inc. v. Book Sales Inc.* case also dealt with the concern that fictional characters might not identify a single source.[163] The court stated that it would not be enough that the illustrations have already come to signify Beatrix Potter as the author of the books but the plaintiff had to show that they have also come to represent Warne's goodwill and reputation as publisher of those books.[164]

A character may be simultaneously associated with a number of different sources also because it appears in a variety of different media or because the ownership of the trademark isn't perfectly clear. In *Universal City Studios v. Nintendo Co.* Universal alleged that video game *Donkey Kong* by Nintendo infringed Universal's trademark in

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[156] E.g. Gruelle v. Molly-'Es Doll Outfitters Inc., 94 F.2d 172, 174 (3d Cir. 1937), where author John B. Gruelle's long association with the dolls Raggedy Ann and Raggedy Andy gave him property rights to the dolls (https://casetext.com/case/gruelle-v-molly-es-doll-outfitters, accessed 29 April 2016); and Patten v. Superior Talking Pictures, 8 F. Supp. 196, 197 (S.D.N.Y. 1934), where the court found that character named Frank Merriwell was "closely identified in the public mind with the work of a particular author", Gilbert Patten's pseudonym Burt L. Standish, and could be protected "even after the expiration of copyright" (http://law.justia.com/cases/federal/district-courts/FSupp/8/196/1905029/, accessed 29 April 2016);. See also Calboli 2014 p. 28.

[157] Argument presented in the *Warne* cases. See also Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 later on chapter 4.2.7.

[158] E.g. Processed Plastic Co. v. Warner Communications., Inc., 675 F.2d 852, 856 (7th Cir. 1982), where the General Lee car from television show *The Dukes of Hazzard* was associated with Warner Bros. (https://casetext.com/case/processed-plastic-co-v-warner-communications, accessed 29 April 2016); and Wyatt Earp Enterprises v. Sackman Inc., 157 F. Supp. 621, 624–25 (S.D.N.Y. 1958), where television series *The Life and Legend of Wyatt Earp* was associated with the publisher (https://casetext.com/case/wyatt-earp-enterprises-v-sackman-inc, accessed 29 April 2016). See also Lone Ranger, Inc. v. Cox, 124 F.2d 650 (4th Cir. 1942), http://law.justia.com/cases/federal/appellate-courts/F2/124/650/1506772/ (accessed 29 April 2016).

[159] E.g. Premier Pabst Corp. v. Elm City Brewing Co., 9 F. Supp. 754, 760–61 (D. Conn. 1935), where the court held that the defendant was precluded from using a slight variation of the name "Old Maestro" as a tradename because public associated the character with radio broadcaster under contract to promote plaintiff's product, Pabst Blue Ribbon beer (http://law.justia.com/cases/federal/district-courts/FSupp/9/754/2347168/, accessed 29 April 2016).

[160] E.g. DC Comics, Inc. v. Unlimited Monkey Business, Inc., 598 F. Supp. 110, 112, 115 (N.D. Ga. 1984), where the court found that Superman and Wonder Woman have acquired "virtually universal recognition in the United States and throughout the world as unique, distinctive marks symbolizing the extensive goodwill associated with the public image of this hero and heroine" (https://casetext.com/case/dc-comics-inc-v-unlimited-monkey-bus, accessed 29 April 2016).

[161] Rosenblatt 2015 p. 595-597 and Kurtz 1994 p. 443.

[162] Rosenblatt 2015 p. 597.

[163] See footnote 149.

[164] Frederick Warne & Co., Inc. v. Book Sales Inc., 481 F. Supp. 1195 (S.D.N.Y. 1979). See also Foley 2009 p. 943.

King Kong.[165] However the facts surrounding the ownership of King Kong trademark were complicated as the son of Merian C. Cooper, author of the 1932 book and a magazine serial, held the exclusive worldwide book and periodical publishing rights to King Kong, RKO Radio Pictures, Inc. (RKO) owned the rights to the original movie it had produced in 1933 and to its sequel, and Dino De Laurentiis Corporation (DDL) owned the rights to the 1976 remake movie, but Universal did not claim to own trademark in any of these images of King Kong rather than in the King Kong name and another King Kong character by virtue of licensing assignments with Cooper.[166]

Essentially, Universal claimed to own a vague trademark in an "extraordinarily large gorilla standing on top of a tall building holding a woman captive", but because of the existing rights owned by others, Universal's gorilla needed to be distinguishable from the large gorilla holding actress Fay Wray on top of the Empire State Building from the copyrighted black-and-white photograph of the original 1933 *King Kong* movie, owned by the RKO, and from the large gorilla holding Jessica Lange on top of the World Trade Center in the 1976 remake, owned by the DDL. The District Court for the Southern District of New York found that the existence of other rights holders and extensive uncontrolled licencing of the mark in the past indicated either Universal's abandonment of their trademark or trademarks inability to designate a single source of origin to the consumers.[167] Because the King Kong character could not be traced to a single source of origin, no public confusion could exist and King Kong could not have trademark protection to infringe upon.

Both distinctiveness and single source identification are required for fictional character to be considered registerable as a trademark. Regardless of this, several U.S. courts have focused on the easily identifiable character itself causing the likelihood of confusion and ignored the single source requirement, even if the character identifies to a plurality of sources.[168] Right holders have also successfully circumvented the single source requirement by arguing that fictional characters, or at least their names, can be capable of acting as brands that identify the original author as the source.[169] This was the case in

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[165] Universal City Studios v. Nintendo Co., 578 F. Supp. 911 (S.D.N.Y. 1983), http://law.justia.com/cases/federal/district-courts/FSupp/578/911/2363221/ (accessed 29 April 2016) and Universal Studios v. Nintendo Co., 746 F.2d 112 (2d Cir.1984) http://openjurist.org/746/f2d/112 (accessed 29 April 2016). See also Foley 2009 p. 943.
[166] Rosenblatt 2015 p. 597.
[167] Universal City Studios v. Nintendo Co., 578 F. Supp. 929 (S.D.N.Y. 1983).
[168] Kurt 1994 p. 444 and Foley 2009 p. 944.
[169] Rosenblatt 2015 p. 599.

e.g. *Edgar Rice Burroughs, Inc. v. Manns Theatres*, where the United States District Court for Central District of California held that the title *Tarz & Jane & Boy & Cheeta* of a X-rated movie was likely to cause the film to be viewed as provided or authorized by the plaintiff and to dilute the value of the Edgar Rice Burroughs, Inc. trademark TARZAN.[170]

4.2.3. Protected elements

Not just fictional characters as a whole, but also nicknames[171], names[172], and costumes and can be protected as trademarks.[173] The latter was established in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, where the Court of Appeals for Second Circuit found "the combination of the white boots, white shorts, blue blouse, and white star-studded vest and belt" worn by Dallas Cowboys Cheerleaders as an arbitrary design, making the otherwise functional uniform trademarkable, and affirmed the preliminary injunction granted by the district court to prohibit defendants distributing or exhibiting the adult movie *Debbie Does Dallas* – regardless of the fact that the plaintiff did not have a registered trademark on its uniform.[174]

In US case law even distinctive key phrases associated with the character has been seen as protectable with trademarks.[175] Trademarked phrases include "E.T. Phone Home" in *Universal City Studios, Inc. v. Kamar Industries* and Lone Ranger's "Hi, yo, Silver, away".[176] Even "the total concept and feel" of characters can be trademark protected, as

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[170] Edgar Rice Burroughs, Inc. v. Manns Theatres, No. 76-3612-RMT, 1976 WL 20994, at *3 (C.D. Cal. Dec. 20, 1976), http://askjohnarchives.cocolog-nifty.com/blog/2013/12/edgar-rice-burr.html (accessed 29 April 2016).
[171] Ibid., where the District Court found trademark protection for the nickname Tarz based on public recognition of the name Tarzan.
[172] See e.g. Premier Pabst Corp. v. Elm City Brewing Co., 9 F. Supp. 754, 760–61 (D. Conn. 1935) in footnote 159 and the name Old Maestro.
[173] Foley 2009 p. 944.
[174] Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema Ltd., 604 F.2d 200, 204 (2d Cir. 1979), https://casetext.com/case/dallas-cowboys-cheerleaders-inc-v-pussycat-cinema-ltd (accessed 29 April 2016).
[175] Foley 2009 p. 944.
[176] Kurtz 1994 p. 442, Universal City Studios, Inc. v. Kamar Industries, Inc., 217 U.S.P.Q. 1162 (S.D. Texas 1982), http://novalis.org/cases/ET.html (accessed 29 April 2016). For Lone Ranger see next chapter and footnote 180.

was seen in *Sid & Marty Krofft Television Prods. v. McDonald's Corp.,* where the Ninth Circuit found McDonaldland characters infringing the plaintiff's original characters.[177]

4.2.4. Likelihood of confusion

Even when the fictional character or certain element of it is registered as a valid trademark, the alleged infringing use must still cause a likelihood of confusion between the marks to the source or sponsorship of the goods or services in order to infringe on the trademarked fictional character.[178] Likelihood of confusion tests vary from jurisdiction to jurisdiction, but generally if character is well known, the courts have often enjoined the infringing users from using the fictional character in a different form - a bit similar to the way a derivative work could infringe a copyrighted character.[179]

The fictional character Lone Ranger provides an excellent example of such well-known character, as the unlicensed use of the character was enjoined in both circus and in rodeo shows to prevent the likelihood of confusion.[180] Similarly in a more recent case, *Warner Bros. Entertainment v. The Global Asylum*, the Ninth Circuit affirmed the injunction barring a low-budget movie originally called *Age of the Hobbits* from being distributed under that name or using any mark that is similar to Warner Bros.' movie *The Hobbit: An Unexpected Journey*.[181]

However if the character is less well known or the use of trademark occurs in commercial products, causing only general association, courts are more hesitant to restrict the use of trademark. In *DeCosta v. Columbia Broadcasting Systems* the First Circuit emphasized that DeCosta's limited use of his Paladin character and the difference audiences of

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[177] Sid & Marty Krofft Television Prods. v. McDonald's Corp., 562 F.2d 1157, 1167 (9th Cir. 1977), https://casetext.com/case/sid-marty-krofft-tele-v-mcdonalds-corp (accessed 29 April 2016). See also Foley 2009 p. 945.

[178] 15 U.S. Code § 1125.

[179] See e.g. the eight factor test introduced in AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348–49 (9th Cir.1979) (https://casetext.com/case/amf-inc-v-sleekcraft-boats, accessed 29 April 2016), examining the 1) the strength of the mark; 2) the proximity of the goods; 3) the similarity of the marks; 4) evidence of actual confusion; 5) the marketing channels used; 6) the degree of care customers are likely to exercise in purchasing the goods; 7) defendant's intent in selecting the mark; and 8) the likelihood of expansion into other markets. See also Foley 2009 p. 947.

[180] Lone Ranger, Inc. v. Cox, 124 F.2d 650 (4th Cir. 1942), http://law.justia.com/cases/federal/appellate-courts/F2/124/650/1506772/ (accessed 29 April 2016); and Lone Ranger, Inc. v. Currey, 79 F. Supp. 190, 191–95 (M.D. Pa. 1948), http://law.justia.com/cases/federal/district-courts/FSupp/140/341/2349090/ (accessed 29 April 2016).

[181] Warner Brothers Entertainment, et al. v. The Global Asylum, Inc., 2012 WL 6951315, (C.D. Calif. 2012), https://casetext.com/case/warner-bros-entmt-inc-v-global-asylum-inc (accessed 29 April 2016). See also Calboli 2014 p. 29.

rodeos, horse shows, parades etc. resulted in little likelihood of confusion as to the source or sponsorship of the CBS television series *Have Gun Will Travel* with similar character.[182] And in *Toho Co. v. Sears Roebuck & Co,* Bagzilla garbage bags posed no likelihood of confusing consumers to assume that trash bags were made, sponsored or endorsed by the owner of GODZILLA trademark.[183] The use of a character in a commercial product may however sometimes cause the customer to assume an endorsement or other approval by the source of trademark, fulfilling the likelihood of confusion requirement.[184]

Claims based on customer confusion aren't only a current phenomenon. In *Hopkins Amusement* a stage writer William Gillette, creator of licenced play *Sherlock Holmes*, and his co-producer Charles Frohman sued the Hopkins Theatre advertising a play called *Sherlock Holmes, Detective.*[185] The Illinois appellate court granted an injunction on the ground of deception of the public and agreed that regardless of whether Frohman was entitled to a "exclusive property right in the name 'Sherlock Holmes' as a trade-mark" or not, the title of Hopkins's play was likely to result in consumer deception and confusion believing that the Hopkins production was associated with the Gillette/Frohman play.[186] Now the current federal Lanham Act would probably pre-empt a state-law unfair competition claim based on a quasi-trademark theory and the court would need to consider whether Frohman actually had a trademark right to the name Sherlock Holmes for performance entertainment or not, but the differences to claims based on likelihood of confusion or dilution are more semantic than substantive.[187]

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[182] De Costa v. Columbia Broadcasting System, Inc., 520 F.2d 499, 502 (1st Cir. 1975), https://casetext.com/case/decosta-v-columbia-broadcasting-system-inc (accessed 29 April 2016).
[183] Toho Co. v. Sears Roebuck & Co., 645 F.2d 788, 790–91 (9th Cir. 1981), http://openjurist.org/645/f2d/788/toho-company-ltd-v-sears-roebuck-and-co (accessed 29 April 2016). See also Foley 2009 p. 947-949.
[184] See e.g. Conan Props Inc. v. Conans Pizza Inc., 752 F.2d 145, 150 (5th Cir. 1985) (https://casetext.com/case/conan-properties-inc-v-conans-pizza-inc, accessed 29 April 2016) where the court stated that an ordinary consumer might well believe defendant restaurant was affiliated with owners of fictional character Conan The Barbarian through licensing; or Warner Bros. Inc. v. Gay Toys Inc., 658 F.2d 76, 79 (2d Cir. 1981) (http://law.justia.com/cases/federal/appellate-courts/F2/724/327/265055/, accessed 29 April 2016) where the appellate court saw consumers' assumption that the "Dixie Racer" toy car was sponsored by *Dukes of Hazzard* producer Warner Bros. sufficient to infringe the trademark.
[185] Hopkins Amusement Co. v. Frohman, 103 Ill. App. 613 (1902), aff'd, 67 N.E. 391 (Ill. 1903). Case summary in 'Trade. Unfair Competition. Deception of Public. Hopkins Amusement Co. v. Frohman, 67 N. E. 391 (Ill.)', *The Yale Law Journal*, Volume 13, 10 October 1903, https://archive.org/details/jstor-780717 (accessed 29 April 2016). See also William Gillette and Others v. Stoll Film Company Ltd., and Educational Film Exchange, Inc., 120 Misc. 850 (N.Y. Misc. 1922), https://casetext.com/case/gillette-v-stoll-film-co-ltd (accessed 29 April 2016).
[186] Rosenblatt 2015 p. 593-594.
[187] Rosenblatt 2015 p. 594.

4.2.5. Dilution of famous marks

The 1995 Federal Trademark Dilution Act (FTDA) and the Federal Trademark Dilution Revision Act of 2006 (FTDRA) removed the requirement of likelihood of confusion for infringement if the trademark is deemed "famous". This causes even uses that are not likely to cause consumer confusion to be considered as infringing if they "dilute" the reputation of the trademark or its holder, even protecting the use of marks on non-competing goods.[188] Thus the dilution claims protect solely the trademark holder with no benefit to the public, unlike traditional infringement claims protecting the consumer from confusion.[189]

Dilution was first introduced by Frank I. Schechter in his 1927 Harvard Law Review article, where he introduced protection to guard against the "gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use on noncompeting goods" injuring especially strong marks.[190] Even though Schechter never used the term "dilution", this famous passage has been embraced as a description of dilution.[191] Prior to FTDA only 28 states recognized dilution and some required a showing of likelihood of confusion or parties being competitors, but after years of state courts ignoring dilution claims, it eventually became accepted doctrine and the requirements were clarified.[192]

Dilution protection requires the mark to be "famous", which may be difficult to determine, causing unpredictability. The Lanham Act considers a mark famous if "it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner".[193] The degree of recognition is determined considering all relevant factors, including 1) the duration, extent and geographic reach of advertising and publicity of the mark, done by the owner or third parties; 2) the amount, volume and geographic extent of sales of goods or services offered under the mark; 3) the extent of actual recognition of the mark; and 4) how the trademark was registered. And while the cases regarding dilution of fictional characters

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[188] 15 U.S. Code § 1125 (c)(1), granting injunction "regardless of the presence or absence of actual or likely confusion, of competition or of actual economic injury"). See also Foley 2009 p. 940.
[189] Knudsen 2000 p. 14.
[190] Schechter 1927 p. 825. See also Bone 2008 p. 9 and Knudsen 2000 p. 17.
[191] See eg. Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc., 944 F.2d 1446, 1457 (9th Cir. 1991), https://casetext.com/case/academy-of-motion-picture-v-creative-house (accessed 29 April 2016), describing dilution protecting "the gradual "whittling away" of a trademark's value". See also Bone 2008 p. 9-10 and Rierson 2011 p. 213.
[192] Knudsen 2000 p. 17-18.
[193] 15 U.S. Code § 1125(c)(2)(A).

at the federal level have been sparse, they illustrate the potentially sweeping nature of dilution protection.[194]

In order to establish a dilution claim, the plaintiff must show a likelihood of dilution, in addition to verifiable possession of a truly distinctive mark.[195] As stated in *Hormel Foods Corp. v. Jim Henson Prod., Inc.*, such a likelihood can be established by a showing either of blurring or of tarnishment.[196] Blurring occurs when the customers see the plaintiff's mark used on a number of different goods and services, causing mark to lose its "ability to stand as a unique identifier of the plaintiff's product", and tarnishing of a product when it is "linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context", causing the public to associate the lack of quality or lack of prestige in the infringing goods with the plaintiff's original goods.[197]

In *Brown v. It's Entertainment Inc.*, the defendant company had allegedly used an un-licensed costumes of the Arthur the Aardvark character for live entertainment and promotional appearances and the plaintiffs sought to enjoin this unauthorized commercial use.[198] The U.S. District Court for the Eastern District of New York found that the plaintiff had established Arthur's fame and because of Arthur, "a stylized aardvark dressed like a schoolboy", being inherently distinctive, granted preliminary injunction against defendant renting infringing costumes to avoid the "loss of credibility, public affection, and consumer interest" of the character.[199]

Similarly in *Danjaq LLC v. Sony Corp.*, the court granted a broad injunction prohibiting use of the James Bond mark in any capacity by Sony, including making James Bond movies, because it reasoned that allowing Sony's use would cause the mark to be diluted

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[194] Foley 2009 p. 951.
[195] These two requirements were established in Sally Gee, Inc. v. Myra Hogan, Inc., 699 F.2d 621, 625 (2d Cir.1983), https://casetext.com/case/sally-gee-inc-v-myra-hogan-inc (accessed 29 April 2016).
[196] Hormel Foods Corp. v. Jim Henson Prod., Inc., 73 F.3d 497, 506 (2d Cir.1996), https://cyber.law.harvard.edu/metaschool/fisher/domain/tmcases/hormel.htm (accessed 29 April 2016).
[197] Ibid. at 507. See also Deere & Co. v. MTD Prods., Inc., 41 F.3d 39, 43 (2d Cir.1994), http://cyber.law.harvard.edu/metaschool/fisher/integrity/Links/Cases/deere.html (accessed 29 April 2016).
[198] Brown v. It's Entertainment Inc., 34 F. Supp. 2d 854, 860 (E.D.N.Y. 1999), http://law.justia.com/cases/federal/district-courts/FSupp2/34/854/2462683/ (accessed 29 April 2016).
[199] Id. at 859, Schreyer 2015 p. 67-68, and Foley 2009 p. 951-952.

by blurring.[200] The injunction was affirmed by the Court of Appeals for the Ninth Circuit.[201]

Regardless of the fact that sweeping dilution protection without the requirement of misleading the consumers might seemingly limit the public's use of fictional characters, the exclusions of the FDRA confine the scope of dilution by outlining the acts that doesn't dilute the mark.[202] These acts include A) fair use like advertising or promotion permitting consumers to compare goods or services, "identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner";[203] B) news reporting and news commentary; and C) non-commercial use of the mark.[204]

4.2.6. Comedy III Productions, Inc. v. New Line Cinema

As stated before, the plaintiff in *Frederick Warne & Co., Inc. v. Book Sales Inc.* acknowledged that the copyright term of the seven works at issue had already expired, but the court didn't see this as problem and stated that "the fact that a copyrightable character of design has fallen into the public domain should not preclude protection under the trademark law".[205] On the other hand, while determining trademark registrations to three-dimensional representations of Superman, Batman and the Joker, Judge Nies expressed her concern in special concurrence that "when copyrighted doll design is also a trademark for itself, there is a question whether the quid pro quo for the protection granted under the copyright statute has been given, if, upon expiration of the copyright, the design cannot be used at all by others".[206]

The appropriate scope of trademark protection for public domain works was attempted to confine by the United States Court of Appeals for the Ninth Circuit in *Comedy III Productions v. New Line Cinema*.[207] In this case New Line Cinema incorporated a clip

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[200] Danjaq LLC v. Sony Corp., 49 U.S.P.Q.2d 1341, 1343–44 (C.D. Cal. 1998). See Foley 2009 p. 951-952.
[201] Danjaq, LLC v. Sony Corp.,165 F.3d 915, (9th Cir. Nov.19, 1998). See also Danjaq, LLC v. Sony Corp., 263 F.3d 942 (9th Cir. 2001), https://casetext.com/case/danjaq-llc-v-sony-corporation (accessed 29 April 2016), holding laches defence to bar the claim of co-ownership in James Bond character.
[202] Foley 2009 p. 952.
[203] 15 U.S. Code § 1125 (c)(3).
[204] Foley 2009 p. 952.
[205] Frederick Warne & Co., Inc. v. Book Sales Inc., 481 F. Supp. 1191, 1196 (S.D.N.Y. 1979).
[206] In re DC Comics, Inc., 689 F.2d 1042 (C.C.P.A. 1982), https://casetext.com/case/in-re-dc-comics-inc (accessed 29 April 2016).
[207] Comedy III Productions, Inc. v. New Line Cinema, 200 F.3d 593 (9th Cir. 2000), https://www.law.cornell.edu/copyright/cases/200_F3d_593.htm (accessed 29 April 2016).

from The Three Stooges' short film, *Disorder in the Court*, whose copyright term had expired, into a television set for a less than thirty seconds in the background of an interior scene in their theatrical motion picture, *The Long Kiss Goodnight*.[208]

The Comedy III Productions, Inc., claiming to be the exclusive owner of all "rights, title, and interest" in The Three Stooges, sought damages for violation of the Lanham Act.[209] The District Court for the Central District of California had already dismissed Comedy III's claim after ordering it to articulate how it owned an enforceable trademark in the clip allowing the relief it sought, but the plaintiff contended that it was not claiming a trademark in the clip itself, but rather in the "name, the characters, the likeness, and overall 'act' of The Three Stooges".[210] Comedy III alleged that the clip contained an enforceable trademark because it was "particularly distinctive of The Three Stooges' comedy, whereas other clips from *Disorder in the Court* and other films by The Three Stooges are not so distinctive as to be trademarks".[211] The plaintiff also presented right of publicity claim, but it wasn't explicitly addressed by the court because of the absence of the trademark.[212]

The Ninth Circuit agreed with the District Court, stating that Comedy III had not proved the existence of a trademark by explaining how the film footage could contain a distinctive mark or how the footage of The Three Stooges' name, voices, images, and act could have secondary meaning.[213] The Ninth Circuit explicitly stated that trademark law cannot be used to circumvent copyright law and "if material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity".[214]

Comedy III had previously successfully persuaded other film producers to pay them a fee, but this did not obligate New Line to follow suit, as it was not legally obliged to do so.[215] Purchasing licenses to public domain works may happen for the sake of

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[208] Ibid. See also Lee 2001 p. 183-184.
[209] Comedy III Productions, Inc. v. New Line Cinema, 46 U.S.P.Q.2d 1931 (C.D. Cal. 1998), see also Lee 2001 p. 191. Comedy III Productions has later changed its name to C3 Entertainment, Inc. ('Who Are Those Guys?', *C3 Entertainment, Inc.*, http://www.c3entertainment.com/about-us/who-we-are/, accessed 29 April 2016).
[210] Comedy III Productions, Inc. v. New Line Cinema, 200 F.3d 593. See also Foley 2009 p. 957.
[211] Comedy III Productions, Inc. v. New Line Cinema, 200 F.3d 595. See also Lee 2001 p. 191.
[212] Lee 2001 p. 183-184 and
[213] Comedy III Productions, Inc. v. New Line Cinema, 200 F.3d 595.
[214] Ibid.
[215] Ibid.

convenience, if the work, or a copy of the work, is rare or difficult to obtain, or to avoid litigation – not to prove distinctiveness of the mark or validate the trademark claims.[216]

Comedy III cited few earlier cases to outline the scope of trademark protection, but the case concerning TARZAN trademark involved only the name of the character, not its actual performance protected by copyright.[217] In another case the trademark CORKY THE CLOWN was used to identify also the act or entertainment service performed by the character, not just the character.[218] As New Line Cinema had not even mentioned The Three Stooges' name in its film or marketing, aforementioned cases and others presented by Comedy III were not proven to address a similar situation and were unhelpful for the claims. The Ninth Circuit itself referred to an earlier case where Comedy III's rights of publicity claims had succeeded against an artist who sold lithographs and T-shirts reproducing a charcoal drawing depicting The Three Stooges, but stated that it will not "entertain this expedition of trademark protection squarely into the dominion of copyright law", allowing Lanham Act to cover a film clip.[219]

The Ninth Circuit has been criticized for implying trademark and copyright protection as mutually exclusive and for implying that public domain material cannot be protected with trademarks, especially because there are a lot of earlier cases, like *Warne & Co. v. Book Sales, Inc.*, stating the contrary.[220] Additionally Comedy III could not have prevailed with its trademark infringement claim against New Media even if it had succeeded convincing the court that it had a valid trademark on the *Disorder in the Court* clip as mere copying of a trademarked public domain work does not constitute trademark infringement if consumer confusion cannot be shown.[221] Because of this, even though the Ninth Circuit correctly declined to entertain trademark claims made by Comedy III, its ruling cannot alone be viewed as setting an outer limit on trademark law, barring trademark protection for public domain works.

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[216] Ibid. See also Lee 2001 p. 192.
[217] See 165.
[218] In re Florida Cypress Gardens Inc., 208 USPQ 288 (TTAB 1980). See Hutchens 2011.
[219] Comedy II Productions., Inc. v. Gary Saderup, Inc., 21 P.3d 797 (Cal. 2001), https://law.ku.edu/sites/law.ku.edu/files/docs/media_law/Comedy_III_Productions_Inc_v_Gary_Saderup_Inc.pdf (accessed 29 April 2016). Comedy III Productions, Inc. v. New Line Cinema, 200 F.3d 596 and Lee 2001 p. 192-193.
[220] Lee 2001 p. 194-195.
[221] Lee 2001 p. 196-197.

4.2.7. Dastar Corp. v. Twentieth Century Fox

The limits of trademark law were redefined by the United States Supreme Court in *Dastar Corp. v. Twentieth Century Fox Film Corp.*[222] In *Dastar* the petitioner had repackaged the original Twentieth Century Fox (Fox) television series called *Crusade in Europe*, based on 1948 book of the same name written by General Dwight D. Eisenhower and published by Doubleday, as video set called *World War II Campaigns in Europe* passing off the project as its own.[223] Doubleday had originally registered the copyright for the book and granted exclusive television rights to an affiliate of respondent Fox, which arranged for Time, Inc. to produce the *Crusade* television series based on the book, assigning copyright in the series to Fox.[224] The 26-episode series was first broadcast in 1949, but Fox never renewed the copyright on the television series, leaving the series in the public domain after its expiration in 1977.[225]

Doubleday had however renewed the book's copyright in 1975 as the "proprietor of copyright in a work made for hire" and Fox reacquired the television rights in the book in 1988, including "the exclusive right to distribute the C*rusade* television series on video and to sublicense others to do so".[226] SFM Entertainment and New Line Home Video, Inc. acquired the exclusive rights to manufacture and distribute *Crusade* on video from Fox with SFM restoring and repackaging the original series on videotape and New Line distributing the videotapes.[227]

In 1995, Dastar purchased eight Betacam videotapes of the original *Crusade* series, already in public domain, and edited them as *Campaigns* with half the length of the original series, "a new opening sequence, credit page, and final closing for those of the Crusade television series; inserted new chapter-title sequences and narrated chapter introductions; moved the "recap" in the *Crusade* television series to the beginning and retitled it as a "preview"; and removed references to and images of the book".[228] It then manufactured new packaging and sold the video set as its own product, without any

[222] Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003), https://supreme.justia.com/cases/federal/us/539/23/case.html (accessed 29 April 2016).
[223] Id. at 25-26.
[224] Id. at 26.
[225] Ibid. See also Foley 2009 p. 958.
[226] Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 26.
[227] Ibid.
[228] Id. at 26-27.

reference to the *Crusade* television series, with a price substantially lower than New Line's video set.[229]

The respondents brought action against Dastar alleging that its video set infringed Doubleday's copyright in the book and thus their exclusive television rights, constituting a reverse passing off and violation of state unfair competition law.[230] The District Court found for Fox, SFM and New Line, awarding them double the profits Dastar had made, and the Court of Appeals for the Ninth Circuit affirmed the judgment on reverse passing off and on the amount of awards but reversed the copyright claim and sent it back to the district court on remand.[231] The Ninth Circuit later held that Eisenhower's book was indeed made for hire and Doubleday had thus properly renewed the copyright, regardless of the fact that Eisenhower had carefully crafted the structure of his transaction with Doubleday to minimize his taxation.[232]

The Supreme Court, ruling only on the reverse passing off claim, reversed the earlier decisions and rejected the studios' claims.[233] Beginning his reasoning with interpretation of the meaning of the word "origin" in section 43(a) of the Lanham Act[234], Justice Antonin Scalia, writing in the decision, stated that if "origin" referred only to the manufacturer or producer of the physical goods, the *Campaigns* videotapes, made available to the public, then Dastar was the origin, but if "origin" includes the creator of the underlying work that Dastar copied, the original *Crusade* series, then someone else was the origin of Dastar's product.[235] Continuing this, the Supreme Court stated that the wording of the Lanham Act should be interpreted only to the extent of interests of the consumers.[236] And the purchaser concern with communicative products, such as

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[229] Ibid.
[230] Id. at 27. Reverse passing off, as the name suggests, is the opposite of passing off, which occurs when someone represents someone else's goods or services as his own.
[231] Id. at 27-28.
[232] Twentieth Century Fox Film Corp. v. Entertainment Distributing, 429 F.3d 869, 875 (9th Cir. 2005), https://casetext.com/case/20th-century-fox-film-v-enter-distributing (accessed 29 April 2016). See also Patry 2008.
[233] Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 38.
[234] Section 43(a)(1)(A) off the Lanham refers to actionable use of a mark, that "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person." 15 U.S. Code § 1125(a)(1)(A).
[235] Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 31.
[236] Id. at. 32-33.

videotapes, lies also on the identity of the author or creator of the original content, not just on the publisher of the physical item.[237]

This kind of special treatment to communicative products would however cause the Lanham Act to conflict with the copyright law and circumvent the underlying philosophy of limited exclusive ownership of a copyright or patent.[238] Because of this, the Supreme Court concluded that the word "origin" in section 43 of the Lanham Act refers to "the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods"[239] and holding otherwise would create a perpetual mutant version of the copyright law through trademark protection, limiting the public's right to public domain works.[240] Hence, Dastar had not made any false representations as to the origin of the goods, the *Campaigns* series, and had not infringed the trademark interests in the original *Crusade* series.[241]

It is important to notice that *Dastar* dealt only with the reverse passing off claim under section 43(a) of the Lanham Act and not any other form of trademark infringement. Additionally, it did not directly address trademark protection of fictional characters, rather than clarified that upon work entering the public domain, there exists an absolute right to copy it without any identification of its creative source.[242] The Supreme Court also failed to address the possibility of overlapping copyright and trademark protection in general.[243] If Fox had not failed to renew the copyright to *Crusade*, it would have been easy to show copyright infringement and trademark claims wouldn't probably have conflicted with the copyright law.[244]

Court have later interpreted *Dastar* narrowly. In *Bach v. Forever Living Products U.S., Inc.*, the author of the book *Jonathan Livingston Seagull*, Richard Bach, and Russell Munson, who took photographs appearing in the book, sued defendants, a health and beauty products supplier, its affiliated companies, and its founder, for using a

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[237] Id. at 33.
[238] Id. at 33-35.
[239] Id. at 37.
[240] Id. at 34. See also Foley 2009 p. 958.
[241] Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 38. See also Foley 2009 p. 959.
[242] Zissu 2004 p. 457 and Foley 2009 p. 959.
[243] Moffat 2004 p. 1523. The Supreme Court had not seen overlapping of trademark and copyright claims as an issue in Wal-Mart Stores, Inc. v. Samara Brothers, Inc. 529 U.S. 205 (2000) (https://supreme.justia.com/cases/federal/us/529/205/, accessed 29 April 2016), where it rejected trademark claim on grounds of failure to establish second meaning, not because it might constitute a "mutant" copyright protection or limit fair use of work.
[244] Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 31.

copyrighted photo from the book as their corporate logo, and the copyrighted story and character in their advertising, promotional, and training materials.[245] In addition to copyright infringement claim, the plaintiffs alleged that defendants' use of name, title, and images associated with *Jonathan Livingston Seagull* constituted a trademark infringement.[246] The defendant sought dismissal under the *Dastar* standard, but the District Court for the Western District of Washington held that it was inapplicable in this case because the case dealt with separate copyright and trademark infringement claims, not a reverse passing off claim like *Dastar*.[247] Similarly in *Reynolds & Reynolds Holdings, Inc. v. Data Supplies, Inc.,* the District Court for the Eastern District of Virginia dismissed the case on jurisdictional grounds and ignored the overlapping design patent, copyright, and trademark claims.[248]

On the other hand, the Ninth Circuit dismissed the copyright and trademark infringement claims made by the plaintiff in *Fleischer Studios, Inc. v. AVELA, Inc.*, because it found that defendant's depictions of Betty Boop character in its merchandise were not trademark use rather than only an "aesthetically functional" use or fair use. [249] The court then stated that ruling in Fleischer's favour would result in Betty Boop essentially never entering the public domain, which "would run directly contrary to Dastar".[250] The Ninth Circuit however later withdraw its first opinion and superseded it with a less bold approach, still finding that defendant's use did not constitute a trademark infringement, but this time only because the plaintiff had failed to present sufficient evidence establishing secondary meaning for the trademark.[251]

In *Lyons Partnership, L.P. v. Morris Costumes, Inc.*, the plaintiffs prevailed on both their trademark and copyright claims against a costume rental company for renting costumes similar to purple dinosaur character Barney without court even mentioning the

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[245] Bach v. Forever Living Products U.S., Inc., 473 F.Supp.2d 1110 (W.D. Wash. 2007), https://casetext.com/case/bach-v-forever-living-products-us (accessed 29 April 2016).
[246] Ibid.
[247] Id. at 1118.
[248] Reynolds & Reynolds Holdings, Inc. v. Data Supplies, Inc., 301 F. Supp. 2d 545 (E.D. Va. 2004), http://law.justia.com/cases/federal/district-courts/FSupp2/301/545/2511377/ (accessed 29 April 2016). See also Moffat 2004 p. 1528.
[249] Fleischer Studios, Inc. v. AVELA, Inc., 636 F.3d 1124 (9th Cir.2011), https://casetext.com/case/fleischer-studios-inc-v-avela-inc (accessed 29 April 2016). See also Calboli 2014 p. 32-33.
[250] Fleischer Studios, Inc. v. AVELA, Inc., 636 F.3d 1124-1125 (9th Cir.2011).
[251] Fleischer Studios, Inc. v. AVELA, Inc., 654 F.3d 958, 967 (9th Cir. 2011), https://casetext.com/case/fleischer-studios-v-avela (accessed 29 April 2016). See also Calboli 2014 p. 32-33.

overlapping protection or consequences of copyright expiration.[252] Regardless of the fact that *Lyons Partnership* and several other cases ignoring the possible problems caused by intellectual property right protection overlapping were decided before *Dastar*, Supreme Court's decision doesn't change the result in these cases as Justice Scalia didn't address the overlapping intellectual property rights in general.[253] Similarly older cases have also rejected trademark claims because they would expand the scope of Lanham Act beyond trademarks.[254]

4.3. Trademark protection of characters in Europe

As a part of the EU trademark reform, the Regulation (EU) No 2015/2424 of the European Parliament and the Council amended the Community trade mark regulation with Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, changing all CTMs and CTM applications to European Union trade marks and European Union trade mark applications.[255] According to the Article 7(1)(b) and (c) of the amended Regulation, trademarks which are devoid of any distinctive character or which "consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service" shall not be registered.[256] Pursuant Article 7(2), the registration can also be refused if the

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[252] Lyons Partnership, L.P. v. Morris Costumes, Inc., 243 F.3d 789 (4th Cir. 2001), http://law.justia.com/cases/federal/appellate-courts/F3/243/789/603765/ (accessed 29 April 2016). See also Moffat 2004 p. 1527-1528.

[253] Moffat 2004 p. 1528. Older cases ignoring the overlap include L.D. Kichler Co. v. Davoil, Inc., 192 F.3d 1349 (Fed. Cir. 1999), http://openjurist.org/192/f3d/1349/the-ld-kichler-co-v-davoil-inc (accessed 29 April 2016); and Kieselstein Cord v. Accessories by Pearl, Inc., 632 F.2d 989 (2d Cir. 1980) http://madisonian.net/downloads/copyright/kieselstein.pdf (accessed 29 April 2016).

[254] Shaw v. Lindheim, 919 F.2d 1353, 1364-65 (9th Cir. 1990) (https://casetext.com/case/shaw-v-lindheim-2, accessed 29 April 2016); Murray Hill Publications, Inc. v. ABC Communications, Inc., 264 F.3d 622, 634 (6th Cir. 2001) (https://casetext.com/case/murray-hill-publications-v-abc-communications, accessed 29 April 2016); and EMI Catalogue Partnership v. Hill, Holliday, Connors, Cosmopulos, Inc., 228 F.3d 56, 64 (2d Cir. 2000) (https://casetext.com/case/emi-catalog-v-hill-holliday-connors, accessed 29 April 2016). See also Moffat 2004 p. 1528-1529.

[255] See footnote 14. Regulation (EU) No 2015/2424, http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32015R2424&from=EN (accessed 29 April 2016); and Directive (EU) 2015/2436, http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32015L2436&from=EN (accessed 29 April 2016).

[256] Ibid. and Council Regulation (EC) No 207/2009 on the Community trade mark (http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:en:PDF, accessed 29 April 2016) amended by the Regulation (EU) 2015/2424.

trademark is descriptive or is not distinctive in one of the official languages of the European Union, even if it is registrable in another Member State.[257]

Additionally, the Article 52(1)(a) of the Regulation states that European Union trade mark shall be declared invalid on application to the EUIPO or on the basis of a counterclaim in infringement proceedings when the EUTM has been registered contrary to the provisions of Article 7.[258]

4.3.1. National case law and registration practices

Even though registration proceedings for relevant trademarks within the national trademark offices of the European Union member states are usually quite straightforward, using trademarks based on fictional characters can still be found troublesome in Europe as every use of a character's name or likeness, by either the owner or a third party, cannot be considered as a use of a trademark.[259] I've chosen to concentrate on United Kingdom and Germany with a short reference to one French case, as they are the three key European markets. Additionally, United Kingdom is a common law country while Germany and France are civil law countries.

In the United Kingdom the House of Lords denied trademark registration featuring the image of fictitious child character Holly Hobbie used in greeting cards, aimed to be licensed to other traders, because it held that "if there is no real trade connection between the proprietor of the mark and the licensee or his good", this would amount to trafficking and would not be permitted.[260] Later the English Court of Appeal rejected Edgar Rice Burroughs, Inc.'s trademark application for the term TARZAN in respect of films for exhibition and magnetic tape recordings, because it considered it only as a descriptive mark.[261] The court held that the word Tarzan had passed into the everyday language and become a household word by 1965, the date of the application for registration, making it therefore impossible to be adapted to distinguish the applicants' goods. The mark

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[257] Ibid., see also ECJ case C-104/00 P, 'Companyline', DKV Deutsche Krankenversicherung AG v. OHIM, 19 September 2002, http://curia.europa.eu/juris/document/document.jsf?text=&docid=47679&doclang=EN (accessed 29 April 2016).
[258] See footnote 255.
[259] Ewert 2008.
[260] In Re American Greetings Corporation's Application, [1984] 1 All ER 426; [1984] 1 WLR 189; [1984] RPC 329 (HL), http://www.swarb.co.uk/c/hl/1984american_greeting.html (accessed 29 April 2016). See also Preiss 2013 p. 6.
[261] [1970] R.P.C. 450, [1970] F.S.R. 245. See Preiss 2013 p. 6 and Ewert 2008.

referred directly to the character and the subject matter of the goods for which it was to be registered, because the goods were to be merchandise associated with a film dealing with the exploits of Tarzan.[262]

The High Court of Justice, Chancery Division, and later the England and Wales Court of Appeal, Civil Division, applied the same reasoning to the application for several trademark registrations for words ELVIS, ELVIS PRESLEY and the signature "Elvis A. Presley", denying registrations on each of the three marks on the ground of lack of distinctiveness.[263] The court held that the marks were merely describing the nature of the merchandise, seeking to evoke the name and memory of Elvis, rather than distinguishing the origin or the proprietor of the products.[264] Customers were buying Elvis merchandise because it carried the name or likeness of Elvis and not because it came from a particular source.[265] Similarly the Intellectual Property Office of the United Kingdom stated that no one would expect all material bearing name SHERLOCK HOLMES to originate from Conan Doyle or his estate because it has been used by many traders over the years in order to describe a story and a character, making the name descriptive for books, films, etc., lacking any distinctive character.[266]

The courts in Germany have repeatedly held that trademarks depicting famous characters from actual or literary history cannot qualify for protection of goods directly linked with the character, such as books or films, because of the lack of distinctiveness, but can be registered for other goods.[267] In *Winnetou Rückkehr,* the German Federal Court of Justice held that protection for the title *Winnetou Rückkehr* did not conflict with the public domain novel series by Karl May titled *Winnetou I-III*, as the German title protection was limited to the title functioning as an identification of the underlying work and even the minimal addition of *Rückkehr* was sufficient to move the title of the new novels outside the scope of protection of the original title.[268]

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[262] Ibid.
[263] Re Elvis Presley Trade Mark [1997] R.P.C. 543, http://www.elvisly-yours.com/judgment.html (accessed 29 April 2016) and [1999] R.P.C. 567, CA, http://www.elvisly-yours.com/judgement2.htm (accessed 29 April 2016). See also Preiss 2013 p. 6-7 and Ewert 2008.
[264] Ibid.
[265] Re Elvis Presley Trade Mark [1997] R.P.C. 543.
[266] Intellectual Property Office of the United Kingdom, 24 March 1999, regarding trade mark No 1 589 463. See OHIM BOA R 1856/2013-2, Yves Fostier v. Disney Enterprises Inc., 25 February 2015.
[267] Derclaye 2011 p. 252, Ewert 2008, Sakulin 2010 p. 186.
[268] Winnetous Rückkehr (Winnetou's Return), Bundesgerichtshof (BGH, Federal Court of Justice), 5 December 2002, I ZB 19/00, http://openjur.de/u/66065.html (accessed 29 April 2016). See also Derclaye 2011 p. 252-253.

The Federal Court of Justice did also later reject an application for the trademark WINNETOU because of the generic character and lack of distinctiveness of the name.[269] Similarly in *Jesse James* the German Federal Patent Court found the mark JESSE JAMES descriptive and rejected the application.[270] Regardless of some granted trademarks on famous characters, the German courts have more often held applied trademarks of fictional characters like Sherlock Holmes clearly descriptive of the content of a book or film.[271]

German courts have rejected trademark applications on grounds of the descriptive nature of the mark only when the trademark has been based on an actually famous character.[272] Thus the names of lesser known characters, such as the fictional detective Percy Stuart or "the little polar bear", have acquired the trademark protection applied.[273] The restrictive approach of German courts also extends to the visual representations of characters, as can be seen from the Federal Patent Court decision concerning trademark protection on photograph of Marlene Dietrich, famous German actress.[274] In that case the application was rejected for all types of goods connected directly with Dietrich herself because the court found that the portrait was devoid of any distinctive character.[275]

These British and German cases suggest that copyright owners should try to register trademark for fictional characters as early as possible, before the characters become well-known and are viewed as classical cultural icons, making the trademark descriptive to the general public.[276] Great example of this are the granted British and German

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[269] WINNETOU, Bundesgerichtshof (BGH, Federal Court of Justice), 23 January 2003, I ZR 171/00, http://openjur.de/u/66197.html (accessed 29 April 2016), see also Derclaye 2011 p.

[270] JESSE JAMES, Bundespatentgericht (BPatG, Federal Patent Court), 29 August 2007, 28 W (pat) 44/07, http://openjur.de/u/231654.html (accessed 29 April 2016).

[271] "Sherlock Holmes", BGH, 15 November 1957, I ZR 83/56, https://www.jurion.de/Urteile/BGH/1957-11-15/I-ZR-83_56 (accessed 29 April 2016), see also Ewert 2008. Examples of granted German Patent and Trade Mark Office (DPMA) trademarks feature marks 30339107 "Che Guevara" (https://register.dpma.de/DPMAregister/marke/register/303391073/DE, accessed 29 April 2016), 39847685 "Robin Hood" (https://register.dpma.de/DPMAregister/marke/register/398476853/DE, accessed 29 April 2016), and mark 2105469 "TARZAN" (https://register.dpma.de/DPMAregister/marke/register/2105469/DE, accessed 29 April 2016).

[272] Sakulin 2010 p. 186 and Ewert 2008.

[273] "Percy Stuart", BPatG, 5 December 2007, 32 W (pat) 33/06 (http://www.markenmagazin.de/bpatg-percy-stuart/, accessed 29 April 2016) and "Der kleine Eisbär", BPatG, 8 February 2006, 32 W (pat) 269/03 (https://openjur.de/u/229197.html, accessed 29 April 2016).

[274] BPatG, 9 November 2005, 29 W (pat) 147/03 (http://juris.bundespatentgericht.de/cgi-bin/rechtsprechung/document.py?Gericht=bpatg&Art=en&Datum=2006&Sort=3&Seite=0&nr=7953, accessed 29 April 2016), see also Ewert 2008 and Sentfleben 2015 p. 7.

[275] Ibid.

[276] Preiss 2013 p. 7 and Ewert 2008.

trademark registrations for HARRY POTTER, which were applied as early as 1999 and 2000, before any of the Harry Potter movies and after only the first three books.[277]

Jules Rimet Cup Ltd. v The Football Association Ltd. however shows that it is possible to prove distinctiveness for a trademark bearing a fictional character's name and depiction even decades later.[278] In this case the claimants applied to register their version of the 1966 Football World Cup mascot World Cup Willie, a cartoon lion dressed in Union Jack shirt, and the name WORLD CUP WILLIE as their trademarks in respect of a range of goods for the 2006 World Cup in Germany.[279] The Football Association Ltd., who hosted the 1966 World Cup, contacted at least one licensee, who terminated its agreement with Jules Rimet Cup Ltd., causing JRCL to bring an action seeking declarations that their trademark applications could not be opposed by the FA. The High Court held that JRCL did not infringe FA's copyright on the original mascot, but found that FA could have prevented the trademark application in 2005 by an action for passing off and that JRCL's trademark applications were made in bad faith.[280]

In a French case concerning the comic characters *Les Pieds Nickelés*, the Paris High Court stated that the modern versions, made by Guy Delcourt with the help of Patrick Cerf and Stéphane Oiry, of the public domain characters Ribouldingue, Croquignol and Filochard did not infringe the rights of Publications Georges Ventillard, who owned the publishing rights for the comic series.[281] The Paris High Court went as far as annulled Ventillards trademarks for *Les Pieds Nickelés* as they were considered fraudulent.[282]

4.3.2. The European Union case law

The former Office for Harmonisation in the Internal Market (OHIM), which is now called the EU Intellectual Property Office (EUIPO), has shown more leniency in registering Community Trade Marks (CTM), now known as European Union trade marks (EUTM),

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[277] UK00002206369, HARRY POTTER (https://www.ipo.gov.uk/tmcase/Results/1/UK00002206369, accessed 29 April 2016) and DE30012566, HARRY POTTER (https://register.dpma.de/DPMAregister/marke/register/300125666/DE, accessed 29 April 2016). See also Ewert 2008.
[278] Jules Rimet Cup Ltd. v The Football Association Ltd., [2007] EWHC 2376 (Ch); [2008] FSR 10; (2008) 31(1) IPD 31002, http://www.5rb.com/wp-content/uploads/2013/10/Jules-Rimet-v-FA-Ch-18-Oct-2007.pdf (accessed 29 April 2016). See also Preiss 2013 p. 7.
[279] [2007] EWHC 2376 (Ch).
[280] Ibid.
[281] Tribunal de Grande Instance (TGI) de Paris, 3e ch., 2e sect., Publications Georges Ventillard v. Guy Delcourt Productions, Syndicat national de l'édition (SNE), 1 July 2011. See Pasamonik 2011.
[282] Pasamonik 2011:2.

than some national European trademark offices. [283] Unlike the British and German trademark offices, OHIM has granted CTMs for TARZAN[284], ELVIS PRESLEY[285], JESSE JAMES[286], WINNETOU[287], and SHERLOCK HOLMES[288] representing books, films and related goods.[289] Because of this, even public domain characters like Tarzan or Sherlock Holmes are currently protected with European Union trade marks (EUTMs).[290]

Against the backdrop of previous registrations, the aforementioned OHIM Cancellation Division decision invalidating the ZORRO trademark for printed matter and entertainment could be seen as a step towards the approach adopted by the national courts.[291] In this case the Cancellation Division found the trademark as non-distinctive because the average consumer assumes that the Zorro is a subject matter and content of the good and services rather than recognise the term as an indicator of trade origin.[292] The Fourth Board of Appeals had earlier stated that Zorro's reputation in literary and other artistic productions did not mean that this reputation is automatically transferred to any other products that carry the word ZORRO, holding the ZORRO trademark registration for tobacco products done by other company, but OHIM Cancellation Division decision was the first case concerning the Zorro character in its original context.[293]

This isn't however the first time OHIM had refused to grant a trademark protection for character as the Cancellation Division referred to earlier Board of Appeals case law, like the decision on Winnetou trademark.[294] In *Winnetou* the First Board of Appeal stated that if the relevant public understands the name of a novel character as a synonym for a certain character, in view of its well-known nature, it is devoid of any distinctive

[283] Ewert 2008.
[284] 001117183, http://euipo.europa.eu/eSearch/#details/trademarks/001117183 (accessed 29 April 2016).
[285] 004406385,http://euipo.europa.eu/eSearch/#details/trademarks/004406385 (accessed 29 April 2016).
[286] 003412401, http://euipo.europa.eu/eSearch/#details/trademarks/003412401 (accessed 29 April 2016).
[287] 002735017, http://euipo.europa.eu/eSearch/#details/trademarks/002735017 (accessed 29 April 2016).
[288] 001263342, http://euipo.europa.eu/eSearch/#details/trademarks/001263342 (accessed 29 April 2016).
[289] Ewert 2008.
[290] See also Conan, 000302190, http://euipo.europa.eu/eSearch/#details/trademarks/000302190 (accessed 29 April 2016).
[291] OHIM Cancellation Division, Cancellation No 7924 C, Robert W. Cabell v. Zorro Productions Inc. See also Gardner 2015:3.
[292] OHIM Cancellation Division, Cancellation No 7924 C, Robert W. Cabell v. Zorro Productions Inc.
[293] OHIM BOA R 337/2008-4, Zorro Productions Inc. v. Jens Bleich and Jürgen Bleich.
[294] Ibid.

character, taking also the earlier German Federal Court of Justice decision into account.[295]

After *Winnetou* the Second Board of Appeal had found PINOCCHIO "incapable of being ascribed any meaning other than just a particular story", also stating that if a title is famous enough to the relevant public, primarily signifying a famous story or book title, a mark may be perceived as non-distinctive.[296] According to the Board of Appeals, the finding of non-distinctiveness is more likely if there has been a large number of published versions of the story and/or if there has been numerous television, theatre and film adaptations reaching a wide audience.[297]

If the trademark applicant wants to exploit a classic character from actual or literary history and there has already been several adaptations of the character, exposing the character to possibility of non-distinctiveness, he/she might want to consider the option of making certain alterations to the original character. This may have been the case with the Walt Disney Corporation substituting the name of the historical figure Hua Mulan, for whom the heroine of the animated feature film Mulan was loosely based, with the fictional name Fa Mulan while developing the film.[298] The Walt Disney Corporation however failed to file its trademark application in time, leading the company to a series of conflicts with third parties who had already applied for the trademark FA MULAN in anticipation of the film's release.[299]

Trademark based on a famous celebrity's name may also enjoy a significant scope of protection against even remotely similar trademarks, as shown in a German Federal Patent Court case between the trademarks BORIS BECKER and BORIS.[300] The European Court of Justice has later held in *Nichols* that a common surnames may be registered as trademarks, although with strict criteria, but such trademark cannot be used to prevent another person of the same name from using his or her name in commerce.[301]

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[295] OHIM BOA R 125/2012-1, Constantin Film Produktion GmbH v. Karl May Verwaltungs- und Vertriebs-GmbH, 9 July 2013.
[296] OHIM BOA R 1856/2013-2, Yves Fostier v. Disney Enterprises Inc., 25 February 2015.
[297] Ibid.
[298] OHIM Case No. R 1187/2000-2 of August 7, 2002, https://euipo.europa.eu/copla/trademark/data/000356691/download/CLW/APL/2002/EN/1129-2000-2. (accessed 29 April 2016). See also Ewert 2008.
[299] Ibid.
[300] Bundespatentgericht, 10 February 1998, 24 W (pat) 243/95. See Ewert 2008.
[301] ECJ case C-404/02, Nichols plc v. Registrar of Trade Marks, http://curia.europa.eu/juris/document/document.jsf?text=&docid=49511&doclang=EN (accessed 29 April

It is also important to notice that even if the trademark for a character is granted by the EUIPO, which seems less plausible nowadays, the owner may still have to face the national jurisdiction when enforcing the mark, as the courts responsible for deciding cases dealing with the infringement and revocation of EUTMs are national courts.[302]

4.4. Trademark fair use

Trademark rights are only obtained for specific goods and services in context where the mark is used, only affecting other parties' rights to use the mark for those or sufficiently related products to prevent customer confusion as to source.[303] Use of someone else's trademark may however also be permissible if it is descriptive or nominative.[304] The descriptive use, which is also often called "classic fair use" refers to situations, where trademark holder's mark is used to describe alleged infringer's own good or services rather than identifying the source of trademark holder's products, and the latter, nominative fair use, to situations where someone else's trademark is used to refer to the actual goods and services that trademark is protecting and not the one's of the alleged infringer.[305]

These special circumstances permitting someone other than the trademark owner to use the trademark are called fair use defenses, but are not to be confused with the fair use doctrine in copyright, regardless they both refer to exceptions to exclusive intellectual property rights.[306]

4.4.1. The European Union

In the European Union, the descriptive use defense can be derived from Article 12 of the Council Regulation (EC) No 207/2009, which states that trademark cannot entitle the proprietor to prohibit a third party from using, in the course of trade, his own name or address; "indications concerning the kind, quality, quantity, intended purpose, value,

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2016). See Article 12(a) of the amended European Union trade mark regulation, (EC) No 207/2009, https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/legal_reform/regulation_20152424_en.pdf (accessed 29 April 2016).

[302] Ewert 2008.

[303] Zissu 2004 p. 455.

[304] INTA 2015 and Fhima 2011 p. 227.

[305] Cairns v. Franklin Mint Co., 292 F.3d 1139, 1151 (9th Cir. 2002), https://casetext.com/case/cairns-v-franklin-mint-co-2 (accessed 29 April 2016).

[306] INTA 2015.

geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service"; or even the trademark if it is necessary to indicate the intended purpose of accessories or spare parts - provided that the use is in accordance with honest practices in industrial or commercial matters.[307] However after the ECJ decisions on *Adam Opel* and *Gillette v. LA Laboratories*, the scope of this defense is unclear.[308] Additionally, as mentioned before, the use of surname can be considered as be fair use, even if that surname is the same as or similar to existing registered trademark.[309]

In the United Kingdom fair use provision can be found in Section 11(2) of the Trademarks Act of 1994 (TMA) and in *International Business Machines Corp.,* the Chancery Division of the High Court of Justice stated that this exception may apply even if there is some actual confusion with a registered mark.[310] Similarly in *Reed Executive P.L.C. v. Reed Business Information Ltd.,* the Supreme Court stated that if the alleged infringing use is applicable with the Section 11(2) of the TMA, only question is whether use has been in accordance with honest practices in industrial or commercial matter, relying also on the ECJ case *Gerolsteiner Brunnen GmbH & Co. v. Putsch GmbH*, where the ECJ found that the geographical name KERRY did not infringe on the trademark GERRI, provided it was used in accordance with honest practices.[311]

4.4.2. The United States

In the United States, the use of the protected mark may be permitted if the use is descriptive or concerns the personal name of the alleged infringer or a person connected

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[307] Council Regulation (EC) No 207/2009 on the Community trade mark as amended by the Regulation (EU) 2015/2424, see footnotes 255-256. Similar provisions on national trademarks can be found in Article 6(1)(b) of the Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32008L0095&from=EN (accessed 29 April 2016).

[308] ECJ C-48/05, Adam Opel AG v. Autec AG, http://curia.europa.eu/juris/document/document.jsf?text=&docid=65459&doclang=EN (accessed 29 April 2016); and ECJ C-228/03, The Gillette Company and Gillette Group Finland Oy v. LA-Laboratories Ltd Oy, http://curia.europa.eu/juris/document/document.jsf?text=&docid=54126&doclang=EN (accessed 29 April 2016). See also Fhima 2011 p. 231-232, 235.

[309] INTA 2015.

[310] Ewelukwa 2011 p. 136-139. International Business Machines Corp. v. Web-Sphere Ltd., [2004] EWHC (Ch.) 529, http://www.oami.europa.eu/pdf/natcourt/Websphere.pdf (accessed 29 April 2016).

[311] Reed Executive P.L.C. v. Reed Business Information Ltd., [2004] EWCA (Civ) 159, http://www.5rb.com/wp-content/uploads/2013/10/Reed-Executive-v-Reed-Business-Information-CA-3-Mar-2004.pdf (accessed 29 April 2016); and ECJ C-100/02, Gerolsteiner Brunnen GmbH & Co. v. Putsch GmbH, http://curia.europa.eu/juris/document/document.jsf?text=&docid=48822&doclang=EN (accessed 29 April 2016). See also Ewelukwa 2011 p. 139.

with the alleged infringer, provided that the term is used fairly and in good faith solely for that purpose.[312] There isn't however an absolute right to use to use your own name as a tradename if the use could cause confusion to a similar famous mark associated with another source.[313] Similar provisions protecting the non-trademark use can also be found in Section 33 of the Lanham Act.[314]

The Supreme Court held in *KP Permanent Make-Up* that an alleged infringer relying on the classic defense of descriptive fair use doesn't need to prove that his use isn't confusing consumers about the origin of the goods as even use that might cause some confusion can be considered as fair.[315] Even though the plaintiff has the burden of proof to show that defendant's use of mark is likely to cause consumer confusion, the mere existence of a risk of confusion does not disprove a fair use defense.[316] In this case the Lasting Impression I, Inc. had trademark for the phrase "micro color", but KP Permanent Make-Up, Inc. sued for declaratory judgment, claiming it used the term first.[317] The writ of certiorari was granted on the issue of which party had the burden of proof to demonstrate likelihood of confusion.[318]

When it comes to nominative fair use defense, the Ninth Circuit held in *New Kids on the Block v. News America Publishing* that even commercial trademark use may be permissible provided, that 1) the product or service in question is not readily identifiable without use of the trademark, 2) only so much of the mark is used as is reasonably necessary to identify the product or service, and 3) use of the mark does not suggest sponsorship or endorsement by the trademark owner.[319] In this case the defendant had performed a survey on the band New Kids on the Block and the Ninth Circuit found that it is often virtually impossible to refer to a particular product for purposes of comparison, criticism, or point of reference without using the mark.[320] The nominative fair use

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[312] Section 28 of the Restatement (Third) of Unfair Competition (1995) by the American Law Institute, http://is.muni.cz/th/169953/pravf_m/Extract_III.pdf (accessed 29 April 2016). See also American Bar Association 2006 p. 71.
[313] INTA 2015.
[314] 15 U.S. Code § 1115(b)(4), https://www.law.cornell.edu/uscode/text/15/1115 (accessed 29 April 2016).
[315] KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 117-19 (2004), https://www.law.cornell.edu/supct/html/03-409.ZO.html (accessed 29 April 2016). See also American Bar Association 2006 p. 71-72.
[316] 543 U.S. 119-122 (2004). See also Ewelukwa 2011 p. 98.
[317] 543 U.S. 114 (2004).
[318] Ibid.
[319] New Kids on the Block v. News America Publishing, 971 F.2d 302, 308 (9th Cir. 1992), http://cyber.law.harvard.edu/metaschool/fisher/integrity/Links/Cases/newkids.html (accessed 29 April 2016). See also American Bar Association 2006 p. 72 and INTA 2015.
[320] New Kids on the Block v. News America Publishing, 971 F.2d 306-307 (9th Cir. 1992).

defense was extended to website meta-tagging in *Playboy Enterprises, Inc. v. Welles*, where the Ninth Circuit found that Terri Welles had to use the trademark protected term to completely describe herself truthfully as the Playmate of the Year 1981.[321]

The freedom of speech rights, as guaranteed by the First Amendment, also allow some confusion caused by the use of trademark in the title of a creative or communicative work with at least some relationship to the content if the mark is used for creative expression and not primarily for a commercial purpose.[322] This was laid down by the Second Circuit in its decision on *Rogers v. Grimaldi*, where it found that the plaintiff's concern of the title misleading the consumers was overweighed by the defendants' freedom of expression, in danger being unduly restricted by suppressing an artistically relevant though ambiguous title, and held no violation.[323]

In this case Ginger Rogers sued Alberto Grimaldi, MGM/UA Entertainment Co., and PEA Produzioni Europee Associate, S.R.L., alleging that Federico Fellini's film *Ginger and Fred*, produced and distributed by the defendants, violated her 1) Lanham Act trademark rights, by "creating the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film"; 2) her right of publicity; and 3) her right to privacy by depicting her in a false light, defaming her.[324] The Second Circuit stated that he Lanham Act does not bar "a minimally relevant use of a celebrity's name in the title of an artistic work where the title does not explicitly denote authorship, sponsorship, or endorsement by the celebrity or explicitly mislead as to content", creating the rule known as the *Rogers* test.[325]

The *Rogers* test has been extended by the Second Circuit in *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, where it stated that the test was "generally applicable to Lanham Act claims against works of artistic expression", including parody context.[326] Additionally in *Girl Scouts of America v. Bantam Doubleday Dell Publishing Group*, the District Court for the Southern District of New York found that the test

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[321] Playboy Enterprises, Inc. v. Welles, 279 F.3d 796, 802 (9th Cir. 2002), quoting the District Court decision 78 F.Supp.2d 1066 (S.D.Cal.1999), http://caselaw.findlaw.com/us-9th-circuit/1233126.html (accessed 29 April 2016).
[322] Zissu 2004 p. 455, Schreyer 2015 p. 89.
[323] Rogers v. Grimaldi, 875 F.2d 994, 1005 (2d Cir. 1989), https://law.resource.org/pub/us/case/reporter/F2/875/875.F2d.994.88-7828.88-7826.600.601.html (accessed 29 April 2016), see also Schreyer 2015 p. 89.
[324] Rogers v. Grimaldi, 875 F.2d 997 (2d Cir. 1989).
[325] Rogers v. Grimaldi, 875 F.2d 1005 (2d Cir. 1989).
[326] Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc., 886 F.2d 490 (2d Cir. 1989), http://law.justia.com/cases/federal/appellate-courts/F2/886/490/19015/ (accessed 29 April 2016).

weighing necessity to underlying artistic expression with the possibility of consumer confusion applied regardless of the medium of artistic expression.[327] Courts have also applied the *Rogers* test to trademark used in the body of the work, in *ESS Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, and to paintings in *ETW Corporation v. Jireh Publishing, Inc.*[328] The Eleventh Circuit applied the latter decision in *University of Alabama Board of Trustees v. New Life Art, Inc.*, where it weighed the public interest in free expression with the commercial interest of the trademark holder.[329]

The Ninth Circuit adapted the *Rogers* test in Mattel v. MCA Records, where it upheld the dismissal of the District Court for the Central District of California, ruling that the song *Barbie Girl* by a Danish band Aqua did not infringe Mattel's trademark rights in the Barbie name.[330] The Ninth Circuit stated that title *Barbie Girl* merely described the underlying work and that Mattel did not have the right to control public discourse whenever someone imbued their mark with a meaning beyond its source-identifying function – which is precisely what Aqua did with their song, making fun of the cultural values they claim Barbie represents.[331] This lampooning use also caused song title to fall within the non-commercial exemption of the FTDA, dismissing Mattel's dilution claims, even though MCA's use was blurring the Barbie mark.[332]

Similarly in a case against Thomas Forsythe's Walking Mountain Productions, the Ninth Circuit affirmed the district court's judgement and found that Forsythe's use of the Barbie name in the titles of his photographs, depicting nude Barbie dolls juxtaposed with vintage kitchen appliances, was artistic expression accurately describing the subject of the photos and not explicitly misleading Mattel as to the source or the content of the photos.[333] It is however important to notice that these cases involved parodying uses of

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[327] Girl Scouts of the United States of America v. Bantam Doubleday Dell Publishing Group, Inc., 808 F. Supp. 1112, 1121 (S.D.N.Y. 1992), http://law.justia.com/cases/federal/district-courts/FSupp/808/1112/1478554/ (accessed 29 April 2016).
[328] ESS Entertainment 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095 (9th Cir.2008), http://caselaw.findlaw.com/us-9th-circuit/1485435.html (accessed 29 April 2016); and ETW Corporation v. Jireh Publishing, Inc., 332 F.3d 915, 918–19 (6th Cir.2003), https://casetext.com/case/etw-corp-v-jireh-pub-inc (accessed 29 April 2016).
[329] University of Alabama Board of Trustees v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012), http://caselaw.findlaw.com/us-11th-circuit/1603066.html (accessed 29 April 2016).
[330] Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894 (9th Cir. 2002), cert. denied 537 U.S. 1171 (2003), https://law.resource.org/pub/us/case/reporter/F3/296/296.F3d.894.98-56577.html (accessed 29 April 2016). See also Schreyer 2015 p. 90.
[331] Mattel, Inc. v. MCA Records, Inc., 296 F.3d 902 (9th Cir. 2002).
[332] Mattel, Inc. v. MCA Records, Inc., 296 F.3d 908 (9th Cir. 2002).
[333] Mattel, Inc. v. Walking Mountain Productions, 353 F.3d 792 (9th Cir. 2003), http://ncac.org/resource/mattel-inc-v-walking-mountain-productions (accessed 29 April 2016). See also Schreyer 2015 p. 90.

the mark and trade dress for the Barbie doll, but not the character itself, and there has not been any fair use trademark cases concerning previously copyrighted characters.

Another fair use test was introduced earlier by the Second Circuit in aforementioned *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.,* where the court found that defendant could have found "alternative avenues of communication" to express their comments on the possible sexuality in athletics without infringing the Dallas Cowboys Cheerleaders trademark, citing the Supreme Court's reasoning in *Lloyd Corp. v. Tanner*.[334] After this decision, the Second Circuit has however limited the application of "alternative avenues of communication" test to cases which involve "blatantly false and misleading advertising".[335] Additionally, the Southern District of California adopted this test in *Dr. Seuss Enterprises v. Penguin Books USA, Inc.*[336]

[334] Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema Ltd., 604 F.2d 206 (2d Cir. 1979), see chapter 4.2.3. Lloyd Corp. v. Tanner, 407 U.S. 551, 567 (1972), https://casetext.com/case/lloyd-corp-v-tanner#p567 (accessed 29 April 2016).
[335] Ocean BioChem, Inc. v. Turner Network Television, 741 F. Supp. 1546, 1560 n.8 (S.D. Fla. 1990), citing Silverman v. CBS Inc., 870 F.2d 48 (2d Cir.) and Rogers v. Grimaldi, 875 F.2d 999 (2nd Cir. 1989). See Given 1998.
[336] Dr. Seuss Enterprises v. Penguin Books USA, Inc., 924 F. Supp. 1559 (S.D. Cal. 1996), http://law.justia.com/cases/federal/district-courts/FSupp/924/1559/1471640/ (accessed 29 April 2016).

5 ESTIMATING THE FUTURE OF CHARACTER PROTECTION

5.1.1. Zorro's Ride into Terror[337]

Playwright Robert W. Cabell originally filed a lawsuit against Zorro Productions, Inc. (ZPI) in District Court for the Western District of Washington in 2013, claiming that trademark registrations on Zorro relating to literary works, visual arts, and performing arts should be cancelled because Zorro is in public domain.[338] Cabell brought suit after ZPI threatened to sue him and his licensees for trademark and copyright infringement purportedly relating to his musical *Z - the Musical of Zorro*, based on Johnston McCulley's 1919 novel *The Curse of Capistrano* and a 1920 silent movie *The Mark of Zorro* by Douglas Fairbanks, Sr., which are both in public domain.[339] Cabell cites the District Court for the Central District of California case *Sony Pictures Entertainment v. Fireworks Entertainment Group*, where the court noted in a footnote that all of the essential character elements of Zorro expressed in *The Curse of Capistrano* and in *The Mark of Zorro* moved into the public domain when the renewal terms of those copyrights expired – either in 1948 or 1995.[340]

Cabell also accused ZPI of fraud, tortious interference, and unfair competition and claimed that ZPI had even duped the United States Patent and Trademark Office (USPTO) while obtaining its ZORRO trademark registrations, such as U.S. Trademark Reg. No. 2,198,254 of word mark ZORRO in entertainment, especially in the nature of theatre productions.[341] According to ZPI, this particular mark prevents third parties from promoting Zorro musicals, even based on public domain stories. Cabell amended his lawsuit to add that ZPI had copied original material from his musical and used it as the

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[337] Title of the eighth episode of the first season of *Zorro* television series, first aired 28 November 1958 (http://www.imdb.com/title/tt0762802/, accessed 29 April 2016).

[338] Gardner 2013. See also United States District Court for Western District of Washington case 2:13-cv-00449, Robert W. Cabell v. Zorro Productions, Inc., John Gertz, and Stage Entertainment Licensed Productions, Complaint for declaratory judgment, cancellation of federal trademark registrations, injunctive relief, and monetary damages, filed 13 March 2013, https://www.scribd.com/doc/130370303/Zorro (accessed 29 April 2016).

[339] Ibid.

[340] Sony Pictures Entertainment v. Fireworks Entertainment Group, 137 F. Supp. 2d 1198 (C.D. Cal. 2001). See chapter 4.2. and footnote 143.

[341] See footnote 338.

basis for their own musical as well as book by author Isabel Allende upon which it was based, offered to Cabell's licensees.[342]

ZPI argued court's lack of personal jurisdiction and, regardless of Cabell's argumentation that the defendants had "purposefully availed themselves of the benefits of doing business in the State of Washington", District Judge Ricardo Martinez agreed, dismissing the lawsuit.[343] This wasn't however the end as Judge Martinez reconsidered the case after Cabell's motion for partial reconsideration and eventually transferred the case to the Northern District of California, mainly because of the dismissal's potential to preclude Cabell from seeking recovery from his amended claims on ZPI violating his copyright.[344]

As stated before, OHIM Cancellation Division declared ZORRO CTM invalid for printed matter and entertainment but the decision has been appealed.[345] Furthermore the District Court for the Northern District of California hasn't decided the Unites States case yet so regardless of the earlier decisions on the public domain, señor Zorro still has to wait for the certainty on his trademark protection.[346]

5.1.2. The Curious Case of Mickey Mouse

Ever since the Air Pirates case, Disney's Mickey Mouse character has been in the centre of discussion for intellectual property right protecting fictional characters.[347] Although Disney's attitude towards Mickey is understandable, as "Mickey Mouse character identifies and symbolizes Disney itself" – and additionally he was estimated to be worth 5.8 billion dollars annually to Disney in 2004 – this one particular rodent might have

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[342] Ibid. See also Gardner 2015.
[343] United States District Court for Western District of Washington case 13-cv-00449, Order granting defendant's motion to dismiss, 21 October 2014, https://www.scribd.com/doc/244931441/zorro2 (accessed 29 April 2016); 2:13-cv-00449-RSM, Motion to dismiss of defendants, filed 16 May 2013, https://www.scribd.com/doc/244931442/zorro1 (accessed 29 April 2016); and footnote 338. See also Gardner 2014.
[344] 2:13-cv-00449-RSM, Order granting plaintiff's motion for partial reconsideration, 3 February 2015, https://docs.justia.com/cases/federal/district-courts/washington/wawdce/2:2013cv00449/191388/84 (accessed 29 April 2016). See also Gardner 2015.
[345] OHIM Cancellation Division, Cancellation No 7924 C, Robert W. Cabell v. Zorro Productions Inc. and Correspondence for EUTM 005399787, https://euipo.europa.eu/eSearch/#details/trademarks/005399787 (accessed 29 April 2016).
[346] Cabell v. Zorro Productions, Inc. et al, California Northern District Court, Case No. 4:15-cv-00771, http://www.plainsite.org/dockets/2k6euaa1h/california-northern-district-court/cabell-v-zorro-productions-inc-et-al/ (accessed 29 April 2016).
[347] See chapter 2.2.

pushed the boundaries of his protection too far, finally affecting the trademark and copyright protection of all fictional characters.[348]

Even though Mickey Mouse first publicly appeared in as the character Steamboat Willie in animated short film of the same name in 1928 and the Copyright Act of 1909 would have caused the copyright to expire in 1984, with renewal, after the Copyright Term Extension Act (CTEA) of 1998, the character depicted in *Steamboat Willie* enters the public domain 1 January 2024.[349] The CTEA is often referred as "The Mickey Mouse Protection Act" as Disney lobbied heavily to pass the Act, preventing Mickey to enter public domain in 2004.[350] Internet publisher Eric Eldred, represented by legal scholar Lawrence Lessing, contested the constitutionality of the CTEA, but the United States Supreme Court eventually held that the retroactive extension did not violate the Copyright Clause or the First Amendment of the United States Constitution.[351]

It is important to notice that even though the source of Mickey is in his first appearance, only the version of Mickey Mouse depicted in "Steamboat Willie" is entering the public domain in 2024 as there are several characteristics added in the later works – situation similar to Sherlock Holmes in *Leslie Klinger v. Conan Doyle Estate, Ltd.* [352] But even if Disney doesn't succeed to prolong to US copyright protection again and this certain version of Mickey Mouse enters the public domain in January 1, 2024 as planned, he is still protected with the trademarks registered by the Disney Enterprises, Inc.[353] And as stated in *Frederick Warne & Co., Inc. v. Book Sales Inc.*, trademark can protect a public domain character if the character has "secondary meaning" identifying the origin of the character – a trait Mickey Mouse certainly possesses as the pre-eminent symbol of Disney.[354]

The current appearance of Mickey Mouse differs significantly from "Steamboat Willie", preventing the use of any other depiction of Mickey after *Steamboat Willie* enters the public domain, but the trademark registration for the visual aspect of Mickey used in "animated and live action motion picture films", inter alia, looks lot more like the original

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[348] Walt Disney Company v. Transatlantic Video Inc., U.S.D.C., Central District of California, Case No. CV-91-0429 (1991), and Gisquet–Rose 2004.
[349] Liu 2013 p. 1408 and Crockett 2016. See also footnote 43.
[350] Carlisle 2014, Crockett 2016.
[351] Eldred v. Ashcroft, 537 U.S. 186 (2003), https://supreme.justia.com/cases/federal/us/537/186/case.html (accessed 29 April 2016).
[352] See footnote 64, Crockett 2016, and Carlisle 2014.
[353] Crockett 2016 and Carlisle 2014.
[354] See footnote 149.

Mickey than his modern depiction.[355] The registration, filed in 2004 when the copyright protection for *Steamboat Willie* would have expired without the CTEA, also states that the colour is not claimed as a feature of the mark, making the registration black and white instead of featuring the signature red shorts and yellow shoes of the modern day Mickey.[356]

Additionally, it can be argued that the *Dastar* would overrule *Warne*, stating that copyright protection cannot be extended with trademarks, but as Columbia Law School Professor Jane C. Ginsburg expressed in her recent Copyright Society of the USA presentation, *Dastar* did not explicitly answer the question of whether a public domain cartoon can be trademark protected and *Warne* is distinguishable from *Dastar*.[357] With enormous amount of money and effort invested in protecting Mickey and growing public interest in exploiting the character, lawsuits clarifying the boundaries of *Dastar* are imminent.[358]

Mickey isn't however the first important Disney character to enter public domain as the first Winnie the Pooh stories by A.A. Milne were published in 1926, two years before "Steamboat Willie", with Pooh entering the public domain in the beginning of 2022.[359] Additionally, the original Milne character or its visual depiction by Ernest H. Sheppard did not originate from Disney and *Warne* requires trademark to be able to identify the creator.[360] So even though Disney has multiple trademark registrations for WINNIE THE POOH, including "motion picture films in the nature of adventure and comedy", only elements they own as the creator are the elements later added to the character by them, making the trademark protection of Winnie the Pooh significantly weaker than Mickey Mouse's.[361]

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[355] Trademark 3598848, USPTO, http://tsdr.uspto.gov/#caseNumber=3598848&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=statusSearch, accessed 29 April 2016. See also Carlisle 2014.
[356] Ibid.
[357] Gisselberg 2016.
[358] Moffat 2004 p. 1507.
[359] Carlisle 2014.
[360] Ibid.
[361] Trademark 3038490, USPTO, http://tsdr.uspto.gov/#caseNumber=3038490&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=statusSearch, accessed 29 April 2016. See also Carlisle 2014.

5.1.3. More general cases potentially effecting the future

There are also several other cases determining the future of trademark protection of fictional characters, including the characters of Sherlock Holmes and Buck Rogers, and illustrating the possible challenges trademark protected characters might cause. Majority of these cases are from the United States, but their impact can be seen in Europe as well.

Even though the Seventh Circuit confirmed that the first Sherlock Holmes stories are no longer copyright protected in *Leslie Klinger v. Conan Doyle Estate, Ltd.*, that didn't stop the Conan Doyle Estate (CDE) from hitting Miramax with copyright and trademark infringement lawsuit over the movie *Mr. Holmes*, starring Sir Ian McKellen as retired Sherlock.[362] This case, targeted against Miramax, Penguin Random House, and Mitch Cullin, author of the book *A Slight Trick of The Mind* the movie was based on, was filed only couple of months before the movie was due to be released with CDE claiming that Cullin took elements of the Sherlock Holmes character from the still protected ten Canonical stories to his work and alleging the movie makers of creating confusion on the origin of the movie, injuring CDE's reputation.[363] CDE also pointed out that every other film studio project, including Warner Brothers' movies, BBC's *Sherlock* series and CBS' *Elementary* series, had licensed their works with CDE.[364] Even though Mitch Cullin initially described the lawsuit as "an extortion attempt pure and simple, brought on by the desire to make money once the film version of the book came to their attention", the case was settled and the legal status of Sherlock Holmes trademarks is still unclear.[365] The timing of CDE's suit was well planned, as Miramax decided to settle and release their movie in schedule rather than risk an expensive and potentially lengthy court proceeding postponing their movie. This is an excellent example of the problems rising from trademark registrations granted to fictional characters as they can potentially harm the derivative works even with questionable claims.

More recently, film producer Don Murphy filed a lawsuit asking the District Court for the Central District of California to declare that novel *Armageddon 2419 A.D.* by Philip

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[362] For Seventh Circuit ruling see chapter 2.2.4. and footnote 64. See also Gardner 2015:2.
[363] United States District Court for the District of New Mexico case 1:15-CV-432, Conan Doyle Estate Ltd. v. Miramax, LLC, Roadside Attractions LLC, Penguin Random House LLC, Mitch Cullin, and William Condon, Complaint for injunction and damages, filed 51 May 2015, https://www.scribd.com/doc/266283769/Mr-Holmes (accessed 29 April 2016). See also Gardner 2015:2.
[364] Ibid.
[365] Houghton 2015.

Nowlan, originally published in 1928, is in the public domain.[366] Additionally Murphy asked the court to void all the trademarks based on Buck Rogers character because the origins of the character are in public domain and the Dille Family Trust, which owns to rights to Buck Rogers character, threatened to sue Murphy as they had not given him any license to use the character.[367] The case was moved to the Western District of Pennsylvania because the trustee for the Dille Family Trust, Louise A. Geer, lives there and eventually decided by District Judge Joy Conti, who dismissed the case because it did not have actual controversy nor immediacy or reality of alleged infringements.[368] This means that the intellectual property rights covering Buck Rogers will not be decided until someone actually produces a potentially infringing work. Interestingly, the Nowlan Family Trust had applied for registration of the EUTM for BUCK ROGERS for, inter alia, motion pictures just few months before the lawsuit.[369]

There is also a recent case in the Central District of California, where Paramount Pictures Corporation and CBS Studios Inc. filed a law suit against Axanar Productions, Inc., and other makers of crowdfunded Star Trek mockumentary called *Prelude to Axanar*[370]. The movie studios claim that the Anaxar project infringes "innumerable copyrighted elements of Star Trek, including its settings, characters, species, and themes", and the defendants replied claiming that several of these elements, such as words and short phrases, the Klingon language, or the Vulcan appearance are not protected by copyright and .[371] Paramount and CBS, however, see the use of Klingon language, being an aspect of the Klingon characters, as further evidence of the infringement and demand similar protection to Star Trek starships as Batmobile had in *DC Comics v. Towle*.[372] As *Prelude*

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[366] United States District Court for the Central District of California, Case 2:15-cv-05880-FFM, Team Angry Filmworks, Inc. v. Louise A. Geer as the trustee of Dille Family Trust, Complaint for declatory judgment, filed 4 August 2015, http://cdn.arstechnica.net/wp-content/uploads/2015/08/buckrogers.pdf (accessed 29 April 2016). See also Kravets 2015 and Gardner 2015:4.

[367] Ibid.

[368] United States District Court for the Western District of Pennsylvania, Civ. No. 15-1381, Case 2:15-cv-01381-JFC, 21 March 2016, https://www.documentcloud.org/documents/2774821-Buck.html (accessed 29 April 2016). See also Gardner 2016.

[369] 014259551, https://euipo.europa.eu/eSearch/#details/trademarks/014259551 (accessed 29 April 2016).

[370] Van der Sar 2015.

[371] United States District Court for Central District of California case 2:15-cv-09938-RGK-E, Paramont Pictures Corporation and CBS Studios Inc. v. Axanar Productions, Inc., Alec Peters, and Does 1-20, Complaint for copyright infringement, contributory copyright infringement, vicarious copyright infringement and declaratory judgment, filed 29 December 2015, https://torrentfreak.com/images/576e12e5-d7ec-4533-a726-49fa08328d5b.pdf (accessed 29 April 2016). See also Van der Sar 2016.

[372] United States District Court for Central District of California case 2:15-cv-09938-RGK-E, Plaintiff's opposition to defendant's motion to dismiss or strike in part plaintiff's first amended complaint, dated 11

to Axanar and its follow-up have together gathered over 738 000 dollars through crowdfunding, a hefty sum for fan-art project, in my opinion this uncertainty on copyright protection might have been avoided or at least the claims could have been reinforced with Paramount and CBS trademarks because costumes, phrases, and "the total concept and feel" of characters can also be trademark protected.[373] These were established in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, in *Lone Ranger* cases and in *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, respectively.[374]

April 2016, https://torrentfreak.com/images/klingrep.pdf (accessed 29 April 2016). See also Van der Sar 2016:2.

[373] Ibid.

[374] See chapters 4.2.3. and 4.2.4.

6 CONCLUSIONS

Unlike exclusive rights granted for the authors of copyrighted works, which are designed to be valid for only a limited time period, ultimately releasing the works to be freely exploited by the public, trademark protection can be practically perpetual. And although majority of the trademark classes doesn't prevent derivative works, some trademark registrations for previously copyright protected fictional characters are spreading out to the classes or formats the characters were originally published in, such as motion pictures or literature. Right before the copyright protection of several famous early twentieth century characters is expiring, the public domain is actually shrinking and some of the most important characters and the works they originate from may never be truly public.

As discussed before, there are some requirements for the character to be recognized as a registrable and enforceable trademark that aren't met with every single character, especially the ones with no visual representation. Even though Disney has a registered trademark SNOW WHITE for motion pictures on both sides of the Atlantic, that didn't prevent Universal Studios from releasing their film *Snow White and the Huntsman* in 2012 as the original character doesn't originate from Disney.[375] Similarly Disney has over 50 characters that are based in public domain works with copyright protecting only the Disney version of their appearance and traits.[376] There are however some characters, like Mickey Mouse, that are so famous and so closely associated with their creators that they can easily be protected with trademarks even after the expiration of their copyright protection.[377] These symbolic characters might be exceptions never relinquished, but at the same time they are the characters of the greatest interest, both creatively and commercially.

Trademark protection of a fictional character may offer huge benefits to the right holder in the form of product licensing and other endorsements.[378] Additionally, as settled case of *Mr. Holmes* movie in the previous chapter showed us, merely the possibility of a

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[375] Trademark 77618057 USPTO (http://tsdr.uspto.gov/#caseNumber=77618057&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=statusSearch, accessed 29 April 2016), EUTM 005235502, (https://euipo.europa.eu/eSearch/#details/trademarks/005235502, accessed 29 April 2016) and Carlisle 2014.

[376] Crockett 2016.

[377] Carlisle 2014.

[378] See e.g. Conan Props Inc. v. Conans Pizza Inc., 752 F.2d 145, 150 (5th Cir. 1985) or Warner Bros. Inc. v. Gay Toys Inc., 658 F.2d 76, 79 (2d Cir. 1981) in footnote 184.

trademark infringement lawsuit may bully the alleged infringer to acquire a license - even in situations where the license isn't necessarily needed at all. And while the national courts in Europe and the European Union Intellectual Property Office, formerly known as OHIM, have begun to be more critical to the trademark applications based on fictional characters, the *Dastar* decision didn't bring a conclusion to the situation in the United States and the USPTO continues to grant trademark registrations for fictional characters in classes containing, inter alia, motion pictures or printed matter. I find it very likely that we will see more trademark infringement cases on fictional characters, especially if the term of copyright protection isn't prolonged again and well-known characters actually start entering the public domain. And as nearly every recent case has narrowed to scope of trademark protection of public domain characters, if they haven't been settled, the growing interest to utilize fictional characters could result in expansion of the public domain. Additionally, the average economic life of trademark is only 15 percent longer than that of the average copyright, releasing several trademarked characters eventually to the public domain anyway.[379]

We might never get to see a commercial adaptation telling us the story of Tarzan, Zorro, and Mickey Mouse going to a bar, but with all the recent case law there may well be time when at least the first two characters can enjoy a refreshment together without the fear of trademark infringement claim - if we forget the fact that Zorro stories are supposed to take place almost 100 years before the Tarzan stories.

[379] Landes–Posner 2002 p. 40.

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