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Have You Seen Sam Spade?: How Literary Characters Are Denied Proper Copyright Protection

By: Michael Heitmann

Introduction

Harry Potter, James Bond, Frodo, Batman, and Spider Man. What do all these characters have in common? They represent five of the ten highest grossing movie franchises of all time.¹ Characters such as these have been a very valuable source of income for a variety of companies, representing billions of dollars in potential revenue. They have been utilized in movies, video games, toys, TV shows, commercials and a variety of other forms beyond the original medium in which they originally appeared. These characters and others like them are pop culture icons that have become part of the American Zeitgeist.

These iconic characters were all created in literary works; however, they are not treated equally under copyright law. Perplexingly, only characters with a visual representation, such as Batman or Spider Man, consistently receive the full protection afforded under the Copyright Act of 1976. Characters that were initially developed as purely literary characters have been treated as second class characters until they received a visual representation through movies. However, this result is not mandated by the Act itself, but rather is the result of a series of judicial decisions which have evolved over time to the current situation.

Under the Copyright Act of 1976, a literary work is copyrightable if it is an original work of authorship that is fixed in any tangible medium of expression.² Nevertheless, the Act is silent on whether or not a character can be protected outside of the work in which they originally appeared. Thus, a character like Holden Caulfield may be protected as a part of the novel
Catcher in the Rye, but it is not entirely clear if he would be protected if another author used him in a completely different work. This is an extremely important issue because the value and recognition of many of these characters transcend the work in which they originally appeared. Characters that began life as literary creations are then adapted into films, video games, or other mediums, where they are given a visual representation. There is no clear answer about whether these characters are only protectable under the Copyright Act when they receive this visual representation or whether they were always worthy of protection.

A central tenet of the Copyright Act is that only the expression of an idea is protected, not the underlying idea itself. This protects the rights of authors while allowing for future creative works by protecting core ideas that can be incorporated into all creative works. If these underlying core ideas were also protectable under the Copyright Act, it would quickly create a situation where authors would not be able to create new works without unlawfully infringing on previous works. Thus, Herman Melville can likely receive protection for the character of Captain Ahab from Moby Dick, but would be unable to protect a generic ship’s captain with one leg. This is because the character of Captain Ahab rises above such a commonplace “stock character” to become something wholly unique, a fanatical and tragic figure whose obsession with revenge costs him his very life. Characters such as Captain Ahab are very easy to distinguish from “stock characters,” but this is not the case for every character.

This can be a difficult line for courts to draw and is the reason they have struggled with the concept of copyright protection of literary characters. What makes these characters memorable and worthy of protection is that they touch upon and build on these underlying themes and universal truths. It enables the author to make their characters relatable to their readers and contributes to their popularity. The challenge for the courts is to determine the point at which
these underlying ideas that are unprotectable become, through the original expression of the author, protectable.

In copyright law, this tension is articulated in the idea/expression dichotomy, which is treated as a matter of law for the courts to decide. While at first glance this proposition seems simple, in practice it has proved to be anything but. The question of where an idea ends and a character begins is a difficult and, and in many ways, subjective determination that has led some commentators to challenge the very idea that such a split even exists. Courts are, in many ways, forced to make subjective determinations on the quality of the character since it relates directly to how easily the character can be delineated from the idea upon which they are based. Since the Act itself is silent on the issue, it has been left to courts to devise a means for determining where the line should be drawn between an unprotectable idea and protectable expression unique to the author, which the Act protects. In an effort to establish this line, the courts have created two competing tests to determine whether a character can be protected outside of the work in which he or she first appeared. This paper examines the two competing tests, as well as the strengths and weaknesses of each.

Section I examines the first test articulated by the Second Circuit, which is termed the “character delineation test” and is considered to be the easier of the two to satisfy. Section II examines the second test, which was put forth by the Ninth Circuit and is known as the “story being told test”. Both tests have their faults and there is no clear consensus on which test is best. While the character delineation test has been criticized for being too easily satisfied, the story being told test has conversely been criticized for setting too high a bar for protection. The story being told test is applied more frequently because the Ninth Circuit is home to a majority of the cases dealing with this issue due to the fact that California is located within its jurisdiction.
has earned it the nickname of the “Hollywood Circuit” due to the large amount of cases related to issues in the entertainment industry\textsuperscript{11}. This has forced courts to become creative in dealing with this issue if they believe a character should be protected under the Act but are required to apply the story being told test.

Section III examines this tension, which has led courts to favor copyright for easily distinguishable and identifiable characters with a visual depiction over their more abstract literary brethren. Courts have distinguished these types of characters from literary characters on the basis that a visual depiction makes it easier to separate a “stock character”\textsuperscript{12} from one that can be protected under the Act.\textsuperscript{13} Ask anyone who is familiar with Spider Man what the character looks like and you will get one answer. Ask anyone who has read Catcher in the Rye what Holden Caulfield looks like and you could get a different answer each time.

It is this easy distinction that courts have favored when addressing the story being told test and despite its merits for its ease of use, it is flawed for that very reason. In their efforts to distinguish “stock characters”\textsuperscript{14} from copyrightable characters, courts have injected an element that is not required under the Copyright Act and that unfairly favors characters with a visual representation over those that lack one. There is no legitimate reason a literary character like Harry Potter should not receive copyright protection outside of the Sorcerer’s Stone. The character was just as unique and original an expression at that point in time as he was later on when portrayed by Daniel Radcliff in the film version of the story.

Section IV argues that the character delineation test is the best method to determine the copyrightability of a character outside of the work in which they originally appeared. Unlike the story being told test, it does not favor one type of character over another or create an unnecessary
bar to protection. The test focuses solely on whether the character at issue is an unprotectable “stock character” or an original and unique expression that can be protected under the Copyright Act.

The writing concludes with an examination of the relative strengths and weaknesses of both tests and the reasoning behind why the character delineation test is superior. It tracks the evolution of how courts have treated the copyrightability of characters outside of the work in which they originally appeared and examines why literary characters have been treated differently. In doing so, it argues that this result has been the product of misunderstanding and mistakes in the analysis of what factors contribute to the copyrightability of characters, both literary and visual, under the Copyright Act.

I. Learned Hand and Delineation Test

The issue of whether a literary character is worthy of copyright protection is one that has long challenged the courts and even predates the current Copyright Right Act of 1976. One of the earliest and most influential cases to address the copyrightability of literary characters was Nichols v. Universal Pictures Corporations, which was decided in 1930. Prior to this point, the issue of whether a literary character could be protected outside of the work in which they originally appeared had not been raised. The case was brought by the author of a play entitled “Abie’s Irish Rose” against the producers “The Cohens and The Kellys” who the plaintiff alleged copied from his original work. At issue was not only the copyrightability of the works themselves but also the characters they contained. In the case, Judge Hand fashioned the character delineation test which, although it was dicta, has become an important tool in assessing the copyrightability of a character.
In order to better understand the test, it is necessary to understand the facts of the case in which it was fashioned. The central point of analysis for Judge Hand in this case was the comparison of the two main families in each work and not the plot of the works themselves. In “Abie’s Irish Rose,” a Jewish boy falls in love with and marries a Catholic girl, which is objectionable on religious grounds to both his father.\textsuperscript{20} Since his father has disapproved of his relationships in the past, the son tells his father the Catholic girl is in fact Jewish and that he is thinking about marrying her.\textsuperscript{21} After meeting the girl, his father approves of the match and while he is in the process of arranging a Jewish wedding the girl’s father, a Catholic who shares a similar dislike for Jews, arrives.\textsuperscript{22} The remainder of the play deals with each of the aggrieved fathers reconciling with the young couple as a result of their desire to spend time with their grandchildren.\textsuperscript{23}

Similarly, in “The Cohens and the Kellys” a rich Jewish girl marries a poor Irish boy, which her father disapproves of because of the boy’s low station.\textsuperscript{24} However, in this story, both mothers are still alive and there are also other family members who share in the dislike between the families.\textsuperscript{25} While the couple in this play also marries in secret, the primary contention between the fathers is related to a large inheritance instead of religion.\textsuperscript{26} The eventual reconciliation between the fathers in this work is related to the resolution of the conflict over who properly owned the inheritance and not the presence of any grandchildren as was the case in “Abie’s Irish Rose”.\textsuperscript{27}

On the surface, the plots of these two works are very similar. They both have characters that are of different religions, have a controversial wedding, and deal with the effect of that union on their respective families. However, these similarities are largely superficial and it is not clear that the copying, if any actually occurred, was apparent enough to be actionable under the
Copyright Act. The question becomes what is the unprotectable idea behind each work and what is the protectable expression that is unique to each author.\textsuperscript{28}

The goal of the character delineation test is to separate the non-protectable “stock characters”\textsuperscript{29} from fully realized characters that can be protected under the Act. This stems from the notion that simple “stock characters”\textsuperscript{30} are nothing more than ideas that any author can utilize. It would be impossible to protect these types of characters because there are only so many ways such simple characters can be expressed. Thus, the issue becomes how well developed is the character in question compared to the generic “stock character”\textsuperscript{31} on which they are based. As Judge Hand put it, “the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly”.\textsuperscript{32} This echoes that idea/expression dichotomy of copyright law, which balances the First Amendment’s protection of free speech and the author’s property interest in the characters and works they have created.

In finding that there was no infringement, the court characterized the characters in both works as “stock characters”\textsuperscript{33} saying “it is indeed scarcely credible that she should not have been aware of those stock figures, the low comedy Jew and Irishman. The defendant has not taken from her more than their prototypes have contained for many decades”.\textsuperscript{34} This demonstrates the belief of the \textit{Nichols} court that the characters themselves were only fleshed out enough to further the moral of the story, little more than pieces used to achieve the author’s goal. In this vein, the stories are similar to other stories of forbidden love such as \textit{West Side Story} or \textit{Romeo and Juliet}. Stories that contain similar plots and characters, but expand upon them to such a degree to evolve from the simple ideas present in such “stock characters”\textsuperscript{35} to become a wholly unique expression worthy of protection under the Act.
Thus, under the character delineation test, a character has to be sufficiently delineated from a “stock character”\textsuperscript{36} to be copyrightable. Stated alternatively, the test serves to separate universally utilized ideas from an author’s unique expression of those ideas. This is because the Copyright Act does not protect the basic ideas that are embodied in “stock characters”\textsuperscript{37}. While the court found that the plots in this case did not infringe on one another and the characters themselves were mere “stock characters”\textsuperscript{38}, characters may be protected independently of the plot if they are sufficiently delineated.\textsuperscript{39} Though the test itself is a simple one, it has proven to be difficult to apply consistently. This is largely due to the fact that every determination of copyrightability involves an analysis of the complexity of the character at issue, which involves some subjective judgment by the court.

Subsequent courts have struggled to determine when a character should receive copyright protection independently of the work in which they appear.\textsuperscript{40} The question becomes at what point the character has been described with “enough specificity so as to constitute protectable expression”\textsuperscript{41}. This question is a challenging one because on some level, it involves a value judgment of the intrinsic worth of the character. A judgment of this type is something which courts generally, and judges specifically, are not the best suited for. A judge is not a literary critic and any reliable test to determine the copyrightability of a character outside of the work in which they first appeared should not require them to act as one. This determination is made especially challenging for courts because there are no factors to apply in the character delineation test. What factors or traits that help distinguish a “stock character”\textsuperscript{42} from a protectable character depends on the judgment of the court, which also contributes to the variety of results in these types of cases.
This was something that Judge Hand himself struggled with when attempting to articulate the point at which the line between underlying idea and protected expression has been crossed.\textsuperscript{43} In the course of discussing where that line should be drawn, Judge Hand did state that there is a point at which characters may so closely correspond that there would be infringement independently of the plot itself.\textsuperscript{44} However, where exactly that line should be drawn was left by Judge Hand for future courts to answer. Subsequent courts have come to recognize this case for first recognizing the important fact that there should be “copyright protection for characters who are especially distinctive”\textsuperscript{45}. Despite this recognition, the issue is far from settled.

This test, while it has led to imperfect results, addresses the central issue of whether a character is copyrightable. Namely, if the author’s original expression is sufficiently unique to satisfy the idea/expression dichotomy, then the character can receive copyright protection.\textsuperscript{46} The court’s discussion of “stock characters”\textsuperscript{47} serves as a useful tool to conceptualize the type of vague characters that the Act does not protect. Only characters that are sufficiently fleshed out and that rise above such universal constructs can be claimed by an author as his or her own unique and original artistic expression. No author can claim credit for creating the idea of a character who is an international spy; however Ian Fleming can rightly receive protection for his unique expression of such a “stock character”\textsuperscript{48} in the more developed character of James Bond.\textsuperscript{49}

II. The Sam Spade Case and the Story Being Told Test

While the \textit{Nichols} case was important for the early development of copyright protection for literary characters, perhaps the most influential and far-reaching case on this subject is the Ninth Circuit’s decision in \textit{Warner Bros. Pictures v. Columbia Broadcasting System} [subsequently the
Sam Spade case\footnote{50} More commonly known as the Sam Spade case, the decision addressed the rights relating to The Maltese Falcon\footnote{51} Since this decision took place in the Hollywood Circuit, it has become a touchstone, for better or worse, for future cases dealing with the copyrightability of characters.

The case spawned the story being told test, which heightened the requirements for a character to receive copyright protection under the Act\footnote{52}. While the test enabled the court to reach a just result in the case, its application in future copyright cases has been challenging to say the least. This is because the application of the test by subsequent courts has served to raise the bar on copyright protection above that which is found in the 1976 Act\footnote{53}. To understand how this has happened and why the test is fatally flawed, it is necessary to understand the context of the case itself and the result the court sought to achieve.

The case arose out of a contract dispute between the author of The Maltese Falcon, Dashiell Hammett, and Warner Bros. over the right to the character Sam Spade. The contract at issue was a 1930 grant of rights in The Maltese Falcon to Warner Brothers of “certain defined and detailed exclusive rights... in moving pictures, radio, and television”\footnote{54}. Warner Bros. was to take Hammett’s popular detective and adopt the serial drama to the then new mediums of radio, movies, and television. Sam Spade was a very popular character during this time and was played by Humphrey Bogart in the well-received movie\footnote{55}. This seemingly clear grant of rights was interpreted extremely differently by the two parties and spawned the genesis of arguably one of the most influential decisions concerning the copyrightability of literary characters outside of the work in which they originally appeared.
The central issue of the case was whether the right to use the Sam Spade character was included in the grants of rights by Hammett to Warner Bros. or whether Hammett retained the rights himself. Warner claimed that they had acquired the exclusive rights to the character along with the rights to *The Maltese Falcon*, while Hammett claimed he retained the rights to the character and proceeded to use Sam Spade in other works.\(^{56}\) The character was subsequently used by Hammett in 1946 when he granted a third party the exclusive right to use Sam Spade outside of *The Maltese Falcon*.\(^{57}\) As a result of this grant of rights, radio broadcasts occurred from 1946 to 1950 containing the character of Sam Spade.\(^{58}\) This placed the court in an interesting position in trying to determine if Hammett was guilty of infringing upon the copyright in a character he created. The court concluded that the assignment did not include the characters as they “were vehicles for the story told, and the vehicles did not go with the sale of the story”.\(^{59}\) In the course of its decision, the court fashioned the story being told test which has been widely examined, even outside of the Ninth Circuit.

The story being told test differs from the character delineation test in that its goal is to determine to what extent the character is intertwined with the plot of the story. As the court said in the case, “it is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection”.\(^{60}\) Thus, under this test, the only way a character could receive protection independent of the work in which he or she appear is if the character is so essential to the story that he or she is virtually inseparable from it. This is a very high bar to satisfy, which is made clear by the fact that the court in the Sam Spade case found that the character did not constitute the story being told. While not impossible to satisfy, there are only a few examples of characters that have been able to satisfy this more rigorous test.\(^{61}\)
There are two main areas in which characters have been found to be protectable under this test. The first notable way a character has been found to satisfy this test is if the character’s name is in the title of the work. This is a very simple consideration to address and it satisfies the requirement that the character is so engrained in the plot of the work that they are considered by the author to be synonymous. A perfect example of this is the E.T. character from the movie of the same name. In *Universal City Studios, Inc. v Kamar Inds., Inc.* the court examined this basic relationship between the title and the character in finding “that “E.T.” is more than a mere vehicle for telling the story and that “E.T.” actually constitutes the story being told”. The very brief analysis of the court in this case emphasizes the simplicity of this determination and how easy it is for a court to find that it is satisfied.

The second area in which a character has been found to satisfy the story being told test is if the work in question focuses on character development at the expense of the plot. This determination directly relates back to the character delineation test developed in *Nichols* as it concerns the complexity of the character. The larger the role character development takes within the work, the easier it becomes to distinguish a protectable character from a “stock character”. Once this distinction is made, the character at issue is afforded copyright protection independently of the work in which he or she originally appeared. In *Anderson v. Stallone*, the court recognized this fact in finding that the character of Rocky was worthy of copyright protection under the story being told test. The court emphasized that “all three Rocky movies focused on the development and relationships of the various characters… [they] did not revolve around intricate plots”.

It is significant that this factor relates to the character delineation test because it highlights the fact that both tests attempt to answer the same question, albeit by different
methods. The question that is central to both tests is whether the character is sufficiently developed to be worthy of copyright protection outside of the work in which they first appear. While the character delineation test arose from a true copyright context, the fact that the story being told test centers around a contractual dispute has unnecessarily complicated matters for the courts.

The challenge with the story being told test is that courts have struggled to reconcile the result of the case with the modern trend to protect characters. This is due to the fact that the decision the court reached in the case was that Sam Spade was not worthy of independent copyright protection outside of The Maltese Falcon. This enabled the court to find that the author did not convey the exclusive rights to the character to Warner Bros. and therefore he could continue to use the characters in future works. Thus while the court reached what most would consider a just result, it did so in a manner that would cause future courts to struggle to find a way to protect characters independently.

III) Visual/Comic Characters

Since the story being told test created such an extremely high standard, and the Sam Spade case is still good law, courts have had to become creative in order to extend copyright protection to characters that would not necessarily constitute the story being told. Since Sam Spade was a literary character introduced in The Maltese Falcon, the character lacked a visual depiction. Courts have used this fact to treat characters that have a visual depiction differently than purely literary characters. The main contention of these courts has been that the presence of a visual depiction of the character adds a depth and complexity to the character that enables them
to easily rise above “stock characters”\textsuperscript{68}. This is in contrast to literary characters who would struggle in this area due to the ambiguity inherent in an author’s visual description.

This recent trend began when the Ninth Circuit, recognizing the limitations of their decision in Sam Spade, addressed the copyrightability of the Mickey Mouse character. The defendants in the case used Disney’s characters in their adult comic books.\textsuperscript{69} The defendant made no attempt to hide this fact, going so far as to refer to the characters by their names.\textsuperscript{70} The defendant made use of these well-known characters in an attempt to criticize the positive messages conveyed by these characters by portraying them “as active members of a free thinking, promiscuous, drug ingesting counterculture”.\textsuperscript{71} This was a perfect opportunity for the court to address the copyrightability of characters, because the defendant’s use of the characters at issue required evaluation of how well they were developed and the determination of whether they were protected outside of the works in which they originally appeared. The only way that Air Pirates, the defendants, could win was if that court brought into the argument that only the works themselves were copyrightable.

The crux of the argument by the defense was that the characters at issue were not independently copyrightable.\textsuperscript{72} For the court to resolve this issue, it had to directly address the legacy of its decision in the Sam Spade case. The court recognized that the decision in the case does lend itself to the idea that characters are not ordinarily independently copyrightable.\textsuperscript{73} The court then highlighted that the decision was in the context of a contract dispute and emphasized that “a restriction on Hammett’s future use of a character was unreasonable, at least when the characters were merely vehicles for the story and did not “really constitute” the story being told”.\textsuperscript{74} While the idea that Mickey Mouse might not be copyrightable may seem comical now, it was only by making this distinction that the court was able to protect this well-known character.
The court could have very easily have not distinguished the character based on the visual representation and found that Mickey Mouse did not constitute the story being told and thus was not protectable outside of the works in which he appeared.

Courts that have addressed the legacy of the Sam Spade decision have emphasized the contractual nature of the issue that led to the creation of the story being told test. In Gaiman v McFarlane, the Seventh Circuit went as far as to say “that decision is wrong, though perhaps understandable on the ‘legal realist’ ground that Hammett was not claiming copyright in Sam Spade”. However, in defense of the Ninth Circuit’s decision it was not clear at that time that the decision would create a body of the law that would negatively affect the rights of authors. This highlights the unique facts that the Ninth Circuit was faced with in the case and also why it is not the best set of facts to give rise to such an influential test for copyright protection for characters. It is very likely that if the case was decided today “Dashiell Hammett's famously distinctive detective character Sam Spade” would have received copyright protection outside of his appearance in The Maltese Falcon.

In Air Pirates the court pivoted and began discussing the difficulty in distinctively delineating a literary character. In discussing the problems in creating a literary character who embodies more than an unprotected idea, the court argued that a comic book character would more easily satisfy this requirement as their visual representation would likely have that unique expression. It went on to hold because of this, comic books characters are distinguishable from literary characters. Therefore, the Sam Spade language does not prevent them from being protected independently of the work in which they appear.
This highlights the challenges that courts have faced in dealing with the legacy of the Sam Spade case. In Air Pirates the court was left with two alternatives: Either limit the decision to characters in literary works or attempt “to harmonize granting copyright protection to graphic characters with the “story being told” test. In choosing to distinguish graphic characters from literary characters, the court chose to treat graphic characters differently from literary characters, a distinction not made anywhere in the Copyright Act. The question for graphic characters was no longer whether they constituted the story being told. Instead, a graphic representation was assumed to contain a unique expression that enables such a character to easily delineate them from a “stock character”. This places an emphasis on a visual representation of a character that was absent from Judge Hand’s character delineation test.

This is an extremely simplistic way of looking at the character delineation test articulated by Judge Hand and one that misses the goal of the test. It was designed to enable courts to separate “stock characters” from protectable characters, not to create a bright line rule that values one type of character over another. A visual representation of a character should, under the test, be only one of the factors a court considers when attempting to decide whether a character is capable of receiving copyright protection independently of the work in which he or she appears.

This becomes clear when examining the early images of the Mickey Mouse character that was at issue in the Air Pirates case. The first visual representation of Mickey Mouse in Steamboat Willie was extremely simplistic, being hand drawn in black and white. This unsophisticated representation belies the distinct and unique characteristics the Air Pirates court alleged would help to easily delineate characters with visual representations from unprotectable ideas. It highlights why characters with a visual depiction are not necessarily easier to delineate
from "stock characters"\textsuperscript{84} when their representation can be so basic. It is very difficult to argue that such a basic visual representation easily distinguishes a protectable character from a "stock character"\textsuperscript{85} when there are so few distinguishable characteristics of the drawing of Mickey Mouse on its own.

Courts that have favored characters with a visual depiction over purely literary characters have demonstrated the ambiguity inherent in descriptions of literary characters,\textsuperscript{86} suggesting that the fact that those readers have to picture the character in their mind makes it more difficult to differentiate them from "stock characters"\textsuperscript{87}. Characters such as Holden Caulfield from \textit{Catcher in the Rye} are among the most popular and enduring literary characters in American history despite never have been portrayed by an actor. In some respects this has only contributed to the popularity of the character as it has enabled generations of people to relate more easily to the character. Few would doubt either the popularity of a character like Holden Caulfield or that he should be protected if another author attempted to use him in a new work. In fact, in \textit{Salinger v. Colting}, the court addressed this specific issue and found that the character is "sufficiently delineated".\textsuperscript{88} This gives further credence to the idea that the presence of a visual representation for a character should not be dispositive when assessing the copyrightability of a character outside of the work in which he or she originally appeared.

In light of \textit{Air Pirates} "applying a less stringent test for protectability of graphic characters,"\textsuperscript{89} there is doubt about whether the stricter story being told test is still necessary for literary characters. Since \textit{Air Pirates} limited "the story being told requirement to word portraits"\textsuperscript{90} Professor Nimmer\textsuperscript{91} has suggested that the reasoning of the Sam Spade decision has been undermined even in regard to word portraits.\textsuperscript{92} As the court in \textit{Anderson} pointed out:
“a graphically depicted character is much more likely than a literary character to be fleshed out in sufficient detail so as to warrant copyright protection. But this fact does not warrant the creation of separate analytical paradigms for protection of characters in the two mediums”. ⁹³

While the court in this case still placed a heavy emphasis on the ability of visual representation to delineate a character from a “stock character,”⁹⁴ it correctly noted that the central question remains whether the character is a sufficiently unique expression by the author to qualify for copyright protection.

At issue in Anderson were the characters that Sylvester Stallone had created for the Rocky movies. Stallone had publicly announced his plans for Rocky IV and even disclosed some broad plot ideas in a public interview.⁹⁵ Shortly after this, the plaintiff created a treatment for the movie using the Rocky characters and attempted to sell the treatment to the studio.⁹⁶ In the course of the subsequent litigation, the court was presented with the issue of the copyrightability of the Rocky characters.

Significantly, the court found “as a matter of law that the Rocky characters are delineated so extensively that they are protected from bodily appropriation when taken as a group and transposed into a sequel by another author.”⁹⁷ The court treated the Rocky characters the same as the comic characters in the Air Pirates decision and did not apply the story being told test. Instead, they used the language of the character delineation test articulated by Judge Hand.⁹⁸ In the course of reaching its decision, the court highlighted the “unsettled state of the law”⁹⁹, which accounts for its discussion of both story being told test and the character delineation test. Thus,
there are real questions regarding the current state of the story being told test and the cases in which characters are copyrightable outside of the work in which they originally appeared.

**IV) Story Being Told or Character Delineation Test**

It is in this chaotic context that courts are still struggling to address the question of whether characters can receive copyright protection outside of the work in which they originally appeared. The central issue still concerns the point at which an unprotected idea or “stock character” becomes a protectable expression through the author’s unique voice. While both tests attempt to answer this question, they arrive at very different results. The story being told test’s

> “protection of a fictional character requires not so much a well-drawn characterization, as it does a drawing. Graphic representation fills in for depth of character and leads to the unbalanced, and unfair, result that graphic characters are found more deserving of protection than literary characters”.

This test is the unfortunate and unintended result of a decision that attempted to protect the rights of an author with respect to his or her characters, but instead succeeded only in limiting them. It was only through the efforts of the courts to limit the decision reached in the Sam Spade case that certain characters, namely those with visual representations, were able to enjoy the type of protection that the court sought to achieve.

The central problem with the story being told test is that it does not focus on the quality of the character directly, but rather the role the character plays in the work in question. While that can be a good indicator of the strength of the character, it has been conflated to such a degree that it is almost impossible to satisfy. This is largely a result of the fact that Sam Spade,
well-known and very popular character, was found by the court not to constitute the story being told. Subsequent courts have struggled with the story being told test for this very reason and have only found the test satisfied in a few cases.

The two main areas that courts have found the story being told test to be satisfied are when the character’s name appears in the title of the work and when the focus of the work in question is character development at the expense of the plot. Both of these areas indicate the issues with the story being told test, but for somewhat different reasons. The very fact that characters whose names appear in the title of the work have been found to satisfy the test demonstrates how the test has in some ways been over simplified. Similarly to how the presence of a visual representation has been deemed sufficient to delineate a character from a “stock character,” the mere presence of the character’s name in the title has also been given undue weight.

The character’s name being included in the title should only be one indicia of the importance of the character to the story. It serves as evidence that the character is sufficiently delineated from a “stock character” because the author considered the character in question to be the primary representation of their unique copyrightable expression. However, it is disingenuous to suggest that if *The Maltese Falcon* was instead called “The Adventures of Sam Spade,” that fact alone would satisfy the story being told test and grant copyright protection to the Sam Spade character. That small difference does not make the character any more or less delineated from a “stock character.” There can be many reasons why a character’s name does not appear in the title of the work in question. Many of these reasons reflect only creative choices by the author and are not a reflection on the complexity or uniqueness of the character.
Similarly, courts have shown a tendency to protect characters that appear in works that focus on their characterization and development of character relationships at the expense of plot. Works like the *Rocky* movies are known not for their complex plots, but rather for the popularity of the characters. This popularity was created and grown throughout the course of the movies because they focused heavily on the relationships between Rocky, Adrian, Paulie and all of the other characters. Even a seminal movie like *E.T.* owes its popularity more to the character of E.T. and his relationship with the children in the movie than to the overarching plot of him trying to return home.

Upon initial examination, this makes sense. The more time the author spends developing the character, the easier it is for courts to delineate them from “stock characters.” However, the presence of a simplified plot alone is not a reliable indicator of the complexity of the characters themselves. For example, the plots of the two plays at issue in Nichols were very simple and straightforward, but as the court itself noted, the characters themselves were merely “stock characters”.

These shortcomings support the conclusion that the character delineation test is the better test for determining the copyrightability of a character, literary or visual, independent of the source material. This is because it places the emphasis on the issue of how well developed the character is and if he or she is an expression unique enough so as to be easily distinguished from a “stock character.” The goal under either inquiry is to determine whether the character consists of an unprotectable idea that anyone can utilize, or a particularized expression that is unique to the author and in which he or she has a protected interest in under the Copyright Act. This seemingly simple inquiry has caused numerous problems for the courts since Judge Hand first articulated his test, but it remains the best means to make this determination. By focusing on
the separation between the underlying idea and the author’s unique expression of that idea, the character delineation test stays true to the requirements of the Act.

The bar for copyright right protection is not particularly high and when faced with the question of whether the character in question satisfies this requirement, there should be no additional hurdles. This is the greatest failure of the story being told test. The test makes it more difficult for a literary character to receive protection than for a visual character. There is nothing in the Act itself that indicates that one type of character should be treated differently than another. This preference for visual characters is solely the result of judicial construction in the wake of the Ninth Circuit’s Sam Spade decision.

While in some cases the presence of a visual representation would enable a character to be more easily delineated from a “stock character,” it should never be the sole factor in making such a determination. “What truly makes a character copyrightable must be the ‘characterization or personality portrait’ and it is the determination of what that portrait’s ‘threshold of delineation’ is that occupies a court's deliberation.” It is the character delineation test that best achieves this goal and thus, should be used exclusively in determining whether a character should receive copyright protection independently of the work in which they originally appeared. The test does not value visual characters over literary character but rather addresses the issue of copyrightability based solely on how well developed the character in comparison to “stock characters.”

Conclusion

The character delineation test is the best tool for courts to use to determine if a character can receive copyright protection outside of the work in which he or she originally appeared. When
Judge Hand first proposed the concept that a character could receive copyright protection outside of the work in which they originally appeared, the idea was a novel one. There was little judicial precedent dealing with the issue and much less public concern over the rights of author’s in the characters they had created. However, since then the idea has become more widely accepted and has found widespread support in the courts. There has been an ever increasing recognition not only of the rights that authors have in the works but in the inherent value of the characters themselves. This is due in a large part not only to the never ending stream of sequels and prequels turned out by Hollywood year after year, but also to the presence of these characters in the many different types of media we consume on a daily basis. This only highlights the importance of establishing a uniform test to determine whether a character can receive copyright protection.

The character delineation test has the ability to balance the inherent First Amendment concerns present in any such inquiry with the property interests at stake. The test enables courts to make a balanced determination of when a particular character can be considered a “stock character” and thus, preserved for the use of the public through the First Amendment’s guarantee of free speech. Protecting an author’s unique and original expression, while at the same time enabling future authors to make use of underlying unprotectable ideas, is a difficult balance to strike and highlights the value of the test.

By focusing on the underlying idea and the author’s expression of that idea, the test enables the court to determine if the character at issue should receive copyright protection outside of the work in which he or she originally appeared. The character delineation test examines the character as a whole and does not place any undue emphasis on characters of particular type. Since there is nothing the Copyright Act itself regarding the copyrightability of
characters outside of the original work, there is certainly nothing to suggest that a character of a certain type should be more likely to receive protection. This recognizes that there are numerous ways a character can be delineated from a 'stock character' beyond something as simple as a visual representation.

The story being told test does not reach this underlying issue effectively and thus is the inferior of the two tests. This is largely the result of the context in which the test was created. The story being told test was created by the Ninth Circuit in the context of a contract dispute between two parties over the use of the Sam Spade character. In reaching a just result the court established a test that seemingly contradicted the goals the court sought to achieve.

By framing the issue in the terms it does the story being told test fails to properly address the central issue of what makes a character copyrightable. The test does not attempt to delimit what is protectable under the Copyright Act and what is unprotectable free speech. This is one of the main reasons that courts have struggled with applying this test since it was created. In addition, this confusion is compounded by the fact that it is not even entirely clear whether the court in the Sam Spade case applied the story being told test in reaching their decision or if it was just dicta. Understandably this has frustrated future courts attempting to apply the story being told test and led to a variety of results, with some seemingly at odds with others.

The story being told test does not analyze the relationship between the character at issue and the underlying idea that the character is constructed on. Rather, it looks at the relationship between the character and the story he or she is first utilized in. This misplaced emphasis has created a situation where the analysis is centered on how large a role the character plays in the story in which they originally appeared. While the role of the character in the story can be an
indication of how well developed the character is, a single factor such as this should be the only element.

The overreliance on a single factor in satisfying the story being told test is demonstrated by the fact that there are only two main ways that courts have found this test to be satisfied. The first way a court has found the story being told test to be fulfilled is when the name of the character at issue appears in the title of the work in which he or she originally appeared. The second manner in which courts have found the test to be met is when character development is emphasized over the plot. Both of these factors illustrate how the story being told test has shifted the focus of the courts from the characters themselves to the relationship between the characters and the story in which they appear.

Subsequent courts have recognized the flaws inherent in the story being told test and have attempted to remedy them by taking a different approach with characters that have a visual representation. This approach distinguishes characters that have a visual representation from characters that are purely literary. Courts have made this distinction on the basis that characters that have a visual representation contain an extra element that makes it easier to distinguish them from characters that are unprotectable.

This move away from the language and emphasis of the story being told test and back toward the character delineation test is further evidence of the advantage of the original test. However, in the course of moving back toward the application of the character delineation test an undue emphasis on characters with a visual representation has been created. This undue emphasis is largely the result of courts attempting to minimize the applicability of the decision in the Sam Spade case. While the presence of a visual representation can, and should, be a factor to
consider when examining the copyrightability of a character under the character delineation test, it should not be the single determining factor. Instead, when applying the character delineation test to decide if a character can be protected outside of the work in which they originally appeared, courts should examine the character as a whole and attempt to define what makes him or her different from the unprotectable “stock character” that served as a basis for the character development.

The character delineation test is the best method available to courts to make these determinations and to address the copyrightability of a character, either literary or visual, outside of the work in which he or she originally appeared. The test properly emphasizes the relationship between the character at issue and the underlying unprotectable idea over the role the character plays in the story. The character delineation test challenges courts to examine the complexity of the character as a whole instead of providing a single factor that can easily be met or not.

5 Id.
11 White v. Samsung Electronics Am., Inc., 989 F.2d 1512, 1521 (9th Cir. 1993).
12 Lewinson at 567.
13 Schienke, supra, at 72.
14 Lewinson at 567.
15 Id.
17 Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930).
18 Id. at 120.
20 Id. at 120.
21 Id.
22 Id.
23 Id.
24 Id.
25 Id.
26 Id.
27 Id. at 121.
29 Lewinson at 567.
30 Id.
31 Id.
32 Nichols at 121.
33 Lewinson at 567.
34 Nichols at 122.
35 Lewinson at 567.
36 Id.
37 Id.
38 Id.
39 Nichols at 121.
40 Feldman, supra, at 692.
42 Lewinson at 567.
43 Nichols at 121.
44 Id.
45 Olson v. Nat'l Broad. Co., 855 F.2d 1446, 1452 (9th Cir. 1988).
47 Lewinson at 567.
48 Id.
51 Id.
54 Warner Bros. Pictures at 948.
56 Warner Bros. at 948.
57 Id.
58 Id.
59 Warner Bros. at 950.
60 Id.
61 27 No. 1 Corp Couns Quarterly ART 2.
62 Bartholomew, supra at 348.
64 Id.
65 Bartholomew, supra at 348.
66 Lewinson at 567.
67 Anderson at *8.
68 Lewinson at 567.
69 Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 752 (9th Cir. 1978).
70 Id. at 753.
71 Id.
72 Id. at 754.
73 Id. at 755.
74 Id.
75 Gaiman v. McFarlane, 360 F.3d 644, 660 (7th Cir. 2004).
76 Id.
77 Walt Disney Prods. at 755.
78 Id.
79 Id.
80 Anderson at *6.
81 Lewinson at 567.
82 Id.
84 Lewinson at 567.
85 Id.
86 Gaiman at 660.
87 Lewinson at 567.
88 Salinger v. Colting, 607 F.3d 68, 73 (2d Cir. 2010).
89 Anderson at *7.
91 “The most cited work in the field and the undisputed leading authority for in-depth, comprehensive analysis of U.S. copyright law”,


93 Anderson at *7.
94 Lewinson at 567.
95 Anderson at *1.
96 Id.
97 Id. at *7.
98 Id.
99 Id.
100 Lewinson at 567.
101 Schienke, supra at 72-73.
102 Lewinson at 567.
103 Id.
104 Id.
105 Id.
106 Id.
107 Id.
108 Id.
109 Schienke, supra at 81.
110 Lewinson at 567.
111 Id.
112 Id.
113 Olson at 1452.
114 Lewinson at 567.