

Licensing your brainchild

by Jacqueline Tadros

The whole idea that licensing would be a revenue stream didn't occur to anybody ...' It seems fantastic now, yet those very words were once uttered by the great George Lucas in connection with his masterpiece, *Star Wars*, the space odyssey that would spawn a multi-billion dollar merchandising juggernaut and teach Hollywood once and for all the power of licensing.

Fictional characters, both literary and graphical (comic strip) are the brainchild of their creator and, as such, are entitled to intellectual property protection. The degree and type of legal protection afforded these fictional characters varies from one situation to the next and has sent many a studio executive and their menagerie of lawyers scurrying into late-night overdrive.

The granting of permission to use intellectual property rights is indicated by the term 'licensing'. Hence it is important to attempt to define the intellectual property rights emanating from a particular character in order to assess its potential commercial value.

Copyright and trademark protection represent two of the intellectual property rights that may be available for fictional characters. A possible advantage afforded by trademark protection over copyright is that a trademark has a potentially infinite life whereas copyright protection is limited by statute to a term of years.

With regards to trademark law, however, it is noteworthy that a trademark identifies the source of a product or service that indicates certain quality standards inherent in the product or services. Thus a character in and of itself is not entitled to the benefit of a trademark unless it is used in conjunction with a product or service bearing that mark.

In the oft-quoted case of *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930) Judge Learned Hand said that 'the less

developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly... The test for copyright protection of literary characters is their degree of breadth, distinction and delineation.'

Apparently the judicial system had it right all along. Flesh out your characters and you shall profit in more ways than you can imagine.

Another important case regarding the protection of fictional characters is *Warner Bros. Pictures, Inc., v. Columbia Broadcasting System, Inc.*, 216 F.2d 945 (9th Cir. 1954), also commonly referred to as the 'Sam Spade' case



The Maltese Falcon: Warner Bros.

after the name of the fictional character created by author Dashiell Hammett. In that case, Mr Hammett sought to reuse his own brainchild, the character of 'Sam Spade'. However, in order to do so he had to attempt to overcome Warner Brothers' claim of ownership over the copyright.

As Bogart aficionados may or may not recall, the entire copyright of *The Maltese Falcon* was assigned to Warner Brothers but Mr Hammett continued to use the character of 'Sam Spade' and assigned the right to use the character to defendant Columbia Broadcasting. Consequently, Warner Brothers sued Columbia Broadcasting claiming

copyright infringement.

The court held that the 'Sam Spade' character was not entitled to copyright protection since the character was 'merely a chessman in the game of telling the story'. The court noted that no character is worthy of copyright protection separate and apart from the work in which the character appears unless the character is so well-delineated as to constitute 'the story being told'. Thus the 'story being told' test emerged and continues to be used today.

Clearly the issue of character delineation is an important one, however, it is not as critical in the case of graphical (comic strip) characters. Graphical characters are depicted by a graphic representation. As such, they have objective, identifiable, physical characteristics endowing the character, if not their creator, with a distinct uniqueness too often lacking in literary characters. This objectively distinct uniqueness is what sets the character apart and leads to stronger legal protection.

The Copyright Act of 1976 has given us many things but clear guidance on the issue of Character Protection is not one of them. The Act does not specifically address the issue of protecting a character as an entity separate and apart from the work in which the character appears. Therefore, as in so many instances, if you want to know what the law means, you may have to litigate the issue.

So is it copyright infringement or merely a very sincere form of flattery? The elusive answer is that perhaps not even your lawyer knows for sure.

This article is not legal advice. You should consult a lawyer if you have legal questions that relate to your specific publishing issues and projects.

Jacqueline Tadros is a Registered Patent & Trademark Attorney. She can be reached at jtadros@intellectualpropertynow.com