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A not-so-elementary copyright case

By Andrew J. Thomas

Content Matters

This is a monthly column devoted to matters of interest to those who create content of all kinds (entertainment, news, software, advertising, etc.) and bring that content to market. Our hope is to shed light on key issues facing the creative content community. If you have questions, comments or topic ideas, let us know at ContentMatters@jenner.com. **Because content matters.**

When does a recurring literary character qualify for copyright protection, and in what form can he enter the public domain? The question becomes especially vexing when a complex, richly delineated character is depicted in multiple works now in the public domain, but also is featured in works that are still under copyright protection.

It may take the world's greatest detective, along with an Illinois federal court, to solve that mystery this year by deciding whether, and to what extent, the 126-year-old character Sherlock Holmes is still protected by U.S. copyright law.

Sir Arthur Conan Doyle introduced Holmes to the world in the 1887 novel "A Study in Scarlet" and featured the detective in 59 more novels and stories between 1887 and 1927. The iconic character's enduring popularity has made Holmes far more than a noble bachelor or dying detective. He lives on in two recent Warner Bros. films, in the BBC series "Sherlock," and in the CBS television series "Elementary."

While the U.K. copyrights in Conan Doyle's works have all expired, a handful of his Sherlock Holmes stories (either nine or 10) are still protected under U.S. copyright law, and the Conan Doyle Estate Ltd. continues to demand license fees for uses of Holmes, Dr. Watson, Mycroft, Prof. Moriarty and other Holmesian characters. (Under U.S. law, if a work was created before Jan. 1, 1923, it most likely is in the public domain; if created after that date, it may still enjoy copyright protection.)

The game has been afoot in Illinois federal court since February, when an illustrious client, a Sherlock Holmes scholar named Leslie S. Klinger, filed suit against the estate, seeking a declaratory judgment that the elements of the Holmes character delineated in the roughly 50 novels and short stories published before 1923 are now in the public domain and, thus, are free to be used by anyone without restriction (or payment).

Klinger asserts he is no crooked man because his latest book, an edited collection of new Holmes stories by various authors, relies entirely on characters, character traits, story lines and other elements that were developed extensively in the pre-1923 works. If Klinger prevails, it will mean that many of the license fees paid for use of the Sherlock Holmes characters have been unnecessary.

Klinger filed a summary judgment motion in July, and the estate filed its response in September, arguing that all aspects of the Sherlock Holmes character remain protected by copyright because Conan Doyle did not finish fully creating the character until he took his last bow and finished writing his last Sherlock Holmes story in 1927.

According to the estate, Conan Doyle did not create multiple Sherlock Holmes characters but instead created a complex, unitary (yet evolving) character — a single "work of authorship" that cannot be "dismantled" into a partial public domain version and a collection of later, protected traits. Holmes, the estate argues, is a "complex literary personality that can no more be unraveled without disintegration than a human personality."

The estate's theory may be intriguing psychologically — is the human self a unified whole across one's lifetime, or does it mean something to say, "I was a different person then than I am now?" But from a copyright perspective — rather than as a case of identity — the estate's logic is far from elementary. For one thing, it suggests that, in the case of literary characters, the limitation imposed by a fixed copyright term can be evaded by churning out an endless stream of new works — thus preventing the key characters from ever being completely and finally "created." Under current copyright law, the copyright term of a work created as a work for hire — where the copyright may be owned by a corporate employer, rather than an individual author — is 95 years from first publication. But as long as the company keeps using the character in new works, copyright protection could be prolonged indefinitely, making the public domain an empty house.

A second stain on the estate's theory is that it would mean that an author who successfully establishes copyright protection of a character — as MGM did for James Bond in a 1995 lawsuit — might risk losing that copyright protection in a silver blaze if it produces further sequels using that character, thus elongating the "creation" of that single, holistic character.

As a final problem, the estate's theory runs contrary to every reported case that has considered the issue.

The 2nd U.S. Circuit Court of Appeals initially addressed copyright protection of fictional characters in *Nichols v. Universal Pictures*, 45 F.2d 119 (2d Cir. 1930). Judge Learned Hand explained that a character could be protected by copyright if sufficiently delineated, but that stock or flat characters enjoy no such protection: "[T]he less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly." This "character-delineation test" is a logical extension of copyright law's idea-expression dichotomy: If a character is too indistinct, it represents a mere idea and not the expression of an idea.

The 9th Circuit took a narrower approach to the issue in a case involving another iconic detective, Sam Spade. In *Warner Bros. Pictures v. CBS*, 216 F.2d 945 (9th Cir. 1954), the court announced that a character may qualify for copyright protection if it "really constitutes the story being told," but will not be protected if the character "is only the chessman in the game of telling the story."

Over the years, courts consistently have held, under either test, that once a character is sufficiently drawn to merit copyright protection, adding new traits or biographical details in later works does not undermine the character's copyright protection.

In the 1990s, the Central District of California found that characters as diverse as James Bond and Godzilla were protectable, even though both had changed significantly across the numerous films in which they appeared. The court explained that the fact that "many actors can play Bond is a testament to the fact that Bond is a unique character whose specific qualities remain constant despite the change in actors." *MGM v. American Honda*, 900 F. Supp. 1287, 1296 (C.D. Cal. 1995). Even transforming from a malevolent monster to a benevolent one did not change the fact that "Godzilla is always a pre-historic, fire-breathing, gigantic dinosaur alive and well in the modern world." *Toho Co. v. William Morrow & Co.,* 33 F. Supp. 2d 1206, 1216 (C.D. Cal. 1998).

The 2nd Circuit expressly addressed the situation where early works featuring a character are in the public domain but later works are not, in *Silverman v. CBS*, 870 F.2d 40 (2d Cir. 1989). In that case, a playwright, seeking to use characters from the "Amos 'n' Andy" television and radio show in a new stage musical, argued that certain pre-1948 radio scripts were in the public domain and, consequently, CBS did not have any rights over the characters delineated in those scripts. The court agreed, but held that because CBS owned valid copyrights in the post-1948 works, attributes of the characters that were developed only in those later works remained protected and could not be used by the playwright without permission.

Most recently, in litigation over rights in the Superman character, the Central District of California confirmed that copyrightable aspects of a character are protected only to the extent the work in which they first appear remains protected — regardless of whether the traits or attributes also appear in "subsequent sequels" featuring the same character. *Siegel v. Warner Bros.*, 690 F. Supp. 2d 1048, 1059 (C.D. Cal. 2009).

So, how much of Sherlock Holmes is in the public domain? Both logic and experience suggest that it is every character trait and attribute described in the 50 stories that pre-date 1923 — about 83 percent of the Holmesian Canon. That would leave protected only those attributes delineated in the nine or 10 post-1923 stories — a 17 percent solution unlikely to satisfy the Conan Doyle Estate.

A decade ago, a New York federal court reached precisely that conclusion, albeit in dicta. See *Pannonia Farms v. USA Cable*, 2004 WL 1276842, at *9 (S.D.N.Y. June 8, 2004). The Klinger case now squarely tees up the issue.

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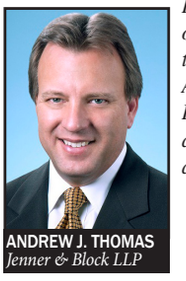
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