

**Bangor University**

## **DOCTOR OF PHILOSOPHY**

**The practical difficulties of applying current trade mark law, actions for passing off and copyright law to literary fictional characters per se, independent of the original work**

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*Award date:*  
2017

*Awarding institution:*  
Bangor University

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**T BUKATZ**

**The practical difficulties of applying current trade  
mark law, actions for passing off and copyright law  
to literary fictional characters per se, independent of  
the original work**

A thesis submitted for the Degree of Doctor in Philosophy  
School of Law  
Bangor University  
2017

## Acknowledgements

I would like to thank Bangor University School of Law for the 125<sup>th</sup> Anniversary Scholarship. I am also thankful for the Eric Sunderland Travel Scholarship in Intellectual Property Law from the Welsh Livery Company.

To my first supervisor Dr. M. Hyland, thank you for agreeing to take on the supervision of my PhD and your thought-provoking guidance, although you were not especially enthusiastic about my choice of topic initially. Thank you also for instilling in me an interest in trade mark law.

My *gwerthfawrogiad dwfn* also goes to my second supervisor and muse A. Griffiths for his unremitting optimism and motivational discussions on, for example, character merchandising relating to Victorian pottery.

M. Owen also deserves heartfelt thanks. She helped me in so many ways that it would take all the pages of my doctoral thesis to mention everything that she has done for me. Thank you for making my life so much easier.

Dr. Y. McDermott Rees has also been a great help. Thank you for the tireless efforts to orientate the PhD workshops to the needs of the students, and for offering assistance on the PhD even outside normal office hours.

I am also much obliged to R. Combes from the Authors' Licensing and Collecting Society (ALCS). Thank you for being there for me over the years whenever I had some ideas to bounce off. I am especially grateful for inspiring me to write two journal articles about the legal implications of Kindle Worlds, Amazon's commercial fanfiction platform.

I would like to thank my partner Z. Spencer for the unfailing encouragement and for believing that I can do anything I set my mind and willpower to.

A big THANK YOU and hugs go to my family. Their support and care helped me to stay focused on my doctoral thesis.

Special mention goes to our cats for proofreading. They never doubted their aptitude.

**Thank you all for being  
supercalifragilisticexpialidocious!**

## Abstract

Fictional characters have a gigantic commercial and social appeal. Fans create fanfiction and other transformative works. Professionals create films, plays and artwork or literary, musical, and other works based on the underlying work by another author. These professionals as well as third parties are involved in character merchandising. Disney reported a revenue of USD 45.2 billion just for retail sales of worldwide licensed products in 2014.

The appeal of fictional characters is not limited to artistic fictional characters (AFCs), but also encompasses literary fictional characters (LFCs), such as 'Harry Potter' and 'The Doctor'.

The plot-independent protection of LFCs is more challenging than AFCs, because of their representation in words instead of images. Non-graphic representation inevitably leaves more to the imagination of the reader. Regardless, authors' interests in their LFCs are worth protecting.

Copyright is more appropriate than trade mark law and actions for passing off when it comes to the protection of authors against unauthorized exploitation of LFCs per se for new professional literary and other works, fanfiction, mash-ups or other transformative works by amateur content creators, as well as unauthorized character merchandise. Copyright vests in the author automatically. No formalities are required. No cost is involved. Moreover, under copyright law LFCs would benefit from a set of moral rights, which could protect the LFC per se i.a. against unsavoury distortion or attribution to another than its creator.

Trade mark law is ill equipped for the protection of LFCs, i.a. because names of LFCs are often devoid of distinctiveness and are descriptive of posters, notebooks, and similar products which feature the characters.

Passing off actions are also suboptimal. Like trade marks, an action for passing off is also trader orientated instead of author orientated. This leads to an imbalance favouring whoever fulfils the criteria for a claim that the tort passing off has been committed. Thus, even a free-riding trader can claim protection against the author who actually created the LFC.

However, in order to accommodate copyrightability of LFCs per se, a combination of judicial re-interpretation and changes to the Copyright, Designs and Patents Act 1988 are required.

These are set out in this thesis. The effect of the ‘new’ originality standard (‘the author’s own intellectual creation’) on LFC copyrightability shall be discussed as well.

Both foreign common law jurisdictions (namely Canada and the USA) as well as civil law jurisdictions (namely Germany and France) provide insights into the protection of LFCs by copyright. Each country has its own strong points to offer: In Canada, LFCs are copyrightable, if they are distinct and recognized by the public. Moreover, an exception concerning user-generated content, which affects fanfiction, was introduced into the Canadian Copyright Act 1985 by the Copyright Modernization Act 2012. In the USA, LFCs have been protected since 1930 and two tests have been developed to judge LFC copyrightability. In Germany, quite a number of copyright cases concerning LFCs, in particular with regard to character merchandising, have been decided. Even the Supreme Court held that LFCs can attract copyright. In France, LFCs can enjoy copyright protection even after the economic rights have expired, because the moral rights last indefinitely.

In addition to critically evaluating how LFCs could be protected by copyright plot-independently, this thesis also considers how further legal certainty could be provided for parties intending to reuse existing LFCs. In this regard, this thesis looks i.a. into the viability of an extension of PLSclear in collaboration with the Copyright Hub to licensing of LFCs via this system.

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## List of Abbreviations

17 USC	United States Code, Title 17 - Copyright
Abs	Absatz (subsection)
AC	Law Reports, Appeal Cases
AFC	Artistic Fictional Character
AfP	Zeitschrift für Medien- und Kommunikationsrecht (Journal of media and communications law)
AG	Advocate General
AHRC	Arts & Humanities Research Council
ALCS	The Authors' Licensing and Collecting Society
All ER	All England Law Reports
ALR	Australian Law Reports
Anglo-Am L Rev	Anglo-American Law Review
App Cas	Law Reports, Appeal Cases
Az	Aktenzeichen (file number)
B & Ald	Barnewall and Alderson
BASCA	British Academy of Songwriters, Composers and Authors
BBJ	Bookbarn International
BCSC	British Columbia Supreme Court
BGBI	Bundesgesetzblatt (Federal Law Gazette)
BGH	Bundesgerichtshof (Federal Supreme Court)
BGHZ	Entscheidungen des Bundesgerichtshofs in Zivilsachen (decisions of the Federal Supreme Court on civil matters)
BLACA	The British Literary and Artistic Copyright Association
BPatG	Bundespatentgericht (Federal Patent Court)
BU	Bournemouth University
c	contre (versus)
C D Cal	District Court for the Central District of California
C D Mass	District Court for the Central District of Massachusetts
CA	Court of Appeal
CA 1985	Copyright Act 1985
CAD file	computer-aided design file
Cal L Rev	Southern California Law Review
Can Ex Ct	Exchequer Court of Canada
CanLII	Canadian Legal Information Institute
Cardozo Arts & Ent L J	Cardozo Arts & Entertainment Law Review
Cass	Cour de cassation
CAT	Court of Appeal Transcript
CBS	Columbia Broadcasting System, Inc

CCNY	Circuit Court for the Southern District of New York
CDPA	Copyright, Designs and Patents Act
Cert denied	petition for writ of certiorari denied
CETA	Comprehensive Economic and Trade Agreement
CFI	Court of First Instance
Ch, Ch D	Law reports, Chancery Division
ch	chambre (chamber)
ch crim	chambre criminelle (chamber for criminal law cases)
CIPR	Revue Canadienne de Propriété Intellectuelle (Canadian Intellectual Property Review)
Cir	Circuit
CJEU	Court of Justice of the European Union
CLA	Copyright Licensing Agency
CLJ	Cambridge Law Journal
CLLR	Commercial Liability Law Review
CMLR	Common Market Law Report
Cmnd, Cm	Command paper
CMO	Copyright Management Society
col	column
Colum L Rev	Columbia Law Review
Columbia-VLA Journal of Law and the Arts	Columbia-Volunteer Lawyers for the <i>Arts</i> Journal of Law and the Arts
Copyright Soc’y USA	Journal of the Copyright Society of the USA
Court of Appeal for Ontario	ON CA
CPI	Code de la propriété intellectuelle (Intellectual Property Act)
CPR	Canadian Patent Reporter
CREATE	Centre for Copyright and New Business Models in the Creative Economy
CSPLA	Conseil supérieur de la propriété littéraire et artistique (superior council for literary and artistic property)
DACS	The Design and Artists Copyright Society
D Conn	District Court for the District of Connecticut
D Mass	District Court for the District of Massachusetts
D P R	District Court for the District of Puerto Rico
Deb	debates
DFC	Dramatic Fictional Character
DLR	Dominion Law Reports
E D La	District Court for the Eastern District of Louisiana
E D Mich	District Court for the Eastern District of Michigan, Southern Division
E D Miss	District Court for the Eastern Division of Missouri
ECDR	European Copyright and Design Reports

ECR	European Court Reports
ED NY	District Court for the Eastern District of New York
EEA	European Economic Area
EFTA	European Free Trade Association
EIPR	European Intellectual Property Review
EMLR	Entertainment and Media Law Reports
Emory LJ	Emory Law Journal
Ent LR	Entertainment Law Review
ER	Europäische Rechtsprechung (European jurisdiction)
ETMR	European Trade Mark Reports
EUIPO	European Intellectual Property Office
EUTM	European Union trade mark
EWCA Civ	England and Wales Court of Appeal (Civil Division)
EWHC	England and Wales High Court
EWPC	England and Wales Patents County Court
Ex CR, Ex Ct	Canadian Exchequer Court Reports
FA	Football Association
FAPL	Football Association Premier League
F Supp	Federal Supplement
FC, Fed Ct	Federal Court
FCA	Federal Court of Appeal
FCR	Canada Federal Court Reports
FCTD	Federal Court of Canada - Trial Division
FSR	Fleet Street Reports
FTR	Federal Trial Reports
Geo LJ	Georgetown Law Review
GG	Grundgesetz (Basic Law)
Golden Gate U L Rev	Golden Gate University Law Review
GRUR	Gewerblicher Rechtsschutz und Urheberrecht (industrial property and copyright)
GRUR Int	Gewerblicher Rechtsschutz und Urheberrecht, Internationaler Teil (industrial property and copyright, international section)
GRUR-RR	Gewerblicher Rechtsschutz und Urheberrecht, Rechtsprechungs-Report (industrial property and copyright, law report)
Harv Int'l LJ	Harvard International Law Journal
HC	House of Commons
HKLR	Hong Kong Law Reports
HL	House of Lords
IALS	Institute of Advanced Legal Studies
IEHC	High Court of Ireland
IHL	The In-House Lawyer



IIC (formerly Int'l Rev Indus Prop & Copyright L)	International Review of Industrial Property and Copyright Law
IJLIT, Int J Law Info Tech	International Journal of Law and Information Technology
InfoSoc Directive (= Copyright Directive)	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
IPJ	Intellectual Property Journal (Canada)
IPO	Intellectual Property Office
IPQ	Intellectual Property Quarterly
ITA	International Trade Administration
ITMA Review	Institute of Trade Mark Attorneys Review
J Cop Soc USA	Journal Copyright Society of the USA
J Intell Prop L	Journal of Intellectual Property Law
J Leg Stud	Journal of Legal Studies
JBL	Journal of Business Law
JETLaw	Vanderbilt Journal of Entertainment & Technology Law
JIPLP	Journal of Intellectual Property Law & Practice
KG	Kammergericht (Court of Appeal in Berlin)
KUG	Kunsturhebergesetz (Gesetz betreffend das Urheberrecht an Werken der bildenden Künste und der Photographie = Copyright Act regarding works of art and photographie)
LFC	Literary Fictional Character
LG	Landgericht (German regional court)
LQR	Law Quarterly Review
LS	Legal Studies
LT	Law Times Reports
MacG CC	MacGillivray's Copyright Cases
MarkenG	Markengesetz (Trade Marks Act)
Marq Intell Prop L Rev	Marquette Intellectual Property Law Review
M&E	media and entertainment
N D Ga	District Court for the Northern District of Georgia
N D Ill	District Court for the Northern District of Illinois, Eastern Division
NJW	Neue juristische Online-Zeitschrift
NJW-RR	Neue juristische Online-Zeitschrift, Rechtsprechungs-Report
NLA	Newspaper Licensing Agency
NSSC	Nova Scotia Supreme Court
NZIPA	New Zealand Institute of Patent Attorneys
OHCHR	Office of the High Commissioner for Human Rights
OHIM	Office for Harmonization in the Internal Market

Ohio St LJ	Ohio State Law Journal
OJ	Official Journal
OLG	Oberlandesgericht (provincial high court and court of appeal in Germany)
ON CA	Ontario Court of Appeal
Ont Gen Div	Ontario Court of Justice (General Division)
Ont SCJ	Superior Court of Justice in Ontario
OR	Ontario Reports, New Series
PD	public domain
PL	The Practical Lawyer
PLR	public lending right
PLS	Publishers Licensing Society
Pub	Publication
QB	Law Reports, Queen's Bench
QCCA	Québec Court of Appeal
Que CA	Québec Court of Appeal
Que SC	Québec Official Reports, Superior Court
Queen's LJ	Queen's Law Journal
R	Release
RCD	Registered Community Design
RGZ	Entscheidungen des Reichsgerichts in Zivilsachen (decisions of the supreme court of the Reich on civil matters)
RIDA	Revue Internationale du Droit d'Auteur (international review of author right)
RJQ	Québec Law Reports, Recueil des Jurisprudence du Québec
Rn	Randnummer (marginal number)
RPC	Reports of Patent, Design, and Trade Mark Cases
RQ	research question
Rutgers LJ	Rutgers Law Journal
S	Seite (page)
S Ct	Supreme Court Reporter
S D Fla	District Court for the Southern District of Florida
SCC	Supreme Court of Canada
SCJ	Superior Court of Justice
SCR	Supreme Court Reports, Canada
SD Tex	District Court for the Southern District of Texas, Houston Division
SDNY	Southern District of New York
SLT	Scots Law Times
SSRN	Social Science Research Network
TGI	Tribunal de Grande Instance
Trade Marks Directive 1989	First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights

U Miami Ent & Sports L Rev	University of Miami Entertainment & Sports Law Review
UCC	Universal Copyright Convention
UFITA	Schriftenreihe des Archivs für Urheber- und Medienrecht (publication series of the archive for copyright and media law)
UGC	user-generated content
UKHL	United Kingdom House of Lords
UKSC	United Kingdom Supreme Court
UrhG	Urheberrechtsgesetz (Copyright Act)
US	United States Supreme Court Reports
USC	United States Code
USPQ	United States Patents Quarterly
VersR	Versicherungsrecht (insurance law)
W D Mo	District Court for the Western Division of Missouri
W D Wash	Western District of Washington
WCT	WIPO Copyright Treaty
WIPO	World Intellectual Property Organization
Wis Int'l LJ	Wisconsin International Law Journal
Wis L Rev	Wisconsin Law Review
WLR	Weekly Law Reports
WRP	Wettbewerb in Recht und Praxis (journal of competition in law and practice)
ZUM	Zeitschrift für Urheber- und Medienrecht (journal of copyright and media law)

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# Table of Contents

ACKNOWLEDGEMENTS .....	I
ABSTRACT.....	II
LIST OF ABBREVIATIONS .....	IV
TABLE OF CONTENTS.....	X
CHAPTER 1 - INTRODUCTION .....	1
<b>1.1. Background .....</b>	<b>1</b>
1.1.1. Harry Potter – a story of litigation.....	3
1.1.2. The limited protection of fictional characters in the UK .....	7
1.1.2.1. Cases concerning AFCs.....	7
1.1.2.1.1. King Features Syndicate Inc v O and M Kleeman Ltd .....	7
1.1.2.1.2. Mirage Studios v Counter-Feat Clothing Company Limited .....	9
1.1.2.1.3. Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others .....	10
1.1.2.1.4. Other cases concerning diverse AFCs .....	11
1.1.2.1.5. Conclusion .....	11
1.1.2.2. Cases concerning LFCs .....	11
1.1.2.2.1. Kelly v Cinema Houses, Ltd .....	12
1.1.2.2.2. Bolton v International Pictures Ltd .....	13
1.1.2.2.3. Universal City Studios Inc and Others v Mukhtar & Sons Ltd .....	14
1.1.2.2.4. Allen v Bloomsbury Publishing Plc .....	15
1.1.2.2.5. Hodgson v Isaac.....	15
1.1.2.2.6. Ravenscroft v Herbert .....	16
1.1.2.2.7. Harman Pictures v Osborne .....	16
1.1.2.2.8. Conclusion .....	17
<b>1.2. Research objective .....</b>	<b>17</b>
<b>1.3. Research question(s) .....</b>	<b>18</b>
<b>1.4. Research strategy and structure .....</b>	<b>19</b>
1.4.1. The first component of the thesis .....	19
1.4.2. The second component of the thesis and geographical scope .....	19
<b>1.5. Research methodology .....</b>	<b>20</b>
1.5.1. Library-based research .....	20
1.5.2. Comparative approach .....	21
<b>1.6. Conclusion .....</b>	<b>23</b>
CHAPTER 2 – LITERATURE REVIEW AND CONTEXT .....	25
<b>2.1. No copyright for LFCs per se: The general lack thereof and the specific gaps.....</b>	<b>25</b>
<b>2.2. Reasons for re-evaluating LFC copyrightability .....</b>	<b>35</b>
2.2.1. Commercial reproductions.....	36
2.2.2. Fanfiction.....	37
2.2.3. Incentive to create cultural and educational works.....	39
2.2.4. Personality right .....	40
2.2.5. Moral rights .....	40

2.2.6. Character merchandising .....	42
2.2.7. Statistics .....	44
2.2.8. Prevention of consumer misinformation .....	47
2.2.9. Sequels .....	48
<b>2.3. Conclusion .....</b>	<b>50</b>
<b>CHAPTER 3 – STRENGTHS AND WEAKNESSES OF TRADE MARK PROTECTION .....</b>	<b>52</b>
<b>3.1. Introduction .....</b>	<b>52</b>
<b>3.2. Purpose of trade marks and copyright.....</b>	<b>53</b>
<b>3.3. Duration of copyright and trade marks.....</b>	<b>55</b>
<b>3.4. Registration of trade marks .....</b>	<b>57</b>
<b>3.5. Registration of copyright in LFCs? .....</b>	<b>58</b>
3.5.1. Registration service .....	59
3.5.2. Licensing service .....	60
3.5.3. Digital Public Domain Registry or Public Domain Calculator .....	63
<b>3.6. Scope of trade mark protection .....</b>	<b>66</b>
3.6.1. Character names .....	68
3.6.2. Origin function.....	70
3.6.2.1. Animated Music Ltd’s Trade Mark.....	71
3.6.2.2. Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others.....	72
3.6.3. Absolute grounds for refusal of trade mark registration .....	73
3.6.3.1. Decorative use .....	73
3.6.3.2. Linkin Park LLC’s Application.....	76
3.6.3.2.1. The hearing officer’s decision (2005) .....	76
3.6.3.2.2. The appeal (2006) .....	77
3.6.3.2.2.1. Invented word .....	77
3.6.3.2.2.2. Characteristics .....	80
3.6.3.2.2.3. Nature of the goods and the Registrar’s practise.....	81
3.6.4. Relative grounds for refusal of trade mark registration and infringement.....	83
3.6.4.1. Interlego AG v Tyco Industries Inc .....	83
3.6.4.2. Hearst v A.V.E.L.A., and La Chemise Lacoste .....	84
<b>3.7. Conclusion .....</b>	<b>86</b>
<b>CHAPTER 4 – STRENGTHS AND WEAKNESSES OF AN ACTION FOR PASSING OFF.....</b>	<b>92</b>
<b>4.1. Introduction .....</b>	<b>92</b>
<b>4.2. Purpose of an action for passing off .....</b>	<b>92</b>
<b>4.3. Limitation period.....</b>	<b>93</b>
<b>4.4. Scope of protection of an action for passing off .....</b>	<b>94</b>
4.4.1. The requirements of an action against passing off in general .....	94
4.4.2. The requirements of an action against passing off with regard to fictional characters.....	96
4.4.2.1. The general requirements with regard to fictional characters.....	96
4.4.2.2. Additional requirements with regard to fictional characters .....	99
4.4.3. Difficulties of proof.....	101
4.4.3.1. Goodwill.....	101
4.4.3.2. Misrepresentation .....	102

4.4.3.3. Damage .....	102
4.4.4. Misrepresentation of a connection .....	103
4.4.5. Common field of activity .....	107
4.4.5.1. Wombles Ltd v Wombles Skips .....	108
4.4.5.2. Taverner Rutledge Ltd v Trexapalm Ltd .....	109
4.4.5.3. Lyngstad v Anabas Products Ltd .....	110
4.4.6. Departure from the strict doctrine.....	110
4.4.7. Awareness of character merchandising .....	112
4.4.8. Points to consider when establishing confusion .....	115
4.4.9. Mr Spoon, Rihanna, and Betty Boop .....	116
4.4.9.1. Allen v Redshaw .....	117
4.4.9.2. Fenty v Arcadia Group Brands Ltd (t/a Topshop) .....	117
4.4.9.2.1. Goodwill .....	118
4.4.9.2.2. Misrepresentation.....	119
4.4.9.2.3. Damage .....	121
4.4.9.3. Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others .....	121
4.4.10. Protection against use of a character in another literary work .....	123
<b>4.5. Conclusion .....</b>	<b>126</b>
<b>CHAPTER 5 – THE MORAL RIGHTS ASPECT .....</b>	<b>131</b>
<b>5.1. Introduction .....</b>	<b>131</b>
<b>5.2. Structure of this chapter.....</b>	<b>132</b>
<b>5.3. Purpose of a passing off action and moral rights .....</b>	<b>132</b>
<b>5.4. The individual moral rights.....</b>	<b>135</b>
5.4.1. Paternity right .....	135
5.4.1.1. Elements & scope of the paternity right.....	135
5.4.1.2. The use of the paternity right against unauthorized literary works .....	137
5.4.1.2.1. Restricted acts.....	137
5.4.1.2.2. Restricted acts in relation to an adaptation.....	140
5.4.1.2.3. Exceptions to the paternity right .....	142
5.4.1.3. The use of the paternity right against (un)authorized character merchandising .....	142
5.4.1.3.1. Communication to the public.....	143
5.4.1.3.2. Commercial publication .....	145
5.4.1.3.3. Recommendation.....	146
5.4.2. Right to object to false attribution .....	147
5.4.2.1. Elements & scope of the right to object to false attribution .....	147
5.4.2.2. The use of the right to object to false attribution against unauthorized literary works .....	149
5.4.2.3. The use of the right to object to false attribution against (un)authorized character merchandising .....	150
5.4.3. Integrity right.....	151
5.4.3.1. Elements & scope of the integrity right .....	152
5.4.3.1.1. Treatment .....	152
5.4.3.1.2. Derogatory .....	152
5.4.3.1.3. Distortion and mutilation.....	152
5.4.3.1.4. Prejudicial to the honour or reputation .....	153
5.4.3.2. The use of the integrity right against unauthorized literary works .....	156
5.4.3.2.1. Any part of a work.....	156
5.4.3.2.2. Fanfiction, screenplays and the integrity right .....	157
5.4.3.2.3. Restricted acts.....	158
5.4.3.2.4. Exceptions to the integrity right.....	158
5.4.3.3. The use of the integrity right against (un)authorized character merchandising .....	159

<b>5.5. The overlap of the right to object to false attribution and an action for passing off .....</b>	<b>160</b>
<b>5.6. Conclusion .....</b>	<b>164</b>
5.6.1. Main advantages of moral rights.....	164
5.6.2. Main advantages of an action for passing off .....	165
5.6.3. Recommended changes to the CDPA 1988.....	166
<b>CHAPTER 6 – COPYRIGHT PROTECTION OF LFCs IN CANADA AND THE USA .....</b>	<b>168</b>
<b>6.1. Introduction .....</b>	<b>168</b>
<b>6.2. Canada .....</b>	<b>170</b>
6.2.1. General legal requirements for copyright protection of LFCs.....	170
6.2.1.1. Catalogue of protected works .....	171
6.2.1.2. Fixation requirement .....	172
6.2.1.3. Originality.....	173
6.2.1.3.1. Tele-Direct (Publications) Inc v American Business Information, Inc.....	174
6.2.1.3.2. CCH Canadian Ltd v Law Society of Upper Canada .....	175
6.2.1.3.3. Originality in the UK and according to the CJEU .....	176
6.2.1.3.4. Berne Convention 1886 .....	177
6.2.1.3.5. Balance of conflicting interests .....	177
6.2.1.3.6. NAFTA.....	178
6.2.1.3.7. Summary and conclusion.....	179
6.2.1.4. Idea / expression dichotomy .....	179
6.2.1.5. Titles.....	181
6.2.2. Specific legal requirements for copyright protection of LFCs .....	182
6.2.3. Fanfiction.....	186
6.2.4. Unauthorized character merchandising .....	188
6.2.5. Moral rights .....	190
<b>6.3. United States of America .....</b>	<b>191</b>
6.3.1. General legal requirements for copyright protection of LFCs.....	191
6.3.1.1. Catalogue of protected works .....	192
6.3.1.2. Fixation requirement .....	192
6.3.1.3. Originality.....	193
6.3.1.4. Idea / expression dichotomy .....	196
6.3.1.4.1. Hand CJ: No infallible principle .....	197
6.3.1.4.2. Prof. Chafee: The pattern of a work.....	197
6.3.1.4.3. Hamley CJ: ‘total concept and feel’ of the work .....	197
6.3.1.4.4. Hand CJ and Kaplan: ‘abstractions test’ .....	198
6.3.1.4.5. Hand CJ and Scheindlin J: The individual complexity of a character .....	199
6.3.1.4.6. Hand CJ: The importance of the character to the work.....	200
6.3.1.5. Titles and names .....	200
6.3.2. Specific legal requirements for copyright protection of LFCs .....	201
6.3.2.1. The delineated test .....	202
6.3.2.1.1. The test .....	202
6.3.2.1.2. Components.....	203
6.3.2.1.3. Criticism of the delineated test.....	204
6.3.2.2. The story being told test.....	207
6.3.2.2.1. The test .....	207
6.3.2.2.2. Criticism of the story being told test.....	208
6.3.2.3. Both tests .....	210
6.3.2.4. Scènes à faire .....	212
6.3.3. Duration of protection for LFCs.....	212
6.3.4. Fanfiction and commercial fan works .....	216
6.3.5. Character merchandising .....	219
6.3.5.1. Ideal Toy Corp v Kenner Products.....	220
6.3.5.2. Universal Studios, Inc, et al v JAR Sales et al.....	221

<b>6.4. Conclusion</b> .....	<b>222</b>
<b>CHAPTER 7 – COPYRIGHT PROTECTION OF LFCs IN GERMANY AND FRANCE</b> .....	<b>228</b>
<b>7.1. Introduction</b> .....	<b>228</b>
<b>7.2. Germany</b> .....	<b>230</b>
7.2.1. General principles of copyright protection applied to LFCs .....	230
7.2.1.1. Catalogue of protected works .....	230
7.2.1.2. Originality – de minimis .....	232
7.2.1.2.1. Personal intellectual creations .....	232
7.2.1.2.2. Gestaltungs-/Schöpfungshöhe .....	232
7.2.1.2.3. Titles and names of LFCs .....	233
7.2.1.2.4. LFCs and the idea/expression dichotomy .....	234
7.2.1.3. No fixation required .....	237
7.2.2. Specific principles of character copyrightability .....	239
7.2.2.1. AFCs .....	239
7.2.2.2. LFCs .....	241
7.2.2.2.1. ‘Sherlock Holmes’ case .....	241
7.2.2.2.2. ‘A girlfriend for Pumuckl’ case .....	243
7.2.2.2.3. ‘Harry Potter’ case .....	243
7.2.2.2.5. ‘Die Päpstin’ case .....	246
7.2.2.2.6. ‘Anna Marx’ case .....	247
7.2.2.2.7. ‘Pippi Langstrumpf’ cases .....	248
7.2.2.2.7.1. LG Berlin, Urteil vom 11.08.2009 .....	248
7.2.2.2.7.2. LG München and OLG München .....	249
7.2.2.2.7.2.1. LG München I, Beschluss vom 20.07.2011 .....	250
7.2.2.2.7.2.2. OLG München, Beschluss vom 10.08.2011 .....	251
7.2.2.2.7.3. OLG Köln, Urteil vom 14.10.2011 .....	252
7.2.2.2.7.4. LG Köln, OLG Köln, and BGH .....	253
7.2.2.2.7.4.1. The LG Köln’s decision .....	253
7.2.2.2.7.4.2. The OLG Köln’s decision .....	254
7.2.2.2.7.4.3. The BGH’s decision .....	255
7.2.3. Character merchandising .....	256
7.2.3.1. AFCs .....	256
7.2.3.1.1. ‘Bill the dog’ case .....	256
7.2.3.1.2. ‘Hippo Azul’ case .....	257
7.2.3.2. LFCs .....	258
7.2.4. Moral rights .....	258
<b>7.3. France</b> .....	<b>259</b>
7.3.1. General principles of copyright protection .....	260
7.3.1.1. Work of the mind .....	260
7.3.1.2. Record of a work - Ideas and their expression .....	261
7.3.1.3. The subjectivity of originality .....	262
7.3.2. Specific principles of copyright protection of LFCs .....	264
7.3.2.1. Name .....	264
7.3.2.2. Character criteria .....	266
7.3.2.2.1. Physical likeness .....	266
7.3.2.2.2. The nature of the character .....	267
7.3.2.3. Equal criteria for AFCs and LFCs .....	268
7.3.2.4. Copyright protection of characters via moral rights .....	269
7.3.2.4.1. France - UK .....	270
7.3.2.4.2. France - Germany .....	274
7.3.2.4.3. France – Germany - UK .....	276
7.3.2.5. Economic rights, moral rights and merchandising .....	277
<b>7.4. Conclusion</b> .....	<b>280</b>



<b>CHAPTER 8 – LFCS AND THE UK COPYRIGHT CRITERIA.....</b>	<b>285</b>
<b>8.1. Introduction .....</b>	<b>285</b>
<b>8.2. Categorising LFCs.....</b>	<b>285</b>
8.2.1. Literary work .....	286
8.2.2. Substantial part .....	292
8.2.3. Work sui generis.....	294
<b>8.3. Copyright principles, requirements and criteria.....</b>	<b>296</b>
8.3.1. Idea/expression dichotomy.....	297
8.3.2. Originality .....	304
8.3.3. The potential effect of Brexit on originality .....	322
8.3.4. Criteria of a substantial part of a work.....	323
8.3.4.1. Same treatment of the whole and a part? .....	323
8.3.4.2. Character formula.....	324
8.3.4.3. Non-character specific substantiality criteria .....	327
8.3.4.4. Reader recognition requirement .....	329
8.3.4.5. An element of predictability .....	332
8.3.4.6. Character dictating genre and plot .....	333
8.3.4.7. Intentional copying .....	333
<b>8.4. Main areas of potential copyright infringement of LFCs .....</b>	<b>334</b>
8.4.1. Fanfiction.....	335
8.4.2. Character merchandising issues .....	337
8.4.2.1. Section 17(3) and the dimensional shift of LFCs .....	338
8.4.2.2. The limits of section 17(3) .....	339
8.4.2.3. General principles of protection .....	341
8.4.2.4. Term of protection.....	343
8.4.2.5. The adaptation right and character merchandising .....	344
<b>8.5. Conclusion .....</b>	<b>345</b>
<b>CHAPTER 9 – RECOMMENDATIONS AND CONCLUSIONS.....</b>	<b>350</b>
<b>9.1. Introduction .....</b>	<b>350</b>
<b>9.2. Research objective .....</b>	<b>350</b>
<b>9.3. Research Questions and Answers.....</b>	<b>352</b>
<b>9.4. Recommendations .....</b>	<b>361</b>
9.4.1. Recommended judicial re-interpretation of the CDPA 1988 .....	361
9.4.2. Recommended additions to the CDPA 1988 .....	362
<b>9.5. Key conclusions .....</b>	<b>367</b>
<b>9.6. Suggestion for future development.....</b>	<b>369</b>
<b>BIBLIOGRAPHY.....</b>	<b>VII</b>

## Chapter 1 - Introduction

*‘A work of art is the unique result of a unique temperament. ... Art is the most intense mode of individualism that the world has known.’*<sup>1</sup> It exhibits individualism of the creators as well as individualism of the creations.

### 1.1. Background

The term ‘art’ as used above does not refer exclusively to paintings, but to all forms of creative works. Hence, art comprises sonnets, caricatures, songs, radio broadcasts, sculptures, films, computer games and many more types of works. The Copyright, Designs and Patents Act (CDPA) 1988 protects the major categories of works of art i.a. from being copied as a whole or a substantial part of the literary ‘mother work’.<sup>2</sup>

However, literary fictional characters (LFCs) per se, independent of the underlying work, are not protected by UK copyright,<sup>3</sup> although each form of art may make use of fictional characters.

The introduction of a *sui generis* character right had been suggested, but was dismissed, in the Government’s White Paper Cm 1203.<sup>4</sup> The Whitford Committee had been concerned how copyrightable characters could be distinguished from non-

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<sup>1</sup> Oscar Wilde, ‘The Soul of a Man Under Socialism’ in Sally Ledger and Roger Luckhurst (eds), *The Fin de Siècle – A Reader in Cultural History c 1880-1900* (1<sup>st</sup> edn, OUP 2000) 189 (emphasis added). Oscar Wilde classed literature among the arts. In the cross-examination by Edward Carson in the Queensberry case, Oscar Wilde said: ‘I am entirely concerned with literature: that is, with art.’ Hesketh Pearson, *The life of Oscar Wilde* (1<sup>st</sup> edn, Penguin Books 1960) 155.

<sup>2</sup> CDPA 1988 ss 16(3)(a), 17; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 132, 157.

The term ‘mother work’ coined in this thesis denotes the literary work which featured the LFC originally.

<sup>3</sup> *Tavener Rutledge Ltd v Trexapalm Ltd* [1977] RPC 275, 278; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 4 and 13; Gary Scanlan, ‘Derivative aspects of character and perceived attributes in persona as forms of intellectual property: Part 2’ (2004) 15 Ent LR 1, 4.

<sup>4</sup> Department of Trade and Industry, *Reform of Trade Marks Law* (Cm 1203, 1989/90) para 4.42; Howard Johnson, ‘Legal aspects of character merchandising’ (1992) 34 Managerial Law 1, 5.

copyrightable ones.<sup>5</sup> To this day, no character right has been introduced into copyright legislation.

This thesis was inspired by this lack of protection, which is in stark contrast to copyright protection of LFCs in Germany, France, Canada and the US. In particular in view of the omnipresence and financial worth of character merchandise, LFC copyrightability in the UK should be re-evaluated. It is not necessary to go as far as introducing a *sui generis* character right, but critically evaluating and establishing plot-independent LFC copyrightability is the purpose of this thesis.

To begin with, some terminology should be explained. The individual terms of the different types of characters, i.e. fictional persons,<sup>6</sup> depend on the form of work they appear in. Fictitious characters from novels, poems, and other literary works are called literary fictional characters, here abbreviated to LFCs. Some practical examples of LFCs are ‘Sherlock Holmes’ and ‘Dr. Watson’ created by Sir Arthur Conan Doyle, ‘Carrot Ironfoundersson’ and the ‘Patrician of Ankh-Morpork’, ‘Lord Havelock Vetinari’, from Terry Pratchett’s *Discworld* series, ‘Uhtred of Bebbanburg’ from Bernard Cornwell’s *Saxon Stories*, also known as *The Last Kingdom* series, and ‘Esca Mac Cunoval’ and ‘Marcus Flavius Aquila’ from Rosemary Sutcliff’s *The Eagle of the Ninth*.<sup>7</sup> Fictional characters from TV scripts, films or plays for stage productions may be referred to as both dramatic fictional characters (DFCs) and LFCs. Fictive characters also appear in comics, cartoons, computer games and other artistic works. These are termed artistic fictional characters (AFCs) or characters in graphic form.<sup>8</sup>

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<sup>5</sup> Whitford Committee, *Copyright and Designs Law – Report of the Committee to consider the Law on Copyright and Designs* (Cmnd 6732, 1976-77) para 909.

<sup>6</sup> Ian C Baillie, ‘Merchandising: an historical survey’ in John N Adams, *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) xxxix.

<sup>7</sup> These characters are simply examples of LFCs. Whether these LFCs should be copyrightable is a different matter.

<sup>8</sup> JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 271; Nicholas Ide and Alain Strowel, ‘Character Merchandising – A business’ in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer International Law 2003) 36.

### 1.1.1. Harry Potter – a story of litigation

New authors, publishing houses and film producers may, on occasion, take a short cut to 'easy money'. By simply jumping on the bandwagon of another author's popularity and by drawing strong inspiration from the work of the popular authors, instead of producing and publishing something that stems entirely from their own mind, they can get a slice of the cake themselves. This money making strategy worked out well for the publisher and author of the Russian 'Harry Potter' clone 'Tanya Grotter', of which an entire series was published and continues to be published. Within nine months of 'Tanya Grotter's' launch, Yemetz sold 600,000 copies. In comparison, JK Rowling sold 1.5 million copies of 'Harry Potter' books in the same period in Russia.<sup>9</sup> Although Rowling is still ahead of the race, Yemetz is serious competition. The (financial) success of the 'Tanya Grotter' series i.a. in Russia led to the publication of so far fourteen volumes plus sixteen 'Tanya Grotter' spin-offs, and a further fourteen spin-offs, such as thirteen volumes of the 'Methodius Buslaev' series about a young, male magician.<sup>10</sup> JK Rowling and Time Warner failed to succeed in the Russian court against the author and publisher of 'Tanya Grotter' for copyright infringement. This makes 'Harry Potter' easy prey for other authors and publishers etc. 'Tanya Grotter' is not the only popular 'Harry Potter' imitation. There is also 'Porry Gatter' by Andrei Zhvalevskiy in Belarus.<sup>11</sup> This phenomenon is not restricted to Russia and Belarus. In recent years JK Rowling and Time Warner fought cases around the globe.

For example, in China, an unauthorized novel with the title *Harry Potter and Bao Zoulong* was published in 2002. The book was basically *The Hobbit* by JRR Tolkien.

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<sup>9</sup> Robyn Dixon, "'Tanya Grotter' tries to grab Potter's magic' (*Orlando Sentinel*, 13 April 2003) <[http://articles.orlandosentinel.com/2003-04-13/news/0304130070\\_1\\_potter-books-tanya-harry-potter](http://articles.orlandosentinel.com/2003-04-13/news/0304130070_1_potter-books-tanya-harry-potter)> accessed 20 May 2013; ABC News, 'Harry Potter wins "Tanya Grotter" court battle' (4 April 2003) <<http://www.abc.net.au/news/2003-04-04/harry-potter-wins-tanya-grotter-court-battle/1829698>> accessed 2 June 2013.

<sup>10</sup> A spin-off is a work derived from an already existing work, which centres most commonly upon a particular character, but may also focus on a particular event or topic.

<sup>11</sup> Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 122; Anupam Chander and Madhavi Sunder, 'Everyone's a Superhero: A Cultural Theory of "Mary Sue" Fan Fiction as Fair Use' (2007) 95 *California Law Review* 597, 610 et seq. However, unlike 'Tanya Grotter' which has many parallels to 'Harry Potter' character- and story-wise, 'Porry Gatter' uses a grenade launcher and re-fights the Belarussian War of Independence. Tim Wu, 'Harry Potter and the International Order of Copyright' (*Slate*, 27 June 2003) <[http://www.slate.com/articles/news\\_and\\_politics/jurisprudence/2003/06/harry\\_potter\\_and\\_the\\_international\\_order\\_of\\_copyright.html](http://www.slate.com/articles/news_and_politics/jurisprudence/2003/06/harry_potter_and_the_international_order_of_copyright.html)> accessed 2 June 2013.

The names of the characters were changed to those of 'Harry Potter'. In the same year, another fake 'Harry Potter' novel was published, *Harry Potter and the Porcelain Doll*. An estimate of 15 million copies of 'Harry Potter' novels, which have not been written by JK Rowling, are circulated in China.<sup>12</sup>

In 2003, the publishers of the 'genuine Harry Potter' stopped Uttam Ghosh from selling *Harry Potter in Kolkata*. In that book, 'Harry Potter' makes the acquaintance of characters from Bengalese literature.<sup>13</sup>

A couple of years later, in 2008, Rowling and Warner Brothers sued Vander Ark and RDR Books in the US.<sup>14</sup> Vander Ark had created a 'Harry Potter' fan website on which anyone could inform themselves about the characters, creatures, places, events, spells, objects, terms and other fictional facts from the magical 'Harry Potter' realm. Much of the information were verbatim excerpts from Rowling's novels. RDR books intended to launch this electronic encyclopedia in book form. Rowling proclaimed the same intention and tried to stop the publication, which would harm her economic interests. The District Court for the SDNY stated that the defendants had infringed copyright in Rowling's 'Harry Potter' series and the companion books, because substantial parts were copied.<sup>15</sup> Fictional characters are protected in the US by copyright. However, in the case against RDR & Vander Ark not just LFCs were copied, but also places, magical items, etc. Hence, the court did not concentrate on LFCs, but instead held that the defendants had copied a substantial part of the 'Harry Potter' works by Rowling. Some of the copied content had been rephrased, but most of the copied content had been taken word for word. The court did not have to resort to copyright protection of fictional characters.

However, the copyright infringement might have been justified by fair use, if the defendants' lexicon was sufficiently transformative.<sup>16</sup> That means, if the defendants

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<sup>12</sup> Potter Game, 'Legal disputes over the Harry Potter series – CNC Machining Parts Manufacturer – China Turned parts' (18 November 2010) <<http://www.pottergame.org/harry-potter-internet-game/>> accessed 25 May 2013.

<sup>13</sup> Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 123; Anupam Chander and Madhavi Sunder, 'Everyone's a Superhero: A Cultural Theory of "Mary Sue" Fan Fiction as Fair Use' (2007) 95 Cal L Rev 597, 610 et seq.

<sup>14</sup> *Warner Bros Entertainment Inc v RDR Books*, 575 F Supp 2d 513, 552 (SDNY 2008).

<sup>15</sup> *Ibid* 534-538 and 554.

<sup>16</sup> The *Harry Potter Lexicon* was not a consistently transformative work, because it copied the wording of the 'Harry Potter' series excessively. Hence, the defendant could not rely on fair use as a defence against copyright infringement. *Ibid* 539 et seqq and 544.

had paraphrased Rowling's expression/work and had put more creativity of their own into the making of the encyclopedia, then Rowling may not have been able to prevent the publication of a lexicon written by somebody else based on her creations. In consequence, she would have lost revenue, because a lexicon of her own would have been superseded on the consumer market by the earlier published lexicon written by somebody else who cashes in on her success.<sup>17</sup> This sparks the questions: How far does copyright protection of fictional characters go in the US? Where are the limits to copyrightability of fictional characters? Are minor characters such as 'Harry Potter's son copyrightable?

In 2004, a comic based on 'Harry Potter' was published in a US army manual on equipment maintenance for soldiers. The comic featured a character named 'Topper' who lived at Mogmarts School, which was run by 'Prof. Rumbledore'. The matter was resolved outside court.<sup>18</sup> This also raised the questions: How far removed from the original would the copy have to be so that it was not a reproduction in the legal sense? How would this be measured?

While a fanfiction writer may be able to claim fair use in the USA, it is highly unlikely that the fanfiction writer would be able to excuse herself under the fair dealing provisions in the UK. The CDPA 1988 contains a specific list of copyright exceptions, such as for example criticism and review. However, a writer of fanfiction is 'an enthusiast ... not a critic'.<sup>19</sup> Copyright infringement would depend very much on the substantiality of the copied elements.

In the Dutch case *Rowling v Uitgeverij Byblos BV*,<sup>20</sup> the defendant Dutch Publishing Company intended to publish the book *Tanya Grotter and the Magical Double Bass* by

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<sup>17</sup> A fan lexicon on a series of works of a certain author is a work created to sate fans. It is unlike any other common encyclopedia on today's knowledge on science, art, geography, philosophy etc. The publication of a fan lexicon should be in the control of the author of the underlying works.

<sup>18</sup> The editor of the monthly journal for soldiers agreed not to repeat the utilisation of the character.

<sup>19</sup> Grace Westcott, 'Friction over Fan Fiction' (2008) *Literary Review of Canada* <[www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/](http://www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/)> accessed 9 January 2013.

<sup>20</sup> LJN: AF6846, Rechtbank Amsterdam, KG 03/477 SR (3 April 2003) = *Rowling v Uitgeverij Byblos BV* [2003] ECDR 23. The decision was confirmed by the appellate court in LJN: AN7646, Gerechtshof Amsterdam, 844/03 SKG on 6 November 2003.

the Russian author Dmitri Yemetz. The District Court of Amsterdam granted injunctive relief, because the defendant would infringe the applied for word mark 'Harry Potter', if the application for trade mark registration was successful.<sup>21</sup> In addition, Byblos would infringe copyright by publishing the 'Tanya Grotter' series. Rowling used many elements from the public domain in her 'Harry Potter' novels, such as 'orphan with mean step-parents, children with magic powers, magic objects, flying on broomsticks'. Therefore, Rowling's copyright protection is diminished.<sup>22</sup> Even so, the judge held that the defendant was liable for copyright infringement. However, due to the public domain elements used for the creation of 'Harry Potter', the court rather concentrated on the close resemblance between the storyline (chronology, plot, ending) of *Harry Potter and the Philosopher's Stone* by JK Rowling and Dmitri Yemetz's novel.<sup>23</sup>

A British court, too, would have relied on the storyline to find copyright infringement, because CDPA 1988 s 16(1)(a), (2) and (3) protect original works and their substantial parts from being copied. In order to ascertain whether a substantial part has been copied courts compare the plot and scenes (like the Dutch court did). However, how would a court decide in cases where the storyline of both works is not alike, but the characters are obviously the same? As fictional characters per se independent of the plot are not protected by copyright under the CDPA 1988, their authors would be relatively powerless.<sup>24</sup>

JK Rowling proceeded against parties who allegedly copied elements of her 'Harry Potter' novels in many countries around the world. Is it not ironic that 'Harry Potter' would not be as well protected in his country of creation, because LFCs per se are not copyrightable plot-independently in the UK? Apart from the 'Willy the wizard' case against Bloomsbury Publishing,<sup>25</sup> and a case regarding stolen copies of one of her

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<sup>21</sup> *Rowling v Uitgeverij Byblos BV* [2003] ECDR 23 [H7].

<sup>22</sup> *Ibid* [4].

<sup>23</sup> *Ibid* [6].

<sup>24</sup> The only protection afforded would be by trade mark law and the law of passing off. However, these means of protection are inadequate or at least inappropriate for the protection of LFCs as will be argued in chapters 3 and 4.

<sup>25</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560.

books offered for sale by the thief before actual publication,<sup>26</sup> no case for copyright infringement of the character ‘Harry Potter’ was fought in UK courts.

### 1.1.2. The limited protection of fictional characters in the UK

The following case-law illustrates in how far fictional characters are protected in the UK, where the limits are, and thereby also how differently AFCs and LFCs are treated. Although this thesis is concerned with the practical difficulties of copyright protection of LFCs per se, cases dealing with copyrightability of AFCs are addressed here first. It is easier to protect AFCs by copyright than LFCs due to the AFCs’ visual nature. Even so, there is not even one hundred percent consensus that AFCs are protected by copyright. This demonstrates how much more challenging it is for LFCs to be protected by copyright.

#### 1.1.2.1. Cases concerning AFCs

##### 1.1.2.1.1. *King Features Syndicate Inc v O and M Kleeman Ltd*<sup>27</sup>

In *King Features Syndicate Inc v O and M Kleeman Ltd* (‘Popeye’ case), the plaintiffs were the owners of the copyright in the comic strips ‘Popeye The Sailor’. The defendant ordered the production of and imported similar looking dolls and brooches, referred to as e.g. ‘Plaster filled Popeye’ or ‘Mechanical Popeye toy’ in the invoice, without the plaintiffs’ consent.<sup>28</sup> The plaintiffs claimed that the defendant infringed their copyright. The High Court (Chancery Division), Court of Appeal, and House of Lords agreed that the three-dimensional products such as dolls were reproductions of the two-dimensional cartoon strip character ‘Popeye’, and therefore infringed artistic

<sup>26</sup> *Bloomsbury Publishing Plc, JK Rowling v Newsgroup Newspapers Limited* [2003] EWHC 1087 Ch.

<sup>27</sup> Chancery Division (Simonds J): *King Features Syndicate Inc v O and M Kleeman Ltd* [1938] K 477, [1940] Ch 523; Court of Appeal (Scott, Clauson and Luxmoore LJ): *King Features Syndicate Inc v O and M Kleeman Ltd* [1940] Ch 806; House of Lords (Viscount Maugham, Lord Russell of Killowen, Lord Wright, Lord Romer and Lord Porter): *King Features Syndicate Inc v O and M Kleeman Ltd* [1941] AC 417 (‘Popeye The Sailor’ case).

<sup>28</sup> *King Features Syndicate Inc v O and M Kleeman Ltd* [1938] K 477, [1940] Ch 523, 530.



copyright.<sup>29</sup> The toys were not exact copies of the original drawings, but they resembled the AFC to such a degree that

- a) copyright was infringed by reproducing the features and attributes of a fictional character<sup>30</sup> as a substantial part of an original work, the comic strip, and not an original work itself<sup>31</sup>
- b) in another medium (three-dimensional toy instead of two-dimensional drawing)
- c) independent of the original work.

This last fact is derived from the judges' decision that the reproduction constituted copyright infringement of the original artistic work, although the products ordered and imported by the defendant were no direct reproduction of the cartoon sketches, but copies of the licensees' toys.<sup>32</sup>

This case was a milestone in solving the question whether copyright can vest in fictive characters, but concerned merely AFCs, not LFCs. Although many scholars believe that characters based on drawings are protected by copyright as artistic works,<sup>33</sup> the

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<sup>29</sup> *King Features Syndicate Inc v O and M Kleeman Ltd* [1940] Ch 523; *King Features Syndicate Inc v O and M Kleeman Ltd* [1941] AC 417 (HL). However, the Court of Appeal departed from this course in so far as it held that the reproduction would constitute copyright infringement, but for the Copyright Act 1911 s 22. According to the CA's view design prevented copyright. *King Features Syndicate Inc v O and M Kleeman Ltd* [1940] Ch 806, 815, 827 (CA).

<sup>30</sup> 'Popeye' is dressed as a sailor, wearing i.a. a sailor's hat, a sailor's jacket with up-turned sleeves so that the grotesquely large forearms show, an anchor tattooed on each arm, a pipe in the corner of his mouth. *King Features Syndicate Inc v O and M Kleeman Ltd* [1940] Ch 806, 822.

<sup>31</sup> *King Features Syndicate Inc v O and M Kleeman Ltd* [1940] Ch 523; *King Features Syndicate Inc v O and M Kleeman Ltd* [1940] Ch 806, 815.

<sup>32</sup> *King Features Syndicate Inc v O and M Kleeman Ltd* [1940] Ch 523; *King Features Syndicate Inc v O and M Kleeman Ltd* [1940] Ch 806 (CA); *King Features Syndicate Inc v O and M Kleeman Ltd* [1941] AC 417 (HL); John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 7.

<sup>33</sup> John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 5; Peter Jaffey and Nic Couchman, 'English Law' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 362; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 210; John Hull, 'The merchandising of real and fictional characters: an analysis of some recent developments' (1991) 2 Ent LR 124, 125; Allison Coleman, 'Character Merchandising and Fictitious Characters' (1982) 10 EIPR 285.

McGee and Scanlan agree that AFCs are copyright protected, but they argue that this protection is very limited. They take the view that an illustrator could not even protect her AFCs against an 'essentially similar' pictorial reproduction of her AFC. Andrew McGee and Gary Scanlan, 'Copyright in character' (2003) JBL 470, 480. This thesis does not agree with that assessment as this thesis will demonstrate throughout the chapters.

'Popeye' case was not the end to the debate on the copyrightability of characters. Courts are still struggling to answer the question of copyrightability of AFCs, and at times, even avoid or try to avoid dealing with it.

#### 1.1.2.1.2. *Mirage Studios v Counter-Feat Clothing Company Limited*<sup>64</sup>

In *Mirage Studios and Others v Counter-Feat Clothing Company Limited and Another* ('Turtles' case), the court had to decide whether the 'Ninja Turtles' created by the defendant infringed the 'Teenage Mutant Ninja Turtles' of the plaintiffs. Sir Nicolas Browne-Wilkinson V-C maintained that names of characters were not protected by copyright,<sup>35</sup> but that copyright infringement of the drawing of the fictional characters was arguable.<sup>36</sup> However, he left it at that and focused instead on passing off. The reason for this was that fundamentally copyright does not protect ideas, only their expression. Sir Nicolas Browne-Wilkinson V-C conceded that it was 'difficult' to ascertain what this meant for the present case - whether the concept of humanoid turtles etc. was only an accumulation and combination of ideas or whether it went beyond a mere idea.<sup>37</sup>

<sup>34</sup> *Mirage Studios and Others v Counter-Feat Clothing Company Limited and Another* [1991] FSR 145.

<sup>35</sup> *Ibid* 154; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 572. This was confirmed in *Exxon Corp v Exxon Insurance Consultants International Ltd* [1982] Ch 119, 120; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 666. This was also confirmed by *Hitachi Ltd v Zafar Auto & Filter House* [1997] FSR 50, 51. There is no copyright in a single word, in this case 'Hitachi'. David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 53.

Wynn-Parry J stated in *Conan Doyle v London Mystery Magazine, Ld* (1945) 66 Reports of Patent, Design, and Trade Mark Cases 312, 313 that the name of the central fictional character in the detective stories of the late Sir Arthur Conan Doyle, 'Sherlock Holmes', (and the famous address of his abode, 221b, Baker Street) was not protected by copyright.

<sup>36</sup> *Mirage Studios and Others v Counter-Feat Clothing Company Limited and Another* [1991] FSR 145, 154; *Elvis Presley Trade Marks* [1999] RPC 567, 582; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 571.

<sup>37</sup> *Mirage Studios and Others v Counter-Feat Clothing Company Limited and Another* [1991] FSR 145, 154; Tamara Bukatz, 'Amazon's fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part I' (2013) 18 (4) Communications Law 122, 124; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 572.

### 1.1.2.1.3. *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others*<sup>38</sup>

Birss J had even rejected copyrightability of AFCs per se in the more recent case *Hearst Holding Inc v A.V.E.L.A. Inc*. He had to decide on the defendants' allegations that the claimants had registered the trade mark 'Betty Boop' in bad faith, because the claimants had no rights, such as copyright, in the well-known character 'Betty Boop'. The defendants' claim failed, because the claimants had a right stemming from passing off (unregistered trade mark rights).

However, Birss J commented regarding AFC copyright that:

An important point is that the [defendants'] allegations are focused on copyright in the character. The point is not focused on whether any given drawing which includes a picture of Betty Boop may or may not be an artistic work in which copyright subsists belonging to the claimants. The allegations are about copyright in a character itself. For this purpose, I can take it that while under US law it may be possible to have copyright in a character, such a thing is not possible under the UK law of copyright.<sup>39</sup>

This would mean that AFCs per se cannot attract copyright in the way it had been granted in the 'Popeye' case, i.e. independent of the individual pose of the AFC and beyond the individual drawing. AFCs could only attract copyright in the specific drawings. If one followed the above statement, then a person who copied the face and other physical attributes of an AFC, but changed the AFC's attire and pose from existing drawings might not be liable for copyright infringement. It is submitted that this violates basic copyright principles. A drawing is an artistic work. It does not have to be a comic book or comic strip consisting of many drawings to be an artistic work. Copyright is not only infringed, where the whole work has been copied, but also when a substantial part of the drawing has been copied without the authorization of the copyright holder.<sup>40</sup>

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<sup>38</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 1553 (Ch).

<sup>39</sup> *Ibid* [47].

<sup>40</sup> CDPA 1988 s 16(3)(a).

#### 1.1.2.1.4. Other cases concerning diverse AFCs

In contrast, the AFC ‘World Cup Willie’ (the FA’s mascot) was copyright protected as a whole work against the defendant’s trade mark application in *Jules Rimet Cup Ltd v Football Association Ltd*.<sup>41</sup>

Then again, the artwork of the ‘Teletubbies’ in *BBC Worldwide and Another v Pally Screen Printing et al*<sup>42</sup> was not protected by copyright. However, the reason was that the ‘Teletubbies’ had been created for making three-dimensional puppets for a TV programme, not a comic. Therefore, the drawings were design documents within the meaning of CDPA 1988 s 51(3).<sup>43</sup> This implies that AFCs can be copyright protected, if the drawings are made for the purpose of a comic or suchlike.

#### 1.1.2.1.5. Conclusion

The above cases make it clear that although many accept AFC copyrightability, there is still no consensus whether or not AFCs per se are copyrightable, independent or dependent of the underlying work, in the exact poses drawn or any pose conceivable, as a whole work or a substantial part.

#### 1.1.2.2. Cases concerning LFCs

LFCs are in an even worse position than AFCs, because LFCs are definitely not protected by copyright against unauthorized plot-independent use. LFCs are either

- a) regarded as ideas<sup>44</sup> and thus free to be copied by anyone, or
- b) LFCs are ignored in favour of an artistic representation of the underlying LFC, even when the AFC based on the LFC was created by another than the author of the original LFC,<sup>45</sup> or

<sup>41</sup> *Jules Rimet Cup Ltd v Football Association Ltd* [2008] ECDR 4 [H4] and [9].

<sup>42</sup> *BBC Worldwide and Another v Pally Screen Printing et al* [1998] FSR 665.

<sup>43</sup> *Ibid* 671 et seq.

<sup>44</sup> See para 1.1.2.2.1.

<sup>45</sup> See para 1.1.2.2.3.

- c) LFCs are only considered substantial parts, which benefit from the copyright in the underlying whole work, in combination with other story elements, such as incidents or the overall plot structure<sup>46</sup> as the following case-law demonstrates:

#### 1.1.2.2.1. *Kelly v Cinema Houses, Ltd*<sup>47</sup>

*Kelly v Cinema Houses, Ltd* concerned the film *The Outsider* (1926). *The Outsider* was originally a play written by the playwright Miss Dorothy Brandon. The plaintiff, Mrs Joan Kelly, wrote a novel based on this play, with Miss Brandon's consent. The plaintiff introduced two new characters into the novel (most importantly: 'Carol Stanton', the rival in love) and as a result a couple of new scenes that were not part of the play. The defendants are film producers. They obtained a licence from Miss Brandon to turn the play into a dramatic work. However, they did not approach Mrs Kelly. Nevertheless, the defendants made use of the character 'Carol Stanton' as well as the scenes written by the plaintiff in her novel. The 'new' characters created by Mrs Kelly appear in a couple of scenes, both in the novel and the film. These scenes are very much the same.<sup>48</sup> The court, however, held that no substantial part was copied as the scenes were presented in the film version in a different setting with different dialogue. Hence the defendants did not infringe copyright in Mrs Kelly's work.<sup>49</sup>

Maugham J states that he would 'hesitate a long time' before he would hold for copyright infringement even when a very well developed character with a high recognition factor was obviously copied by another writer.<sup>50</sup> The reason is that he regards fictive characters as ideas.<sup>51</sup> Maugham J continued that it is the use that is

<sup>46</sup> See paras 1.1.2.2.1., 1.1.2.2.4. – 1.1.2.2.7.

<sup>47</sup> *Kelly v Cinema Houses, Ltd* [1928-35] MacG CC 362.

<sup>48</sup> For example: In a scene from the book 'Lalage' witnesses 'Basil', the man she loves, and her cousin 'Carol' together in the park. She also sees 'Ragatzy' looking at her in the theatre. This determines her decision to undergo experimental treatment for her disability. The scene that leads to 'Lalage's decision in the film has a different setting, but is basically the same. 'Lalage' sees 'Basil' and her cousin 'Carol' together ice-skating. She also sees 'Ragatzy' looking at her from across the ice rink. *Kelly v Cinema Houses, Ltd* [1928-35] MacG CC 362, 365 et seq.

<sup>49</sup> *Ibid* 370.

<sup>50</sup> *Ibid* 368; Ute Klement, 'Copyright protection of unauthorised sequels under the Copyright, Designs and Patents Act 1988' (2007) 18 Ent LR 13, 14.

<sup>51</sup> *Kelly v Cinema Houses, Ltd* [1928-35] MacG CC 362, 368.

made of the characters, which is important, meaning the scenes in which characters appear, not the characters themselves.<sup>52</sup>

To conclude, the two authors (Miss Brandon and Mrs Kelly) were basically in the same situation.<sup>53</sup> Nevertheless they were treated differently by the law. The defendants had to obtain a licence from the author of the play, but not from the author of the novel, although the novel contained scenes and characters of which existed no counterpart in the play. The defendant was free to use these scenes of the plaintiff commercially in a slightly transformed way, as well as the characters created by her, because the court had neither recognized copyright in the LFCs independent of the author's work nor as a substantial part of the work in which the LFCs first appeared. This unsatisfactory outcome might have been avoided if LFCs were protected by copyright. This case demonstrates how easy it is to circumvent copyright infringement in the present state of UK copyright law. A copycat might simply have to change the setting of a scene, in order to escape copyright infringement.<sup>54</sup>

#### **1.1.2.2.2. *Bolton v International Pictures Ltd*<sup>55</sup>**

The results of *Bolton v International Pictures Ltd* are, in principle, the same as in the above case. The plaintiff was a renowned playwright. He had adapted the German film 'Fräulein, falsch verbunden' under licence into the play 'Give me a ring'. In an effort to extend the duration and add a comic element, the plaintiff had added two telephone repairmen to the telephone exchange scenario of the film. These two LFCs/DFCs did not appear in the German film on which the licensed play was based. The defendants were a film production company (first defendant) and distributor (second defendant). These defendants had not been able to obtain a licence from the plaintiff to produce a film based on the comic musical play. Thereupon, the defendants took out a licence from the rightholder of the German film instead. However, the two telephone mechanics as well as other scene elements from the English play were found in the

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<sup>52</sup> Ibid.

<sup>53</sup> Both had written a piece of work that served as the basis for the film of the plaintiff.

<sup>54</sup> Tamara Bukatz, 'Amazon's fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part I' (2013) 18 (4) Communications Law 122, 124.

<sup>55</sup> *Bolton v International Pictures Ltd* [1936] MacG CC 20.

English film produced by the first defendant and are the subject matter of the dispute. After quickly contemplating the (non-)originality of the introduction of telephone repairmen to the setting of a telephone exchange for comic relief, the judge found that ‘*in any case there cannot be any real question of copyright in the mere idea of introducing comic characters*’.<sup>56</sup> The entire wording of this statement, especially the three words ‘in any case’, means that, regardless of the circumstances, fictional characters are ideas and can therefore not be covered by copyright.

This meant for this case, just like in *Kelly v Cinema Houses* above that the defendants required a licence from the creator of the German film on which the English film (including the main characters and plot) is based, but were free to copy the characters added to the play<sup>57</sup> written by the plaintiff.

#### **1.1.2.2.3. *Universal City Studios Inc and Others v Mukhtar & Sons Ltd*<sup>58</sup>**

The following case also indicates that LFCs are not copyright protected in the UK. The plaintiffs owned the copyright in a drawing of a shark’s mouth and printed this image, accompanied by the slogan ‘Jaws’, on T-shirts. The defendant wholesalers sold unauthorized ‘Jaws’ T-shirts. The plaintiffs sought and were granted *ex parte* relief against the defendant, whose stock was placed in safe custody.

Interestingly, although the shark character was based on a novel by Peter Benchley, the plaintiffs had not obtained rights in the LFC ‘Jaws’, but according to the judgment had ‘acquired ... copyright in a drawing of a shark's mouth’.<sup>59</sup>

Later cases did at least recognize that LFCs can partake in the copyright of the overall work as a substantial part, but only in combination with the plot.

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<sup>56</sup> Ibid 30 (emphasis added). Here, ‘comic characters’ refers to funny characters, not AFCs from a comic strip.

<sup>57</sup> Ibid 20.

<sup>58</sup> *Universal City Studios Inc and Others v Mukhtar & Sons Ltd* [1976] 1 WLR 568.

<sup>59</sup> Ibid.

#### 1.1.2.2.4. *Allen v Bloomsbury Publishing Plc*<sup>60</sup>

The characters ‘Willy’ and ‘Harry’ were considered as part of the plot in *Allen v Bloomsbury Publishing Plc*.<sup>61</sup> However, both main characters are mentioned only superficially in mere two sentences: ‘Willy and Harry are both wizards ... both the wizards ... are very different. Harry is a schoolboy wizard whereas Willy is a grown man and fully qualified and as described as having “5 stars”.’<sup>62</sup> The court stated though that even material that per se is not copyrighted (like LFCs) can share in the copyright of the whole work, if this material forms a substantial part with other literary material, whose original collection, selection, arrangement, and structure has been copied.<sup>63</sup> Kitchin J’s summary judgment was that the claimant’s claim of copyright infringement might be successful, but that it was unlikely.<sup>64</sup>

#### 1.1.2.2.5. *Hodgson v Isaac*<sup>65</sup>

The characters in *Hodgson v Isaac* did not even receive that much attention. The court contented itself with stating that the defendant’s script was very close to the claimant’s book ‘in terms of its plot, characters and the striking incidents and events which take place’.<sup>66</sup> Indeed, the comparison between the two works rather looked at the events instead of the LFCs’ character traits.<sup>67</sup> When analysing whether the copied parts fell on the idea side or the expression side, the court highlighted indirectly how little importance it attached to characters. The court stated that, if all that had been taken from the claimant’s book *Flipper’s Side* was the idea of giving an account of a disabled person’s life story, and that person was such a football fan that he followed the team, then this would undoubtedly not be a substantial part of the book. The court continued that

In addition to the use of the main characters and many of the settings and contexts, the DADM [*Down Among the Dead Men*] script uses specific and

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<sup>60</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560.

<sup>61</sup> *Ibid* [22] et seqq and [27].

<sup>62</sup> *Ibid* [28].

<sup>63</sup> *Ibid* [83].

<sup>64</sup> *Ibid* [90].

<sup>65</sup> *Hodgson v Isaac* [2012] ECC 4.

<sup>66</sup> *Ibid* [69].

<sup>67</sup> *Ibid* [30] - [52].



striking incidents from *Flipper's Side* and uses striking details of those incidents presented in the book. It also employs the same interpretation of those events as appears in *Flipper's Side*.<sup>68</sup>

It was these 'specific and striking incidents' that led the court to find that the defendant had copied a substantial part of the claimant's novel, not the LFCs.

#### **1.1.2.2.6. *Ravenscroft v Herbert***<sup>69</sup>

The LFCs in *Ravenscroft v Herbert* were also treated as negligible. Although the court stated that both the claimant's work and the work of the first defendant featured the same characters and incidents, this came only as a minor addition. The court had already clearly stated – even before mentioning the LFCs - that the first defendant had copied a substantial part of the plaintiff's work by writing the prologues for each chapter. These prologues were sections taken from the plaintiff's work.<sup>70</sup>

#### **1.1.2.2.7. *Harman Pictures v Osborne***<sup>71</sup>

The court ruled in *Harman Pictures v Osborne*<sup>72</sup> that the defendant's screenplay for the production of the film 'The Charge of the Light Brigade', which deals with this historical incident and the events connected with it, infringed the plaintiff's copyright in the novel *The Reason Why* on the same topic. There were significant similarities of the incidents, situations, characterisation, quotations, and combination of ideas.<sup>73</sup> Moreover, instead of analysing the LFC, the court had merely pointed out that 'a considerable number of matters attributed to Captain Nolan in the film are in fact in the book'.<sup>74</sup> Therefore, LFCs were also only copyright protected in this case in so far as they were caught up in the incidents and situations.

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<sup>68</sup> Ibid [80] (emphasis added).

<sup>69</sup> *Ravenscroft v Herbert* [1980] RPC 193.

<sup>70</sup> Ibid 194.

<sup>71</sup> *Harman Pictures v Osborne* [1967] 1 WLR 723.

<sup>72</sup> Ibid.

<sup>73</sup> Ibid 737; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 214.

<sup>74</sup> *Harman Pictures v Osborne* [1967] 1 WLR 723, 734.

Hence, courts offer some copyright protection in LFCs. However, copyright only protects LFCs in conjunction with other story elements, instead of LFCs per se. This leads to a gap in copyright protection. Authors cannot protect their intellectual creations (their LFCs) against unauthorized literary and dramatic works and films, which copy only the LFC, or unauthorized character merchandise by means of copyright. In particular, character merchandise is most of the time plot-independent. An excellent example of a film<sup>75</sup> which copied characters from other works and makes reference to the plot of these literary works extremely marginally<sup>76</sup> is *The League of Extraordinary Gentlemen*.<sup>77</sup> The TV series *Penny Dreadful* operates on a similar concept.

#### 1.1.2.2.8. Conclusion

The above cases relating to LFCs demonstrate that LFCs partake, under the correct circumstances, in the copyright of the whole literary work as a substantial plot-dependent part of the whole work. However, not even that is universally accepted. What is more, LFCs per se are still not copyright protected independent from the plot and other elements of the literary work, in which the LFC first emerged.

## 1.2. Research objective

Therefore, the first objective of this thesis is to justify the need for copyright protection of LFCs independent of the plot of a novel or screenplay. This shall be accomplished by introducing areas in which an author could benefit from independent LFC copyrightability (e.g. fanfiction, sequels and character merchandising) as well as explaining the financial, moral and other incentives for LFC copyrightability.<sup>78</sup> Moreover, it shall be established by analysing the advantages and disadvantages of

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<sup>75</sup> The film is based on the eponymous comic series.

<sup>76</sup> That means, one could argue that the film is independent of the plot of the underlying works from which the LFCs were derived.

<sup>77</sup> However, the LFCs chosen for this work are out of copyright anyway. These include ‘Dorian Gray’, ‘Captain Nemo’, ‘Allan Quartermain’, ‘Wilhelmina Murray’ (‘Mina Harker’), ‘Dr Jekyll’/‘Mr Hyde’, the ‘Invisible Man’ and ‘Professor Moriarty’.

<sup>78</sup> See para 2.2.

trademark law<sup>79</sup> and actions for passing off<sup>80</sup> that the protection by either is insufficient and inappropriate regarding LFCs. This leaves a gap that can be filled by copyright.

Hence, the main research objective of this thesis is to critically evaluate current UK copyright law and analyse how LFCs could be copyright protected in the same way that the AFC 'Popeye' was offered copyright protection in *King Features Syndicate Inc v O and M Kleeman Ltd*. That means, independent from the plot and other elements of the underlying work (i.e. by themselves) and even in case of transfer into another copyright medium or character merchandise. Identifying those sections of the CDPA 1988, that would have to be judicially re-interpreted or changed, and establishing how so, is an integral part of this objective.

### 1.3. Research question(s)

Hence, the principal research question posed is:

To what extent are trade mark law and actions for passing off appropriate and sufficient for the protection of LFCs, and does current UK copyright law have the potential to grant copyright protection for LFCs per se, independent of the work they feature in originally?

The principal research question can be divided into the following research questions which this thesis addresses:

RQ 1: Do trade mark law and actions for passing off protect authors against unauthorized use of their LFCs sufficiently?

RQ 1.a: Does trade mark law protect authors against unauthorized use of their LFCs sufficiently?

RQ 1.b: Do actions for passing off protect authors against unauthorized use of their LFCs sufficiently?

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<sup>79</sup> See chapter 3.

<sup>80</sup> See chapters 4 and 5.

RQ 2: May a LFC per se be copyright protected as a work *sui generis*, a literary work or a substantial part of a copyright protected literary work?

RQ 2.a: May a LFC per se be copyright protected as a work *sui generis*?

RQ 2.b: May a LFC per se be copyright protected as a literary work?

RQ 2.c: May a LFC per se be a substantial part of a copyright protected literary work?

RQ 3: How can a court distinguish between copyrightable and non-copyrightable LFCs?

RQ 4: Is current copyright law capable of covering LFCs per se by judicial re-interpretation, or are legislative changes necessary to the CDPA 1988?

## 1.4. Research strategy and structure

That means, the main research question is twofold. It determines the following strategic approach of this thesis.

### 1.4.1. The first component of the thesis

The first component of the principal research question is whether it is reasonable to extend current UK copyright law to copyright protection of LFCs per se. At present, fictional characters are protected by trade mark law and actions for passing off to a certain extent. Chapters 3 - 5 of this doctoral thesis critically evaluate the advantages and disadvantages of trade mark and passing off against copyright, in particular in view of moral rights (chapter 5), in order to determine which form of protection is the most suitable for the protection of purely textual fictional characters, and whether copyright protection for LFCs per se might be advisable.

### 1.4.2. The second component of the thesis and geographical scope

This is followed by the second component, which addresses the issue of whether it is feasible to extend current UK copyright law so that it offers plot-independent copyright

protection to LFCs per se. This is covered by chapters 6 - 8. Chapter 8 basically critically evaluates how LFCs per se could be copyright protected. Copyright-related sections of the CDPA 1988 shall be analysed in order to establish e.g. whether LFCs are a self-sufficient literary work within the meaning of CDPA 1988 s 1(1)(a), a substantial part of an original work, or a work *sui generis*. Moreover, the general copyright principle, that ideas are not protected by copyright, but their expressions are, shall be examined carefully. The new originality standard shall also be critically evaluated. Inspiration is sought from foreign jurisdictions, which already offer copyright protection to LFCs, in chapters 6 and 7. Two common law and two civil law jurisdictions were selected. These are Canada, the USA, Germany and France. These jurisdictions have been chosen i.a. for the following reasons: US courts have developed tests explicitly for considering character copyrightability. Canadian courts have adopted the distinctly delineated test as well. Germany is the cradle of moral rights, while moral rights are the strongest under French law.<sup>81</sup> Indeed, LFCs benefit in the majority of cases discussed on French law from moral rights protection.

Finally, Chapter 9 brings all insights and conclusions together and offers recommendations in respect of changes of the judicial interpretation of the CDPA 1988 as well as additions to the existing provisions of the CDPA 1988.

## 1.5. Research methodology

### 1.5.1. Library-based research

A thesis necessitates thorough investigation and interpretation: investigation of the current situation, interpretation of the current law, and, with regard to this thesis, consideration how current copyright law might be judicially re-interpreted and/or changed in order to facilitate copyright protection of LFCs per se. The method most

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<sup>81</sup> Mira T Sundara Rajan, 'Moral rights or economic rights?' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 210. For example, the paternity right does not require assertion by the author of the work. Further, the scope of the integrity right is wider in France than in the UK as well. The integrity right in France is applicable to all works, not just certain works. The honour or reputation does not need to be affected, and an author may claim a violation of the integrity right even when a work has been denigrated without altering it, but was instead put in a defamatory context. André Lucas, 'Moral right in France: towards a pragmatic approach?' 1 and 1.2 <<http://www.blaca.org/Moral%20right%20in%20France%20by%20Professor%20Andre%20Lucas.pdf>> accessed 7 June 2013.

suitable for achieving this goal is library-based research. That includes hard copy as well as digital sources. The majority of the research material gathered for this thesis is available at Bangor University Law Library or via the Bangor University databases, such as HeinOnline, LexisNexis, Westlaw, as well as publicly accessible databases, such as Bailii and CanLii. The IALS in London as well as the British Library also proved to be indispensable. The material on the section on LFC copyrightability in Germany was researched at Trier University and German courts. The university library of Trier University is a treasure trove. Not only does it provide a vast number of hard copy sources on German IP law, but also textbooks, commentaries and journals on French law and Anglo-American law. The law library of the Higher Regional Court of Koblenz also hosts hard copies of commentaries and journal articles on IP law, and provides access to the law database JURIS. The Regional Court Trier kindly granted access to digital sources as well.

### 1.5.2. Comparative approach

This thesis also employs a comparative approach, which again makes use of different methods: the functional method and the analytical method. These methods complement one another. The functional method concentrates on the actual basic problem<sup>82</sup> and its effects. Instead of considering the legal provisions, the functional approach considers the judicial responses to similar situations,<sup>83</sup> what common ground exists and what differences, what the results are and whether the results are similar or different. Thereby, the functional method ties in with the analytical method, which describes the process of analysing the legal provisions and doctrines (e.g. the idea/expression dichotomy) of different jurisdictions as well as the doctrinal structures and arguments. This involves detecting the common core as well as the differences of the law.<sup>84</sup> Hence, the above methods entail research on the interpretation of the respective relevant Federal copyright law of the foreign jurisdictions judged by its

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<sup>82</sup> That is the lack of plot-independent copyright protection of authors against unauthorized use of LFCs in the UK, and their copyrightability in some foreign legal systems.

<sup>83</sup> Ralf Michaels, 'The Functional Method of Comparative Law' in Mathias Reimann and Reinhard Zimmermann (eds), *The Oxford Handbook of Comparative Law* (OUP 2006) 342.

<sup>84</sup> Mark Van Hoecke, 'Methodology of Comparative Legal Research' (Dec 2015) *Law and Method* <<http://www.bjutijdschriften.nl/tijdschrift/lawandmethod/2015/12/RENM-D-14-00001>> accessed 25 Feb 2017.

wording, its *telos*, its systematical position within the Federal copyright law, as well as its historical background. *Inter alia* because tests to distinguish between copyrightable and non-copyrightable LFCs have been developed e.g. in the US by the courts, case-law is studied thoroughly too i.a. so as to find out the limitations of character copyrightability, and whether any other issues surfaced that require attention, and how these were or can be resolved, if necessary. The purpose of this *modus operandi* is to discover new ways of solving the legal issues regarding copyright protection of LFCs.

This method may result in legal transplants.<sup>85</sup> However, the aim of this thesis is to preserve the integrity, wording and structure of the CDPA 1988 by borrowing as little as necessary from other jurisdictions and instead retain and refine provisions that are already in place in the UK as much as possible. This is borne in mind when drawing inspiration from the following jurisdictions in order to judge how the UK might adopt copyright protection for LFCs.

For this thesis, two common law jurisdictions other than the UK (Canada and the USA) as well as the law of two civil law countries (France and Germany) are enquired into. Among those four jurisdictions, two major jurisdictions shall be consulted in more depth, namely the USA and Germany. Both, the USA and Germany rank among the top five in the Media and Entertainment industry worldwide.<sup>86</sup> Moreover, copyright protection for LFCs in the USA exists since 1930.<sup>87</sup> Due to this long history of copyrightability of LFCs in the USA, there is ample legal research material and experience with the concomitant problems and complexities of copyright as a means of protection for non-visual characters one can draw from.

Authors' rights in Germany are very strong. Of particular interest is that, contrary to the UK and USA, moral rights are inalienable according to the German *Urheberrecht*.<sup>88</sup>

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<sup>85</sup> 'Legal transplants are rather an aim or result, not a comparative method in its own right.' Ibid.

<sup>86</sup> Ranking: USA, Japan, China, Germany, UK. Until 2011 Germany held third place. PricewaterhouseCoopers, 'Global entertainment and media outlook: 2012-2016, China overtakes Germany in 2011 to become third largest entertainment and media market' (2012) <<http://www.pwc.com/gx/en/global-entertainment-media-outlook/data-insights.jhtml>> accessed 25 January 2013.

<sup>87</sup> *Nichols v Universal Pictures Corporation*, 45 F 2d 119 (2d Cir 1930).

<sup>88</sup> § 29 I Urheberrechtsgesetz (UrhG); BGH, GRUR 1963, 40, 42. In the UK, moral rights are neither assignable (CDPA 1988 s 94), nor can they be passed on to the heirs after the author's death (CDPA 1988 s 95), but they may be waived (CDPA 1988 s 87). In the USA, moral rights cannot only be waived, but according to 17 USC § 106A (Visual Artists Rights Act) moral rights are not even applicable to all types of works, just to works of visual art such as drawings and sculptures.

That means, an author, who transfers her rights of exploitation of the work to another person, retains the right of integrity in and paternity to the work created by her. The moral rights are headed by the term *Urheberpersönlichkeitsrecht*. This translates literally to authors' personality right. Its foundations are Article 1 subsection 1 and Article 2 subsection 1 of the German Basic Law. The work of an author is respected as an extension of the creator's individual personality.<sup>89</sup> The moral rights of an author are also very strong under French copyright law, and the French courts are very sensitive to any abuse of an author's moral rights. The moral rights of authors are basically regarded as 'human rights for creators'.<sup>90</sup>

Therefore, the federal copyright laws of the above jurisdictions offer deep and differing insights into LFC copyrightability.

## 1.6. Conclusion

As long as creative works are produced and consumed, there will always be a danger of illicit copying of the entire works or substantial parts thereof, as others seek to cash in on the success of popular and established authors. Down to the present day, LFCs are not protected by copyright independently.<sup>91</sup> Therefore, LFCs are exposed to 'abduction'.

There is already some support that LFCs should be copyrightable. Moreover, characters may not only be copied to write new books or produce new films, but also for unauthorized character merchandising.<sup>92</sup> Character merchandising was developed

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<sup>89</sup> § 11 UrhG; Paul Goldstein and P Bernt Hugenholtz, *International Copyright Principles, Law and Practice* (3<sup>rd</sup> edn, OUP 2013) 6; Adolf Dietz, 'Germany' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 7[1] (Pub 399, Rel 28-12/2016); Adolf Dietz and Alexander Peukert, 'Germany' in Gillian Davies and Kevin Garnett (eds), *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 455 et seq; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 220.

<sup>90</sup> Lauriane Nocella, 'Copyright and moral rights versus author's right and droit moral: convergence or divergence?' (2008) 19 Ent LR 151, 153. The moral rights are not human rights under French law, but they are valued as such. A humanist spirit underlies French Intellectual Property Law. Simon Newman, 'The development of the German, French and English legal systems—the development of copyright and authors' rights' (2011) 33 EIPR 677, 684.

<sup>91</sup> See para 1.1.2.2.

<sup>92</sup> Character merchandising in the broad sense embraces character merchandising in the strict sense, personality merchandising and image merchandising. Personality merchandising describes the activity



in the 1930s by Kay Kamen working at the Walt Disney Studios<sup>93</sup> and has grown into a multibillion dollar business which is still expanding.<sup>94</sup> Disney ranked first in 2015 with revenue of \$45.2 billion in global retail sales of licensed merchandising products in 2014. This is \$4.3 billion more than the year before.<sup>95</sup>

The time may be ripe to reconsider the Whitford Committee's concerns, i.e. whether plot-independent copyright protection for LFCs should be introduced in the UK, and how to distinguish between copyrightable and non-copyrightable LFCs.

In November 2010, former Prime Minister David Cameron commissioned Professor Ian Hargreaves to issue an independent review on how the Intellectual Property framework could cater for the needs arising from the Digital Revolution in order to become more competitive. This resulted in 10 recommendations, i.a. on copyright, in May 2011.<sup>96</sup> The Hargreaves Review concerned itself with improvements regarding the increasing use of digital works, and how IP law could keep up with this development. This thesis will argue that there is room for further improvement of IP law, not just because of the advent and advance of digital content, but also regarding copyrightability of LFCs abstracted from their literary works. This thesis expounds how exactly that might be realised.

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of promoting the sale of goods associated with celebrities mainly from entertainment and sports. Image merchandising denotes the same activities as personality merchandising with the difference that the celebrities appear in their role and disguise. The celebrities are not promoted as who they really are, but as who they represent. That means image merchandising would e.g. depict 'Gandalf' played by Sir Ian McKellen in the film *The Hobbit: An unexpected journey* (2012) and not simply Sir McKellen as he himself. Character merchandising in the strict sense circumscribes the franchising of fictive characters such as 'Thomas the Tank Engine', 'Bob the Builder', and 'Peter Rabbit'. Howard Johnson, 'Legal Aspects of Character Merchandising' (1992) 34 *Managerial Law* 3; WIPO, 'Character Merchandising' (WO/INF/108, December 1994) 4.

<sup>93</sup> WIPO, 'Character Merchandising' (WO/INF/108, December 1994) 6.

<sup>94</sup> Marshall Leaffer, 'Character merchandising in the U.K., a nostalgic look' (1993-1994) 11 *U Miami Ent & Sports L Rev* 453.

<sup>95</sup> Tony Lisanti, 'Top 150 Global Licensors' (2015) 18 (2) *Global Li©ence!* T3 <<http://images2.advanstar.com/PixelMags/license-global/digitaledition/05-2015-top150.html#2>> accessed 11 December 2016.

<sup>96</sup> Ian Hargreaves, 'Digital Opportunity – A Review of Intellectual Property and Growth' (May 2011) 8 et seq <<http://www.ipo.gov.uk/ipreview-finalreport.pdf>> accessed 3 October 2011.

## Chapter 2 – Literature Review and Context

### 2.1. No copyright for LFCs per se: The general lack thereof and the specific gaps

As particularised in the preceding chapter, this thesis deals with the copyrightability of fictitious characters – to be more exact, LFCs as such independent of the work or series of works in which the characters featured originally. The issue of independent protection of a LFC separate from the original work arises when a LFC is used in a new work,<sup>97</sup> for example a film bringing characters from different books together, fanfiction or character merchandise.

First, the objective of this thesis is to establish that copyright is the more fitting form of protection for LFCs per se as compared with trademark law and actions for passing off. Second, the main research objective is to critically evaluate how LFCs could be protected by copyright independent of the plot and other elements of the original literary work for which the LFC was created initially. The findings shall lead to recommendations stating exactly which provisions of the CDPA 1988 would have to be changed and how, and which terms and concepts already used in copyright law would have to be judicially re-interpreted and how.

In 1976, the Whitford Committee considered whether it should introduce a character right in the UK. The Committee decided against it, stating that copyright should only protect ‘against the reproduction of the literary or artistic form’, meaning a literary or artistic work.<sup>98</sup> Hence, it did not regard fictional characters separate from their original work as independent works. The Committee’s main concern and reason for its decision against copyright protection for fictive characters was the complexity of determining

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<sup>97</sup> Jasmina Zecevic, ‘Distinctly Delineated Fictional Characters That Constitute The Story Being Told: Who Are They And Do They Deserve Independent Copyright Protection?’ (2006) 8 *Vanderbilt J of Entertainment and Tech Law* 365, 366.

<sup>98</sup> Whitford Committee, *Copyright and Designs Law – Report of the Committee to consider the Law on Copyright and Designs* (Cmnd 6732, 1976-77) para 909.

which character should be copyrightable and which non-copyrightable, and which features are essential to distinguish one character from the other.<sup>99</sup> It is submitted that the Committee's concerns are not completely unfounded, but that, with a little bit more daring, the Committee could have achieved what is the norm in some other countries. Though complex, Canada, the USA, Germany and France offer LFC copyrightability. For example in the USA, this has been the case since 1930.<sup>100</sup>

At the present time, authors can and should protect their LFCs contractually when forming agreements with e.g. publishers and producers. Authors can limit the grant of rights in a contract. For example, an author may limit the producer's right to making only one film based on the author's literary work. Even better, the author can prohibit that the producer can use any further films with the same LFCs unless the author writes subsequent novels with these LFCs and the producer takes out another licence from the author to produce another film based on the subsequent novel. That way, the author can guard herself against the production of spin-offs which make use of the author's LFCs, but not the author's novels.<sup>101</sup>

However, this protection is only possible with parties with whom the author contracts. Authors' options to protect themselves against unauthorized use of their LFCs by third parties e.g. for fanfiction and character merchandise is much more limited. Trade mark law and actions for passing off do provide some protection, but are inadequate or at least inexpedient, as this thesis will prove in subsequent chapters. At present, there is no copyright in LFCs as such under UK copyright law.

Turner and Lewis assert that this is the 'common view' and that 'general consensus' exists on this matter, because it does not seem to be the intention of the CDPA 1988 to grant LFCs a separate copyright.<sup>102</sup> They expound that CDPA 1988 s 1 contains an exhaustive list of works that can attract copyright and that LFCs are not literary works

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<sup>99</sup> Ibid.

<sup>100</sup> See paras 6.1. and 6.3.2.1.1.

<sup>101</sup> Caroline Turner and Alys Lewis, 'Sequel rights: are fictional characters, plots and themes protectable?' (*Harbottle & Lewis LLP*, Sept 2008) 10 <<http://www.legal500.com/developments/5437>> accessed 07 November 2016.

<sup>102</sup> Ibid 8 et seq.

according to common opinion.<sup>103</sup> This thesis disagrees on one account, and refers to new developments on another account. For one thing, this thesis argues that LFCs can be literary works depending on the circumstances.<sup>104</sup> Moreover, the CJEU's decision on *Infopaq* and subsequent decisions on the new originality standard opened up the discussion whether subject matter has to fall under any category or whether any work can be protected by copyright as long as it is the author's own intellectual creation.<sup>105</sup>

Dickson agrees with Turner and Lewis that in relation to fictional characters there is no separate copyright in LFCs under English law. In his opinion, LFCs cannot exist independent of the book.<sup>106</sup> Only the whole work in which the fictional character features enjoys copyright.<sup>107</sup> He also points out, as do Turner and Lewis,<sup>108</sup> Sterling<sup>109</sup> and McGee and Scanlan<sup>110</sup> that there is no precedent in English law which established

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<sup>103</sup> Ibid.

<sup>104</sup> See para 8.2.1.

<sup>105</sup> See paras 8.2.1. and 8.2.3.

<sup>106</sup> Craig J Dickson, "A Life of His Own" – the copyright protection of fictional characters' (*NZIPA*, 2007) 8 <[http://www.nzipa.org.nz/Site/loman\\_friedlander\\_award/loman-friedlander.aspx](http://www.nzipa.org.nz/Site/loman_friedlander_award/loman-friedlander.aspx)> accessed 30 January 2013).

<sup>107</sup> Ibid 27.

<sup>108</sup> Caroline Turner and Alys Lewis, 'Sequel rights: are fictional characters, plots and themes protectable?' (*Harbottle & Lewis LLP*, Sept 2008) 8 et seq <<http://www.legal500.com/developments/5437>> accessed 07 November 2016.

<sup>109</sup> JAL Sterling, Michael Hart and Emily Riddle, 'Subject Matter of Protection' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 273 et seq, fn 62.

The limited case-law concerning LFC copyrightability either

- a) did not recognize copyright in LFCs (*Kelly v Cinema Houses, Ltd* [1928-35] MacG CC 362, 368), or
- b) considered rather the plot, the stories around the LFCs, than the LFCs (*Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [22] et seqq and [27]). This is somewhat unlike its US counterpart, which at least considered 'Willy the Wizard's attributes, but found them lacking. The District Court of the SDNY found that the attributes described merely a 'general prototype'. See para 6.3.1.4.5. and *Allen v Scholastic*, 739 F Supp 2d 642, 660 (SDNY 2011). This difference in the UK and US case can be attributed to the fact that the US courts recognize LFC copyrightability, whereas the UK courts do not.
- c) did not consider the LFC itself in its entirety, but only the name and home address (*Conan Doyle v London Mystery Magazine, Ltd* (1945) 66 Reports of Patent, Design, and Trade Mark Cases 312, 313), or
- d) did not even reach a point, where the court had to decide on the claim of copyright infringement in the LFCs. The English court found that 'it would be an exercise in futility to allow the claims', because the tort in question was local to the USA and the court doubted whether its decision would be treated as binding on the USA (*Tyburn Productions Ltd v Conan Doyle* [1991] Ch 75, 89).

<sup>110</sup> Andrew McGee and Gary Scanlan, 'Copyright in character' (2003) JBL 470, 483.

the opposite. No English or Welsh court has held that copyright in a character alone was infringed, where the actual words used to describe the character were not copied.<sup>111</sup> This thesis demonstrates that though the opinion of the aforementioned authors is correct, LFCs could attract copyright protection against unauthorized two-dimensional copying without a change to the CDPA 1988. Courts would only need to be convinced that LFCs are literary works or a substantial part thereof, and that some LFCs are more than mere ideas.<sup>112</sup>

For example, Su states that drawings of a character can attract copyright, whereas ‘characters in themselves’, i.e. characters as such, cannot. She points towards one of the main issues why LFCs are not copyright protected independent of the original work. She maintains that LFCs ‘cannot ordinarily fall within the category of “form”, i.e. expression. According to Su and Howell, characters per se are merely ideas, part of the theme and plot of the underlying work.<sup>113</sup> Adams, Hickey and Tritton agree that LFCs per se are not copyright protected for that reason in the UK outside the literary context provided by incidents, narrative and plot.<sup>114</sup> This thesis takes a more differentiated view than the aforementioned authors. It establishes that some LFCs can be protectable expressions while others are only ideas.<sup>115</sup> Other countries, namely Canada, the USA, Germany and France, have already demonstrated that it is possible to overcome the idea/expression dichotomy as challenging as that may be.<sup>116</sup> Su also states that names of fictional characters are in general not protected by copyright. Though her view is correct as far as names of characters are considered by themselves, this thesis suggests that the names of LFCs should be able to attract copyright in combination with other character elements together.<sup>117</sup>

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<sup>111</sup> Craig J Dickson, “‘A Life of His Own’ – the copyright protection of fictional characters’ (*NZIPA*, 2007) 29 <[http://www.nzipa.org.nz/Site/loman\\_friedlander\\_award/loman-friedlander.aspx](http://www.nzipa.org.nz/Site/loman_friedlander_award/loman-friedlander.aspx)> accessed 30 January 2013); Steven L Nemetz, ‘Copyright Protection of Fictional Characters’ (1990-2000) 14 *IPJ* 59, 99.

<sup>112</sup> See paras 8.2. and 8.3.

<sup>113</sup> Zhiqiang Su, ‘Copyright Protection of Character Merchandising’ (*Article.chinalawinfo*, 2002) 3 <[www.article.chinalawinfo.com/Article\\_Detail.asp?ArticleID=23641](http://www.article.chinalawinfo.com/Article_Detail.asp?ArticleID=23641)> accessed 30 January 2013; Robert G Howell, ‘Character merchandising: the Marketing Potential Attaching to a Name, Image, Person or Copyright Work’ (1991) 6 *IPJ* 197, 219 et seq.

<sup>114</sup> John N Adams, Julian B Hickey, Guy Tritton, *Merchandising Intellectual Property* (3<sup>rd</sup> ed, Tottel 2007) 13 et seq; David Vaver, ‘The protection of character merchandising: a survey of some common law jurisdiction’ (1978) 9 *IIC* 541, 554.

<sup>115</sup> See paras 8.3.1. and 8.3.4.

<sup>116</sup> See paras 6.2.1. et seq, 6.3.1. et seq, 7.2.1 et seq and 7.3.1. et seq.

<sup>117</sup> See para 8.3.4.2.

JAL Sterling describes the copyrightability of characters as an ‘interesting challenge’ in *Sterling on World Copyright Law*.<sup>118</sup> He distinguishes in his non-country specific considerations on character copyrightability between the literal and non-literal elements in the portrayal of a character. The literal element is the presentation of the fictional character in a combination of words, describing the character. The bigger problem arises where the non-literal aspects representing a character are ‘extracted’ from the original work and moved into another creator’s work, in a different series of words, but even so in essence recognizable as the character of a different author.<sup>119</sup> Sterling wonders how many features of a character would have to be ‘extracted’ in order to be still the original character. He employs the following example: Would ‘Popeye’s striking physiognomy by itself, without the sailor’s cap and pipe, be protected?’<sup>120</sup> ‘Popeye’, is an AFC. This thesis, however, focuses on LFCs, not AFCs. The same considerations raised by Sterling apply to LFCs though, too, and shall be discussed in chapter 8. AFCs have an edge over LFCs. Ruijsenaars points out that if somebody ‘steals’ an AFC for her work, the components of the characters can be easily compared, because the characteristics and the overall impression are visual.<sup>121</sup> LFCs are less tangible than AFCs due to the non-visual nature of LFCs. That makes it even more challenging to determine when a character has been copied by another.

In addition to his non-country specific considerations, Sterling addresses the protection of AFCs and LFCs in France, Germany, Israel and the USA shortly by providing cases from those countries.<sup>122</sup> Interestingly, Sterling does not discuss character copyrightability in the UK, although Sterling’s textbook mentions UK copyright law many times, i.a. in relation to compilations<sup>123</sup> and originality.<sup>124</sup> Later in the textbook, he mentions characters again in the section on the originality requirement in

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<sup>118</sup> JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 271.

<sup>119</sup> ‘Extracted’ from the original work means independent of the work. This factor shall be explained in more detail below.

<sup>120</sup> JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 272.

<sup>121</sup> Heijo E Ruijsenaars, ‘The world of fictional characters: a journey of fantasy’ (1993) 4 Ent LR 182.

<sup>122</sup> JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 273 – 276.

<sup>123</sup> *Ibid* 290 et seq.

<sup>124</sup> *Ibid* 347 et seqq.

Germany,<sup>125</sup> but does not do so in the section on the UK originality requirement.<sup>126</sup> This is a further indication that LFCs are not copyright protected under UK copyright law. If LFCs per se were copyrightable in the UK, Sterling would have discussed this. His textbook is very methodical.

Griffiths, Bently and Cornish do not state explicitly that there is no LFC copyrightability under UK copyright law. They merely state in *International copyright law and practice* that it would be unlikely that a court would find substantial copying of a work, if a person had copied the ‘identifying features’ of a LFC without copying plot details or colloquy, as well.<sup>127</sup> By making this statement, the authors have said indirectly that LFCs are not copyright protected as plot-independent whole literary works or substantial parts thereof under UK copyright law. Whether or not LFCs are literary works and as such can avail of copyright protection is the subject of this thesis though.<sup>128</sup>

Whether fictional characters are protected by copyright in the UK or whether they are in the public domain was also examined in CREATE’s research and knowledge exchange project ‘Valuing the Public Domain’.<sup>129</sup> The purpose of this project is to sketch out the size of the public domain (PD), evaluate the role of PD works for the creation of new works, and advise UK companies in the M&E industry to determine business models which capitalize on the PD.<sup>130</sup> Erickson, Kretschmer, Mendis et al stated in this working paper with reference to Vitoria et al that ‘it can be purported that “it is not impossible for copyright to be infringed by the parasitic use of another author’s

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<sup>125</sup> Ibid 355 et seq.

<sup>126</sup> Ibid 363 et seq.

<sup>127</sup> Jonathan Griffiths, Lionel Bently and William R Cornish, ‘United Kingdom’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[4][b] (Pub 399, Rel 28-12/2016).

<sup>128</sup> See para 8.2.1. et seq.

<sup>129</sup> The research was financially supported by the Economic and Social Research Council (ESRC) as well as the UK IPO. A Workshop for UK Creative Firms and other interested parties titled ‘Valuing the Public Domain’ took place in the Connected Digital Economy Catapult Centre, London on 5th December 2014.

<sup>130</sup> Kristofer Erickson, Martin Kretschmer, Dinusha Mendis et al, ‘Copyright and the Value of the Public Domain’ (CREATE Working Paper 2015/01) 3 <<https://zenodo.org/record/14975/files/CREATE-Working-Paper-2015-01.pdf>> accessed 20 February 2015.

character“.<sup>131</sup> This seemed to indicate that LFCs are copyrightable in the UK. However, after considering an appreciable amount of UK case-law relating to fictional characters, Mendis et al came to the valued conclusion that ‘the copyright status of characters in the UK remains unclear’.<sup>132</sup> This observation is applicable even with regard to AFCs, the most clear-cut of characters.<sup>133</sup> In particular, though, ‘literary characters['] ... protection under copyright law has met with much uncertainty’.<sup>134</sup> This thesis aims to relieve that uncertainty regarding LFCs. In addition to the above contribution, Mendis et al mention that specific tests for determining character copyrightability were established in the US, and that several fictional characters received copyright protection as a result of the application of these tests. In that regard, the authors call attention to the provocative debate in the US whether copyright in a LFC could be extended beyond the copyright term of the novel, if the LFC had been developed further by giving it additional attributes over the course of a book series.<sup>135</sup> They state that Posner J had decided in a 2014 case concerning ‘Sherlock Holmes’<sup>136</sup> that any LFC’s copyright expired along with the copyright of the original literary work, in which the character was first created. This ruling will be criticised in this thesis in chapter 6.<sup>137</sup>

The CREATE working paper cites *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 as the source which offered that LFC copyrightability was ‘not impossible’.<sup>138</sup> Despite this pronouncement, Vitoria et al then state the limitation of their opinion. They confirm in their textbook that LFCs as such are not copyright protected.<sup>139</sup> Then, they suggest that ‘the collection of attributes, features, well-known

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<sup>131</sup> Ibid 22; Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1689.

<sup>132</sup> Kristofer Erickson, Martin Kretschmer, Dinusha Mendis et al, ‘Copyright and the Value of the Public Domain’ (CREATE Working Paper 2015/01) 23 <<https://zenodo.org/record/14975/files/CREATE-Working-Paper-2015-01.pdf>> accessed 20 February 2015.

<sup>133</sup> See para 1.1.2.

<sup>134</sup> Kristofer Erickson, Martin Kretschmer, Dinusha Mendis et al, ‘Copyright and the Value of the Public Domain’ (CREATE Working Paper 2015/01) 22 <<https://zenodo.org/record/14975/files/CREATE-Working-Paper-2015-01.pdf>> accessed 20 February 2015.

<sup>135</sup> Ibid 23.

<sup>136</sup> *Leslie Klinger v Conan Doyle Estate*, 755 F 3d 496, 500 (7<sup>th</sup> Cir 2014).

<sup>137</sup> See para 6.3.3.

<sup>138</sup> Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1689.

<sup>139</sup> Ibid.



quotations and so forth which ... make[s] up the imaginary world in which the character moves may amount to a substantial part of the author's original work.'<sup>140</sup> The first half of this sentence (up to the word 'forth') sounded as if Vitoria et al supported LFC copyrightability in the form of a collection of LFC characteristics. However, the second half of the sentence (starting with the word 'which') gives it a twist and thereby an entirely different meaning. The two relative pronouns 'which' and 'in which' are key to this sentence. The first 'which' relates to 'the collection of attributes'. The second 'in which' relates to the imaginary world. That means, Vitoria et al ponder on the collection of attributes that make up the imaginary world, instead of the collection of attributes which make up the LFC. Therefore, it seems that Vitoria et al do not consider LFCs as a potential substantial part, but the 'universe', also known as the 'world' in which the LFC 'lives'. The 'imaginary world in which the character moves' is not the same as a fictional character. It goes beyond what amounts to a character. The 'world' also encompasses the character's connection to other characters,<sup>141</sup> the period in which the LFC lives, inventions and housing of the time, climate and landscape, and much more. Vitoria et al's textbook is ambiguous in this regard.

Jaffey and Couchman also reflected on LFC copyrightability. They voice the opinion that copying a LFC from the literary work and then reproducing it in another literary work or film can 'possibly' amount to copyright infringement, if the LFC was 'drawn in sufficient detail and enough of his characteristics are copied'.<sup>142</sup> However, they do not elaborate on when a LFC is sufficiently detailed. This criterion shall be pondered in depth in this doctoral thesis.<sup>143</sup>

McGee and Scanlan also advocate in a series of articles on UK character copyrightability that LFCs should be copyrightable,<sup>144</sup> as does this thesis. Their series

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<sup>140</sup> Ibid.

<sup>141</sup> See Vitoria et al's example of an imaginary world: Ibid 1688 at para 40.25.

<sup>142</sup> Peter Jaffey and Nic Couchman, 'English Law' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 364.

<sup>143</sup> See chapters 6 - 8, in particular paras 7.2.2., 8.3.1. and 8.3.4.

<sup>144</sup> Andrew McGee and Gary Scanlan, 'Copyright in character, intellectual property rights and the internet: Part 2' (2006) 17 Ent LR 15, 16; Andrew McGee and Gary Scanlan, 'Copyright in character, intellectual property rights and the internet: Part 1' (2005) 16 Ent LR 209, 211 et seqq; Gary Scanlan, 'Derivative aspects of character and perceived attributes in persona as forms of intellectual property:

of journal articles is the most comprehensive source of all reference material regarding character copyright in the UK, in particular with regard to LFCs. That makes McGee and Scanlan's articles also the most challenging works from which this thesis must distinguish itself. At the same time it presents the opportunity to describe the contribution of this thesis to the existing knowledge.

McGee and Scanlan examine whether 'literary features' of characters could be protected by copyright. They do so with regard to fictional characters from literary and dramatic works and their reproduction in artistic or dramatic works (i.e. films).<sup>145</sup> As dramatic works are based on screenplays, which are literary works, there is no significant difference to this thesis as far as the type of characters are concerned. An important difference, though, is that this thesis does not only address the issue of reproduction of LFCs' features in two dimensions, but also the reproduction of LFCs' features in three dimensions, i.e. character merchandise items such as figurines.

McGee and Scanlan propose that a character's literary features and attributes could attract copyright, if they were a sufficiently original creation. They suggest that this is the case where the features are copied exactly or where any person would recognize these features in the copy.<sup>146</sup> Though this thesis agrees that the recognition element should play a role,<sup>147</sup> McGee and Scanlan do not critically evaluate the recognition criterion (which this thesis does<sup>148</sup>). They do not state exactly either how they would gauge recognition. One may assume though that they meant recognition by a reasonable member of the public, as this is the standard Scanlan proposed regarding 'perceived attributes'.<sup>149</sup> This thesis proposes a very similar recognition standard, but it is more target group specific. Not a general reasonable member, but that a reading member of the public or not, is required by this thesis. This thesis suggests instead

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Part 2' (2004) 15 Ent LR 1, 4; Andrew McGee and Gary Scanlan, 'Copyright in character' (2003) JBL 470, 483 et seqq.

<sup>145</sup> Andrew McGee and Gary Scanlan, 'Copyright in character' (2003) JBL 470, 480 and 483.

<sup>146</sup> Ibid 482.

<sup>147</sup> See paras 7.2.2.2.7.4.3. and 8.3.4.3. et seq.

<sup>148</sup> See para 8.3.4.4.

<sup>149</sup> Gary Scanlan, 'Derivative aspects of character and perceived attributes in persona as forms of intellectual property: Part 2' (2004) 15 Ent LR 1, 4.

'Perceived attributes' according to Scanlan are a creation which results from 'a creative partnership between the actor portraying the role, which exhibits these attributes, and the writers of the screenplay'. Thus the persona of the fictional character is created.

that a hypothetical average reader would have to be able to recognize the LFC from the original in the alleged copy.<sup>150</sup>

McGee and Scanlan also try to restrict their proposed copyright protection of the literary features and attributes of fictional characters. One of their ideas is to exclude copyright infringement where the fictional character was used without authorization in a different genre than the one it had been created for.<sup>151</sup> Though it is understandable that McGee and Scanlan try limiting copyright protection of literary characteristics to few instances, this thesis is not in favour of their criterion as will be discussed later in this thesis.<sup>152</sup> They also proposed that a character's literary features should only then be protected where the fictional character dictates 'the very course, format or plot' of the medium, i.e. the original book or film.<sup>153</sup> However, then a character would not be infringed, even if its features were reproduced exactly as in the original, if these were used in an atypical plot. This concern is corroborated by another section in McGee and Scanlan's work where these authors state that stories in which the character appears must follow a certain 'shape and pattern'<sup>154</sup> and the story copying the features and attributes of the character must also follow this 'shape and pattern'.<sup>155</sup> Otherwise, copyright is not infringed, even if the literary features of the character were drawn with some specificity and were copied without authorization. In case of 'Sherlock Holmes' that would mean that the story reproducing 'Sherlock's features must be a story in which the character solves a mystery applying his known talents. In case of Columbo that would mean that a perfect crime must be committed and a smart killer will eventually be found out.<sup>156</sup> This thesis finds itself unable to agree, because the aforementioned criterion would mean that most LFCs would not be protected by copyright against reproduction e.g. in sex novels or other media of that kind. However, this is a field that authors might wish to protect themselves and their LFCs against.

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<sup>150</sup> See para 8.3.4.4.

<sup>151</sup> Andrew McGee and Gary Scanlan, 'Copyright in character' (2003) JBL 470, 483.

<sup>152</sup> See para 8.3.4.6.

<sup>153</sup> Andrew McGee and Gary Scanlan, 'Copyright in character, intellectual property rights and the internet: Part 1' (2005) 16 Ent LR 209, 214; Andrew McGee and Gary Scanlan, 'Copyright in character, intellectual property rights and the internet: Part 2' (2006) 17 Ent LR 15, 16.

<sup>154</sup> Andrew McGee and Gary Scanlan, 'Copyright in character, intellectual property rights and the internet: Part 1' (2005) 16 Ent LR 209, 213 et seq.

<sup>155</sup> Ibid.

<sup>156</sup> Ibid.

One of the major differences between McGee and Scanlan's journal articles and this thesis is that their articles do not consider the existing alternative options trade marks and passing off, which are analysed in depth in this thesis in chapters 3 – 5 in relation to protection of LFCs. This thesis even evaluates critically the benefits of moral rights as compared to an action for passing off.

Even more importantly, since the publication of McGee and Scanlan's journal articles new case-law in relation to characters was decided.<sup>157</sup> Among that new character related case-law are the 'Betty Boop' cases, which were fortunately decided with regard to trade marks, passing off, and copyright.<sup>158</sup> Moreover, since McGee and Scanlan's journal articles were written, the originality standard changed, and Brexit may also affect the media and entertainment industry. Therefore, this thesis provides a fresh outlook on LFC copyrightability by critically evaluating the new CJEU-inspired originality standard and possible implications by Brexit.<sup>159</sup> McGee and Scanlan's journal articles do not make any concrete recommendations regarding the wording of the CDPA 1988 either. In addition to making recommendations in that regard,<sup>160</sup> this thesis considers how systems like PLSclear linked to the Copyright Hub and the implementation of a Digital Public Domain Registry for literary works may be of use, if LFCs were copyright protected.<sup>161</sup>

## 2.2. Reasons for re-evaluating LFC copyrightability

The Whitford Committee had decided in the late 70s that no character right should be introduced to UK copyright law.<sup>162</sup> Moreover, courts are still not protecting LFCs

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<sup>157</sup> For example: *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 1553 (Betty Boop); *Allen v Redshaw* [2013] WL 2110623 (Mr Spoon); *Hodgson v Isaac* [2012] ECC 4 (Flipper's Side); *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 (Willy the Wizard); *Jules Rimet Cup Ltd v Football Association Ltd* [2008] ECDR 4 (World Cup Willie).

<sup>158</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 1553 (copyright); *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) (trade mark and passing off).

<sup>159</sup> See paras 8.3.2. et seq.

<sup>160</sup> See paras 5.6.3., 6.4., 7.4., 8.5. and 9.4.

<sup>161</sup> See paras 3.5.2. et seq and 9.6.

<sup>162</sup> See para 2.1.

independent of the plot of the literary work in which the LFC exists.<sup>163</sup> However, there are compelling reasons for re-evaluating plot-independent LFC copyrightability. Copyrightability of LFCs per se would be beneficial to authors in the following fields: fanfiction, commercial publications such as prequels and sequels as well as films, and character merchandising. The last-mentioned is of particular concern in this thesis. The fields just mentioned as well as other reasons for re-evaluating LFC copyrightability will now be analysed in more depth.

### **2.2.1. Commercial reproductions**

AFCs are copyright protected by themselves, but LFCs are not. As a result, the following gap exists: For example, Alan Alexander Milne wrote the ‘Winnie-the-Pooh’ stories. The stories were illustrated by Ernest Sheppard. Disney produced a ‘Winnie-the-Pooh’ cartoon series. McGee and Scanlan argue in ‘Copyright in character’ that Disney’s representation of ‘Winnie’ looked sufficiently distinct in the cartoon series from Sheppard’s drawings,<sup>164</sup> and that therefore Disney did not infringe Sheppard’s copyright in the AFC. Disney’s ‘Winnie’ was instead portrayed like ‘Winnie’ in the books by Milne.<sup>165</sup> However, because LFCs are not copyright protected, Disney’s reproduction of ‘Winnie’ did not infringe Milne’s copyright either. This argument, of course, is only valid, if nothing apart from the LFC (such as the story) is reproduced. Even so, it illustrates the issue very well. The current gap makes it possible that multinational entertainment and mass media conglomerates as well as other commercially operating groups may copy popular characters from books without much effort and reproduce them in cartoon films and series, and as character merchandise items without legal and financial liability towards the creator of the LFCs.

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<sup>163</sup> See paras 1.1.2.2.4. – 1.1.2.2.7.

<sup>164</sup> This is arguable. Andrew McGee and Gary Scanlan, ‘Copyright in character’ (2003) JBL 470, 478 et seq.

<sup>165</sup> Ibid.

### 2.2.2. Fanfiction

Fanfiction is another field that is highly dependent on the LFCs of others as O'Rourke points out in 'Integrity on the web'.<sup>166</sup> Fanfiction is mostly not written for commercial purposes by the fans of an author and her work. The stories are written for the enjoyment of writing them and making a name in the fan community. Westcott and Schwabach observe how much has changed for fanfiction due to the internet. Before the electronic revolution, fanfiction relied on hand to hand distribution, for example at conventions, and by post.<sup>167</sup> Therefore, it was limited in its circulation. In rare cases fanfiction even got published in magazines.<sup>168</sup> The advent of the internet, however, lifted the possibilities of distribution (amount, time, and range) to an entirely different level.

Some fanfiction is very well written. However, stories of fanfiction can also be of low quality, and if these were erroneously attributed to the author of the canon, this might damage the author's reputation. Regardless of the quality, there is certainly a risk that readers and other third parties may get confused about who the true author of the fanfiction is. For example, when George Norman Lippert published *James Potter and the Hall of Elders' Crossing*, a novel-length prequel fanfiction, on his professional looking website, Australian press speculated that this work had been written by JK Rowling herself.<sup>169</sup>

Apart from mistaking a work of fanfiction for the real thing, which would be particularly detrimental if substandard writing would be attributed to the author of canon, fanfiction that connects the author of canon to causes the author strongly condemns can be detrimental to the author of the canon as well.

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<sup>166</sup> Fanfiction refers to stories written by fans which use elements of another author's work. For example, when a fan is dissatisfied with the officially published ending of the original work she will write a different ending to the work, or she might write a continuation, or a story that takes place before the plot of the original work. Quite frequently the fanfiction writer has taken a fancy to certain characters and writes a story around them. Grace Westcott, 'Friction over Fan Fiction' (2008) *Literary Review of Canada* <[www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/](http://www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/)> accessed 9 January 2013; Karina O' Rourke, 'Integrity on the web' (2012) 34 *EIPR* 815, 822.

<sup>167</sup> Grace Westcott, 'Friction over Fan Fiction' (2008) *Literary Review of Canada* <[www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/](http://www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/)> accessed 9 January 2013.

<sup>168</sup> Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 9.

<sup>169</sup> Grace Westcott, 'Friction over Fan Fiction' (2008) *Literary Review of Canada* <[www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/](http://www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/)> accessed 9 January 2013.

Moreover, fanfiction offers a combination of opportunity and at the same time danger for the author of the canon. On the one hand, the original author might discover from fanfiction what the fans like and want to read, and thereby might derive inspiration from this. On the other hand, the fanfiction stories might limit the original author's chances of getting her new works published, if the fanfiction pre-empts the plot of the author's next work. Consequently, the market for new works by the canon writer may be eroded even by non-commercial fanfiction. Further, Westcott wisely warns, there is even a risk that if the author of the canon really lets herself be inspired by a work of fanfiction and is sued by the fanfiction writer for copyright infringement, the reputation of the author of the original would suffer, although the fanfiction writer's claim would not be successful.<sup>170</sup>

Furthermore, fanfiction is not always for free. For example, the Japanese equivalent to fanfiction in the manga sector, doujinshis,<sup>171</sup> are becoming increasingly popular, not only within Japan. Doujinshis are commonly sold at comic conventions such as the half-yearly Comiket in Tokyo. At each session, more than 30,000 doujinshi circles attract a total of approx. 500,000 visitors.<sup>172</sup>

Even literary fanfiction is being commercially exploited. *The Guardian* reported that Amazon launched Kindle Worlds on the US market at the end of June 2013.<sup>173</sup> Kindle Worlds is an online platform on which fanfiction writers publish their works on certain canons for which Amazon was able to secure an agreement with the rightsholders of the underlying work.<sup>174</sup> At least, the Licensors retain control over the content: Moreover, the revenue from the sale of the fanfiction is split between the originator (i.e.

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<sup>170</sup> Karina O' Rourke, 'Integrity on the web' (2012) 34 EIPR 815, 822.

<sup>171</sup> Doujinshis are self-published magazines, manga or novels, often created by amateurs. Many of these creations are derivative works, that means works based on another mangaka's work. Nathaniel T Noda, 'Copyrights Retold: How Interpretive Rights Foster Creativity and Justify Fan-Based Activities' (2010) 20 Seton Hall Journal of Sports & Entertainment Law 131, 132. Although initially sold in limited numbers, their distribution has become less restricted, because scanlators operating in worldwide networks act together to translate these works into other languages and make them available to the public (usually free of charge) via the internet.

<sup>172</sup> Comic Market Preparations Committee, 'Welcome to the Comic Market' (*Comiket*, 2016) 38 <<http://www.comiket.co.jp/info-a/TAFO/C91TAFO/C91eng.pdf>> accessed 11 May 2017.

<sup>173</sup> James Bridle, 'How Kindle Worlds aims to colonise fan fiction' (*The Guardian The Observer*, 2 June 2013) <<http://www.theguardian.com/books/2013/jun/02/kindle-worlds-amazon-fan-fiction>> accessed 18 July 2013.

<sup>174</sup> The term 'canon' describes the original source of the work of fanfiction, i.e. the underlying work, but also denotes pairings, events, or story arcs that were suggested in the original.

the author of the canon), the author of the fanfiction, and Amazon Publishing.<sup>175</sup> Fanfiction stories often centre on one or more characters from the canon. LFCs can enjoy copyright in the US. There is no issue with the business model, as Kindle Worlds has licensing agreements with the rightsholders. However, the situation would be different, if Kindle Worlds came to the UK, where LFCs are fair game, because they are not copyrighted independent from the underlying work in which they were created. One may argue that Kindle Worlds would nevertheless require a licence from the originator, because not all fanfiction writers limit themselves to using just the LFC of the canon. Other elements of the author's canon are copied by the fanfiction writers every so often, too.

Both, authors and fanfiction writers have good reasons to consider the other party's interests. Authors of source works do not wish to lose their fans and the fans do not wish to take away the authors' reputation and livelihood.<sup>176</sup>

### 2.2.3. Incentive to create cultural and educational works

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<sup>175</sup> The revenue is split between the writer of the fanfiction (35 % for works of at least 10,000 words; 20 % for works between 5,000 and 10,000 words), the World Licensor, and Amazon Publishing. Amazon, 'Kindle Worlds Publishing Agreement s 5(a)' (Last revised 17 Feb 2015) <[https://kindleworlds-eu.amazon.com/agreement?token=H4sIAAAAAAAAAAFvzloG1uIjBOjk%2FVYy8xN7EqP0%2BvJD87NS%2BzKrEkE8hJzslMzSvR80%2FJzAtBEncGC6uAhRzezzOfvuPKLCYG5mgGlozcxOQSBqZoJx8GvtzEktSizMScYDBZwiDgk5VYlqifk5iXru%2BTn5du7cPAIp%2BUIZpcUsIgBpHLzNeHqAZaJSTal1RUFoEMm3NZ%2FEfbBwhD5gYGC0KGBgYFBIs9xxh2LZu7ufC1Q9PqO5PE1KoObfO0yw8K%2FSZ9ZMQ3Tagp%2FhAJuqBbNMD29b9ZMKZfuX7TAyMXgysZYk5pakVRQwCCEV%2BpblJqUVta6bKck950A2zCQQYgaZpIgVRfmK5XnFqUVlmcqqev2N4UGpiin9eTmVQamFpanFJkETQbiOLT2E8QBOKGFRx6HNKLE4F6wXrWaAotKHRVNYOpKeghGFKtRIk5D1TIKyUsjPzUnJS48vzi3JSipV0IFLyk0tzUSXhcsMJecmpOaFFOUCpjJKSgmLrfX1kJTCnAF2ln5ZYCNYCtsknPzxxJxWoy88RZEVmcUFOYmVAYIFibrGSVV5pTk5tBQDgfr5hLQIAAA%3D%3D&language=en\\_US](https://kindleworlds-eu.amazon.com/agreement?token=H4sIAAAAAAAAAAFvzloG1uIjBOjk%2FVYy8xN7EqP0%2BvJD87NS%2BzKrEkE8hJzslMzSvR80%2FJzAtBEncGC6uAhRzezzOfvuPKLCYG5mgGlozcxOQSBqZoJx8GvtzEktSizMScYDBZwiDgk5VYlqifk5iXru%2BTn5du7cPAIp%2BUIZpcUsIgBpHLzNeHqAZaJSTal1RUFoEMm3NZ%2FEfbBwhD5gYGC0KGBgYFBIs9xxh2LZu7ufC1Q9PqO5PE1KoObfO0yw8K%2FSZ9ZMQ3Tagp%2FhAJuqBbNMD29b9ZMKZfuX7TAyMXgysZYk5pakVRQwCCEV%2BpblJqUVta6bKck950A2zCQQYgaZpIgVRfmK5XnFqUVlmcqqev2N4UGpiin9eTmVQamFpanFJkETQbiOLT2E8QBOKGFRx6HNKLE4F6wXrWaAotKHRVNYOpKeghGFKtRIk5D1TIKyUsjPzUnJS48vzi3JSipV0IFLyk0tzUSXhcsMJecmpOaFFOUCpjJKSgmLrfX1kJTCnAF2ln5ZYCNYCtsknPzxxJxWoy88RZEVmcUFOYmVAYIFibrGSVV5pTk5tBQDgfr5hLQIAAA%3D%3D&language=en_US)> accessed 24 June 2015.

For more information on Amazon's Kindle Worlds project and what Amazon publishing would have to consider when expanding Kindle Worlds to the UK, please see the following two journal articles: Tamara Bukatz, 'Amazon's fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part I' (2013) 18 (4) *Communications Law* 122-127; Tamara Bukatz, 'Amazon's fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part II' (2014) 19 (1) *Communications Law* 20 - 25.

<sup>176</sup> Grace Westcott, 'Friction over Fan Fiction' (2008) *Literary Review of Canada* <[www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/](http://www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/)> accessed 9 January 2013.



LFC copyrightability would not only have a direct effect on the author of the original, but also has some indirect benefits on the general public.

Creativity and actual productivity are encouraged by sufficient legal protection of the author's work.<sup>177</sup> An author who writes, composes or creates a work in any other form in the knowledge that she can rely on protection for their work, feels that her work is safe and appreciated. As creators feel more appreciated and protected, they will be more creative. This might incentivise authors to create more content or content of a higher quality. In this regard, the owner of intellectual property will behave no different from the owner of material property. An owner of diamond earrings will be more willing to acquire and wear them in the knowledge that they are insured. The owner of intellectual property will feel the same way with regard to her brainchild. Hence, to protect fictional characters means to protect the authors, so that they continue to create, entertain and educate us with their works.

#### 2.2.4. Personality right

Carty points out in 'Advertising, Publicity Rights and English Law' that the basis for celebrity (and character) merchandising in civil law countries is '[T]he protection of personal autonomy and dignity'.<sup>178</sup> Indeed, in Germany, protection of LFCs actually originates from the personality right of the author.<sup>179</sup> Although moral rights in France are not derived from the personality right,<sup>180</sup> French *droit d'auteur* grants perpetual protection of characters to the creator by way of moral rights (*droit moral*), which protect the author's personality and reputation.<sup>181</sup>

#### 2.2.5. Moral rights

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<sup>177</sup> Andrew McGee, Alexandrine Cerfontaine and Gary Scanlan, 'Creativity and Form as Grounds for Copyright Protection in English Law' (2001) *Commercial Liability Law Review* 73, 80.

<sup>178</sup> Hazel Carty, 'Advertising, Publicity Rights and English Law' (2004) 3 IPQ 209, 248.

<sup>179</sup> §§ 12 - 14 UrhG 1965.

<sup>180</sup> André Lucas, 'Moral right in France: towards a pragmatic approach?' 1.1 <<http://www.blaca.org/Moral%20right%20in%20France%20by%20Professor%20Andre%20Lucas.pdf>> accessed 7 June 2013.

<sup>181</sup> See paras 7.3.2.4. and 7.3.2.4.1.

Even if one does not agree that fanfiction lessens the chances for publication and revenue of the original author, ethical issues remain. Here moral rights could be very useful. A story of fanfiction might involve two of the characters, just the two characters and nothing else of the original author's universe, and no verbatim parts either, so that no substantial part is copied. The fanfiction writer might weave a story around those two of questionable content, that distorts the characters to an abominable, though still recognizable extent. Westcott comments, and is justified in her view, in 'Friction over Fan Fiction' that the author might regard this as an attack on the integrity of her LFCs and may not look favourably on the abuse of her work as 'a cultural spare parts counter for others to rummage in.'<sup>182</sup> Moral rights protection against distortion of a LFC might be particularly important where children's and youth literature are concerned. Imagine, a young reader of 'Harry Potter' canon comes across a reproduction of 'Rubeus Hagrid', which presents him as a sadomasochist. Though this may not influence an adult reader, there is a risk that the work of JK Rowling would be besmirched or even ruined in the eyes of an impressionable young reader. As copyright is not afforded to LFCs in the UK, no moral rights apply.

If on the other hand, characters were copyrighted, then the author could rely on her moral rights to prevent damage to her reputation and her characters, O'Rourke writes in 'Integrity on the web'.<sup>183</sup> McGee and Scanlan fully agree in 'Copyright in character, intellectual property rights and the internet: Part 2' with special reference to the integrity right.<sup>184</sup> This moral right gives the author the power to take action against the derogatory treatment of her work.<sup>185</sup> However, according to present UK copyright law, moral rights are not applicable to fictional characters as they do not enjoy copyright protection. Even if they did, moral rights would still be relatively limited. Their protection ends, in case of the paternity right and the integrity right 70 years and in case of the right to object to false attribution of authorship 20 years from the end of the calendar year in which the author died.<sup>186</sup> Scanlan and McGee submit that moral rights should be assignable and inalienable, so that not only the author but any current owner is able

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<sup>182</sup> Grace Westcott, 'Friction over Fan Fiction' (2008) Literary Review of Canada <[www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/](http://www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/)> accessed 9 January 2013.

<sup>183</sup> Karina O' Rourke, 'Integrity on the web' (2012) 34 EIPR 815, 821 et seq.

<sup>184</sup> Andrew McGee and Gary Scanlan, 'Copyright in character, intellectual property rights and the internet: Part 2' (2006) 17 Ent LR 15, 20.

<sup>185</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 135.

<sup>186</sup> CDPA 1988 ss 12(2), 86(1) and (2).

to protect the integrity of the literary work and especially its characters.<sup>187</sup> As WIPO's document on 'Character Merchandising' reveals, LFCs are protected by copyright in France if they are sufficiently individual and if the character is recognizable by its character traits outside its context.<sup>188</sup> Cases in which fictional characters were copied are often decided with special regard to the author's moral right of integrity of her work, as JAL Sterling, Michael Hart and Emily Riddle discover in Sterling on *World Copyright Law*.<sup>189</sup>

Not only the moral rights element of copyright is more beneficial than the tort of defamation, but also the economic element of copyright would be. If LFCs were copyright protected, the author could claim damages from the person or company that makes unauthorized use of her LFC for profit. The tort of defamation might help the author of the original character only somewhat. An author's literary reputation was e.g. defamed in *Humphries v Thompson* i.a. by changing the names of all the characters.<sup>190</sup> However, a celebrity cannot claim defamation by a hotel which untruthfully claims that the celebrity has endorsed the hotel, if it does not damage the celebrity's reputation.<sup>191</sup> Likewise, the tort of defamation is not a useful remedy to an author, if no harm was done to the author by claiming untruthfully that the author had licensed the hotel to use her LFC and thereby sort of endorsed the hotel.

### 2.2.6. Character merchandising

In addition to fanfiction, authors would benefit even considerably more, if copyright would protect them against unauthorized character merchandise involving LFCs. The profit that can be gained from character merchandising is much higher than the royalties that flow from the underlying novel. Baillie backs this up in Adams' *Character Merchandising* by giving the example that character merchandise based on the

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<sup>187</sup> Andrew McGee and Gary Scanlan, 'Copyright in character, intellectual property rights and the internet: Part 2' (2006) 17 Ent LR 15, 20.

<sup>188</sup> WIPO, 'Character Merchandising' (WO/INF/108, December 1994) Annex I, 2.

<sup>189</sup> JAL Sterling, Michael Hart and Emily Riddle, 'Subject Matter of Protection' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 273 et seq.

<sup>190</sup> *Humphries v Thompson* [1905-10] MacG CC 148.

<sup>191</sup> Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 664 et seq.

unsuccessful film *Sergeant Pepper's Lonely Hearts Club Band* was more profitable than the film itself.<sup>192</sup>

However, the issue here is not only the absence of LFC copyrightability. English law does not provide a specific legal foundation by means of which an author has and can protect a general character merchandising right, as was lamented by Jaffey and Couchman in Ruijsenaars' *Character Merchandising in Europe*.<sup>193</sup> The only legal provision under copyright law that could be invoked distinguishes between the types of works on which character merchandise is based. The CDPA 1988 does not contain an equivalent section like 17(3) for literary works than it does for artistic works.<sup>194</sup> CDPA 1988 s 17(3) stipulates that the act of copying an artistic work includes the reproduction of a two-dimensional work in three dimensions, and vice versa. The first alternative clearly describes character merchandising, as it involves i.a. the making of a three-dimensional likeness of an AFC e.g. as a shampoo bottle or figurine. Since no such provision as CDPA 1988 s 17(3) exists for literary works (or substantial parts thereof), authors are not protected by copyright against unauthorized character merchandise making unlicensed use of their LFCs. This legislative lacuna is in line with those commentators who claim that there is no copyright protection for LFCs in the UK.<sup>195</sup> Colston and Galloway agree in *Modern Intellectual Property Law* that the absence of such a provision makes copyright protection of authors' LFCs against the production and sale of e.g. 'Sherlock Holmes' dolls and tea towels etc. at least unlikely, regardless of how distinctive and detailed a LFC.<sup>196</sup> This thesis will look into the possibility of UK copyright protection against unauthorized character merchandising of LFCs in chapter 8.

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<sup>192</sup> Ian C Baillie, 'Merchandising: an historical survey' in John N Adams, *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) xliii.

Adams is a distinguished scholar on character merchandising. He wrote a third edition of this textbook in 2007. However, unlike the second edition, the third edition does not cover copyright protection in different jurisdictions anymore. In fact, it does not discuss the law of foreign jurisdictions at all, and instead included e.g. taxation issues and deals with UK trade marks and passing off. For these reasons, this thesis makes use of both editions.

<sup>193</sup> Peter Jaffey and Nic Couchman, 'English Law' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 356.

<sup>194</sup> Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 449.

<sup>195</sup> See para 2.1.

<sup>196</sup> Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 449.

### 2.2.7. Statistics

The annual income of most authors from writing is rather low as the numbers from the ALCS study below prove. Fictional characters have great financial value to character merchandisers, though, and the M&E industry is doing well, too, as is shown below. Although most fictional characters are first created by authors of books and screenplays, the authors do not benefit from the reuse of their LFCs as much as they could, if LFCs were protected by copyright. This thesis aims to strengthen authors' position by critically evaluating how copyright protection for LFCs, independent of a novel's plot, could be shaped.

As stated in Directive 2012/28/EU of the European Parliament and of the Council of 25 October 2012 on certain permitted uses of orphan works: 'Copyright is the economic foundation for the creative industry since it stimulates innovation, creation, investment and production.'<sup>197</sup> King wrote during the double-dip recession of 2012: 'Britain's problem: "You don't make anything"'.<sup>198</sup> That is not quite true. The UK was and is among the top five in the M&E industry worldwide.<sup>199</sup> The M&E industry performed well globally even during the economic crisis. The content industry, that includes video and film, books, music and video games, grew globally by 66 per cent from 1998 to 2010<sup>200</sup>...and counting. The world's population spent 5.4 per cent more on products of the creative industries across the board in 2014. In 2013 it had been 5.2 per cent according to McKinsey's 'Global Media Report 2016'.<sup>201</sup> The revenue in the UK from

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<sup>197</sup> Directive 2012/28/EU of the European Parliament and of the Council of 25 October 2012 on certain permitted uses of orphan works [2012] OJ L299/5, recital 5.

<sup>198</sup> Stephen King, 'Britain's problem: "You don't make anything"' *The Times* (London, 11 December 2012) 20.

<sup>199</sup> The ranking in 2016 according to the 2015 - 2019 Entertainment & Media Outlook by PwC: USA, China, Japan, Germany, UK. International Trade Administration (ITA), '2016 Top Markets Report - Media and Entertainment' (*US Department of Commerce*, Oct 2016) 5 <[http://trade.gov/topmarkets/pdf/Media\\_and\\_Entertainment\\_Top\\_Markets\\_Report.pdf](http://trade.gov/topmarkets/pdf/Media_and_Entertainment_Top_Markets_Report.pdf)> accessed 25 Jan 2017. The ITA comments on page 3 that 'As the research was conducted prior to the "Brexit" decision, the report may need revisions as we learn more about the impact of this major event.'

<sup>200</sup> Mike Masnick, 'The Sky is Rising: The Entertainment Industry is Large & Growing... not Shrinking' (*techdirt*, 30 January 2012) <<http://www.techdirt.com/articles/20120129/17272817580/sky-is-rising-entertainment-industry-is-large-growing-not-shrinking.shtml>> accessed 25 January 2013.

<sup>201</sup> However, this is less than the gains recorded for 2009 to 2012. The annual increase during that period was 6.2 per cent. McKinsey & Company, 'Global Media Report 2016' (September 2015) 7

children's books alone was £473m in 2010.<sup>202</sup> The Department of Culture, Media and Sport announced in 2014 that the creative industries were worth £71.4 billion in 2012, 5.2 per cent of the UK economy. That is £8 million/hour.<sup>203</sup> The GVA of the publishing sector alone is around £10 billion. Hence, it is bigger than e.g. the pharmaceuticals sector, and also bigger than the automotive sector.<sup>204</sup>

However, the money does not end up in the pockets of authors. According to a study on authors' earnings by Queen Mary, University of London, commissioned by ALCS, professional authors' income for 2013 had dropped by 29% per cent since 2005 to £11,000. This amount lies roughly £6,000 below the Minimum Income Standard (£16,850), the income level that enables a socially acceptable standard of living.<sup>205</sup>

Hence, in a time where some argue for reducing copyright protection, like Hargreaves, who had proposed a couple of copyright exceptions which were enacted in early June and October 2014,<sup>206</sup> ALCS sought new ways to increase author's revenue. ALCS tested the waters for an author resale right and is running a pilot project with Bookbarn International which agreed to compensate authors for any book that is sold by the second-hand book retailer.<sup>207</sup>

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<<http://www.mckinsey.com/industries/media-and-entertainment/our-insights/global-media-report-2015>> accessed 25 Jan 2017.

<sup>202</sup> Robert Kenny and Tom Broughton, 'Securing the future of UK animation' (September 2011) 18 <[www.animationuk.org/files/report-pdfs/docs/4I6KD5YW2J.pdf](http://www.animationuk.org/files/report-pdfs/docs/4I6KD5YW2J.pdf)> accessed 22nd January 2013.

<sup>203</sup> Department for Culture, Media & Sport, 'Creative Industries Economic Estimates – January 2014 – Statistical Release' (14 Jan 2014) 7 <[https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/271008/Creative\\_Industries\\_Economic\\_Estimates\\_-\\_January\\_2014.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/271008/Creative_Industries_Economic_Estimates_-_January_2014.pdf)> accessed 5 August 2014.

<sup>204</sup> ALCS, 'Are we all on the same page? The ALCS Debate' (22 July 2014) <<http://www.alcs.co.uk/ALCS-News/2014/July-2014/Copyright-debate>> accessed 22 July 2014.

<sup>205</sup> ALCS, 'What are words worth now? A survey of authors' earnings' (8 July 2014) 5 <<http://www.alcs.co.uk/Documents/A-Free-for-All-Loughborough-research/what-are-words-worth-now.aspx>> accessed 22 July 2014; Alison Flood, 'Authors' incomes collapse to abject levels' (*The Guardian*, 8 July 2014) <<http://www.theguardian.com/books/2014/jul/08/authors-incomes-collapse-alcs-survey>> accessed 22 July 2014.

<sup>206</sup> The Copyright and Rights in Performances (Quotation and Parody) Regulations 2014 came into force on 1<sup>st</sup> October 2014. The Copyright (Public Administration) Regulations 2014, The Copyright and Rights in Performances (Research, Education, Libraries and Archives) Regulations 2014, The Copyright and Rights in Performances (Disability) Regulations 2014 came into force on 1<sup>st</sup> June 2014.

<sup>207</sup> BBI and ALCS, 'First Book Resale Right Initiative Launched' (10 June 2014) <<http://www.alcs.co.uk/CMSPages/GetFile.aspx?nodeguid=bfb4b724-bd45-4327-8b73-485bdfef1f11b>> accessed 22 August 2014.

This thesis claims that the money is unequally and unfairly divided. Take for example character merchandising. Over the decades character merchandising, which consists of licensing the use of a name or image of a fictional or real character in relation to marketing of goods/services,<sup>208</sup> has become common practice. Even companies that are not involved in the creative industries create fictional characters to enhance the recognizability of their brand. This includes AFCs such as the Exxon Tiger and Kellogg's Toucan Sam decorating boxes of Froot Loops cereal. Eventually merchandise items were produced of those too. The value of character merchandising becomes very apparent from the following business transaction. In early 2012, Mattel acquired HIT Entertainment and with it i.a. the Thomas & Friends franchise, the number one pre-school brand (in the UK).<sup>209</sup> The negotiated purchase price was \$680m. That is approximately nine and a half times as much as the company's income (before interest, tax, depreciation and amortisation).<sup>210</sup> Over the last ten years, the investment of British enterprises in intangible assets has exceeded the investment in tangible assets each year. For example in 2008, £137bn was invested in intangible assets while £104bn was invested in tangible assets. Five per cent of global trade lies in licensing. That is £600bn/p.a.<sup>211</sup>

A significant amount of royalties from merchandising can even be secured for unsuccessful films.<sup>212</sup> The same can apply to illustrated books, especially children's books, because character merchandising is primarily directed at children and teenagers. The authors of such books are protected by artistic copyright, e.g. Beatrix Potter, the creator of 'Peter Rabbit' and 'Squirrel Nutkin', could prevent a third person

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<sup>208</sup> David Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 888; David Goldberg, Gavin Sutter and Ian Walden (eds), *Media Law and Practice* (1<sup>st</sup> edn, OUP 2009) 225; Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 300; Lynette Owen, *Selling rights* (7<sup>th</sup> edn, Routledge 2014) 321; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 435.

<sup>209</sup> Andrew Laughlin, 'Mattel acquires Bob the Builder, Thomas & Friends owner for \$680m' (*Digital Spy*, 24 October 2011) <[digitalspy.co.uk/media/news/a347168/mattel-acquires-bob-the-builder-thomas—friends-owner-for-usd680.html](http://digitalspy.co.uk/media/news/a347168/mattel-acquires-bob-the-builder-thomas—friends-owner-for-usd680.html)> accessed 22 January 2013.

<sup>210</sup> Helia Ebrahimi, 'Thomas the Tank Engine owner Hit Entertainment sold to Mattel for \$680m' (*The Telegraph*, 24 October 2012) <<http://www.telegraph.co.uk/finance/newsbysector/retailandconsumer/8847097/Thomas-the-Tank-Engine-owner-Hit-Entertainment-sold-to-Mattel-for-680m.html>> accessed 23 January 2013; Andrew Laughlin, 'Mattel acquires Bob the Builder, Thomas & Friends owner for \$680m' (*Digital Spy*, 24 October 2011) <[digitalspy.co.uk/media/news/a347168/mattel-acquires-bob-the-builder-thomas—friends-owner-for-usd680.html](http://digitalspy.co.uk/media/news/a347168/mattel-acquires-bob-the-builder-thomas—friends-owner-for-usd680.html)> accessed 22 January 2013.

<sup>211</sup> Ian Hargreaves, 'Digital Opportunity – A Review of Intellectual Property and Growth' (May 2011) 3 <<http://www.ipo.gov.uk/ipreview-finalreport.pdf>> accessed 25 January 2013.

<sup>212</sup> Ian C Baillie, 'Merchandising: an historical survey' in John N Adams, *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) xliii.

from designing nursery wallpaper displaying her characters at the very beginning of the 20<sup>th</sup> century.<sup>213</sup> The creators of unillustrated LFCs are at a disadvantage in this regard. They are not copyrighted independent of the work they appear in. That makes them more vulnerable to free-riding by undertakings producing and selling character merchandise.

This unequal treatment of LFCs and AFCs could be remediated, if the law could find a way to resolve the issues that have frustrated copyright protection for LFCs so far. This thesis attempts to do that.

Character merchandise has such great commercial power that part of Tokyo Grand Central Station is even called ‘Character Street’. It houses many character merchandise shops, each dedicated to a specific character or series of fictional characters e.g. ‘Moomin’ and ‘My Neighbour Totoro’. Even so, the field of character merchandising ‘has received only limited legal recognition in the UK’ as Torremans points out in *Holyoak and Torremans Intellectual Property Law*.<sup>214</sup> Later on he adds, though, that ‘a fair range of’ IPRs is applicable.<sup>215</sup> It is submitted that this ‘fair range’ is suffering from many issues, which make it worthwhile to reconsider author’s rights and character merchandise in this doctoral thesis.

### **2.2.8. Prevention of consumer misinformation**

According to Adams, Hickey and Tritton’s *Character Merchandising*, the average consumer expects the author of a character to be the single official source of the character products.<sup>216</sup> However, in reality, there is no right to license. Hence, companies manufacturing and selling character goods do not need to pay a licence fee to the originator of a LFC, but may on the other hand license the name or image of

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<sup>213</sup> Ibid.

<sup>214</sup> Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 656.

<sup>215</sup> Ibid 658.

<sup>216</sup> John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 59 et seq.



the character themselves, if the company has registered the name or image of the character successfully or has acquired a reputation in these for itself.

The reasons for improving the law on character merchandising, especially by introducing copyright protection for fictional characters, go beyond economic justifications. The population might get confused without protection of characters, opines Norman in *Intellectual Property Law*.<sup>217</sup> It is suggested here in this thesis that confusion may also be fought, though not prevented, by creating a public awareness of the actual state of the law. In the eyes of the public, LFCs are better protected than they are in reality. Without the legal obligation to acquire a licence, and without clear rules on how to disclose or whether to disclose at all that a work is not a work by the author of the LFC, a potential or actual buyer is in danger of buying an unlicensed instead of a licensed product under the false impression that the author would benefit from the sale.

### 2.2.9. Sequels

Apart from fanfiction and character merchandising, the interests of the creator of a character are also threatened by sequels, spin-offs, and the like. In particular films, which bring together characters from different works, have become increasingly popular with publishers and film production companies,<sup>218</sup> because the revenue they can garner from it is guaranteed. Klement states in ‘Copyright protection of unauthorized sequels under the Copyright, Designs and Patents Act 1988’ that the most vital factor in a sequel’s or spin-off’s success is a recognizable character which the reader/audience can relate to. Such a character only requires a minimal connection with the plot of the earlier work.<sup>219</sup> Kurtz comments in ‘The Independent Legal Lives of Fictional Characters’ that the fame of ‘James Bond’ and ‘Rocky’ makes an infinite

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<sup>217</sup> Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 500.

<sup>218</sup> One may think of e.g. the prequels and sequels of ‘Batman’ and the ‘Underworld’ series.

<sup>219</sup> Ute Klement, ‘Copyright protection of unauthorised sequels under the Copyright, Designs and Patents Act 1988’ (2007) 18 Ent LR 13.

number of sequels (financially) possible.<sup>220</sup> Klement goes so far to say that '[t]his conjuncture may render a character more valuable than the works from which it originated.'<sup>221</sup>

Eagles, too, broached the subject of sequels and prequels at the AHRC.<sup>222</sup> His paper has a different focus, though. He discusses whether the copyright holders should have the exclusive right to authorize the creation of sequels with respect to the narratives in the works which are already owned by the author. He regards the debate on character copyright as too narrow, and stipulates that copyright is incapable of 'principled resolution'.<sup>223</sup> Klement agrees that the current framework of the CDPA 1988 is not suited to harbour the US tests on LFC copyrightability.<sup>224</sup> She highlights the difference in the wording of the United States Code (USC) and the CDPA 1988. While 17 USC § 102(a) contains an illustrative list of categories of works of authorship, section 1 of the CDPA 1988 provides an exhaustive list of copyright works. As a consequence, LFCs would have to fall under one of the works listed in the CDPA, e.g. literary work, in order to be copyright protected. She concedes that a separate legal category may be introduced into the CDPA 1988 to grant fictional characters copyright protection. However, this would still leave the problem of a test or guidelines to distinguish between copyrightable and uncopyrightable LFCs. That is an important issue which will be addressed by this thesis in chapters 6 - 8. She regards the US tests as too subjective.<sup>225</sup> It is submitted that some level of subjectivity will always be present. One can only try to keep the level as low as possible.

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<sup>220</sup> Leslie A Kurtz, 'The Independent Legal Lives of Fictional Characters' (1986) *Wis L Rev* 429, 437; Ute Klement, 'Copyright protection of unauthorised sequels under the Copyright, Designs and Patents Act 1988' (2007) 18 *Ent LR* 13.

<sup>221</sup> Ute Klement, 'Copyright protection of unauthorised sequels under the Copyright, Designs and Patents Act 1988' (2007) 18 *Ent LR* 13.

<sup>222</sup> Ian Eagles, 'Prequels, Sequels and the Law of Copyright' (AHRC Copyright Conference, London, 27-28 June 2006).

<sup>223</sup> *Ibid* 1.

<sup>224</sup> Ute Klement, 'Copyright protection of unauthorised sequels under the Copyright, Designs and Patents Act 1988' (2007) 18 *Ent LR* 13.

<sup>225</sup> *Ibid* 17.

Furthermore, Klement points out that litigation on authors' protection against sequels in the UK has been scarce, and at best confusing if not unclear and contradictory with regard to copyright.<sup>226</sup> Trade mark law and the law of passing off offer some protection, though.<sup>227</sup> That protection, however, is inadequate or inexpedient at the least. This will be demonstrated in chapters 3 - 5.

### 2.3. Conclusion

The internet makes it possible for fanfiction to be easily distributed to every corner of the globe quickly. There, fanfiction is accessible by an uncontrollable number of readers. Many of those stories feature characters from other authors in such a way that may be regarded by the originators as detrimental to the moral integrity of their work. However, LFCs by themselves are not copyrighted. Hence the authors of the original are at a legal disadvantage. Merchandising, too, enjoys increased popularity<sup>228</sup> which it draws heavily from the entertainment industry's success. Nevertheless, till this day LFCs are not protected by copyright independent of the literary work they originate from.<sup>229</sup> They receive partial protection from trade marks and the tort of passing off. However, both these areas of law are inadequate or at the least inexpedient for the protection of LFCs, especially in the merchandising sector.<sup>230</sup>

Apart from the individual deficiencies of the existing remedies against character reproduction, the fact that there are different forms of protection each covering just a bit of a character, but never all, not even all remedies together, in itself is a shortcoming. The law could be simpler, more user friendly for laymen. Not all companies and individual persons who may wish to use a character on their own creations or goods will have a legal department or legal knowledge. A uniform,

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<sup>226</sup> Here Klement refers especially to *Kelly v Cinema Houses, Ltd* [1928-35] MacG CC 362 (for details see para 1.1.2.2.1.).

<sup>227</sup> William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 682 et seq and 698 et seq.

<sup>228</sup> See para 2.2.6 et seq.

<sup>229</sup> See para 1.1.2.2.

<sup>230</sup> See paras 3.7. and 4.5.

comprehensive means of protection would be advisable. It will be argued in this thesis that copyright would be the most adequate form of protection.<sup>231</sup>

Scholars such as Adams, Hickey and Tritton have referred to the absence of LFC copyrightability independent of the literary mother work in the UK.<sup>232</sup> So far no one has come up with a feasible complete solution to the problem. McGee and Scanlan, who discussed the possibility of copyright protection of literary physical features and attributes intensively, came very close, though. The UK resisted reforms in this regard so far.

This thesis is dedicated to finding guidelines to determine which characters are copyrightable and which are not. Other countries, such as the USA, Canada, France and Germany provide inspiration.<sup>233</sup> They have demonstrated for decades that LFCs can be protected by copyright. This thesis will critically evaluate the suitability of these countries' tests and the handling of LFC copyrightability. It shall also be critically evaluated how the UK's current copyright system might offer copyright protection to authors for the creation of LFCs and which changes might be recommendable.<sup>234</sup>

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<sup>231</sup> Ibid.

<sup>232</sup> John N Adams, Julian B Hickey, Guy Tritton, *Merchandising Intellectual Property* (3<sup>rd</sup> ed, Tottel 2007) 13 et seq; Craig J Dickson, "A Life of His Own" – the copyright protection of fictional characters' (*NZIPA*, 2007) 8 <[http://www.nzipa.org.nz/Site/loman\\_friedlander\\_award/loman-friedlander.aspx](http://www.nzipa.org.nz/Site/loman_friedlander_award/loman-friedlander.aspx)> accessed 30 January 2013); Zhiqiang Su, 'Copyright Protection of Character Merchandising' (*Article.chinalawinfo*, 2002) 3 <[www.article.chinalawinfo.com/Article\\_Detail.asp?ArticleID=23641](http://www.article.chinalawinfo.com/Article_Detail.asp?ArticleID=23641)> accessed 30 January 2013; Robert G Howell, 'Character merchandising: the Marketing Potential Attaching to a Name, Image, Person or Copyright Work' (1991) 6 IPJ 197, 219 et seq; David Vaver, 'The protection of character merchandising: a survey of some common law jurisdiction' (1978) 9 IIC 541, 554.

<sup>233</sup> See chapter 6 et seq.

<sup>234</sup> See chapter 8 and para 9.4.

## Chapter 3 – Strengths and weaknesses of trade mark protection

### 3.1. Introduction

Before going into the copyrightability issues of LFCs, this thesis critically evaluates how well protected an author and her LFCs are by trade mark law and actions for passing off.

This chapter explores to which extent LFCs are protected by UK trade mark law. This entails an in-depth analysis of the benefits and deficiencies of this IPR as opposed to the protection that copyright might grant, if protection of LFCs as an abstracted whole was accepted by law.

The purpose behind this examination and, in part, comparison is to demonstrate that

- a) LFCs are insufficiently protected by trade mark law, and
- b) copyright is the more suitable means of protection for LFCs.

Copyright and trade marks are both IPRs, but each of them has their own purpose as well as different scope of protection governed by different laws i.a. on the duration, registration, grounds for refusal, and infringement of these IPRs.<sup>235</sup>

In a first step, the objective of both, copyright and trade mark, will be examined. The second step is a critical evaluation of the pros and cons of the two forms of IPRs with regard to duration and registration. The adoption of a copyright registration service for LFCs modelled after the trade mark registration system will be considered there, too, as well as the suitability of the copyright licensing service PLSclear for LFCs. In the third and major step, the scope of trade mark protection in general and specifically regarding its suitability for the protection of LFCs will be evaluated. This involves also a closer look at case-law regarding spin-off products, i.e. merchandising goods.

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<sup>235</sup> Craig S Mende and Belinda Isaac, 'When copyright and trademark rights overlap' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 138.

### 3.2. Purpose of trade marks and copyright

Copyright and trade marks are both beneficial to the owner of the IPR as well as the public. However, their purpose and mode of doing so strongly differs from each other.<sup>236</sup>

The central function of trade marks is the prevention of consumer confusion and/or deception as regards primarily the source, and quality of the goods/services.<sup>237</sup> Trade marks are indicia of origin by means of which the consumers may identify goods as a product of a particular manufacturer or distributor, and thus distinguish the goods of competitors.<sup>238</sup> Consumers are able to repeat their good experience with the brand or avoid bad experience in the future with the aid of trade marks. Hence, trade marks embody the goodwill which the proprietor of the mark enjoys among consumers.<sup>239</sup>

Copyright protects the expression of creativity, and aims to incentivise the creation of new works by authors.<sup>240</sup> In addition, it aims at securing a just reward for the labour of authors.<sup>241</sup> Further purposes are contributing to people's social life as well as preserving and promoting their cultural heritage.<sup>242</sup> Hence copyright specifically protects authors. At present, it is questionable whether authors are receiving a just reward.<sup>243</sup>

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<sup>236</sup> Ibid 141.

<sup>237</sup> Ibid 138 and 141; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 9; Peter Jaffey and Nic Couchman, 'English Law' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 358.

<sup>238</sup> TMA 1994 s 1(1); *R v Johnstone* [2004] ETMR 2 [H8] and [13]; *Griggs Group v Ross Evans and Others* [2004] ECDR 15 [21]; Craig S Mende and Belinda Isaac, 'When copyright and trademark rights overlap' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 141.

<sup>239</sup> Craig S Mende and Belinda Isaac, 'When copyright and trademark rights overlap' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 141.

<sup>240</sup> *Griggs Group v Ross Evans and Others* [2004] ECDR 15 [17]; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 5; Craig S Mende and Belinda Isaac, 'When copyright and trademark rights overlap' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 138 and 141.

<sup>241</sup> Mira Sundara Rajan, 'Tradition and change: the past and future of Authors' moral rights' in Toshiko Takenaka (ed), *Intellectual Property in Common Law and Civil Law* (Edward Elgar 2013) 123.

<sup>242</sup> Mira Sundara Rajan, 'Moral rights in information technology: a new kind of "personal right"?' (2004) 12 IJLIT 32, 39 et seq; André Kerever, 'Reflections on the Future Development of Copyright - Is Copyright an Anachronism?' (1983) 19 Copyright 368, 370.

<sup>243</sup> See para 2.2.7.

A report from PwC reveals that the average professional writer earns little more than £25,000 per annum, whereas e.g. higher education teaching professionals earn on average close to £40,000 a year.<sup>244</sup> Bournemouth University's research on authors' earnings for 2005 showed even worse numbers. Median earnings for professional authors were £12,330. Less than half of that income stemmed from writing for over 40% of professional writers. 60% of professional writers hold second jobs to secure a living.<sup>245</sup> The difference in these figures is down to 'The winner takes it all'-nature of writing.<sup>246</sup> The highest returns are earned by a small group of authors,<sup>247</sup> while in particular writers in the age group of 25 - 34 receive a median income of £5,000/year.<sup>248</sup> According to the latest independent study on authors' earnings conducted by Queen Mary, University of London, professional authors' income for 2013 has dropped by 29% per cent since 2005 to £11,000. This is below the Minimum Income Standard, the income level considered to enable a socially acceptable standard of living.<sup>249</sup> The typical earnings of all writers (including part-time writers) has fallen by 19% since 2005 to £4,000 in 2013.<sup>250</sup> As a result of the strong downwards trend in remuneration of

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<sup>244</sup> PwC, 'An economic analysis of copyright, secondary copyright and collective licensing' (March 2011) 18 <[http://www.cla.co.uk/data/corporate\\_material/submissions/2011\\_pwc\\_final\\_report.pdf](http://www.cla.co.uk/data/corporate_material/submissions/2011_pwc_final_report.pdf)> accessed 10 February 2014; ALCS, 'Independent Review of Intellectual Property and Growth' (March 2011) 12 <[www.alcs.co.uk/Documents/Submissions/Hargreaves/hargreaves-review-response](http://www.alcs.co.uk/Documents/Submissions/Hargreaves/hargreaves-review-response)> accessed 10 February 2014.

<sup>245</sup> Martin Kretschmer and Philip Hardwick, 'Authors' earnings from copyright and non-copyright sources: A survey of 25,000 British and German writers' (*CIPPM, Bournemouth University*, December 2007) 24, table 3.1 <<http://microsites.bournemouth.ac.uk/cippm/files/2007/07/ACLS-Full-report.pdf>> accessed 10 February 2014; ALCS, 'Independent Review of Intellectual Property and Growth' (March 2011) 12 <[www.alcs.co.uk/Documents/Submissions/Hargreaves/hargreaves-review-response](http://www.alcs.co.uk/Documents/Submissions/Hargreaves/hargreaves-review-response)> accessed 10 February 2014.

<sup>246</sup> ALCS, 'Independent Review of Intellectual Property and Growth' (March 2011) 11 <[www.alcs.co.uk/Documents/Submissions/Hargreaves/hargreaves-review-response](http://www.alcs.co.uk/Documents/Submissions/Hargreaves/hargreaves-review-response)> accessed 10 February 2014.

<sup>247</sup> Martin Kretschmer and Philip Hardwick, 'Authors' earnings from copyright and non-copyright sources: A survey of 25,000 British and German writers' (*CIPPM, Bournemouth University*, December 2007) 86, table 7.3 <<http://microsites.bournemouth.ac.uk/cippm/files/2007/07/ACLS-Full-report.pdf>> accessed 10 February 2014.

<sup>248</sup> *Ibid* 27, table 3.4.

<sup>249</sup> ALCS, 'What are words worth now? A survey of authors' earnings' (8 July 2014) 5 <<http://www.alcs.co.uk/Documents/A-Free-for-All-Loughborough-research/what-are-words-worth-now.aspx>> accessed 22 July 2014; Alison Flood, 'Authors' incomes collapse to abject levels' (*The Guardian*, 8 July 2014) <<http://www.theguardian.com/books/2014/jul/08/authors-incomes-collapse-alcs-survey>> accessed 22 July 2014.

<sup>250</sup> ALCS, 'What are words worth now? A survey of authors' earnings' (8 July 2014) 6 <<http://www.alcs.co.uk/Documents/A-Free-for-All-Loughborough-research/what-are-words-worth-now.aspx>> accessed 22 July 2014.

authors, the percentage of professional authors has decreased as well, from 40% in 2005 to 11.5% in 2013. This is a very rapid fall in the number of full-time authors.<sup>251</sup>

This imbalance is a clear signal that a copyright regime that supports authors and their ability to make a living from their creations needs to be created.<sup>252</sup> According to Adam Singer, Chair of the ALCS Board, new ways to monetise (existing and new) creative content must be found.<sup>253</sup>

This thesis suggests that securing authors' share in revenue from character merchandise via licensing fees by establishing LFC copyrightability might be an option.

### 3.3. Duration of copyright and trade marks

The term of copyright protection for literary works is 70 years from the end of the year in which the author dies.<sup>254</sup> Hence, copyright provides a quasi-monopoly<sup>255</sup> for a limited duration unlike trade marks which may potentially last indefinitely.<sup>256</sup> After the expiration of the period of copyright, the work enters the public domain and is consequently free for use by any member of the public.<sup>257</sup>

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<sup>251</sup> Ibid 4 and 11.

<sup>252</sup> Ibid 11; ALCS, 'What are words worth now? Not enough' (22 July 2014) <<http://www.alcs.co.uk/ALCS-News/2014/July-2014/Authors-Earnings>> accessed 22 July 2014.

<sup>253</sup> Caroline Sanderson, 'ALCS News 2014 – Editor's Note' (ALCS, 22 July 2014) <[http://www.alcs.co.uk/ALCS-News/2014/July-2014/Editor-s-Note?utm\\_medium=email&utm\\_source=Authors%27+Licensing+and+Collecting+Society&utm\\_campaign=4456945\\_ALCS+News+July&utm\\_content=EdNoteJuly2014&dm\\_i=76%2c2NJ01%2cEQZWEL%2c9P6CA%2c1](http://www.alcs.co.uk/ALCS-News/2014/July-2014/Editor-s-Note?utm_medium=email&utm_source=Authors%27+Licensing+and+Collecting+Society&utm_campaign=4456945_ALCS+News+July&utm_content=EdNoteJuly2014&dm_i=76%2c2NJ01%2cEQZWEL%2c9P6CA%2c1)> accessed 22 July 2014.

<sup>254</sup> CDPA 1988 s 12(1) and (2).

<sup>255</sup> Contrary to a trade mark, copyright does not give a full monopoly, but a quasi-monopoly, because copyright may vest in two or more identical works provided the defendant created the alleged copied work independently without knowledge of, i.e. without actually copying the claimant's work. Bruce Goldstein, 'Patents and Patent Licenses' in John I Gallin and Frederick P Ognibene, *Principles and Practice of Clinical Research* (3rd edn, Elsevier 2012) 446; Craig S Mende and Belinda Isaac, 'When copyright and trademark rights overlap' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 139 et seq; David A Burge, *Patent and Trademark Tactics and Practice* (3<sup>rd</sup> edn, Wiley 1999) 188; UK©CS, 'Top 10 copyright myths' <[www.copyrightservice.co.uk/copyright/copyright\\_myths](http://www.copyrightservice.co.uk/copyright/copyright_myths)> accessed 22 January 2013. This means also that, unlike it is the case with trade marks, a work can attract copyright without being novel, if it is original.

<sup>256</sup> Craig S Mende and Belinda Isaac, 'When copyright and trademark rights overlap' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 140.

<sup>257</sup> Ibid.



A trade mark is initially registered for a period of ten years.<sup>258</sup> Towards the end of this term, the trade mark may be renewed indefinitely for further periods of ten years in return for the payment of a renewal fee.<sup>259</sup> Hence, theoretically a trade mark can exist forever which means the proprietor of the trade mark may exploit the mark infinitely. However, a trade mark may be revoked e.g. if it was not put to genuine use for an uninterrupted period of five years after registration, or if use has been suspended for five years, without a valid reason for non-use of the mark.<sup>260</sup> This shall prevent 'warehousing'<sup>261</sup> and shall ensure that the register is not blocked for newcomers.<sup>262</sup> The catchphrase 'Use it or lose it!' is not to be understood unconditionally, though. If the trade mark is not challenged, it will remain in existence regardless of non-use.

In comparison, under copyright a work will benefit from the full term of copyright protection regardless of use or non-use, if it is an original, recorded work, that falls within one of the descriptions of works specified in CDPA 1988 s 1(1)(a)-(c). Therefore, even a written work that is kept at home and is not published and may not be bought in a book store, is protected by copyright during the lifetime of the author plus 70 years from the end of the year in which the author dies.

At first glance the indefinite term of trade mark protection seems a big advantage that a trade mark has over copyright. This view is one-sided. The possibility of indefinite trade mark protection is advantageous for the proprietor of this right, because it effects what is in point of fact 'a copyright of unlimited duration'.<sup>263</sup> However, the public benefit has to be taken into the equation, too. The limitation of the copyright term is an essential factor in striking a balance between the authors' interest to receive an incentive to create more works and the public's interest to freely access and use these works for their own purposes.<sup>264</sup> On the other hand, although trade marks may, in

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<sup>258</sup> TMA 1994 s 42(1).

<sup>259</sup> Ibid ss 42(2) and 43(1); Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 65.

<sup>260</sup> TMA 1994 s 46(1)(a) and (b); Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 508 et seq; David Goldberg, Gavin Sutter and Ian Walden (eds), *Media Law and Practice* (1<sup>st</sup> edn, OUP 2009) 225; Peter Shears, 'Legal protection for the character merchandiser: in England and the United States' (1985) 14 *Anglo-Am L Rev* 49, 56.

<sup>261</sup> Glen Gibbons, *Trade Marks Law* (2<sup>nd</sup> edn, Clarus Press 2016) 320.

<sup>262</sup> Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 47.

<sup>263</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [70] ('Betty Boop' case).

<sup>264</sup> Craig S Mende and Belinda Isaac, 'When copyright and trademark rights overlap' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 140.

theory, be of indefinite duration and some *de facto* have existed for a very long time,<sup>265</sup> character merchandising depends on fashion and popularity of the characters. Some characters are not merchandisable for a long period. Therefore, the proprietor of a trade mark may let it expire. This might be even earlier than copyright would expire.<sup>266</sup>

### 3.4. Registration of trade marks

Copyright vests automatically from the moment in which a qualifying work is written down or fixed in another manner. It does not require registering. Therefore, there is neither a lengthy registration process nor registration fees. For authors lacking the necessary financial power, copyright is the best option – an option authors do not have for the protection of LFCs independent of the underlying work. In principle, copyright vests regardless of whether a person or undertaking can afford to pay for an IPR, unlike trade marks. The registration fee may not appear too high, but for the majority of authors £200 for basic registration in one class and £50 for each additional class,<sup>267</sup> it does make a big difference considering their low income (see above). The official fees for trade mark registration are quite often just the tip of the iceberg. Businesses spend much more on professional fees as well as fees for trade mark watch and clearance services, that monitor new filings and publications of marks which may be identical or confusingly similar to their clients' trade marks.<sup>268</sup>

However, the registration system used for trade marks has the advantage that potential applicants as well as the public may search the register and find out whether a certain mark (e.g. for a character name and for which goods/services) has already been registered.<sup>269</sup> In addition, this system permits anybody to see the date of application

<sup>265</sup> The first registered UK trade mark for an image, the Bass Brewery's red triangle, was registered in 1876 and is still in use today.

<sup>266</sup> Department of Trade and Industry, *Reform of Trade Marks Law* (Cm 1203, 1989/90) para 4.42; Craig S Mende and Belinda Isaac, 'When copyright and trademark rights overlap' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 143; Heijo E Ruijsenaars, 'The world of fictional characters: a journey of fantasy' (1993) 4 Ent LR 182, 187; Howard Johnson, 'Legal aspects of character merchandising' (1992) 34 *Managerial Law* 1, 5.

<sup>267</sup> IPO, 'Trade mark forms and fees' <<http://www.ipo.gov.uk/types/tm/t-formsfees.htm>> accessed 27 February 2014; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 94; Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 42.

<sup>268</sup> Trade mark watch and clearance services are offered e.g. by Thomson Reuters CompuMark and Wolters Kluwer Corsearch.

<sup>269</sup> Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 49.

(the date from which the sign will be treated as a registered trade mark once it has actually been registered). Hence, one can see when the IPR came into existence, and in comparison with other marks, which was there first. Under copyright it is not that simple. One could look at the date of first publication, but copyright vests earlier than this, from the time when the work was put down in writing. Even if the author was to remember exactly when that was and was able to prove it, this information would be inaccessible to other authors and the public in general. Hence, the author may maintain that her work was created at an earlier time and that she therefore has an earlier right and even manufacture evidence to support her case.

Another advantage of the trade mark system from the point of view of the public and the third party is that due to the registration of a word/name for only certain goods, the name may under circumstances still be registrable for other goods. For instance, 'Apple' is used for 'The Beatles' record label as well as the computer and electronics company.<sup>270</sup> Consequently, the pool of trademarkable names in relation to goods will not be easily depleted.

### 3.5. Registration of copyright in LFCs?

So far, copyright vests without a formal requirement of registration. However, if LFCs were copyrightable, could authors and their LFCs benefit from a registration service or licensing service? In theory, such services would have the advantage that parties interested in using LFCs would find it easier to know whether a LFC is protected and also whether the author of the LFC is interested in licensing the LFC for reuse. However, are such services practicable? The following services are considered:

- a) a registration service like the one administered by the UK IPO for trade marks<sup>271</sup>

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<sup>270</sup> Ibid 330.

<sup>271</sup> Copyright registration systems exist e.g. in the USA, China, and India. Copyright registration is voluntary in these countries, but has legal advantages. For example, a certificate of copyright registration serves as *prima facie* evidence that the work was created at the registered time and owned by the person registering the work. However, this section of this PhD is considering a registration system like trade mark registration for copyright in LFCs. That means, if such a system was found suitable, it would be up to the author of the LFC to decide whether or not she wanted to apply for copyright registration of her LFCs. Hence, the act of application is voluntary, but without copyright registration of her LFC an

- b) a copyright licensing service such as the Copyright Hub<sup>272</sup> and PLSclear,<sup>273</sup>
- c) public domain registry or public domain calculator.

### 3.5.1. Registration service

One big advantage of the trade mark registration system is that competitors can check whether another business has already registered an identical or similar sign as they intended to use or are using as well already. If LFCs were registered, authors and others wishing to use the LFCs could check who to obtain a licence from, and under a system like the Copyright Hub and PLSclear could also already obtain such a licence.

Another issue with the creation of a LFC copyright registration database (modelled after the IPO trade mark register) would be who would decide whether a LFC was registrable and therefore copyrighted? A likely option would be the IPO as it already administers a registration system for trade marks, patents and designs. However, on the one hand with regard to copyright, it is the judges' responsibility and privilege to

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author could not obtain any copyright protection of a LFC. Whether a system like this is sensible is discussed here.

<sup>272</sup> The Digital Copyright Exchange (DCE), also referred to as the Copyright Hub, was implemented in April 2016 (first 'proof of concept' phase) as a result of a recommendation by Professor Ian Hargreaves in the Hargreaves Review of May 2011. Therein, Professor Hargreaves recommended the creation of a government and industry funded website that makes copyright licensing easier by connecting copyright owners with those who want to use the works. The Copyright Hub covers music, images, videos, multimedia and texts.

For more information on the Copyright Hub, please refer to <http://www.copyrighthub.co.uk/> or Richard Hooper, 'UK's Copyright Hub: a license to create' (April 2016) 2 WIPO Magazine 29-32.

<sup>273</sup> The Copyright Hub is phasing in a link to PLSclear. PLS, 'About the Copyright Hub and our involvement' (2014-2016) <<https://www.pls.org.uk/services/copyright-hub/>> accessed 9 November 2016.

PLSclear is an online permissions contact database provided by the Publishers Licensing Society (PLS). This service enables authors, publishers, editorial teams, rights requisition teams and other users to contact rightholders directly and request copyright permission to use a certain work. In this manner, this service makes seeking copyright permission from authors easier. For one, the copyright owner of a work can be easily identified and directly contacted through PLSclear by a single permissions request form. This online process also guides the potential licensee through a series of questions (typically less than 10), thereby insuring that all essential points are addressed and all necessary information is provided. PLS, 'Frequently Asked Questions – Requestors' (PLSclear, 2016) <<http://www.plsclear.com/Help/Faqs>> accessed 9 November 2016; ALCS, 'PLS Launches PLSclear' (ALCS News, 21 Oct 2014) <<http://www.alcs.co.uk/ALCS-News/2014/October-2014/PLS-further-the-Digital-Copyright-Exchange-with-PL>> accessed 21 October 2014.

Making occasional requests via PLSclear are free. A table with costs for making and receiving requests can be found at <http://www.plsclear.com/Help/Publishers/Costs>. The subscription fee for, e.g. 20 - 39 uses is GBP 99.

decide on copyright matters. On the other hand, trade marks are also registered, and the trade mark examiner who decides on the registration is not a judge, but an administrator at the IPO empowered by the Trade Marks Act (TMA) 1994 s 63. Hence, theoretically, a similar system as the trade marks register could be implemented for LFCs. Registering a LFC would be more difficult though than a trade mark, which is either visual or ‘tangible’ in another way, such as sounds made durable and intelligible by way of stored sound files. If a trade mark is not traditional, such as a word or device mark, the mark can also be described in words in section 7 of form TM3 (Application to register a trade mark). If LFCs per se were registrable as trade marks, the character’s name, personality attributes and physiognomy would then have to be described in the application form. If the trade mark examiner would have to check the accuracy of the LFC by reading the underlying book or books, the application process would be long-winded and costlier than trade mark registration currently is. However, if one followed the example of trade mark registration, then the LFC examiner would not have to check more than the application form. The LFC examiner would not even have to check whether earlier identical or similar LFCs have already been registered. The LFC would be published in a LFC copyright journal (like the trade mark journal) and the public and competitors would have the opportunity and obligation to make oppositions or observations. This would be sort of self-regulatory, but it would not provide true legal certainty that a particular LFC has been comprehensively described or that there has not been an earlier LFC that could rightfully claim infringement. Implementing a copyright registration system for LFCs would involve payment by the author (or publisher) for this service.

On balance, registration of LFCs by themselves would seem excessive.

### **3.5.2. Licensing service**

It would also seem inadvisable for reasons of cost and effort to create a licensing service solely for LFCs. Maybe a combination of existing services might be a solution. The cost involved in using this service is typically absorbed by the publisher. There are still some issues to be solved, though. The authors whose works are listed in PLSclear are commonly the authors whose works have been published by traditional publishing houses. These publishers absorb the cost for the listing of their authors’ works.

However, not all publishers use PLSclear yet or at least are not offering their entire 'literature portfolio' for licensing. For example, the major publishing company HarperCollins is a 'non-participating publisher' according to PLSclear.<sup>274</sup> Small publishers may not even wish to participate due to the cost (or other reasons) or apportion the cost to its authors. Moreover, an author who is self-published would have to come up with the fees for using PLSclear by themselves. These authors are commonly less known and might enjoy PLSclear for free. PLSclear offers a freemium service for authors and publishers who receive less than 20 requests per year. If an author/publisher receives more requests, the annual subscription fee orientates itself on the number of requests per annum.<sup>275</sup> Authors whose publisher is not participating in PLSclear, but who have chosen to participate themselves, may be able to amortise the cost for the request by the licensing fees the authors may receive as a result of using this service.

Another issue is that many authors would often not even know about the existence of PLSclear and the possibilities it opens up to authors.

As LFCs are not copyright protected in the UK yet, PLSclear does not give the option to contact and obtain a licence from the author yet. The only options in the request system by means of which an interested party can contact an author/publisher are text extracts, poems, illustrations/diagrams, tables/charts, or chapters. Among those options, 'text extracts' is the closest to LFCs, but the number of words for which permission is sought has to be provided. As LFCs cannot be defined solely by picking a short verbatim description of its appearance and personality from the text, the options offered in PLSclear do not fit very well. That is why an additional option would have to be added for making a request to license a LFC, if LFC copyrightability were introduced to the UK.

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<sup>274</sup> If one types e.g. the following HarperCollins book titles, 'A hat full of sky', 'Clark the shark', or 'Cocoa beach' in the search bar, the words 'non-participating publisher' are displayed on the PLSclear website. However, one can proceed to request a licence for titles such as 'Ways of grace' and 'Guide to vice and virtue'. This suggests that only part of HarperCollins' portfolio of literary works is open to licensing.

<sup>275</sup> PLS, 'How much does it cost to use PLSclear?' (*PLSclear*, 2016) <<http://www.plsclear.com/Help/Publishers/Costs>> accessed 7 December 2016.

An even bigger issue is that PLSclear is a licensing service. This service would only apply to those works that are copyrighted, but it does not determine whether a work is copyrightable. This is quite a conundrum.

If PLSclear would appoint administrators empowered by the CDPA 1988 to decide which LFCs attract copyright,

- a) similar issues as discussed in the previous section regarding LFC registration modelled after the trade mark system would arise,<sup>276</sup>
- b) a section would have to be inserted into the CDPA 1988 empowering administrators to decide on LFC copyrightability,
- c) a two-classes copyright system would arise, because an administrator would decide about LFC registration and copyrightability whereas this would not be required regarding literary works, such as novels and poems.

Hence, extending PLSclear may not seem feasible, but maybe the above concerns are not as dire as they appear. One should bear in mind, that the process of deciding whether a LFC is copyrightable is similar to deciding whether a text excerpt from a book is copyright protected and requires a licence or whether it is so short and indistinct and does not meet the originality threshold. Both, LFC and text excerpts are smaller parts of a larger work (in cases where the LFC is not a work by itself). Though guidelines exist regarding the percentage of words or passages that may be taken from a work without infringing copyright, these are only guidelines and a court may decide differently, if challenged. Likewise, this thesis sets out guidelines for determining whether a LFC is copyrightable and copying requires a licence. As PLSclear administers requests for reuse of text excerpts, it could administer requests for reuse of LFCs.

If somebody sends a request via PLSclear two things can happen. Either the rightsholder has signed up to PLSclear's automated licence issuing service and the requestor will receive a licence within the hour, or the requestor's request is sent to the rightsholder who will then decide whether or not a licence is required and whether or

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<sup>276</sup> See para 3.5.1.

not to grant a licence to the requestor.<sup>277</sup> The first alternative (automated licensing) would only be operable regarding LFCs, if the system had already been fed the information which LFC the rightsholder or administrator regards as copyrighted. Naturally, the second alternative (direct licence from the rightsholder) also carries the danger that the rightsholder subjectively decides about the LFCs copyrightability and ‘licensability’ pursuing her own interests and thereby diminishing the public domain by requiring licences for all or most of their LFCs. Fortunately, this risk is contained by the courts’ power to review the facts and make a legally binding decision, should a dispute arise between the parties. Courts are authorized and capable of deciding about copyright of excerpts. The same should be the case for LFCs, once LFCs are acknowledged as copyrightable in principle. The Copyright Tribunal specifically is empowered to decide on cases involving licensing bodies.<sup>278</sup> It can even decide on prospective licences.<sup>279</sup> Hence, the actions of PLSclear and the rightsholders licensing their creations via this service can be controlled anytime.

Hence, the above issues a) - c) might be overcome. Therefore, extending PLSclear to license LFCs is a viable procedure.

### 3.5.3. Digital Public Domain Registry or Public Domain Calculator

As PLSclear still has a few gaps (not all LFCs and their underlying works are licensed via this service), a ‘triple safety net’ could be created to support the PLSclear licensing service and bring more legal certainty to content users, such as creators of transformative works. The French Conseil supérieur de la propriété littéraire et artistique (CSPLA)<sup>280</sup> had commissioned Professor Benabou to write a report on transformative works.<sup>281</sup> In this report, Benabou makes a practical proposition – the

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<sup>277</sup> PLS, ‘How PLSclear works?’ (2016) <<http://www.plsclear.com/Help/MakeRequests>> accessed 7 December 2016.

<sup>278</sup> PLSclear is a service run by PLS, which is a licensing body.

<sup>279</sup> CDPA 1988 s 125.

<sup>280</sup> Superior Council for Literary and Artistic Property.

<sup>281</sup> Valérie Laure Benabou, ‘Rapport de la mission du CSPLA sur les “œuvres transformatives”’ (CSPLA, 6 Oct 2014) <<http://www.culturecommunication.gouv.fr/Politiques-ministerielles/Propriete-litteraire-et-artistique/Conseil-superieur-de-la-propriete-litteraire-et-artistique/Travaux/Missions/Mission-du-CSPLA-relative-aux-creations-transformatives>> accessed 8 December 2016. Transformative works include fanfiction.



implementation of a digital public domain registry.<sup>282</sup> If such a database would be created in which all works (and their LFCs), that are in the public domain, are registered, content users could easily choose works registered in this database for the creation of their own works without worrying whether they might be sued over the use of another persons creation or part of it. One may even give authors the option to voluntarily and irreversibly enter their work in the register, divesting themselves of their copyright.<sup>283</sup>

By implementing such a digital public domain registry accessible by the public, and by informing the public about the availability of such a registry, the public domain would become ‘tangible’ for the public. Therefore, (unintentional) illegal appropriation could be avoided more easily.<sup>284</sup> The British Library keeps a record of and stores one copy of each book, periodical and newspaper that is published or distributed in the UK as well as the Republic of Ireland. Consequently, the British Library would be an ideal candidate for providing a digital public domain registry of literary works. The British Library already made available online scans of 1,000,000 digital images of ‘prints, drawings, maps, art works and photographs, as well as illuminated manuscripts, digitised bookbindings and philatelic collections’, which are in the public domain, via its Flickr Commons collection on 12 December 2013.<sup>285</sup> Benabou seems to suggest the same should be done for literary works, meaning literary works in the public domain should be made available to the public in the form of digital image files on an online accessible repository.<sup>286</sup> In principle, Benabou’s idea for the implementation of a public domain registry is promising.

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<sup>282</sup> This should not be confused with the Public Domain Registry, which provides domain registration solutions.

<sup>283</sup> Valérie Laure Benabou, ‘Rapport de la mission du CSPLA sur les “œuvres transformatives”’ (CSPLA, 6 Oct 2014) 69 <<http://www.culturecommunication.gouv.fr/Politiques-ministerielles/Propriete-litteraire-et-artistique/Conseil-superieur-de-la-propriete-litteraire-et-artistique/Travaux/Missions/Mission-du-CSPLA-relative-aux-creations-transformatives>> accessed 8 December 2016.

<sup>284</sup> Illegal appropriation in general could not be avoided entirely, just to an extent. Some people may still want to use another author’s work knowing that it is still in copyright, and others may not use the registry.

<sup>285</sup> British Library, ‘Images’ <<http://labs.bl.uk/Digital+Collections+--+Images>> accessed 8 December 2016; The British Library, ‘Fotostream’ (*Flickr*) <<https://www.flickr.com/photos/britishlibrary>> accessed 8 December 2016; Open Culture, ‘The British Library Puts 1,000,000 Images into the Public Domain, Making Them Free to Reuse & Remix’ (14 Dec 2013) <<http://www.openculture.com/2013/12/british-library-puts-1000000-images-into-public-domain.html>> accessed 8 December 2016.

<sup>286</sup> Valérie Laure Benabou, ‘Rapport de la mission du CSPLA sur les “œuvres transformatives”’ (CSPLA, 6 Oct 2014) 69 <<http://www.culturecommunication.gouv.fr/Politiques-ministerielles/>

However, the digitisation process for such a large enterprise would take years, if not decades, if all the works of which the British Library has stored a physical copy would be digitised. For now, a public domain registry could be served by providing the name of the author and title of each literary work that is in the public domain. One may even add a little description of the content of each item to enable a more detailed keyword search (though that would be rather time-consuming for the British Library). A user/creator could then easily check on the database whether the work the person wishes to reuse is in fact in the public domain or whether further search and a licence via PLSclear and the Copyright Hub might be necessary.

Such a public domain registration system would still not list LFCs explicitly, but at least the public would know that those listed works, in which the LFC appears, are already in the public domain.

Why should the British government, British Library, or licensing bodies go to all this effort of implementing a digital domain registry, if the public could easily calculate by themselves whether or not a work is in the public domain? In this age of the internet, tablets, and smartphones it has become increasingly important to the public that information is available immediately and with little effort. Benabou adds in this regard that the legal questions that professional writers and other professionals deal with regularly pose a complex destabilising issue. For example, amateur creators generating user content are not well-versed in the legal subtleties which are involved in the creation of a work.<sup>287</sup> Therefore, it is important that potential users of content should be able to consult a centralised tool comfortably, i.e. easily and directly, to inform themselves.

These criteria are already satisfied by copyright term calculators, also referred to as public domain calculators. Amateur as well as professional creators will find legal information relating to the creation of literary works, artistic works, music, films, performance on [copyrightuser.org](http://copyrightuser.org). This informative site created by Bournemouth University, CREATE et al is accessible online, free of charge, and is, above all, comprehensible even for those who are unfamiliar with the law and legal language.

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Propriete-litteraire-et-artistique/Conseil-superieur-de-la-propriete-litteraire-et-artistique/Travaux/Missions/Mission-du-CSPLA-relative-aux-creations-transformatives> accessed 8 December 2016.

<sup>287</sup> Ibid.

This Copyright User Portal links to a European Union funded public domain calculator where web users can select jurisdictions of the European Union.<sup>288</sup>

Hence, the costly and time-consuming creation of a public domain registry might be deemed unnecessary. However, a public domain repository instead of a registry or term calculator has the advantage that interested parties could see and read the work in question and draw inspiration from the material in the public domain. That way, the public could search the actual content of the public domain, not just titles and names.

### 3.6. Scope of trade mark protection

The above sections considered the advantages of copyright regarding its purpose, duration and the fact that copyright does not and should not require registration as compared to trade marks. Possible countermeasures to illegal appropriation of LFCs were also considered, i.e. in particular the extension of the licensing service of PLSclear, as this would make it possible for character merchandisers, authors and other consumer's of LFCs to check with some certainty whether a certain LFC requires an interested party to acquire a licence before the LFC can be used.

Not only regarding the objective, formalities and viability above would copyright be more suitable than a trade mark in relation to LFCs. Trade marks are also inadequate for the protection of LFCs with regard to the actual scope of trade mark protection.

Trade mark protection of fictional characters was fraught with problems before the trade mark reform in 1994, and to an extent is still today. Under the TMA 1938 (prior to the currently applicable TMA 1994), it was difficult to register names or images which were the basis of a merchandising programme. For example, the sign 'Tarzan' could not be registered for films and tapes, because it was not an invented word, had a direct reference to the character and quality of the goods, and lacked distinctiveness.<sup>289</sup> The Court of Appeal agreed. The word 'Tarzan' did not suggest the trade origin of the films, meaning the applicants, an American company exclusively entitled to the production

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<sup>288</sup> Ronan Deazley and Bartolomeo Meletti, 'Public domain' (2016) <<http://copyrightuser.org/topics/public-domain/>> accessed 9 December 2016; OutOfCopyright, 'Home' <<http://outofcopyright.eu/>> accessed 9 December 2016.

<sup>289</sup> *Tarzan Trade Mark* [1969] FSR 271 (Chancery Division); [1970] FSR 245 (Court of Appeal); Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 507.

of films, and merchandise based on the fictive character 'Tarzan' (created by Edgar Rice Burroughs). It merely suggested that the film was about the fictional figure and could therefore best be described as a 'Tarzan' film.<sup>290</sup> The registration of the same sign was refused for games, toys, sporting articles, etc., because the goods were centred on the fictitious character 'Tarzan'. It could therefore be presumed that all goods in class 28 were 'intended to portray or relate to the character 'Tarzan' in one way or another'. Hence the word 'Tarzan' referred to the character and quality of the goods. The onus to disprove this direct reference is on the applicant.<sup>291</sup>

Many years later, in 1999, but still under the 1938 Act, the Court of Appeal decided in *Elvis Presley Trade Marks*<sup>292</sup> that the trade mark application regarding the name and signature of the famous deceased Rock 'n' Roll icon for goods in class 3 (toiletries) had been validly opposed. Hence registration was denied. Walker LJ, agreeing with the High Court decision of Laddie J, explained that the sign lacked in the distinctiveness department, since the goods in question were memorabilia of the deceased singer. Buyers of the Elvis Presley merchandise acquire these items, because they bear the name or picture of 'The King', not because these goods come from a certain source.<sup>293</sup> Morritt and Brown LJ added that under the TMA 1938 s 9(1)(b) it was necessary for trade mark registration that the sign could indicate a trade connection between the applicant and the goods, but that there was obviously none between the goods in question and the sign Elvis Presley.<sup>294</sup>

The distinctiveness threshold was not the only issue that merchandisers who sought to register a name or an image of a character had to overcome. In *In re American Greetings Corporation's Application*,<sup>295</sup> the House of Lords confirmed the refusal of registration for the name of the fictional character 'Holly Hobbie' (which coincides with

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<sup>290</sup> *Tarzan Trade Mark* [1970] FSR 245, 248; James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 827.

<sup>291</sup> *Tarzan Trade Mark* [1970] FSR 245, 254; James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 827, fn 14.

<sup>292</sup> *Elvis Presley Trade Marks* [1999] RPC 567.

<sup>293</sup> *Ibid* 585 (Court of Appeal, Walker LJ); *Elvis Presley Trade Marks* [1997] RPC 543, 554 (High Court, Laddie J); James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 827. Other cases in which trade mark registration for a celebrity name in relation to goods/services was denied for lack of distinctiveness include *Linkin Park LLC's Trade Mark Application* [2005] ETMR 17 [179]; *Executrices of the Estate of Diana, Princess of Wales' Application* [2001] ETMR 25 [H10] et seq; *Jane Austen Trade Mark* [2000] RPC 879, 880.

<sup>294</sup> *Elvis Presley Trade Marks* [1999] RPC 567, 592 and 598; James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 827.

<sup>295</sup> *In re American Greetings Corporation's Application* [1984] 1 WLR 189 (House of Lords).

its creator's name) in relation to 12 classes of goods, which were supposed to be exclusively made by the applicant's licensees under registered user agreements. The Registrar and the courts regarded this as inadmissible trafficking in the mark according to TMA 1938 s 28(6).<sup>296</sup>

The TMA 1938 was repealed on 31 October 1994 and the new TMA 1994 came into force. It is easier to register a trade mark under the new system. For example, instead of putting the onus on the applicant to justify registration, it is now the trade mark examiner's obligation to find a reason based on which the application fails and registration must be denied. Furthermore, facilitating trafficking of marks is no longer a reason for refusal of registration.<sup>297</sup> Trade marks may now be treated as commodities and licensing of trade marks is now permitted by TMA 1994 ss 28 - 31.<sup>298</sup> Even so, registration of a trade mark in relation to a fictional character is still problematic. Many of the old issues prevail. The 'new' (current) Trade Marks Act 1994 is still no 'sound basis ... for protecting a merchandising mark as a registered trade mark.'<sup>299</sup> This is substantiated in sections 3.6.2. – to 3.6.4.

### 3.6.1. Character names

Trade marks have one big advantage over copyright when it comes to fictional characters. Trade mark law accepts the registration of word marks. That includes signs of a single word.<sup>300</sup>

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<sup>296</sup> *In re American Greetings Corporation's Application* [1983] 1 WLR 269 (Chancery Division); [1983] 1 WLR 912 (Court of Appeal); [1984] 1 WLR 189 (House of Lords); James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 828; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 189.

<sup>297</sup> Department of Trade and Industry, *Reform of Trade Marks Law* (Cm 1203, 1989/90) para 4.40; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 658.

<sup>298</sup> Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 191.

<sup>299</sup> Peter Jaffey, 'Merchandising and the law of trade marks' (1998) 3 IPQ 240, 262.

<sup>300</sup> TMA 1994 s 1(1); Glen Gibbons, *Trade Marks Law* (2<sup>nd</sup> edn, Clarus Press 2016) 100 et seq; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 54; Craig S Mende and Belinda Isaac, 'When copyright and trademark rights overlap' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 144; Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1679; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 456.

Copyright, by contrast, does not protect names of characters.<sup>301</sup> Copyright protection has been explicitly denied to the names ‘James Bond’ and ‘Kojak’ (70s NYPD Detective Lieutenant).<sup>302</sup> Copyright does not even attach to a combination of a few words in most cases,<sup>303</sup> and especially not single words.<sup>304</sup> This flows from the *de minimis* principle, which separates those works that may be copyrighted from those that are not. The only way for names of characters as such to receive copyright protection would be if the name qualified as a literary work. Adams argues that a name fails to ‘provide information, instruction or pleasure in the form of literary enjoyment’, and therefore is

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<sup>301</sup> *Taverner Rutledge v Trexapalm* [1975] FSR 479, 486; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 567; William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 682; David Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 889; Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1687; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 13 et seq; Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 504; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 229 and 440; Jan Klink, ‘50 years of publicity rights in the United States and the never ending hassle with intellectual property and personality rights in Europe’ (2003) 4 IPQ 363, 373; Reuben Stone, ‘Copyright protection for titles, character names and catch-phrases in the film and television industry’ (1996) 5 Ent LR 178, 182; Howard Johnson, ‘Legal aspects of character merchandising’ (1992) 34 Managerial Law 1, 6.

<sup>302</sup> *O’Neill v Paramount Pictures Corp*n [1983] Court of Appeal Transcript 235; *Taverner Rutledge v Trexapalm* [1977] RPC 275, 278 et seq; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 229.

<sup>303</sup> Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 567; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 53 and 57; Estelle Derclaye and Matthias Leistner, *Intellectual Property Overlaps – A European perspective* (Hart Publishing 2011) 201.

It was held in *Sinanide v La Maison Kosmeo* (1928) 139 LT 365 that a quotation of a bit of an advertising slogan (i.e. a part of a literary work) was too insignificant to form the subject matter of copyright infringement. Further, the song title ‘The man who broke the bank at Monte Carlo’ was ‘too unsubstantial’ to attract copyright. *Francis Day & Hunter Ltd v Twentieth Century Fox Corporation Ltd* [1940] AC 112, 113, 122 et seq.

However, there are also some cases where a few words making up a title/newspaper heading are sufficient for copyright purposes, because sufficient skill and labour had been invested in their creation. *Newspaper Licensing Agency Ltd v Meltwater Holdings BV* [2011] EWCA Civ 890 [H11] and [H19]; *Shetland Times Ltd v Dr Jonathan Wills* [1997] FSR 604, 605, 609; JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 299; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 53.

<sup>304</sup> *Hitachi Ltd v Zafar Auto & Filter House* [1997] FSR 50 (‘Hitachi’); *Exxon Corporation v Exxon Insurance Consultants International Ltd* [1981] 3 All ER 241 (‘EXXON’); Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 666; Estelle Derclaye and Matthias Leistner, *Intellectual Property Overlaps – A European perspective* (Hart Publishing 2011) 201; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 110. However, in *IPC Magazines Ltd v MGN Ltd* [1998] FSR 431, 438 the court conceded that copyright subsisted in the word ‘Woman’ (written in white on a red background) as part of a masterhead of a magazine. This was contemplated, though, as artistic and not literary copyright, which means that the merit was not actually in the word ‘Woman’, but in the layout.

not a literary work.<sup>305</sup> The question what a work, and in particular what a literary work is, will be discussed in chapter 8.

Although trade marks have an advantage over copyright when it comes to protection of a character's name, trade marks are, nevertheless, not the Holy Grail for the protection of LFC names for the reasons elaborated on in the following sections on the origin function as well as absolute and relative grounds for refusal of trade mark registration.

### 3.6.2. Origin function

One of the main criteria for a trade mark is that a sign must be capable of distinguishing goods or services of one company from those of another company.<sup>306</sup> This criterion arises from the origin function of trade marks.<sup>307</sup> As mentioned at the beginning of this chapter, trade marks function as badges of origin. Hence, if a sign is e.g. non-distinctive and therefore does not denote the undertaking that takes responsibility for the product or service marketed under that sign, it is not eligible for trade mark registration.<sup>308</sup> A sign is non-distinctive, for instance, if it is descriptive. The name of a character identifies the character itself, but does not automatically serve as an identification of the source of the product to which the name is applied.<sup>309</sup> A character's name may

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<sup>305</sup> John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 14; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 79; *Exxon Corp v Exxon Insurance Consultants International Ltd* [1982] Ch 119, 143.

<sup>306</sup> TMA 1994 s 1(1); Case C-245/02 *Anheuser-Busch Inc v Budejovicky Budvar* [2004] ECR I-10989, para 68; Glen Gibbons, *Trade Marks Law* (2<sup>nd</sup> edn, Clarus Press 2016) 99.

<sup>307</sup> Case C-245/02 *Anheuser-Busch Inc v Budejovicky Budvar* [2004] ECR I-10989, para 69; Case C-40/01 *Ansul BV and Ajax Brandbeveiliging BV (Minimax)* [2003] ECR I-2439, para 36; Case C-206/01 *Arsenal Football Club plc v Reed* [2002] ECR I-10273, paras 47 et seq; Joined Cases C-53/01 to C-55 *Linde AG, Windward Industries Inc and Rado Uhren AG* [2003] ECR I-3161, para 40; Case C-299/99 *Koninklijke Philips Electronics NV gegen Remington Consumer Products Ltd* [2002] ECR I-5475, para 35; Joined Case C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* [1999] ECR I-2779, para 46; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 7 et seq and 13 et seqq.

<sup>308</sup> See para 3.2.

<sup>309</sup> Heijo E Ruijsenaars, 'The world of fictional characters: a journey of fantasy' (1993) 4 Ent LR 182, 186.

therefore not be trademarked, if it is no indication of origin and is devoid of distinctiveness.<sup>310</sup>

Under these circumstances, it can be used by anyone without fear of being sued. The next two cases illustrate the origin function of trade marks in relation to LFCs further.

### 3.6.2.1. *Animated Music Ltd's Trade Mark*<sup>311</sup>

In *Animated Music Ltd's Trade Mark*, the claimant, Dash Music succeeded against Animated Music and had the trade mark 'Nellie the Elephant' removed from the trade mark register. 'Nellie the Elephant' is a children's song, the copyright of which is owned by Dash Music. The defendant, Animated Music, acquired a licence to use 'Nellie' as the main character in a cartoon series featuring a female pink elephant named 'Nellie'. Animated then registered the trade mark 'Nellie the Elephant' for various services in class 41 (Education and Entertainment Services). Dash Music sought the revocation of this trade mark claiming that Animated Music was not making trade mark use of 'Nellie the Elephant'.<sup>312</sup>

The Registry held that Animated Music did not provide any evidence that 'Nellie the Elephant' indicated the trade origin of any of the services for which the mark had been registered. On the contrary, anyone who wished to use Animated Music's film production and other services for which the mark was registered would likely do so by reference to the name Animated Music, and not 'Nellie the Elephant'. 'Nellie the Elephant' merely indicated the content of the cartoon, and not the source of the content (the production company Animated Music) behind it.<sup>313</sup> The Trade Marks Act 1994

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<sup>310</sup> Estelle Derclaye and Matthias Leistner, *Intellectual Property Overlaps – A European perspective* (Hart Publishing 2011) 201; *Elvis Presley Trade Marks* [1999] RPC 567, 596; Vitoria M et al, *Laddie, Prescott and Vitoria - The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1678.

<sup>311</sup> *Animated Music Ltd's Trade Mark, Application for Revocation by Dash Music Co Ltd* [2004] ETMR 79.

<sup>312</sup> *Ibid* [H2].

<sup>313</sup> *Ibid* [21] - [24]. The same argument was applied in *R v Johnstone* [2004] ETMR 2 [H3] and [H12] where Lord Nicholls of Birkenhead maintained that the defendant had not made use of the trade mark 'Bon Jovi' by printing it onto counterfeit CDs, rather the defendant had used the name of the artist to describe the contents of the CD, i.e. that the CD contained music by the band 'Bon Jovi', instead of indicating the trade origin of the CD. Also in agreement: *Jane Austen Trade Mark* [2000] RPC 879, 886.



merely restricts the use of a trade mark as a trade mark, and not the use of a trade mark in a descriptive sense, because such use does not affect the trade mark with regard to its functions.<sup>314</sup>

### 3.6.2.2. *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others*<sup>315</sup>

It was decided in *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others*, that the words ‘Betty Boop’ satisfied the origin function. Birss J held that the average consumer had been educated by the claimants/proprietors of the mark and their agent to regard the words ‘Betty Boop’ and the character image as trade marks, and also to believe all ‘Betty Boop’ merchandise came from a single official source - the claimants.<sup>316</sup> The sign ‘Betty Boop’ was used in different poses, but only a device mark showing her in one pose is registered. Nevertheless, the court held that ‘Betty Boop’ (word and image) designated trade origin regardless of the different poses of the character, because it was ‘Betty Boop’ herself that is recognized by the typical consumer. Mainly due to her very distinct head, the character is recognizable in a myriad of poses other than the one in the registered device.<sup>317</sup> Over the decades, the words ‘Betty Boop’ were used in combination with the device of ‘Betty Boop’ showing her in different poses, so that now ‘Betty Boop’ is recognized as manifestly ‘Betty Boop’ regardless of her pose and without the words written below the device.<sup>318</sup>

Hence, in the end, it comes down to whether the public has been educated by the user of the fictional character to regard the character as an indication of trade origin. This and other aspects from the ‘Betty Boop’ case will be further illuminated later in this chapter as this case is relevant for different aspects of trade mark law.

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Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 648 and 743.

<sup>314</sup> Case C-487/07 *L’Oréal SA v Bellure NV* [2009] ECR I-5185, para 61; *R v Johnstone* [2004] ETMR 2 [13]; Case C-206/01 *Arsenal Football Club plc v Reed* [2002] ECR I-10273, para 54; James Mellor et al, *Kerly’s law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 447 et seq.

<sup>315</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch).

<sup>316</sup> *Ibid* [97] et seq and [104]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 587 et seqq; Nick Aries, ‘Lifeline for leading lights?’ (July/August 2014) ITMA Review 10.

<sup>317</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [101]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 587.

<sup>318</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [151] and [160].

### 3.6.3. Absolute grounds for refusal of trade mark registration

Apart from the above requirements needed for a sign to qualify as a trade mark, an application for a trade mark registration may also fail because of one or more of the absolute grounds for refusal laid down in TMA 1994 s 3. In particular s 3(1)(b) and (c) apply as the critical evaluation of mostly character and celebrity merchandising cases in the following sections up to and including 3.6.3.2.2.3. shows. That means, if a trade mark is devoid of distinctive character (s 3(1)(b)), or if the sign designates e.g. the kind and intended purpose of the goods (s 3(1)(c)), the sign shall not be registered as a trade mark.

#### 3.6.3.1. Decorative use

Among the most common arguments raised against the use of a name (or image) of a character as a sign in relation to goods/services is the argument that the use does not amount to trade mark use. That can have many reasons. It had already been stated in the White Paper of 1990 on the reform of trade mark law that character merchandising was not a trade mark matter, because the fictional characters and their names were not trade marks, nor were they used as such. They merely served the purpose of enhancing the eye appeal of the goods.<sup>319</sup> According to the IPO's Trade Marks Manual, use of a fictional character (name or image of an AFC or LFC given shape after the description of the character in the book) on products, for instance bubble bath, toothbrushes and toothpaste, mugs, and clothing in a decorative way, may be seen by the trade mark examiner as exclusively for the purpose of attracting customers, a simple marketing gimmick, and not trade mark use.<sup>320</sup> Hence, the White Paper stated

<sup>319</sup> Department of Trade and Industry, *Reform of Trade Marks Law* (Cm 1203, 1989/90) para 4.42.

<sup>320</sup> IPO, 'Trade Marks Manual' (2016) 128 <[https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/560039/Manual-of-trade-marks-practice.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/560039/Manual-of-trade-marks-practice.pdf)> accessed 16 Dec 2016; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 59 and 67. Jaffey agrees in Peter Jaffey, 'Merchandising and the law of trade marks' (1998) 3 IPQ 240 and 244.

further that character merchandising is a matter that should concern copyright rather than trade mark protection.<sup>321</sup>

The IPO takes a more moderate approach. It states in the Trade Marks Manual that objection to trade mark registration can be based on TMA 1994 s 3(1)(b) and (c), if the character is used ‘purely for the purpose of attracting potential customers, rather than trade mark use.’<sup>322</sup> That leaves room for instances in which the use of a name (or image) of a fictional character may amount to trade mark use, even if the character is used also, but not solely for customer attraction. The CJEU expounded in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd*<sup>323</sup> that the fact that a sign is regarded by the public as an embellishment is not an obstacle to trade mark protection against a similar sign, as long as the relevant public makes a mental link between the decorative matter (name) and the trade mark (word mark). Purely decorative use of a sign, however, is permitted and may not be restricted by a trade mark, because the public does not make a link between the sign used as decoration and the registered trade mark of another undertaking.<sup>324</sup>

Birss J agreed in *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others*.<sup>325</sup> He, too, declared that the average consumer’s response is multi-faceted. The average consumer will view the name (or image) of the fictional character as attractive and aesthetic. Naturally, the consumer will generally not wish to buy an item that does not look good. Furthermore, the average consumer will also associate the sign with the character generated by the claimants.<sup>326</sup> That meant, that ‘Betty Boop’ is not purely decorative. He added that the average consumer would recognize it as merchandising and take the presence of ‘Betty Boop’ as an indication that the product was licensed from a source of merchandising licences associated with that character. Therefore, the average consumer would regard the presence of ‘Betty Boop’ on the product as having

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<sup>321</sup> Department of Trade and Industry, *Reform of Trade Marks Law* (Cm 1203, 1989/90) para 4.42; Howard Johnson, ‘Legal aspects of character merchandising’ (1992) 34 *Managerial Law* 1, 5.

<sup>322</sup> IPO, ‘Trade Marks Manual’ (2016) 128 <[https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/560039/Manual-of-trade-marks-practice.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/560039/Manual-of-trade-marks-practice.pdf)> accessed 16 Dec 2016.

<sup>323</sup> Case C-408/01 *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* [2003] ECR I-12537, paras 38 - 41.

<sup>324</sup> *Ibid*; Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 510; James Mellor et al, *Kerly’s law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 833.

<sup>325</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [166] et seq.

<sup>326</sup> *Ibid* [110].

origin significance.<sup>327</sup> However, this is a result of educating the public, instead of making a general assumption.

Simply the fact that a character appears in a book, a video, or is an item of decoration on stationery does not indicate that the character is used as or will be perceived as a trade mark by the relevant public. It was maintained in *Francis Fitzpatrick v Disney Enterprises*<sup>328</sup> that the use of a fictional character such as 'Winnie-the-Pooh' is in relation to their appearance in the book. Characters are well-known as characters, and not as a trade mark. The case would be different if the fictional character was to be used for goods/services that do not relate to the character. Then it could be more reasonably argued that the name of a fictive character is chiefly used as a trade mark. For one thing, there would be no danger that the character would be regarded by the public as indicating the content instead of the trade mark proprietor, unlike in cases where the character is registered for goods/services relating to the character, as the public is used to distinguishing, for example, between the publisher and a publication.

As a consequence, names of fictional characters, AFCs, and visual representations of LFCs may be registered as trade marks and therefore may receive protection against use by others. However, the characters' names must be used in a way that they are regarded by the public as trade marks indicating the origin of the product instead of as merely characters, titles, or items of decoration.<sup>329</sup> Otherwise, trade marks could not be registered for characters' names. The public does not even have to regard the character as purely decorative in order for a trade mark application for a character's name to fail. A trade mark examiner at the IPO would already refuse registration of a trade mark for a character's name, if the examiner believes that the relevant public purchasing the item bearing a famous character name is indifferent as to who manufactures and supplies the item and who is responsible for it.

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<sup>327</sup> Ibid [158] and [168].

<sup>328</sup> *Francis Fitzpatrick v Disney Enterprises* No 951/2001 is an unreported case. However, part of the transcript is available in *Animated Music Ltd's Trade Mark, Application for Revocation by Dash Music Co Ltd* [2004] ETMR 79 [18].

<sup>329</sup> James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 830.

### 3.6.3.2. *Linkin Park LLC's Application*

The 2005 and 2006 decisions in *Linkin Park LLC's Application* for a trade mark are particularly good examples for the issues which the name of a fictional character faces under trade mark law. Though the decisions concern the American band *Linkin Park*, and not fictional characters, the issues described below are the same.

#### 3.6.3.2.1. **The hearing officer's decision (2005)**<sup>330</sup>

The UK Trade Mark Registry refused *Linkin Park LLC's* application for registration of the words 'Linkin Park' as a trade mark in class 16 (posters). The application failed on two grounds.

The application did not comply with the requirements of TMA 1994 s 3(1)(b) and (c).<sup>331</sup> The mark was devoid of distinctive character and also designated the kind and intended purpose of the goods.

The IPO explains in its *Trade Marks Manual* that, whether or not a famous name can be registered as a trade mark, depends on the types of goods and also on whether or not the name is descriptive in relation to these. For the reason that the use of a famous name for books, CDs, DVDs, TV programmes, performances, etc. implies control to at least some degree by the celebrity or originator and/or copyright holder the famous name may be registered for these goods by that person.<sup>332</sup>

Where a famous name is used as a badge of allegiance, e.g. on T-shirts, mugs, and scarves (typical merchandise) the celebrity may register a trade mark for such goods, even though the likelihood that other manufacturers also produce (unofficial) merchandise cannot be ruled out. Trade mark application for a famous name in relation

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<sup>330</sup> *Linkin Park LLC's Trade Mark Application* [2005] ETMR 17.

<sup>331</sup> *Ibid* [176].

<sup>332</sup> IPO, 'Trade Marks Manual' (2016) 125 <[https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/560039/Manual-of-trade-marks-practice.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/560039/Manual-of-trade-marks-practice.pdf)> accessed 16 Dec 2016. See also: Case T-623/11 *Pico Food GmbH v OHIM* (CJEU (Second Chamber) 9 April 2014) para 30; *Linkin Park LLC's Application* [2006] ETMR 74 [34].

to these types of goods will therefore generally be accepted unless there is reason to believe that this name is unable to fulfil the origin function of a trade mark.<sup>333</sup>

However, in case of mere image carriers such as posters, photos and figurines (also typical merchandise) the celebrity's name will probably be viewed as referring to the subject matter of these goods. Hence objections against registration would usually be made based on TMA 1994 s 3(1)(b) and (c).<sup>334</sup> That was indeed the case in Linkin Park LLC's Trade Mark Application.<sup>335</sup>

### 3.6.3.2.2. The appeal (2006)<sup>336</sup>

'Linkin Park' appealed the hearing officer's decision. The appeal was dismissed.<sup>337</sup> The Lord Chancellor's Appointed Person agreed with the hearing officer's decision.

#### 3.6.3.2.2.1. Invented word

The applicant's first contention was that the sign 'Linkin Park' was invented by the band. As an invented phrase, it was without any meaning, and could therefore not be descriptive. In principle, apart from fancy devices, invented words are the most distinctive signs. Moreover, it is also correct that the sign 'Linkin Park' was not a dictionary term. It is not a prerequisite, though, that a word is a dictionary term in order for TMA 1994 s 3(1)(c) to apply.<sup>338</sup> The applicant's argument is flawed, because the decisive time when the meaning of words is evaluated as to their compliance with TMA 1994 s 3 is the date of application for trade mark registration.<sup>339</sup> The phrase 'Linkin Park' was indeed meaningless at the time when it was coined, but at the time of

<sup>333</sup> IPO, 'Trade Marks Manual' (2016) 125 <[https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/560039/Manual-of-trade-marks-practice.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/560039/Manual-of-trade-marks-practice.pdf)> accessed 16 Dec 2016.

<sup>334</sup> Ibid 125; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 659 et seq; Tina Hart, Simon Clark and Linda Fazzani, *Intellectual Property Law* (6<sup>th</sup> edn, palgrave macmillan 2013) 142; Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 507 et seq.

<sup>335</sup> *Linkin Park LLC's Trade Mark Application* [2005] ETMR 17 [178] et seq.

<sup>336</sup> *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74.

<sup>337</sup> Ibid.

<sup>338</sup> Ibid [42]; Case C-191/01 P *OHIM v Wrigley* (Doublemint) [2003] ECR I-12447, para 32.

<sup>339</sup> *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74 [33]; Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619, para 32; *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513, 532; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 580.

application 'Linkin Park' denoted the band, and was therefore descriptive.<sup>340</sup> The same applied to 'Tarzan'. Although cases that were decided under the repealed TMA 1938 are not authoritative anymore, they may on occasion help explain current practices.<sup>341</sup> When ER Burroughs wrote the first 'Tarzan' adventure story, he invented the word 'Tarzan'. By the time the application for trade mark registration was filed, the word 'Tarzan' was so well established in the minds of the public that it had become a household word.<sup>342</sup>

This has a detrimental effect for performers as well as authors etc. They would have better chances registering their band name or the name of a fictional character as a trade mark at a time when they have just created the name or when they are still unknown than later when they have become famous.<sup>343</sup> However, this was not regarded as a paradox by Arnold QC in 'Linkin Park',<sup>344</sup> because

- a) there was no evidence either at the time of application for a trade mark nor at a later point in time that the band was well known for trading in posters. If they had been able to give such proof, then their trade mark application could have been accepted on that basis.
- b) a sign may be distinctive in one class of goods/services, but at the same time may be descriptive for other goods/services.<sup>345</sup>

This makes it difficult for authors, artists, musicians, etc. to protect words (names) created by them, because when they are still at the beginning of their fame, if they will ever achieve that state, they are also financially less well off than once their works sell well. Even if they did register a trade mark or even create an advance portfolio of several registered trade marks of various characters from one work, the next problem

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<sup>340</sup> *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74 [H7].

<sup>341</sup> *Jane Austen Trade Mark* [2000] RPC 879, 884; *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74 [7].

<sup>342</sup> *Tarzan Trade Mark* [1970] FSR 245, 247; *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74 [9]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 580; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 457.

<sup>343</sup> *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74 [43]; Tina Hart, Simon Clark and Linda Fazzani, *Intellectual Property Law* (6<sup>th</sup> edn, palgrave macmillan 2013) 142; James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 833; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 66.

<sup>344</sup> *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74.

<sup>345</sup> *Ibid* [43]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 585.

would be that they have to make use of the mark, otherwise it can eventually (after five consecutive years of non-use) be revoked according to TMA 1994 s 46(1)(a). That means the author or band would have to trade in all those kinds of goods for which the mark was registered.<sup>346</sup> Certainly, this is not financially viable for the creator at that time. However, even after becoming famous, it is hard to imagine that an author would personally manufacture and sell all imaginable merchandise and other goods (and provide services) under that mark. They might, after registration, try to license the use of the character names registered in relation to certain goods/services, but which company would be interested to produce merchandise of unknown characters? Third party character merchandisers would usually only seek to register and exploit fictional characters that are commercially attractive, and not minor or unknown characters.<sup>347</sup> Hence, at a cursory glance, it seems that the legal and financial disadvantage of authors where LFCs are concerned is negligible, but this is only at the outset, when it is unknown which characters will become popular and commercially valuable for manufacturing. The situation changes drastically once a character has become famous. Protection for LFCs should be feasible before raptors (companies with the necessary financial backing) can seize their prey (LFC created by another).

Moreover, if on the other hand a name has not become a household word and is distinctive at a later time after all so that a trade mark is registered for it, the scope of protection may be more limited than it would be for a less distinctive name.<sup>348</sup> The Picasso estate opposed the registration of the sign Picaro for motor vehicles. They argued that the greater the distinctive character of a sign, be it per se or due to its reputation within the market, the broader the protection.<sup>349</sup> The opposition proceedings and appeals to OHIM as well as the subsequent appeals to the Court of First Instance and the Court of Justice failed. Both the Court of First Instance as well as the Court of Justice held that the appellant could not rely on settled case-law that states that the greater the distinctive character of a sign, either per se or because of its reputation,

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<sup>346</sup> Jon Holyoak, 'United Kingdom character rights and merchandising rights today' (1993) JBL 444, 449.

<sup>347</sup> John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 66.

<sup>348</sup> James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 833; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 660.

<sup>349</sup> Case C-251/95 *SABEL BV v Puma AG, Rudolf Dassler Sport* [1997] ECR I-6191, para 24; Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, para 18; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, para 20.



the broader the protection. The reason was that the sign 'Picasso' itself was merely well-known as the name of the Spanish painter Pablo Picasso. The mark 'Picasso' was devoid of a highly distinctive character in relation to motor vehicles. Picasso's renown for painting was incapable of increasing the likelihood of confusion with the sign 'Picaro' for cars.<sup>350</sup> On the contrary, the distinctive character inherent in the sign 'Picasso' (for paintings) is at such a high level that any discernible variation is prone to eliminate any likelihood of confusion by the relevant consumers. In the abstract this means, the more a name is known to the public, the narrower the scope of trade mark protection might be against similar signs.<sup>351</sup>

### 3.6.3.2.2. Characteristics

The appellant's second contention was that the words 'Linkin Park' do not refer to characteristics of the goods.<sup>352</sup> The appellant maintained that it should not be distinguished between mere image carriers and other goods such as media.

Arnold QC propounded that a customer coming to a store seeking to buy a poster depicting the band 'Linkin Park' would ask for a 'Linkin Park' poster. There is no better or alternative way to describe a poster bearing the image of the band 'Linkin Park' than as a 'Linkin Park' poster or a poster of 'Linkin Park'. The formulation is always descriptive. The creator of those posters could not sell any of these unless he used the sign 'Linkin Park'.<sup>353</sup> That is the crux. If the band's own creation (their name 'Linkin Park') was protected, then no non-licensed company could sell merchandise such as posters showing the band. Protection of two words (an invented name) by copyright would currently fail the *de minimis* threshold, but without any protection of a creation

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<sup>350</sup> Case T-185/02 *Claude Ruiz-Picasso and Others v OHIM* (CFI (Second Chamber) 22 June 2004) paras 61 and 65; Case C-361/04 P *Claude Ruiz-Picasso and Others v OHIM and DaimlerChrysler* [2006] ECR I-643, paras H8, 32, 33.

<sup>351</sup> James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 833; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (7<sup>th</sup> edn, OUP 2013) 665 et seq.

<sup>352</sup> *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74 [44].

<sup>353</sup> *Ibid* [46] - [49]; *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [69]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 586 et seq.

as small as this, others will always be able to ride on somebody else's coat-tails of fame.

### 3.6.3.2.2.3. Nature of the goods and the Registrar's practise

The appellant's second and third contention overlap. The appellant had argued that the Registrar wrongly distinguished between image carriers and other goods. Behind this contention lies the appellant's attorney's argument that performers should have a general right to stop unauthorized, non-licensed use of their names in relation to any goods or services. However, this is impossible under current trade mark law not least due to the origin function discussed already.

The Registrar's representative (respondent) put forward the argument that the consumers' expectation that the goods were authorized or endorsed by the persons whose work was subject matter of the goods depended on a crucial factor - the nature of the goods. Consumers were less likely to think that posters had been licensed by the performer depicted on them than in the case of books and CDs. Even so, this did not mean that one should strictly distinguish between media (books, CDs) and mere image carriers (posters). It was held in *Bravado Merchandising Services Ltd v Mainstream Publishing (Edinburgh) Ltd* that the use of the name of the band 'Wet Wet Wet' by an unlicensed author as part of a title for an unauthorized biography of that band did not infringe the bands/proprietor's trade mark according to TMA 1994 s 11(1)(b).<sup>354</sup>

The appellant's attorney in the 'Linkin Park' case argued that the relevant consumers of merchandise relating to 'Linkin Park' would expect products bearing the name of 'Linkin Park' (that includes posters) to have been licensed by the band. Arnold QC, doubted whether this assertion was correct. There was no evidence that the average consumer's perception was as contended.<sup>355</sup> On the contrary, Arnold QC maintained, the typical consumers of posters portraying 'Linkin Park' are young men, who have knowledge about the band and current popular music, but are 'otherwise of no

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<sup>354</sup> *Bravado Merchandising Services Ltd v Mainstream Publishing (Edinburgh) Ltd* [1996] SLT 597, 598; *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74 [65]; Peter Jaffey, 'Merchandising and the law of trade marks' (1998) 3 IPQ 240, 259.

<sup>355</sup> *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74 [66] et seq.

particular sophistication.<sup>356</sup> Some family members or friends would occasionally buy these posters as presents, too. The goods itself are relatively inexpensive, everyday items that are bought over a shop counter. Hence, the buyer would not make the purchase with any special degree of care unlike when buying a car, which commonly involves close inspection, detailed brochures, test drive, and discussions with the salesperson.<sup>357</sup> What Arnold QC meant by this was that the buyer of the posters will most likely not give any thought as to whether these goods have or have not been licensed by 'Linkin Park'.

Laddie J had stated the same in *Elvis Presley Trade Marks*.<sup>358</sup> He remarked that consumers purchase a toy of a famous fictional character because it depicts that character, not because it comes from one particular 'genuine' source.<sup>359</sup> He continued that he had 'no reason to believe that they [the customers] care one way or the other who made, sold or licensed it.'<sup>360</sup> That means, this decision refused to accept that the public may be aware of merchandising activities and expect the products to be sold under licence of the celebrity or creator of the character.

Laddie J had accorded very little knowledge and consciousness of character merchandising to the public.<sup>361</sup> On appeal, Brown LJ stated that at least there should not be an *a priori* assumption of a general right to exploitation of a character exclusively enjoyable by the famous person or author of a character. 'Monopolies should not be so readily created.'<sup>362</sup> Hence, any such presumption that products bearing the name of a fictional character were licensed by the author of the character must be proven by evidence with respect to the facts of the individual case.

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<sup>356</sup> Ibid [H6].

<sup>357</sup> Ibid [38]; *Lancer Trade Mark* [1987] RPC 303, 325.

<sup>358</sup> *Elvis Presley Trade Marks* [1997] RPC 543, 554.

<sup>359</sup> Genuine source meant the famous person or her estate or the originator or successor of a fictitious character. Ibid 553.

<sup>360</sup> Ibid 554. This view that character merchandise often involves the use of a character in a way that is not indicative of the goods' origin is also expressed in Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1678. Instead of regarding the name or likeness of a character on a product as 'an assurance of trade origin', the buyer is indifferent to the origin of the goods and may, for example, just wish to wear a piece of clothing with the character's name or image for fashion reasons or 'other capricious cause'.

<sup>361</sup> *Elvis Presley Trade Marks* [1997] RPC 543, 554.

<sup>362</sup> *Elvis Presley Trade Marks* [1999] RPC 567, 598; Charlotte Waelde et al, *Contemporary Intellectual Property Law and Policy* (4<sup>th</sup> edn, OUP 2016) 849; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 660.

Birss J concurred in *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others*. He maintained that the average consumer in the ‘Betty Boop’ case needed to be and actually had been educated by the claimants/proprietors of the mark and their agent to regard the words ‘Betty Boop’ and the character image as trade marks, and also to believe all ‘Betty Boop’ merchandise came from a single official source, the claimants.<sup>363</sup> He went so far to state that over the decades the words ‘Betty Boop’ were used in combination with the device of ‘Betty Boop’ showing her in different poses, so that now ‘Betty Boop’ is recognized as manifestly ‘Betty Boop’ regardless of her pose and without the words written below the device.<sup>364</sup>

### 3.6.4. Relative grounds for refusal of trade mark registration and infringement

In addition to the issues arising from the absolute grounds for refusal of trade mark registration, authors of LFCs are also affected by the relative grounds for refusal of trade mark registration. However, with regard to the relative grounds it is not quite so clear whether trade mark law or copyright offers more appropriate protection as is highlighted by aid of the three following judgments.

#### 3.6.4.1. *Interlego AG v Tyco Industries Inc*<sup>365</sup>

Mende and Isaac advocate that trade marks are stronger than other IPRs. Their reason for this statement is that trade marks enable their proprietor to prevent the use of non-exact copies of the trade mark.<sup>366</sup> It is correct that the owner of a trade mark may prevent others who wish to use or are using a later sign similar to the earlier trade mark from doing so.<sup>367</sup> However, a copyright proprietor is also protected against copycats from works that are similar, even those works that are different for the most part, as

<sup>363</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [97] et seq and [104]; Nick Aries, ‘Lifeline for leading lights?’ (July/August 2014) ITMA Review 10.

<sup>364</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [151] and [160].

<sup>365</sup> *Interlego AG v Tyco Industries Inc* [1989] 1 AC 217.

<sup>366</sup> Craig S Mende and Belinda Isaac, ‘When copyright and trademark rights overlap’ in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 143.

<sup>367</sup> TMA 1994 ss 5 and 10; Isabel Davies and the Eversheds Intellectual Property Group, ‘United Kingdom’ in Isabel M Davies (ed), *Sweet & Maxwell’s European trade mark litigation handbook* (Sweet & Maxwell 1998) 572.

long as a substantial part of the original is copied.<sup>368</sup> This is also supported by the fact that a small modification of an existing copyright work does not result in new copyright in the altered work, as the modified version is at the same time a substantial reproduction of the original.<sup>369</sup> This has been confirmed in *Interlego AG v Tyco Industries Inc*, where independent copyright protection for the modifications to the existing drawing of a Lego brick was denied, although the alterations were technically significant. The rationale behind this is the prevention of indefinite copyright. If the act of making only slight changes to a copyright work, warranted independent copyright in the altered copyright work, then copyright would persist infinitely in what is essentially the same work.<sup>370</sup> Originality requires more than the draughtsmanship to redraw an artistic work.<sup>371</sup>

Hence, in reality, trade marks do not have an advantage over copyright with regard to what is said to be trade marks' forte – that is according to Mende and Isaac that trade marks enable their proprietor to prevent the use of non-exact copies of the trade mark. However, since there is no copyright protection of LFCs independent from the work they feature in, and trade mark law at least partly protects LFCs, trade marks have a head start. If, on the other hand, copyright law was applied to LFCs, then trade marks would not have an advantage over copyright in this regard.

### 3.6.4.2. *Hearst v A.V.E.L.A.*,<sup>372</sup> and *La Chemise Lacoste*<sup>373</sup>

Trade marks have no advantage over copyright with regard to a shift in the medium either. A shift in the medium takes place e.g. when a word/literary work is depicted as a device/artistic work, or vice versa.

According to Birss J in the 'Betty Boop' case and Hobbs QC in *La Chemise Lacoste*, word marks may not only be compared with word signs, but also devices. That means,

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<sup>368</sup> CDPA 1988 s 16(3)(a). It gets complex where the other work is substantially different. Substantial differences may well lead to copyright protection of its own, as a copyright work independent from the 'inspiring work'. It may be remembered here that originality is a question of degree. *Interlego AG v Tyco Industries Inc* [1989] 1 AC 217 [235].

<sup>369</sup> *Interlego AG v Tyco Industries Inc* [1989] 1 AC 217 [269].

<sup>370</sup> *Ibid* [258]; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 46.

<sup>371</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 46.

<sup>372</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch).

<sup>373</sup> *La Chemise Lacoste SA v Baker Street Clothing Ltd* [2011] RPC 5.

an undertaking making use of an image may be hindered at registering it, if the device is similar to an earlier registered word mark to an extent that gives rise to a likelihood of confusion. The similarity between the word 'Alligator' and the Lacoste crocodile was found to be not sufficient to confuse the relevant public in *La Chemise Lacoste*.<sup>374</sup> However, this was only a question of fact, which does not affect the law. Words and devices may be compared for the purposes of TMA 1994 ss 5 and 10. Hobbs QC stated explicitly that the outcome of a comparison between a word mark and a device could well be different, if the word is so well rooted in the public's mind that it automatically conjures up certain perceptions of images, as it was the case with the words 'Mona Lisa', 'Eiffel Tower', and 'Stars and Stripes'.<sup>375</sup> That means vice versa, depending on the facts of the case it is theoretically possible that a logo representing a character may be refused registration or can infringe a registered word mark that is the name of that character, if the image triggers the name (word mark) of the character, which has been registered, so that the public believes the origin of the device to be the proprietor of the word mark (the character's name).<sup>376</sup> The risk, that the relevant public will assume that the conflicting signs share the same origin or at least stem from economically linked companies, already constitutes a likelihood of confusion.<sup>377</sup> In case of 'Betty Boop' it was held that the image used by the defendants inevitably and spontaneously called the claimants' word mark (the name 'Betty Boop') into the consumer's mind.<sup>378</sup> This could well be because the public had seen the words 'Betty Boop' and variations of the image often being used together. It would be much more difficult to prove that the name of a character triggered a certain image, if the image has not been used in combination with the words before, which is typically the case with LFCs.<sup>379</sup>

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<sup>374</sup> *Ibid* [51].

<sup>375</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [154]; *La Chemise Lacoste SA v Baker Street Clothing Ltd* [2011] RPC 5 [55].

<sup>376</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [158].

<sup>377</sup> Case T-33/03 *Osotspa Co Ltd v OHIM* [2005] ECR II-763, para 36 (SHARK case).

<sup>378</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [156] and [158].

<sup>379</sup> The conflicting signs are usually compared in the assessment of their similarity with regard to their visual, oral, aural, and conceptual similarities and differences at the level of perception of the average consumer of the relevant goods (which depends on factors such as price, everyday item or luxury item etc.). Case T-623/11 *Pico Food GmbH v OHIM* (CJEU (Second Chamber) 9 April 2014) para 29; *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [155].

The overall impression given by the conflicting signs must be assessed, because the average consumer commonly perceives a mark as a whole and usually does not analyse the various details of the mark. Case T-33/03 *Osotspa Co Ltd v OHIM* [2005] ECR II-763, para 47; Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, para 47.

This level of protection could also be achieved to an extent by copyright, if LFCs were copyright protected as literary works or substantial parts thereof. The act of making an adaptation by creating an artistic version of a written description of a LFC would be an infringement of copyright according to CDPA 1988, s 21(3)(a)(iii). However, this could go only as far as the LFC's written description is concerned. Creating an AFC or comic based on the mere name of a LFC would not amount to copyright infringement, even if LFCs per se were protected by copyright.<sup>380</sup>

Hence, it would seem that trade marks do have an advantage in comparison to copyright here after all. However, one should also bear in mind that it is important for balance's sake that names are not copyright protected. If names of LFC were protected by copyright independent of further description of the LFC, then creators of AFCs (and creators of LFCs) would be severely limited in their future creations. A comic artist would already infringe copyright, if she drew an AFC inspired by the name of a LFC and giving it the same name. This should not be possible i.a. due to the creative efforts of the artist.

Therefore, in this regard, whether trade marks or copyright are more appropriate, depends very much on one's point of view as to what is important – protection of the commercial interests of the proprietor of a word mark (that may be the author of the LFC or somebody else), or a balance of the rights of all parties affected by creations.

### 3.7. Conclusion

This chapter endeavoured to determine whether trade mark law is well equipped to deal with the protection of LFCs, and reached the conclusion that it is not,<sup>381</sup> though

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All factors must be taken into account, i.a. the level of the mark's reputation, the level of distinctiveness of the mark, the level of similarity between the conflicting marks, the type of goods/services to which the signs relate as well as the level of proximity between the goods/services of the conflicting parties, and, where necessary, the probability of dilution or tarnishment of the mark. Case C-487/07 *L'Oréal SA v Bellure NV* [2009] ECR I-5185, para 44; Case C-252/07 *Intel Corporation Inc v CPM United Kingdom Ltd* [2008] ECR I-8823, paras 76 et seqq.

<sup>380</sup> See paras 3.6.1. and 8.3.4.2.

<sup>381</sup> See paras 3.1. – 3.6.3.

with regard to the relative grounds for refusal of trade mark registration trade mark law and copyright may be on par with each other.<sup>382</sup>

The diverging purposes of copyright and trade marks already suggest that copyright is the more suitable form of protection for LFCs of two IPRs.<sup>383</sup> Copyright specifically protects rights of authors whereas trade marks do not. Trade mark law ‘has nothing to do with protecting any creative skill and labour in coming up with a trade mark’.<sup>384</sup> Trade mark law protects the rights of the proprietor of the mark. That could be an author, but also any undertaking using the name of LFCs as an indication of origin of the goods/services.

However, trade mark registration proves problematic for both media (e.g. printed matter and films) and merchandising goods (e.g. posters, mugs, and pencil cases). Character merchandising and registered trade marks are not quite as compatible as one might hope. This is down to the deviating principal aims. The foremost function of trade marks is to guarantee the trade origin,<sup>385</sup> whereas character merchandisers’ main interest is to sell as many products as possible. They are less concerned with the use of a character or its name as a sign of origin, but rather with the use of the character’s and its name’s eye appeal, which attracts customers to buy their products.<sup>386</sup> Signs that are above all ornamental are frequently denied trade mark registration, because they do not indicate the source, the commercial origin, of the goods or services.<sup>387</sup>

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<sup>382</sup> See para 3.6.4.

<sup>383</sup> See para 3.2.

<sup>384</sup> *Griggs Group v Ross Evans and Others* [2004] ECDR 15 [20]; Craig S Mende and Belinda Isaac, ‘When copyright and trademark rights overlap’ in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 148.

<sup>385</sup> See para 3.6.2.

<sup>386</sup> Department of Trade and Industry, *Reform of Trade Marks Law* (Cm 1203, 1989/90) para 4.42; IPO, ‘Trade Marks Manual’ (2016) 128 <[https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/560039/Manual-of-trade-marks-practice.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/560039/Manual-of-trade-marks-practice.pdf)> accessed 16 Dec 2016; Gilian Black, ‘Exploiting image: making a case for the legal regulation of publicity rights in the UK’ (2011) 33 EIPR 413, 414; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 59.

<sup>387</sup> Craig S Mende and Belinda Isaac, ‘When copyright and trademark rights overlap’ in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 142; Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 648. See also para 3.6.3.1.



According to the Trade Marks Manual the name of a fictional character can be registered for any goods/services for which the sign is likely to be taken as a sign indicating one particular undertaking or trader.<sup>388</sup> However, if the name of the fictional character is very well known to the population, there is the risk that the name may have passed on into the language. The name of a character may indeed be associated with the character and therefore might be regarded as describing the character instead of a source of origin. As trade marks must be distinctive instead of descriptive, the character would not be registrable under these circumstances.

When indicating a source of origin, it is also of importance in relation to which goods/services registration of the name of a character is applied for. Using an identical character name for goods A may not be regarded as conflicting with the use of identical name of products B. Hence, for example the name 'Spiderman' can be legally used as a trade mark for a magazine. The name 'Spiderman' then does not denote the character name, but the name of the magazine. In fact, any character that identifies the goods/services of one particular undertaking can be registered as a trade mark, if it serves as a means of indication of the trader, notwithstanding that it is also the name of a famous fictitious character. It is irrelevant who coined a name, if it is regarded as purely the name of a fictional character at the time of application, and not an indication of origin of the author, but the trader of the magazine.<sup>389</sup>

Moreover, even the name 'Sherlock Holmes' is devoid of distinctiveness and is descriptive of books, films, and similar products wherein the character features.<sup>390</sup> A EUTM was refused for 'Dr No' in relation to books, model cars, posters and so on by the EUIPO for the same reason.<sup>391</sup> A character name would also be descriptive of posters bearing an artistic version of a LFC, because the name designated the kind and intended purpose of the goods, just like the name of the band 'Linkin Park' was considered to do in relation to posters depicting the band.<sup>392</sup> There is no real alternative

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<sup>388</sup> IPO, 'Trade Marks Manual' (2016) 127 <[https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/560039/Manual-of-trade-marks-practice.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/560039/Manual-of-trade-marks-practice.pdf)> accessed 16 Dec 2016.

<sup>389</sup> Ibid.

<sup>390</sup> Ibid; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 35.

<sup>391</sup> Case T-435/05 *Danjaq LLC v OHIM* [2009] ECR II-2097, para 25; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 35.

<sup>392</sup> The same argument was applied in *Animated Music Ltd's Trade Mark, Application for Revocation by Dash Music Co Ltd* [2004] ETMR 79 [21] - [24] with regard to the cartoon character 'Nellie the Elephant', and with regard to 'Bon Jovi' in *R v Johnstone* [2004] ETMR 2 [H3] and [H12].

for the seller and buyer to refer to the poster other than ‘Linkin Park poster’.<sup>393</sup> A trade mark application would hence be denied according to TMA 1994 s 3(1)(c).

Only where the consumers identify a certain source with a mark, and do not regard it as purely decorative may a trade mark be registered. The opinions whether or not the average consumer makes the link between the character and a single source are divided.<sup>394</sup> A relatively recent case that acknowledged the average consumer’s ability to identify merchandising goods and regard it as coming from one official source was the ‘Betty Boop’ case.<sup>395</sup> In that case, the successors of the originator of the 1970s cartoon character ‘Betty Boop’ successfully asserted their trade mark in the character name and image of ‘Betty Boop’ i.a. against AVELA Inc and its UK licensing agent TPTL, which had licensed ‘Betty Boop’ artwork for merchandising goods. Birss J’s view was that the public would consider the AFC as an indication of a single source.<sup>396</sup> However, this case is not as revolutionary as it may seem. The reason why the successors of the originator of ‘Betty Boop’ won the trade mark case was not because they had the copyright in the original cartoons,<sup>397</sup> but because they had put an effort into educating the public and there had been only one source of ‘Betty Boop’ merchandise until the defendant had started licensing ‘Betty Boop’, too. Therefore, nothing much has changed. Still, - regardless of whether it is the originator of the fictional character or an unlicensed trader – whoever successfully registered a trade

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<sup>393</sup> *Linkin Park LLC’s Trade Mark Application* [2006] ETMR 74 [46] - [49]; *Linkin Park LLC’s Trade Mark Application* [2005] ETMR 17 [179].

<sup>394</sup> Some argue that the public has an awareness of character merchandising. *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [110] and [166] et seq; Case C-408/01 *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* [2003] ECR I-12537, paras 38 - 41; Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 515 et seq; James Mellor et al, *Kerly’s law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 833.

Some argue that the public does not have an awareness of character merchandising. *Linkin Park LLC’s Trade Mark Application* [2006] ETMR 74 [38]; *Elvis Presley Trade Marks* [1997] RPC 543, 554; Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 514; Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 740.

However, the awareness alone is not sufficient.

<sup>395</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [97] et seq and [104]; Nick Aries, ‘Lifeline for leading lights?’ (July/August 2014) ITMA Review 10.

<sup>396</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [110] and [166] et seq. See para 3.6.3.2.2.3.

<sup>397</sup> In fact, others may have rights in the original ‘Betty Boop’ cartoons as well, but Birss J did not have to resolve this issue. *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [103].

mark for the name of a fictional character first may enforce trade mark rights against others.

A glimmer of light is TMA 1994 s 3(6) which allows a famous person with a commercial reputation some relief against the registration of a trade mark by a third party. Under the terms of this section, a trade mark shall not be registered if, or to the extent that the application for registration is made in bad faith. A third party's application for registration of a famous name (only names with commercial reputation, not names of politicians) is in bad faith, if the application relates to goods/services that are associated with the famous person.<sup>398</sup> If one applies the same principle to names of fictional characters, that means that an author may object to trade mark registration of the name of her LFCs on the basis of bad faith provided the author is known for selling character goods. Authors will very rarely sell character goods themselves. However, an author may license the sale of character goods. Therefore, in order to claim that the applicant for a trade mark is in bad faith, the author would actually have to be in the licensing business and must also have a reputation for granting licences regarding certain LFCs, which the author must prove. A general assumption that the public believes each author to be in licensing cannot be made. The better known an author is, the better known will be her LFCs and the more likely it is that she attracts licensing opportunities. However, the better known the name of the LFC, the more likely it is that the character name becomes associated with the character, and it is regarded as descriptive. The name would then not be registrable as a trade mark. The chances of a successful trade mark registration are at their highest when the name of the character is unknown. Ironically, at that stage, the author will usually not have the financial capacity to market merchandising goods himself, and third parties would commonly not be interested to take out a licence for producing and selling merchandise of an unknown character, because the profit margin is too low. Hence, an objection to another person's application for trade mark registration of the character name on grounds of bad faith would fail.

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<sup>398</sup> IPO, 'Trade Marks Manual' (2016) 126 <[https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/560039/Manual-of-trade-marks-practice.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/560039/Manual-of-trade-marks-practice.pdf)> accessed 16 Dec 2016.

Since LFCs are not protected by copyright, an author could not even claim an earlier right according to TMA 1994 s 5(4)(b) against the trade mark registration by an unauthorized undertaking either.

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## Chapter 4 – Strengths and weaknesses of an action for passing off

### 4.1. Introduction

The previous chapter examined in how far trade mark law protects LFCs, its strengths and weaknesses, i.e. the suitability of trade mark law for the protection of LFCs, and compared the key elements of trade mark law with copyright. This chapter now analyses to what extent LFCs may be protected by the tort of passing off against

- a) the use of a LFC by a non-licensed trader for items of character merchandise as well as
- b) the use of a LFC by another author or publisher.

The essential requirements of the tort of passing off shall be analysed as well as case-law, in particular on character merchandising. However, contrary to chapter 3, this chapter will not examine the key elements of copyright again as this was done already in the previous chapter. Therefore, passing off is balanced against copyright merely in the conclusions of this chapter.

### 4.2. Purpose of an action for passing off

Lord Oliver stated in *Reckitt & Coleman Products Ltd v Borden Inc* that no person may steal another person's trade by deceit<sup>399</sup> and Lord Halsbury LC said in *Reddaway v Banham* about passing off that no one has the right to present his goods as those of another.<sup>400</sup> Both statements express the twofold purpose of an action for passing off. On the one hand, the purpose of an action for passing off is to protect actual and potential consumers, both end consumers as well as businesses, from being misled into thinking that the goods/services from seller/manufacturer or supplier A are those of seller/manufacturer or supplier B.<sup>401</sup> On the other hand, an action for passing off's

<sup>399</sup> *Reckitt & Coleman Products Ltd v Borden Inc* [1990] 1 WLR 491, 509 ('Jif Lemon' case).

<sup>400</sup> *Reddaway v Banham* [1896] AC 199, 204.

<sup>401</sup> Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 4 et seq.

aim is also to enable a business which uses a mark as its (unregistered or registered) trade mark in relation to goods/services to prevent other undertakings from making use of an identical or similar sign as an (unregistered or registered) trade mark which causes deception of consumers and leads to a diversion of trade from the proprietor of the mark or damage to the goodwill in the mark and business.<sup>402</sup> However, unlike a registered trade mark, passing off does not confer a monopoly right in the use of a name, not even if it is distinctive and well-known.<sup>403</sup> Therefore, another person or business may make use of an identical or similar name, if she effectively distinguishes her undertaking or goods and does not misrepresent her goods as those of another.<sup>404</sup>

### 4.3. Limitation period

Since an action for passing off does not grant a proprietary right like copyright, one cannot speak of duration of the negative right provided by a passing off action. Instead an action for passing off has a limitation period. This term describes the time frame in which an action for passing off must be brought. The general rule is that the limitation period in an action for passing off is six years from the date when the injured party was first entitled to file a claim in respect of the tort of passing off, i.e. when the cause of action accrued.<sup>405</sup>

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<sup>402</sup> Ibid; Peter Jaffey, 'Merchandising and the law of trade marks' (1998) 3 IPQ 240, 246.

<sup>403</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [34]; *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697, 711; Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) paras 1-16, 3-8 and 5-3; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 449.

<sup>404</sup> This is illustrated by *DaimlerChrysler AG v Javid Alavi*, where the plaintiffs intended to stop a clothes retailer from using the word 'Merc' for their store. The plaintiffs had goodwill in 'Mercedes' and 'Mercedes-Benz' for cars, which were commonly abbreviated to 'Merc'. However, the defendant (clothes retailer) had been trading under the name 'Merc' for many years before the plaintiffs (car manufacturer) sought to prohibit the clothes retailer from using this word. The defendant had already established goodwill, independent of the plaintiffs' business. Potential consumers did not believe that the defendant's clothes were connected to the car manufacturer. Hence, the plaintiffs' action for passing off failed. *DaimlerChrysler AG v Javid Alavi (t/a Merc)* [2001] RPC 42 [H5] - [H13].

<sup>405</sup> Limitation Act 1980 s 2; Nicholas J McBride and Roderick Bagshaw, *Tort Law* (5<sup>th</sup> edn, Pearson 2015) 760; Simon Deakin, Angus Johnston and Basil Markesinis, *Markesinis and Deakin's Tort Law* (7<sup>th</sup> edn, OUP 2012) 782; Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 9-105.

This is subject to a number of qualifications. For example, if the court finds that the plaintiff was delayed in suing the alleged infringer, then the mark may be held to have lost its distinctiveness, and the plaintiff forfeits the right to restrain the defendant from using the mark at that point in time, so that only the possibility to claim past damages remains.

## 4.4. Scope of protection of an action for passing off

### 4.4.1. The requirements of an action against passing off in general

In general, for an action in passing off to succeed three elements are required:

- a) *Goodwill attached to the name (or other distinguishing indicia) of the claimant or his undertaking, because of the reputation in the goods/services*

Goodwill is the attractive force that brings business to an undertaking.<sup>406</sup> The goodwill has to be judged from the point of view of the purchasing public. It is necessary that the relevant customers associate the 'get up', this includes i.a. the brand name and trade description, with the particular goods/services offered to the public by the claimant. The relevant public must recognize the get up as specifically distinctive of the claimant's goods/services.<sup>407</sup>

- b) *Misrepresentation by the defendant*

The misrepresentation by the defendant must lead or must be likely to lead the relevant consumers, i.e. the claimant's potential and actual, direct and indirect consumers,<sup>408</sup> to think that the goods/services which she is offering are the claimant's goods/services. The defendant is guilty of a misrepresentation, for example, if she sells goods which are falsely described by the trade name to which the goodwill is attached.<sup>409</sup>

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<sup>406</sup> *The Commissioners of Inland Revenue v Muller & Co's Margarine Ltd* [1901] AC 217, 223 et seq; *Erven Warnink Besloten Vernnootschap v J Townend & Sons (Hull) Ltd (No 1)* [1979] AC 731, 735 (*Advocaat* case); Nicholas J McBride and Roderick Bagshaw, *Tort Law* (5<sup>th</sup> edn, Pearson 2015) 531; Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 167.

<sup>407</sup> Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 31 et seq; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 449 et seq.

<sup>408</sup> Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 5-120.

<sup>409</sup> *Erven Warnink Besloten Vernnootschap v J Townend & Sons (Hull) Ltd (No 1)* [1979] AC 731, 736.

c) *Damage to the goodwill suffered by the claimant as a result of the misrepresentation (in a quia timet action: likelihood to suffer damage<sup>410</sup>)*

There must be a likelihood of more than minimal damage to the goodwill of the plaintiff,<sup>411</sup> and a causal connection must exist between the misrepresentation of the defendant and the damage suffered by the claimant.<sup>412</sup>

Conceivable damage in a merchandising case can be:

- (1) The loss of licensing revenue
- (2) Loss of opportunities to expand the undertaking in new fields of business
- (3) Diminished reputation
- (4) Dilution of the fictional character.<sup>413</sup>

The above three factors (goodwill, misrepresentation, damage) are commonly referred to as the classical trinity.<sup>414</sup> However, Aldous LJ maintained in *British Telecommunications plc v One in a Million Ltd* that, although these criteria were not incorrect, one should not confine an action for passing off strictly to these characteristics in order to allow for the common law to evolve further and remain flexible so that it may be applied to new forms of trade and activity, changing trading

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<sup>410</sup> *Reckitt & Coleman Products Ltd v Borden Inc* [1990] 1 WLR 491; *H P Bulmer Ltd and Showerings Ltd v J Bollinger SA and Champagne Lanson Père et Fils* [1978] RPC 79, 99; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 541; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 86; Jennifer Davis, 'Why the United Kingdom should have a law against misappropriation' (2010) CLJ 561, 576.

<sup>411</sup> *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697, 714.

<sup>412</sup> *Reckitt & Coleman Products Ltd v Borden Inc* [1990] 1 WLR 491; Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 32; Jennifer Davis, 'Why the United Kingdom should have a law against misappropriation' (2010) CLJ 561, 575; Ceri Lynn Delemore, 'Character merchandising – the position under English law: a review of the Teenage Mutant Ninja Turtles Case' (1992) 13 Media Law & Practice 229, 231.

<sup>413</sup> Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 739.

<sup>414</sup> *Consorzio del Prosciutto di Parma v Marks & Spencer plc* [1991] RPC 351; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 211; Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 166.



environments and circumstances.<sup>415</sup> This chapter will show whether or not the law of passing off is flexible enough to provide adequate protection of LFCs.

#### 4.4.2. The requirements of an action against passing off with regard to fictional characters

##### 4.4.2.1. The general requirements with regard to fictional characters

An action for passing off predominantly secures the property in an undertaking or goodwill of an enterprise.<sup>416</sup> That means, the law of passing off does not protect names (including fictive names of LFCs) as such,<sup>417</sup> but rather the goodwill the name generates.<sup>418</sup> Hence, the true value of a name resides in the name's ability to capture the public's imagination.<sup>419</sup> If a name has captivated the imagination of the public, then it has obtained goodwill under that name. The words 'Harry' and 'Potter' by themselves have not much power of association, but put together as 'Harry Potter' the vast majority of people will immediately think of JK Rowling, the originator of the fictive boy wizard 'Harry Potter'.

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<sup>415</sup> *British Telecommunications Plc v One in a Million Ltd* [1999] 1 WLR 903, 913; Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 165 et seq and 175.

<sup>416</sup> *Burge v Haycock* [2001] EWCA Civ 900 [47]; *Kean v McGivan* [1982] FSR 119, 120; Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 3-1; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 79; Peter Jaffey and Nic Couchman, 'English Law' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 358; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 6 and 15.

<sup>417</sup> Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 3-1; Allison Coleman, 'Character Merchandising and Fictitious Characters' (1982) 10 EIPR 285, 286.

<sup>418</sup> *Dawnay Day & Co Ltd v Cantor Fitzgerald International* [2000] RPC 669, 701; *Harrods Ltd v The Harrodian School Ltd* [1996] RPC 697, 716; *Taverner Rutledge Ltd v Trexapalm Ltd* [1975] FSR 479, 480; *Erven Warnink Besloten Vernnootschap v J Townend & Sons (Hull) Ltd (No 1)* [1979] AC 731, 735; Charlotte Waelde et al, *Contemporary Intellectual Property Law and Policy* (4<sup>th</sup> edn, OUP 2016) 759; Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 7-93; Allison Coleman, 'Character Merchandising and Fictitious Characters' (1982) 10 EIPR 285, 286.

<sup>419</sup> Reuben Stone, 'Titles, character names and catch-phrases in the film and television industry: protection under the law of passing off' (1996) 7 Ent LR 263.

The element of misrepresentation poses a problem though, because it traditionally relates to source, i.e. the origin.<sup>420</sup> In a case of an author against a character merchandiser, the claimant must demonstrate that a reputation is attached to the character goods under that name or visual representation of the LFC, and that either the name or image has become distinctive of the goods sold under that name/image. Moreover, the appropriation of the same name/image by the defendant must cause confusion, which in turn must result in damage to the plaintiff's goodwill.<sup>421</sup> However, although merchandising goods usually make use of a character's name or image on the goods, the goods are not manufactured and sold under that name or image. They are merely used in a decorative way, not as a distinctive mark of a certain undertaking.

However, the *sui generis* action for passing off has developed beyond cases in which a misrepresentation is made in relation to source.<sup>422</sup> The tort of passing off also encompasses instances where the defendant has misrepresented the quality of the claimant's products/services<sup>423</sup> as well as cases in which the defendant has misrepresented a connection with the claimant's goods/services.<sup>424</sup> The last-mentioned is the closest among the above mentioned purposes by means of which free-riding of characters created by another (the originator of the character) may be prevented. However, the tort of passing off, although protecting against misrepresentation, harm to goodwill and consumer information, does not have protection against simply free-riding in mind. Free-riding, as long as it does not cause any harm, is acceptable. This was supported in *Cadbury Schweppes Pty v Pub Squash Co Pty Ltd*.<sup>425</sup> Another case to corroborate this is *IPC Magazines Ltd v Black & White Music Corporation*.<sup>426</sup> Therein, the defendants wrote a song about the cartoon character 'Judge Dredd' and displayed the name and an image of 'Judge Dredd' on

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<sup>420</sup> Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 4.

<sup>421</sup> Reuben Stone, 'Titles, character names and catch-phrases in the film and television industry: protection under the law of passing off' (1996) 7 Ent LR 263; *Norman Kark Publications Ltd v Odhams Press Ltd* [1962] 1 WLR 380, 383.

<sup>422</sup> Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 14.

<sup>423</sup> *Spalding v Gamage* [1914-15] All ER Rep 147, 149; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 15.

<sup>424</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [34]; *Dawnay Day & Co Ltd v Cantor Fitzgerald International* [2000] RPC 669, 693; *Combe International Ltd v Scholl (UK) Ltd* [1977] FSR 464, 471; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 15.

<sup>425</sup> *Cadbury Schweppes Pty v Pub Squash Co Pty Ltd* [1981] 1 WLR 193, 205; Hazel Carty, 'Advertising, publicity rights and English law (2004) 3 IPQ 209, 255.

<sup>426</sup> *IPC Magazines Ltd v Black & White Music Corporation* [1983] FSR 348.

the cover.<sup>427</sup> Goulding J stated that consumers might believe the record to be approved by the plaintiff, and that thereby a misrepresentation had been committed by the defendant. However, the action failed, because the plaintiff could not provide evidence of damage to his goodwill. Moreover, there was no proof either that other third parties would make use of the character 'Judge Dredd' without a licence.<sup>428</sup>

In conclusion to the above, the claimant must prove in an action for passing off of a fictional character

- a) that the claimant has built up goodwill around the fictional character,
- b) that the defendant misrepresented that there was a connection between the claimant's and defendant's business activity, and
- c) that this has led to a loss of revenue, or to some other form of damage.<sup>429</sup>

Business in this context includes not only traders, but also sportsmen, writers<sup>430</sup> and licensors.<sup>431</sup> In case of novels or other literary works, goodwill may attach to a character name or the character per se 'starring' in the underlying work, if the fictional character attracts the reader.<sup>432</sup>

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<sup>427</sup> Ibid.

<sup>428</sup> Ibid 353; Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 515; Howard Johnson, 'Legal Aspects of Character Merchandising' (1992) 34 *Managerial Law* 1, 11.

<sup>429</sup> *Allen v Redshaw* [2013] WL 2110623 [32] et seq. This case concerned unauthorized merchandise of the characters from the hand puppet play (and later also TV series) *Mr Spoon on Button Moon*. John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 80.

<sup>430</sup> *Allen v Redshaw* [2013] WL 2110623 [2] and [32] et seq; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 80.

<sup>431</sup> *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, 146; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 571; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 62. The plaintiffs in the 'Turtles' case were not operating in the manufacture and marketing of character goods, but licensed others to do so.

<sup>432</sup> John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 80.

#### 4.4.2.2. Additional requirements with regard to fictional characters

*Mirage Studios v Counter-Feat Clothing* introduced further requirements for a successful action in passing off.

- a) The plaintiff must own IPRs in the images of the character.<sup>433</sup>
- b) The plaintiff must prove that the public expects with regard to character merchandising (and other reuses of fictional characters) that the character is commonly under licence of the plaintiff (e.g. the originator or licensing agents) and will not appear without a licence from the plaintiff.<sup>434</sup>
- c) The public must be misled in relation to a feature or the quality of the products, and must also associate this feature or quality with the plaintiff.<sup>435</sup> *Browne-Wilkinson V-C* accepted in the ‘Ninja Turtles’ case that there was evidence that a substantial number of potential consumers connected the defendants’ goods with the character originating from the plaintiffs’ client, and also that the application of the character by the defendants on their products suggested the grant of a licence to the buying public.<sup>436</sup> There were two misrepresentations in the ‘Ninja Turtles’ case. Firstly, the public was made to believe that the defendants’ goods were the genuine article. Secondly, the public was led to believe that the goods were licensed.<sup>437</sup> By using the character created by the plaintiffs’

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<sup>433</sup> *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, 158; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 64 et seq; Ceri Lynn Delemore, ‘Character merchandising – the position under English law: a review of the Teenage Mutant Ninja Turtles Case’ (1992) 13 *Media Law & Practice* 229, 233.

<sup>434</sup> *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, 155; Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 740; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 63.

<sup>435</sup> *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, 157; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 62.

<sup>436</sup> *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, 155; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 891 et seq; William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 684; Tina Hart, Simon Clark and Linda Fazzani, *Intellectual Property Law* (6<sup>th</sup> edn, palgrave macmillan 2013) 143; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 63.

<sup>437</sup> Lionel Bently and Brad Sherman, *Intellectual Property Law* (4<sup>th</sup> edn, OUP 2014) 857.

client the defendants misled the buying public into thinking that the goods sold by the defendants were licensed, but in fact were not.<sup>438</sup>

- d) There must be evidence that the claimant has goodwill in the character.
- e) There must also be actual or potential damage to the claimant's goodwill by misappropriation of the goodwill.<sup>439</sup> Sir Nicholas Browne-Wilkinson found in the 'Ninja Turtles' case that there were two damages: the loss of royalties from the unauthorized sale of character goods by the defendants (diversion of business), and the loss of licensing opportunities due to the depreciation of value of the licensing rights (artistic copyright) in the images of the 'Turtles' by printing images of humanoid turtles on goods of inferior quality (erosion of goodwill).<sup>440</sup>

Some of these criteria are repetitive, but they are expanded to be applicable to character merchandising cases. Particularly problematic is requirement a) which restricts the application of the tort of passing off to plaintiffs who have IPRs to license. Criterion a) is not in unison with the first element of the classic trinity, which is also the purpose of an action for passing off. The 'Ninja Turtles' decision would mean for character image marketeers as such that they cannot manufacture and sell character merchandise unless they acquire a licence from the creator of the character image (who holds the artistic copyright in the character). As good as this result may sound, it would lead an action for passing off *ad absurdum*, because the purpose of the tort of passing off is to protect the goodwill of an undertaking, not IPRs. Lord Parker had already stipulated in *Spalding v Gamage* that the tort of passing off protects goodwill and not intellectual property.<sup>441</sup> It was confirmed in *Star Industrial Co Ltd v Yap Kwee*

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<sup>438</sup> *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, 146; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 63.

<sup>439</sup> *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, 146; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 87 et seq.

<sup>440</sup> *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, 146; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 571; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 63 et seq; John Hull, 'The merchandising of real and fictional characters: an analysis of some recent developments' (1991) 2 Ent LR 124, 129.

<sup>441</sup> *Spalding v Gamage* [1914-15] All ER Rep 147, 150; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 64.

*Kor* that it is the goodwill in a business or a mark that is protected by the tort of passing off.<sup>442</sup>

Furthermore, if criterion a) is transferred (from AFCs) to LFCs one arrives inevitably at the crux on which this thesis is based. The literary work in which characters exist is copyrighted, but no copyright attaches to the LFCs by themselves. Hence, if the ‘Ninja Turtles’ decision were applied to LFCs and if criterion a) were acknowledged, then writers could never resort to passing off for the protection of their labour against character merchandisers who manufacture, sell and license although they have no rights and licences themselves. An action for passing off would not be successful against other writers copying one of the originators fictional characters under these circumstances either. Only cases where the whole book or a substantial part of it, such as LFCs in combination with the plot, is copied, could be protected by an action for passing off. However, character merchandise objects typically just represent the character and not the plot.

#### **4.4.3. Difficulties of proof**

An action for passing off does not give a registered proprietary right unlike a trade mark.<sup>443</sup> Therefore, the claimant needs to prove every single requirement of the classic trinity. This is examined in the following three sections.

##### **4.4.3.1 Goodwill**

Initially, the creator of a LFC must be able to prove that she has goodwill that is capable of being damaged.<sup>444</sup> Factors such as the trade generated by the undertaking, numbers of sales, advertising, recurring custom, and a considerable turnover may give evidence of goodwill.<sup>445</sup> That means that the claimant has to disclose a lot of information about the business in an action for passing off.

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<sup>442</sup> *Star Industrial Co Ltd v Yap Kwee Kor* [1976] FSR 256, 261; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 64.

<sup>443</sup> Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 31 and 165.

<sup>444</sup> *Ibid* 167.

<sup>445</sup> *Ibid*.

#### 4.4.3.2. Misrepresentation

Proving misrepresentation or deception poses the main challenge.<sup>446</sup> The object and effect of character merchandising activities are frequently non-deceptive, because the user of the character on products simply intends to use the character's magnetism to enhance the commercial attractiveness of the goods instead of claiming a commercial connection with the creator or licensor of the character.<sup>447</sup> However, intent is not necessary for passing off.<sup>448</sup> It is a question of fact, and depending on the public's perception of characters and character merchandising, misrepresentation may be established, although the infringer is unaware of this. Having said this, where it has been shown that the defendant had the dishonest intention to benefit from the goodwill of the plaintiff's business, the courts are inclined to find that the defendant has achieved her goal by appropriating e.g. the name or get-up making the consumers believe that her goods are those of the defendant, or at least that they are connected.<sup>449</sup>

#### 4.4.3.3. Damage

The plaintiff must also provide evidence that the damage to the defendant's interests is a result of the misrepresentation.<sup>450</sup> Damage to an author's interests is the pecuniary prejudice resulting from lost opportunities to license the right to use the character for merchandising activities. However, the originator of a character would only have such a 'merchandising right' if she could file a suit for passing off, but an action for passing

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<sup>446</sup> John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 80; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 6.

<sup>447</sup> Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 87.

<sup>448</sup> *Reckitt & Coleman Products Ltd v Borden Inc* [1990] 1 WLR 491; Millett LJ in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697, 720; Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 169.

<sup>449</sup> Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 234.

<sup>450</sup> James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 835; Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 261 and 173; Howard Johnson, 'Legal Aspects of Character Merchandising' (1992) 34 *Managerial Law* 1, 10; *Erven Warnink Besloten Vennootschap v J Townend & Sons (Hull) Ltd (No 1)* [1979] AC 731, 740.

off can only succeed if the claimant suffers damage. The argument is therefore circular.<sup>451</sup>

Bently and Wadlow opine that this assessment is technically correct, but parties may enter into licensing agreements, although they are not legally required to.<sup>452</sup> Bently argues that the above is no problem as long as courts acknowledge damage through loss of revenue where there is a likelihood of licensing.<sup>453</sup> It is submitted that it is improbable that a business pays licence fees on a voluntary basis, if it is certain it is not obliged to do so. A business may even try getting around paying licence fees by drawing its own version of a similar type of characters, like the defendants did in the ‘Ninja Turtles’ case.<sup>454</sup>

#### 4.4.4. Misrepresentation of a connection

It has been maintained that the use of a merchandising sign does not involve by necessity any misrepresentation, because the merchandising sign merely functions as eye appeal and does not convey information about the trade origin of the goods to the consumers.<sup>455</sup> Browne-Wilkinson V-C saw matters differently in *Mirage Studios v Counter-Feat Clothing*.<sup>456</sup> He objected to the use of images of similar humanoid turtles being printed on clothing and sold by the defendant. The judge stated that the fact that the defendant did not have a licence from the claimant to use images of the ‘Turtles’ meant that the defendant was deceiving the consumers. Consumers would believe that there was a connection between the clothing and the claimant in the sense that it was

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<sup>451</sup> *Taverner Rutledge Ltd v Trexapalm Ltd* [1975] FSR 479, 481; Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 874; Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 4-9; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 87.

<sup>452</sup> Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 874.

<sup>453</sup> *Ibid.*

<sup>454</sup> Though the defendants did not succeed in this instance, the outcome might be different in similar cases depending on the plaintiffs’ goodwill and the level of similarity of the plaintiffs’ and the defendants’ characters.

<sup>455</sup> Peter Jaffey and Nic Couchman, ‘English Law’ in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 365 et seq.

<sup>456</sup> *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145.



necessary for the defendant to acquire a licence from the claimant and that it had been granted, which in fact was not the case.<sup>457</sup>

This thesis supports this view largely. Some consumers will not give a thought to the origin of the product and the images and writing the item bears. Some people will just buy a product, because it looks nice, because their children were attracted by it, and because of the price of the item, or because it was the only available product of the sort at the time when they quickly needed it. There is a myriad of reasons why a person will buy an item. Not all people will think alike. It is submitted that a substantial number of people will expect character merchandise to be licensed. They will expect that the creator of the character will benefit from it. However, even among those who think this way, quite a few people will probably not care whether or not the creator of the character truly receives royalties or whether it is a company unrelated to the author of the character which licenses the manufacture and sale of the character goods. Moreover, the cheaper the product, the less thought will a consumer spare as to whether or not it is licensed or unauthorized character merchandise. While it will be important for a collector of 'Gundam Wing' figures whether or not they buy the 'genuine' product, this will probably not be at the forefront of the buyer's thoughts of a plastic cup or biro for 99 pence.

Some academic commentators along with corroborating court rulings also maintain that a substantial number of members of the public believe that there is a single source behind merchandising of a particular character and that a seller of that merchandise (be it sold as official or unofficial) has a commercial arrangement with the single source and sells the merchandise under licence.<sup>458</sup> However, expectation and (legal) reality are not always in accord. A mere assumption about what the public thinks and expects is not sufficient. Proof must follow. *Browne-Wilkinson V-C* realised this, too. Though the 'Ninja Turtles' case advocated for a public awareness, the judge maintained that

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<sup>457</sup> Ibid 146 and 155; Peter Jaffey and Nic Couchman, 'English Law' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 366; Peter Jaffey, 'Merchandising and the law of trade marks' (1998) 3 IPQ 240, 248; Jon Holyoak, 'United Kingdom character rights and merchandising rights today' (1993) JBL 444, 451; Ceri Lynn Delemore, 'Character merchandising – the position under English law: a review of the Teenage Mutant Ninja Turtles Case' (1992) 13 Media Law & Practice 229, 231.

<sup>458</sup> *Mirage Studios v Counter-Feat Clothing Co Ltd* [1991] FSR 145, 146 and 155; *IPC Magazines Ltd v Black & White Music Corp* [1983] FSR 348, 352; Reuben Stone, 'Titles, character names and catch-phrases in the film and television industry: protection under the law of passing off' (1996) 7 Ent LR 263, 271; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 5.

public awareness of character licensing should not be assumed in general. Evidence was necessary that the man on the street was aware of the system of character merchandising. The judge was satisfied that such evidence had been given and affirmed that there had been a misrepresentation.<sup>459</sup> The claim in passing off was held in favour of the plaintiffs in *Mirage Studios* for the reason that the licensing business of an undertaking may be damaged by the production and dissemination of unlicensed goods. The licensor may not only lose licensing revenue, but there is also a risk that defects in the quality of the unlicensed products damage the goodwill of the official licensor.<sup>460</sup> However, claimants that have only a limited public profile will have more difficulty to satisfy the court of the damage that was potentially caused by unlicensed use of a non-copyright protected character on goods. Even if the plaintiff convinces the court, the court will merely order compensation by payment of reasonable royalties.<sup>461</sup> It is more likely that a court will find for a likelihood of damage, if the claimant can prove that he is applying rigorous product approvals to potential licensees.<sup>462</sup>

The High Court in *Arsenal Football Club v Reed*<sup>463</sup> also reasserted that awareness of merchandising could not be generally assumed without evidence. The use of the Arsenal FC name and emblems on scarves and memorabilia would not generally be understood by the relevant public to indicate that these goods were manufactured and sold by Arsenal FC or at the direction of Arsenal FC. A group of potential consumers would assume that the name and emblem are merely a display of allegiance.<sup>464</sup> However, no evidence was brought as to the relative size and category of buyers who

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<sup>459</sup> *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, 155 and 158 et seq; Seung Chong and Spyros M Maniatis, 'The Teenage Mutant Hero Turtles case: "zapping" English law on character merchandising past the "embryonic" stage' (1991) 13 EIPR 253, 255; Reuben Stone, 'Titles, character names and catch-phrases in the film and television industry: protection under the law of passing off' (1996) 7 Ent LR 263, 271.

<sup>460</sup> *Mirage Studios v Counter-Feat Clothing Co Ltd* [1991] FSR 145, 152 and 156; Reuben Stone, 'Titles, character names and catch-phrases in the film and television industry: protection under the law of passing off' (1996) 7 Ent LR 263, 272.

<sup>461</sup> *IPC Magazines Ltd v Black & White Music Corp* [1983] FSR 348, 354 ('Judge Dredd' case); Reuben Stone, 'Titles, character names and catch-phrases in the film and television industry: protection under the law of passing off' (1996) 7 Ent LR 263, 272.

<sup>462</sup> Reuben Stone, 'Titles, character names and catch-phrases in the film and television industry: protection under the law of passing off' (1996) 7 Ent LR 263, 272.

<sup>463</sup> *Arsenal Football Club v Reed* [2001] RPC 46.

<sup>464</sup> *Ibid* [22]; Peter Jaffey and Nic Couchman, 'English Law' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 366.

purchased the goods as signs of allegiance and the part of the public which cared about the origin of the goods and wanted to buy licensed goods in order to support Arsenal FC financially.<sup>465</sup>

*BBC Worldwide v Pally Screen Printing*<sup>466</sup> had a reasoning similar to the High Court's decision in *Arsenal v Reed*. It was held in *BBC Worldwide v Pally Screen Printing* that quite possibly, due to the lack of evidence to the contrary, consumers who saw shirts bearing the image of the 'Teletubbies' would regard it as no more than an

artwork bearing illustrations of well-known television characters without having any regard whatsoever to the source of supply and without any regard as to whether or not these T-shirts were put out with the sanction or under the aegis of the [claimants].<sup>467</sup>

By this the court meant that the public

- a) will not regard the image of the 'Teletubbies' as an indication that the shirts originated from the creator of the characters, but instead regard the image as merely decorative, and
- b) will not give any thought as to whether the merchandiser has sold the goods under licence or not.

Later, in *Irvine v TalkSport*, it was stipulated, though, that when a celebrity is famous like Eddie Irvine and therefore is in a position to exploit the fame by endorsing products, this capacity of endorsement means that the celebrity has goodwill for the purposes of an action for passing off, regardless of whether or not the celebrity herself is in the business of manufacturing and selling identical or similar type of goods.<sup>468</sup> However,

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<sup>465</sup> *Arsenal Football Club v Reed* [2001] RPC 46 [13].

<sup>466</sup> *BBC Worldwide v Pally Screen Printing* [1998] FSR 665.

<sup>467</sup> *Ibid* 674; Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 857; James Mellor et al, *Kerly's law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 837; William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 684; Peter Jaffey and Nic Couchman, 'English Law' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 366.

<sup>468</sup> *Irvine v TalkSport* [2002] EWHC 367 [38]; Peter Jaffey and Nic Couchman, 'English Law' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 367; Manoranjan, 'Character merchandising and personality merchandising: the need for protection: an analysis in the light of UK and Indian laws' (2012) 23 Ent LR 43, 47.

one cannot conclude that just using the name and/or image of a celebrity implies endorsement of goods by a celebrity, except for situations where the nature of the goods imply this.<sup>469</sup> That would be the case for example where the name of a famous Rugby player (such as Gareth Thomas or Leigh Halfpenny) is used in relation to a Rugby ball. Applying the same thought to LFCs, passing off might occur under limited circumstances, e.g. when the name 'Harry Potter' is printed on magic wands.

#### 4.4.5. Common field of activity

Another issue is that, if the originator of the LFC has never engaged in trade and not built up a goodwill in goods other than the literary work, then it will be rather hard or even unlikely that likelihood of confusion will be proven, because both parties operate in a different field of activity.<sup>470</sup> One could not assume in general that consumers believed there is a connection between the creator of a fictional character for a novel and a trader using the character outside the context of the literary work.<sup>471</sup>

The common field of activity between the plaintiff and the defendant used to be a formal requirement for a successful action in passing off.<sup>472</sup> Both parties had to be in trade, and trade to the same customers as well as in the same or at least similar field of goods or services.<sup>473</sup> It meant that if a plaintiff could not demonstrate that she and the defendant operated in a common field of business, the action for passing off was defeated.<sup>474</sup>

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<sup>469</sup> *Elvis Presley Trade Marks* [1999] RPC 567, 597; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 81; Peter Jaffey and Nic Couchman, 'English Law' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 367.

<sup>470</sup> *McCulloch v Lewis A May (Product Distributors) Ltd* [1948] 65 RPC 58, 64 [30], 66 [50] and 67 [10]; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 81; Ceri Lynn Delemore, 'Character merchandising – the position under English law: a review of the Teenage Mutant Ninja Turtles Case' (1992) 13 *Media Law & Practice* 229, 231.

<sup>471</sup> *McCulloch v Lewis A May (Product Distributors) Ltd* [1948] 65 RPC 58, 66 [40]; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 81.

<sup>472</sup> Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 567; Jon Holyoak, 'United Kingdom character rights and merchandising rights today' (1993) *JBL* 444, 449.

<sup>473</sup> Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 550.

<sup>474</sup> *McCulloch v May (Produce Distributors) Ltd* [1948] 65 RPC 58, 66 [50] and 67 [10]; *Wombles Ltd v Wombles Skips Ltd* [1975] FSR 488; *Taverner Rutledge Ltd v Trexapalm Ltd* [1975] FSR 479, 484; Jeremy Phillips and Allison Coleman, 'Passing Off and the Common Field of Activity' (1985) 101 *LQR* 242, 263; Reuben Stone, 'Titles, character names and catch-phrases in the film and television industry: protection under the law of passing off' (1996) 7 *Ent LR* 263, 268.

The following three cases concerning characters or celebrities are particularly good examples of cases in which the common field of activity doctrine was applied:

#### 4.4.5.1. *Wombles Ltd v Wombles Skips*<sup>475</sup>

The plaintiffs in *Wombles Ltd v Wombles Skips* were the owners of the copyright in the original book and drawings of the fictitious characters called ‘Wombles’, which later featured in a same-named television series. The ‘Wombles’ are furry creatures with pointy noses which display an environmental awareness by collecting and recycling litter. The plaintiffs exploited the copyright in the book and the drawings of the ‘Wombles’ to a great extent. Licences had been granted for goods varying from yoghurt to magic slates to waste paper baskets.<sup>476</sup> The defendants produced refuse skips. They incorporated the name ‘Wombles’ into the company name, because these characters were portrayed as very tidy. The defendants hoped for a positive image in the eye of the purchasing public.<sup>477</sup> The counsel for the plaintiffs adduced the argument that the plaintiffs’ licensing potential in the name of the ‘Wombles’ was reduced by the defendants’ use of said name in relation to waste collection. It is submitted that this argument is particularly fitting, because ‘Wombles’ are characters that collect waste. Even so, the plaintiffs lost the case. Hence, they could not extend their business and license the name ‘Wombles’ to be used on rubbish skips.

The reason for the action failing was the common field of activity condition. Walton J maintained that no one would assume that there is any business connection between the defendants’ business of manufacturing rubbish containers and the plaintiffs’ business, the licensing of copyright reproductions.<sup>478</sup> Interestingly, the learned judge commented though that: ‘It may be a defect in the law that, having invented the

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<sup>475</sup> *Wombles Ltd v Wombles Skips Ltd* [1975] FSR 488. The ‘Wombles’ were created by Elisabeth Beresford (authoress) and Margaret Gordon (initial book illustrations).

<sup>476</sup> *Ibid* 489.

<sup>477</sup> *Ibid* 490.

<sup>478</sup> *Ibid* 491; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 567; Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 7-152; Tina Hart, Simon Clark and Linda Fazzani, *Intellectual Property Law* (6<sup>th</sup> edn, palgrave macmillan 2013) 143.

characters known as the “Wombles“, the authoress has not a complete monopoly of the use of that invented word ... but such is the law<sup>479</sup>.

#### 4.4.5.2. *Taverner Rutledge Ltd v Trexapalm Ltd*<sup>480</sup>

Regardless of his personal opinion, Walton J had to hold against the plaintiff again in *Taverner Rutledge Ltd v Trexapalm Ltd*. This dispute concerned the authorized exploiter (defendant) of the fictitious character ‘Kojak’ from the eponymous TV detective series. ‘Kojak’ was a detective well-known for his fondness for lollipops. The defendant had obtained a licence from the rightholders in the TV series with regard to selling lollipops under the name ‘Kojak Lollies’. The plaintiffs were manufacturers of lollies as well, and sold these under the name ‘Kojakpops’. Contrary to the defendant, the plaintiffs had no licence from the owners of the TV show. The plaintiffs brought an action for passing off against the official licensees. The plaintiffs’ action succeeded, because they had already built up substantial business with a strong goodwill before the defendants had even begun trading.<sup>481</sup> The defendant’s licence was not a valid defence, because the field of the lollipop manufacturers and sellers was very different from that of the producers of the television series. Hence, they had no property in the name ‘Kojak’ for the production and sale of lollies.<sup>482</sup> Moreover, Walton J did not accept the argument that character merchandising through the granting of licences was a well-known practice among the public by then and that the potential consumers would be confused into connecting the plaintiffs’ lollipop business with the TV series, since the lollipops bore the name of the protagonist of the TV series, and lollipops were the trade mark of that fictitious character.<sup>483</sup>

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<sup>479</sup> *Wombles Ltd v Wombles Skips Ltd* [1975] FSR 488, 491; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 26; Allison Coleman, ‘Character Merchandising and Fictitious Characters’ (1982) 10 EIPR 285, 286 et seq.

<sup>480</sup> *Taverner Rutledge Ltd v Trexapalm Ltd* [1975] FR 479.

<sup>481</sup> John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 85.

<sup>482</sup> *Taverner Rutledge Ltd v Trexapalm Ltd* [1975] FR 479, 480; Geoffrey Hobbs, ‘Passing Off and the Licensing of Merchandising Rights Part 2’ (1980) EIPR 79.

<sup>483</sup> *Taverner Rutledge Ltd v Trexapalm Ltd* [1975] FR 479, 485.

#### 4.4.5.3. *Lyngstad v Anabas Products Ltd*<sup>484</sup>

The *Lyngstad v Anabas Products Ltd* case, in which the Swedish pop group attempted to stop unauthorized traders from selling ABBA T-shirts and pillow cases had the same outcome as the ‘Wombles’ and the ‘Kojak’ case. The principal distinguishing point to the two aforementioned cases was that Oliver J believed that the common field of activity concept is tantamount to a likelihood of confusion.<sup>485</sup> He held that there was no confusion in this case, because the potential consumers would not think that goods bearing the name or effigy of ABBA were derived from the pop group itself,<sup>486</sup> despite the fact that the only rational purpose of the use of the name and image of ABBA was to further the sales of the paraphernalia. ABBA had no goodwill for merchandising their image, as they had not started merchandising yet at the time of the action for passing off. Their goodwill in music was held not to extend to merchandising.<sup>487</sup>

#### 4.4.6. Departure from the strict doctrine

In all the above outlined cases the prerequisite of a common field of activity prevented the judges from making a decision that would have favoured the originator, other proprietor of the rights in the work featuring the character, or licensee thereof. The common field of activity doctrine was also a major drawback for the entertainment industry, which was regarded as operating in a separate field of business.<sup>488</sup>

However, the common field of activity condition was re-evaluated in later case-law. The question was no longer whether there is a common field of activity, but whether

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<sup>484</sup> *Lyngstad v Anabas Products Ltd* [1977] FSR 62.

<sup>485</sup> *Ibid* 67; John Hull, ‘The merchandising of real and fictional characters: an analysis of some recent developments’ (1991) 2 Ent LR 124, 128.

<sup>486</sup> *Lyngstad v Anabas Products Ltd* [1977] FSR 62, 67 et seq; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 567 et seq; Lionel Bently and Brad Sherman, *Intellectual Property Law* (4<sup>th</sup> edn, OUP 2014) 854 et seq; Hazel Carty, ‘Advertising, publicity rights and English law (2004) 3 IPQ 209, 236; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 27.

<sup>487</sup> *Lyngstad v Anabas Products Ltd* [1977] FSR 62, 66 and 70; Hazel Carty, ‘Advertising, publicity rights and English law (2004) 3 IPQ 209, 236.

<sup>488</sup> Geoffrey Hobbs, ‘Passing Off and the Licensing of Merchandising Rights’ (1980) EIPR 47.

there is a likelihood of confusion.<sup>489</sup> Falconer J rejected the common field of activity doctrine in *Lego System Aktieselskab v Lego M Lemelstrich*,<sup>490</sup> claiming that the real issue was whether similarities between the opposing parties' goods/services would confuse a sufficient number of representatives of the relevant public. The common field of activity was downgraded to just an indication within the evaluation of confusion.<sup>491</sup> The plaintiffs in this case were the producers of the coloured plastic building bricks. They sought to prevent the defendants from selling irrigation equipment under the name 'Lego'. Their action succeeded. It was held that the reputation of the plaintiffs went far beyond children's toys, and the admittedly *bona fide* use of the name 'Lego' on irrigation equipment would make consumers believe that these goods were connected to the producer of the toys.<sup>492</sup> It was feared that any deficiencies in goods produced by other manufacturers would be attributed to Lego, the toy manufacturer, and consequently would have a bad effect on the reputation of Lego bricks. Furthermore, it was held that the plaintiffs should retain their option to expand their business and exploit their renown in areas outside their present activities.<sup>493</sup>

The outcome of this case was rather unusual. In general, the further apart the fields of activity of the parties are, the more difficult it becomes to show that the operation of the defendant has misled the relevant public. This means that the reputation of the claimant's undertaking and the evidence of confusion must be stronger in cases where the parties operate in very different fields of activity than in cases where both parties

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<sup>489</sup> Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 5-112; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 85.

<sup>490</sup> *Lego System Aktieselskab v Lego M Lemelstrich Ltd* [1983] FSR 155.

<sup>491</sup> *Ibid* 186 et seq; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 550 et seq; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 228 et seq; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 29; Jon Holyoak, 'United Kingdom character rights and merchandising rights today' (1993) JBL 444, 452.

<sup>492</sup> *Lego System Aktieselskab v Lego M Lemelstrich Ltd* [1983] FSR 155, 156; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 663; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 86; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 29.

<sup>493</sup> *Lego System Aktieselskab v Lego M Lemelstrich* [1983] FSR 155, 196; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 451; Jon Holyoak, 'United Kingdom character rights and merchandising rights today' (1993) JBL 444, 452.



operate in the same field of business.<sup>494</sup> The famous London store ‘Harrods’ was unable to stop a school from naming itself ‘The Harroddian School’. The Court of Appeal was convinced that the public would not be confused into thinking that there was a connection between the two undertakings. The link between the two names was insufficiently strong. Furthermore, there was no overlap between the plaintiff’s undertaking and the defendant’s business.<sup>495</sup> However, one may have argued the same in the ‘Lego’ case. There was certainly no overlap between the manufacturers of the Lego toys and the irrigation equipment. The reputation of the name Lego and goodwill in the toy company was held to be so prominent, though, that the case was decided in favour of the toy manufacturers. Falconer J had maintained that it would be much more difficult to be successful in an action for passing off if the name in which the goodwill of an undertaking resides was less well-known.<sup>496</sup> Surely, Harrods is not much less known than Lego? The different outcome of these two cases demonstrates clearly how fickle the assessment of the facts and evaluation of confusion can be.

#### 4.4.7. Awareness of character merchandising

The concept of a ‘common field of activity’ was not applied rigidly in the above cases, but was classified as merely an ‘evidential factor’.<sup>497</sup> The formerly absolute test became an indicator of the likelihood of confusion suffered by the relevant public.<sup>498</sup> However, only as such it still poses obstacles to this day, because it is an indication for a real possibility of confusion, which is the basis of the action.<sup>499</sup> Hence it places a significant

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<sup>494</sup> *Lego System Aktieselskab v Lego M Lemelstrich* [1983] FSR 155, 187; James Mellor et al, *Kerly’s law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 620; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 29.

<sup>495</sup> *Harrods Limited v The Harroddian School Limited* [1996] RPC 697, 699; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 29; Peter Jaffey, ‘Merchandising and the law of trade marks’ (1998) 3 IPQ 240, 250 et seq.

<sup>496</sup> *Lego System Aktieselskab v Lego M Lemelstrich* [1983] FSR 155, 187; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 29 et seq.

<sup>497</sup> Howard Johnson, ‘Legal Aspects of Character Merchandising’ (1992) 34 *Managerial Law* 1, 11; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 228 et seq.

<sup>498</sup> Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 5-106; Jennifer Davis, *Intellectual Property Law* (4<sup>th</sup> edn, OUP 2012) 179 et seq; Reuben Stone, ‘Titles, character names and catch-phrases in the film and television industry: protection under the law of passing off’ (1996) 7 *Ent LR* 263, 269.

<sup>499</sup> *Harrods Limited v The Harroddian School Limited* [1996] RPC 697, 699; *Lyngstad v Anabas* [1977] FSR 62, 67; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 550 et seq; Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation*

evidential burden on the plaintiff in relation to misrepresentation and a real likelihood of damage.<sup>500</sup>

Crucial to the element of confusion is also whether or not the public has an awareness of the practice of character merchandising.<sup>501</sup> It is a powerful tool to produce evidence that there is an awareness of character merchandising in the public mind, and that consequently unofficially (unauthorized) manufactured and sold merchandise would be easily regarded as official merchandise from the originator of the character. Goulding J accepted, *obiter*, in the ‘Judge Dredd’ case that there was some such awareness among the public.<sup>502</sup>

The position of originators of characters who were also engaging in character merchandising initially seemed to be strengthened in the ‘Turtles’ case, as well. The defendants were selling clothes bearing images of humanoid turtles, like the plaintiffs. The images of these turtles, however, were not identical, but only similar to the ‘Turtles’ created by the first plaintiffs. Even so it was held that there was evidence that the buying public would confuse the two products. Moreover, *Browne-Wilkinson V-C* accepted that the potential customers thought that character merchandising required a licence.<sup>503</sup> The defendants had not obtained any such licence from the plaintiffs. Consequently the plaintiffs’ business was negatively affected in two ways. For one thing the plaintiffs were losing licensing fees, and for another thing they were losing sales as the defendants were selling the same products with images of turtles.<sup>504</sup>

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(5<sup>th</sup> edn, Sweet & Maxwell 2016) para 5-106; Howard Johnson, ‘Legal Aspects of Character Merchandising’ (1992) 34 *Managerial Law* 1, 11; Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 514.

<sup>500</sup> James Mellor et al, *Kerly’s law of trade marks and trade names* (15<sup>th</sup> edn, Sweet & Maxwell 2011) 835; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 229; Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 514; Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 867.

<sup>501</sup> Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 30; Jon Holyoak, ‘United Kingdom character rights and merchandising rights today’ (1993) *JBL* 444, 450.

<sup>502</sup> *IPC Magazines Ltd v Black & White Music Corporation* [1983] *FSR* 348, 352; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 86; Jon Holyoak, ‘United Kingdom character rights and merchandising rights today’ (1993) *JBL* 444, 451.

<sup>503</sup> *Mirage Studios and others v Counter-Feat Clothing Company Limited and Another* [1991] *FSR* 145, 146 and 155; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 31.

<sup>504</sup> *Mirage Studios and others v Counter-Feat Clothing Company Limited and Another* [1991] *FSR* 145, 155 et seq; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 31.

Laddie J, however, maintained in *Elvis Presley Trade Marks* (High Court) that the ‘Turtles’ case did not lay down ‘a finding of fact of universal application’ that, in similar circumstances,

- the claimant’s goods were regarded as the ‘genuine article’ attributable to a single source in similar circumstances, and that
- competing traders were therefore misrepresenting the origin of the goods.<sup>505</sup>

It must always be judged in the individual case whether the consumers viewed the products as genuine and hence whether a misrepresentation has been made. That means, Laddie J did not accept a general awareness of the public for character merchandising nor did he agree that the public would assume that merchandising goods had to be licensed by the originator. The learned judge argued that the buyers of character toys or other merchandising goods do not care who produced and sold the goods and whether or not the character was licensed, because they were simply interested in buying a product depicting a character that has taken their fancy. When, for example, buying a mug the buyer is interested in obtaining a cup bearing the image of a particular star, not a product from a certain source. Therefore, evidence needs to be shown in every individual case that the public believes that a character/celebrity’s likeness stems from a particular source that can be attributed to the originator/celebrity.<sup>506</sup>

Laddie J’s High Court ruling in the ‘Elvis’ case was re-affirmed by the Court of Appeal two years later, which added that there shall be no assumption that solely the celebrity could market or license his image and character.<sup>507</sup> *Halliwell and Other v Panini*<sup>508</sup> also confirmed Laddie’s assessment. The plaintiffs in this case, a pop group known under the name Spice Girls, failed to demonstrate a misrepresentation by the defendant who

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<sup>505</sup> *Elvis Presley Trade Marks* [1997] RPC 543, 553; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 452.

<sup>506</sup> *Elvis Presley Trade Marks* [1997] RPC 543, 554; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 452 et seq.

<sup>507</sup> *Elvis Presley Trade Marks* [1999] RPC 567, 593 et seq and 597 (Morritt LJ); Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 514; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 453 et seq.

<sup>508</sup> *Halliwell and Other v Panini SpA* [1997] (unreported).

sold an unauthorized collection of stickers bearing images of the Spice Girls. The court found that the public would not believe that the stickers by Panini were licensed by the pop group.<sup>509</sup> Like Laddie J, the judge in the Spice Girls case, stated that the source of the stickers was of no concern to the consumers. The buying public was merely interested in buying goods bearing the image of the celebrities and not in the origin of the product.<sup>510</sup> Reliance on the fact, that the use or licensing agreements is common nowadays, is insufficient by itself. Specific evidence is necessary to support a claim in passing off.<sup>511</sup>

#### 4.4.8. Points to consider when establishing confusion

Since there is disagreement as to whether or not the buying public has an awareness for character merchandising, it is of importance to ask who the relevant public is and how confusion is proven.

The term ‘relevant public’ denotes a notional average consumer. Under trade mark law this would be a reasonably well informed and reasonably circumspect and observant member of the purchasing public.<sup>512</sup> In passing off cases, the court must take the customers of the goods/services as it finds them.<sup>513</sup> In principle, it will be an ordinarily sensible representative of the public.<sup>514</sup> The standard varies though depending on the market of the concerned undertakings. In the case *Asprey & Garrard v WAR (Guns) Ltd* the relevant consumers were typically very wealthy, foreign, and unfamiliar with the

<sup>509</sup> Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 574; Andrew McGee, Sarah Gale and Gary Scanlan, ‘Character merchandising: aspects of legal protection’ (2001) 21 *Legal Studies* 266, 243; Bernard M Nyman, ‘Passing off – sale of “unofficial” merchandise’ (1997) 8 *Ent LR* E94; Jennifer Davis, *Intellectual Property Law* (4<sup>th</sup> edn, OUP 2012) 195.

<sup>510</sup> *Halliwell and Other v Panini SpA* [1997] (unreported); Bernard M Nyman, ‘Passing off – sale of “unofficial” merchandise’ (1997) 8 *Ent LR* E95; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 453.

<sup>511</sup> *Halliwell and Other v Panini SpA* [1997] (unreported); Bernard M Nyman, ‘Passing off – sale of “unofficial” merchandise’ (1997) 8 *Ent LR* E94 et seq; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 454.

<sup>512</sup> Case T-623/11 *Pico Food GmbH v OHIM* (CJEU (Second Chamber) 9 April 2014) para 30; *Linkin Park LLC’s Application* [2006] *ETMR* 74 [34]; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 226.

<sup>513</sup> Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 225 et seq.

<sup>514</sup> Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 8-48.

English language as well as London.<sup>515</sup> In *Edge v Niccolls*, on the other hand, the relevant consumers were cottagers, washerwomen and other likely illiterate people.<sup>516</sup> In other cases, the court may even take the ignorant and wary into account,<sup>517</sup> but the court cannot argue that the relevant public would not have been deceived had the consumers been more careful or perspicacious.<sup>518</sup> That also means that if a consumer does not care whether she is buying the goods from the plaintiff or the defendant, the original or the fake, the licensed or unauthorized, then any confusion caused in the consumer is irrelevant, because the consumer was not moved to buy the goods of the defendant as a result of the defendant's misrepresentation. It is the wrong sort of confusion for an action of passing off, because the misrepresentation is not cause for the damage.<sup>519</sup>

#### 4.4.9. Mr Spoon, Rihanna, and Betty Boop

The years 2013 and 2014 saw two major and one less known character merchandising case. The last-mentioned case concerns 'Mr Spoon', an AFC from the hand puppet play *Mr Spoon on Button Moon* (2013).<sup>520</sup> From the other two very well-known cases, one pertains to the celebrated singer Rihanna (2013)<sup>521</sup> and the other to the AFC 'Betty Boop' (2014).<sup>522</sup> These three cases will be examined to establish whether the application of the tort of passing off with regard to character rights has developed, and, if so, how, or whether the old issues continue.

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<sup>515</sup> *Asprey & Garrard Ltd v WAR (Guns) Ltd (t/a William R Asprey Esquire)* [2002] FSR 30 [11] (Jacob J); Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 8-48.

<sup>516</sup> *William Edge & Sons Ltd v William Niccolls & Sons Ltd* [1911] AC 693, 704; Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 8-48.

<sup>517</sup> *Singer Manufacturing Co v Loog* [1882] 8 App Cas 15, 18; *Taittinger SA v V Allbev Ltd* [1993] FSR 641, 667; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 32.

<sup>518</sup> *Reckitt & Colman Products v Borden Inc* [1990] 1 WLR 491, 508; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 226; Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 172.

<sup>519</sup> Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 227; Ceri Lynn Delemore, 'Character merchandising – the position under English law: a review of the Teenage Mutant Ninja Turtles Case' (1992) 13 Media Law & Practice 229, 231.

<sup>520</sup> *Allen v Redshaw* [2013] WL 2110623.

<sup>521</sup> *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 (Ch); confirmed by the Court of Appeal in 2015: *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3.

<sup>522</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch).

#### 4.4.9.1. *Allen v Redshaw*<sup>523</sup>

Arnold J's decision in *Allen v Redshaw* confirms that AFCs (drawings of the hand puppet characters 'Mr Spoon' and Co.) attract goodwill through the hand puppet shows, the television reproduction, and licensed character merchandise, such as T-shirts.<sup>524</sup> Mr Redshaw had applied images very similar to the AFCs from Button Moon on mugs and shirts. He had no licence for his merchandising operation from Mr Allen. Arnold J stated that Mr Redshaw had thereby misrepresented the unauthorized character merchandising items as official merchandise.<sup>525</sup> Here, Arnold J implied that the public would believe the items were licensed goods connected to Mr Allen. Due to the brevity of the decision regarding this, it is unclear whether Arnold J assumed in general that the public would believe in licensing by creators of characters or whether he came to his conclusion on the facts of the case.

Moreover, Arnold J held that the main defence against passing off, a disclaimer, fails in this case.<sup>526</sup> The defendant's disclaimer on the goods was either in very small print or 'well-nigh invisible, even in good light', and on one occasion was only found after the defendant Mr Redshaw had pointed it out to Arnold J. The discussion of a disclaimer suggests that if a disclaimer on the goods is strong enough, the creator of AFCs and official licensees could not prevent an unauthorized character merchandiser from selling unofficial merchandise. Consequently, unauthorized character merchandisers riding on the wave of the creator's success could easily avoid legal liability for passing off and the creator's loss in licensing fees.

#### 4.4.9.2. *Fenty v Arcadia Group Brands Ltd (t/a Topshop)*<sup>527</sup>

The first modern reported case in which a celebrity succeeded in preventing the use of their likeness on products is *Fenty v Arcadia Group Brands Ltd (t/a Topshop)*.<sup>528</sup> The

<sup>523</sup> *Allen v Redshaw* [2013] WL 2110623.

<sup>524</sup> *Ibid* [32].

<sup>525</sup> *Ibid* [33].

<sup>526</sup> *Ibid* [35] et seqq.

<sup>527</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3; *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 (Ch).

<sup>528</sup> Nick Aries, 'Lifeline for leading lights?' (July/August 2014) ITMA Review 10.

first claimant, Rihanna, is a famous singer. The defendants are Arcadia Group Brands Ltd, trading under the name Topshop, and Top Shop/Top Man Ltd, a well-known clothing retailer. The defendants commenced selling T-shirts bearing an image of the claimant Rihanna. The image had been taken by an independent photographer. Topshop had taken out a licence from this photographer, but did not obtain a licence from Rihanna. Rihanna claimed that selling these shirts without her permission infringed her rights.<sup>529</sup>

There is no general right of celebrities to control the reproduction of their image.<sup>530</sup> Hence, the classical trinity of passing off has to be considered.<sup>531</sup>

#### 4.4.9.2.1. Goodwill

Rihanna is not only a famous pop singer, but also operates through her companies a large merchandising and endorsement business. She had licensed Bravado/Live Nation to sell Rihanna merchandise, which included clothing, at Topman (which is part of the Arcadia Group, one of the defendants in this case). Moreover, she herself made an effort to make a name for herself in the world of fashion. She worked with H&M Fashion Against Aids, Gucci, Armani, and River Island.<sup>532</sup> For these reasons Rihanna had goodwill. Her goodwill as a music artist did not extend beyond music, but rather she has a separate goodwill in the world of fashion, because she is active as a designer and promoter of fashion and has become a style icon.<sup>533</sup>

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<sup>529</sup> *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 (Ch) [1]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 593.

<sup>530</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [29]; *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 (Ch) [2]; *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [106]; *Douglas & ors v Hello! Ltd & ors (No 3)* [2007] UKHL 21 [253], [285] and [293]; Susan Fletcher and Justine Mitchell, ‘Court of Appeal found no love for Topshop tank: the image right that dare not speak its name’ (2015) 37 EIPR 394, 400.

<sup>531</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [33]; *Reckitt & Coleman Products Ltd v Borden Inc* [1990] 1 WLR 491, 492.

<sup>532</sup> *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 (Ch) [38] - [42].

<sup>533</sup> *Ibid* [41] et seq and [45] et seq.

#### 4.4.9.2.2. Misrepresentation

Both, Birss J (High Court) and Kitchin LJ (Court of Appeal), agreed that one cannot simply assume that the public will generally believe a consumable commercial item is endorsed by a celebrity just because the item bears their name or image.<sup>534</sup> Since an action for passing off depends on the nature of the relevant market and the perceptions of the relevant buying public, its outcome is always a question of fact and not based on general assumptions.<sup>535</sup> Therefore, Rihanna had to provide evidence that a substantial number of the relevant consumers assumed that she had authorized the print of her image on a shirt.<sup>536</sup> A factor to consider according to Birss J is that today's consumers are much more aware that music artists are active in merchandising and endorsement operations.<sup>537</sup>

Topshop had made it look like there was a connection between Topshop and Rihanna. In 2010, Topshop had run a shopping competition. The winner was offered the chance to go shopping at Topshop's flagship store at Oxford Circus, London, with Rihanna as style consultant. Moreover, Topshop publicity material made a point of Rihanna wearing or choosing clothing from Topshop. Shortly before launching the offending shirt, the Rihanna tank, Rihanna had been indeed shopping at Topshop. Topshop once again exploited this via Twitter.<sup>538</sup> These public links between Topshop and Rihanna enhanced the likelihood that the relevant consumers believe the shirt was authorized by the artist.<sup>539</sup>

Another factor giving the impression that the shirt was endorsed by Rihanna was that the image of Rihanna displayed on the shirt was taken from a video shot for her single 'we found love', a recent musical release subsequent to the sale of the tank top by Topshop. Although some buyers will not give any thought to the question of authorization when purchasing the shirt, a substantial portion of buyers of the shirt will think the garment was authorized by Rihanna, especially her fans will recognize the

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<sup>534</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [41]; *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 [34], [53] and [55].

<sup>535</sup> *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 [34], [53] and [55]; Glen Gibbons, *Trade Marks Law* (2<sup>nd</sup> edn, Clarus Press 2016) 92.

<sup>536</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [43]; *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 [34], [53] and [55].

<sup>537</sup> *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 (Ch) [53].

<sup>538</sup> *Ibid* [56] et seq.

<sup>539</sup> *Ibid* [71].



image as taken from her recent album 'Talk That Talk' and will regard the sale of the shirt as a marketing campaign by Rihanna for her new album.<sup>540</sup> The thought that the shirt was endorsed by Rihanna is part of their motivation behind purchasing the shirt, because for many of her fans she is their style icon.<sup>541</sup> Consequently, the defendants made a misrepresentation.<sup>542</sup>

The 'Rihanna' case elucidates the critical issue of misrepresentation well. If the consumer is motivated to buy the product, because she wants to buy an item with the image of the pop star, then there is no misrepresentation.<sup>543</sup> If on the other hand the consumer bought the item, thinking that it was official merchandise, authorized by the celebrity where that was in fact not the case, then a misrepresentation might have taken place. It is not necessary that this was the sole reason for buying the item. It is sufficient, if the name and/or image were taken by the consumers as denoting the source of the goods,<sup>544</sup> and if their belief played part in the consumer's decision to buy the product.<sup>545</sup> The false suggestion that the goods are licensed is not sufficient though to qualify as misrepresentation in an action for passing off, if the lie is not material, i.e. if the fact whether or not the goods were licensed has no effect on the buying decision.<sup>546</sup> In the 'Rihanna' case, however, it was found that the buyers had been motivated to buy the shirt with Rihanna's well-known image from her recent video shoot, because Rihanna is their idol of style and not because she is a music artist. Hence, there was a misrepresentation on the part of the defendants Topshop and others.

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<sup>540</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [61]; *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 [69]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 597; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 13.

<sup>541</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [47] and [51]; *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 [72].

<sup>542</sup> *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 [73].

<sup>543</sup> *Ibid* [35].

<sup>544</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [45].

<sup>545</sup> *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 (Ch) [36].

<sup>546</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [45] et seq.

#### 4.4.9.2.3. Damage

This false belief of authorization led to loss of sales from Rihanna's own merchandising business as well as loss of control over her reputation in the fashion sphere.

The 'Rihanna' case once more demonstrates that the common field of activity doctrine is not entirely outdated. If Rihanna had not had a reputation in the fashion world, she would not have succeeded with her action for passing off.<sup>547</sup> It was the fact that she operated in the same line of business as the defendant that saved her. Her reputation for music would not have protected her interests in her own image and the creation and sale of merchandise bearing her image.

#### 4.4.9.3. *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others*<sup>548</sup>

Another merchandising case decided by Birss J is *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others*. The claimants in this case were the successors of the creator of the 'Betty Boop' cartoons. They had been selling 'Betty Boop' merchandise for a few decades when the first defendant (AVELA) started licensing the 'Betty Boop' images and the word 'Boop' for merchandising goods, and the second and fifth defendant (Poeticgem and J Fox) took out licences from AVELA via the third defendant (AVELA's UK licensing agent TPTL), and the fourth defendant (U Wear) distributed the goods (T-shirts and bags) supplied by Poeticgem and J Fox.

The claimants were able to establish that they owned a substantial goodwill in the name and image of 'Betty Boop' in the UK.<sup>549</sup> Birss J then focused on the question how the general public would perceive the shirts and bags bearing the 'Betty Boop' character. He maintained that the average consumer regarded the items of the defendants as 'Betty Boop' merchandise, because the character 'Betty Boop' and the word 'Boop' were printed on these.<sup>550</sup> However, did the public believe the defendant's items to be official merchandise or unofficial goods? The public had only known official

<sup>547</sup> *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 (Ch) [45] and [75].

<sup>548</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch).

<sup>549</sup> *Ibid* [120]; Glen Gibbons, *Trade Marks Law* (2<sup>nd</sup> edn, Clarus Press 2016) 91.

<sup>550</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [120].

'Betty Boop' merchandise until the complained of acts by the defendants began. The claimants had been the single source before the defendants entered the market.<sup>551</sup> The labels on the defendants' products bore the words 'Officially Licensed Product' or 'Official Licensee'. This reinforced the trade origin significance of the depiction of the character 'Betty Boop' on the goods. It indicated to the public that these goods come from the official merchandise source. Although only the word 'Boop' and not 'Betty Boop' was printed on some of the goods in combination with an image of the character, Birss J stated that the public would view the items as coming from the genuine source, the claimants. He doubted whether many consumers would notice that it merely said 'Boop' and not 'Betty Boop' below the image of the cartoon character.<sup>552</sup>

The fact that the mark Radio Days was printed on the label did not negate this impression. The public might merely assume that the official source, the claimants, were selling under the trade name Radio Days, which was in fact a trade mark of one of the defendants, or that Radio Days had an official licence from the claimants.<sup>553</sup> Neither of these assumptions are correct. Hence, the purchasing public wishing to obtain the genuine article are deceived by the defendants. This damages the goodwill of the claimants in turn.<sup>554</sup>

The defendants tried to argue though that the items (bags, shirts) were merely memorabilia and the use of the character was simply decorative. Birss J rejected the defendants' view. He conceded that some consumers will purchase the items without regard to whether or not these come from the official 'Betty Boop' merchandiser. He adds, though, that a significant portion of consumers want the merchandise to be genuine, i.e. from the official source, and would as a result be deceived by the defendants which were licensing and selling unofficial 'Betty Boop' merchandise.<sup>555</sup>

Once again, there is no general assumption that the public believes a product displaying a character or image of a celebrity always originated from the creator of the character or celebrity in question. Birss J made his decisions on the facts of the cases.

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<sup>551</sup> Ibid [103] and [121].

<sup>552</sup> Ibid [132].

<sup>553</sup> Ibid.

<sup>554</sup> Ibid.

<sup>555</sup> Ibid [133].

The originator won the case, because ‘It is plain on the evidence that for about 20 years in the UK the claimants have been the sole source of ‘Betty Boop’ merchandise. There was no other realistic source until AVELA came along.’<sup>556</sup> During those 20 years, the claimants built up goodwill for ‘Betty Boop’ merchandise. They acquired goodwill first. If the defendants had been merchandising first and had built up goodwill for ‘Betty Boop’ merchandise first, then the defendants would have won the case.

Hence, it is still fraught with difficulty for the creator of a character or a celebrity to protect their LFC and/or its name against unauthorized character merchandising by means of an action for passing off.

#### **4.4.10. Protection against use of a character in another literary work**

Cornish, Llewelyn and Aplin maintain that despite its deficiencies in protecting an author’s LFCs against unauthorized merchandising operations, an action for passing off may sometimes be raised in aid against ‘interlopers’ who wish to exploit the author’s characters in the same line of business.<sup>557</sup> That means, authors, publishing houses, and film production companies may prevent another person from publishing a book, making a film, or communicating fanfiction to the public which features ‘their’ LFCs.<sup>558</sup>

Wadlow on the other hand professes that if a LFC, storyline, theme or other literary creation is adopted by another author or publishing company without the originator’s consent, an action for passing off will not be successful. He states that passing off deals merely with misrepresentation, and not with misappropriation. He explains that, although the following works are all featuring characters which are derived from other writer’s works, it would usually not be conjectured that there is any misrepresentation

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<sup>556</sup> Ibid [79].

<sup>557</sup> William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 682 et seq.

<sup>558</sup> Whether or not one can include film production companies here depends on how wide one draws the field of business. One should bear in mind in this regard that films and shows are commonly scripted. A script is a literary work, like a novel or poem.

in Tom Stoppard's *Rosencrantz and Guildenstern are Dead* or George MacDonald Fraser's series *Flashman*.<sup>559</sup>

Granted, in these examples the well-read consumer would know that 'Rosencrantz' and 'Guildenstern' are minor characters from William Shakespeare's *Hamlet*. Moreover, the author's name, Tom Stoppard, is printed on the cover of *Rosencrantz and Guildenstern are Dead*. Hence, the relevant consumers would not be confused as to who the originator is and who wrote the later work. The potential consumers would not believe Tom Stoppard was the creator of the character's 'Rosencrantz' and 'Guildenstern'. There is no misrepresentation from Tom Stoppard's side, neither intentionally nor unintentionally. Rather, since Stoppard's play is a tragicomedy parodying the original *Hamlet*, it will commonly be read by those who have read Shakespeare's *Hamlet* previously. Hence, there is no diversion of business, no financial damage, although there is financial benefit by Stoppard due to the fact that he is using Shakespeare characters and scenes from *Hamlet* in his play. In addition, Shakespeare's works are in the public domain – so this example is rather hypothetical.

Therefore, it is submitted that an action for passing off is neither as 'reliable' as Cornish, Llewelyn and Aplin state nor as impossible as Wadlow maintains. Author A (originator) may resort to an action for passing off, if author B presents author A's LFC as her's. However, there are high hurdles to overcome.

For example, if the buying public does not recognize the character in author B's work as that of author A, then an action for passing off would fail due to lack of goodwill of author A in her LFC.

Even if the reader recognizes the character or its name, an action for passing off may nevertheless fail.

In *Conan Doyle v London Mystery Magazine*,<sup>560</sup> the defendant published a detective magazine in which he made reference to 'Sherlock Holmes'. The magazine also pretended to be published in 221B Baker Street. Wynn-Parry J decided that the

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<sup>559</sup> Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 8-242.

<sup>560</sup> *Conan Doyle v London Mystery Magazine* [1949] 66 RPC 312.

goodwill in Sir Arthur Conan Doyle's 'Sherlock Holmes' series did not sustain any damage, stating that the magazine was merely boasting to be worthy of 'Sherlock Holmes' standards.<sup>561</sup> One might argue though that the defendant is hampering the plaintiff's opportunities to license the publication of such a mystery magazine. The same may have been said in the next case.

The plaintiffs in *Grundy Television v Startrain*<sup>562</sup> were the producers of the television soap *Neighbours*. The defendants published the magazine *Neighbours Who's Who* about the fictional characters created for the TV series. Since the defendants offered to write the title of the magazine in a script other than was used for the TV soap opera, interlocutory relief was denied, because there was no misrepresentation by the defendants implying a connection with the plaintiffs. The name of the magazine was chosen to make the subject matter of the magazine apparent. The plaintiffs stood to lose potential revenue, though, if they were to issue a similar magazine.<sup>563</sup> However, the judge did not even get that far as to consider damage, because it was found there was already no misrepresentation. It is interesting to note in that case that what the judge considered was merely whether the name of the magazine implied a connection to the plaintiffs. He did not consider whether exploiting the characters and plot of the TV show implied a connection to the plaintiffs.

Whether or not a work of fanfiction was misrepresented as a work by the originator must be decided on the individual facts of the case, too. A factor coming into play could be how apparent it is that the fanfiction is no more than a work by a fan of the author of the underlying work and not another work by the originator.<sup>564</sup> Another factor is the size of the fanfiction. It has commonly, but not always, a much lower word count than an officially published original. In some cases of fanfiction, even a disclaimer is used

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<sup>561</sup> Ibid; Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 8-242.

<sup>562</sup> *Grundy Television Pty Ltd v Startrain Ltd* [1988] FSR 581 (Millet J).

<sup>563</sup> Ibid 582; Christopher Wadlow, *The Law of Passing-Off – Unfair Competition by Misrepresentation* (5<sup>th</sup> edn, Sweet & Maxwell 2016) para 8-242.

<sup>564</sup> Tamara Bukatz, 'Amazon's fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part I' (2013) 18 (4) *Communications Law* 122, 125.

by the fanfiction writer. Fanfiction is mostly communicated to the public via online fanfiction databases some of which require registration. These contain fanfiction exclusively and the fanfiction writers generally leave their name or alias on the fanfiction. However, there is a small risk that these databases are not just accessed by those who actively look for fanfiction, but also those who have never heard of fanfiction and will not recognize it as such. Many copyright works, mostly films and music, but also novels and comics are available for free on the internet. Hence, a reader of fanfiction might get confused as to the origin of a work. Especially when the fanfiction is written convincingly like the canon, a 'layperson' is at risk of believing the fanfiction to have been written by the originator of the canon. It is an inherent risk of fanfiction to be attributed to the author of the original, because fanfiction often stays within the boundaries of the original, meaning e.g. the World, the elements, story, characters, etc. created by the originator of the underlying work. Whether a court would actually find for the plaintiff in an action for passing off against the writer of fanfiction would depend though strongly on how prominent the name of the actual author, how strong the resemblance to the original work, and how strong the disclaimer is. Furthermore, it is difficult to say whether freely accessible fanfiction of underlying commercialized works have a financially detrimental effect on the author of the canon in the form of financial loss resulting from reduced sales, or whether instead fanfiction whets the appetite for more from the originator. The advent of Kindle Worlds, Amazon's online fanfiction store, on the US market on 27<sup>th</sup> June 2013 may give the opportunity to collect valuable data on or at least an indication of the effect of fanfiction on the creative industry, especially the financial gain or loss.<sup>565</sup>

#### **4.5. Conclusion**

Some aspects of an action for passing off are favourable in comparison to copyright. However, overall it is impractical in respect of protection of LFCs.

A factor weighing in favour of copyright, depending on the vantage point, is that copyright lasts for 70 years from the end of the year in which the copyright owner died. Hence, though copyright protects authors and their creations, it does so only for a

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<sup>565</sup> Ibid.

limited period of time. In contrast, an action for passing off may be brought six years from the date when the cause of action occurred, i.e. when the claimant's goodwill was injured by a misrepresentation of the defendant. The claimant may have cause to file an action for passing off for as long as the claimant has goodwill. That may be indefinitely. Hence, an action for passing off may be filed with the court anytime within six years from when the misrepresentation of the opposing party harmed the goodwill. That may be in one year or in 100 years. Therefore, copyright is more beneficial to the balance of authors' and the public's interests.

The purpose of copyright is also more favourable than the purpose of an action for passing off with regard to LFCs. The purpose of an action for passing off is the protection of consumers and commercial entities.<sup>566</sup> The purpose of copyright is i.a. the protection of creativity and the incentive to write new works,<sup>567</sup> which further cultural promotion as well as social and personal development.<sup>568</sup> The purpose of copyright is more author-specific and multi-faceted.

Aside from the aforesaid issues, an action for passing off has also many aspects relating to its scope that make it a less than ideal form of protection for LFCs.

An action for passing off requires goodwill.<sup>569</sup> Copyright does not. In order for copyright to vest, it must 'merely' be a work in one of the categories enumerated in CDPA 1988 s 1(1), original, and recorded in writing or otherwise.<sup>570</sup> In this regard, copyright has the advantage over passing off, because goodwill may change over time. It is not static. Goodwill depends i.a. on the volatile *volens volens* of the public, i.e. it is subject to the public's caprice and 'hunger' for goods bearing popular characters.

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<sup>566</sup> Glen Gibbons, *Trade Marks Law* (2<sup>nd</sup> edn, Clarus Press 2016) 54. See also para 4.2.

<sup>567</sup> *Griggs Group v Ross Evans and Others* [2004] ECDR 15 [17]; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 5; Craig S Mende and Belinda Isaac, 'When copyright and trademark rights overlap' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 138 and 141.

<sup>568</sup> Mira Sundara Rajan, 'Moral rights in information technology: a new kind of "personal right"?' (2004) 12 IJLIT 32, 39 et seq; André Kerever, 'Reflections on the Future Development of Copyright - Is Copyright an Anachronism?' (1983) 19 Copyright 368, 370.

<sup>569</sup> Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 169.

<sup>570</sup> CDPA 1988 s 3(2).



Bainbridge agrees that passing off is not an effective means of protection in relation to character merchandising. He points out that the buyer of a telephone in a 'Garfield' design is not likely to make a complaint to the originator of the 'Garfield' cartoons Jim Davis if the telephone turns out to be a faulty product.<sup>571</sup> By this, Bainbridge means that the buyer of character goods will regard the character merely as decorative and not as an indication of origin of the phone. However, Birss J stated in his 'Betty Boop' judgment that a buyer may be motivated to buy character merchandise for more reasons than just eye appeal of the goods, e.g. because she believes the creator of the goods to benefit from the sale financially as the creator of the character. The public certainly has a greater awareness of character merchandising nowadays than it used to have in the past due to the ever-present advertising of merchandise whenever a new blockbuster is aired, in commercial breaks between films, and via the internet, etc. Even so, courts cannot adopt a universal assumption that the public has a general awareness of character merchandising.<sup>572</sup> The individual facts must be considered and goodwill, misrepresentation and damage proven in each action for passing off.

The creator of a character must provide evidence that the consumers thought the goods were licensed by the plaintiff and that they bought the merchandise on this basis. Otherwise, no misrepresentation occurred. That means the creator has to prove that the consumers' economic behaviour would have been different, i.e. that they would not have bought the items, had they known that the products were not licensed by the plaintiff.<sup>573</sup> Therefore, it would not be passing off, if the consumer realised that the product was an unauthorized product or if it did not matter to the relevant consumer whether or not the character goods were official merchandise.

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<sup>571</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 889.

<sup>572</sup> *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 [41] and [43]; *Fenty v Arcadia Group Brands Ltd (t/a Topshop)* [2013] EWHC 2310 [34], [53] and [55]; *Linkin Park LLC's Application* [2006] ETMR 74 [38]; *Elvis Presley Trade Marks* [1999] RPC 567, 593 et seq and 597 (Morritt LJ); *BBC v Pally Screen Printing* [1998] FSR 665, 674; *Elvis Presley Trade Marks* [1997] RPC 543, 554; *Halliwel and Other v Panini SpA* [1997] (unreported); *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, 155 and 158 et seq. See also para 4.4.9.3.

<sup>573</sup> Lionel Bently and Brad Sherman, *Intellectual Property Law* (4<sup>th</sup> edn, OUP 2014) 857.

This has not changed with the decisions in 'Turtles',<sup>574</sup> 'Rihanna'<sup>575</sup> and 'Betty Boop'.<sup>576</sup> Neither was the 'common field of activity'-doctrine truly abolished. It still plays a significant role and the creators in the mentioned cases merely succeeded with an action for passing off, because they all operated in the same field of business as the unauthorized merchandiser.

For example, in the 'Turtles' case both opposing parties were engaging in identical business (licensing operations) using very similar characters. The creators of the 'Turtles' had established their goodwill for licensing images of upright walking turtles before the defendants, which had entered into direct competition when licensing images of similar upright walking turtles.

The same applies to Rihanna, who had made a name for herself in the fashion world in addition to music so that she won against unauthorized users of her image on clothing.

The successors of the creator of 'Betty Boop' also had been in the character merchandising business for twenty years before the defendants' merchandise bearing the image of 'Betty Boop' and the word 'Boop' were put on the market. It was only due to the fact that the plaintiffs had been licensing the image for merchandise for a considerable period of time before the defendants entered the market, that won them the case. It was just by chance that the successors to the originator were the plaintiffs in this case. Had the position been reversed, had AVELA been licensing 'Betty Boop' images for a considerable time before the successors of the originators started the same operation, then they would have won the case instead of the originators.

Hence, not much has changed since *Taverner Rutledge Ltd v Trexapalm Ltd*.<sup>577</sup> In this case, the unauthorized character merchandiser selling lollies even successfully sued the licensed seller of character merchandise lollies, because the unauthorized party had established goodwill before the licensee. The same unsatisfactory results are still possible today.

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<sup>574</sup> See paras 4.4.2.2., 4.4.4. and 4.4.7.

<sup>575</sup> See para 4.4.9.2.

<sup>576</sup> See para 4.4.9.3.

<sup>577</sup> *Taverner Rutledge Ltd v Trexapalm Ltd* [1975] FR 479. See para 4.4.5.2.

Consequently, if an author has not yet garnered any goodwill for licensing, then an action for passing off is not an option for the author of the LFC. Reasons why an author has not acquired goodwill could be manifold and include: a) the author is still rather unknown, b) the author had not made the effort to engage in character merchandise before somebody else did, c) the author did not have the finances to produce character goods herself, or d) the author had not yet been approached by interested parties and did not know how to approach parties who might be interested in licensing before somebody else attracted goodwill by manufacturing and selling character goods based on the author's LFC. The author would invariably lose the case. Copyright on the other hand might protect authors of LFCs regardless of their finances and regardless of their level of activity in character merchandising, as long as the LFC is an original literary work or substantial part thereof.

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## Chapter 5 – The moral rights aspect

### 5.1. Introduction

The previous chapters 3 and 4 considered the suitability of trade mark law and actions for passing off for the protection of LFCs with regard to an author's commercial interests. This chapter considers the advantages of the non-commercial<sup>578</sup> moral rights under copyright law in general as well as specifically in relation to LFCs, as if LFCs were protected by copyright.

Copyright comprises two distinct forms of rights - economic and moral rights.<sup>579</sup> The three relevant moral rights are namely

- the right to be identified as author of a literary work, also called paternity right (CDPA 1988 ss 77 - 79),
- the right to object to derogatory treatment of a work, also referred to as the integrity right (CDPA 1988 ss 80 - 83), and
- the right to object to the false attribution of a work (CDPA 1988 s 84).

The economic rights protect the authors' commercial interests. The moral rights covered in this chapter protect the author's reputation<sup>580</sup> This dual aspect of copyright gives an edge to this IPR over trade marks. If copyright law only focused on the economic rights and was exclusively competition-orientated, there would be a risk that copyright law seeks to satisfy the copyright industries instead of the authors. Therefore, this chapter critically evaluates moral rights and the benefit moral rights could have in relation to the copyright protection of LFCs. The results shall be contrasted with protection by an action for passing off, because it overlaps with the right to object to

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<sup>578</sup> Though moral rights can serve an author's economic interests indirectly, they are referred to as non-commercial here, because the moral rights are unassignable and unlicensable unlike the economic rights under copyright law.

<sup>579</sup> The violation of moral rights is actionable, not as an infringement of copyright like the economic rights, but instead as a breach of statutory duty which is owed to the person who is entitled to the moral right (CDPA 1988 s 103(1)).

<sup>580</sup> Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 5, fn 10; Whitford Committee, *Copyright and Designs Law – Report of the Committee to consider the Law on Copyright and Designs* (Cmnd 6732, 1976-77) para 51.

false attribution. This overlap is expedient for the analysis and evaluation of the differences of moral rights and an action for passing off.

## 5.2. Structure of this chapter

First, the purpose of an action for passing off and the purpose of moral rights will be compared. All provisions named hereafter in this chapter without reference to a specified Act are provisions of the CDPA 1988.

Second, the scope and the elements of the three moral rights will be analysed one by one.

Third, the scope of each individual moral right will be applied against the unauthorized use of LFCs in commercial and non-commercial literary works or films – assuming for argument's sake that LFCs are protected by copyright.

Fourth, since copyright protects artistic two-dimensional works against copying in three-dimensional form,<sup>581</sup> and because this thesis asserts that AFCs and LFCs should be treated the same, this chapter also looks at whether moral rights could theoretically protect LFCs and their creators against unauthorized character merchandising.

Fifth, the overlap between the author's right to object to false attribution and an action for passing off are critically evaluated. The objective is to establish which of these two options would be more beneficial to the author.

## 5.3. Purpose of a passing off action and moral rights

As will be recalled from the previous chapter, the purpose of an action for passing off is the protection of businesses and individuals against a misrepresentation. That misrepresentation must have caused confusion as to which undertaking is responsible for the product or service in question, and must have caused damage to the goodwill of an undertaking.<sup>582</sup> The first element that is required by the plaintiff in an

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<sup>581</sup> Section 17(3).

<sup>582</sup> Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 4 et seq; Peter Jaffey, 'Merchandising and the law of trade marks' (1998) 3 IPQ 240, 246.

action for passing off is goodwill. Goodwill is more than just reputation.<sup>583</sup> It is the sum of all factors, which constitute the attractive force, that brings in custom through actual trading.<sup>584</sup> Pre-trading activities may shorten the period of time or amount of the actual business dealings with costumers that is required for creating goodwill.<sup>585</sup> However, eventually this quantifiable asset is based upon the reputation that a business has gained through its trading with potential and actual customers.<sup>586</sup> Therefore, one can say that an action for passing off has a ‘moral element’ (protection of the honour or reputation of a business), and indeed there is case-law in which both passing off and moral rights were applied as we shall see later in this chapter.<sup>587</sup>

In comparison, moral rights within the meaning of copyright law are sets of entitlements that are bestowed on creators by statute in order to control the way in which their works are treated and presented by others.<sup>588</sup> Moral rights transcend the author’s monetary concerns.<sup>589</sup> According to Adeney, moral rights protect a wide range of interests, namely

- ‘they protect personality; ...
- they uphold human rights;
- they address concerns about the ethical treatment of creators;

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<sup>583</sup> It has been confirmed once more in *Starbucks v BskyB* that reputation alone is not sufficient for a non-UK undertaking to receive protection by an action for passing off in the UK, unless the foreign undertaking had customers in the UK/was trading in the UK. The judges decided that ‘Its [the appellants] business is based in Hong Kong, and it has no customers, and therefore no goodwill, in the UK.’ *Starbucks (HK) Ltd and another v British Sky Broadcasting Group plc and others* [2015] UKSC 31, 67.

<sup>584</sup> *The Commissioners of Inland Revenue v Muller & Co’s Margarine Ltd* [1901] AC 217, 223 et seq; *Erven Warnink Besloten Vernnootschap v J Townend & Sons (Hull) Ltd (No 1)* [1979] AC 731, 735 (*Advocaat* case); Nicholas J McBride and Roderick Bagshaw, *Tort Law* (5<sup>th</sup> edn, Pearson 2015) 531; Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 167.

<sup>585</sup> *Home Box Office Inc c Channel 5 Home Box Office Ltd* [1982] FSR 449, 456; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 216.

<sup>586</sup> *The Commissioners of Inland Revenue v Muller & Co’s Margarine Ltd* [1901] AC 217, 223; Amanda Michaels and Andrew Norris, *A practical guide to trade mark law* (5<sup>th</sup> edn, OUP 2014) 218.

<sup>587</sup> See para 5.5.

<sup>588</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 1.

<sup>589</sup> Mira T Sundara Rajan, ‘Moral rights or economic rights?’ in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 210; Mira T Sundara Rajan, ‘Moral rights in the digital age: new possibilities for the democratization of culture’ (2002) 16 *International Review of Law, Computers and Technology* 187.

- they safeguard social and professional standing;
- they maintain the economic advantages of reputation;
- they prevent the deception of the consumer;
- they are the guardians of civilisation and the arts;
- they are a bulwark against dilution of the national culture.<sup>590</sup>

In sum, moral rights serve several purposes, among them the preservation of cultural goods, facilitation of proceedings against deception of readers, and chiefly the protection of creators' reputation and personality.<sup>591</sup>

Moral rights are particularly important for the author where the author has assigned her economic rights to the publisher or another natural or legal person. The author retains the moral rights even when she is not the owner of the copyright. The moral rights are neither assignable<sup>592</sup> nor licensable. The moral rights will give the author at least some degree of control over her work after it has been communicated to others or the wider public, or even after copyright ownership has been assigned.<sup>593</sup> This is confirmed by the Berne Convention for the Protection of Literary and Artistic Works

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<sup>590</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 3. The rationales of moral rights as perceived by Adeney, however, consider moral rights as they were developed in continental Europe and not just specifically the UK. In Germany and France, apart from the paternity right and the right to object to derogatory treatment, two further moral rights exist, namely the right of disclosure and the right of withdrawal. André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 7[1][a] and [d] (Pub 399, Rel 28-12/2016). This makes the position of an author in those two countries stronger than those of authors in the UK. Moral rights under French law are perpetual and inalienable (cannot be assigned or waived) according to Article L121-1 of the Code de la Propriété Intellectuelle 1992. Actually, this provision mentions only the right of attribution and the integrity right, but it is generally assumed that the other moral rights are perpetual too. André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 7[3] (Pub 399, Rel 28-12/2016). In Germany, the moral rights are not perpetual. The duration of protection for moral rights is the same as the duration of protection for the economic rights. That is 70 years from the author's death according to § 64 UrhG 1965. The 'Urheberrecht' is inalienable according to § 29 I UrhG 1965. German copyright law applies a monist approach. Both, moral as well as economic rights are inalienable. However, economic rights may be licensed and with regard to the paternity right, the author may authorize the licensee to change the name of the author and the title of the author's work on the book (§§ 29 II, 39 I UrhG 1965).

<sup>591</sup> IPO, 'Moral rights' <<http://www.ipo.gov.uk/types/copy/c-otherprotect/c-moralrights.htm>> accessed 3<sup>rd</sup> November 2013.

<sup>592</sup> Section 94 (2); Clive Lawrence, *Brands – Law, Practice and Precedents* (Jordans 2008) 159.

<sup>593</sup> Tamara Bukatz, 'Amazon's fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part II' (2014) 19 Communications Law 20, 22.

1886 (Berne Convention). Article 6*bis*(1) of this convention states that an author's economic and moral rights exist independently of each other, and that the author may still claim the paternity of the work as well as object to derogatory treatment of the work after the economic rights have been transferred. Hence, the author should be careful not to waive her moral rights.

## 5.4. The individual moral rights

### 5.4.1. Paternity right

#### 5.4.1.1. Elements & scope of the paternity right

The first moral right of relevance to this thesis is the paternity right. It grants the author the right to be identified as the originator of her creation.<sup>594</sup> This right provides a positive duty to name the author of a work.<sup>595</sup> However, it is contentious whether the paternity right merely concerns itself with the identification of the author on her work (author's positive right to be identified on the work as author), or whether it also prevents the misattribution of the author's work to another author (negative right of the author that not somebody else's name is written on the work).<sup>596</sup> The prevailing opinion is that the paternity right covers both.<sup>597</sup>

Therefore, the paternity right could also be called the right of attribution.<sup>598</sup> This understanding of the paternity right does not conflict with the right to object to false attribution of a work. In fact, this interpretation of the paternity right complements the right to object to false attribution, because the right to object to false attribution can only be claimed by the person to whom a work is attributed. That is the person who has in reality not authored the book in question, but has been mentioned on the book

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<sup>594</sup> Section 77(1).

<sup>595</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 394 et seq.

<sup>596</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 395.

<sup>597</sup> Whitford Committee, *Copyright and Designs Law – Report of the Committee to consider the Law on Copyright and Designs* (Cmnd 6732, 1976-77) para 55; *Sawkins v Hyperion Records Ltd* [2004] EWHC 1530 (Ch) [85]; *Sawkins v Hyperion Records Ltd* [2005] EWCA Civ 565 [69]; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 116; Jonathan Griffiths, 'Misattribution and misrepresentation – the claim for reverse passing off as "paternity right"' (2006) 1 IPQ 34, 53; Robyn Durie, 'Moral rights and the English business community' (1991) 2 Ent LR 40, 45; Sheila J McCartney, 'Moral Rights under the United Kingdom's Copyright, Designs and Patents Act of 1988' (1990-1991) 15 Columbia-VLA Journal of Law and the Arts 205, 219.

<sup>598</sup> Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 5.



as author by the publisher regardless due to an error. That person can then institute proceedings for removal of her name from the work of another author.

This interpretation relies on the wording of section 84(1)(a) which provides the right to object to false attribution. It states: ‘A *person* has the right ... not to have a literary ... work falsely attributed *to him as author*’.<sup>599</sup> It does not state: An author has the right not to have a literary work false attributed to another person. Therefore, if the paternity right was interpreted as excluding the misattribution of the author's work to another author, then for example the actual sole author A of book A could merely claim that her name should be written on the book, but could not object to the book falsely bearing the name of author B as well. Author A would have to wait for author B to object to the false attribution. Author B may not be interested in correcting the false attribution, because too much inconvenience is involved, or may not be contactable. Therefore, it is sensible that the paternity right should also cover a right of the author against misattribution, so that the author can enjoy the paternity right fully. Any other interpretation would lead to half-baked results.

Consequently, the paternity right is infringed when a work is published commercially or the work is communicated to the public without attributing the work to its correct author.<sup>600</sup> The same applies when an adaptation is made of the work. The author of the underlying work shall still be named.<sup>601</sup>

Infringement of the paternity right is, however, dependent on prior assertion of the paternity right by the proprietor of this right in accordance with section 78.<sup>602</sup> That

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<sup>599</sup> Emphasis added.

<sup>600</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 131; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 398.

<sup>601</sup> Section 77(2); Paul Torremans, *Holyoak & Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 247.

<sup>602</sup> Sections 77(1) and 78(1); Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 456; JAL Sterling and Stavroula Karapapa, ‘Moral Rights’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 406. The rationale behind the positive assertion requirement is that just because the name of the author was printed on some works, this did not necessarily mean that the author wanted this to be done. The Government wished ‘to avoid the need for copyright owners to worry about identifying the author in a large number of circumstances in which the author, having been paid, does not care whether he is identified and does not make his indifference known.’ HL Deb 12 November 1987, vol 489, col 1536; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 141. Another reason for the assertion requirement is that it allows users of copyrighted material to know where they stand. Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 141. If the author has already asserted her right, then for example the publisher knows that the name of the author shall be printed on the book.

means, the alleged infringer must have been bound by notice of assertion.<sup>603</sup> The author asserts her right to be identified as the author of a work as follows: In case of an assignment of copyright in the work this is done by including a statement that the author asserts in relation to that work her right to be identified in the instrument effecting the assignment. In any other case, the author asserts her right by instrument in writing signed by the author.<sup>604</sup> Hence, assertion is relatively formal. It must always be in writing.<sup>605</sup>

#### **5.4.1.2. The use of the paternity right against unauthorized literary works**

This section of the chapter analyses how the paternity right could protect an author in case somebody uses her LFCs in an unauthorized commercial or non-commercial literary work. It is assumed for argument's sake that a LFC is a literary work or a substantial part thereof<sup>606</sup> and that it can avail of copyright. Under these conditions, the author of the literary work for which she has created the LFC could claim the paternity right against the use of the LFC in another literary work abstracted from her literary work by others.

##### **5.4.1.2.1. Restricted acts**

The first scenario concerns the use of author A's LFC's in the commercial literary work (e.g. a novel or a script) of author B published by publishing company C. The second scenario concerns pure fanfiction that is distributed without commercializing it and without prior licensing agreements. However, the paternity right covers only certain

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<sup>603</sup> Section 78(1); Paul Torremans, *Holyoak & Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 247; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 905.

<sup>604</sup> Section 78(2); Charlotte Waelde et al, *Contemporary Intellectual Property* (4<sup>th</sup> edn, OUP 2016) 105; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 906.

<sup>605</sup> In case of an artistic work, the signature of the artist on the frame of the original artistic work or an authorized copy of it is sufficient for assertion. No further notice is necessary. Anyone into whose hands the original of the artistic work falls is bound by this mode of assertion, regardless of whether the signature is still visible on the artistic work or not. Literary works, however, are once again treated less favourably in comparison. An author may not claim that she has asserted her right, if she merely placed her name on the cover of the literary work. Irimi A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 489.

<sup>606</sup> See para 8.2.1. et seq.

restricted acts. That means, that some actions do not amount to an infringement of the paternity right while other actions do. The author of a work only had the right to be identified as author whenever the whole work or any substantial part of the work<sup>607</sup> is published commercially, performed in public, communicated to the public, copies of a film or sound recording including the work are issued to the public or any of these acts are done in relation to an adaptation of the work.<sup>608</sup> The main aim of the restricted act of commercial publication is profit. The restricted act of public performance and issue of copies to the public can be both of a commercial as well as non-commercial nature.

The author's right of communication to the public can also be infringed with and without making a profit or the intention of making a profit. The CJEU had stated in *Football Association Premier League Ltd (FAPL) v QC Leisure* that 'it is not irrelevant that a "communication" within the meaning of Article 3(1) of the Copyright Directive is of a profit-making nature'.<sup>609</sup> 'not irrelevant' means that an act must not necessarily be done with the intention to make a profit in order to be a communication to the public. It is only one factor, which is considered with the overall facts of the case.<sup>610</sup>

Further, Article 3(1) of the Copyright Directive, also known as the InfoSoc Directive, which grants authors 'the exclusive right to authorize or prohibit *any* communication to the public of their works'.<sup>611</sup> The word 'any' clearly suggests that a communication to the public may be commercial as well as non-commercial.

Moreover, the meaning and scope of Article 3(1) of the Copyright Directive must be interpreted in light of its objective and the context in which it occurs, not just the

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<sup>607</sup> The paternity right applies in relation to the whole or any substantial part of a work. Section 89(1); Charlotte Waelde et al, *Contemporary Intellectual Property* (4<sup>th</sup> edn, OUP 2016) 104.

<sup>608</sup> Section 77(2)(a) and (b).

<sup>609</sup> Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, para 204; Case C-135/10 *Società Consortile Fonografici v Marco Del Corso* [2012] ECDR 16, para 88.

<sup>610</sup> One other factor is e.g. the number of people to whom the work, e.g. a broadcast, is played. Case C-135/10 *Società Consortile Fonografici v Marco Del Corso* [2012] ECDR 16, paras 95 et seq; Case C-162/10 *Phonographic Performance (Ireland) Limited v Ireland and Attorney General* [2012] 2 CMLR 29, para 41.

Another factor is whether the audience could listen to the music or watch the film 'only as a result of the deliberate intervention of the operator'/that dentist. Case C-162/10 *PPL v Ireland* [2012] 2 CMLR 29, para 40; Case C-306/05 *Sociedad General Autores y Editores de España v Rafael Hoteles SA* [2006] ECR I-11519, para 42.

<sup>611</sup> Emphasis added. 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 [2001] OJ L167/10, art 3(1).

wording.<sup>612</sup> The principal aim of the Copyright Directive is to ensure a high level of author protection, guaranteeing an appropriate financial reward for the use of the authors' works, including for acts such as communication of a work to the public.<sup>613</sup> Therefore, the term 'communication to the public' has to be interpreted broadly.<sup>614</sup> Recital 23 of the Copyright Directive indeed states explicitly that 'This Directive should harmonise further the author's right of communication to the public. This right should be understood in a broad sense covering all communication to the public not present at the place where the communication originates.'<sup>615</sup> One of the purposes of copyright is to assure that the author is able to reap a reward for her work. If a work is made available to a potentially large number of persons worldwide, this negatively affects the copyright owner's profit, as the author does not receive any royalties for these works. That is a fact independent of whether or not the person who made the work available from distribution on a potentially large scale anytime and anywhere did so for free or for profit. Hence, a 'communication to the public' should be independent from profit.

Moreover, the CJEU points out in *SGAE v Rafael Hoteles* relying on the Guide to the Berne Convention published by WIPO, that

if reception is for a larger audience, *possibly for profit*, a new section of the receiving public hears or sees the work and the communication of the programme via a loudspeaker or analogous instrument no longer constitutes simple reception of the programme itself but is an independent act through which the broadcast work is *communicated to a new public*.<sup>616</sup>

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<sup>612</sup> Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, para 185; Case C-306/05 *Sociedad General Autores y Editores de España v Rafael Hoteles SA* [2006] ECR I-11519, para 34; Case C-53/05 *Commission of the European Communities v Portuguese Republic* [2006] ECR I-6215, para 20; Case C-156/98 *Federal Republic of Germany v Commission of the European Communities* [2000] ECR I-6857, para 50; Case C-301/98 *KVS International BV v Minister van Landbouw, Natuurbeheer en Visserij* [2000] ECR I-3583, para 21; C-223/98 *Adidas AG* [1999] ECR I-7081, para 23; Case 292/82 *Firma E Merck v Hauptzollamt Hamburg-Jonas* [1983] ECR I-3781, para 12.

<sup>613</sup> Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, para 186; Case C-306/05 *Sociedad General Autores y Editores de España v Rafael Hoteles SA* [2006] ECR I-11519, para 36.

<sup>614</sup> *Ibid*; JAL Sterling and Stavroula Karapapa, 'Economic Rights' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 452.

<sup>615</sup> 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 [2001] OJ L167/10, recital 23.

<sup>616</sup> Emphasis added. Case C-306/05 *Sociedad General Autores y Editores de España v Rafael Hoteles SA* [2006] ECR I-11519, para 41; Johan Axhamn, 'Striking a Fair Balance Between the Protection of

The formulation ‘possibly for profit’ makes clear that a communication to the public does not depend on any intention or actual making of profit by the person committing the act.

The Commission of the European Communities then also regarded ‘the pursuit of profit ... *not* a necessary condition for the existence of a communication to the public’.<sup>617</sup>

Hence, the paternity right can apply to fanfiction which is distributed for free via the internet. It is communicated to the public. Hence, the author of the underlying work can claim credit. The paternity right itself would not prevent the defendant from using the LFC. The defendant must merely ensure that she acknowledges the creator of the LFC sufficiently, so that it is obvious to the reader that the LFC was created by the plaintiff while the story was created by the defendant.

#### 5.4.1.2.2. Restricted acts in relation to an adaptation

The paternity right also applies when any of the restricted acts was performed in relation to an adaptation. More specifically, the paternity right could be infringed, if a work of fanfiction or another work based on the underlying original work of another was published commercially and qualified as an adaptation of the underlying work. If any of these works are adaptations, then the creator A of a LFC may rely on the paternity right, if her LFC from her literary work was used in a literary work by author B. Hence, the question is whether a literary work based on a literary work or substantial part thereof, such as a LFC, can be an adaptation within the meaning of section 77(2).

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Creative Content and the Need to Foster Its Dissemination: The Challenges Posed by Internet Linking and Meta Search Engines’ in Tanel Kerikmäe (ed), *Regulating eTechnologies in the European Union: Normative Realities and Trends* (Springer 2014) 111 fn 85; WIPO, ‘Guide to the Berne Convention for the Protection of Literary and Artistic Works (Paris Act, 1971)’ (1978) Articles 11bis, 68 et seq <<ftp://ftp.wipo.int/pub/library/ebooks/historical-ipbooks/GuideToTheBerneConventionForTheProtectionOfLiteraryAndArtisticWorksParisAct1971.pdf>> accessed 18 November 2015.

<sup>617</sup> Emphasis added. Case C-306/05 *Sociedad General Autores y Editores de España v Rafael Hoteles SA* [2006] ECR I-11519, para 44. The European Communities (EC) were three international organisations: the European Coal and Steel Community, the European Economic Community and the European Atomic Energy Community.

The act of making an adaptation is restricted to literary, dramatic and musical works.<sup>618</sup> In principle, an adaptation can be made of a work in the same medium.<sup>619</sup> Hence, an adaptation in a literary format (such as non-commercial and commercial fanfiction as well as commercially published novels) may be made from a literary work (such as a novel).

The making of an adaptation of a literary work other than a computer program or database is defined in section 21(3)(a) as

- a translation of a work,
- a dramatisation of a non-dramatic work<sup>620</sup> as well as the conversion of a non-dramatic work into a dramatic work, and
- a conversion of a literary work into a work that primarily conveys the story and action by means of pictures, commonly published in newspapers, magazines, and books. It is submitted that this refers to artistic works such as a graphic novel or comic strip.

The above is a closed list as the wording of section 21(3) suggests. Provisions that are only illustrative, and do not contain a closed list, typically indicate this by terms such as ‘in particular’ or ‘include’.<sup>621</sup> Section 21(3) does not use any such indicators that the enumeration in the provision is exemplary. Instead, section 21(3) states with finality: “adaptation” in relation to a literary work ... *means* a translation of a work’ etc.<sup>622</sup> Therefore, making an adaptation of a literary work is limited to the above options expressly contained in this legal provision.

Hence, writing fanfiction based on a film, which in turn is based on a script, or drawing a fanfiction comic based on a novel qualifies as an adaptation. Turning a pure literary work such as a novel into a stage play (‘dramatic work’ that can also be regarded as a

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<sup>618</sup> Section 21(1); Jennifer Davis, *Intellectual property law* (4<sup>th</sup> edn, OUP 2012) 58.

<sup>619</sup> For the exact reasoning, please see my following journal article: Tamara Bukatz, ‘Amazon’s fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part II’ (2014) 19 (1) *Communications Law* 20, 21.

<sup>620</sup> This is the case when a novel is turned into a screenplay.

<sup>621</sup> For example, section 3(1), which stipulates what literary and dramatic works are, is phrased as follows: ‘In this Part- “literary work” means any work, other than a dramatic or musical work, which is written, spoken or sung, and accordingly *includes*- (a) a table or compilation ... “dramatic work” *includes* a work of dance and mime’. Emphasis added.

<sup>622</sup> Emphasis added.

literary work) is an adaptation. Writing a stage play based on a novel or substantial part of a novel is also an adaptation. However, writing any other kind of literary work based on a literary work, such as a novel or poem based on a novel or substantial part of a novel, is not covered by section 21(3)(a). Therefore, the paternity right would not apply under these circumstances.

#### 5.4.1.2.3. Exceptions to the paternity right

The paternity right is not only limited to the restricted acts enumerated in section 77. The paternity right is also subject to the exceptions statutorily provided for in section 79. That means, no acknowledgement is required where the paternity right is covered by an exception. For example, the paternity right does not apply where the literary work is published or was intended for publication e.g. in a newspaper or magazine.<sup>623</sup> This means that the author of a short story that is published in a short story magazine or other magazine cannot claim that her name shall appear on her article in the magazine. Though the exception to the paternity right may be understandable regarding encyclopedias to which quite a number of people may have contributed, it is not reasonable for periodicals. Hence, it is suggested that section 79(6) is removed from the list of exceptions to the paternity right.

#### 5.4.1.3. The use of the paternity right against (un)authorized character merchandising

Moral rights do not only apply to literary reproductions of the literary work, but also to non-literary productions, i.e. physical character merchandising objects, e.g. in France<sup>624</sup> as well as Germany.<sup>625</sup> If the UK establishes copyright protection for LFCs,

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<sup>623</sup> Section 79(6)(a).

<sup>624</sup> See para 7.3.2.5. The moral rights were considered applicable to character merchandise e.g. in *Sarl Procidis c Sieur Glattauer*, CA Paris, 4 e ch, 26 avril 1977, (1978) 95 RIDA 131, 138 (Colargol). However, in this specific case, the integrity right was held to have not been infringed, because the author's reputation was not negatively affected due to the facts of the case. Jacques Mazaltov, 'France' in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 270 et seq.

<sup>625</sup> See paras 7.2.3. and 7.2.4. Germany has a monist understanding of copyright. The economic and the moral rights are protected by an inseparable, unitary author's right. Mira T Sundara Rajan, 'Moral rights or economic rights?' in Neil Wilkof and Shammad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 216.

then it would not be limited to the economic rights. The author of a LFC would be able to claim moral rights in relation to LFCs, too. These rights should then be applicable not only in relation to the act of copying the LFC into another literary work, but also when making or distributing character merchandise based on the LFC.

It does not make much sense, though, to apply the paternity right in relation to an unauthorized character merchandiser. However, it is of use, if a licensed character merchandiser is remiss in applying the author's name on the physical merchandising object. The buying public would take it as an indication that the item is official merchandise, if the product bears the creator's or licensor's name. The public is willing to pay higher prices for official fan articles.

As was explained above, the paternity right is applicable only in relation to certain acts.<sup>626</sup> Among these, the communication to the public and commercial publication are pertinent to the use of the paternity right in relation to character merchandise. These two acts shall be treated in the following sections.

#### **5.4.1.3.1. Communication to the public**

Firstly, it shall be considered whether the production and sale of character merchandising is a communication to the public. Article 3 of the InfoSoc Directive stipulates that a communication to the public is conducted 'by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access them from a place and at a time individually chosen by them.'<sup>627</sup> This was transposed into UK law in section 20(2)(b). Basically, a communication to the public is made, when the material is made accessible to an indeterminate, potentially large number of recipients on internet websites, which are accessible anywhere and anytime.<sup>628</sup> Character merchandise are physical objects. Physical objects are not communicated via the internet. A communication to the public

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<sup>626</sup> See para 5.4.1.2.1.

<sup>627</sup> 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 [2001] OJ L167/10, art 3(1).

<sup>628</sup> Section 20(2)(b); David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 179.



requires that the item itself is accessible over the internet. It is not sufficient that the character merchandise is offered for sale online and arrives by post later.

However, with the increasing affordability of 3D printing and easy accessibility of services connecting consumers to providers of local printing facilities<sup>629</sup> one has to think further ahead. Character merchandise might be sold in electronic form as CAD files<sup>630</sup> in future in addition to the physical objects being sold in shops. CAD files of 3D printable models of 'Warhammer' armies and other items resembling products from Games Workshop are already available for free e.g. on Thingiverse<sup>631</sup> and can also be easily found via Yeggi, the search engine for 3D printable models.<sup>632</sup> Not only Games Workshop related items can be downloaded from the internet in form of CAD files, but also character merchandise based on AFCs and LFCs. For example, a variety of 'Batman' fidget spinners<sup>633</sup> as well as 'Harry Potter' inspired items can be found via Yeggi.<sup>634</sup> This is a communication to the public, too, and the paternity right may be applicable.

3D items, which are not created for their artistic merit, such as figurines for games, are not copyright protected as sculptures, because they are utilitarian like the 'Stormtrooper' helmet in *Lucasfilm v Ainsworth*.<sup>635</sup> However, unauthorized CAD files and 3D-printed items based on artistic works (that includes AFCs created for comics)

<sup>629</sup> For example, 3D Hubs connects consumers to printing service providers. Find out more about 3D Hubs at <https://www.3dhubs.com/>.

<sup>630</sup> CAD files are documents created with computer-aided design software. This software is used e.g. by artists and architects to create two- or three-dimensional precise drawings or technical illustrations.

<sup>631</sup> Thingiverse <<https://www.thingiverse.com/tag:warhammer>> accessed 25 July 2017.

Thingiverse is an online repository where users share digital files with the public for free. The use of the files made available for download on Thingiverse is free of charge. Find out more about Thingiverse at <https://www.thingiverse.com/>.

<sup>632</sup> Yeggi, <<http://www.yeggi.com/q/games+workshop/?s=tt>> accessed 25 July 2017.

<sup>633</sup> Yeggi <<http://www.yeggi.com/q/batman+fidget+spinner/>> accessed 25 July 2017.

<sup>634</sup> Yeggi <<http://www.yeggi.com/q/harry+potter/>> accessed > accessed 25 July 2017.

<sup>635</sup> *Lucasfilm v Ainsworth* [2008] ECDR 17 [H7] and [121] (High Court), [2010] ECDR 6 [51] and [53] (Court of Appeal), [2012] 1 AC 208 [44] and [47] (Supreme Court). *Lucas v Ainsworth* is largely based on section 51(1). For the implications of section 51(1) to character merchandising, see paras 8.4.2.2. et seq.

Dinusha Mendis, 'Clone Wars': Episode II - The Next Generation: The Copyright Implications relating to 3D Printing and Computer-Aided Design (CAD) Files' (*BU repository*, 2014) 12 <<http://eprints.bournemouth.ac.uk/21871/1/Clone%20Wars-%20Episode%20II%20-%20Dinusha%20Mendis.pdf>> accessed 29 July 2017; Dinusha Mendis, 'The clone wars': episode 1 – the rise of 3D printing and its implications for intellectual property law – learning lessons from the past?' (2013) *EIPR* 155, 167; Dinusha Mendis, 'Unravelling 3D Printing and Intellectual Property Laws: From Napster to Thingiverse and beyond' (*ORGZine*, 21 May 2013) <<https://zine.openrightsgroup.org/features/2013/unravelling-3d-printing-and-intellectual-property-laws-from-napster-to-thingiverse-and-beyond>> accessed 29 July 2017.

infringe copyright.<sup>636</sup> This thesis argues that the same should apply to LFCs created for novels.<sup>637</sup> If LFCs were copyright protected plot-independently, then whether the author of the LFC or the author of the CAD file of the LFC is regarded as the creator of the work would depend on whether the creator of the CAD copied the author's work substantially by creating the CAD file based on the literary portrait of the LFC, or whether the CAD is the CAD author's own intellectual creation. However, this is a dream of the future and changes to the existing law would be necessary.<sup>638</sup>

#### **5.4.1.3.2. Commercial publication**

Presupposing again that LFCs per se were copyright protected, another act to which the paternity right applies is commercial publication. Commercial publication is traditionally the process of printing, distributing and selling bound paper editions of a literary work (books). Nowadays this also includes the compilation and sale of digital copies of the literary work (ebooks). Hence, it is submitted that offering CAD files based on LFCs for sale, ready for download, to private customers with access to a 3D printer or offering such a CAD file for sale over the internet to commercial manufacturers of character merchandise qualifies as commercial publication. Therefore, the paternity right would be applicable.

Hence, the author of the LFC would be able to protect herself comprehensively against unauthorized character merchandise, but only where the product was offered for sale in digital format. 'Comprehensively' means here, that the author of the LFC could make use of her economic rights and claim copyright infringement and receive damages. One might wonder why the author would have an interest to claim paternity in this regard. The reason is that it may happen that the two parties (author of the LFC and creator of the CAD) enter a licensing agreement in the aftermath of the case. The author might then find it useful to require the licensee (CAD creator) and all sub-

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<sup>636</sup> Dinusha Mendis, "The clone wars": episode 1 – the rise of 3D printing and its implications for intellectual property law – learning lessons from the past? (2013) EIPR 155, 167.

<sup>637</sup> To date, LFCs are not copyright protected plot-independently, unlike AFCs. See paras 1.1.2.2.4. – 1.1.2.2.7., 1.1.2.1.1. and 1.1.2.1.4.

<sup>638</sup> See recommendations in this thesis in para 9.4.

licensees (buyers of the CAD file who use the file for mass production) to acknowledge the author's paternity of the LFC on all the products.

#### 5.4.1.3.3. Recommendation

Character merchandise is still mainly sold to natural persons in physical format, not as a digital file.<sup>639</sup> However, restricted acts provided for in section 77(2) do not cover situations where a LFC is copied and produced as physical character merchandise. Consequently, the paternity right is not applicable to most character merchandise based on LFCs. The following solutions are proposed:

One option would be, if the courts re-interpreted the term 'commercial publication', so that it would also refer to items other than books and digital files, or if a statutory definition of 'commercial publication' were added to the CDPA 1988 to that effect.

Alternatively, the act of making character merchandise based on a literary work and the possession and distribution of the character merchandise (for commercial purposes) could be added to one of the subsections (a) or (b) of section 77(2) or laid down in a new subsection (c) in section 77(2).

Another option would be to imitate the economic rights by adding 'copying' to the restricted acts in section 77(2). Interestingly, the act of copying, which is a restricted act with regard to the economic rights (sections 16(1)(a), 17), is not mentioned in the paternity right.

The best option, though, would be, instead of introducing the author's exclusive right of 'copying', to add a section stating that the paternity right could be infringed if somebody possesses or deals with a work or copy of a work in the course of business. This wording has the advantage that the moral right could be exercised against anyone in connection with the character merchandise based on the author's LFC, while 'copying' would only cover the manufacturer of the infringing character merchandise. Moreover, the favoured wording would be consistent with the other moral rights relevant to this thesis. The proposed solution would mirror the wording of section

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<sup>639</sup> The digital format is especially relevant though where the manufacturer has commissioned another to create a CAD file for them to programme their machines for manufacturing the items.

83(1)(a) concerning the integrity right, and section 84(5)(a) concerning the right to object to false attribution.

#### 5.4.2. Right to object to false attribution

The second moral right of relevance to this thesis is the right to object to false attribution. Unlike the paternity and integrity right, section 84(1) stipulates that ‘A person has the right’.<sup>640</sup> Hence, the right to object to false attribution does not only protect the author of a work, but also other persons (non-authors).<sup>641</sup> For this thesis, it only matters though that authors are covered by this provision as well.

##### 5.4.2.1. Elements & scope of the right to object to false attribution

The right to object to false attribution basically means that an author or any other person to whom a work is attributed, although that person/author is in fact not the author of that work, can complain about this state of affairs. The objector has the right to have her name or other indication, such as a photograph of the incorrect author, removed from any issuance of copies, performance or communication to the public of the work in question.<sup>642</sup> For example, the literary work of author C.C. Humphreys shall not be presented as being written by author Bernard Cornwell. Bernard Cornwell would have the right to object to this false attribution (whereas C.C. Humphreys could claim correction of this error due to his paternity right).

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<sup>640</sup> Emphasis added.

<sup>641</sup> Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 927; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 213; JAL Sterling and Stavroula Karapapa, ‘Moral Rights’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 416 et seq; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 402. This conclusion also results from the wording of section 84(8) which speaks of the false attribution ‘to a person as author’.

<sup>642</sup> Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 165; Jonathan Griffiths, Lionel Bently and William R Cornish, ‘United Kingdom’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 7[1][b] (Pub 399, Rel 28-12/2016).

The right to object to false attribution of a work is infringed i.a. when copies of a work are issued to the public,<sup>643</sup> or the work is communicated to the public<sup>644</sup> and there is false attribution in relation to the work, or when somebody possesses or deals with a copy of a work in or on which there is a false attribution.<sup>645</sup> The right is also infringed when a literary work is falsely represented as being an adaptation of the work of a person.<sup>646</sup>

In case of the communication to the public and the possession or dealing with a copy of a work in relation to which there is a false attribution, the right to object to false attribution of authorship can only be infringed if the person committing the act knows or has reason to believe that the attribution is false. Section 84(3) and (5). In contrast, passing off never requires actual knowledge of misrepresentation. Misrepresentation may be intentional or unintentional.<sup>647</sup>

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<sup>643</sup> Section 84(2)(a); Paul Torremans, *Holyoak & Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 252; JAL Sterling and Stavroula Karapapa, 'Moral Rights' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 417.

<sup>644</sup> Section 84(3)(a). Works of fanfiction are primarily distributed via the internet, often on fanfiction platforms or in online archives for fanfiction, but also personal websites and blogs etc. Making material available to the public by placing the material on the internet is a communication to the public. Section 20(2)(b); David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 179.

<sup>645</sup> Section 84(5)(a); Paul Torremans, *Holyoak & Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 252. Both the author of a work (B) using another author's LFCs (A) as well as B's publishing company possess and deal with copies of a work on or in which a false attribution of authorship may have been made (*Clark v Associated Newspapers Ltd* [1998] 1 WLR 1558). Section 84(5)(a) also requires that author B and the publisher know or have reason to believe that there is such an attribution and that it is false. That means that author B and the publisher must have known that LFCs created by author A are used in author B's work. Author B and B's publisher must at least have had reason to know that LFCs by author A are used in author B's work. Author B, as the author of her work, is in a position to know whether or not she purposely makes use of author A's LFCs. If author B does so unintentionally, she is still liable, if she has reason to know that she uses author A's LFCs, such as when author A's LFCs are very well-known, popular ones. If the LFCs used by author B are very popular LFCs of author A, then it can be inferred that the publisher has or must have realised that LFCs of author A are used in author B's work.

<sup>646</sup> Section 84(8)(a); Paul Torremans, *Holyoak & Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 252; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 404.

<sup>647</sup> *Reckitt & Coleman Products Ltd v Borden Inc* [1990] 1 WLR 491; Millett LJ in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697, 706: 'Deception is the gist of the tort of passing off, but it is not necessary for a [claimant] to establish that the defendant consciously intended to deceive the public if that is the probable result of his conduct.'

### 5.4.2.2. The use of the right to object to false attribution against unauthorized literary works

Torremans writes that the

right [to object to false attribution of authorship] would be useful, for example if someone [A] were to plagiarize the style of a famous novelist ... in producing a mediocre work in which he or she advocates the imposition of Mafia-style taxes – that is, extortion - to generate funds for a political party and prints [the] name of author [B] instead of the name of the real author [A] on the publication.<sup>648</sup> The right to object to false attribution is not only applicable, if author A's work contained an express statement that the work had been written by author B, but also when such a statement was implied.<sup>649</sup> Fanfiction commonly copies the style of the author of the canon and communicates it to the public e.g. via a fanfiction platform. There, it will be listed as fanfiction in relation to a particular canon by the author B of the canon. This might give the impression that the work of fanfiction written by author A was written by author B, the author of the canon which features the LFCs on which the fanfiction is based.

However, whether such a listing was sufficient for an implied statement within the meaning of section 84(1) depends on whether it 'is the single meaning which the literary work conveys to the notional reasonable reader'.<sup>650</sup> As works of fanfiction are mostly available for free, available via designated fanfiction platforms or other online platforms for fans, and because the name or the pseudonym of the fanfiction writer is commonly stated prominently on the fanfiction, a notional reasonable reader would perceive the work of fanfiction for what it is, i.e. fanfiction written by the fanfiction writer, not the author of the canon.

The chances that author/person B's claim against false attribution succeeds against author A is higher, if author A's work is communicated to the public as a commercially published ebook with an established publishing house. The public would more readily

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<sup>648</sup> Paul Torremans, *Holyoak & Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 252.

<sup>649</sup> Section 84(1).

<sup>650</sup> *Clark v Associated Newspapers Ltd* [1998] 1 WLR 1558, 1568; Paul Torremans, *Holyoak & Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 253.

believe that a commercially published work (author A's work) via the usual professional channels has been written by the author whose name is written on the title page (author/person B), although in reality the actual author of the work was another (author A), whose name is not mentioned on the title page.

The situation is different, where only author B's LFC is used in author A's work, and author A's name is written prominently on the ebook. It is unlikely that the mere use of author B's LFC would be understood as a false attribution of author A's entire work to author B. However, it would very much depend on the presentation of the work – the strength of the implication that the work was written by author B and the strength of the counter-indications that the work was written by author A. The use of B's LFCs might cause some confusion among the readership. However, upon a closer look on the cover page, most should be able to understand who the true author of the book is. The readers may then only believe that author B has given her consent to the use of her LFC and that she is receiving a licensing fee from A's publisher. This false assumption is not objectionable though under section 84.

#### **5.4.2.3. The use of the right to object to false attribution against (un)authorized character merchandising**

The right to object to false attribution is applicable when somebody possesses or deals with a copy of a literary work in or on which there is a false attribution in the course of business. Therefore, the right to object to false attribution may cover situations where character merchandise, that has been produced based on the LFC of author A or a character that was created by the character merchandiser herself, is marked with the name of the famous author or popular person B and even sold under that name in an attempt to increase sales.

The famous person or author B, whose name is applied to LFC merchandise of a LFC which has been created by another author, has an interest that the producer of the character merchandise does not capitalise on her name and abuse the advertising effect connected to it. For one thing, author B may lose revenue from licensing authorized character merchandise of her own LFCs, as the market has already been

saturated with the falsely attributed character merchandise. Moreover, person or author B may not like that author A's LFC is falsely attributed to her (B), as B perceives A's LFC e.g. as a bad role model for children. The integrity right applies only under limited conditions. While the requirements of the integrity right might not be implied, person B might nevertheless be able to have the false attribution removed by means of section 84.

The right to object to false attribution of a work is not only applicable when a work that has been written by A is falsely represented as having been written by B. The right is also applicable where the work of author B has been altered by somebody else (M). For example, B has written a literary work with an insanely popular LFC. Character merchandiser M has taken a licence from B allowing M to manufacture and sell a LFC according to B's instructions regarding the look of the character goods. M shows B the items, B is satisfied, but the product that eventually enters the market is rather different from B's agreement with M, though still recognizable as B's LFC. B might then claim false attribution. If the alteration of B's LFC in form of character goods produced under licence by the licensee M is also prejudicial to B's reputation, the right to object to the false attribution and the integrity right may apply simultaneously.

### **5.4.3. Integrity right**

The third moral right of relevance to this thesis is the integrity right. It may also be referred to as the 'right of respect' – respect for the integrity of a work.<sup>651</sup> Its exact requirements are as follows:

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<sup>651</sup> Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 6.



### 5.4.3.1. Elements & scope of the integrity right

The integrity right gives the author of a work the power to object to the derogatory treatment of that work or parts thereof.<sup>652</sup> A LFC is a literary work or at least a part thereof.<sup>653</sup>

#### 5.4.3.1.1. Treatment

Section 80(2)(a) defines ‘treatment’ of a work as any addition to, deletion from or alteration to the work. That means that a modification must be made to the work to harm its integrity.<sup>654</sup>

#### 5.4.3.1.2. Derogatory

This modification must be of a derogatory nature. Section 80(2)(b) limits the concept of ‘derogatory’ to the treatment of a work that ‘amounts to distortion or mutilation of the work or is otherwise prejudicial to the honour or reputation of the author’.

#### 5.4.3.1.3. Distortion and mutilation

In order for an alteration of a work to amount to distortion or mutilation more than just trivial differences are necessary. This is implied by the following two cases: Rattee J held in *Tidy v Trustees of the Natural History Museum* that reproductions of artistic works (large-scale dinosaur cartoons exhibited in a museum) in a scale small enough for a book published by the trustees of the museum are not a mutilation.<sup>655</sup> It was held in *Pasterfield v Denham* that variations in colour and minor differences in the details of the underlying work of art and the reproduction of this artistic work were not a

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<sup>652</sup> Section 80(1) and (7); David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 135.

<sup>653</sup> See para 8.2.1. et seq.

<sup>654</sup> Paul Torremans, *Holyoak & Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 249 et seq; William Cornish, David Llewelyn, and Tanya Aplin, *Intellectual Property – Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 509.

<sup>655</sup> *Tidy v Trustees of the Natural History Museum* [1994] EWHC T 4562 (Ch) [page 4 lines 14-18]; JAL Sterling and Stavroula Karapapa, ‘Moral Rights’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 431.

derogatory treatment.<sup>656</sup> Overend J had relied on the definition of ‘distortion’ and ‘mutilation’ as set down in the Oxford English Dictionary in *Pasterfield v Denham*. According to this judgment, the OED defines ‘distortion’ as ‘the twisting or perversion of words so as to give them a different sense’. ‘Mutilation’ is defined as ‘the fact of rendering a thing imperfect by excision or destruction of one or more of its parts.’<sup>657</sup>

#### 5.4.3.1.4. Prejudicial to the honour or reputation

It is disputed whether mutilation and distortion are acts that are prejudicial to the author’s reputation and honour by themselves (the disjunctive reading) or whether acts other than mutilation and distortion could amount to derogatory treatment (conjunctive reading).<sup>658</sup> If the disjunctive reading were followed, the courts could assume derogatory treatment without actual proof of harm to the author’s reputation or honour. If the conjunctive reading were preferred, the plaintiff would have to provide evidence that the act was in fact prejudicial to the honour and reputation of the author.<sup>659</sup> Adeney criticises the disjunctive reading, because she believes this means that distortions or mutilations would cause infringement of the integrity right regardless of what effect the mutilation or distortion actually has in the individual case.<sup>660</sup> Overend J also favoured the conjunctive interpretation in *Pasterfield v Denham* as well for the same reason.<sup>661</sup> This thesis supports the conjunctive reading, too. The words ‘distortion’ and ‘mutilation’ themselves already have negative connotations. However, that alone is not sufficient. The wording and systematic position of ‘otherwise prejudicial’ in section 80(2)(b) indicates that prejudice to an author’s reputation or honour is a fixed requirement without which a treatment would not be regarded as derogatory. For one thing, section 80(2)(b) is enumerative. The wording of this provision suggests that alternative ways of causing harm to the author’s reputation are possible. This provision states clearly ‘distortion or mutilation of the work or is otherwise prejudicial’ (wording). Two examples

<sup>656</sup> *Pasterfield v Denham* [1999] FSR 168, 169.

<sup>657</sup> *Ibid* 180 et seq; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 919.

<sup>658</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 407 et seq.

<sup>659</sup> *Ibid*.

<sup>660</sup> *Ibid* 408; Karina O’Rourke is of the same opinion in ‘Integrity on the web’ (2012) EIPR 815, 816.

<sup>661</sup> Overend J stipulates that ‘what the plaintiff must establish is that the treatment accorded to his work is either a distortion or a mutilation that prejudices his honour or reputation’. *Pasterfield v Denham* [1999] FSR 168, 181 et seq. Also in favour of the conjunctive reading: Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 257.

of what may result in prejudice to the author's reputation are given - distortion and mutilation. For another, this interpretation also seems justified by the fact that the word 'and' connects section 80(2)(a) and (b).

Moreover, the conjunctive interpretation is in accord with Article 6*bis*(1) of the Berne Convention 1886, which was intended to be implemented by section 80.<sup>662</sup> This article postulates that the act in question must cause harm to the reputation of the author. The exact wording of Berne Convention 1886, Article 6*bis*(1) is: 'the author shall have the right ... to object to any distortion, mutilation or other modification of, or *other derogatory action* in relation to, the said work, which would be *prejudicial to his honor or reputation*.'<sup>663</sup>

The relative pronoun 'which' connects the prejudice to the author's reputation to the derogatory action. Therefore, only an 'addition to, deletion from or alteration to or adaptation that ... is ... prejudicial to the honour or reputation of the author' qualifies as derogatory treatment, as it was, indeed, the intention of the drafters of the CDPA 1988.<sup>664</sup>

The systematic structure of section 80(2) itself also supports the conjunctive reading. The neutral wording of section 80(2)(a) is limited by the use of terms with a negative connotation in section 80(2)(b) (wording and systematic position). This is how legal provisions are commonly constructed. Provisions or a group of provisions usually start with the general rule after which restrictions and exceptions of and to the general rule are stipulated.<sup>665</sup>

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<sup>662</sup> Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 919.

<sup>663</sup> Emphasis added. This article was worded differently in the original proposal. It stated that the author shall have the right to object to 'any modification of the work which would be prejudicial to [the author's] moral interests.' The British delegation observed that the concept of 'moral interests' has no clear meaning and would introduce vagueness into the CDPA 1988. Hence, the wording was changed. Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 919.

<sup>664</sup> *Ibid* 257 et seq.

<sup>665</sup> For example, section 77(1) grants the paternity right. Section 77(2) - (7) stipulate limitations to the paternity right. The author's right to be identified on the work can only be claimed under certain conditions, such as when the work was commercially published or communicated to the public. Section 78 adds the qualifying requirement of assertion without which the paternity right cannot be claimed, followed by exceptions to the paternity right in section 79.

In conclusion, if the act in question is a mutilation or distortion of a work, prejudice to author's reputation or honour must always be proven, otherwise the treatment is not derogatory within the meaning of section 80. An act other than a mutilation or distortion can also be a derogatory treatment of a work, if the act prejudices the author's reputation or honour. There must always be proof of the prejudice to the author's reputation or honour. There cannot be a *prima facie* assumption in favour of prejudice to the author in case of a mutilation or distortion to the work,<sup>666</sup> nor can there be such an assumption in relation to any other act the author claims to be derogatory. The burden of proof that the treatment, i.e. the modification which the defendant made to the work, is prejudicial to the honour or reputation is on the author. The burden of proof is not on the alleged infringer.

As to what treatment is prejudicial to the honour or reputation of the author depends on the individual circumstances. In principle, addition of excessive violence, graphic sexual acts and drug use to a work, where none of that was an element of the original work, is likely to be held as derogatory treatment of the work that might be harmful to the author's reputation. Furthermore, modifications to an author's work which will make the author seem 'inept, untruthful, bigoted' are also examples of derogatory treatment.<sup>667</sup> Although what is derogatory in a legal sense is judged according to an objective test (the appraisal by a notional reasonable member of the public),<sup>668</sup> in order to protect third parties from oversensitive authors,<sup>669</sup> in the end there are quite a few subjective elements to it. For one thing, it depends on the author in the first place whether or not she institutes proceedings for infringement of her moral right. If the author does not claim infringement of her integrity right, there will not be any court

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<sup>666</sup> *Confetti Records v Warner Music UK Ltd* [2003] EWHC 1274 [150]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 171; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 409.

<sup>667</sup> Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 920.

<sup>668</sup> *Confetti Records v Warner Music UK Ltd* [2003] EWHC 1274 (Ch) [160]; *Tidy v Trustees of the Natural History Museum* [1994] EWHC T 4562 (Ch) [page 7 lines 6-12]; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 7 and 265; Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond*, Vol 1 (2<sup>nd</sup> edn, OUP 2006) 607.

<sup>669</sup> Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond*, Vol 1 (2<sup>nd</sup> edn, OUP 2006) 607.

proceedings.<sup>670</sup> Courts do not act on their own accord. Therefore, the objective test is restricted by the individual, personal standard of the respective author, to an extent.<sup>671</sup>

In a next step, after the author has filed a claim for infringement of her integrity right, the court will consider what a reasonable third person would commonly regard as prejudicial to the author's honour and reputation.<sup>672</sup> This, however, is not only based on what can harm an author's reputation according to public opinion in general, but also on the current reputation of the specific author<sup>673</sup> and the information that the court is fed by both plaintiff and defendant. A subjective element is involved again thereby.

### 5.4.3.2. The use of the integrity right against unauthorized literary works

#### 5.4.3.2.1. Any part of a work

The integrity right applies in relation to the whole or any part of a work according to section 89(2). Due to the fact that the paternity right and the right to privacy of certain photographs and films apply 'in relation to the whole or any *substantial* part of a work' according to section 89(1), 'any part' within section 89(2) must mean a part of a work that is less significant than a substantial part from a perspective of quality.<sup>674</sup> Even so, one may assume, it remains subject to the *de minimis* doctrine.<sup>675</sup>

Hence, even if LFCs were not literary works or substantial parts of literary works,<sup>676</sup> the integrity right would be applicable to LFCs as 'any part' regardless.

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<sup>670</sup> *Confetti Records v Warner Music UK Ltd* [2003] EMLR 35 [H21] and [157].

<sup>671</sup> Tamara Bukatz, 'Amazon's fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part II' (2014) 19 *Communications Law* 20, 23. The author's gold standard might be even lower than that of a reasonable independent person.

<sup>672</sup> *Tidy v Trustees of the Natural History Museum* [1994] EWHC T 4562 (Ch) [page 7].

<sup>673</sup> *Confetti Records v Warner Music UK Ltd* [2003] EMLR 35 [160]; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 409.

<sup>674</sup> Charlotte Waelde et al, *Contemporary Intellectual Property* (4<sup>th</sup> edn, OUP 2016) 107.

<sup>675</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 417.

<sup>676</sup> Chapter 8 argues that LFCs can be both, depending on the circumstances. See para 8.2.1. et seq.

#### 5.4.3.2.2. Fanfiction, screenplays and the integrity right

In *Morrison Leahy Ltd v Lightbond Ltd* the High Court held that it was a ‘treatment’ to take literary and musical excerpts from five different songs and create a medley of music and lyrics from these five compositions and intersperse these with music composed by others.<sup>677</sup> This is comparable to taking a couple of LFCs from different works and putting them in a new work. This latter procedure is typical of fanfiction as well as films about superheroes or other characters coming together from several comics or Victorian novels. This treatment must be derogatory in order to infringe the integrity of the work. A treatment is derogatory if it distorts, mutilates, or is otherwise prejudicial to the honour and reputation of the author. Distortion is the perversion of the work, which changes the meaning of the work. Hence, if author B abstracts LFCs for fanfiction or a screenplay from author A’s work and puts the LFCs into a different context which affects the LFCs’ character, this might be regarded as a distortion. It is even more so a distortion when author B purposely makes a change to the LFC’s characteristics, such as rewriting a mild mannered pacifist into a homicidal maniac who puts up a harmless front. By altering a LFC in a fanfiction story or screenplay, the spirit of ‘the World’ may be affected.<sup>678</sup> ‘Spirit of “the World”’ refers to the feel of the canon, the style and thoughts underlying the pre-existing work. If an author of fanfiction or screenplay copies a LFC and the world the character lives in, but changes the LFC’s behaviour or the belief system of the original author which builds the foundation of the LFC and the world, the whole underlying work or works may be distorted. If LFCs were protected by copyright, authors of pre-existing works could protect their work and their reputation by means of the integrity right against such violation, as long as the author of the pre-existing work can establish that indeed her honour or reputation were negatively affected by the treatment of her work.

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<sup>677</sup> *Morrison Leahy Ltd v Lightbond Ltd* [1993] EMLR 144, 151. However, although holding that taking pieces of different songs and putting them together amounted to a ‘treatment’, Morritt J also stated that this treatment did not necessarily constitute a distortion or mutilation of the underlying works. He deemed it arguable though at page 150 et seq; JAL Sterling and Stavroula Karapapa, ‘Moral Rights’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 430.

<sup>678</sup> Tamara Bukatz, ‘Amazon’s fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part II’ (2014) 19 Communications Law 20, 23.

#### 5.4.3.2.3. Restricted acts

Only certain acts in relation to the derogatory treatment of an author's work infringe the integrity right. The restricted acts under section 80 in relation to literary works are commercial publication, public performance of the work (such as giving a lecture or speech of the work), communication of the work to the public or issuing to the public copies of a film or sound recording including a derogatory treatment of the literary work or any part thereof.<sup>679</sup> Therefore, both fanfiction based on another author's LFC which is distributed by uploading it on the internet (communication to the public), and literary works containing another author's LFC which are published by publishing companies (commercial publication) are covered.

Unlike the paternity right and the right to object to false attribution, the integrity right is also applicable in relation to a non-commercial act. According to section 83(1)(d), the integrity right is violated by a person who 'distributes otherwise than in the course of a business so as to affect prejudicially the honour or reputation of the author or director, an article which is, and which he knows or has reason to believe is, an infringing article.' Therefore, the integrity right protects the creator of the canon against fanfiction distributed in paper form, e.g. on conventions, as well as fanfiction distributed in digital format, provided the fanfiction writer treats the canon derogatorily or is otherwise prejudicial to the honour or reputation of the author of the underlying work and LFC. That is for example the case where the aesthetic content is reduced or the literary style of a work is negatively affected by the alteration of a work.<sup>680</sup>

#### 5.4.3.2.4. Exceptions to the integrity right

However, the integrity right is subject to the exceptions set down in section 81. Sections 81(3), (4)(a) and (b), and (6)(c) relate to literary works and any parts thereof. These sections are unproblematic, though. In fact, the exception in section 81(6)(c) even supports a point raised earlier regarding what can amount to derogatory treatment that is prejudicial to the honour or reputation of an author. It was argued above that adding

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<sup>679</sup> Section 80(3); Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 411.

<sup>680</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 136.

use of e.g. excessive violence and very graphic sexual acts to a work whose original version exhibited neither of these might qualify as such a treatment.<sup>681</sup> Interestingly, section 81(6)(c) concerns the opposite, the deletion of parts that violate common decency and encourage crime. It stipulates that the integrity of a work is not infringed by anything done for the purpose of avoiding the inclusion in a programme broadcast by the BBC of anything which offends against good taste or decency or which is likely to encourage or incite to crime or to lead to disorder or to be offensive to public feeling, provided that there is a sufficient disclaimer where the author or director is identified at the time of the relevant act or has previously been identified in or on published copies of the work.<sup>682</sup>

Since the BBC is free to delete any parts, as described, from the original work, the author of the original may also object to the addition of such material to her work for the same reason.

#### **5.4.3.3. The use of the integrity right against (un)authorized character merchandising**

The integrity right may also be infringed indirectly by a person who, e.g. possesses in the course of business or sells, distributes, or only exhibits in the course of business an infringing article and which this person knows (actual knowledge) or has reason to know is (constructive knowledge) an infringing article.<sup>683</sup> An 'infringing article' is 'a work or a copy of a work' which is subject to derogatory treatment within the meaning of section 80.<sup>684</sup> LFCs are indisputably a part of a literary work. Which changes are required to the CDPA 1988 so that the creation of objects bearing an AFC based on the LFC (such as post-it notes with a decorative image of a character) or three-dimensional objects based on the description of the LFC qualifies as a copy is analysed in detail in chapter 8.<sup>685</sup>

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<sup>681</sup> See para 5.4.3.1.4.

<sup>682</sup> Section 81(6)(c).

<sup>683</sup> Section 83(1)(a) - (c).

<sup>684</sup> Section 83(2).

<sup>685</sup> See para 8.4.2.



If making a three-dimensional object, that was modelled after the literary description of a LFC, were a copy of the underlying work, then either the way a LFC is represented in the form of a physical object or the type of product itself might be a derogatory treatment of a LFC. For example, the sale of 'Harry Potter' or 'Tinkerbell' as blow-up dolls, or puppets that utter insults, curse words or profanities when one pulls the string, may be regarded as items that harm the integrity of a work, although others may merely have a good laugh. It depends on the mindset of the individual public. It may be tough for the author to prove that these examples have a negative effect on her honour or reputation - mere cause of embarrassment to the author is not enough. It is necessary that the author's reputation is diminished in the eye of the reasonable consumer. Some consumers may know that the author has not licensed such items. The author's reputation would then not suffer any harm. However, the author's reputation may be prejudiced, if others assume that there must have been a licence agreement between the author and the manufacturer and that the author approves of the items in question. Even if the author has in fact authorized character goods, the author may not have authorized the manufacture and sale of such particular goods or goods with certain derogatory features. An author's economic rights would not be of use to the author in this situation due to the licence. However, the author could claim that her integrity right was violated.

### **5.5. The overlap of the right to object to false attribution and an action for passing off**

According to section 171(4) an action for passing off is unaffected by the provisions on moral rights. That means that infringement of moral rights and an action for passing off are independent from each other. In fact, the right to object to false attribution and an action for passing off overlap and may apply simultaneously. The major differences between the two, and in particular the strengths of the right to object to false attribution of a work shall be analysed in comparison to an action for passing off.

It was observed in *Moore v News of the World Ltd* that 'There may be many cases where a person cannot sue in ... passing-off but can sue under section 43 [now section

84].<sup>686</sup> For example, the right to object to false attribution of a work can be claimed by ‘a person’.<sup>687</sup> Therefore, the protection of section 84 includes persons who have not authored a work, but whose name erroneously appears on a work.<sup>688</sup> An action for passing off is more restrictive, although it too may apply to situations where the false representation was made that a work has been created by the owner of an undertaking, who in fact has not created that work. The core criteria of an action for passing off are goodwill, misrepresentation and damage to the goodwill. Hence, the false attribution must have caused or be likely to cause damage to the goodwill of the claimant. Therefore, only somebody who has goodwill as a writer or other kind of creator may claim passing off.<sup>689</sup>

A case in which the claimant was an author, and whose claims for both passing off and false attribution of a work succeeded is *Clark v Associated Newspapers Ltd*.<sup>690</sup> Hence, this prominent case is ideal for analysing in detail which of the two claims is more advantageous for authors. *Clark v Associated Newspapers Ltd* concerned a newspaper column published in the ‘Evening Standard’. The plaintiff had published his ‘Diaries’, which contained many revelations from his time as a Conservative Party politician and former Cabinet minister. He later entered an agreement with the News of the World to write a weekly column. He ceased writing the column after his selection as a parliamentary candidate. In the period that followed, Peter Bradshaw wrote a column entitled ‘Alan Clark’s Secret Election Diary’. This was accompanied by a photograph of the plaintiff, Mr Clark. It was intended as a spoof diary or parody. Therefore, it was presented like a genuine diary of the plaintiff, although in fact it was written by Mr Bradshaw, whose name was actually displayed, too, in capitals.

Lightman J decided that the defendant had infringed the plaintiff’s right not to have a literary work falsely attributed to him as author. He also held that at the same time the defendant had appropriated and diluted the plaintiff’s goodwill and reputation as an

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<sup>686</sup> *Moore v News of the World Ltd* [1972] 1 QB 441, 445.

<sup>687</sup> Section 84(4).

<sup>688</sup> *Noah v Shuba* [1991] FSR 14, 33; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 215 et seq; JAL Sterling and Stavroula Karapapa, ‘Moral Rights’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 416 et seq; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 402.

<sup>689</sup> Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 213.

<sup>690</sup> *Clark v Associated Newspapers Ltd* [1998] 1 WLR 1558.

author illegally by the same act.<sup>691</sup> The false impression, that Mr Clark was the author of the secret diaries when in reality he was not, could have been neutralised by an express disclaimer or counter-messages, such as giving the real author's name. However, it was found that the counter-indications in the newspaper article were not as bold, precise, and compelling as the false statement, the false statement being the unequivocal representation of Alan Clark's name as that of the author.<sup>692</sup> Therefore, there was no neutralising effect.

The main differences between the right to object to false attribution and an action for passing off that can be learned from this case are as follows:

First, the plaintiff does not need any goodwill or reputation in order to receive protection against false attribution.<sup>693</sup> This is a big advantage compared to an action for passing off, because establishing goodwill is one of the three main elements of an action for passing off.<sup>694</sup>

An author with a high public profile may very likely prove goodwill, and a likelihood of damage may be assumed readily. However, if the author is rather unknown, then the author may not be able to prove goodwill.<sup>695</sup> Consequently, an action for passing off would fail, where the right against false attribution may still protect the author.

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<sup>691</sup> Ibid 1559.

<sup>692</sup> Ibid and 1567, 1571; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 167; Paul Torremans, *Holyoak & Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 253; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 404. Other decisions in which the judge stipulated that the effects of a false trade description which is attached to goods can be neutralised by an express disclaimer or any other contradiction of the false trade description: *R v Southwood* [1987] 1 WLR 1361, 1366; *Norman v Bennett* [1974] 1 WLR 1229, 1232. The disclaimer or contradiction of the message contained in the trade description must be 'as bold, precise and compelling as the trade description itself and must be as effectively brought to the notice of any person to whom the goods may be supplied' in order to be effective.

<sup>693</sup> *Clark v Associated Newspapers Ltd* [1998] 1 WLR 1558, 1564; Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 464; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 404.

<sup>694</sup> See para 4.4.1.

<sup>695</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 438.

Second, the law of passing off requires that a substantial number of notional customers is misled or likely to be misled into believing that the product by B is a product of A.<sup>696</sup> It is slightly different for the right to object to false attribution. In order to succeed in a claim under section 84, the single meaning conveyed to the notional reader must be that the act in question was a false attribution of authorship.<sup>697</sup> It is the person claiming false attribution who must provide evidence that the meaning as conveyed by facts to a notional reasonable reader is a false one. It is insufficient to merely prove that a substantial number of people are misled.<sup>698</sup>

The meaning of the preceding paragraph is that for passing off it is necessary that some consumers (a substantial number) may arrive at the mistaken belief that the literary work was written by P, who in some cases may not even be an author at all, instead of D, while some other consumers arrive at the truth and understand that the literary work was written by D (not P). In contrast, for the right to object to false attribution, just like for defamation,<sup>699</sup> there will be a general assumption based on the question how a notional reasonable reader understands the situation. It will then be assumed that all readers would have understood the situation in the same way.

Third, false attribution, including the misrepresentation of authorship, is actionable per se.<sup>700</sup> That means that the plaintiff does not need to prove that she is suffering actual damage by the allegedly infringing act either. This constitutes another big difference to an action for passing off where in a *quia timet* injunction at least a likelihood of damage must be proven, and, in case of an action for passing off, actual damage.<sup>701</sup>

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<sup>696</sup> Richard Harrison, 'Pastiche-off' (1998) 9 Ent LR 181, 182.

<sup>697</sup> *Clark v Associated Newspapers Ltd* [1998] 1 WLR 1558, 1568; Paul Torremans, *Holyoak & Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 253; Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 464.

<sup>698</sup> Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 464; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 403.

<sup>699</sup> *Charleston v News Group Newspapers Ltd* [1995] 2 AC 65, 71.

<sup>700</sup> *Clark v Associated Newspapers Ltd* [1998] 1 WLR 1558, 1564; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 333 and 335.

<sup>701</sup> *Reckitt & Coleman Products Ltd v Borden Inc* [1990] 1 WLR 491; *H P Bulmer Ltd and Showerings Ltd v J Bollinger SA and Champagne Lanson Père et Fils* [1978] RPC 79, 99; Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 86; Jennifer Davis, 'Why the United Kingdom should have a law against misappropriation' (2010) CLJ 561, 576.

To conclude, an action for passing off requires much more effort than an objection to false attribution.

## 5.6. Conclusion

This chapter confirms once again – this time with regard to moral rights - that copyright is more suitable for the protection of LFCs than an action for passing off.

### 5.6.1. Main advantages of moral rights

It is submitted that the main advantages of moral rights protection of LFC's as opposed to an action for passing off are the following:

- a) The predominant purpose of the paternity right is to bestow on the author the right to be identified as the creator of her work. This shall ensure that the author of a book can welcome the recognition for her work that is due to her.<sup>702</sup> The paternity right has the creator of a (literary) work in mind. It is not so much concerned about the proprietor of a business or the consumer of the works. Where authors are concerned, copyright should apply instead or at least in addition to laws that primarily protect businesses and consumers.
- b) Both passing off and the integrity right protect the goodwill or reputation of the creator. However, an action for passing off protects against financial loss resulting from loss of business stemming from damage to goodwill by misrepresentation causing confusion as to who really manufactured the item.<sup>703</sup> Therefore, copyright has an advantage over an action for passing off, because it provides an author with economic as well as moral rights.
- c) The paternity right does not require proof of reputation or goodwill, in contrast with an action for passing off.

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<sup>702</sup> Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 116.

<sup>703</sup> Such a misrepresentation would be e.g. if M sold her goods as those of P. This leads to a loss of sales for P. If M's goods are of lower quality than the goods sold by P, then this may damage P's goodwill and business even further.

- d) The paternity right does not require a misrepresentation either. The fact that the name of the author was not printed on the work is sufficient. Proof of confusion of the public is not necessary for the paternity right, whereas an action for passing off depends on the existence of a misrepresentation which caused confusion among the consumers.<sup>704</sup>
- e) In contrast with an action for passing off, false attribution is actionable per se.<sup>705</sup> A plaintiff claiming false attribution does neither have to prove goodwill or reputation<sup>706</sup> nor actual damage or a likelihood of damage.<sup>707</sup>
- f) In order to satisfy the requirement of misrepresentation for an action for passing off there must be proof that a substantial number of readers were deceived into thinking that the literary work in question was written by P instead of D. For a claim of false attribution of authorship to succeed, the plaintiff merely has to prove that a notional reasonable reader would have thought that the literary work was written by P instead of D. Once it is proven to the court that a notional reasonable reader erred as to the identity of the real author, the court will make the general assumption that all readers would have made the same mistake. The court will not accept proof from the defendant that some actual readers have in fact not been misled and realised that the work had not been written by P or that the work had been written by D. Hence, the burden of proof on the plaintiff in claims of false attribution is lighter than for an action for passing off.

### 5.6.2. Main advantages of an action for passing off

There are significantly fewer advantages associated with an action for passing off. They are:

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<sup>704</sup> Jonathan Griffiths, ‘Misattribution and misrepresentation – the claim for reverse passing off as “paternity right”’ (2006) 1 IPQ 34, 53.

<sup>705</sup> *Clark v Associated Newspapers Ltd* [1998] 1 WLR 1558, 1564; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 333 and 335.

<sup>706</sup> *Clark v Associated Newspapers Ltd* [1998] 1 WLR 1558, 1564.

<sup>707</sup> See para 5.5.

- a) The tort of passing off covers any act which harms the goodwill of the claimant and causes damage resulting from misrepresentation. Copyright on the other hand as well as moral rights can only be infringed by certain acts.<sup>708</sup>
- b) No actual knowledge of misrepresentation is required for an action for passing off,<sup>709</sup> unlike for the right against false attribution where the tortfeasor must know or must have reason to believe that the attribution is false.

### 5.6.3. Recommended changes to the CDPA 1988

The result is therefore that copyright would be more suitable for the protection of LFCs than an action for passing off. However, this chapter has also made clear that certain provisions of the CDPA 1988 need to be interpreted more broadly. Moreover, changes will need to be made to the wording of the existing CDPA 1988, if copyright protection of LFCs were to be provided. Recommended changes identified in this chapter would be:

- a) All references to a literary work in all sections throughout the CDPA 1988, including the provisions on moral rights, should be interpreted more widely, so as to allow LFCs to fall within the scope of copyright protection of literary works or a substantial part thereof. Otherwise, the author of the LFC could neither protect her moral interests (in particular her reputation) in the LFC against the (un)authorized commercial reuse nor against non-commercial creative works taking advantage of the earlier work.
- b) Even if LFCs were protected by copyright, the paternity right would not apply in cases of character merchandising, because section 77(2) contains no restricted act that would cover the manufacture and making available for sale of physical objects. This thesis recommends that a new section regarding the possession or dealing with a work or copy of a work in the course of

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<sup>708</sup> The author's exclusive economic rights, i.e. the rights which are restricted to the copyright owner or licensee, are listed in sections 16 (detailed in sections 17 - 26). The exclusive moral rights of an author/person are enumerated in sections 77(2), 80(3) and 83, and 84(2) - (5).

<sup>709</sup> *Reckitt & Coleman Products Ltd v Borden Inc* [1990] 1 WLR 491; Millett LJ in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697, 706.

business is added to the CDPA 1988, so that the author can claim that her name is attached to licensed character merchandise.

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## Chapter 6 – Copyright protection of LFCs in Canada and the USA

### 6.1. Introduction

Now that it has been established a) that protection of LFCs by trade mark law and action for passing off are inadequate or at least unsuitable, b) how much more suitable copyright would be, and c) how beneficial copyright protection would be to authors, this thesis considers next how copyright protection of LFCs could be established. Inspiration can be drawn from jurisdictions, in which LFCs are copyright protected, such as Canada and the United States of America (USA).

The objective of this chapter is to identify and critically evaluate the general and specific LFC copyrightability principles used in Canada and the USA. The following shall be considered carefully in pursuit of this aim:

- a) the Federal legal provisions from which copyright protection of LFCs can be derived in Canada and the USA,
- b) Canadian and US case-law in which these Federal copyright laws have been applied, and
- c) the principles one can draw from both.

These two jurisdictions have been selected, because:

- a) Copyright protection for LFCs is well developed, especially in the USA, where it was documented as early as 1930.<sup>710</sup> Due to comic heroes' economic and social importance in the USA, the copyrightability of AFCs was established by US courts even as early as 1903.<sup>711</sup>

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<sup>710</sup> The sufficiently delineated test was established in *Nichols v Universal Pictures Corporation*, 45 F 2d 119 (2d Cir 1930).

<sup>711</sup> *Empire City Amusement Co v Wilton*, 134 F 132, 133 (CD Mass 1903); *Hill v Whalen & Martell, Inc.*, 220 F 359, 360 (SDNY 1914) (Mutt & Jeff). Although the courts decided then that the respective AFCs

- b) Canada and the USA share the same historical common law roots with the UK. Common law emerged in the UK during the Middle Ages and was applied in the colonies of the British Empire. Both Canada and the USA are common law jurisdictions like the UK.<sup>712</sup> Canada and the Thirteen American Colonies at the East Coast of North America were British overseas territories. The Thirteen American Colonies became independent in 1776. US legislature followed British Copyright law and can be traced back to the Statute of Anne, which was enacted in the UK by the British Parliament in 1710. Eventually, it was superseded in the US by the US Constitution of 1787 and the US' first copyright statute on a federal level in 1790.<sup>713</sup> However, many legal principles are shared and similar.<sup>714</sup>

Canada is still part of the Commonwealth of Nations.<sup>715</sup> Until its first domestic Copyright Act of 1921 which came into force in 1924 (57 years after Canada's confederation) Canada applied British laws to regulated copyright. Canadian copyright law is largely based on the UK Copyright Act 1911.<sup>716</sup> Further, the

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were copyright protected from being exactly copied (the same particular image), it was not determined whether AFCs are copyrightable abstracted from the underlying work. That came much later, in 1978. The 9<sup>th</sup> Circuit Court decided that AFCs are copyrighted in principle, and abstracted from the work, i.e. independent of the comic's story. *Walt Disney Productions v Air Pirates*, 581 F 2d 751, 755 (9<sup>th</sup> Cir 1978), cert denied sub nom *O'Neill v Walt Disney Productions*, 439 US 1132 (S Ct 1979). Thereby, it was implied that an AFC is copyrighted independent from the comic book it appears in. This implication was accepted in later cases. *Warner Bros v American Broadcasting Companies*, 720 F 2d 231, 240 et seq (2d Cir 1983); *United Features Syndicate v Sunrise Mold Co*, 569 F Supp 1475, 1480 (S D Fla 1983); *DC Comics v Reel Fantasy*, 217 USPQ 307 (2d Cir 1982); Leslie A Kurtz, 'The Independent Legal Lives of Fictional Characters' (1986) *Wis L Rev* 429, 450; *DeCarlo v Archie Comics Pub*, 11 Fed Appx 26, 28 (2d Cir 2001), cert denied, 534 US 1056 (S Ct 2001) (AFC with 'sufficiently particularity' is copyrighted); Heijo E Ruijsenaars, 'Ein urheberrechtlicher Streifzug – Teil 1: Zum Schutz von Comic-Figuren' (1993) *GRUR Int* 811, 3(b)(i).

<sup>712</sup> The exception in the UK is Scotland, which uses a mix of civil and common law. The exception in Canada is the province Québec, where civil law matters are regulated by civil law due to Québec's heritage as a French colony. Both criminal as well as public law are regulated by common law. The exception in the USA is Louisiana, which also applies a civil law system to civil law matters based on French and Spanish civil law, and common law in criminal law and other areas of law.

<sup>713</sup> Dorothy J Howell, *Intellectual Properties and the Protection of Fictional Characters* (Quorum Books 1990) 3 and 10. Copyright cases are solely in the domain of federal courts.

<sup>714</sup> Mary W S Wong, 'Cyber-trespass and 'Unauthorized Access' as Legal Mechanisms of Access Control: Lessons from the US Experience' (2007) 15 *Int J Law Info Tech* 90, 91.

<sup>715</sup> Canada became a dominion in the Commonwealth in 1867 with the passing of the British North America Act. At the same time John A Macdonald became Canada's first prime minister.

Whilst Queen Elizabeth II is Head of State of Canada, she has no real political power and is represented by the Canadian Governor General.

<sup>716</sup> Digital Copyright Canada, 'Chronology of Canadian Copyright Law' 2 <[www-digital-copyright.ca/chronology](http://www-digital-copyright.ca/chronology)> accessed 10 January 2013; Jay Makarenko, 'Copyright Law in Canada: An Introduction to the Canadian Copyright Act' (*Mapleleafweb*, 13 March 2009) <<http://www.mapleleafweb.com/features/copyright-law-canada-introduction-canadian-copyright-act#history>> accessed 8 March 2016.

Canadian Copyright Act 1921 was also revised around the same time as the UK Copyright Act 1956 (now Copyright, Designs and Patents Act 1988).

The results of the critical and comparative assessment in this thesis chapter will contribute to the evaluation of how copyrightable and non-copyrightable characters could be distinguished in the UK as well as the evaluation of how UK copyright law could be changed.<sup>717</sup>

## **6.2. Canada**

This section concerning LFC copyrightability under Canadian copyright law first analyses the general principles of copyright protection including the scope of copyright, the originality element, and the idea/expression dichotomy. Subsequently, the principles that are adopted specifically to judge whether a certain character is copyrighted are carefully analysed. This is followed by separate evaluations of whether fanfiction and unauthorized character merchandising infringe copyright.

### **6.2.1. General legal requirements for copyright protection of LFCs**

The general requirements of copyright are stipulated in the Copyright Act (CA) 1985. Section 3(1) of the CA 1985 stipulates, like s 16(3)(a) of the CDPA 1988, that the owner of the copyright can exercise the restricted exclusive rights that copyright bestows, such as the right to reproduce (i.e. to prevent others from reproducing), in relation to the whole work or any substantial part thereof.

The regular term of copyright protection in Canada is shorter than in the UK. Instead of 70 years, the term for which copyright shall subsist under the Canadian CA 1985 is the life of the author plus fifty years from the end of the calendar year in which the author died.<sup>718</sup>

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<sup>717</sup> See chapter 8.

<sup>718</sup> CA 1985 s 6.

### 6.2.1.1. Catalogue of protected works

Canadian case-law does not state explicitly how LFCs are categorised, and whether or not the LFC is categorised e.g. as a literary work. This section will look into the possibilities.

As CA 1985 s 5, which stipulates which works may attract copyright, is a closed list, like s 1 of the CDPA 1988, a LFC must be one of the works mentioned in section 5. There is no section in the CA 1985, which explicitly mentions character copyrightability. According to the CA 1985 s 5, works in which copyright may subsist are literary, dramatic, musical and artistic works.<sup>719</sup> Section 2 of the CA 1985, which defines various terms used in the CA 1985, stipulates that

*every original literary, dramatic, musical and artistic work* includes every original production in the literary, scientific or artistic domain, whatever may be the mode or form of its expression, such as compilations, books, pamphlets and other writings, lectures, dramatic or dramatico-musical works, musical works, translations, illustrations, sketches and plastic works relative to geography, topography, architecture or science.

This list is more illustrative than and not so IT focused as the UK's CDPA 1988 s 3. In that regard, Canada's CA 1985 resembles Article L112-2(2) and (4) of the French Code de la propriété intellectuelle (CPI) 1992, which is even more specific and enumerative. Even so, the road has been set for Canada in CA 1985 s 5 by its exhaustive nature. Therefore, a LFC cannot be a work *sui generis* under Canadian law unlike under French copyright law. A LFC may only be copyrighted as a literary work or substantial part thereof under Canadian copyright law.

The CA 1985 leaves the courts a lot of leeway when interpreting what a literary work is,<sup>720</sup> because it defines literary works merely by giving examples. According to CA 1985 s 2 a 'literary work includes tables, computer programs, and compilations of literary works'. This section is merely illustrative as the wording ('includes') clearly

<sup>719</sup> CA 1985 s 5(1); Philip B Kerr, 'Copyright Law in Canada' (*Kerr & Nadeau*) <[www.http://users.trytel.com/~pbkerr/copyright.html](http://users.trytel.com/~pbkerr/copyright.html)> accessed 10 January 2013.

<sup>720</sup> Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[2] (Pub 399, Rel 28-12/2016).

suggests. Therefore, other works or substantial parts of the work, not mentioned in this definition, such as LFCs, may be a literary work or substantial part thereof too.<sup>721</sup>

### 6.2.1.2. Fixation requirement

Following the wording of the CA 1985, the fixation requirement does not apply to all types of works. Fixation is expressly mentioned in CA 1985 s 2 for computer programs, dramatic works, and sound recordings. However, no such requirement is mentioned for literary works (nor artistic or musical and cinematographic works). According to CA 1985 s 2 a 'literary work includes tables, computer programs, and compilations of literary works'. However, the fixation requirement is only mentioned in the definition of computer programs specifically, but not in the definition provided by the same section on literary works. This suggests that a literary work does not have to be fixed in writing or otherwise. Consequently, the CA 1985 may protect some more ephemeral works of literature that might find it challenging to meet the requirement of fixation, such as LFCs.

This is similar to German as well as French copyright law, where copyright works do not have to be recorded in writing or otherwise.<sup>722</sup> Both these countries, like Canada and the USA, offer copyright protection to LFCs.<sup>723</sup> In contrast, the UK, which does not accept LFC copyrightability, has a fixation requirement for literary works.<sup>724</sup> CDPA 1988 s 3(2) stipulates: 'Copyright does not subsist in a literary, dramatic or musical work unless and until it is recorded, in writing or otherwise'.

It makes sense not to have a general fixation requirement. LFCs are more than just the written word. LFCs ask more of the reader's imagination than artistic works.

Even so, it is not strictly necessary to abandon the fixation requirement for literary works set down in the CDPA 1988 in order to facilitate LFC copyrightability in the UK

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<sup>721</sup> *Productions Avanti Ciné-Video Inc v Favreau* (1999) 1 CPR (4<sup>th</sup>) 129 (Que CA); Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016); Grace Westcott, 'Friction over Fan Fiction' (2008) *Literary Review of Canada* <[www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/](http://www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/)> accessed 9 January 2013.

<sup>722</sup> See paras 7.2.1.3. and 7.3.1.2.

<sup>723</sup> See paras 6.3.2., 7.2.2. and 7.3.2.5.

<sup>724</sup> CDPA 1988 s 3(2).

as is demonstrated by US copyright law.<sup>725</sup> A judicial interpretation, that LFCs are literary works themselves, and that enough substance of a LFC's external and internal characteristics is recorded, would be sufficient to resolve this issue.<sup>726</sup> Finding that the appearance of a LFC has been recorded sufficiently is less problematic. It may be extracted from a story much easier than a description of the LFC's inner workings, because although the LFC's beliefs, thoughts and morals may be recorded expressly, the individual internal character traits will often still need to be derived from these, interpreted and formulated in general by the judge (reader) deciding in the individual case.

### 6.2.1.3. Originality

An essential copyright requirement is that the work must be original.<sup>727</sup> According to the CA 1985 s 5 'copyright shall subsist in Canada ...in every original literary ... work'. The CA 1985 does not define the term originality though. It is left to the courts to interpret what originality is. Different courts have interpreted the originality requirement differently. The British Columbia Supreme Court followed the UK's interpretation of originality in *Software Guy Brokers Ltd v Hardy*<sup>728</sup> as did the Federal Court of Canada in *U & R Tax Services Ltd v H & R Block Canada Inc.*<sup>729</sup> The Federal Court decided that 'original' merely means that the work should be a copy of a pre-existing work and instead originate from the author of the work.<sup>730</sup> This interpretation is consistent with the 'sweat of the brow' approach. The sweat of the brow doctrine means that the creator of a work deserves and obtains copyright simply by exerting diligence and

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<sup>725</sup> See para 6.3.1.2.

<sup>726</sup> See paras 8.2.1. and 8.3.1. et seq.

<sup>727</sup> CA 1985 s 5(1); Philip B Kerr, 'Copyright Law in Canada' (*Kerr & Nadeau*) <[www.http://users.trytel.com/~pbkerr/copyright.html](http://www.http://users.trytel.com/~pbkerr/copyright.html)> accessed 10 January 2013.

<sup>728</sup> *Software Guy Brokers Ltd v Hardy* (2004) 32 CPR (4<sup>th</sup>) 88 [28] (BCSC).

<sup>729</sup> *U & R Tax Services Ltd v H & R Block Canada Inc* (1995) 62 CPR (3d) 257 [22] (FCTD); *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601, 609.

<sup>730</sup> *U & R Tax Services Ltd v H & R Block Canada Inc* (1995) 62 CPR (3d) 257 [22] (FCTD); *Software Guy Brokers Ltd v Hardy* (2004) 32 CPR (4<sup>th</sup>) 88 [28] (BCSC); *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601, 609; Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b] (Pub 399, Rel 28-12/2016); John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 249.

investment.<sup>731</sup> This standard finds its premise in John Locke's thesis that a person has a natural right to receive a reward for her labour.<sup>732</sup>

### 6.2.1.3.1. *Tele-Direct (Publications) Inc v American Business Information, Inc*<sup>733</sup>

At first sight, the Federal Court of Appeal seemingly decided in *Tele-Direct (Publications) Inc v American Business Information, Inc* that a work is original, if it is creative.<sup>734</sup> This decision cited the US ruling *Feist Publications, Inc v Rural Telephone Service Co, Inc*.<sup>735</sup> The *Feist* case maintains a creativity requirement for originality of a work.<sup>736</sup> The sweat of the brow approach to originality was rejected in *Feist* by the US Supreme Court. O'Connor J reasoned that the sweat of the brow approach stretched the protection of copyright for a compilation to the facts, that had been selected and arranged instead of offering copyright merely to the selection and arrangement itself. This extension of copyright protection meant that any later compilers could not use any of the already selected and arranged information of the earlier compiler without infringing the copyright of the compiler, even if some additional information had been selected and the adopted (and other) information had been arranged differently.<sup>737</sup> This was inconsistent with copyright law's cardinal tenet that there is no copyright in ideas (and facts/information).<sup>738</sup>

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<sup>731</sup> Hence, e.g. a solicitors' directory can be copyright protected under the sweat of the brow standard. The competitor must therefore collect the relevant information themselves and come up with a directory independently, otherwise the copyright in the earlier directory will be infringed. *Waterlow Publishers Ltd v Rose* [1995] FSR 207, 208; Andrew McGee, Alexandrine Cerfontaine and Gary Scanlan, 'Creativity and Form as Grounds for Copyright Protection in English Law' (2001) *Commercial Liability Law Review* 73, 75.

<sup>732</sup> *CCH Canadian Ltd v Law Society of Upper Canada* (2004) SCC 13 [15], (2004) 1 RCS 339, 351 et seq; Deming Liu, 'Reflections on the idea/expression dichotomy in English copyright law' (2017) 1 JBL 71, 73; Andreas Rahmatian, 'Originality in UK copyright law: the old "skill and labour" doctrine under pressure' (2013) 44 IIC 4, 13.

<sup>733</sup> *Tele-Direct (Publications) Inc v American Business Information, Inc* (1998) 2 FC 22 (CA).

<sup>734</sup> *Ibid* [29]; JAL Sterling and Estelle Derclaye, 'Protection Criteria' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 380.

<sup>735</sup> *Feist Publications, Inc v Rural Telephone Service Co, Inc*, 499 US 340 (1991); *Tele-Direct (Publications) Inc v American Business Information, Inc* (1998) 2 FC 22 (CA).

<sup>736</sup> *Feist Publications, Inc v Rural Telephone Service Co, Inc*, 499 US 340, 345 (1991); Emma Steel, 'Original sin: reconciling originality in copyright with music as an evolutionary art form' (2015) 37 EIPR 66, 73; Eleonora Rosati, 'Originality in US and UK copyright experiences as a springboard for an EU-wide reform debate' (2010) 41 IIC 524, 533.

<sup>737</sup> *Feist Publications, Inc v Rural Telephone Service Co, Inc*, 499 US 340, 353 (1991).

<sup>738</sup> *Ibid*; *Miller v Universal City Studios, Inc*, 650 F 2d 1365 [11] (5<sup>th</sup> Cir 1981); Leslie A Kurtz, 'The scope of copyright protection in the United States' (1995) 6 Ent L R 88.

However, if one reads *Tele-Direct (Publications) Inc v American Business Information Inc* carefully, one notices that the Canadian Federal Court of Appeal did not follow the creativity requirement after all. The FCA supported the sweat of the brow approach. It had merely pointed out that the sweat of the brow approach did not mean that labour *per se* was sufficient ground for originality of a work.<sup>739</sup> Décarý JA states that allowing labour alone to suffice for copyright protection is not consistent with copyright legislation, because the purpose of the Copyright Act is the protection of intellectual creation.<sup>740</sup> Aside from labour, the author's intellectual effort has to be taken into account.<sup>741</sup>

#### 6.2.1.3.2. *CCH Canadian Ltd v Law Society of Upper Canada*<sup>742</sup>

In *CCH Canadian Ltd v Law Society of Upper Canada*, Chief Justice McLachlin also took a stance on the skill, labour, judgment versus creativity issue. He maintained that a work is original in accordance with the CA 1985, if the work originates from the author, i.e. the work must be more than a simple copy of another author's work. The work must also be the product of the author's skill and judgment. 'creativity is not required to make a work "original"'.<sup>743</sup> McLachlin CJ elaborates further, that a work does not have to be creative in terms of being unique or novel. Novelty and inventive character are requirements for patent protection, not copyright.<sup>744</sup> However, the author must have exercised skill and judgment.<sup>745</sup> McLachlin CJ uses the term 'judgment' within the meaning of a person's ability for reasoning or competence in forming an opinion or

<sup>739</sup> *Tele-Direct (Publications) Inc v American Business Information, Inc* (1998) 2 FC 22 [29] (CA); JAL Sterling and Estelle Derclaye, 'Protection Criteria' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 380.

<sup>740</sup> *Tele-Direct (Publications) Inc v American Business Information, Inc* (1998) 2 FC 22 [29] (CA).

<sup>741</sup> Décarý JA reiterated this view in *Édutile Inc v Automobile Protection Association* (2000) 4 FCR 195 [8].

<sup>742</sup> *CCH Canadian Ltd v Law Society of Upper Canada* (2004) 1 RCS 339.

<sup>743</sup> *Ibid* 356; JAL Sterling and Estelle Derclaye, 'Protection Criteria' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 382; William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 439.

<sup>744</sup> *CCH Canadian Ltd v Law Society of Upper Canada* (2004) SCC 13 [16], (2004) 1 RCS 339, 352; Emma Steel, 'Original sin: reconciling originality in copyright with music as an evolutionary art form' (2015) 37 EIPR 66, 73.

<sup>745</sup> *CCH Canadian Ltd v Law Society of Upper Canada* (2004) SCC 13 [16], (2004) 1 RCS 339, 352; *France Animation SA v Robinson* (2011) QCCA 1361 [28]; *Wall v Horn Abbot Ltd* (2007) NSSC 197 [495].



capability to evaluate something by considering various options from creating a work. Perforce, this will involve intellectual efforts. The exercise of skill and judgment shall not be so trivial that one could speak of 'a purely mechanical exercise'.<sup>746</sup>

Hence, McLachlin CJ is not a supporter of a strict understanding of the skill, labour judgment approach. The exercise of skill, labour and judgment requires intellectual effort. The requirement of intellectual effort is also in line with the Berne Convention 1886, as the notion behind 'literary and artistic work' is that these are creations of the mind.<sup>747</sup> Berne does not explicitly ask for creativity, just that the literary and artistic works constitute intellectual creations.<sup>748</sup>

### 6.2.1.3.3. Originality in the UK and according to the CJEU

UK courts had also advocated against creativity - letting labour and skill suffice, as long as the work originated from the author.<sup>749</sup> Accordingly, copyright was even granted for maths exam papers with common maths problems.<sup>750</sup> It was not until the CJEU's decisions in *Infopaq International v Danske Dagblades Forening*; *Bezpečnostní softwarová asociace – Svaz softwarové ochrany v Ministerstvo kultury*; *Eva-Maria Painer v Standard VerlagsGmbH* and *Football Dataco v Yahoo! Ltd*, which bind UK courts to interpret originality in line with their judgments, that the UK had to accept that exercising labour and skill is not enough to obtain copyright and that the author's personal touch is required.<sup>751</sup> Since then, originality must be understood as a requirement for the author's own intellectual creation.<sup>752</sup>

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<sup>746</sup> For example, merely altering the font of a literary work with a PC to create a new work would fall below the *de minimis* threshold and would fail to qualify as an original work. No copyright could be awarded to such a work. *CCH Canadian Ltd v Law Society of Upper Canada* (2004) SCC 13 [16], (2004) 1 RCS 339, 352; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 195.

<sup>747</sup> *CCH Canadian Ltd v Law Society of Upper Canada* (2004) SCC 13 [19], (2004) 1 RCS 339, 353.

<sup>748</sup> Berne Convention 1886, art 2(5).

<sup>749</sup> See para 8.3.2.

<sup>750</sup> *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601 and 609.

<sup>751</sup> Case C-604/10 *Football Dataco v Yahoo! Ltd* [2012] ECDR 10, paras 38; Case C-145/10 *Eva-Maria Painer v Standard VerlagsGmbH* [2012] ECDR 6, paras 88 et seq and 92.

<sup>752</sup> Case C-5/08 *Infopaq International v Danske Dagblades Forening* [2009] ECR I-6569, para 45; C-393/09 *Bezpečnostní softwarová asociace – Svaz softwarové ochrany v Ministerstvo kultury* [2010] ECR I-13971, para 50; Case C-604/10 *Football Dataco v Yahoo! Ltd* [2012] ECDR 10, paras 38, 42 and 46; Case C-145/10 *Eva-Maria Painer v Standard VerlagsGmbH* [2012] ECDR 6, paras 88 et seq and

#### 6.2.1.3.4. Berne Convention 1886

The term ‘intellectual creation’ stems from Article 2(5) of the Berne Convention 1886.<sup>753</sup> This article makes clear that the underlying notion of specifically a literary and artistic work is that of an intellectual creation. If one adopts an industriousness / sweat of the brow approach in deciding whether a work is original or not, one disregards the idea behind the Berne Convention. The sweat of the brow approach carries the risk that works are protected that just involved an investment of money, time and labour, but are not intellectual literary creations in the true sense of the expression ‘literary work’. This issue was redressed by the Federal Court of Appeal in *Tele-Direct (Publications) Inc v American Business Information, Inc*, which determined that labour by itself is not sufficient, but that skill and judgment are also required.<sup>754</sup> McLachlin CJ added to this in the Supreme Court of Canada’s decision in *CCH Canadian Ltd v Law Society of Upper Canada* by requiring intellectual effort in addition to skill and judgment.<sup>755</sup>

#### 6.2.1.3.5. Balance of conflicting interests

Copyright law has to strike a balance between authors’ interests in protection of their intellectual work against unauthorized exploitation, so that the author will reap a just reward, and the public interest in the dissemination of creators’ works to stimulate the mind and encourage an interest in the arts and future creation of new works. A lenient approach to originality such as the sweat of the brow approach might offer copyright too easily. The consequence is that the public domain will be steadily depleted and the balancing scales are tipped severely in favour of the interests of authors. Author’s would be rewarded (financially and otherwise) for the creation of their works, but less and less new works could be created without infringing somebody else’s copyright.<sup>756</sup>

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94; Andreas Rahmatian, ‘Originality in UK copyright law: the old “skill and labour” doctrine under pressure’ (2013) 44 IIC 4, 7.

<sup>753</sup> Canada signed up to the Berne Convention 1886 in 1928.

<sup>754</sup> *Tele-Direct (Publications) Inc v American Business Information, Inc* (1998) 2 FC 22 (CA) [29].

<sup>755</sup> *CCH Canadian Ltd v Law Society of Upper Canada* (2004) SCC 13 [25], (2004) 1 RCS 339, 356.

<sup>756</sup> Carys J Craig, ‘Locke, Labour and Limiting the Author’s Right: Warning against a Lockean Approach to Copyright Law’ (2002) 28 Queen’s LJ 1, 45 et seq; Jessica Litman, ‘The Public Domain’ (1990) 39 Emory LJ 965, 969.

A stricter approach to originality ensures a balance between the conflicting interests of creators and the general public. Such a stricter approach is the need for the exercise of skill and judgment by an author requiring an intellectual effort, such as was proposed in *CCH Canadian Ltd v Law Society of Upper Canada*.<sup>757</sup>

It is here submitted though that whether or not skill and judgment grant copyright too easily depends on the level of skill and judgment that is asked for.

#### 6.2.1.3.6. NAFTA

Is the sweat of the brow approach reconcilable with the North American Free Trade Agreement (NAFTA) 1993?<sup>758</sup> According to Article 1705 of the NAFTA 1993, each signatory party of the NAFTA 1993 shall offer copyright protection to the types of works covered by Article 2 of the Berne Convention 1886, namely i.a. literary and artistic works, and works of applied art etc. The underlying notion of the Berne Convention 1886 that is not explicitly stated in the Berne Convention is expressly mentioned in Article 1705(1)(b) of the NAFTA 1993. This subsection provides that '1. ... works covered by Article 2 of the Berne Convention ... compilations of data or other material, ... which ... constitute intellectual creations, shall be protected as such.' Although subsection (1)(b) refers to compilations of data or other material, it is still clear from this subsection that the underlying notion for copyright to vest in a work is that the work is an 'intellectual creation'.

However, neither Berne nor NAFTA require creativity specifically. All these two mention is that the work must be the author's own intellectual creation. Hence, Berne and NAFTA are reconcilable with the expanded skill, labour, and judgment approach, as applied in *Tele-Direct* and *CCH*, but not the sweat of the brow approach.

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<sup>757</sup> *CCH Canadian Ltd v Law Society of Upper Canada* (2004) SCC 13 [25], (2004) 1 RCS 339, 356; Carys J Craig, 'Locke, Labour and Limiting the Author's Right: Warning against a Lockean Approach to Copyright Law' (2002) 28 Queen's LJ 1, 16 et seqq.

<sup>758</sup> Canada signed the NAFTA on 17 December 1992.

### 6.2.1.3.7. Summary and conclusion

In summary, a work is original within the meaning of the CA 1985, if

- a) it originates from the person claiming copyright and is not a copy of another author's work,
- b) skill and judgment were exercised in the creation of the work,
- c) the exercise of skill and judgment was not so trivial as to be regarded as mechanical, and
- d) there are elements that are a result of the author's own intellectual creation.
- e) Creativity is not a requirement for originality in Canada, but would be an attractive though inessential enhancement.

However, this thesis asserts that McLachlin made creativity a requirement despite stating explicitly that creativity is not required for originality. The creativity element is hidden in the first requirement that McLachlin mentioned as a compulsory criterion – a work must originate from the author.<sup>759</sup> This element, one might argue, already contains the requirement that a work must have the author's personal touch. The author's personality is what makes a work creative.<sup>760</sup>

### 6.2.1.4. Idea / expression dichotomy

A work is unprotected if granting copyright protection would mean that the underlying idea could not be used. Simply put, ideas are not protected by copyright, but the words and language used to express ideas, themes and concepts are.<sup>761</sup> However, the expression must exceed the *de minimis* threshold.

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<sup>759</sup> *CCH Canadian Ltd v Law Society of Upper Canada* (2004) SCC 13 [25], (2004) 1 RCS 339, 356.

<sup>760</sup> See para 8.3.2.

<sup>761</sup> *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 [100] (Ont SCJ); *Cuisenaire v South West Imports Ltd* (1969) SCR 208, 211 (SCC); *Moreau v St Vincent* (1950) Ex Ct 198, 203; Sunny Handa, *Copyright Law in Canada* (Butterworths 2002) 209; Government

Whether enough skill and judgment was involved in a creation, is a question of fact and degree. Therefore, originality is a question of fact and degree.<sup>762</sup> The main question therefore is: When has enough skill and judgment been exercised so that an idea has crossed the line to protectable expression. This question can only be answered on a case by case basis. However, the courts are guided in their decision by some basic principles. For example, the narrower the nature of the subject and the more limited the number of ways to describe a subject, the lower the chances of copyright protection are. This shall ensure that sufficient 'material' remains in the public domain and that anyone can engage in the subject matter.<sup>763</sup> No-one shall dominate one subject entirely. The term 'subject' has a different meaning than 'specific expression'. Hence, that means one person may not be granted copyright covering an entire subject area, such as e.g. how to use a brush to wash a car in general. That means, granting copyright e.g. for all possible descriptions of how to use the brush for washing cars would be excessive and deplete the public domain at a quick pace. What could be protected might be the individual description of how to use the brush for a car wash. However, even then the *de minimis* threshold for individual expressions must be borne in mind. Therefore, copyright was in fact denied to instructions explaining how to use a brush for washing cars in *Les Promotions Atlantiques Inc v Hardcraft Industries Ltd*.<sup>764</sup> Copyright was also denied to a computer program designed to monitor the performance of a HP 3000.<sup>765</sup> If such works had been created in the UK, where the High Court granted copyright even for maths exam papers with common math problems, these works may have received copyright protection.<sup>766</sup> Although the threshold for copyright used to be lower in the UK than in Canada, LFCs are not copyrighted in the UK independent of the plot,<sup>767</sup> but may be protected by copyright in Canada.

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of Canada Publications, 'About Copyright' (*Government of Canada*, 7 Jan 2013) <<http://publications.gc.ca/site/eng/ccl/aboutCopyright.html>> accessed 14 January 2013.

<sup>762</sup> *Productions Avanti Ciné-Video Inc v Favreau* (1999) 1 CPR (4<sup>th</sup>) 129 (Que CA).

<sup>763</sup> Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b] (Pub 399, Rel 28-12/2016).

<sup>764</sup> *Les Promotions Atlantiques Inc v Hardcraft Industries Ltd* (1987) 17 CPR (3d) 552 [5]; Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b] (Pub 399, Rel 28-12/2016).

<sup>765</sup> *Delrina Corp v Triolet Systems Inc* (2002) 58 OR (3d) 339, (2002) CanLII 11389 [35], [82] (ON CA); Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b] (Pub 399, Rel 28-12/2016).

<sup>766</sup> *University of London Press Ltd v University Tutorial Press Ltd* [1916] 2 Ch 601.

<sup>767</sup> See paras 1.1.2.2.4. – 1.1.2.2.7.

### 6.2.1.5. Titles

In an endeavour to further evaluate how low or high the threshold for copyright protection is, this thesis looks at the copyrightability of titles. Titles of literary and other works are typically short like character names or even coincide with the name of the protagonist.

The title of a work is included in the work and partakes in the work's copyright, if the title itself is 'something substantial',<sup>768</sup> 'original and distinctive'.<sup>769</sup> However, the title does not enjoy copyright separate from the work which it denotes.<sup>770</sup> For example, the Ontario Supreme Court found in *Shewan v Canada* that the title of the song 'Yukon Magic and Mystery' without the music was not a substantial part of the song, but a mere idea.<sup>771</sup>

This would suggest that the same applies to names of fictional characters. Indeed, this was confirmed by a 2013 Government publication as well as the courts.<sup>772</sup> In principle, names are not copyrighted,<sup>773</sup> but 'where the name identifies a well known character,

<sup>768</sup> Government of Canada Publications, 'About Copyright' (*Government of Canada*, 7 Jan 2013) <<http://publications.gc.ca/site/eng/ccl/aboutCopyright.html>> accessed 14 January 2013.

<sup>769</sup> CA 1985 s 2 which states: 'work includes the title thereof when such title is original and distinctive; (*oeuvre*)'.

<sup>770</sup> *Shewan v Canada* (Attorney-General) (1999) 14930 [107] (ON SC); Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][a] (Pub 399, Rel 28-12/2016).

<sup>771</sup> *Shewan v Canada* (Attorney-General) (1999) 14930 [100] and [107] (ON SC); Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][a] (Pub 399, Rel 28-12/2016).

Other examples that lacked originality and distinctiveness: example 'Guinness Book of Olympic Records' (book title) *Canadian Olympic Association v Konica Canada Ltd* (1991) 85 DLR (4<sup>th</sup>) 719, (1992) 1 FC 797, 39 CPR (3d) 400 [31] et seq (FCA), 'There Goes my Everything' (song title) *Blue Crest Music Inc v Canusa Records Ltd* (1974) 17 CPR (2d) 149 [14] (Fed Ct) [There was no evidence from the defendant that the title was original and distinctive.], and 'Médecine d'aujourd'hui' (TV series) *Flamand v Société Radio-Canada* (1967) Que SC 424, (1967) 53 CPR 217 [15] and [17] (Que SC).

<sup>772</sup> Government of Canada Publications, 'About Copyright' (*Government of Canada*, 7 Jan 2013) <<http://publications.gc.ca/site/eng/ccl/aboutCopyright.html>> accessed 14 January 2013; *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 [111] (Ont SCJ); *Preston v 20<sup>th</sup> Century Fox Canada Ltd* (1990) 38 FTR 183, 33 CPR (3d) 242, 275 (Fed Ct); *Cité-Amérique Distribution Inc v CEPA Le Baluchon Inc* (2002) RJQ 1943 [64] (Que SC); *King Features Syndicate Inc v Lechter* (1950) Ex CR 297 [305] et seqq (Cameron J: 'where the name identifies a well known character copyright in the name and associated character may be recognized'. This Canadian case concerned 'Popeye'.)

<sup>773</sup> *King Features Syndicate v Lechter* (1950) 12 CPR 60, (1950) Ex CR 297 [11] et seq.

copyright in both the name and the character may be recognized.<sup>774</sup> Interestingly, this Government publication regarded the name of a character as a substantial part of the fictional character instead of regarding it as part of the literary or artistic work in which the LFC or AFC features. This reflects clearly that characters are copyrightable in Canada under the basic principles that apply to all other works. In addition to the above general requirements, some requirements specific to LFCs shall be critically evaluated in the subsequent paragraphs.

### 6.2.2. Specific legal requirements for copyright protection of LFCs

The Québec Superior Court granted copyright protection to an AFC/LFC as early as *Zlata v Lever Bros Ltd* (1948).<sup>775</sup> The case concerned short stories in comic format which recounted the life of the AFC/LFC ‘Bécassine’, a naïve and loyal maid servant from Brittany who moved to Paris for work.<sup>776</sup> The defendants had aired a radio programme featuring a character of the same name and characteristics. The defendants had not acquired a licence to do so from the author of the *Bécassine* series. The plaintiff on the other hand, a professional radio artist, had obtained the necessary exclusive licence from the author to adapt the author’s work into audio plays for radio transmission. The plaintiff’s claim against the defendants for copyright infringement was successful.<sup>777</sup>

Another case regarding LFCs, that granted copyright protection to LFCs (though in combination with the setting) was *Cinar Corporation v Robinson*.<sup>778</sup> In this case, the

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<sup>774</sup> *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 [111] (Ont SCJ); *King Features Syndicate v Lechter* (1950) 12 CPR 60, (1950) Ex CR 297 [11]; John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 249.

<sup>775</sup> *Zlata v Lever Bros Ltd* (1948) Que SC 459, (1948) 9 CPR 34 [3] (Que SC).

<sup>776</sup> The author of this series classifies ‘Bécassine’ as an AFC/LFC combination, because this comic figure was presented differently than comics are presented nowadays. The ‘Bécassine’ comics, although naturally consisting of drawings of the character in question, did not have any speech bubbles in which the character itself spoke. Instead each panel was accompanied by a narrative. Strictly speaking, all comic characters, unless presented exclusively in artistic format (drawing), are a combination of an artistic and literary character due to the common speech bubbles in comics.

<sup>777</sup> *Zlata v Lever Bros Ltd* (1948) Que SC 459, (1948) 9 CPR 34 [3] (Que SC); Ysolde Gendreau and David Vaver, ‘Canada’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016).

<sup>778</sup> *Cinar Corporation v Robinson* (2013) SCC 73 [56].

film distribution company Cinar appealed the Court of Appeal's decision that it was liable for infringement of the respondent's (Robinson's) copyright in the setting and characters, which Robinson had created while developing an educational childrens' programme. Robinson had developed the setting and characters drawing sketches of these, writing storyboards, scripts and synopses, also detailing the characters in writing. Therefore, the characters in question are AFCs and LFCs. The Supreme Court of Canada held that the appellant had copied a substantial part from the respondent's work (settings, characters, etc. – not just characters).<sup>779</sup> This case also made clear that a work could also be reproduced by non-literal copying, as long as there were substantial similarities between the new work and the earlier work.<sup>780</sup> Adding differences to the similarities does not change the fact that there has been culpable similarity between the works. Whether the similarities are substantial is evaluated from the point of view of the target audience/group of the work in question, meaning the 'perspective of a [lay] person whose senses and knowledge allow him or her to fully assess and appreciate all relevant aspects ... of the works at issue'. Depending on the subject matter, it may become necessary to go beyond a lay person's perspective and to consult expert witnesses, who are 'reasonably versed in the relevant art or technology' as evidence to assist in process.<sup>781</sup>

In an earlier case, *Preston v 20th Century Fox Canada Ltd*,<sup>782</sup> some vague criteria for LFC copyrightability like in the USA had already been set out. It was held in this case that LFCs from a film script could be copyright protected separate from the underlying work, the script. The Federal Court of Canada also stipulated, that in order to achieve copyright protection, the LFC must be 'sufficiently clearly delineated' in the underlying copyright work and it must be 'widely known and recognized'.<sup>783</sup> It is left open how

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<sup>779</sup> Ibid.

<sup>780</sup> Ibid [27]; Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 8[1][a] [ii] (Pub 399, Rel 28-12/2016).

<sup>781</sup> *Cinar Corporation v Robinson* (2013) SCC 73 [51]; Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016).

<sup>782</sup> *Preston v 20<sup>th</sup> Century Fox Canada Ltd* (1990) 38 FTR 183, 33 CPR (3d) 242 (Fed Ct) ('Ewoks' case).

<sup>783</sup> Ibid 275 (Fed Ct); Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016); Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 103; Barry Gamache, 'Heirs' Reversionary Rights Outweigh Rights of Licensee' (2001) 2-4 World Licensing



exactly this shall be measured by the court. It is only clear that the character must be very memorable in order to become widely known and remain in the reader's imagination long after reading the story. One might argue that less developed characters are more memorable to the public than complex characters such as 'John, the Savage', from Aldous Huxley's *Brave New World*. However, this would counter the requirement that a character must be 'sufficiently clearly delineated'. Moreover, the court further held in *Preston v 20<sup>th</sup> Century Fox Canada Ltd* that the rudimentary characters in this particular case ('Ewoks' from the script *Space Pets*) did not meet the test. Hence, the defendants who had produced the *Star Wars* film *The Return of the Jedi*, in which furry creatures called 'Ewoks' feature, did not infringe the plaintiffs copyright.<sup>784</sup>

If one contemplates only the above cases, the requirements for LFC copyrightability in Canada are vaguer and therefore more open to differing interpretations than the criteria that have been determined in France and in particular Germany, where the LFC's external and internal characteristics are discussed specifically and in much more detail<sup>785</sup> than the LFC's were represented in the above Canadian cases. The advantage of the vaguer Canadian requirements for LFC copyrightability is that the courts are more flexible when judging the individual case. However, it also means that there is less legal certainty as to which LFCs are sufficiently clearly delineated. On the one hand that might have the positive effects for authors that

- a) more broadcasters, filmmakers, etc. would take out a licence from the authors whose character might appear copied in their work
- b) fewer competing authors would dare copy another author's character.

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Law Reports 3, 4; International Bureau, 'Character Merchandising' (WO/INF/108, 1994) Annex I, 2 <[http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo\\_inf\\_108.pdf](http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo_inf_108.pdf)> accessed 20 September 2012.

<sup>784</sup> *Preston v 20<sup>th</sup> Century Fox Canada Ltd* (1990) 38 FTR 183, 33 CPR (3d) 242, 275 (Fed Ct); affirmed by (1993) 53 CPR (3d) 407 (Fed CA).

<sup>785</sup> See paras 7.2.2. and 7.3.2.

That again has the positive effect that authors would earn more royalties. It would also have a benefit for the public, because competing authors would have to take more care creating new characters.

On the other hand, the negative effect of vague LFC copyrightability criteria is that authors in general might feel concerned that they might copy another author's work. This might have a stifling effect on their productivity. In principle, an author should not be overly worried whether she will infringe copyright, if she has created the work independently from the plaintiff author. However, their worries would not be entirely unfounded, because a court might regard it as an indication that the defendant author has illegally copied the plaintiff author's work if there is quite a number of similarities between the creations.

Fortunately, not all court cases relating to LFCs have been as vague as the above in judging the characters' copyrightability. The following case was more specific. The Québec Court of Appeal was well-disposed towards protection of characters in a case concerning the reproduction of characters from the popular TV series *La Petite Vie* which were parodied archetypically in the adult film *La Petite Vite – Réflexologie érotique*. The defendant had reproduced the features of the characters and made use of similar props and the series' soundtrack. Neither the script nor the dialogue from the script and series of the plaintiff were reproduced. Initially, the Québec Superior Court ruled that the characters created by the plaintiff were not sufficiently original by themselves.<sup>786</sup> The Québec Superior Court's decision by Cote J was overturned by the Québec Court of Appeal two years later. According to Gendreau J, fictional characters which are clearly identifiable, autonomous, well characterized and who can be recognized by their external appearance, conduct, antics, and language are copyrightable.<sup>787</sup> Gendreau J states:

The staging is essential to the text as [are] the sets and characters. One does not go without the other. Each party is a creation in itself and the fruit of the

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<sup>786</sup> *Productions Avanti Ciné-Video Inc v Favreau* (1997) 79 CPR (3d) 385 [39] (Que SC); Andrew McGee and Gary Scanlan, 'Copyright in Character' (September 2003) JBL 470, 481.

<sup>787</sup> *Productions Avanti Ciné-Video Inc v Favreau* (1999) 1 CPR (4<sup>th</sup>) 129 (Que CA); *Cité-Amérique Distribution Inc v CEPA Le Baluchon Inc* (2002) RJQ 1943 [66] (Que SC); Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016); Andrew McGee and Gary Scanlan, 'Copyright in Character' (September 2003) JBL 470, 481.

imagination of the author. ... On the view that the characters themselves are a creation, a substantial part of the work, ... Avanti holds the copyright ... unauthorized use becomes unlawful under the Act.<sup>788</sup>

The Ontario Superior Court was even more specific. For one thing, it followed the abstract criteria of *Preston v 20th Century Fox Canada Ltd* in *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* by stipulating that a 'requirement for copyright of characters in a literary work is that the description in the work be sufficiently clearly delineated such that the character subsequently becomes well known and widely recognized.'<sup>789</sup> For another thing, the Ontario Superior Court then went on to actually describe 'Anne' and the situations she finds herself in in the books.<sup>790</sup> In the end, the Ontario Superior Court found that the defendant had reproduced 'Anne Shirley's 'vivid, unique, and complete' character traits as well as her physical attributes in the character wares.<sup>791</sup>

Hence, the LFC specific copyrightability criteria used by Canadian courts coincide with those in France and Germany. The character's personality as well as appearance are relevant criteria. Like humans, what distinguishes one from the other is their inner character, values and beliefs which dictate their behaviour, and their appearance (plus their education, job, family situation). As authors shape characters (mostly) on humans, they should be distinguished by the same criteria.

### 6.2.3. Fanfiction

Although LFCs are copyrightable in Canada, fanfiction will commonly not infringe copyright. The reason is section 29.21 of the CA 1985. This section was introduced into the CA 1985 by the Copyright Modernization Act 2012 and came into force on 7 November 2012. Section 29.21 contains the so-called UGC exception (user-generated

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<sup>788</sup> *Productions Avanti Ciné-Video Inc v Favreau* (1999) 1 CPR (4<sup>th</sup>) 129 (Que CA).

<sup>789</sup> *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 [111] (Ont SCJ).

<sup>790</sup> *Ibid* [114], [117] et seqq and [121].

<sup>791</sup> *Ibid*.

content). It stipulates that copyright is not infringed, if an individual uses a copyrighted existing work to create a new work provided that

- a) the use is for non-commercial purposes,
- b) the existing source work is mentioned in the new work, if reasonable under the circumstances,
- c) the individual had reasonable grounds to believe that the source work itself was not already infringing copyright, and
- d) the use of the new work does not have a substantial adverse effect on the financial or other interests of the author of the source work.

Although this provision was aimed at digital user-generated works, such as mashups, fanfiction is capable of being caught by the same provision.<sup>792</sup> That would mean that fanfiction would not infringe copyright. Fanfiction is typically, though not always, provided for free, and usually names the source (in many instances though no mention is made of the source author's name). Whether the work of fanfiction has a substantial negative financial or other adverse effect on the author of the canon is debatable though and depends on the individual circumstances.

It should be noted though that moral rights are not affected by the UGC exception.<sup>793</sup> That means, even though a story of fanfiction, which has clearly copied the LFCs of another author, may still infringe the author's moral rights, even when the fanfiction fulfils all criteria of the UGC exception and therefore does not infringe copyright. Moral rights can be infringed even if the economic rights are not. That could for example be, if the integrity of the author's LFC is compromised by a distortion of the LFCs in the work of fanfiction. However, if the author of fanfiction commercializes the work, then it could infringe copyright in the underlying work and its characters after all.

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<sup>792</sup> Bob Tarantino, 'Fan Fiction – After the Copyright Modernization Act' (*Entertainment & Media Law Signal*, 11 December 2012) <[www.entertainmentmedialawsignal.com/articles/copyright/](http://www.entertainmentmedialawsignal.com/articles/copyright/)> accessed 9 January 2013.

<sup>793</sup> *Ibid.*

#### 6.2.4. Unauthorized character merchandising

Fictional characters are not only protected against 2D reproduction in other literary works, but also against reproduction in three dimensions. That pertains to direct as well as indirect reproduction.<sup>794</sup>

For example, the manufacture and distribution of dolls representing ‘Strawberry Shortcake’ without the authorization by the copyright owner of the drawings of the AFC ‘Strawberry Shortcake’ was stopped by injunction based on the plaintiff’s copyright.<sup>795</sup>

The copyright owner of the sculpture of ‘E.T.’ also successfully obtained an interlocutory injunction against the unauthorized production and sale of ‘E.T.’ merchandise, such as keychains bearing ‘E.T.’s image and ‘E.T.’ dolls.<sup>796</sup>

Even T-shirts bearing the distinctive artistic lettering ‘Crocodile Dundee’ were held to infringe copyright in the advertisements of the film distributor from which the words and artwork had been copied.<sup>797</sup>

Not only AFCs, but also LFCs are protected by copyright against unauthorized character merchandising. They, too, are protected from direct as well as indirect reproduction. Indirect reproduction refers to the reproduction of a character as merchandising items, such as dolls, shampoo bottles, 3D stickers. This is an indirect reproduction, because other steps are necessary before the end product can be made. For example, firstly, the literary work has to be read and the character traits extracted from the literary work. Secondly, drawings, CAD files and/or moulds have to be made according to the extracted character traits. Lastly, the merchandising product, such as a lunch box with the image of the LFC or a collectible figurine representing the LFC can be manufactured.

<sup>794</sup> John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 250.

<sup>795</sup> *American Greetings Corp v Oshawa Group Ltd* (1982) 69 CPR (2d) 238 [12] and [15] (Fed Ct); Ysolde Gendreau and David Vaver, ‘Canada’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016); Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 224 et seq.

<sup>796</sup> *Universal City Studios Inc v Zellers Inc* (1984) 1 FC 49, (1983) 73 CPR (2d) 1 [1] and [16] (Fed Ct); Ysolde Gendreau and David Vaver, ‘Canada’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016).

<sup>797</sup> *Paramount Pictures Corp v Howley* (1991) 5 OR (3d) 573, 39 CPR (3d) 419, 426 [15] et seqq (Ont Gen Div); *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 [109] (Ont SCJ); Ysolde Gendreau and David Vaver, ‘Canada’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016).

*Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* is the key judgment, that proves that copyright in LFCs protects the owner of the copyright against unauthorized character merchandising.<sup>798</sup> The case concerned the LFC ‘Anne Shirley’ aka ‘Anne of Green Gables’, which had been created by Canadian author Lucy Maud Montgomery, and is Canada’s most illustrious LFC. The defendant had taken out a licence from the plaintiffs which allowed them to manufacture and sell character merchandise bearing a semblance to LFCs from the ‘Anne of Green Gables’ book series. The defendant did not pay the licence fees. Hence, the plaintiffs terminated the licensing agreement. Regardless, the defendant continued with its activities. Therefore, the plaintiffs sought damages for unpaid licence fees for the period before as well as the period after the agreement’s termination. Additionally, the plaintiffs also sought injunctive relief to prevent the defendant from selling any further ‘Anne of Green Gables’ related merchandise wares (e.g. ‘Anne’ dolls and puzzles). The defendant argued that the craft objects were no reproduction of the literary book series ‘Anne of Green Gables’, and that therefore no copyright of the plaintiffs had been infringed. The court disagreed and found in favour of the plaintiffs.

Firstly, the court stated explicitly that the verbal portrait of LFCs was copyrighted, if the LFC was ‘clearly delineated, distinctive, thorough and complete’.<sup>799</sup> The court found that these criteria were satisfied by the LFC ‘Anne Shirley’ after analysing the description of ‘Anne’ and her experiences in life in the books.<sup>800</sup>

Secondly, the Ontario Superior Court of Justice answered the question whether the copyright interest of Lucy Maud Montgomery’s heirs included the right to license two-dimensional and three-dimensional objects resembling the LFCs (or situations) of the *Anne* book series in the affirmative.<sup>801</sup> As stated above, the defendant had reproduced

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<sup>798</sup> *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 (Ont SCJ); affirmed by (2000) 6 CPR (4<sup>th</sup>) 57 (Ont CA).

<sup>799</sup> *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 [100] (Ont SCJ); Ysolde Gendreau and David Vaver, ‘Canada’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016); Grace Westcott, ‘Friction over Fan Fiction’ (2008) *Literary Review of Canada* <[www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/](http://www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/)> accessed 9 January 2013; D Paul Thackaberry, ‘Canada: licensing – breach of “Anne of Green Gables” licence agreement’ (2001) 12 Ent LR N16.

<sup>800</sup> *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 [114], [117] et seqq and [121] (Ont SCJ); Barry Gamache, ‘Heirs’ Reversionary Rights Outweigh Rights of Licensee’ (2001) 2-4 *World Licensing Law Reports* 3, 4.

<sup>801</sup> *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 [119] and [121] (Ont SCJ); Ysolde Gendreau and David Vaver, ‘Canada’ in Lionel Bently (ed), *International*

‘Anne Shirley’s ‘vivid, unique, and complete’ character traits as well as her physical attributes in the character wares.<sup>802</sup>

The court also pointed out that the defendant had failed to make the royalty payments, because it was the defendant’s ‘irrational view’ that she was the one doing all the work.<sup>803</sup> The defendant’s view radically undermined the concept of copyright as well as the very purpose of a licensing agreement.<sup>804</sup>

### 6.2.5. Moral rights

The above two sections mainly discuss the economic aspects of LFC copyrightability. The next section covers the moral rights’ dimension.

Provisions on moral rights of authors have been part of Canadian copyright law since 1931. Canada was the first common law country to adopt moral rights provisions. It did so only three years after the Rome Act 1928 had introduced Article 6*bis* on moral rights into the Berne Convention 1886.<sup>805</sup>

However, as Canada is a common law country, moral rights do not play such a major role in protection of LFCs in Canada, unlike in Germany and in particular France.<sup>806</sup> For one thing, moral rights have not been claimed in the Canadian copyright cases concerning LFCs. On the whole, only a few copyright cases dealing with moral rights have been adjudicated in Canada at all. It is rare for an author to claim infringement of her moral rights in Canada. The economic rights, especially the reproduction right, are generally regarded as more beneficial in Canada. For one thing, the fact that there are many more precedents concerning authors’ economic rights makes economic rights the preferred choice instead of moral rights. For another thing, moral rights are more

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*Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016); D Paul Thackaberry, ‘Canada: licensing – breach of “Anne of Green Gables” licence agreement’ (2001) 12 Ent LR N16.

<sup>802</sup> *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 [114], [117] et seq and [121] (Ont SCJ).

<sup>803</sup> *Ibid* [274]; *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 6 CPR (4<sup>th</sup>) 57 [15].

<sup>804</sup> Barry Gamache, ‘Heirs’ Reversionary Rights Outweigh Rights of Licensee’ (2001) 2-4 World Licensing Law Reports 3, 4.

<sup>805</sup> Kristin L Lingren, ‘Canada’ in Gillian Davies and Kevin Garnett (eds), *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 785; Mira T Sundara Rajan, ‘Moral rights or economic rights?’ in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 212.

<sup>806</sup> See paras 7.2.4., 7.3.2.4.1., 7.3.2.4.3. and 7.3.2.5.

complex than economic rights. For example, proving an infringement to the reproduction right is easier than proving infringement of the integrity right for the practical reason that the author who claims violation of her integrity right must prove prejudice to her reputation or the reputation of her work.<sup>807</sup> This is not necessary in a claim for infringement of the reproduction right.

Moreover, unsurprisingly, like in the UK, moral rights may not be assigned, but waived entirely or partly.<sup>808</sup> This does not mean that moral rights are irrelevant. However, all things considered, moral rights play a minor role in Canada, especially with regard to LFCs. The author of a LFC theoretically has moral rights (the integrity right and the paternity right)<sup>809</sup> in the LFC, but will commonly not assert these.

### 6.3. United States of America

Copyright protection of published as well as unpublished works is regulated by the Copyright Act 1976 Title 17 (17 USC). However, characters are neither mentioned in 17 USC § 102 which lays down the subject matter of copyright in general, nor 17 USC § 106 which sets forth the exclusive rights in copyrighted works, nor 17 USC § 501 which deals with the infringement of copyright. LFCs are only copyrighted, if the general legal requirements of copyright are satisfied. In addition, some character specific tests were developed by US courts. Both the general requirements as well as the test shall be critically evaluated on the following pages.

#### 6.3.1. General legal requirements for copyright protection of LFCs

Just like UK copyright law, US copyright law grants copyright protection to creations of authorship which are original and fixated so that the expression of ideas is tangible.<sup>810</sup>

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<sup>807</sup> CA 1985 s 28.2(1); Mira T Sundara Rajan, 'Moral rights or economic rights?' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 213.

<sup>808</sup> Canada: CA 1985 s 14.1(2). UK: CDPA 1988 s 94 (not assignable) and s 87(2) (waiver).

<sup>809</sup> CA 1985 s 14.1(1); Kristin L Lingren, 'Canada' in Gillian Davies and Kevin Garnett (eds), *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 789; Philip B Kerr, 'Copyright Law in Canada' (*Kerr & Nadeau*) <[www.http://users.trytel.com/~pbkerr/copyright.html](http://users.trytel.com/~pbkerr/copyright.html)> accessed 10 January 2013.

<sup>810</sup> 17 USC § 102(a); Noel L Allen, Brenner A Allen and Nathan E Standley, 'Laws of the United States with Commentary' in Dennis Campbell (ed), *World Intellectual Property Rights and Remedies Laws*



### 6.3.1.1. Catalogue of protected works

Title 17 USC enumerates works that are subject to copyright protection in § 102(a). Among the types of works named in 17 USC § 102(a) are literary works. According to 17 USC § 101 “Literary works” are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.’ A LFC is expressed in words and can be embodied in printed works, such as books and magazines. Therefore, it easily falls under the definition of literary works, as set out by 17 USC § 101.

Unlike the UK’s CDPA 1988, which stipulates a comprehensive list of works that may enjoy copyright in Section 1(1), the 17 USC specifies in § 102(a) that ‘Works of authorship include the following categories...’. It also states that works of authorship may be works that are ‘now known or later developed’. Both expressions (‘include’ and ‘now known or later developed’) make it clear that the list of works is illustrative, not exhaustive, and that even new categories of works, which authors may come up with in the future, may be copyrightable. Indeed, the USC Title 17 states in § 101 itself that ‘The terms “including” and “such as” are illustrative and not limitative.’ Therefore, due to the 17 USC’s broad scope, a LFC may be not only classified as a literary work, but may instead be copyright protected as a work *sui generis* like in France.<sup>811</sup>

### 6.3.1.2. Fixation requirement

The fixation requirement is legislatively rooted in 17 USC § 102(a) according to which ‘original works of authorship fixed in any tangible medium of expression’ are copyright protected. The embodiment of the fixation must be sufficiently durable and stable, not of a mere transitory nature.<sup>812</sup> A speech, publicly read poem, or presentation is not copyrightable in its oral form unless it is recorded e.g. in writing or sound. It is sufficient

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*with Commentary*, Vol 6, § 95:5 (R 5/2016); John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 302.

<sup>811</sup> See para 7.3.1.1.

<sup>812</sup> 17 USC § 101.

for fixation that the author dictates a poem to a stenographer.<sup>813</sup> As regards literary works, the fixation requirement means that the work must be ‘expressed in words, numbers, other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, ..., phonorecords, ... disks ... in which they are embodied.’<sup>814</sup> That means, that the literary work must be recorded either visually or audibly. LFCs are written down in literary works, albeit their description may be labour intensive to extract from the entire text.

### 6.3.1.3. Originality

17 USC § 102(a) also specifies another requirement for copyright protection – originality. A work is original, if it originates from the author. That means that the work must not be a copy of another author’s work.<sup>815</sup> Moreover, originality requires an element of creativity according to *Feist Publications, Inc v Rural Telephone Service Co, Inc*.<sup>816</sup> This definition of ‘originality’ reflects 17 USC § 102(b) according to which copyright vests only in the expression of ideas, but never the underlying facts and ideas themselves.<sup>817</sup>

Prior to *Feist*, the circuit courts had differing views on which of the two major doctrines should be applied to determine copyright – the sweat of the brow doctrine or the creative choice doctrine. The key reason for this split are the different justifications of copyright protection – incentivising effort and/or investment by rewarding the author with copyright, or incentivising the creation of new works available to the public by

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<sup>813</sup> *Adrien v Southern Ocean County Chamber of Commerce*, 927 F 2d 132, 135 (3d Cir 1991); Eric J Schwartz and David Nimmer, ‘United States’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, §2[1][a] (Pub 399, Rel 28-12/2016).

<sup>814</sup> 17 USC § 101.

<sup>815</sup> Eric J Schwartz and David Nimmer, ‘United States’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, §2[1][b] (Pub 399, Rel 28-12/2016).

<sup>816</sup> *Feist Publications, Inc v Rural Telephone Service Co, Inc*, 499 US 340, 345 (1991); *Tele-Direct (Publications) Inc v American Business Information, Inc* (1998) 2 FC 22 [29] (CA); Intellectual Property Practice Team Moore & Van Allen, ‘Laws of the United States with Commentary’ in Dennis Campbell (ed), *World Intellectual Property Rights and Remedies Laws with Commentary*, Vol 3, § 50:18 (R 12/2013).

<sup>817</sup> *Feist Publications, Inc v Rural Telephone Service Co, Inc*, 499 US 340, 347 (1991); Dorothy J Howell, *Intellectual Properties and the Protection of Fictional Characters* (Quorum Books 1990) 85; Roberta Mongillo, ‘The idea-expression dichotomy in the US and EU’ (2016) 38 EIPR 733.

rewarding the author with copyright. Unlike in Germany and France,<sup>818</sup> US copyright is not a natural right emanating from ‘the author’s creative soul.’<sup>819</sup> Instead, the US takes the view that copyright should be regarded rather as a contract that has been formed between the public and the author. This social ‘contract’ should, however, be concurrent with the US Constitution’s aim to ‘promote the progress of ... arts, by securing for limited times to authors ... the exclusive right to their respective writings’.<sup>820</sup>

Therefore, the Supreme Court of the United States had to decide in *Feist* whether the labour should be rewarded (thereby following the sweat of the brow doctrine) or whether creativity should be rewarded (thereby following the creative choice doctrine).

The Constitutional clause (US Constitution 1787 Article 1, § 8, Clause 8) stipulates that ‘Congress shall have the Power ... To promote the Progress of Science and useful Arts... by securing for limited Times to Authors ... the exclusive Right to their ... Writings’. Hence, the main objective of copyright is the promotion of the progress of authors’, not providing a reward for authors’ labour. Consequently, copyright protects authors’ original expression on the one hand, but on the other hand permits others to use and build upon ideas and information from other works,<sup>821</sup> thereby fostering creativity.

Hence, the classical sweat of the brow test is insufficient, because it extends copyright in compilations beyond selecting and arranging facts to the facts themselves. This transgresses the principle that ideas are not copyrightable.<sup>822</sup> Hence, *Feist* sought to revise the classical test. It is the creative choices, which an author makes and thereby shows her personality in her work, that distinguish one work from the other and makes it original.<sup>823</sup> The element of creative choice had been mentioned in the very early cases with regard to photographs, but had not been adopted for compilations. Thus,

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<sup>818</sup> See para 1.5.2.

<sup>819</sup> Daniel J Gervais, ‘Feist goes global: A comparative analysis of the notion of originality in copyright law’ (2002) 49 J Copyright Soc’y USA 949, 953; Marci Hamilton, ‘Copyright at the Supreme Court: A jurisprudence of deference’ (2000) 47 J Copyright Society 317, 323 et seq.

<sup>820</sup> US Constitution 1787 art 1, s 8, cl 8 (the copyright clause); Daniel J Gervais, ‘Feist goes global: A comparative analysis of the notion of originality in copyright law’ (2002) 49 J Copyright Soc’y USA 949, 953.

<sup>821</sup> *Feist Publications, Inc v Rural Telephone Service Co, Inc*, 499 US 340, 349 et seq (1991).

<sup>822</sup> *Ibid* 353.

<sup>823</sup> *Ibid* 348.

the sweat of the brow approach continued to be applied to compilations until *Feist*.<sup>824</sup> The *Feist* test requiring the author's creative choice has been adopted by the courts as the standard test.<sup>825</sup> That means, the courts apply the *Feist* test to all categories of works, not just compilations.<sup>826</sup>

The judges in *Feist* did not intend to introduce a stricter level of originality when changing the approach to judging copyright protection. The Supreme Court merely sought a more fitting test, one that is applicable to modern types of works and, at the same time, reflects the purpose of copyright. Creating a stricter originality threshold would have been contrary to what *Feist* found to be the only true justification for copyright protection. That is, to act as an incentive for authors to create new works for the common good, not to threaten the livelihood of authors, if their writings are not imaginative enough.<sup>827</sup> Therefore, *Feist* advocates a minimum degree of creativity that even allows copyright for the arrangement and selection of facts (though, of course, not facts themselves) as a compilation, if the compiler exercised some creativity independently.<sup>828</sup> It is submitted that since factual compilations can be granted copyright protection, it is natural that more creative works, such as fictive characters can pass the originality requirement. An approach similar to the one applied to compilations can also be used with regard to character protection. The individual elements of a character are the raw material, like facts of a compilation. Facts

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<sup>824</sup> *Trade-mark cases. US v Steffens, US v Wittemann, US v Johnson*, 100 US 82, 94 (S Ct 1879); *Burrow-Giles Lithographic Co v Sarony*, 111 US 53, 60 (S Ct 1884); *Falk v Brett Lithographing Co*, 48 F 678, 679 (CCNY 1891); *Gentieu v John Muller & Co, Inc*, 712 F Supp 740, 742 (W D Mo 1989); Joseph P Hart, 'From facts to form: Extension and application of the Feist "Practical Inevitability" test and creativity standard' (1992) 22 Golden Gate U L Rev 549, 550.

<sup>825</sup> *Kregos v Associated Press*, 937 F 2d 700, 704 (2d Cir 1991); *Sem-Torq, Inc v K Mart Corp*, 936 F 2d 851, 854 et seq (6<sup>th</sup> Cir 1991); *BellSouth Advertising & Publishing Corp v Donnelley Info Publishing, Inc*, 999 F 2d 1436, 1440 (11<sup>th</sup> Cir 1993), cert denied, 114 S Ct 943 (1994); Tracy Lea Meade, 'Ex-Post Feist: Applications of a landmark copyright decision' (1994-1995) 2 J Intell Prop L 245.

<sup>826</sup> Jane Ginsburg, 'No "Sweat"? Copyright and other protection of works of information after *Feist v Rural Telephone*' (1992) 92 Colum L Rev 338, 339.

<sup>827</sup> *CCC Information Services, Inc v Maclean Hunter Market Reports, Inc*, 44 F 3d 61, 66 (2d Cir 1994), cert denied, 116 S Ct 72, 516 US 817 (S Ct 1995); *Feist Publications, Inc v Rural Telephone Service Co, Inc*, 499 US 340, 347 - 351 (1991); Daniel J Gervais, 'Feist goes global: A comparative analysis of the notion of originality in copyright law' (2002) 49 J Copyright Soc'y USA 949, 955.

<sup>828</sup> Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 80; *Feist Publications, Inc v Rural Telephone Service Co, Inc*, 499 US 340, 348 and 358 (1991). The court found that the white pages of the respondent Rural were of a 'garden-variety', i.e. too ordinary for creativity. Rural's subscribers had to fill out a standard form with their name and address. Rural merely listed these raw data alphabetically. Hence, Rural's directory was devoid of creativity. Consequently, the appellant Feist did not infringe copyright. *Feist* was cited e.g. in *Effie Film, LLC v Eve Pomerance*, 909 F Supp 2d 273, 294 (SDNY 2012).

themselves are not protected, but the original selection and arrangement of these facts is capable of attracting copyright. Hence, the compilation of character traits which forms a fictional character should be copyrightable, and indeed characters are copyrightable under US law.

#### 6.3.1.4. Idea / expression dichotomy

Mere ideas, such as concepts, principles, and thoughts, are unprotected.<sup>829</sup> It is the arrangement of words, which the author chose to express her ideas that is copyrighted.<sup>830</sup> This ensures on the one hand that any person can make use of words and ideas like sunlight, air, a crouching pose and exaggerated muscles<sup>831</sup> without first having to seek and obtain authorization from the person who expressed the ideas in question first. 'Ideas are raw materials that serve as building blocks for creativity'.<sup>832</sup> Hence, one author can build on the ideas of another. On the other hand, the idea/expression dichotomy also ensures that authors receive some protection for their work. Thereby, authors are encouraged to produce new works for their own and the public's benefit.

If ideas were protected by copyright, free exchange of ideas would be impossible and the creation of works would be severely limited. Authors could not create many new works as a result and only a limited number of works would be available for the public to read, enjoy, educate themselves and critically evaluate.

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<sup>829</sup> 17 USC § 102(b); Intellectual Property Practice Team Moore & Van Allen, 'Laws of the United States with Commentary' in Dennis Campbell (ed), *World Intellectual Property Rights and Remedies Laws with Commentary*, Vol 3, § 50:18 (R 12/2013).

<sup>830</sup> *Warner Bros Pictures v Columbia Broadcasting System*, 102 F Supp 141 (DC Cal 1951).

<sup>831</sup> In *Mattel v Azrack-Hamway International*, Mattel, creator of *Masters of the Universe* dolls, sued its competitor Remco for copyright infringement. The court did not grant injunctive relief to Mattel holding that Remco's dolls were merely an artistic rendering of human features with exaggerated musculature, and therefore an unprotected idea. The crouching pose was also only regarded as a fighting pose that existed since the Neanderthal during the Ice Age. *Mattel v Azrack-Hamway International*, 724 F 2d 357, 360 (2d Cir 1983).

<sup>832</sup> Melville B Nimmer and David Nimmer (ed), *Nimmer on Copyright*, Vol 5, §19E.04[B] (Pub 465, Rel 74-11/2007).

#### 6.3.1.4.1. Hand CJ: No infallible principle

Circuit Judge Hand stated in *Nichols v Universal Pictures Corp* that there is no precise line between an idea and its expression.<sup>833</sup> In *Peter Pan Fabrics, Inc v Martin Weiner Corp*, he added that one cannot define any infallible principle according to which a judge can decide whether somebody has overstepped the idea threshold and instead illegally copied the expression of an idea. Decisions have to be made on a case by case basis for that reason.<sup>834</sup>

#### 6.3.1.4.2. Prof. Chafee: The pattern of a work

Professor Chafee attempted a solution and maintained that the pattern of a work is copyrighted. The pattern consists of the sufficiently concrete sequence of events, the interaction of characters and their development by which the author expresses the theme or her idea.<sup>835</sup> It is submitted that not only the work in its entirety has a pattern, but also individual elements of a work have patterns, such as LFCs. This thesis calls it the ‘character pattern’. The character pattern is determined in particular by a LFCs thoughts, values and actions. Accordingly, it was held in *TMTV, Corpr v Mass Prod, Inc* that copyright was infringed, because the characters in the copyrighted work (sitcom ‘20 Pisos de Historia’) and the infringing work had the same name, wore close to identical costumes, and interacted very similarly.<sup>836</sup>

#### 6.3.1.4.3. Hamley CJ: ‘total concept and feel’ of the work

Hamley CJ proposed that in addition to pattern analysis, the substantial similarity of an allegedly infringing work as compared to the copyrighted work should be judged according to the ‘total concept and feel’ of the works in question.<sup>837</sup> This makes sense

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<sup>833</sup> *Nichols v Universal Pictures Corp*, 45 F 2d 119, 121 (2d Cir 1930).

<sup>834</sup> *Peter Pan Fabrics, Inc v Martin Weiner Corp*, 274 F 2d 487, 489 (2d Cir 1960).

<sup>835</sup> Zechariah Chafee, ‘Reflections on the Law of Copyright’ (1945) 45 Colum L Rev 503, 513 et seq; *Effie Film, LLC v Eye Pomerance*, 909 F Supp 2d 273, 292 (SDNY 2012); *Hogan and Masucci v DC Comics et al*, 48 F Supp 2d 298, 308 et seq (SDNY 1999); *Shaw v Lindhelm*, 919 F 2d 1353, 1363 (9<sup>th</sup> Cir 1990); *Giangrasso v CBS, Inc*, 534 F Supp 472, 476 (ED NY 1982); Melville B Nimmer and David Nimmer (eds), *Nimmer on Copyright*, Vol 4, §13.03[A][1][b] (Pub 465, Rel 98-12/2015).

<sup>836</sup> *TMTV, Corpr v Mass Prod, Inc*, 345 F Supp 2d 196, 213 (D P R 2004).

<sup>837</sup> *Roth Greeting Cards v United Card Co*, 429 F 2d 1106, 1110 (9<sup>th</sup> Cir 1970).

for the same reason that the similarity of a later mark with an earlier mark is also evaluated in trade mark law. There, too, the similarity of trade marks is not just determined by their individual elements, but the overall impression, because the average consumer commonly perceives a mark as a whole and usually does not analyse the various details of the mark.<sup>838</sup>

#### 6.3.1.4.4. Hand CJ and Kaplan: ‘abstractions test’

Hand CJ’s ‘abstractions test’ is also expedient. He wrote that a great number of general patterns fit upon any work, as more and more of the description of the specific situation is left out making it more and more abstract. The last abstraction could be no more than a general message of what the work deals with. Going through those levels of abstraction, there is somewhere a point where copyright protection cannot be given. If that were not the case, then an author could prevent another from using her ideas. However, there is no copyright in ideas.<sup>839</sup>

At first this seems obvious and not helpful, rather abstract - the name says it all. However, Kaplan applied the abstractions test to Shakespeare’s *Hamlet*,<sup>840</sup> thereby giving the test some more substance. One starts with the most concrete idea (the fully developed LFC, such as ‘Hamlet’, a Prince of Denmark, who suspects foul play after his uncle crowns himself and marries ‘Hamlet’s mother after the death of ‘Hamlet’s father, who appears to ‘Hamlet’ as a ghost informing him that indeed his uncle killed him). Then one abstracts the expressive elements (such as ‘Hamlet’ being Danish, having been visited by his father’s ghost, planning to expose his uncle) until one is left with a non-protectable idea (such as ‘Hamlet’ being a prince).<sup>841</sup> It is submitted, that

<sup>838</sup> Case T-623/11 *Pico Food GmbH v OHIM* (CJEU (Second Chamber) 9 April 2014) para 29; *Jack Wills Ltd v House of Fraser (Stores) Ltd* [2014] EWHC 110 (Ch) [56]; *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24 [52]; Case T-33/03 *Osotspa Co Ltd v OHIM* [2005] ECR II-763, para 47; Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, para 47; Case C-251/95 *SABEL BV v Puma AG, Rudolf Dassler Sport* [1997] ECR I-6191, para 23; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, para 25.

<sup>839</sup> *Nichols v Universal Pictures Corp*, 45 F 2d 119, 121 (2d Cir 1930); *Effie Film, LLC v Eve Pomerance*, 909 F Supp 2d 273, 291 et seq (SDNY 2012); Deming Liu, ‘Reflections on the idea/expression dichotomy in English copyright law’ (2017) 1 JBL 71, 77; Ute Klement, ‘Copyright protection of unauthorised sequels under the Copyright, Designs and Patents Act 1988’ (2007) 18 Ent LR 13, 14.

<sup>840</sup> Mathew A Kaplan, ‘Rosencrantz and Guildenstern are dead, but are they copyrightable?: Protection of literary characters with respect to secondary works’ (1999) 30 Rutgers LJ 817, 822.

<sup>841</sup> *Ibid.*

the more elements have to be abstracted and stripped away from the character until one arrives at the basic idea, the more highly developed the character is and the higher the chances are that the character is protected by copyright.

#### 6.3.1.4.5. Hand CJ and Scheindlin J: The individual complexity of a character

This is in accordance with *Nichols v Universal Pictures Corporation*, which basically states that whether a character or incident is copyright protected is dependent upon its individual complexity. The more developed a character is, the more likely is copyright. The corollary is, the less developed a character is, the less deserving it is of copyright.<sup>842</sup>

For example, the LFC ‘Willy the Wizard’ by Adrian Jacobs was found to be superficial and only a ‘rough idea ... of general nature’ in *Allen v Scholastic*.<sup>843</sup> The common attributes between the claimant’s ‘Willy the Wizard’ and the defendant’s ‘Harry Potter’ (renowned male wizards, who were initiated into wizardry relatively late in their pre- and early adolescence, went to wizard school and had to partake in competitions) outlined only a ‘general sketch of a character’, ‘a general prototype’.<sup>844</sup> Hence, ‘Willy’ was an unprotected idea. Moreover, ‘Willy the Wizard’ was so amorphous that the LFC could have been ‘either a villain or hero, acclaimed or maligned, old or young, a social butterfly or solitary recluse—in short, he may be anyone at all.’<sup>845</sup> Scheindlin J stated that substantial similarity cannot be found where, like in this case, two very different LFCs can be construed based on the plaintiff’s character description.<sup>846</sup> The similar characteristics among other characters, who were better developed as ‘Willy the Wizard’, were also regarded as unoriginal, and therefore unprotected ideas.<sup>847</sup>

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<sup>842</sup> *Nichols v Universal Pictures Corp*, 45 F 2d 119, 121 (2d Cir 1930); Mathew A Kaplan, ‘Rosencrantz and Guildenstern are dead, but are they copyrightable?: Protection of literary characters with respect to secondary works’ (1999) 30 Rutgers LJ 817, 821; Carole E Handler, ‘Fictional characters in new media’ (*Lathrop & Gage LLP*, 9 July 2010) 1 <<http://www.lexology.com/library/detail.aspx?g=bbc1a509-f972-4ec6-8ea1-b4c98eaaeb8f>> accessed 10 January 2013.

<sup>843</sup> *Allen v Scholastic*, 739 F Supp 2d 642, 661 (SDNY 2011).

<sup>844</sup> *Ibid* 660.

<sup>845</sup> *Ibid*.

<sup>846</sup> *Ibid* 659 et seqq.

<sup>847</sup> *Ibid* 660; *Sheldon Abend Revocable Trust v Spielberg et al*, 748 F Supp 2d 200, 205 (SDNY 2010); *Arden v Columbia Pictures Industries, Inc*, 908 F Supp 1248, 1261 (SDNY 1995); *Hogan and Masucci v DC Comics et al*, 48 F Supp 2d 298, 310 (SDNY 1999); *Rogers v Koons*, 960 F 2d 301, 308 (2d Cir 1992).



#### 6.3.1.4.6. Hand CJ: The importance of the character to the work

Another indicator of a character's copyright is the importance of the character to the work it was created in. A protagonist is much more likely to be copyrighted than a secondary character. Secondary characters are often stereotypical stock characters and therefore, no more than unprotected ideas,<sup>848</sup> such as an intoxicated Santa Claus, or the curious maid who listens at doors.<sup>849</sup> The aforementioned is only a general principle and every work has to be judged individually. If the protagonist of a work is not well developed, which is the sign of a mediocre (or worse), superficial work, it cannot be copyright protected;<sup>850</sup> and if a secondary character is well developed, it can attract copyright regardless of its secondary position within the highly qualitative work.<sup>851</sup>

#### 6.3.1.5. Titles and names

Titles are not copyright protected in the USA<sup>852</sup> unlike in Canada, where the title is protected as part of the work, if it is original, distinct and substantial.<sup>853</sup> In Germany, titles receive inner protection by copyright against change by (authorized) licensees.<sup>854</sup>

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Example 1: two men in their thirties, bachelors, self-absorbed, who were somehow trapped in a cycle repeating the day again and again. *Arden v Columbia Pictures Industries, Inc*, 908 F Supp 1248, 1261 (SDNY 1995).

Example 2: two young men by the same name (Nicholas Gaunt), half vampire, half human, dark wild hair, pale skin and tired eyes, on a personal quest for their origins, eventually succumbing to evil. *Hogan and Masucci v DC Comics et al*, 48 F Supp 2d 298, 310 (SDNY 1999).

<sup>848</sup> *Nichols v Universal Pictures Corporation et al*, 45 F 2d 119, 121 et seq (2d Cir 1930); Eric J Schwartz and David Nimmer, 'United States' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, §2[4][b] (Pub 399, Rel 28-12/2016); Robert Fremlin, *Entertainment Law* (1990 Clark Boardman Callaghan) 379.

<sup>849</sup> *Burns v Twentieth Century Fox Film Copr*, 75 F Supp 986, 992 (D Mass 1948).

<sup>850</sup> For example, if the protagonist is no more than a black and white cat, who can talk, but without closer description of the cat's appearance (e.g. pattern) and without hints to the cat's nature, this protagonist is too superficial to deserve copyright.

<sup>851</sup> For example, Terry Pratchett undertook so much care in the creation of the characters in his many books that none of them actually feel like secondary characters, such as the librarian of the Unseen University.

<sup>852</sup> *Warner Brothers Pictures, Inc v Majestic Pictures Corp*, 70 F 2d 310, 311 (2d Cir 1934); Robert E Lee, *A Copyright Guide for Authors* (1<sup>st</sup> edn, Kent Press 1995) 131.

<sup>853</sup> See para 6.2.1.5.

<sup>854</sup> Inner protection of titles is regulated by § 39 UrhG 1965. According to this provision, the holder of an exploitation right (licensee, not copyright owner) may neither alter the work nor its title nor the name of the author, unless agreed otherwise.

Titles are also copyright protected in France.<sup>855</sup> However, in the US, titles may instead be protected by trade mark law or unfair competition.<sup>856</sup> Fictional characters on the other hand can be protected by copyright.<sup>857</sup> That may include the character's name.<sup>858</sup> A character can be copyright protected without a name, but a name cannot be copyright protected without the character it denominates.

### 6.3.2. Specific legal requirements for copyright protection of LFCs

A body of case-law exists on LFC copyrightability. Among these cases is *Nichols v Universal Pictures Corporation*<sup>859</sup> which was already partly reviewed above with regard to the idea/expression dichotomy.<sup>860</sup> This case is one of the two foundations of LFC copyrightability. Hand CJ proposed 'the sufficiently delineated test' in this case to decide whether a LFC is copyrighted or not.<sup>861</sup> Another test, 'the story being told test', was developed in *Warner Bros Inc v Columbia Broadcasting System Inc.*<sup>862</sup> Both these cases and the body of cases applying or considering the above test are critically evaluated in the following.

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Outer protection against use of titles by non-licensees, i.e. e.g. competitors, is regulated by trade mark law in Germany.

<sup>855</sup> See para 7.3.2.1.

<sup>856</sup> Robert E Lee, *A Copyright Guide for Authors* (1<sup>st</sup> edn, Kent Press 1995) 131.

<sup>857</sup> Carole E Handler, 'Fictional characters in new media' (*Lathrop & Gage LLP*, 9 July 2010) 1 <<http://www.lexology.com/library/detail.aspx?g=bbc1a509-f972-4ec6-8ea1-b4c98eaaeb8f>> accessed 10 January 2013; Robert E Lee, *A Copyright Guide for Authors* (1<sup>st</sup> edn, Kent Press 1995) 131.

<sup>858</sup> *Edgar Rice Burroughs, Inc v Manns Theatres*, 195 USPQ 159 [4] (CD Cal 1976) (Tarz & Jane & Boy & Cheeta); International Bureau, 'Character Merchandising' (WO/INF/108, 1994) Annex I, 2 <[http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo\\_inf\\_108.pdf](http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo_inf_108.pdf)> accessed 20 September 2012.

<sup>859</sup> *Nichols v Universal Pictures Corp*, 45 F 2d 119 (2d Cir 1930).

<sup>860</sup> See paras 6.3.1.4.1., 6.3.1.4.4. – 6.3.1.4.6.

<sup>861</sup> See para 6.3.2.1.1.

<sup>862</sup> *Warner Bros Pictures, Inc v Columbia Broadcasting System, Inc*, 216 F 2d 945, 950 (9<sup>th</sup> Cir 1954), cert denied 348 U S 971 (S Ct 1955). See para 6.3.2.2.1.

### 6.3.2.1. The delineated test

#### 6.3.2.1.1. The test

The first US case that accepted copyrightability of a LFC was *Nichols v Universal Pictures Corporation*.<sup>863</sup> Hand CJ formulated the delineated test in this judgment to distinguish idea from expression. According to this test, a fictional character is protectable by copyright when it is not ‘too indistinct[ly]’, that means when the character has been developed sufficiently.<sup>864</sup> Where a character has not been sufficiently fleshed out, it shall be regarded as a mere idea. Consequently, it cannot exist outside the plot proper and is not copyrightable.<sup>865</sup> Judge Hand provided two examples of LFCs from Shakespeare’s play ‘Twelfth Night’ aka ‘What you will’, which were merely at the idea stage: Malvolio, a conceited steward who became enamoured with his mistress, and Sir Toby Belch, a cunning and humorous free-loading relative and drunkard of aristocratic descent.<sup>866</sup>

Consequently, the less elaborately a character is presented, the less likely it will attract copyright protection. This is the risk or penalty an author, whose characters are rather indistinct, must bear.<sup>867</sup>

When establishing copyright infringement under the delineation test, the court has to determine first whether the character is sufficiently developed to attract copyright. The

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<sup>863</sup> *Nichols v Universal Pictures Corp*, 45 F 2d 119, 121 et seq (2d Cir 1930). Although the court accepted that LFCs can be copyrightable, and even developed a test in order to distinguish between copyrightable and non-copyrightable LFCs, the court found that no copyright infringement had taken place in the LFCs from the plaintiff’s play ‘Abie’s Irish Rose’.

<sup>864</sup> *Ibid*; *Silverman v CBS Inc*, 632 F Supp 1344, 1354 (SDNY 1986); *Warner Bros Entertainment, Inc v X One X Productions and AVELA*, 644 F 3d 584, 597 (8<sup>th</sup> Cir 2011); Jasmina Zecevic, ‘Distinctly Delineated Fictional Characters That Constitute The Story Being Told: Who Are They And Do They Deserve Independent Copyright Protection?’ (2006) 8 *Vanderbilt J of Entertainment and Tech Law* 365, 370 et seq; Gregory S Schienke, ‘The Spawn of Learned Hand – A Reexamination of Copyright Protection and Fictional Characters: How Distinctly Delineated Must the Story Be Told?’ (2005) 9 *Marq Intell Prop L Rev* 63, 68 et seq; Robert E Lee, *A Copyright Guide for Authors* (1<sup>st</sup> edn, Kent Press 1995) 134.

<sup>865</sup> Tamara Bukatz, ‘Amazon’s fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part I’ (2013) 18 (4) *Communications Law* 122, 124.

<sup>866</sup> *Nichols v Universal Pictures Corp*, 45 F 2d 119, 121 (2d Cir 1930); Carole E Handler, ‘Fictional characters in new media’ (*Lathrop & Gage LLP*, 9 July 2010) 2 <<http://www.lexology.com/library/detail.aspx?g=bbc1a509-f972-4ec6-8ea1-b4c98eaaeb8f>> accessed 10 January 2013.

<sup>867</sup> *Nichols v Universal Pictures Corp*, 45 F 2d 119, 121 (2d Cir 1930); Rebecca Brackley, ‘Fictional characters and their legal homes’ (1999) 16 *CIPR* 127, 129; Carole E Handler, ‘Fictional characters in new media’ (*Lathrop & Gage LLP*, 9 July 2010) 2 <<http://www.lexology.com/library/detail.aspx?g=bbc1a509-f972-4ec6-8ea1-b4c98eaaeb8f>> accessed 10 January 2013.

level of delineation is determined by examining the character's physical, mental and emotional characteristics. After determining whether the character is copyrighted, the court has to examine whether these attributes were copied specifically or whether the alleged infringer had created a character that was merely based on an abstract, wider outline of the allegedly infringed character.<sup>868</sup>

### 6.3.2.1.2. Components

Well developed characters are copyrightable. A LFC consists of its physical appearance, attire, personality, name, mannerisms, pattern of speech, background, attitudes. If a character lacks one or more of its three main components (appearance, personality, and interaction with others = actions and reactions), it may not be copyrightable.<sup>869</sup> It is submitted that the third component is already part of the second component. The interaction of a LFC with others shows its actions and reactions. These are determined by the LFC's personality. Hence, Howell's view should be slightly altered. If a LFC consists either only of its appearance, but gives no clue as to its personality, or if a LFC's inner workings are very well developed, but its physical appearance is omitted, the LFC is incomplete.<sup>870</sup> However, it is also submitted that some characters have such distinct attributes that the public would be able to recognize

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<sup>868</sup> *Silverman v CBS*, 870 F 2d 40, 50 (2d Cir 1989), cert denied 109 S Ct 3219 (1989); *Smith v Weinstein*, 578 F Supp 1297, 1302 (SDNY 1984); Jasmina Zecevic, 'Distinctly Delineated Fictional Characters That Constitute The Story Being Told: Who Are They And Do They Deserve Independent Copyright Protection?' (2006) 8 Vanderbilt J of Entertainment and Tech Law 365, 371; Mathew A Kaplan, 'Rosencrantz and Guildenstern are dead, but are they copyrightable?: Protection of literary characters with respect to secondary works' (1999) 30 Rutgers LJ 817, 823; Leslie A Kurtz, 'The scope of copyright protection in the United States' (1995) 6 Ent L R 88, 90.

<sup>869</sup> Dorothy J Howell, *Intellectual Properties and the Protection of Fictional Characters* (Quorum Books 1990) 184 et seqq.

<sup>870</sup> Cases in which the character's appearance as well as personality had to be reproduced: *Allen v Scholastic*, 739 F Supp 2d 642, 660 et seq (SDNY 2011); *DeCarlo v Archie Comics Pub*, 11 Fed Appx 26, 28 (2d Cir 2001) (Mutt and Jeff); *Walt Disney Prod v Filmation Associates*, 628 F Supp 871, 877 (C D Cal 1986) (Pinocchio); *Zambito v Paramount*, 613 F Supp 1107, 1111 (ED NY 1985) (Zeke Banarro and ensemble v Indiana Jones and ensemble); *United Artists Corp v Ford Motor Co*, 483 F Supp 89, 91 (SDNY 1980) (Pink Panther); *Sid & Marty Krofft v McDonald's Corp*, 562 F 2d 1157, 1169 (9<sup>th</sup> Cir 1977) (Pufnstuf); *Detective Comics, Inc v Bruns Publications, Inc*, 111 F 2d 432 (2d Cir 1940) (Superman).

Cases in which the reproduction of the character's appearance was sufficient: *United Features Syndicate v Sunrise Mold Co*, 569 F Supp 1475, 1480 (S D Fla 1983) (Peanuts); *Ideal Toy Corp v Kenner Products*, 443 F Supp 291, 302 (SDNY 1977) (Darth Vader, C-3PO, R2-D2); *Fleischer Studios, Inc v Ralph A Freundlich, Inc*, 73 F 2d 276, 278 (2d Cir 1934) (Betty Boop); Nathan Newbury III, 'Protection of Comic Strips' (1955) 8 Copyright L Symposium 37, 58.

the LFC by these distinct characteristics alone – be it only physical or only personality attributes.<sup>871</sup>

### 6.3.2.1.3. Criticism of the delineated test

The sufficiently delineated test has been criticised by Kurtz as too vague.<sup>872</sup> Schienke agreed when he claimed that ‘what makes a fictional character worthy of protection seems to require Justice Stewart’s “I know it when I see it” test’, which he applied when ‘faced with the task of trying to define what may be indefinable.’<sup>873</sup> Although Schienke’s view is understandable, it is too harsh. It is submitted that Hand CJ concretised the guidelines as far as possible. There can be no absolute assurance as to which LFC will attract copyright and which not, just like there is no absolute certainty whether a judge will find that there are too many similarities between two works and that infringement has taken place.<sup>874</sup> Protecting LFCs by copyright is not so different from protecting whole works by copyright. The difference is that a LFC (more or less necessarily) consists of categorised elements that form the character (physical

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<sup>871</sup> It is submitted that the public would be able to recognize e.g. the following attributes as the appearance and other external elements of the LFC ‘Sherlock Holmes’: British, London based, penchant for his tweed deerstalker hat and cape, often found smoking a pipe, or playing a violin.

The public would also be able to recognize the following characteristics as the personality attributes of ‘Sherlock Holmes’: Amazing powers of deduction, foible for disguises, weakness towards morphine and cocaine, feels superior to other humans, willing to make sacrifices to catch his archenemy ‘Moriarty’.

Other than ‘Sherlock’, the public would e.g. also be able to recognize the following description as that of ‘James Bond’: Penchant for martinis shaken, not stirred, expensive fast cars, vintage wines and pretty women, cold blooded marksmanship based on a licence to kill, preferred weapon is a gun, overt sexuality. Description from *Metro-Goldwyn-Mayer, Inc v American Honda Motor Co, Inc*, 900 F Supp 1287, 1296 (CD Cal 1995).

<sup>872</sup> Leslie A Kurtz, ‘The Independent Legal Lives of Fictional Characters (1986) Wis L Rev 429, 457 et seqq; Jasmina Zecevic, ‘Distinctly Delineated Fictional Characters That Constitute The Story Being Told: Who Are They And Do They Deserve Independent Copyright Protection?’ (2006) 8 Vanderbilt J of Entertainment and Tech Law 365, 372.

<sup>873</sup> Schienke is referring to *Jacobellis v Ohio*, 378 US 184, 197 (S Ct 1964); Gregory S Schienke, ‘The Spawn of Learned Hand – A Reexamination of Copyright Protection and Fictional Characters: How Distinctly Delineated Must the Story Be Told?’ (2005) 9 Marq Intell Prop L Rev 63, 80; Schwabach agrees with Stewart J. Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 28.

<sup>874</sup> Although McGee and Scanlan, too, think that it is hard to avoid some imprecision and uncertainty, they are also in favour of the delineated test. They write that ‘English courts should be jealous of granting copyright protection to the literary features of a fictional character based on the adoption of the character delineation test’. Andrew McGee and Gary Scanlan, ‘Copyright in character, intellectual property rights and the internet: Part 1’ (2005) 16 Ent LR 209, 211.

appearance, attire, personality, name, mannerisms, pattern of speech, background, attitudes). These help determine a LFC's copyrightability.

It is conceded that Werker J's decision in *Burroughs v Metro-Goldwyn-Mayer* is careless. He declared 'Tarzan' as distinctly delineated, but described him as follows: 'Tarzan is the ape-man. He is athletic, innocent, youthful, gentle and strong. He is Tarzan.'<sup>875</sup> A lot of this general description applies to Rudyard Kipling's 'Mowgli' equally.<sup>876</sup> Even so, no observant reader would mistake 'Tarzan' for 'Mowgli'.<sup>877</sup> One should not condemn Hand CJ's delineated test, just because another judge did a debatable job applying it. Hand CJ's test is sufficiently specific. The 'Tarzan' judgment by Werker J simply lacks the judge's endeavour to determine the character in more detail, highlighting its uniqueness.

An argument made by Zecevic against the delineated test is that the delineated test does not protect the most developed LFCs, but rather flatter characters.<sup>878</sup> 'Flat' characters have no profile. They are not construed in detail, have not much personality and are overall not very creative. However, one should distinguish between 'flat' characters, which are basically featureless, and 'flatter' characters, which are just not as well developed as another character. Even if character B is not as well developed as character A, character B is not automatically unworthy of copyright protection. It can still be a well developed character itself and attract copyright. Contrary to Zecevic's intention, this view is confirmed if one looks at the examples that Zecevic provides. Zecevic names 'Raskolnikov' from the novel *Crime and Punishment* as a highly developed character, and 'Sherlock Holmes' as a flatter character. It is submitted that 'Sherlock Holmes' is a well developed LFC as every reader of Conan Doyle's novels would attest. That was the view, too, of the 7<sup>th</sup> Circuit in *Leslie Klinger v Conan Doyle*

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<sup>875</sup> *Burroughs v Metro-Goldwyn-Mayer, Inc.*, 519 F Supp 388, 391 (SDNY 1981); Ute Klement, 'Copyright protection of unauthorised sequels under the Copyright, Designs and Patents Act 1988' (2007) 18 Ent LR 13, 16.

<sup>876</sup> Jasmina Zecevic, 'Distinctly delineated fictional characters that constitute the story being told: Who are they and do they deserve independent protection?' (2006) 8 Vanderbilt J of Entertainment and Tech Law 365, 373.

<sup>877</sup> Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 27.

<sup>878</sup> Jasmina Zecevic, 'Distinctly delineated fictional characters that constitute the story being told: Who are they and do they deserve independent protection?' (2006) 8 Vanderbilt J of Entertainment and Tech Law 365, 375; Leslie A Kurtz, 'The rocky road to character protection' (1990) 1 Ent L R 62, 65.

*Estate*.<sup>879</sup> Moreover, the characters that were granted copyright protection under the delineated test were well developed characters, not ‘flat’ characters. These were, for example, ‘Godzilla’,<sup>880</sup> the Wrestling character ‘Diesel’,<sup>881</sup> ‘Freddy Krueger’,<sup>882</sup> and ‘Holden Caulfield’.<sup>883</sup> ‘Tin Man’, ‘Dorothy’, ‘Scarecrow’ and the ‘Cowardly Lion’ from *The Wizard of Oz* as well as ‘Rhett Butler’ and ‘Scarlett O’Hara’ from *Gone with the Wind* ‘are sufficiently distinctive to merit character protection under the respective film copyrights’, too.<sup>884</sup>

Zecevic claims further that it is very doubtful whether a reader would recognize the LFC ‘Raskolnikov’ in other works, although she believes it to be a very well developed character.<sup>885</sup> Her viewpoint is questionable. Firstly, it is only her belief that ‘Raskolnikov’ is a complex, well developed character. It is not certain whether that is so in the eyes of the law. No US court has confirmed this. Secondly, Zecevic could not provide any cases as evidence that ‘Raskolnikov’ would not attract copyright, if Dostojewski’s heirs had ever brought a claim for copyright infringement regarding the LFC ‘Raskolnikov’. Now *Crime and Punishment*, and, with it, its LFCs, are in the public domain anyway. These were already in the public domain at the time Zecevic wrote her article. Thirdly, it is not necessary for a character to be recognizable by readers in order to be copyright protected under US courts, unlike Canadian courts.<sup>886</sup>

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<sup>879</sup> *Leslie Klinger v Conan Doyle Estate*, 755 F 3d 496, 502 (7<sup>th</sup> Cir 2014), cert denied 135 S Ct 458 (2014). CJ Posner stated that ‘Holmes’ and ‘Watson’ were distinctive copyrightable characters, but that the copyright had expired. Kristofer Erickson, Martin Kretschmer, Dinusha Mendis et al, ‘Copyright and the Value of the Public Domain’ (CREATe Working Paper 2015/01) 23 <<https://zenodo.org/record/14975/files/CREATE-Working-Paper-2015-01.pdf>> accessed 20 February 2015.

<sup>880</sup> *Toho Co v William Morrow, Inc*, 33 F Supp 2d 1206, 1216 (C D Cal 1998) (Godzilla).

<sup>881</sup> *Titan Sports, Inc v Turner Broadcasting Systems, Inc*, 981 F Supp 65, 68 (D Conn 1997).

<sup>882</sup> *New Line Cinema Corp v Bertelsman Music Group*, 693 F Supp 1517 [2] (EDNY 1988).

<sup>883</sup> *Salinger v Colting*, 641 F Supp 2d 250, 253 (SDNY 2009).

<sup>884</sup> *Warner Bros Entertainment, Inc v X One X Productions and AVELA*, 644 F 3d 584, 597 and 602 (8<sup>th</sup> Cir 2011).

<sup>885</sup> Jasmina Zecevic, ‘Distinctly delineated fictional characters that constitute the story being told: Who are they and do they deserve independent protection?’ (2006) 8 *Vanderbilt J of Entertainment and Tech Law* 365, 375 et seq.

<sup>886</sup> See para 6.2.2.

### 6.3.2.2. The story being told test

#### 6.3.2.2.1. The test

Another test was articulated in *Warner Bros Inc v Columbia Broadcasting System Inc*.<sup>887</sup> Unlike *Nichols*, this is not a case where an author claims copyright infringement of his work. Instead, the author of a work and creator of a LFC defends his right to use and license the use of the LFC including the LFC's name in association with the character. This case concerned Dashiell Hammett, the author of *The Maltese Falcon*. Hammett had assigned the film, radio and TV rights in *The Maltese Falcon* to Warner Brothers. After the assignment, Hammett continued to use the protagonist from said work, 'Sam Spade'. Hammett had written and published three more 'Sam Spade' mysteries in the nearly three years following said assignment. Another fourteen years later, Hammett granted the sole and exclusive right of use of the LFC 'Sam Spade' for radio, film and television to Columbia Broadcasting System. Subsequently, the radio show *The Adventures of Sam Spade* was produced and broadcast. Warner Brothers sued Dashiell Hammett and Columbia Broadcasting for copyright infringement, but the claim was denied by the District Court for the Southern District of California.<sup>888</sup> The United States Court of Appeals Ninth Circuit held on appeal that the author Hammett retained his right to use the LFC 'Sam Spade', even though the copyright in the work *The Maltese Falcon* had been assigned to Warner.<sup>889</sup> This way, Hammett retained the series or sequel rights. That means, he could use the LFCs in new environments and stories yet unpublished. He was also entitled to license the use in the LFCs from his creations to third parties.<sup>890</sup> Circuit Judge Stephens stated that if Congress had intended for authors to lose their rights to write sequels to their works and, naturally, use their characters therein after selling the publishing right in the underlying work, Congress would have regulated this expressly. Since the USC neither provides explicitly for sequels nor characters, one may assume that authors retain their right in their characters according to Stephens CJ.<sup>891</sup>

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<sup>887</sup> *Warner Bros Pictures, Inc v Columbia Broadcasting System, Inc*, 216 F 2d 945, 950 (9<sup>th</sup> Cir 1954), cert denied 348 U S 971 (S Ct 1955).

<sup>888</sup> *Warner Bros Pictures, Inc v CBS*, 102 F Supp 141 (DC Cal 1951).

<sup>889</sup> *Warner Bros Pictures, Inc v Columbia Broadcasting System, Inc*, 216 F 2d 945, 949 et seq (9<sup>th</sup> Cir 1954).

<sup>890</sup> *Ibid* 950.

<sup>891</sup> *Ibid*; Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 29; Mathew A Kaplan, 'Rosencrantz and Guildenstern are dead, but are they



Stephens CJ also formulated the so-called story being told test. He stated that: ‘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 afforded by the copyright.’ He maintained with regard to the LFC ‘Sam Spade’ that ‘The characters were vehicles for the story told, and the vehicles did not go with the sale of the story.’<sup>892</sup>

#### 6.3.2.2. Criticism of the story being told test

This test allows for copyrightability of fictional characters only under very limited circumstances. It is more stringent than the sufficiently delineated test.<sup>893</sup> The story being told test was criticised by De Biswas even as envisaging a “story” devoid of any plot, wherein a character study constitutes all, or substantially all of the work.’ De Biswas remarked that this would rarely be the case and that this test would virtually exclude characters from copyright protection.<sup>894</sup> Others agree.<sup>895</sup>

However, it should be borne in mind that a character copyrightability test cannot be too lenient. The pool of characters would be exhausted quickly, if an author could obtain character copyright for her creations easily. This would be an impediment to the creation of new works by authors in general. Authors would have to obtain a myriad of licences in order to write new works, once all potential combinations of character elements, and thus characters, were exhausted. On the other hand, a character copyrightability test should not be too strict either, so as not to bar characters and their authors from protection, leaving them vulnerable to free riders. It is submitted that the story being told test is not as restrictive as De Biswas and Kaplan believe it to be. It

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copyrightable?: Protection of literary characters with respect to secondary works’ (1999) 30 Rutgers LJ 817, 825 et seq.

<sup>892</sup> *Warner Bros Pictures, Inc v Columbia Broadcasting System, Inc*, 216 F 2d 945, 950 (9<sup>th</sup> Cir 1954); Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 29 et seq.

<sup>893</sup> Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 29.

<sup>894</sup> Sourav Kanti De Biswas, ‘Copyright of Characters’ (2004) 9 Journal of Intellectual Property Rights 148, 152 et seq.

<sup>895</sup> Mathew A Kaplan, ‘Rosencrantz and Guildenstern are dead, but are they copyrightable?: Protection of literary characters with respect to secondary works’ (1999) 30 Rutgers LJ 817, 826 and 828; Tabrez Ahmad and Debmita Mondal, ‘The Conflicting Interests in Copyrightability of Fictional Characters’ (SSRN, 1 May 2011) 8 <[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1839361](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1839361)> accessed 5 December 2016.

should rather be taken to mean the following: If the focus of the work is on the character and the story is consequently subordinate to the character, the character deserves copyright protection (if it is a distinct, not a stock character). If the story dominates the work and the character is subordinate to the story as a result, the character is unprotected. Williams J had the same understanding of the story being told test in *Warner Bros v Film Ventures International*. This case concerned the character ‘Regan’ from *The Exorcist*. The court found the character uncopyrightable, because the story was not subordinate to the character.<sup>896</sup>

However, if De Biswas’ and Kaplan’s understanding of the story being told test was correct, then characters would be nearly generally banned to the public domain according to that test, and a test for copyrightability of characters would be merely window dressing.

Case-law demonstrates that despite being very narrowly drawn, the story being told test has not been an absolute bar to copyrightability of fictional characters. The story being told test (like the delineated test) is applicable and, in fact, applied to any type of character. The AFC ‘Mickey Mouse’ was granted copyright protection under this test,<sup>897</sup> and so was the LFC ‘Jonathan Livingston Seagull’.<sup>898</sup> The District Court Houston, Texas held in *Universal City Studios, Inc v Kamar Industries, Inc* that there was a substantial likelihood that the plaintiffs will succeed in their claim for copyright infringement in their dramatic fictional character (DFC) ‘E.T.’ District Judge De Anda based this conclusion on the story being told test. Hence, she granted injunctive relief to the producers of the film ‘E. T.’ against the manufacturer of ‘E.T.’ mugs.<sup>899</sup>

The Court in *Anderson v Stallone*<sup>900</sup> does not seem to agree with De Biswas’ and Kaplan’s perception of the story being told test either. The court stated that the ‘Rocky’ characters ‘were so highly developed and central to the three movies ... that they “constituted the story being told.”’ The films revolved around the characters and their

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<sup>896</sup> *Warner Bros v Film Ventures International*, 403 F Supp 522, 525 (C D Cal 1975); Bayard F Berman and Joel E Boxer, ‘Copyright Infringement of Audiovisual Works and Characters’ (1978-1979) 52 S Cal L Rev 315, 326.

<sup>897</sup> *Walt Disney Productions v Air Pirates*, 581 F 2d 751, 754 et seq (9<sup>th</sup> Cir 1978); Robert Fremlin, *Entertainment Law* (1990 Clark Boardman Callaghan) 375.

<sup>898</sup> *Bach v Forever Living Products*, 473 F Supp 2d 1127, 1136 (WD Wash 2007).

<sup>899</sup> *Universal City Studios, Inc v Kamar Industries, Inc*, 217 USPQ 1162 [4] (SD Tex 1982).

<sup>900</sup> *Anderson v Stallone*, 11 USPQ 2d 1161 (C D Cal 1989).

development, not the plot.<sup>901</sup> One cannot say, though, that the films were devoid of any plot at all.

Interestingly, the District Court of California also applied the sufficiently delineated test in addition to the story being told, to be on the safe side. The court maintained that the dramatic characters from 'Rocky' are among the most highly delineated character ensembles of American cinema.<sup>902</sup> For example, 'Rocky Balboa' is highly delineated due to his speaking mannerisms, physical features, emotional attributes and development of the relationship between the characters throughout the 'Rocky' films.<sup>903</sup>

The 'Rocky' case also makes clear that more than one character can be protected under the story being told test. The 'Rocky' characters 'Adrian', 'Apollo Creed', 'Clubber Lang', 'Paulie' and 'Rocky' were all held to meet the criteria of both tests.<sup>904</sup> The test is not limited to protecting just one central figure.

### 6.3.2.3. Both tests

Some courts are uncertain which test to follow and instead make sure by applying both tests when considering whether a character is copyright protected. Sometimes, both tests fail. That was the case, for example, concerning the LFCs/DFCs from the screenplay for the TV series *Cargo*<sup>905</sup> and the magician character from the home video and script for a TV programme based thereupon called *The Mystery Magician*.<sup>906</sup>

On other occasions, a character is found copyrightable under both tests. That was so, for example, regarding 'James Bond' in *Metro-Goldwyn-Mayer, Inc v American Honda*

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<sup>901</sup> Ibid [8]; Robert Fremlin, *Entertainment Law* (1990 Clark Boardman Callaghan) 378.

<sup>902</sup> Ibid [7].

<sup>903</sup> Ibid; Carole E Handler, 'Fictional characters in new media' (*Lathrop & Gage LLP*, 9 July 2010) 2 and 6 <<http://www.lexology.com/library/detail.aspx?g=bbc1a509-f972-4ec6-8ea1-b4c98eaaeb8f>> accessed 10 January 2013.

<sup>904</sup> *Anderson v Stallone*, 11 USPQ 2d 1161 [7] (C D Cal 1989); Robert Fremlin, *Entertainment Law* (1990 Clark Boardman Callaghan) 377 et seq.

<sup>905</sup> *Olson v National Broadcasting Co*, 855 F 2d 1446, 1451 et seq (9<sup>th</sup> Cir 1988); Robert Fremlin, *Entertainment Law* (1990 Clark Boardman Callaghan) 376.

<sup>906</sup> *Rice v Fox Broadcasting Company*, 330 F 3d 1170 (9<sup>th</sup> Cir 2003).

*Motor Co, Inc.*<sup>907</sup> MGM sued Honda for a commercial, which featured a character that was allegedly very much like ‘James Bond’.<sup>908</sup> The District Court of California noted that the characteristics of ‘James Bond’ had been developed over the course of more than 16 films in three decades by the time this case came to court. Furthermore, it argued that the fact that different actors can play the fictional character ‘James Bond’ is proof that ‘Bond’ is a unique fictional character, whose distinct attributes are constant regardless of the changes in actors. The court also remarks that the audience watches ‘James Bond’ films, because they want to see their hero at work. The audience would not flock to the cinema so religiously, if the same film had a differently named character in it. ‘A James Bond film without James Bond is not a James Bond film.’<sup>909</sup> Schwabach maintains that the ‘James Bond’ decision is questionable, because the ‘Honda man’ did not share many physical characteristics with ‘James Bond’ apart from being a male Caucasian of fair looks.<sup>910</sup> This should have given Schwabach the cue that the personality attributes define ‘James Bond’ much more than his appearance. It had already been rightly pointed out by Kenyon J that the fact that different actors could represent ‘Bond’ over the years without the character losing its appeal on the audience was evidence that ‘Bond’ is a unique character. ‘James Bond’s internal attributes are firmly rooted in the reader’s and viewer’s mind. These characteristics, such as his self esteem and self-assertiveness, manifest themselves in his physical appearance, such as his posture, the way he holds himself and interacts with others, including his attraction to other (fictional) women. It had also been the intention of the producer of the Honda commercial to invoke the image of ‘James Bond’. Not only was the character in the commercial named ‘James Bob’, also ‘James Bond’-type actors and actresses were cast according to the casting director’s wishes.<sup>911</sup>

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<sup>907</sup> *Metro-Goldwyn-Mayer, Inc v American Honda Motor Co, Inc*, 900 F Supp 1287, 1296 (CD Cal 1995); Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 37.

<sup>908</sup> This character is also referred to as the ‘Honda man’ here.

<sup>909</sup> *Metro-Goldwyn-Mayer, Inc v American Honda Motor Co, Inc*, 900 F Supp 1287, 1296 and 1303 (CD Cal 1995).

<sup>910</sup> Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 38.

<sup>911</sup> *Metro-Goldwyn-Mayer, Inc v American Honda Motor Co, Inc*, 900 F Supp 1287, 1297 (CD Cal 1995).

#### 6.3.2.4. Scènes à faire

On the one hand, the line between copyrightable and non-copyrightable characters may be difficult to draw, but on the other hand the *scènes à faire* exception is another factor that brings more clarity to the copyrightability of fictional characters. Even sufficiently delineated characters and characters that amount to the story being told may be denied copyright, if the *scènes à faire* exception applies. This exception refers to, as its name says, characters, settings, incidents and such which are quite standard or even indispensable in the contemplation of a subject.<sup>912</sup> These stock scenes or stock characters do not serve the distinction between works. Therefore, these elements are uncopyrightable.<sup>913</sup> For example, inebriates and sex workers soliciting clients would be *scènes à faire* in a creative work about a policeman operating in the South Bronx.<sup>914</sup>

#### 6.3.3. Duration of protection for LFCs

The Copyright Act 1976 set the copyright term at 50 years after the author's death.<sup>915</sup> The Sonny Bono Copyright Term Extension Act (Pub L No 105-278, 112 Stat 2827 codified as 17 USC § 302(a) 1998) extended the duration of copyright protection by 20 years for works created on or after 1 January 1978.<sup>916</sup> As a result, the copyright in

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<sup>912</sup> *Gaiman v McFarlane*, 360 F 3d 644, 659 (7<sup>th</sup> Cir 2004); *Alexander v Haley*, 460 F Supp 40, 45 (SDNY 1978); Roberta Mongillo, 'The idea-expression dichotomy in the US and EU' (2016) 38 EIPR 733, 735; Leslie A Kurtz, 'The scope of copyright protection in the United States' (1995) 6 Ent L R 88; Kenneth Spahn, 'The Legal Protection of Fictional Characters' (1992) 9 University of Miami Entertainment & Sports Law Review 331, 334.

<sup>913</sup> *Gaiman v McFarlane*, 360 F 3d 644, 659 (7<sup>th</sup> Cir 2004); *Hogan and Masucci v DC Comics et al*, 48 F Supp 2d 298, 310 (SDNY 1999); *Sinicola v Warner Bros*, 948 F Supp 1176, 1185 (EDNY 1996); *Little et al v Twentieth Century Fox Film Corporation*, 1995 WL 404939 [4] (SDNY 1995); *Robinson v Viacom International, Inc*, 1995 WL 417076 [9] (SDNY 1995); *CK Co v Burger King Corp*, 1994 WL 533253 [9] (SDNY 1994); Kenneth Spahn, 'The Legal Protection of Fictional Characters' (1992) 9 University of Miami Entertainment & Sports Law Review 331, 333 et seq.

<sup>914</sup> *Williams v Crichton*, 84 F 3d 581, 588 (2<sup>nd</sup> Cir 1996); *Walker v Time Life Films, Inc*, 784 F 2d 44, 50 (2<sup>nd</sup> Cir 1986).

Other examples are an alcoholic suburban housewife, a talking cat, a Prussian officer wearing a monocle clicking his heels together, a gesticulating Frenchman or dragon which can breathe fire. *Warner Bros Entertainment, Inc v X One X Productions and AVELA*, 644 F 3d 584, 601 (8<sup>th</sup> Cir 2011); *Gaiman v McFarlane*, 360 F 3d 644, 660 (7<sup>th</sup> Cir 2004).

<sup>915</sup> Leslie A Kurtz, 'The effect of international developments of US copyright law' (1995) 6 Ent L R 322, 323.

<sup>916</sup> Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 21 et seq; Matthew A Kaplan, 'Rosencrantz and Guildenstern are dead, but are they copyrightable?: Protection of literary characters with respect to secondary works' (1998-1999) 30 Rutgers L J 817, 818 and 838.

different works of the same author can expire at different times depending on whether the work was written before or after 1 January 1978. The determination of the copyright term in the US is quite complex. Apart from the above different terms, there are a few more varying terms depending on the year of creation or publication.<sup>917</sup>

With the underlying work, copyright would cease to exist in the LFC as well. However, it has been suggested that, if a character is made use of in another work or even medium (an adaptation of the underlying work), e.g. a radio play, and the character shows new character attributes, then the character's new attributes may be copyright protected while the LFC's character attributes, as they appear in the underlying work, fall in the public domain.<sup>918</sup> This has also been suggested with regard to LFCs appearing in a series of works, of which the earlier works are in the public domain while the later works are still in copyright. The defendants in *Leslie Klinger v Conan Doyle Estate* suggested that the LFCs 'Sherlock' and 'Watson' had been unfinished in the earlier literary works by Sir Arthur Conan Doyle<sup>919</sup> and that the LFCs underwent a character development throughout the series. The changed 'Sherlock' and 'Watson' in the later works should remain under copyright and did not enter into the public domain with the earlier works.<sup>920</sup> This did not find favour with the 7<sup>th</sup> Circuit in 2014. CJ Posner claimed that this shrank the public domain and would diminish the incentive for other authors to create derivative works. The longer copyright lasts, the less raw material is in the public domain from which authors can make use of freely for the creation of new

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<sup>917</sup> For a more comprehensive list, see Peter B Hirtle, 'Copyright term and the Public Domain in the United States 1 January 2016' (*Cornell*, 3 January 2016) <<http://copyright.cornell.edu/resources/publicdomain.cfm>> accessed 13 December 2016.

Many factors determine the duration of copyright in the US. The copyright term depends on whether the work was first published in the US or a foreign country, whether it is a work of an author or a work of corporate authorship, whether or not the work was published or unpublished, whether or not the work was published by an anonymous author, and whether the work was published with or without copyright notice and whether or not it was renewed.

<sup>918</sup> *Silverman v CBS*, 870 F 2d 40, 50 (2d Cir 1989) (suggested, but not accepted); Eric J Schwartz and David Nimmer, 'United States' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, §2[4][b] (Pub 399, Rel 28-12/2016); Sourav Kanti De Biswas, 'Copyright of Characters' (2004) 9 *Journal of Intellectual Property Rights* 148, 153; Rebecca Brackley, 'Fictional characters and their legal homes' (1999) 16 *CIPR* 127, 132; Kenneth Spahn, 'The Legal Protection of Fictional Characters' (1992) 9 *University of Miami Entertainment & Sports Law Review* 331, 337 et seq; Tabrez Ahmad and Debmita Mondal, 'The Conflicting Interests in Copyrightability of Fictional Characters' 11 (*SSRN*, 1 May 2011) <[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1839361](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1839361)> accessed 5 December 2016.

<sup>919</sup> Sir Arthur Conan Doyle was born 22 May 1859 and died 7 July 1930.

<sup>920</sup> *Leslie Klinger v Conan Doyle Estate*, 755 F 3d 496, 500 (7<sup>th</sup> Cir 2014). The court in *Silverman v CBS Inc*, 632 F Supp 1344, 1355 (SDNY 1986) (Amos and Andy) was of the same opinion (but involved a change of medium), which contrasts with *Klinger v Conan Doyle Estate*.

works. Authors wanting to use a copyrighted LFC would have to acquire licences before creating works identical to or very similar to that author's LFC.<sup>921</sup> This would only be so, if the later author had copied the earlier author's LFC purposefully or subconsciously having read the earlier author's work. If both parties' LFCs are identical, access to the earlier author's work and copying of the LFC is assumed.

The above manoeuvre as described in *Klinger v Conan Doyle Estate* had already been rejected by Newman CJ in *Burroughs v Metro-Goldwyn-Mayer, Inc.*<sup>922</sup> It has also been criticised as artificially prolonging copyright.<sup>923</sup> An author would be incentivised to continue writing stories with the same characters, just to extend the copyright period for the LFC,<sup>924</sup> instead of encouraging the author to come up with new characters. Posner CJ of the 7<sup>th</sup> Circuit agreed in *Klinger* that this would discourage creativity.<sup>925</sup>

Newman CJ also stated that a character is only original in the first work of a series. Though the subsequent works of a series employing the same character are original, the character itself is exempt from that.<sup>926</sup>

These views are somewhat flawed. For one thing, surely, the work in which the LFC appears already requires and provides a new creative work. For another thing, should an author be given an incentive to discontinue a popular book series? If a series of books by an author with the same LFC keeps being written and published over a long period of time, it means that the series is very successful and has many fans. An author should not be punished for continuing a popular series with popular LFCs. If the LFCs of a series enter the public domain when the earliest work of the series does, then this author is disadvantaged vis-à-vis an author who creates an entirely new well developed character for every work. Imagine, author A writes a book with LFC X annually for ten

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<sup>921</sup> *Leslie Klinger v Conan Doyle Estate*, 755 F 3d 496, 501 (7<sup>th</sup> Cir 2014).

<sup>922</sup> *Burroughs v Metro-Goldwyn-Mayer, Inc*, 683 F 2d 610, 631 (2d Cir 1982).

<sup>923</sup> *Harvey Cartoons v Columbia Pictures Industries, Inc*, 645 F Supp 1564, 1570 (SDNY 1986) (concerning cartoon ghost Fasto from the 'Casper' comics); Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 52 et seq.

<sup>924</sup> Roberta Pearson, 'The Disputed Public Domain Status of Sherlock Holmes' in Erickson and Kretschmer (eds), *Research Perspectives on the Public Domain: Digital Conference Proceedings* (1 Feb 2014) CREATE Working Paper Series 2014/3, 26, 30 <[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2739847](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2739847)> accessed 7 Jan 2017.

<sup>925</sup> *Leslie Klinger v Conan Doyle Estate*, 755 F 3d 496, 501 (7<sup>th</sup> Cir 2014).

<sup>926</sup> *Burroughs v Metro-Goldwyn-Mayer, Inc*, 683 F 2d 610, 631 (2d Cir 1982).

years starting in 1964. The copyright of the first work and the LFC of all works expires in 2059.<sup>927</sup> The copyright of the second work published with copyright notice in 1965 expires in 2060 except for the copyright in the LFC, which already expires in 2059 when the copyright of the first work expires.<sup>928</sup> Author B has published a book every year for ten years, each time with a new character, starting in 1964. The copyright of the first work and the LFC therein expires in 2059, the second novel and LFC in 2060 and so forth. Copyright in the tenth and last work with its distinct LFCs expires in 2069.

However, one may also argue that author B who made the effort to create a new LFC for each novel has been rewarded, but in comparison author A who has created a LFC that has found its way into the hearts of many readers, allowing author A to continue using this LFC, has been at the same time punished by law.

Newman CJ's reasoning in *Burroughs v Metro-Goldwyn-Mayer, Inc* against artificially prolonging LFC copyrightability by creating new derivative works is not applicable to further literary works by the same author of the LFCs. The following scenario illustrates why Newman CJ's approach to derivative works would not fit the bill where literary works of one and the same author are concerned.

Author A has written and published three works before 1 January 1978. These works and the LFCs therein enjoy copyright for 50 years after the author's death. Author A published two more works after 1 January 1978. These enjoy copyright for 70 years after the author's death. The same LFCs are used for all five works. If one followed Newman CJ's reasoning, then the copyright in the LFCs of all five works should expire after the first work enters the public domain 50 years after the author's death. Bizarrely, then the two works published after 1 January 1978 would be copyrightable for another twenty years, except for the LFCs therein that would already be out of copyright.

Moreover, the negative effects of permitting copyright to a distinct LFC in its changed form while giving the LFC in its first form from earlier works over to the public domain would not be as dramatic as CJ Posner imagines in *Leslie Klinger v Conan Doyle*

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<sup>927</sup> Copyright term: 95 years after publication date for works registered or first published in the US. Peter B Hirtle, 'Copyright term and the Public Domain in the United States 1 January 2016' (*Cornell*, 3 January 2016) <<http://copyright.cornell.edu/resources/publicdomain.cfm>> accessed 13 December 2016.

<sup>928</sup> That means for the tenth book in that series that copyright in the tenth book published in 1974 expires in 2069 except for the copyright in the LFCs. Copyright in the LFCs expires in 2059, i.e. ten years earlier, when the copyright in the first book in the series with the same LFCs expires.



*Estate*. This approach would allow other authors to use or create a LFC like the LFC in its earliest version, and would grant the original author copyright in the later version of the LFC. However, this copyright protection of the later version seems no more than an illusion, because other parties could easily avoid copyright protection by sticking to the earliest character version, which also established the success of the author and LFC.

Therefore, it is submitted that the copyright in a LFC should only expire with the work of an author that is longest in copyright regardless of whether or not the LFC underwent further character development or not. This would induce equality among authors' works. This procedure would not disadvantage authors whose works fall under differing copyright durations. The creation of a sub-tier for the LFCs of an author whose characters are so popular they are in series would be prevented.

This proposition should only apply to fictional characters. It should neither apply to LFCs in derivative works by assignees and licensees nor to the novels themselves.

Not all courts follow Newman CJ's reasoning with regard to derivative works either. For example, the 8<sup>th</sup> Circuit in *Warner Bros Entertainment, Inc v X One X Productions and AVELA* found that where derivative works, such as films based on a novel, have added traits to the LFC, these added character elements might be protected by copyright – even when the LFC is already out of copyright.<sup>929</sup> Protection is limited to these added elements.<sup>930</sup>

#### **6.3.4. Fanfiction and commercial fan works**

The protection of LFCs becomes relevant, for example when an author's LFC is used for commercial sequels or prequels by another unauthorized author, commercial or non-commercial parodies or fanfiction by fans of the author's original work (the canon). To this day, authors have no moral rights under US copyright law with the exception of the authors of a work of visual arts under the provision of the Visual Artists Rights Act

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<sup>929</sup> *Warner Bros Entertainment, Inc v X One X Productions and AVELA*, 644 F 3d 584, 597 (8<sup>th</sup> Cir 2011).

<sup>930</sup> *Ibid* 598 (8<sup>th</sup> Cir 2011); *Siegel v Warner Bros Entertainment, Inc, Time Warner and DC Comics*, 542 F Supp 2d 1098, 1126 (CD Cal 2008).

1990.<sup>931</sup> Hence, an author will have to protect herself as best as possible via the economic rights. The author of a work has not only the exclusive right of reproduction, but also the exclusive right to make derivative works based on the copyrighted work.<sup>932</sup>

Fanfiction makes use of familiar story elements, such as LFCs, from the canon and creates new stories based on the canon. Hence, a work of fanfiction might copy from the underlying work to the extent of copyright infringement and might be a copyright infringing derivative work.<sup>933</sup> However, fanfiction may also achieve legitimacy, if it is excused under the fair use doctrine as a parody or otherwise sufficiently transformative work. Moreover, fanfiction is usually not commercial, but this is only one determinative factor under the fair use doctrine. The fair use doctrine has four elements by means of which a court determines whether the defence has effect.<sup>934</sup>

In many cases where a work reproducing some elements of the underlying work is commercial, will the fair use defence fail, as was the case in *Warner Bros Entertainment Inc v RDR Books*.<sup>935</sup> RDR Books had offered Vander Ark a book deal for a 'Harry Potter' Lexicon, which described characters, creatures, objects, spells, places and such from JK Rowling's 'Harry Potter' series. Not only was the publisher commercially minded, but Vander Ark's lexicon was also only marginally transformative, because it was merely a collection of facts from Rowling's works, and

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<sup>931</sup> 17 USC § 106A Visual Artists Rights Act 1990. Authors must instead make do with a combination of state and federal law on e.g. defamation, unfair competition, contract, privacy and trade mark law. Kristin L Lingren, 'United States of America' in Gillian Davies and Kevin Garnett (eds), *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 1039 et seq.

<sup>932</sup> 17 USC §§ 106(2) and 101.

<sup>933</sup> Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 59.

<sup>934</sup> The four elements of the fair use doctrine are laid down in 17 USC § 107 and are the following:

- '(1) the purpose and character of the use, including whether such use is of a commercial nature or is 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.'

In cases where the allegedly infringing work is of low quality, more or less non-commercial, and the distribution is very limited, the fair use doctrine may be successfully invoked. An army unit had produced a film under the title *Sailor Bill*. The 'Mr Bill' character from *Saturday Night Live* was imitated in the army unit's film. The CBS broadcast the film, but only during the annual football game of the Army Navy. *Williams v Columbia Broadcasting Sys, Inc*, 57 F Supp 2d 961, 968 et seqq (C D Cal 1999); Carole E Handler, 'Fictional characters in new media' (*Lathrop & Gage LLP*, 9 July 2010) 11 <<http://www.lexology.com/library/detail.aspx?g=bbc1a509-f972-4ec6-8ea1-b4c98eaeb8f>> accessed 10 January 2013.

<sup>935</sup> *Warner Bros Entertainment Inc v RDR Books*, 575 F Supp 2d 513, 554 (SDNY 2008).

not very creative itself, but also had copied a copious amount from Rowling's expression verbatim, often even copying her colourful language.<sup>936</sup>

The fair use defence was also unsuccessful in *DC Comics Inc v Unlimited Business, Inc*, where the defendants ran a singing telegram business.<sup>937</sup> Among their repertoire were acts such as 'Super Stud' and 'Wonder Wench'. These strongly resembled 'Superman' and 'Wonderwoman'. The court considered the fair use doctrine and noted that: a) the defendants business was commercial, b) both of the plaintiff's AFCs are the result of creative effort and substantial labour, c) the defendants copied more of the plaintiff's AFCs than necessary for a parody, and d) the defendants' business had a diminishing effect on the potential market for superhero singing telegrams.

The author and publisher John David California (actual name: Frederik Colting), who wrote *60 years later: Coming Through the Rye*, was also unable to defend his unauthorized sequel to JD Salinger's *The Catcher in the Rye* on the grounds of fair use.<sup>938</sup> *60 years later* does not comment critically on the theme or any of the LFCs, in particular 'Holden Caulfield', in *The Catcher in the Rye*.<sup>939</sup> Hence, it is not a parody. The court stated that what the reader gets from *60 years later* are the same laconic observations from the main character (called Mr C) that the character had already made in *The Catcher in the Rye*. The difference is that the world has changed in the last 60 years, and Mr C has grown older, but he did not develop mentally and emotionally during all that time. Now that he is 76, he is still the same as he was at the age of 16. Instead of growing up, he only grew old.<sup>940</sup>

However, not all commercial works fail the fair use defence. The ultimate outcome turns on the application of all four fair use factors. In fact, some commercial works

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<sup>936</sup> Ibid 547.

<sup>937</sup> *DC Comics Inc v Unlimited Business, Inc*, 598 F Supp 110, 118 (N D Ga 1984); Carole E Handler, 'Fictional characters in new media' (*Lathrop & Gage LLP*, 9 July 2010) 10 <<http://www.lexology.com/library/detail.aspx?g=bbc1a509-f972-4ec6-8ea1-b4c98eaaeb8f>> accessed 10 January 2013.

<sup>938</sup> *Salinger v Colting*, 641 F Supp 2d 250, 252 (SDNY 2009).

<sup>939</sup> Ibid 258.

<sup>940</sup> Ibid.

based on another author's original copyrighted work are protected under the fair use doctrine as parodies.<sup>941</sup>

### 6.3.5. Character merchandising

Protection of fictional characters is particularly important with regard to character merchandise licensing. The revenue stream from characters and especially licensing character merchandise is often higher than the revenue that can be made from the film or novel itself.<sup>942</sup> Under US copyright law, LFCs are not only protected against copying and use in another literary work, but also against indirect reproduction as an article of merchandising by third parties.

According to 17 USC § 113(a) 'the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work *in or on any kind of article, whether useful or otherwise.*'<sup>943</sup> Character merchandise items are typically useful as well as decorative articles which either bear a pictorial reproduction of an underlying pictorial work or are a three-dimensional item which is shaped like and looks like the underlying two-dimensional pictorial work.

However, 17 USC § 113(a) only applies to pictorial, graphic, or sculptural works, but not to literary works. There is no equivalent separate section in title 17 of the USC. 17 USC seems to have some catching up to do in this regard. Fortunately, US courts have already applied and granted author's common law copyright against unauthorized character merchandise, both with regard to AFCs as well as DFCs and LFCs.<sup>944</sup> The

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<sup>941</sup> *Campbell v Acuff-Rose Music, Inc*, 510 US 569, 572 (S Ct 1994); *Berlin v EC Publications, Inc*, 329 F 2d 541, 543 et seqq (2d Cir 1964); Noel L Allen, Brenner A Allen and Nathan E Standley, 'Laws of the United States with Commentary' in Dennis Campbell (ed), *World Intellectual Property Rights and Remedies Laws with Commentary*, Vol 6, § 95:11 (R 5/2016).

'The Wind Done Gone' by Alice randall was a parody of Margaret Mitchell's 'Gone with the Wind'. *Suntrust Bank v Houghton Mifflin Co*, 268 F 3d 1257, 1276 and 1282 (11<sup>th</sup> Cir 2001); Dinusha Mendis and Martin Kretschmer, 'The Treatment of Parodies under Copyright Law in Seven Jurisdictions – A Comparative Review of Underlying Principles' (IPO, 2013/23) 40; Anupam Chander and Madhavi Sunder, 'Everyone's a Superhero: A Cultural Theory of "Mary Sue" Fan Fiction as Fair Use' (2007) 95 California Law Review 597, 614.

<sup>942</sup> Robert E Lee, *A Copyright Guide for Authors* (1<sup>st</sup> edn, Kent Press 1995) 131; Ivan Hoffman, 'The protection of fictional characters' (2003) <<http://www.ivanhoffman.com/characters.html>> accessed 8 January 2013.

<sup>943</sup> Emphasis added.

<sup>944</sup> *United Feature Syndicate, Inc v Koons* concerned the individual creation of three unauthorized 'Odie' sculptures. These were fashioned after the AFC from the comic strip 'Garfield'. The artist had been

following two rulings are particularly representative, especially because these expand on character-specific requirements.

### 6.3.5.1. *Ideal Toy Corp v Kenner Products*<sup>945</sup>

Twentieth Century Fox had entered around 20 licensing agreements with toy manufacturers, such as Kenner, for *Star Wars* products before the first *Star Wars* film had been released. Ideal Toy had declined the offered licensing deal. Due to the film's and products' popularity, Ideal Toy started manufacturing and selling space toys as well, revising old product lines in order to start selling their products quicker and thus be able to profit from the popularity of Sci-fi toys. Ideal Toy even manufactured a villain called 'Knight of Darkness', which was dressed entirely in black like 'Darth Vader'. He was sold with a space ship by the name of 'Star Hawk'. Ideal Toy's figurines were criticised as closely resembling 'Darth Vader', 'R2-D2' and 'C-3PO'. Hence, Ideal Toy sought a declaration from the District Court for the Southern District of New York that it did not infringe copyright of the producer of the *Star Wars* film or of its licensed competitor Kenner, an American toy company. Kenner filed a counterclaim against Ideal Toy for copyright infringement claiming that copyright in the dramatic work *Star Wars* extended to the LFCs portrayed therein.<sup>946</sup> The court observed that fictional characters in a film show their attributes by interacting with each other. Toys on the other hand have no personality attributes. Only the child that plays with the figurines gives attributes to the toy characters. These may differ from the film and are not the

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shown a postcard depicting 'Odie' and was told to make the Puppy in the *Wild Boy and Puppy* sculpture as close to the dog in the picture as possible. Only the relative length of 'Odie's tongue varied from the drawing on the postcard. The District Court concluded that the defendant had infringed the plaintiff's copyright in 'Odie' by making a total of three three-dimensional sculptures. *United Feature Syndicate, Inc v Koons*, 817 F Supp 370, 377, 382 (SDNY 1993); Carole E Handler, 'Fictional characters in new media' (*Lathrop & Gage LLP*, 9 July 2010) 11 <<http://www.lexology.com/library/detail.aspx?g=bbc1a509-f972-4ec6-8ea1-b4c98eaaeb8f>> accessed 10 January 2013.

In *King Features Syndicate v Fleischer*, the court ruled that the 3D reproduction of the horse 'Spark Plug' from the Barney Google comic strips as a toy infringed the comic artist's copyright, too. *King Features Syndicate v Fleischer*, 299 F 533, 538 (2d Cir 1924).

Herlands J stipulated in *Geisel v Poynter Products, Inc*, that the copyright owner of cartoons in 2D owns the right to reproduce the cartoons and characters therein as three-dimensional figures. The dolls produced after the AFCs from the Dr Seuss cartoons would have infringed copyright in this case, had these not already passed into the public domain. *Geisel v Poynter Products, Inc*, 295 F Supp 331, 351 (SDNY1968).

<sup>945</sup> *Ideal Toy Corp v Kenner Products*, 443 F Supp 291 (SDNY 1977).

<sup>946</sup> *Ibid* 293.

creation of Ideal Toy, but of the child. Consequently, only the outward appearance of the film characters and the toy figurines can be compared.<sup>947</sup> The court found that there was insufficient similarity between the DFCs/LFCs and the toys. Only the idea and theme were adopted by Ideal Toy. The court made a point that, although Ideal Toy wanted to cash in on the *Star Wars* mania, it had taken care not to copy from the film.<sup>948</sup>

Although the licensed manufacturer of character merchandise lost the case, this was only due to the particular facts of the case. The principle, that copyright can under the right circumstances protect against unauthorized character merchandising, persists.

### **6.3.5.2. *Universal Studios, Inc, et al v JAR Sales et al*<sup>949</sup>**

Five years later, *E.T. The Extraterrestrial* was very successful both as a film by Universal Studios as well as character merchandise including soft sculpture 'E.T.' dolls manufactured and sold by Kamar, a licensee of Universal's licensing agent Merchandising. The defendants JAR Sales, Berger and others had designed such a doll after viewing the film. They also had access to Kamar's 'E.T.' dolls before the film was aired at the New York Toy Fair, the New York Stationery Show, extensive promotion and Kamar showrooms located throughout the USA, including LA. The District Court of California granted an injunction in favour of the plaintiff, because there was a significant probability that the plaintiffs' claims for copyright infringement would succeed on its merits. Both the character 'E.T.' in the film of the same name and the 'E.T.' dolls by Kamar were protectable expressions of the plaintiffs' general ideas. The defendants had reproduced these by manufacturing an 'E.T.' moulded-plastic doll and 'E.T.' soft-sculpture doll.<sup>950</sup> The total concept and feel of the defendants' soft sculpture 'E.T.' doll is the same as the character 'E.T.' as it appears in the film and the copyrighted dolls by Kamar.<sup>951</sup> It was also very likely that a jury would find the defendants' character merchandising items very similar to Universal's DFC/LFC and Merchandising/Kamar's 'E.T.' dolls when applying the test of an ordinary observer.<sup>952</sup>

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<sup>947</sup> Ibid 302.

<sup>948</sup> Ibid 304 et seq.

<sup>949</sup> *Universal Studios, Inc, et al v JAR Sales et al*, 216 USPQ 679 (CD Cal 1982).

<sup>950</sup> Ibid [18] et seq.

<sup>951</sup> Ibid [12].

<sup>952</sup> Ibid [17].

The District Court of California pointed out the close similarity in appearance of the defendants' dolls to the film character 'E.T.' and the Kamar dolls as well as 'E.T.'s personality. The court went into detail on 'E.T.'s external features.<sup>953</sup> However, it sufficed that the defendants' 'E.T.' dolls were described as portraying the 'same mood of loveableness' in order to contribute to a significant likelihood of copyright infringement.<sup>954</sup> 'E.T.'s personality received less attention than the physical features, but at least the court had accepted that a character, here 'E.T.', can have personality attributes and that these can be compared. The District Court for the SDNY had rejected this viewpoint in *Ideal Toy Corp v Kenner Products*.<sup>955</sup>

It is submitted that even three-dimensional representations of a character display at least some of the character's personality attributes. These will usually be presented in a simplified, but at the same time prominent style. This makes toys especially attractive to children.

## 6.4. Conclusion

LFCs may move from one novel and story to the next, from one medium to a different medium, developing with new experiences. Both in Canada and the USA, LFCs are copyrightable independent of the stories they were born in against unauthorized character merchandising<sup>956</sup> as well as reproduction of LFCs in literary and other works by persons other than those who have been authorized to make use of the LFC.<sup>957</sup>

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<sup>953</sup> "'E.T.'s oddly-shaped head and facial features, squat torso, long thin arms, and hunched-over posture ... 'E.T.'s wrinkled skin, blue eyes, and characteristic hand gesture, *i.e.*, a finger outstretched toward the sky. The doll has a red spot on its chest, imitating "E.T.'s "heart light" which is a distinctive physical characteristic of "E.T."'. *Universal Studios, Inc, et al v JAR Sales et al*, 216 USPQ 679 [13] et seqq (CD Cal 1982).

<sup>954</sup> *Ibid* [13] et seq.

<sup>955</sup> See para 6.3.5.1.

<sup>956</sup> *Anne of Green Gables Licensing Authority Inc v Avonlea Traditions Inc* (2000) 4 CPR (4<sup>th</sup>) 289 [100] (Ont SCJ); Leslie A Kurtz, 'The Independent Legal Lives of Fictional Characters' (1986) *Wis L Rev* 429, 437. See also paras 6.2.4. and 6.3.5.

<sup>957</sup> Leslie A Kurtz, 'The rocky road to character protection' (1990) 1 *Ent L R* 62. See also paras 6.2.2. and 6.3.4.

In the US, the same general copyright requirements that apply to any other literary, dramatic or artistic work also determine a character's copyrightability, such as the requirement of originality.<sup>958</sup> In addition, the courts have developed some specific requirements (general rules specific to characters) that aid a court to decide whether a particular character has gone beyond a mere idea and has reached the level of copyright protected expression.<sup>959</sup> A specific test was first formulated in *Nichols v Universal Pictures Corp.*<sup>960</sup> According to this ruling, a fictional character is protectable by copyright when it has been developed sufficiently.<sup>961</sup> That means that the character must be sufficiently fleshed out, otherwise it will be regarded as a mere idea.<sup>962</sup> Hence, a LFC is copyrightable, if it possesses clearly delineated attributes. These are expressed as a combination of mannerisms, personality traits, actions and reactions, and physical attributes.<sup>963</sup> Regarded one by one, the individual character attributes might be stock elements, but their combination can form a distinct, protectable character.<sup>964</sup> On occasion, though only in very rare cases, even single characteristics may attract protection by themselves, such as the hand of Freddy Krueger.<sup>965</sup> In principle, though, a single attribute of a character is insufficient to attract copyright.

A second test to determine character copyrightability was developed by CJ Stephens in *Warner Bros Inc v Columbia Broadcasting System Inc.*<sup>966</sup> It bears the long name 'the

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<sup>958</sup> See para 6.3.1.

<sup>959</sup> See para 6.3.2.

<sup>960</sup> *Nichols v Universal Pictures Corp*, 45 F 2d 119, 121 (2d Cir 1930); Rebecca Brackley, 'Fictional characters and their legal homes' (1999) 16 CIPR 127, 129. See para 6.3.2.1.1.

<sup>961</sup> *Nichols v Universal Pictures Corp*, 45 F 2d 119, 121 (2d Cir 1930); *Silverman v CBS Inc*, 632 F Supp 1344, 1354 (SDNY 1986); Jasmina Zecevic, 'Distinctly Delineated Fictional Characters That Constitute The Story Being Told: Who Are They And Do They Deserve Independent Copyright Protection?' (2006) 8 Vanderbilt J of Entertainment and Tech Law 365, 370 et seq; Gregory S Schienke, 'The Spawn of Learned Hand – A Reexamination of Copyright Protection and Fictional Characters: How Distinctly Delineated Must the Story Be Told?' (2005) 9 Marq Intell Prop L Rev 63, 68 et seq; Robert E Lee, *A Copyright Guide for Authors* (1st edn, Kent Press 1995) 134.

<sup>962</sup> Tamara Bukatz, 'Amazon's fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part I' (2013) 18 (4) Communications Law 122, 124.

<sup>963</sup> Eric J Schwartz and David Nimmer, 'United States' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, §2[4][b] (Pub 399, Rel 28-12/2016).

<sup>964</sup> Carole E Handler, 'Fictional characters in new media' (*Lathrop & Gage LLP*, 9 July 2010) 5 <<http://www.lexology.com/library/detail.aspx?g=bbc1a509-f972-4ec6-8ea1-b4c98eaaeb8f>> accessed 10 January 2013.

<sup>965</sup> *New Line Cinema v Easter Unlimited, Inc*, 17 USPQ 2d 1631 [3] (EDNY 1989).

<sup>966</sup> *Warner Bros Pictures, Inc v Columbia Broadcasting System, Inc*, 216 F 2d 945, 950 (9th Cir 1954), cert denied 348 U S 971 (S Ct 1955). See para 6.3.2.2.1.



story being told test'. 'if the character is only a chessman in the game of telling the story he is not within the area of the protection afforded by copyright.'<sup>967</sup> If the fictional character was the 'vehicle' or 'chessman in the game of telling the story', i.e. the means by which the narrative was transported, then the character shall not be afforded copyright protection.<sup>968</sup> This test is more stringent than the sufficiently delineated test and allows for copyrightability of fictional characters only under very limited circumstances.<sup>969</sup> The delineation test is more accepted than the story being told test. However, courts also sometimes apply both tests in the same set of legal proceedings to err on the side of caution.<sup>970</sup>

Though neither of these tests makes it possible to know with absolute certainty which characters are copyrightable and which not, this thesis asserts that these tests are sufficiently clear under the circumstances. These tests provide guidelines according to which a character's copyrightability can be judged: physical appearance and personality; the more developed, the more likely copyrightability; the story supports the character and not the other way around.

These factors shall be considered in each individual case according to its individual facts – not only to decide whether plaintiff or defendant succeeds in the individual case, but also to balance the copyright holder's interests and the interests of the public. The fair use doctrine, according to which a court or user may determine whether the reproduction of a work (or a character) is legitimate fair use or whether it is copyright infringement, also serves keeping a balance.

The delineated test, the story being told test, and the fair use doctrine all provide general guidelines as explained above. General guidelines allow for flexibility. This may bring a little legal uncertainty. However, the biggest advantage of general

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<sup>967</sup> Ibid 216 F 2d 945, 950 (9<sup>th</sup> Cir 1954); Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 29 et seq.

<sup>968</sup> *Warner Bros Pictures, Inc v Columbia Broadcasting System, Inc*, 216 F 2d 945, 950 (9<sup>th</sup> Cir 1954); Robert Fremlin, *Entertainment Law* (1990 Clark Boardman Callaghan) 375; Tamara Bukatz, 'Amazon's fan fiction store: Opportunity or fandom-ination? The legal background to commercial and non-commercial creations from canon - Part I' (2013) 18 (4) *Communications Law* 122, 124.

<sup>969</sup> Aaron Schwabach, *Fan Fiction and Copyright – Outsider Works and Intellectual Property Protection* (Ashgate 2011) 29.

<sup>970</sup> *Rice v Fox Broadcasting Company*, 330 F 3d 1170 (9<sup>th</sup> Cir 2003) (not copyrightable); *Metro-Goldwyn-Mayer, Inc v American Honda Motor Co, Inc*, 900 F Supp 1287, 1296 (CD Cal 1995) (copyrightable); *Olson v National Broadcasting Co*, 855 F 2d 1446, 1451 et seq (9<sup>th</sup> Cir 1988) (not copyrightable).

guidelines is that these can be applied in a vast multitude of cases without a need to change the law if new types of works are created or an otherwise unforeseen case is brought to court.

Regarding copyright protection of LFCs under Canadian copyright law, one has to differentiate between different types of literary works and their purpose. Some literary works are precluded from copyright infringement. Section 29.21 of the CA 1985 contains an exception regarding user-generated content. Most works of fanfiction will satisfy the criteria of the UGC exception and would consequently not infringe copyright.<sup>971</sup> Moral rights are unaffected by the UGC exception.<sup>972</sup> Therefore, the author of a LFC could still protect herself against the unauthorized use of the LFC in fanfiction, if for example the creator of the LFC can prove prejudice to her reputation or the reputation of her work. However, authors rarely rely on their moral rights in court proceedings in Canada, i.a. because economic rights are in principle the easier option. For example, a violation of the integrity right requires proof of prejudice to the author's or her work's reputation, infringement of the economic rights does not. Where fanfiction is concerned, the moral rights would be the only option under the CA 1985 though.

In the USA, 17 USC does not even offer any moral rights protection at all with the exception of the rights of attribution and integrity for authors of visual art.<sup>973</sup> Writers would have to make do with the tort of defamation, unfair competition, contract, privacy and trade mark law.<sup>974</sup>

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<sup>971</sup> Literary works of fanfiction might be caught by this exception, but only the fanfiction a) which is not used for commercial purposes, b) where the name of the author of the canon is acknowledged in the fanfiction, c) the fanfiction author has reason to believe that the work of canon underlying the fanfiction is not itself an infringing work, and d) the communication of the fanfiction does not affect the author of the canon in a substantial way either financially or otherwise. See para 6.2.3.

<sup>972</sup> Bob Tarantino, 'Fan Fiction – After the Copyright Modernization Act' (*Entertainment & Media Law Signal*, 11 December 2012) <[www.entertainmentmedialawsignal.com/articles/copyright/](http://www.entertainmentmedialawsignal.com/articles/copyright/)> accessed 9 January 2013.

<sup>973</sup> 17 USC § 106A; Kristin L Lingren, 'United States of America' in Gillian Davies and Kevin Garnett (eds), *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 1041 et seq.

<sup>974</sup> Leslie A Kurtz, 'The effect of international developments of US copyright law' (1995) 6 Ent L R 322, 324.

In principle, LFCs may be protected as literary works and a substantial part thereof in Canada<sup>975</sup> provided

- a) the character is more than a mere idea, but consists of protectable expression.

Although the principle - that ideas are not copyrightable, but their expression is - is part of Canadian<sup>976</sup> as well as UK copyright law,<sup>977</sup> LFCs are copyrightable in Canada, but not in the UK. Hence, it is a matter of how the courts deal with this principle with regard to LFCs. No change to the CDPA 1988 would have to be made in this regard. UK courts would have to accept first that LFCs are more than just ideas, and that they also on occasion might satisfy the *de minimis* threshold for copyright protection. According to Canadian case-law, a LFC meets this requirement when

- b) the character is sufficiently clearly delineated,<sup>978</sup> taking into account the LFC's physical attributes as well as its internal characteristics;
- c) the character is known in wide sections of the population;<sup>979</sup> and
- d) the character is still recognizable and recognized in the copy.<sup>980</sup> The more likely it is that the LFC is recognized outside its work by the public, the stronger the probability that a court will find that the LFC is copyright protected.<sup>981</sup>

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<sup>975</sup> *Productions Avanti Ciné-Video Inc v Favreau* (1999) 1 CPR (4<sup>th</sup>) 129 (Que CA); Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016); Grace Westcott, 'Friction over Fan Fiction' (2008) *Literary Review of Canada* <[www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/](http://www.reviewcanada.ca/essays/2008/07/01/friction-over-fan-fiction/)> accessed 9 January 2013. See para 6.2.1.1.

<sup>976</sup> See para 6.2.1.4.

<sup>977</sup> See para 8.3.1.

<sup>978</sup> *Preston v 20th Century Fox Canada Ltd* [1990] 38 FTR 183. This decision cites *Nichols v Universal Pictures*, 45 F 2d 119 (1930). See para 6.2.2.

<sup>979</sup> See para 6.2.2.

<sup>980</sup> *Ibid.*

<sup>981</sup> John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 249; Normand Tamaro, *Le droit d'auteur: Fondements et principes* (Les presses de l'Université de Montréal 1994) 74.

It is necessary to mention this fourth requirement d) in addition to requirement c). The reason is that even if a character is very widely known, it may nevertheless not be recognized in its copied form. That is, when the character is outside its original environment, and instead finds itself in a different literary work, maybe with a different AR, or even outside any literary work and instead takes the form of an item of character merchandise or a character on a radio show.

To conclude, fictional characters must be clearly identifiable, autonomous, well characterized and recognizable by their external appearance, conduct, antics, and language.<sup>982</sup>

According to CA 1985 s 6, the term of copyright protection in Canada is shorter than in the UK, France and Germany. Instead of 70 years, copyright expires 50 years from the end of the calendar year in which the author dies. Therefore, Canadian copyright law has opted for two opposing balancing factors. Copyrightability of LFCs tips the scales in favour of authors, while a shorter period of protection is in the public interest. One may also argue the other way around. It is arguable that longer copyright protection would be in the public interest, because it is a motivational factor for authors, whose works the public enjoys. Moreover, it is arguable that LFC copyrightability is in the public interest, because it might motivate authors to create a greater quantity of works as well as works of a better quality. However, one might also argue that authors might be intimidated by the possibility that another author may claim that their copyright in a LFC was infringed by the other. It is all very much a matter of the vantage point.

The aforementioned demonstrates that if the UK adopted LFC copyrightability, it would not necessarily be recommendable to adapt the copyright term and shorten it by 20 years. LFCs are copyrightable in France and Germany. The copyright term in those two countries is the same as in the UK (70 years plus the author's life).<sup>983</sup> Nevertheless, creativity is strong in those countries too, as will be discussed in the following chapter.

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<sup>982</sup> *Productions Avanti Ciné-Video Inc v Favreau* (1999) 1 CPR (4<sup>th</sup>) 129 (Que CA); Ysolde Gendreau and David Vaver, 'Canada' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][b] (Pub 399, Rel 28-12/2016); Gary Scanlan, 'Copyright in Character' (*City University London*) <[www.staff.city.ac.uk/~ra317/articles/IP.htm](http://www.staff.city.ac.uk/~ra317/articles/IP.htm)> accessed 9 January 2013.

<sup>983</sup> Only the economic rights are protected for a term of 70 years from the author's death in France. Moral rights protection in France is indefinite and authors or other rights owners often rely on their moral rights in relation to protection of LFCs.

## Chapter 7 – Copyright protection of LFCs in Germany and France

### 7.1. Introduction

In addition to the two common law jurisdictions of Canada and the USA, inspiration on how LFCs could be protected by copyright in the UK might also be found in the copyright law of the civil law jurisdictions of Germany and France. These two jurisdictions have a long and established tradition of LFC copyrightability. In particular in Germany, the criteria for LFC copyrightability are well developed and clearly presented in a number of cases.<sup>984</sup> Not only are LFCs protected by copyright against unauthorized reuse in literary format in these countries, but also against the unauthorized character merchandising of goods based on LFCs.

Moreover, historically, France and Germany have a more comprehensive protection for authors than the UK. Both Germany and France already acknowledged moral rights before provision was made for moral rights in the Berne Convention in 1928.<sup>985</sup> Despite having ratified the Berne Convention on 5 September 1887, it was not until the CDPA 1988 that authors were accorded moral rights in the UK.<sup>986</sup> Until then, authors merely had economic rights in the UK, which is reflected by the term ‘copyright’ instead of *droit d’auteur* (right of the author) like in France and *Urheberrecht* (right of the originator) as in Germany.

In addition, the USA, the copyright law of which was discussed in the previous chapter, and Germany are historically and commercially linked. The USA significantly influenced the creation of the *Grundgesetz* (the German Basic Law, abbreviated as GG) in Germany after the Second World War. The Basic Law has a bearing on the *Urheberrechtsgesetz* (UrhG) 1965 (Originators’ Rights Code = Copyright Act). The authorial rights are based on the personality right enshrined in Articles 1 I and 2 I of

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<sup>984</sup> See para 7.2.2.2.

<sup>985</sup> Moral rights were first recognized in France and Germany. Cyrill P Rigamonti, ‘Deconstructing Moral Rights’ (2006) 47 Harv Int’l LJ 353, 356.

<sup>986</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 36.

the Basic Law.<sup>987</sup> Moreover, around the time the UrhG 1965 was adopted, character merchandising was already good business in Germany. Germany had already been receptive to merchandising in the early 20<sup>th</sup> century before the Disney Group brought their extremely successful merchandising activities to Germany in the 1950s.<sup>988</sup> The first example of an early form of merchandising in Germany arose in 1910. The Supreme Court of the German Reich prohibited third parties to use the name and likeness of Graf Zeppelin<sup>989</sup> as a trade mark for cigars.<sup>990</sup> Due to the strong commercial ties between the US and Germany at the time as well as the fact that Disney had cast its net to the German market at the time leading up to the UrhG, it is unsurprising that LFCs receive copyright protection in Germany even against character merchandising.

The objective of this chapter is to identify and critically evaluate the general and specific LFC copyrightability principles used in Germany and France, draw a distinction between the principles of both copyright systems, and critically evaluate these. The following shall be considered carefully in pursuit of this aim:

- a) the legal provisions upon which copyright protection of LFCs is based in Germany and France, and how these are different from UK copyright law,
- b) German and French cases in which these legal provisions have been applied in relation to fictional characters, and
- c) the principles one can draw from both.

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<sup>987</sup> § 11 UrhG 1965; Paul Goldstein and P Bernt Hugenholtz, *International Copyright Principles, Law and Practice* (3<sup>rd</sup> edn, OUP 2013) 6; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 220; Volker Jänich, *Geistiges Eigentum – eine Komplementärscheinung zum Sacheigentum?* (Mohr Siebeck 2002) 109. Article 1 GG constitutes the inalienable right to human dignity. Article 2 Abs. 1 GG stipulates that ‘Everyone has the right to free development of his personality insofar as he does not violate the rights of others and does not violate the constitutional order or the moral law.’

<sup>988</sup> Christian Schertz and Susanne Bergmann, ‘Germany’ in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 128.

<sup>989</sup> Graf Zeppelin was the inventor of the well-known hydrogen-filled airship.

<sup>990</sup> Christian Schertz and Susanne Bergmann, ‘Germany’ in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 128; RGZ 74, 308, 312. The judgment is based on § 22 KUG (Copyright Act regarding works of art and photography) 1907 according to which the likeness of a person may not be circulated or put on display without the consent of the person whose image is concerned.

## 7.2. Germany

Apart from the above reasons, the fact that authors are greatly appreciated in Germany is also reflected by § 29 UrhG 1965 according to which copyright is unassignable. Copyright is subject to grants of *Nutzungsrechte* (rights of use) and agreements regarding *Verwertungsrechte* (rights of exploitation). However, the copyright will always remain in the hands of the author. Moreover, the author may revoke the grant of rights of use (including publication) and/or exploitation to protect her personal and intellectual interests, if the author has changed her convictions which are presented in her work.<sup>991</sup>

### 7.2.1. General principles of copyright protection applied to LFCs

The general requirements of copyright are stipulated in the UrhG 1965. These will be analysed and it will be demonstrated how the UrhG 1965 makes copyright protection of LFCs possible.

#### 7.2.1.1. Catalogue of protected works

First of all, a LFC would have to qualify as a work. Without being a work, creations won't be copyright protected. § 1 UrhG 1965 narrows down the term 'work' only slightly. It states that the authors of works of literature, science and art enjoy protection (copyright) in their works. By defining a work merely by stating the major categories of works, a broad scope of copyright protection for authors is guaranteed. The umbrella terms 'literature, science and art', and therefore what works are, are further elucidated in the § 2 UrhG 1965.

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<sup>991</sup> Mira Sundara Rajan, 'Tradition and change: the past and future of Authors' moral rights' in Toshiko Takenaka (ed), *Intellectual Property in Common Law and Civil Law* (Edward Elgar 2013) 136; Adolf Dietz, 'Germany' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 7[1] and 7[1][d] (Pub 399, Rel 28-12/2016); Volker Jänich, *Geistiges Eigentum – eine Komplementärerscheinung zum Sacheigentum?* (Mohr Siebeck 2002) 109 et seq.

§ 2 Abs. 1 UrhG 1965 adds a catalogue of explicitly protected works of literature, science and art. It includes, among others, photographs, technical illustrations, and films. The catalogue groups works of the same category together. § 2 Abs. 1 Nr. 1 UrhG 1965 deals specifically with literary works and mentions as works that attract copyright ‘literary works, such as writings, speeches and computer programs’.<sup>992</sup> The catalogue only names these kinds of works as examples. Therefore, the catalogue is not exhaustive.<sup>993</sup> It is merely illustrative as is clear from the wording of this provision. It stipulates ‘Among the protected works ... are *in particular*...’.<sup>994</sup> § 2 UrhG 1965 thereby continues what § 1 UrhG 1965 began. It leaves room for copyright protection of other creations to ensure a broad protection for authors and cover works which the legislature did not consider at the time, such as multi-media creations.<sup>995</sup> For this thesis, it is of particular interest that the illustrative wording of this provision makes copyright protection of LFCs feasible. An invented character can be copyrighted, if the requirements for copyright protection are satisfied.<sup>996</sup>

However, other types of works, but not other categories of works than those mentioned, may be protected by copyright. A creation must qualify either as a work of literature, science or art, and fulfil the general copyright criteria. That means, a LFC must be a literary work. Due to LFCs’ existence in writing, and typical appearance in literary works, it is natural to protect LFCs under the same category.

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<sup>992</sup> Adolf Dietz, ‘Germany’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[2] (Pub 399, Rel 28-12/2016); Christian Handig, ‘The “sweat of the brow” is not enough! – more than a blueprint of the European copyright term “work”’ (2013) 35 EIPR 334, 339; Christian Handig, ‘The copyright term “work” – European harmonisation at an unknown level’ (2009) 40 IIC 665, 673.

<sup>993</sup> Adolf Dietz, ‘Germany’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[2] (Pub 399, Rel 28-12/2016); Christian Handig, ‘The “sweat of the brow” is not enough! – more than a blueprint of the European copyright term “work”’ (2013) 35 EIPR 334, 339.

<sup>994</sup> § 2 Abs 1 Nr 1 UrhG 1965 (emphasis added).

<sup>995</sup> LG Düsseldorf, Urteil vom 29.09.2010 – Az: 12 O 255/09 Rn 38 (‘Beuys-Aktion’ case, Fluxus); Manfred Rehbinder, *Urheberrecht* (16<sup>th</sup> edn, C H Beck 2010) Rn 147.

<sup>996</sup> Bettina Kormanicki, ‘Germany’ in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 293.



## 7.2.1.2. Originality – *de minimis*

### 7.2.1.2.1. Personal intellectual creations

The scope of German copyright is relatively wide. Indeed, even the work of wrapping the Reichstag in 100,000 m<sup>2</sup> of silvery aluminium-coated fabric in summer 1995 by the artist couple Christo and Jeanne-Claude was protected by copyright against reproduction of their work on commemorative medals.<sup>997</sup> § 2 Abs. 2 UrhG 1965 stipulates that ‘Works within the meaning of this Act are only personal intellectual creations.’<sup>998</sup> Hence, the author must relate a message or point of view about aesthetic, emotional or intellectual affairs.<sup>999</sup> This means that the author must convey her train of thought. The train of thought is based on inspiration from the author’s fantasy, the development and logic of the train of thought, the representation or choice and arrangement of material.<sup>1000</sup> A LFC created by an author, a natural person, may therefore be classified as a work with regard to this criterion. The LFCs are the main vehicle except for the story by means of which an author conveys thoughts and feelings. That could be her own or those of another person, but it would always be the author’s ‘voice’. However, even if the author does not let her LFCs voice her own thoughts and feelings, but those of another real person or lets the LFC voice invented beliefs and feelings, these thoughts and emotions would nevertheless, strictly speaking, always be filtered through the mind of the author who created the LFC.

### 7.2.1.2.2. Gestaltungs-/Schöpfungshöhe

§ 2 Abs. 2 UrhG 1965 is also the basis of the *Gestaltungs-/Schöpfungshöhe* (degree of creativity = threshold of originality) which determines the minimum level of copyright

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<sup>997</sup> KG GRUR 1997, 128.

<sup>998</sup> Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 72; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 50.

<sup>999</sup> Dreyer in: Gunda Dreyer, Jost Kotthoff and Astrid Meckel, *Heidelberger Kommentar zum Urheberrecht* (1<sup>st</sup> edn, C F Müller Verlag 2004) § 2 Rn 37; Eva Inés Obergfell, ‘Kapitel 10 Urheberrechtsgesetz § 2 UrhG’ in Wolfgang Büscher, Stefan Dittmer and Peter Schiwy (eds), *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht – Kommentar* (2<sup>nd</sup> edn, Carl Heymanns Verlag 2011) § 2 Rn 5; Manfred Reh binder, *Urheberrecht* (16<sup>th</sup> edn, C H Beck 2010) Rn 148; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 226.

<sup>1000</sup> Eugen Ulmer, *Urheber- und Verlagsrecht* (3<sup>rd</sup> edn, Springer-Verlag 1980) 132 et seq.

protection.<sup>1001</sup> The *Schöpfungshöhe* demarcates copyrightable works from such subject matter that is not copyrightable and therefore is *gemeinfrei* (in the public domain). The minimum level of personal creativity that is required for copyright is rather liberal. Even works such as catalogues, directories, address books, printed forms and sometimes also a single sentence receive copyright protection.<sup>1002</sup> Works on this lowest level of copyright are referred to as *Kleine Münze* (small change).<sup>1003</sup> It may be ‘small change’, but it is still ‘change’, although only just within the limits of copyright. Hence, even the functional interaction (*Zusammenspiel*) of literary content and graphic arrangement of the entries up and down in crossword puzzles can attract copyright. However, the literary expression of golf club rules does not.<sup>1004</sup>

### 7.2.1.2.3. Titles and names of LFCs

It is rather challenging to achieve copyright protection of character names. However, that does not mean that character names may never obtain copyright protection. The general principles of copyright protection apply to character names like to any other written work. Hence, if the character name is sufficiently original and can also overcome the *de minimis* threshold, it is copyright protected. It would be very rare though for a title to fulfil these criteria. There have been no court judgments in Germany where a name was held to be copyright protected. That means *de facto*, just like in the

<sup>1001</sup> Christian Schertz and Susanne Bergmann, ‘Germany’ in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 130. A photo from a photo booth is not copyrighted. Gunda Dryer, Jost Kotthoff and Astrid Meckel, *Heidelberger Kommentar zum Urheberrecht* (1<sup>st</sup> edn, C F Müller 2004) § 2 Rn 28.

<sup>1002</sup> Adolf Dietz, ‘Germany’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[1][b] (Pub 399, Rel 28-12/2016); Manfred Rehbinder, *Urheberrecht* (16<sup>th</sup> edn, C H Beck 2010) Rn 153; LG München GRUR-RR 2011, 447 (Karl Valentin quote: ‘Mögen hätte ich schon wollen, aber dürfen habe ich mich nicht getraut’); Peter Raue, ‘Das kleinste Kleinzitat’ (2011) 12 GRUR 1088; OLG Köln, Urteil vom 27.02.2009 – Az: 6 U 193/08 [4] (Terms and Conditions); BGH GRUR 2002, 958, 959 (‘Technische Lieferbedingungen’ / ‘technological guidelines’ case); BGH GRUR 1993, 34, 35 (‘Bedienungsanweisung’ / ‘instruction manual’ case).

<sup>1003</sup> JAL Sterling and Estelle Derclaye, ‘Protection Criteria’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 356; Matthias Schmid and Thomas Wirth, *Urheberrechtsgesetz Handkommentar* (1<sup>st</sup> edn, Nomos 2004) § 2 Rn 4; Andreas Rahmatian, ‘Originality in UK copyright law: the old “skill and labour” doctrine under pressure’ (2013) 44 IIC 4, 19.

<sup>1004</sup> OLG Frankfurt a. M. ZUM 1995, 795.

Other examples: LG Mannheim GRUR-RR 2008, 388 (game of dice / ‘Würfelspiel’); LG München I ZUM 2008, 709, 717 (idea to let the farmer demonstrate the length of the key with his hands – ‘Dabei gibt er mit seinen Händen die Größe an’).

UK,<sup>1005</sup> names of fictional characters are not copyrightable in Germany either. The reasons are that a) names fall below the minimum level of creativity,<sup>1006</sup> b) are thought of as descriptive of the LFC, or at least assist in identifying the LFC or underlying work,<sup>1007</sup> and c) lack emotional content (*Gefühlsinhalt*).<sup>1008</sup> For example, the names ‘Pumuckl’<sup>1009</sup> and ‘Anna Marx’ were held to be non-copyrightable.<sup>1010</sup>

#### 7.2.1.2.4. LFCs and the idea/expression dichotomy

Where a television series was produced based on a text outlining plots, themes, characters and settings, the OLG München (Higher Regional Court in Munich) held on 15<sup>th</sup> March 1990 (Az: 29 U 4346/89) that the ideas had not been fleshed out sufficiently and therefore were not protected by copyright (‘Forsthaus Falkenau’ case).<sup>1011</sup> That means, by inference, that LFCs are protected by copyright, if they are sufficiently

<sup>1005</sup> See para 3.6.1.

<sup>1006</sup> Christian Schertz and Susanne Bergmann, ‘Germany’ in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 130; Bettina Kormanicki, ‘Germany’ in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 295; BGH GRUR 1958, 402, 405 Klein’s comment (‘Lili Marleen’ case); Wolfgang Walter, *Die gesellschaftliche Verwertung von Werbesymbolen durch Lizenzvergabe*, Schriftenreihe zum gewerblichen Rechtsschutz (Bd 51) (Carl Heymanns Verlag 1979) 127.

The same was said about titles: Hanseatisches OLG Hamburg, Beschluss vom 26.04.2010 – Az: 5 U 160/08 Rn 5 (‘Solange du wild bist’ case - part of the refrain of a song: ‘alles ist gut solange du wild bist’); BGH, ‘Zum Schutz des Untertitels einer Buchreihe’ (1988) 3 AfP 237, 238 (The Federal Supreme Court denied copyright to the subtitle of a set of two volumes of poetry. The subtitle had consisted of merely one word.) KG Berlin ZUM 2003, 867, 869; Willi Erdmann, ‘Verwendung zeitgenössischer Literatur für Unterrichtszwecke am Beispiel Harry Potter’ (2002) 12 WRP 1329, 1341; Karl-Heinz Fezer, ‘Kennzeichenschutz an Namen fiktiver Figuren’ (1997) 43 WRP 887, 888.

<sup>1007</sup> International Bureau, ‘Character Merchandising’ (WO/INF/108, 1994) Annex I, 2 <[http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo\\_inf\\_108.pdf](http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo_inf_108.pdf)> accessed 20 September 2012.

<sup>1008</sup> LG München II, Urteil vom 24.05.2007 – Az: 7 O 6358/07 in GRUR-RR 2007, 226, 229 = WPR 2007, 828, 835 (Eine Freundin für Pumuckl); Schertz in: Ulrich Loewenheim, *Handbuch des Urheberrechts* (2<sup>nd</sup> edn, C H Beck 2003) § 79 Rn 14.

Texts consisting of one or two words generally do not express *Gefühlsinhalt*.

<sup>1009</sup> LG München II, Urteil vom 24.05.2007 – Az: 7 O 6358/07 in GRUR-RR 2007, 226, 229 = WPR 2007, 828, 837; Volker Kitz, ‘Die Herrschaft über Inhalt und Idee beim Sprachwerk’ (2007) GRUR-RR 217. ‘Pumuckl’ is a LFC created by Elisabeth (Ellis) Kaut. ‘Pumuckl’ is a red-haired goblin, a small descendant of the hobgoblins. He lives with the carpenter ‘Meister Eder’, since he became stuck in a pot of glue at the carpenter’s workshop. As a consequence of being stuck, ‘Pumuckl’ became visible to ‘Meister Eder’. According to goblin law, ‘Pumuckl’ had to stay with ‘Meister Eder’ from then onwards. Among things ‘Pumuckl’ loves are glittering objects, crackling paper, and disorder. Among the things ‘Pumuckl’ dislikes are cheese and cats.

<sup>1010</sup> KG Berlin ZUM 2003, 867 et seq. ‘Anna Marx’ is a LFC in a series of crime stories. She is an investigative journalist and society columnist moving in political circles.

<sup>1011</sup> OLG München GRUR 1990, 674, 675 et seq (*Forsthaus Falkenau*).

elaborate. The LG Köln (Regional Court in Cologne) took the same view on 7<sup>th</sup> July 2004 (Az: 28 O 303/04). The LG Köln stated that LFCs may be copyrightable, but that the protagonist in this case was a ‘typical basic model’ and therefore a mere idea for the story line (*Handlungs-idee*).<sup>1012</sup>

For a literary work to constitute a work within the meaning of § 2 Abs. 2 UrhG 1965 it must be an expression of thoughts.<sup>1013</sup> Only the embodiment of a concept, theory, principles or ideas is protectable by copyright, not the ideas, concepts or underlying meaning (*Sinngehalt*) of those concepts and ideas per se.<sup>1014</sup> As was mentioned earlier, in order to attract copyright a work needs to be an original creation, § 2 Abs. 2 UrhG 1965. Original ideas originate from the individual skills of the individual person.<sup>1015</sup> Even when the ideas are drawn from material that is in the public domain, the creator will quite often add something from herself, from her individual abilities, her thoughts, beliefs, and mood. The choice, arrangement and evaluation themselves are signs of the creator’s individuality.<sup>1016</sup> Hence, a LFC must be distinguishable from pre-existing LFCs by its individuality, its unique creative character (*schöpferische Eigenart*). According to the Bundesgerichtshof (BGH), the Federal Supreme Court, there is no condition in the UrhG 1965 saying that a part of a work must be significant or of a certain length for it to meet the individuality requirement.<sup>1017</sup> The concrete text

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<sup>1012</sup> LG Köln ZUM 2004, 853, 859.

<sup>1013</sup> Bettina Kormanicki, ‘Germany’ in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 293.

<sup>1014</sup> Andreas Ebert-Weidenfeller and Martin Aulich, ‘Germany’ in Dennis Campbell (ed), *World Intellectual Property Rights and Remedies Laws with Commentary*, Vol 1, § 18:25 (R 11/2016); Paul-W Hertin, ‘Zur urheberrechtlichen Schutzfähigkeit von Werbeleistungen unter besonderer Berücksichtigung von Werbekonzeptionen und Werbeideen’ (1997) GRUR 799; BGH, ‘44. Urheberrechte des Graphikers – Rosaroter Elefant’ NJW-RR 1995, 307, 309; Willi Erdmann, ‘Verwendung zeitgenössischer Literatur für Unterrichtszwecke am Beispiel Harry Potter’ (2002) 12 WRP 1329, 1333.

<sup>1015</sup> Manfred Rehbinder, *Urheberrecht* (16<sup>th</sup> edn, C H Beck 2010) Rn 44.

<sup>1016</sup> Eva Inés Obergfell, ‘Kapitel 10 Urheberrechtsgesetz § 2 UrhG’ in Wolfgang Büscher, Stefan Dittmer and Peter Schiwy (eds), *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht – Kommentar* (2<sup>nd</sup> edn, Carl Heymanns Verlag 2011) § 2 Rn 7; Manfred Rehbinder, *Urheberrecht* (16<sup>th</sup> edn, C H Beck 2010) Rn 45; OLG München ZUM 1995, 427, 429; BGH GRUR 1981, 520, 521 (‘Fragensammlung’ / ‘collection of questions’ case).

<sup>1017</sup> Bettina Kormanicki, ‘Germany’ in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 293; BGHZ 28, 234, 242 (‘Kleinzitat’ case); Christian Czychowski and Jan Bernd Nordemann, ‘Die Entwicklung der unter- und obergerichtlichen Rechtsprechung zum Urheberrecht in den Jahren 2008 und 2009 (Teil 1)’ (2010) GRUR-RR 177 (A few scenes with dialogue taken from a TV series had sufficient creative individuality despite their brevity.) Crucial is the work’s individuality, not its length. Eugen Ulmer, *Urheber- und Verlagsrecht* (3<sup>rd</sup> edn, Springer-Verlag 1980) 137.

version and the content of the idea lend individuality to a work.<sup>1018</sup> Content is an accumulation of ideas. The author expresses these ideas in her work by fixating these in words on paper or by making the ideas perceptible in some other way. First, the ideas exist in the author's head. By expressing these ideas they are 'coded' in a story. The code will manifest itself as ideas afresh in the reader's head.<sup>1019</sup> Though expression and content are both copyrightable, content must still be distinguished from ideas in order to avoid a monopolisation of concepts and ideas.<sup>1020</sup> What is protectable is only the combination of ideas in that particular combination (story line, attributes of the fictive characters, place<sup>1021</sup> or a combination of elements forming a LFC), and only then, if this combination has individual personal character.<sup>1022</sup> This accumulation, arrangement and connection of ideas is referred to as the *Fabel* (tale).<sup>1023</sup> A single idea by itself taken from an accumulation of ideas is in the public domain.<sup>1024</sup> In the above mentioned 'Forsthaus Falkenau' case even the accumulation of ideas was not copyrighted, because the TV concept consisted of vague ideas using stock characters. The concept had not taken concrete form by the time the suit was filed in this case.<sup>1025</sup>

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<sup>1018</sup> LG Hamburg GRUR-RR 2003, 233, 240 ('Die Päpstin' case / *Pope Joan* is the English title of the novel); BGH GRUR 1999, 984, 987 ('Laras Tochter' [German book title] / *Lara's Child* [English book title, literal translation 'Lara's Kind'] case); BGH GRUR 1959, 379, 381 ('Gasparone' case); OLG Karlsruhe GRUR 1957, 395, 396 ('Trotzkopf' case); Manfred Rehbinder, *Urheberrecht* (16<sup>th</sup> edn, C H Beck 2010) Rn 47 and 58 et seq; Dreyer in: Gunda Dreyer, Jost Kotthoff and Astrid Meckel, *Heidelberger Kommentar zum Urheberrecht* (1<sup>st</sup> edn, C F Müller Verlag 2004) § 2 Rn 37 and 40; Loewenheim in: Ulrich Loewenheim, *Handbuch des Urheberrechts* (2<sup>nd</sup> edn, C H Beck 2003) § 7 Rn 7; Bettina Kormanicki, 'Germany' in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 293; Volker Kitz, 'Die Herrschaft über Inhalt und Idee beim Sprachwerk' (2007) GRUR-RR 217 et seq.

<sup>1019</sup> Volker Kitz, 'Die Herrschaft über Inhalt und Idee beim Sprachwerk' (2007) GRUR-RR 218.

<sup>1020</sup> Haimo Schack, *Urheber- und Urhebervertragsrecht* (7<sup>th</sup> edn, Mohr Siebeck 2015) § 9 Rn 188; Matthias Schmid and Thomas Wirth, *Urheberrechtsgesetz Handkommentar* (1<sup>st</sup> edn, Nomos 2004) § 2 Rn 2 and 5; Paul-W Hertin, 'Zur urheberrechtlichen Schutzfähigkeit von Werbeleistungen unter besonderer Berücksichtigung von Werbekonzeptionen und Werbeideen' (1997) GRUR 799, 805 et seqq.

<sup>1021</sup> KG Berlin ZUM 2003, 867, 869; BGH GRUR 1999, 984, 987.

<sup>1022</sup> Volker Kitz, 'Die Herrschaft über Inhalt und Idee beim Sprachwerk' (2007) GRUR-RR 218; NJW-RR 2000, 268, 269 ('Das doppelte Lottchen').

<sup>1023</sup> KG Berlin ZUM 2003, 867, 869; LG Hamburg GRUR-RR 2003, 233, 240; Thomas Dreier and Gernot Schulze, *UrhG Kommentar* (3<sup>rd</sup> edn, C H Beck 2008) § 24 Rn 22.

<sup>1024</sup> KG Berlin ZUM 2003, 867, 869; Volker Kitz, 'Die Herrschaft über Inhalt und Idee beim Sprachwerk' (2007) GRUR-RR 218; OLG München GRUR 1990, 674, 676; BGH GRUR 1956, 432, 434 ('Solange Du da bist' case).

<sup>1025</sup> OLG München GRUR 1990, 674, 675 et seq.

In summary, unless a work echoes general ideas, the content of a work may be copyrighted. The content is only protected in its concrete creative presentation<sup>1026</sup> – be that in writing or another form (e.g. verbal creation). That means for authors that stock characters, which are unoriginal characters that commonly support stories, are not copyrightable, whereas when the story evolves around the LFC, the chances are much higher that the LFC is copyrighted. That does not mean though that every protagonist of a story is copyrighted. The courts have to decide whether the LFCs level of originality is sufficient to warrant copyright protection. The criteria which a court considers in such a case shall be outlined later in this chapter with regard to actual cases. Suffice it to say here that being creative and actively creating something does not mean merely to bring something into being. Rather, it requires something imaginative and special. A creation is more than what can be expected from anyone who applied just common intellectual activity in the field of the respective category of works. Compared to commonplace material, a copyrightable creation is something of individual character.<sup>1027</sup> Individuality can only be expressed where the author has creative latitude. Therefore, there is no copyright in a work where its creation is predetermined by the facts and logic.<sup>1028</sup> The development of LFCs is commonly free from restraints. The author has full creative latitude. There is less latitude with regard to historic figures, but even these may be copyrightable if for example not much besides the name of the historic figure is known and the author fleshed out the historic figure for a historic novel. That was so in the case regarding the historic figure ‘Johanna von Ingelheim’ in the novel *Pope Joan*.<sup>1029</sup>

### 7.2.1.3. No fixation required

Interestingly, in distinction from the UK CDPA 1988,<sup>1030</sup> there is no provision in the German UrhG 1965 requiring a work to be recorded in some way, e.g. in writing.<sup>1031</sup>

<sup>1026</sup> BGH GRUR 1978, 302, 304 (‘Wolfsblut’ case / White Fang is a novel by Jack London); BGH GRUR 1963, 40, 41; Bettina Kormanicki, ‘Germany’ in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 293.

<sup>1027</sup> Manfred Reh binder, *Urheberrecht* (16<sup>th</sup> edn, C H Beck 2010) Rn 153.

<sup>1028</sup> Eva Inés Obergfell, ‘Kapitel 10 Urheberrechtsgesetz § 2 UrhG’ in Wolfgang Büscher, Stefan Dittmer and Peter Schiwy (eds), *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht – Kommentar* (2<sup>nd</sup> edn, Carl Heymanns Verlag 2011) § 2 Rn 7.

<sup>1029</sup> LG Hamburg GRUR-RR 2003, 233, 240.

<sup>1030</sup> CDPA 1988 s 3(2).

<sup>1031</sup> Iona Silverman, ‘Copyright and fashion: friends at last?’ (2013) EIPR 637, 640.

That means, a creation does not need to be in material form in order to be a work and attract copyright. Copyright vests automatically with the act of creation<sup>1032</sup> regardless of whether it is corporeal like a manuscript or ephemeral like happenings or live broadcasts. These ephemeral works are copyrighted too.<sup>1033</sup> However, it would be difficult to prove infringement if the work has not been fixated.<sup>1034</sup> Even if a work is not in material form, it must at least be perceptible like a scriptless public speech or an improvised song without a score.<sup>1035</sup> This fits LFCs perfectly, because LFCs are partly corporeal and partly incorporeal. A LFC is mostly written down in the book. Hence, there can be proof of their existence, but a LFC is more than just the written word. It is the manifestation of ideas behind these words which run through the work, unite the pieces of written information on the LFC, and make up the LFC's character and identity. A LFC may, for example, be generous without the text ever mentioning explicitly that the character is generous, but instead this character trait may be described by actions and words of the LFC. These may be written down in the book and thereby corporeal, but the personality of the LFC is, at the same time, also incorporeal.

Indeed, AFCs are protected by copyright in any bodily pose and situation, regardless of whether or not they have been depicted in those poses,<sup>1036</sup> if the AFC has become a distinct personality through a unique combination of external characteristics and skills, typical behaviour and internal attributes.<sup>1037</sup> It is the same for LFCs. A LFC

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<sup>1032</sup> Andreas Ebert-Weidenfeller and Martin Aulich, 'Germany' in Dennis Campbell (ed), *World Intellectual Property Rights and Remedies Laws with Commentary*, Vol 1, § 18:25 (R 11/2016).

<sup>1033</sup> Manfred Rehbinder, *Urheberrecht* (16<sup>th</sup> edn, C H Beck 2010) Rn 150.

<sup>1034</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 227.

<sup>1035</sup> LG Düsseldorf, Urteil vom 29.09.2010 – Az: 12 O 255/09 Rn 38 = ZUM 2011, 77, 79 ('Beuys-Aktion' case); Wolfgang Maaßen, 'Fluxus, Fotografie und Urheberrecht' (2011) 1 AfP 10, 11; Haimo Schack, *Urheber- und Urhebervertragsrecht* (7<sup>th</sup> edn, Mohr Siebeck 2015) § 9 Rn 187; Adolf Dietz, 'Germany' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[1][a] (Pub 399, Rel 28-12/2016); Eva Inés Obergfell, 'Kapitel 10 Urheberrechtsgesetz § 2 UrhG' in Wolfgang Büscher, Stefan Dittmer and Peter Schiwy (eds), *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht – Kommentar* (2<sup>nd</sup> edn, Carl Heymanns Verlag 2011) § 2 Rn 6; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 227; Eugen Ulmer, *Urheber- und Verlagsrecht* (3<sup>rd</sup> edn, Springer-Verlag 1980) 130; Matthias Schmid and Thomas Wirth, *Urheberrechtsgesetz Handkommentar* (1<sup>st</sup> edn, Nomos 2004) § 2 Rn 5.

<sup>1036</sup> GRUR 1994, 191, 192 ('Asterix-Persiflagen' case); GRUR 1994, 206, 207 ('Alcolix' case); Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 227.

<sup>1037</sup> BGH, Urteil vom 11.03.1993 – Az: I ZR 263/91, Abs. 9 et seq = BGHZ 122, 53, 57 = BGH NJW-RR 1993, 1002, 1003 = GRUR 1994, 206, 207; GRUR 1994, 191, 192; Gunda Dryer, Jost Kotthoff and Astrid Meckel, *Heidelberger Kommentar zum Urheberrecht* (1<sup>st</sup> edn, C F Müller 2004) § 2 Rn 30.

External characteristics are all elements that the character's appearance consists of, such as the hair colour, the hair style, the clothes, nose, chin etc. Internal attributes are all elements that form the character's personality, such as temper, believes, social skill etc.

appears in different situations and may behave this way in one situation and that way in another situation, all based on the LFC's mixture of character traits as devised by the author. The LFC remains the same regardless of whether or not the LFC turns right or jumps, encounters situation A or situation B.

### 7.2.2. Specific principles of character copyrightability

Character copyrightability is not explicitly regulated in the UrhG 1965, but arises from the general principles of copyright as described above. In addition, courts apply character specific principles to determine whether or not a character is protected by copyright in the respective case. This will be demonstrated in the following for AFCs and LFCs. As AFCs are easier to protect than LFCs due to their visual aspect, the criteria for copyright in AFCs are described first before the copyrightability of LFCs is analysed in greater depth.

#### 7.2.2.1. AFCs

AFCs can be copyright protected.<sup>1038</sup> That was the case e.g. for 'Bambi',<sup>1039</sup> 'Mickey Mouse', 'Goofy' and 'Donald Duck' from Disney,<sup>1040</sup> 'Astérix' and 'Obélix' created by René Goscinny and Albert Uderzo<sup>1041</sup> as well as the graphic version of the LFC 'Pumuckl'.<sup>1042</sup>

<sup>1038</sup> Eva Inés Obergefell, 'Kapitel 10 Urheberrechtsgesetz § 2 UrhG' in Wolfgang Büscher, Stefan Dittmer and Peter Schiwy (eds), *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht – Kommentar* (2<sup>nd</sup> edn, Carl Heymanns Verlag 2011) § 2 Rn 44; Ludwig Delp, 'Urheberrechtliche Gemeinfreiheit im Verhältnis zu Titel- und Figurenschutz – Eine Entgegnung' (2000) 10 WRP 1086, 1088.

<sup>1039</sup> BGH, Urteil vom 09.10.1959 – Az: I ZR 78/58 in NJW 1960, 37, 38; BGH GRUR 1960, 144; Gernot Schulze, 'Urheber- und leistungsschutzrechtliche Fragen virtueller Figuren' (1997) 2 ZUM 77.

<sup>1040</sup> BGH GRUR 1971, 588, 589 ('Disney-Parodie' / 'Disney parody' case); BGH GRUR 1963, 485, 487 ('Mickey-Maus-Orangen' / 'Mickey Mouse oranges' case).

<sup>1041</sup> BGH, Urteil vom 11.03.1993 – Az: I ZR 263/91 Rn 8 = BGHZ 122, 53, 56 = BGH NJW-RR 1993, 1002, 1003 = GRUR 1994, 191, 192; GRUR 1994, 206, 207; BGH ZUM 1993, 937, 938; OLG München ZUM 1993, 534, 535; Gernot Schulze, 'Urheber- und leistungsschutzrechtliche Fragen virtueller Figuren' (1997) 2 ZUM 77.

<sup>1042</sup> OLG München, Urteil vom 20.12.2007 – Az: 29 U 5512/06 in GRUR-RR 2008, 37, 39. Other copyrighted AFC: BGH, Urteil vom 08.07.2004 – Az: I ZR 25/02 Rn 9 = BGHZ 532, 1, 7 = GRUR 2004, 855, 856 ('Hundefigur' / Bill the Dog [dog character] case); BGH NJW 1960, 573 ('"Mecki-Igel" II' / Hedgehog Mecki II case); OLG Hamburg WRP 1989, 602, 603 ('Schlumpfe' case / The Smurfs).



Not only the AFC's graphic appearance, but also the AFC's personality is considered when judging the copyrightability of an AFC. An AFC's personality attributes are considered, although AFCs are visual and thereby easily comparable with allegedly infringing characters. This includes the AFC's personality resulting from the visual elements of the graphic character (such as good-natured and impish facial features<sup>1043</sup>), but also the inner character attributes of the AFC (behaviour, manners, abilities and attitude).<sup>1044</sup> Since protection of characters under German law attaches importance to a character's non-visual personality attributes even in an AFC, it is unsurprising that LFCs are protected as well.

It is suggested here that there are the following two reasons for this: Firstly, the inner attributes of an AFC play a role in addition to the graphic attributes, because AFC protection is not limited exclusively to the reproduction of individual drawings.<sup>1045</sup> AFCs are not just protected in concrete poses drawn in the underlying work, but also in a variety of poses, which the AFC did not necessarily appear in in the original artistic work. This also means that AFCs are protected independent from the underlying story.<sup>1046</sup>

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The Smurfs were held to be copyrightable artistic works. Copyright was not infringed in this instance, though, because the Smurfs were parodied.

<sup>1043</sup> BGH NJW 1960, 573.

<sup>1044</sup> BGH, Urteil vom 11.03.1993 – Az: I ZR 263/91 Rn 9 = BGHZ 122, 53, 57 = BGH NJW-RR 1993, 1002, 1003 ('Alcolix' case); BGH, Urteil vom 19.10.1994 – Az: I ZR 156/92 B. II. 2. b) ('Rosaroter Elefant' / 'pink elephant' case); BGH, '44. Urheberrechte des Graphikers – Rosaroter Elefant' NJW-RR 1995, 307, 309 = BGH GRUR 1995, 47, 48; Adolf Dietz, 'Germany' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[4][b] (Pub 399, Rel 28-12/2016); JAL Sterling, Michael Hart and Emily Riddle, 'Subject Matter of Protection' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 275.

<sup>1045</sup> OLG München, Urteil vom 20.12.2007 – Az: 29 U 5512/06 in GRUR-RR 2008, 37, 39; BGH GRUR 2004, 855, 856; BGH, Urteil vom 11.03.1993 – Az: I ZR 263/91 Rn 9 et seq = BGHZ 122, 53, 56 = BGH NJW-RR 1993, 1002, 1003 = BGH NJW 1993, 2610; Dreyer in: Gunda Dreyer, Jost Kotthoff and Astrid Meckel, *Heidelberger Kommentar zum Urheberrecht* (1<sup>st</sup> edn, C F Müller Verlag 2004) § 2 Rn 30.

<sup>1046</sup> GRUR 1994, 191, 192; GRUR 1994, 206, 207; Thomas Dreier and Gernot Schulze, *UrhG Kommentar* (3<sup>rd</sup> edn, C H Beck 2008) § 88 Rn 6 (AFCs are discussed by Schulze in this commentary under the heading 'All types of works', not 'Parts of a work'.) Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 227; Gunda Dryer, Jost Kotthoff and Astrid Meckel, *Heidelberger Kommentar zum Urheberrecht* (1<sup>st</sup> edn, C F Müller 2004) § 2 Rn 30; Schertz in: Ulrich Loewenheim, *Handbuch des Urheberrechts* (2<sup>nd</sup> edn, C H Beck 2003) § 79 Rn 13.

Secondly, character copyrightability has its root in the creator's right to have the expression of his personality protected. Indeed, the Federal Supreme Court regards the behaviour and manner of AFCs as part of what makes AFCs distinct.<sup>1047</sup>

### 7.2.2.2. LFCs

LFCs are copyrightable in Germany.<sup>1048</sup> However, not all LFCs in general are copyrightable. This section looks at cases concerning LFCs, where LFCs were held to be copyrightable as well as cases where the copyright claim failed, in order to identify the particular criteria for copyright protection of LFCs.

#### 7.2.2.2.1. 'Sherlock Holmes' case<sup>1049</sup>

First of all, LFCs may not be copyright protected, if the principle of *freie Benutzung* (free utilisation) according to § 24 UrhG 1965 applies. § 24 Abs. 1 UrhG 1965 states that 'An independent work, that has been created in the free use of another author's work, may be published and exploited without the consent of the author of the used work.' If the pre-existing work (*vorbestehendes Werk*) merely serves as an inspiration for the new work, that is, if the individual intellectual creative elements from the pre-existing work pale in the overall view of the new work's creative intellectual individuality,<sup>1050</sup> then the author of the new work used the earlier work freely and does not infringe copyright in the earlier work.<sup>1051</sup> However, the standard applied in the

<sup>1047</sup> BGH, Urteil vom 11.03.1993 – Az: I ZR 263/91 Rn 17 = BGHZ 122, 53, 57 = BGH NJW-RR 1993, 1002, 1004.

<sup>1048</sup> JAL Sterling and Estelle Derclaye, 'Protection Criteria' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 355 et seq; Bullinger in: Arthur-Axel Wandtke and Winfried Bullinger, *Praxiskommentar zum Urheberrecht* (4<sup>th</sup> edn, C H Beck 2014) § 2 Rn 48; Thomas Dreier and Gernot Schulze, *UrhG Kommentar* (3<sup>rd</sup> edn, C H Beck 2008) § 2 Rn 92; Gunda Dryer, Jost Kotthoff and Astrid Meckel, *Heidelberger Kommentar zum Urheberrecht* (1<sup>st</sup> edn, C F Müller 2004) § 2 Rn 30.

<sup>1049</sup> BGH, Urteil vom 15.11.1957 – Az: I ZR 83/56 = BGH GRUR 1958, 354.

<sup>1050</sup> This is generally the case when the individual intellectual creative elements from the pre-existing work take the backseat in the new work, because the new work does not use the old work to a relevant extent. LG Berlin ZUM 2003, 60, 61.

<sup>1051</sup> OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11 [12]; LG Hamburg, Beschluss vom 28.04.2009 – Az: 308 O 200/09 Rn 9 = LG Hamburg ZUM 2009, 581; Helmut Haberstumpf, 'Kapitel 10 Urheberrechtsgesetz § 24 UrhG' in Wolfgang Büscher, Stefan Dittmer and Peter Schiwy (eds), *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht – Kommentar* (2<sup>nd</sup> edn, Carl Heymanns Verlag 2011) § 24 Rn 10; Elizabeth Adeney, 'Authors' rights in works of public sculpture: a German/Australian

decision-making process concerning free utilisation should not be too low in the interest of copyright protection.<sup>1052</sup> This means that the judge should rather adopt a stricter approach in favour of the existing work than a lenient approach in favour of the new work. Moreover, the less individual the replicated elements are, the easier these will fade out (i.e. pale) in the overall view.<sup>1053</sup>

The Federal Supreme Court held that the two protagonist detectives in the film *The Man Who Was Sherlock Holmes* did not infringe the copyright in the LFCs ‘Sherlock Holmes’ and ‘Dr Watson’, because the underlying work had been utilised freely in the film compliant with § 24 Abs. 1 UrhG 1965.<sup>1054</sup> Moreover, the two detectives in the film merely had the outward characteristics of ‘Sherlock Holmes’ and ‘Dr Watson’, but their inner character attributes did not coincide with those of Sir Arthur Conan Doyle’s works. Only the other characters in the script and film mistook the two detectives for ‘Sherlock Holmes’ and ‘Dr Watson’. It was obvious to the audience from the start (despite the title of the film) that these two film detectives were not ‘Sherlock’ and ‘Watson’, because their personalities were very different from those of ‘Sherlock’ and ‘Watson’. The court stipulated that a new creation does not infringe copyright, if it merely makes use of a LFC’s physical appearance.<sup>1055</sup>

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comparison’ (2002) 33 IIC 164, 172; Willi Erdmann, ‘Verwendung zeitgenössischer Literatur für Unterrichtszwecke am Beispiel Harry Potter’ (2002) 12 WRP 1329, 1335. This means also that the decisive factor is how much the two works have in common (not their differences), in particular how much of the individual creative elements, that characterise the earlier work, can be found in the new work. LG Köln, Urteil vom 10.08.2011 – Az: 28 O 117/11 Rn 21; Dinusha Mendis and Martin Kretschmer, ‘The Treatment of Parodies under Copyright Law in Seven Jurisdictions – A Comparative Review of Underlying Principles’ (*IPO*, 2013/23) 29.

<sup>1052</sup> LG Hamburg, Beschluss vom 28.04.2009 – Az: 308 O 200/09 Rn 9 = LG Hamburg ZUM 2009, 581; LG Berlin ZUM 2003, 60, 61; Dinusha Mendis and Martin Kretschmer, ‘The Treatment of Parodies under Copyright Law in Seven Jurisdictions – A Comparative Review of Underlying Principles’ (*IPO*, 2013/23) 31; Willi Erdmann, ‘Verwendung zeitgenössischer Literatur für Unterrichtszwecke am Beispiel Harry Potter’ (2002) 12 WRP 1329, 1335; C T, ‘Case Comment, Germany: Copyright Act, Secs 2, 23, 24 – “Alcolix”’ (1994) 25 IIC 605, 608.

<sup>1053</sup> OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11 Rn 12; BGH NJW 1960, 573, 574.

<sup>1054</sup> BGH, Urteil vom 15.11.1957 – Az: I ZR 83/56 Rn 12 et seqq = BGH GRUR 1958, 354, 356; Adolf Dietz, ‘Germany’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 8[1][a] (Pub 399, Rel 28-12/2016).

<sup>1055</sup> BGH, Urteil vom 15.11.1957 – Az: I ZR 83/56 Rn 13 = BGH GRUR 1958, 354, 356. The BGH and LG München agreed in two, much later, decisions (both concerning ‘Pippi Longstocking’): BGH, Urteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178, 182 Rn 44 = BGH GRUR 2014, 258, 262 Rn 44; LG München I, Beschluss vom 20.07.2011 – Az: 33 O 14810/11 Rn 43.

#### 7.2.2.2.2. 'A girlfriend for Pumuckl' case<sup>1056</sup>

The author of the LFC 'Pumuckl' could not prevent the creator of the artistic version of 'Pumuckl' either to hold a competition for children to draw a girlfriend for 'Pumuckl'. The court held, that the creator of the artistic 'Pumuckl' had not narrated, written or otherwise publicised a new 'Pumuckl' story. She had simply voiced an opinion on 'Pumuckl's potential private life.<sup>1057</sup> Moreover, everybody was free to celebrate a wedding of figures of fantasy in a private environment and announce the event publicly. It does not violate the author's integrity right either to alter fictional characters, so that they are married instead of unmarried characters.<sup>1058</sup> This would also suggest that writers of fanfiction, who create new pairings in their stories, are safe from copyright infringement provided they write the story only for their own enjoyment and not circulate it on the web.

#### 7.2.2.2.3. 'Harry Potter' case<sup>1059</sup>

The LG Köln (Regional Court in Cologne) voiced its misgivings in 2001 whether a single unitary literary 'picture' of 'Harry Potter' exists. It pointed out that 'Harry Potter' looks different on the book covers in the UK, the USA, and on the covers of the German edition by Carlsen publishing.<sup>1060</sup>

The facts of this case were as follows: The proprietor of the right of use in the 'Harry Potter' works sued the manufacturer and seller of bed linen for copyright infringement. The bed linen depicted a boy with cape and magic wand surrounded by dragons and castles.

Since the origin of 'Harry Potter' is its literary form, the court should have compared the LFC 'Harry Potter' to the artistic images on the bedding. This is what the court actually did. Even so, the court opined that there is no uniform image of 'Harry Potter',

<sup>1056</sup> LG München II, Urteil vom 24.05.2007 – Az: 7 O 6358/07 in GRUR-RR 2007, 226 = WPR 2007, 828; LG München I, Urteil vom 10.01.2008 – Az: 7 O 8427/07 in GRUR-RR 2008, 44.

<sup>1057</sup> LG München I, Urteil vom 10.01.2008 – Az: 7 O 8427/07 in GRUR-RR 2008, 44, 45; WPR 2007, 828, 836.

<sup>1058</sup> LG München II, Urteil vom 24.05.2007 – Az: 7 O 6358/07 in GRUR-RR 2007, 226, 228 et seq = WPR 2007, 828, 836; LG München I, Urteil vom 10.01.2008 – Az: 7 O 8427/07 in GRUR-RR 2008, 44, 45.

<sup>1059</sup> LG Köln GRUR-RR 2002, 3.

<sup>1060</sup> Ibid 4.

because of its alleged varying depictions of ‘Harry Potter’ on JK Rowling’s book on the covers in different countries. The LG Köln stated that this proves that more than one way exists to interpret ‘Harry Potter’s look and draw his image.’<sup>1061</sup>

It is submitted here, after checking the cover of the UK, US and German editions, that the LG Köln’s view is questionable. The depictions of ‘Harry Potter’ on the book covers look different, but only slightly. They are very much alike, and their principal external attributes are identical. Moreover, copyright in a work can be infringed if its essential attributes are reproduced. Hence, the allegedly offending work does not have to be identical in order to be an illegal copy.

However in this particular case, the images on the bedclothes did not copy the central physical attributes of ‘Harry Potter’ as he was described in the JK Rowling’s novels. ‘Harry Potter’ is described in the books as a boy with dark hair, green eyes, round glasses, short, delicate build, and a scar on his forehead shaped like a bolt of lightning. The wizard boy on the bed linen was fair haired, round faced, with a sturdy rounded physique, grey/blue eyes and oval glasses. Furthermore, the boy on the bedclothes does not have ‘Harry Potter’s characteristic scar on his forehead.’<sup>1062</sup>

#### 7.2.2.2.4. ‘Laras Tochter’ case<sup>1063</sup>

Certainly, it is not without difficulty to abstract a LFC from the work it appears in. This did not deter courts, though, from affirming character copyrightability of LFCs. One such case is *Laras Tochter* [engl. title: *Lara’s Child*]. The court held that copyright was infringed by the defendant (a German publishing company) who had translated the unauthorized English sequel novel to Boris Pasternak’s novel *Doctor Zhivago* and in the process had copied from Pasternak’s literary work. The setting of the novel (places and time) as well as the characterisation and their relationships to each other had been copied. Although the ‘World’<sup>1064</sup> from *Doctor Zhivago* had not been entirely reproduced and above all not in its complexity and atmospheric density, copyright infringement was

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<sup>1061</sup> Ibid.

<sup>1062</sup> Ibid et seq.

<sup>1063</sup> BGH, Urteil vom 29.04.1999 – Az: I ZR 65/96 = BGH GRUR 1999, 984 = GRUR Int 1999, 884.

<sup>1064</sup> The world is the universe the author has created for the LFCs to live in. That includes for example the time and place, inventions, unknown peoples, strange fashions, etc.

affirmed.<sup>1065</sup> The reproduction of characters and their network of relationships was sufficient for copyright infringement. However, it is unclear from this case whether a LFC is copyrightable independent from its relationships to other LFCs and the *Fabel* in general or whether it is only copyrightable in connection with the *Fabel* (including the LFC's relationships to others).

Some academic commentators claim that fictional characters are solely copyrightable within the web of the *Fabel*.<sup>1066</sup> However, the prevailing view of the courts and scholars is that fictional characters may be copyright protected independent from the *Fabel*.<sup>1067</sup> It is maintained in this thesis that it gives more substance to a LFC, if more is known about the personal background of a LFC, such as that the LFC X has a younger sister Y and an older brother Z, that they remain living under one roof, even in later life, etc. However, the external appearance of a character as well as its inner character traits, which may even be present in the looks of the character, can make a LFC so distinct that a LFC won't need to be thought of as a person in relation to others (in the example here: two siblings Y and Z). The fact that copyright protects LFCs from unauthorized reproduction as character merchandise<sup>1068</sup> teaches us that LFCs can 'survive/exist' by themselves, outside the story and outside the web of relationships. In some instances, the LFC will be manufactured and sold as a merchandise item (e.g. a figure) as part of a collection of other LFCs from the same story or series. In other instances, the LFC will be produced and sold as a single figure in one piece with e.g. the LFC's cat. That is not always the case, though. For example, 'E.T.' figures were produced without 'Elliott'. The relationships of a LFC to other characters is only an additional aspect that

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<sup>1065</sup> BGH, Urteil vom 29.04.1999 – Az: I ZR 65/96 = BGH GRUR 1999, 985 et seqq = GRUR Int 1999, 884, 887; Adolf Dietz, 'Germany' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[4][b] (Pub 399, Rel 28-12/2016); JAL Sterling, Michael Hart and Emily Riddle, 'Subject Matter of Protection' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 297. The same principle was mentioned in: LG Hamburg GRUR 2004, 65 = LG Hamburg NJW 2004, 610; LG Berlin ZUM 2001, 608, 612.

<sup>1066</sup> Christoph Willi, 'Merchandising mit fiktiven Figuren' (1996) 7-8 WRP 652, 653 and 655; Willi Erdmann, 'Verwendung zeitgenössischer Literatur für Unterrichtszwecke am Beispiel Harry Potter' (2002) 12 WRP 1329, 1334 et seqq.

<sup>1067</sup> BGH, Urteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178, 180 et seq Rn 24 -29 = BGH GRUR 2014, 258, 260 Rn 24 - 29; OLG Köln, Urteil vom 24.02.2012 – Az: 6 U 176/11 Rn 10; LG Köln, Urteil vom 10.08.2011 – Az: 28 O 117/11 [16]; OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11 Rn 8; OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11 Rn 22; LG München I, Beschluss vom 20.07.2011 – Az: 33 O 14810/11 Rn 43; LG Berlin, Urteil vom 11.08.2009 – Az: 16 O 752/07 Rn 44 and 51; LG Hamburg, Beschluss vom 28.04.2009 – Az: 308 O 200/09 Rn 16 = LG Hamburg ZUM 2009, 581, 582; LG Berlin ZUM 2003, 60, 61; Thomas Dreier and Gernot Schulze, *UrhG Kommentar* (3<sup>rd</sup> edn, C H Beck 2008) § 24 Rn 22 et seq.

<sup>1068</sup> See para 7.2.3.

would make it easier to decide whether a new creation by another author is sufficiently dissimilar and the existing similarities pale in the overall picture, or whether it infringes a pre-existing LFC.

#### 7.2.2.2.5. 'Die Päpstin' case<sup>1069</sup>

The following case supports the above presented view. In the 'Die Päpstin' case, the authoress of *Pope Joan* obtained a judgment against the writer of a script and film producer preventing the use of the script for the production of the film. The court held that LFCs are copyrightable per se, meaning independent from the plot. A condition for LFC copyrightability is that the LFC itself is already an individual element that is shaped and informed by the author's thoughts (which may itself be shaped by the author's beliefs, experiences and feelings), and gives the underlying work its shape. This distinct individuality can lie in

- a) the characteristics of the LFC by itself, independent from the LFC's relationship to other characters,<sup>1070</sup> or
- b) the characteristics of the LFC bolstered by the LFC's relationship to other characters,<sup>1071</sup> and/or
- c) characteristics of the LFC that are revealed when the LFC interacts with other fictive persons.<sup>1072</sup>

It is not a free utilisation of a LFC, if the distinct individual traits, that form the LFC, are copied by the new work. Where well-known LFCs (or other works) are concerned, only minor allusions suffice to establish a relationship to the pre-existing work. However, these minor allusions only then infringe copyright if the copied attributes are:

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<sup>1069</sup> LG Hamburg GRUR-RR 2003, 233.

<sup>1070</sup> Ibid 240.

<sup>1071</sup> Ibid. Example: The defendant's script had made use of the character Johanna von Ingelheim and her relationships to others without the author's/claimant's authorization. (Johanna has a brother named John. She dresses as a man and assumes his identity after his death. Johanna fell in love with a man in Germany during her youth, whom she later meets again in Rome. He is the chief of the papal guard. He becomes her lover and she bears his child).

<sup>1072</sup> Ibid. Example: Upon learning that her brother can read and write, she persuades her brother to teach her the art of reading and writing too, against the wishes of her father.

- a) distinct individual characteristics of the LFC or other work, which reflect the author's personal touch,<sup>1073</sup> and
- b) are still noticeable in the unique creative character/uniqueness (*schöpferische Eigenart*) of the new creation.<sup>1074</sup>

The reason behind these conditions is that not just any allusion to a LFC can be prohibited by its author, but only the unique intellectual elements of an author's creation.<sup>1075</sup>

#### 7.2.2.2.6. 'Anna Marx' case<sup>1076</sup>

In the 'Anna Marx' case, the KG Berlin (Court of Appeal in Berlin) applied the following criteria for LFC copyrightability:

A unique combination of

- a) outward attributes,
- b) inner attributes,
- c) abilities, and
- d) typical mode of behaviour – shaping a distinct figure, which appears and behaves in a way characteristic for that particular LFC.<sup>1077</sup>

A character is copyrightable, if the synergy of all components represent a unique fictive character.<sup>1078</sup>

<sup>1073</sup> Eugen Ulmer, *Urheber- und Verlagsrecht* (3<sup>rd</sup> edn, Springer-Verlag 1980) 127.

<sup>1074</sup> Helmut Haberstumpf, 'Kapitel 10 Urheberrechtsgesetz § 24 UrhG' in Wolfgang Büscher, Stefan Dittmer and Peter Schiwy (eds), *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht – Kommentar* (2<sup>nd</sup> edn, Carl Heymanns Verlag 2011) § 24 Rn 10.

<sup>1075</sup> LG Hamburg GRUR-RR 2003, 233, 240.

<sup>1076</sup> KG Berlin ZUM 2003, 867.

<sup>1077</sup> *Ibid* 869.

<sup>1078</sup> *Ibid*.



### 7.2.2.2.7. 'Pippi Langstrumpf' cases<sup>1079</sup>

The most prominent LFC among the court cases concerning the unauthorized use of a LFC is 'Pippi Langstrumpf' ('Pippi Longstocking'), a LFC created by Swedish children's author Astrid Lindgren. A considerable number of cases concerning this LFC exists. Many of these cases were appealed, one was even appealed all the way to the highest court. Hence, several independent 'threads' of 'Pippi Longstocking' cases exist in different regions of Germany, all of which apply Federal copyright law. Only the most notable four 'threads' of 'Pippi Longstocking' cases, which detail the specific copyrightability requirements for LFC particularly clearly, shall be analysed here.

#### 7.2.2.2.7.1. LG Berlin, Urteil vom 11.08.2009<sup>1080</sup>

The proprietors of the IPRs of Astrid Lindgren sued the unauthorized distributor of postcards for copyright infringement. The postcards in question bore stills of the actress Inger Nilsson portraying the LFC 'Pippi Longstocking' in the eponymous films.

Firstly, the LG Berlin (Regional Court in Berlin) clearly brought home that copyright applies to a LFC and that 'Pippi' is such a copyrighted LFC. Interestingly, the court invoked the BGH's decision on 'Alcolix',<sup>1081</sup> i.e. a case concerning AFCs. This demonstrates that AFCs and LFCs are treated equally in Germany.<sup>1082</sup>

Secondly, copyright can even then be infringed when the character was copied indirectly, like in this case.<sup>1083</sup> The defendant had copied 'Pippi Longstocking' not

<sup>1079</sup> BGH, Revisionsurteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178 = BGH GRUR 2014, 258; OLG Köln, Berufungsurteil vom 24.02.2012 – Az: 6 U 176/11; LG Köln, Urteil vom 10.08.2011 – Az: 28 O 117/11; OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11; OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11; LG München I, Beschluss vom 20.07.2011 – Az: 33 O 14810/11; LG Berlin, Urteil vom 11.08.2009 – Az: 16 O 752/07 = LG Berlin ZUM 2010, 69; LG Hamburg, Beschluss vom 28.04.2009 – Az: 308 O 200/09 = LG Hamburg ZUM 2009, 581.

<sup>1080</sup> LG Berlin, Urteil vom 11.08.2009 – Az: 16 O 752/07.

<sup>1081</sup> Ibid Rn 44.

<sup>1082</sup> That AFCs and LFCs are treated equally, like in France, was confirmed in BGH, Urteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178, 180 Rn 26 et seq = BGH GRUR 2014, 258, 260 Rn 26 et seq. The aforementioned judgment stipulates that the same principles that are applied for AFCs also apply for LFCs.

Other way round - Judgment on the application of principles for LFCs to AFCs: BGH, Urteil vom 11.03.1993 – Az: I ZR 263/91 Rn 9 et seq = BGHZ 122, 53, 56 = BGH NJW-RR 1993, 1002, 1003 = GRUR 1994, 206, 207; GRUR 1994, 191, 192. The aforementioned judgment states that copyright protection covering AFCs is not limited to the drawings, but extends to the behaviour of the AFC.

<sup>1083</sup> LG Berlin, Urteil vom 11.08.2009 – Az: 16 O 752/07 Rn 47 and 49.

directly from the novels, but from stills from a film based on the literary work. The defendant had argued that the stills were not a work by the authoress, but by the photographer/camera man. The court did not accept that argument, because these photos themselves were only an ‘unfree utilisation’ of the LFC ‘Pippi’. Hence, the defendant needed not only permission from the photographer to use the photos on postcards (which he had obtained), but also the merchandising rights in the LFC from the claimants.<sup>1084</sup>

This proves unequivocally that character copyright goes as far as granting protection against secondary commercial exploitation such as character merchandising by others than the author without licence. The LG Berlin also spoke of the first claimant’s merchandising rights and explained that the merchandising rights commonly encompass the secondary commercialization of fictive characters.<sup>1085</sup>

Thirdly, the LG Berlin stated that it is sufficient for copyright infringement if merely the external features of a fictional character are transferred to the ‘secondary product’ (here: postcards), because these are distinctive and unmistakably ‘Pippi’. It is not necessary that the character’s personality is applied as well.<sup>1086</sup>

#### 7.2.2.2.7.2. LG München and OLG München<sup>1087</sup>

The LG München (Regional Court in Munich) and OLG München (Higher Regional Court / Court of Appeal in Munich) also acknowledged that LFCs are copyrightable. In this ‘Pippi Longstocking case-thread’, the proprietors of the IPRs of Astrid Lindgren sued the operator of an internet shop, who offered for sale and distributed costumes representing ‘Pippi Longstocking’.

<sup>1084</sup> Ibid Rn 53.

<sup>1085</sup> Ibid Rn 47; Schertz in: Ulrich Loewenheim, *Handbuch des Urheberrechts* (2<sup>nd</sup> edn, C H Beck 2003) § 79 Rn 5, 11 and 13; explicitly mentioning postcards: Freitag in: Christian Berger and Sebastian Wündisch, *Urhebervertragsrecht Handbuch* (1<sup>st</sup> edn, Nomos 2008) § 33 Rn 21.

<sup>1086</sup> LG Berlin, Urteil vom 11.08.2009 – Az: 16 O 752/07 Rn 51 = LG Berlin ZUM 2010, 69, 71.

<sup>1087</sup> LG München I, Beschluss vom 20.07.2011 – Az: 33 O 14810/11 – reversed by OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11.

#### 7.2.2.2.7.2.1. LG München I, Beschluss vom 20.07.2011<sup>1088</sup>

The LG München acknowledged that LFCs are copyrightable, but stated clearly that not all representations that would be recognized by the public as a certain LFC infringe copyright. They may instead be free utilisations.<sup>1089</sup> The LG München pointed out that only the outer character traits of ‘Pippi’ were copied.<sup>1090</sup> Since the inner characteristics were not represented in the allegedly offending carnival costume, the LFC ‘Pippi’ had not been reproduced. Moreover, the LG München stated that the literary description of the LFC ‘Pippi’ in the books is not so detailed that a certain concrete pictorial representation would necessarily result from it, but leaves ample room for the artists designing costumes.<sup>1091</sup> That means, the court argued that based on the description of ‘Pippi’ in the books, one artist might create a ‘Pippi’ costume looking one way, while another author creates a ‘Pippi’ costume looking another way, although both read the same book. After consulting the photos of the costumes and having read the books in question, one may have objections to the LG München’s decision. ‘Pippi’ is very well described in the eponymous series of books. ‘Pippi’ has a very distinctive appearance and personality. The latter is also mirrored by her style of dress and the way she looks. The key elements of ‘Pippi’s appearance are unambiguously reflected in the costumes that are offered for sale without the copyright holders’ authorization.

Furthermore, one may also disagree with the LG München in respect of the effect as well as the scope of artists’ leeway. Even if an artist adds a few details or makes minor changes to the key elements of ‘Pippi’s appearance, the combination of the basic attire and hair are sufficient for the population to recognize ‘Pippi Longstocking’.

How could authors protect themselves against unauthorized character merchandising, if all courts reasoned as the LG München did? Using the LG München’s approach, the unauthorized production and sale of action figures looking like Marvel heros could not be legally prevented by the creator or other proprietor of the rights in the AFC. Though a LFC’s and AFC’s inner character traits are invaluable as well and contribute to the

<sup>1088</sup> LG München I, Beschluss vom 20.07.2011 – Az: 33 O 14810/11.

<sup>1089</sup> Ibid Rn 42 et seq.

<sup>1090</sup> Ibid Rn 43. The German Federal Supreme Court is of the same opinion. BGH, Urteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178 = BGH GRUR 2014, 258.

<sup>1091</sup> LG München I, Beschluss vom 20.07.2011 – Az: 33 O 14810/11 Rn 38.

The LG München regards ‘Pippi Longstocking’ as nothing more than a red-headed, freckle-faced girl dressing chaotically.

'presence' of a character, the outer characteristics should be regarded as more significant than the personality attributes of the character, as the character's appearance is what makes the character more recognizable to the public. Indeed, 'Pippi' is a widely known LFC that is easily recognized. The LG München did not want to take this into account, though.<sup>1092</sup>

The decision of the LG München is a rare exception. The estate of 'Pippi Longstocking' has generally protected the fictional character 'Pippi' very successfully in Germany, which is verified by a long history of litigation. Previous decisions<sup>1093</sup> and subsequent decisions<sup>1094</sup> disagree with the LG München. They recognized copyright protection of 'Pippi' in situations where only the character's external had been reproduced. However, eventually the Federal Supreme Court also stipulated that both a character's appearance as well as personality attributes must be reproduced.<sup>1095</sup>

#### 7.2.2.2.7.2.2. OLG München, Beschluss vom 10.08.2011<sup>1096</sup>

Hence, it is unsurprising that the decision of the LG München was successfully appealed. The OLG München held that 'Pippi Longstocking' was copyrightable,<sup>1097</sup> and that the plaintiff could legally prevent the defendant from copying and communicating to the public the image of the 'Pippi' carnival costume.<sup>1098</sup> The OLG München reminded the parties of the basic criteria by means of which free utilization is judged. It is the 'inner distance' (*innerer Abstand*) of the later work from the earlier work that determines whether or not the later work, which makes use of the underlying work, is an independent protected work itself. If the individual intellectual creative elements from the pre-existing work pale in the overall view of the new work's creative intellectual individuality, then the author of the new work has dissociated herself from the earlier work and used the earlier work freely. Then, the new work does not infringe copyright

<sup>1092</sup> Ibid Rn 47 et seq.

<sup>1093</sup> LG Berlin, Urteil vom 11.08.2009 – Az: 16 O 752/07 Rn 44 and 51 = LG Berlin ZUM 2010, 69, 70 et seq; LG Hamburg, Beschluss vom 28.04.2009 – Az: 308 O 200/09 Rn 16 = LG Hamburg ZUM 2009, 581, 582.

<sup>1094</sup> OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11 Rn 8 and 13; OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11 Rn 34; OLG Köln, Urteil vom 24.02.2012 – Az: 6 U 176/11 Rn 19.

<sup>1095</sup> See para 7.2.2.2.7.4.3.

<sup>1096</sup> OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11.

<sup>1097</sup> Ibid Rn 22.

<sup>1098</sup> Ibid Rn 24.

in the earlier work.<sup>1099</sup> However, when making this decision, the approach should be more strict, in favour of the existing work, than lenient, in favour of the new work.<sup>1100</sup>

Consequently, the OLG München made it clear that the transfer of some, but not all features from the literary description of the character ‘Pippi’ was sufficient to constitute ‘unfree use’, thereby constituting copyright infringement. In fact, the OLG München stipulated that it was sufficient that only some of the outer characteristics of the LFC were copied (red hair and hair style, freckles, awkward short, self-made dress, two different coloured curled stockings).<sup>1101</sup> It did not even mention the LFC’s inner characteristics.

### 7.2.2.2.7.3. OLG Köln, Urteil vom 14.10.2011<sup>1102</sup>

A decision by the OLG Köln (Higher Regional Court in Cologne), only two months after the OLG München’s decision, followed the same principles as the OLG München (Higher Regional Court in Munich) and the LG Berlin (Regional Court in Berlin). Once again this case concerned an image of a girl in a carnival costume including a wig, which clearly represents ‘Pippi Longstocking’, despite the use of a different name (‘Lilly Kunterbunt’<sup>1103</sup>).

The OLG Köln held as follows:

- a) The LFC ‘Pippi Longstocking’ is copyright protected. A literary work within the meaning of § 2 Nr. 1 UrhG 1965 enjoys copyright not only with regard

<sup>1099</sup> Ibid Rn 26. See also: LG Hamburg, Beschluss vom 28.04.2009 – Az: 308 O 200/09 Rn 9 = LG Hamburg ZUM 2009, 581; Helmut Haberstumpf, ‘Kapitel 10 Urheberrechtsgesetz § 24 UrhG’ in Wolfgang Büscher, Stefan Dittmer and Peter Schiwy (eds), *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht – Kommentar* (2<sup>nd</sup> edn, Carl Heymanns Verlag 2011) § 24 Rn 10; Dinusha Mendis and Martin Kretschmer, ‘The Treatment of Parodies under Copyright Law in Seven Jurisdictions – A Comparative Review of Underlying Principles’ (IPO, 2013/23) 32; Willi Erdmann, ‘Verwendung zeitgenössischer Literatur für Unterrichtszwecke am Beispiel Harry Potter’ (2002) 12 WRP 1329, 1335.

<sup>1100</sup> OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11 Rn 26. See also: LG Hamburg, Beschluss vom 28.04.2009 – Az: 308 O 200/09 Rn 9 = LG Hamburg ZUM 2009, 581; Willi Erdmann, ‘Verwendung zeitgenössischer Literatur für Unterrichtszwecke am Beispiel Harry Potter’ (2002) 12 WRP 1329, 1335.

<sup>1101</sup> OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11 Rn 34.

<sup>1102</sup> OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11.

<sup>1103</sup> The house that Pippi lives in is called ‘Villa Kunterbunt’ in the German translation of the Pippi novels. Hence, this is another hint as to who the picture of the costume represents.

to the text, but also its content. Therefore, particularly creative fictive characters may be copyrighted by themselves, too.<sup>1104</sup>

- b) The fictive character must be a unique combination of outward attributes as well as features, skills and typical mode of behaviour, which make the character a distinct personality.<sup>1105</sup>
- c) The inner character traits of a LFC are naturally not identifiable in the pictorial representation. Regardless, the LFC 'Pippi Longstocking' was illegally copied by the defendant. The 'unfree' utilisation does not require a complete copy. It is sufficient, that some characteristics have been adopted, if these parts of the work show unique and distinct creativity (*schöpferische Eigenart*).<sup>1106</sup>

#### 7.2.2.2.7.4. LG Köln, OLG Köln, and BGH<sup>1107</sup>

##### 7.2.2.2.7.4.1. The LG Köln's decision<sup>1108</sup>

The LG Köln (Regional Court in Cologne) reiterated in another 'Pippi Longstocking case-thread' that a LFC may enjoy copyright abstracted from the underlying work, if

- a) the fictive character originates from the author's imagination and
- b) demonstrates a characteristic and distinct personality.<sup>1109</sup>

The copyright of a LFC may even be infringed, if the verbally described LFC is transferred into a tangible representation of the LFC (in this case: a carnival costume). Whether or not this transfer constitutes free or unfree utilisation of the pre-existing work depends on whether the external attributes and internal character traits are adopted to such an extent that the essence of the fictional character is preserved (i.e. whether the same content is communicated so that the original and the copy are substantially the

<sup>1104</sup> OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11 Rn 8.

<sup>1105</sup> Ibid.

<sup>1106</sup> Ibid Rn 13.

<sup>1107</sup> LG Köln, Urteil vom 10.08.2011 – Az: 28 O 117/11; OLG Köln, Berufungsurteil vom 24.02.2012 – Az: 6 U 176/11; BGH, Revisionsurteil vom 17.07.2013 – Az: I ZR 52/12.

<sup>1108</sup> LG Köln, Urteil vom 10.08.2011 – Az: 28 O 117/11.

<sup>1109</sup> Ibid Rn 16.

same) or whether the character becomes a separate character which shows similarities to the LFC, but can exist independently 'next' to the earlier LFC from which the new LFC has taken inspiration.<sup>1110</sup>

Although the outward appearance of the carnival costume in the contentious advertising prospectus does not coincide completely with the description of the character, the conveyed overall impression and image of the ad picture of the carnival costume represents 'Pippi's inner character traits too,<sup>1111</sup> not just her external.<sup>1112</sup> This is a very interesting point to note and distinguishes the decision of the LG Köln from the decision of the LG Berlin (2009) and OLG Köln (2011). According to the LG Berlin and the OLG Köln, a reproduction of the LFC's external characteristics suffices for copyright infringement.<sup>1113</sup> The LG Köln takes a different approach. It maintains that the external attributes of the LFC 'Pippi' are so unique and well developed that the LFC's inner personality traits are reflected in her appearance (external attributes).<sup>1114</sup>

#### 7.2.2.2.7.4.2. The OLG Köln's decision<sup>1115</sup>

The OLG Köln (Higher Regional Court / Court of Appeal in Cologne) confirmed the decision of the LG Köln (Regional Court in Cologne) on appeal acknowledging that the LFC 'Pippi' is copyright protected.<sup>1116</sup> However, unlike the LG Köln that saw 'Pippi's inner characteristics in her external characteristics, the OLG Köln considered the reproduction of merely a LFC's appearance enough to constitute copyright infringement.<sup>1117</sup> Therefore, the OLG Köln followed the decision of the LG Berlin from 11.08.2009 and the decision of the OLG Köln from 14.10.2011 in that regard.

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<sup>1110</sup> Ibid Rn 20 et seq.

<sup>1111</sup> 'Pippi' is a wild, nonconformist, unconventional, colourful, and spontaneous girl.

<sup>1112</sup> LG Köln, Urteil vom 10.08.2011 – Az: 28 O 117/11 Rn 23 et seq.

<sup>1113</sup> LG Berlin, Urteil vom 11.08.2009 – Az: 16 O 752/07 Rn 51 = LG Berlin ZUM 2010, 69, 71; OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11 Rn 13.

<sup>1114</sup> LG Köln, Urteil vom 10.08.2011 – Az: 28 O 117/11 Rn 23 et seq.

<sup>1115</sup> OLG Köln, Urteil vom 24.02.2012 – Az: 6 U 176/11.

<sup>1116</sup> Ibid Rn 10.

<sup>1117</sup> Ibid Rn 19.

#### 7.2.2.2.7.4.3. The BGH's decision<sup>1118</sup>

The BGH (Federal Supreme Court) reversed the OLG Köln's decision. The BGH conceded that LFCs are copyrightable in principle, and that 'Pippi's internal and external qualities are so unique that they are copyright protected.'<sup>1119</sup> However, the BGH held that in this particular case there was no copyright infringement. The defendant, who advertised the sale of carnival costumes, had merely copied some of 'Pippi's external characteristics (not all external characteristics, and no internal attributes). That was insufficient to constitute copyright infringement.<sup>1120</sup>

The BGH justifies this by explaining that the mere outward attributes of a character do not constitute copyright in the figure.<sup>1121</sup> This view is debatable. It is submitted that the BGH misapplied the basic principles of free utilization. Whether the later work based on the earlier work is an infringing copy or whether it has sufficient inner distance to be copyright protected itself, determines the legality or illegality of the later work. If the individual intellectual creative elements from the pre-existing work pale in the overall view of the new work's creative intellectual individuality, then the author of the new work used the earlier work freely and does not infringe copyright in the earlier work.<sup>1122</sup> That means, that the copyright in the earlier work can even then be infringed when only part of the earlier work is copied depending on how unique and prominent this part is in the later work.<sup>1123</sup> Hence, if a character's features - be that only external attributes, only internal attributes, or both - clearly stand out in the new work, then the later work infringes the earlier work. Due to the principles of free utilisation, it is also slightly objected here to the BGH's opinion that it is irrelevant in that regard whether or not the

<sup>1118</sup> BGH, Urteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178.

<sup>1119</sup> Ibid 180 et seq Rn 24 -30.

<sup>1120</sup> BGH, Revisionsurteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178, 182 Rn 44 = BGH GRUR 2014, 258, 262 Rn 44.

<sup>1121</sup> BGH, Urteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178, 182 Rn 44 = BGH GRUR 2014, 258, 262 Rn 44.

<sup>1122</sup> OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11 Rn 26. See also: LG Hamburg, Beschluss vom 28.04.2009 – Az: 308 O 200/09 Rn 9 = LG Hamburg ZUM 2009, 581; LG Berlin ZUM 2003, 60, 61; Helmut Haberstumpf, 'Kapitel 10 Urheberrechtsgesetz § 24 UrhG' in Wolfgang Büscher, Stefan Dittmer and Peter Schiwy (eds), *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht – Kommentar* (2<sup>nd</sup> edn, Carl Heymanns Verlag 2011) § 24 Rn 10; Willi Erdmann, 'Verwendung zeitgenössischer Literatur für Unterrichtszwecke am Beispiel Harry Potter' (2002) 12 WRP 1329, 1335.

<sup>1123</sup> This is derived from the fact that the less individual the replicated elements are, the easier these will pale in the overall view. OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11 Rn 12; BGH NJW 1960, 573, 574; OLG Hamburg GRUR-RR 2004, 285, 287.



public recognizes the LFC in the later work.<sup>1124</sup> This thesis asserts that the recognition value is relevant to some extent, because if the public still recognizes the LFC from the earlier work in the later work, then the copied elements from the pre-existing work have not paled in the later work.

### 7.2.3. Character merchandising

Many cases, including the above ‘Pippi Langstrumpf’ cases,<sup>1125</sup> prove that AFCs and LFCs are not only protected by copyright against reproduction in artistic or text format. Copyright also protects fictional characters against unauthorized character merchandise. This can be in two-dimensional as well as three-dimensional form. LFCs are treated the same as AFCs. LFCs’ attributes are just a bit more challenging to extract from the literary work.

#### 7.2.3.1. AFCs

##### 7.2.3.1.1. ‘Bill the dog’ case<sup>1126</sup>

The Belgian artist J. R. had transferred his rights of use in the comic character named ‘Bill’ to the claimant in 1985. The defendant manufactured, distributed and sold coin banks shaped like a dog. The claimant was of the opinion that the defendant had infringed copyright in the character ‘Bill the dog’. The LG Bielefeld (Regional Court in Bielefeld) decided in favour of the claimant. The OLG Hamm (Court of Appeal in Hamm) agreed. However, the OLG’s decision was successfully appealed at the BGH (Federal Supreme Court) by the defendant. Although the BGH allowed the appeal, it confirmed that:

- a) the character ‘Bill’ enjoys copyright,
- b) in all possible poses,

<sup>1124</sup> BGH, Urteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178, 182 Rn 44 = BGH GRUR 2014, 258, 262 Rn 44.

<sup>1125</sup> See para 7.2.2.2.7.

<sup>1126</sup> BGH, Urteil vom 08.07.2004 – Az: I ZR 25/02 Rn 10; BGHZ 532, 1.

- c) in principle, the coin bank could be a reproduction of the AFC 'Bill', and that
- d) the individual attributes of the AFC must be considered as well as the overall picture of the AFC.<sup>1127</sup>

However, the Federal Supreme Court pointed out that, it was not sufficient to consider merely the individual creative elements of the AFC, the overall impression, as well as compare all this to the 3D object. The Court of Appeal should also have considered the commonplace elements of the AFC 'Bill' in more detail. The Federal Supreme Court also found that the Court of Appeal had failed to reflect on the defendant's argument that 'Bill' itself was already an infringing reproduction of 'Idéfix'. In addition to comparing the coin bank to 'Bill', the Court of Appeal should also have compared 'Bill' to 'Idéfix'.<sup>1128</sup>

#### 7.2.3.1.2. 'Hippo Azul' case<sup>1129</sup>

In another case, the claimant was an artist, who had created a blue humanoid hippopotamus naming it 'Hippo Azul'. The claimant was marketing his AFC (including other animal characters). When the artist of 'Hippo Azul' realised that the defendant manufactured and sold collectible blue hippo figurines under the name 'Happy Hippos' in their chocolate Surprise Egg (Kinder *Überraschungsei*), he sued the confectionery manufacturer for copyright infringement. The claimant lost. The court held that the defendant had not infringed copyright by producing and selling the 'Happy Hippos', because the hippos had no relevant attributes in common.<sup>1130</sup> The mere idea of blue hippos is in the public domain. Hence, the 'Happy Hippos' of the defendant were held not to be a reproduction of the claimant's 'Hippo Azul'. Although the claimant lost the case, this case is nevertheless relevant under this heading. The court had at least considered whether the defendant had made a 3D reproduction of the 2D drawing of an AFC. The outcome of the case itself is irrelevant. If the 'Happy Hippos' had attributes identical or similar to attributes of 'Hippo Azul', then the 'Happy Hippos' would have

<sup>1127</sup> Ibid 7; D W, 'Case Comment, Germany: Copyright Act, Secs 2(2), 23, 24, 97 – "dog character" (Hundefigur)' (2005) 36 IIC 871, 872.

<sup>1128</sup> BGH, Urteil vom 08.07.2004 – Az: I ZR 25/02 = BGHZ 532, 1, 9.

<sup>1129</sup> OLG Karlsruhe ZUM 2000, 327.

<sup>1130</sup> Ibid 330.

been a reproduction of the ‘Hippo Azul’ drawings and the manufacturer of the Kinder eggs (defendant) would have infringed the artist’s (claimant’s) copyright.

### 7.2.3.2. LFCs

For cases concerning LFCs that were subjected to unauthorized character merchandising, it is here referred to the ‘Pippi Longstocking’ cases.<sup>1131</sup>

Moreover, the Federal Supreme Court had already stipulated in 1959 that the author of a fictive figure has copyright in the character.<sup>1132</sup> The BGH also stated that this gives the author the right to prohibit others to copy, exploit commercially and *replicate* the fictional character. It is extraneous whether the reproduction is made three-dimensional (e.g. as a figurine) or two-dimensional (a drawing) and whether the entire product (e.g. a doll) is a reproduction or only part of the product (e.g. a plastic figure stuck on top of a pencil). It is the author’s right to license these rights to others.<sup>1133</sup>

### 7.2.4. Moral rights

Since copyright may vest in LFCs, as has been established above, the author of a LFC may rely on economic as well as moral rights. This section is devoted to the moral rights.

Germany has adopted a monist approach to authors’ rights, meaning that both the economic and the moral rights are protected by an inseparable, unitary author’s right.<sup>1134</sup> This means that the provisions which primarily protect the author’s economic rights may also protect the author’s moral rights, and may even be used solely for the protection of the author’s non-economic rights, because the root of the economic rights

<sup>1131</sup> See para 7.2.2.2.7.

<sup>1132</sup> BGH, Urteil vom 09.10.1959 – Az: I ZR 78/58 in NJW 1960, 37, 38.

<sup>1133</sup> Ibid 38 et seq.

<sup>1134</sup> Mira T Sundara Rajan, ‘Moral rights or economic rights?’ in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 216; Volker Jänich, *Geistiges Eigentum – eine Komplementärscheinung zum Sacheigentum?* (Mohr Siebeck 2002) 108. § 11 UrhG 1965 states: ‘Copyright protects the author in his intellectual and personal relationship to the work and in the exploitation of the work.’

is the general right of personality.<sup>1135</sup> The same applies the other way round. Those provisions which primarily protect the author's personal and intellectual interests (moral rights) may also protect the author's commercial interests (economic rights), and may even be used for the purpose of protecting the author's financial interests alone.<sup>1136</sup>

Furthermore, the German UrhG 1965 offers authors a higher number of moral rights than the Berne Convention 1886. The UrhG 1965 as well as the Berne Convention 1886 cover the paternity right<sup>1137</sup> and the integrity right.<sup>1138</sup> Beyond the scope of the Berne Convention 1886, the German UrhG 1965 grants authors the right of disclosure,<sup>1139</sup> the right to access the original of the work,<sup>1140</sup> the right against alteration of the work, its title or the given or assumed name of its author,<sup>1141</sup> and the right to withdraw a work, if the author has changed her way of thinking.<sup>1142</sup> LFCs and their authors may benefit from all these in addition to the commercial rights of exploitation.

### 7.3. France

Having critically evaluated copyright protection of LFCs in Germany, this thesis will now critically evaluate copyright protection of LFCs in France. This part of the chapter will show *that* LFCs are protected by copyright in France, *how* they are covered, and *what* the differences are between the French Code de la propriété intellectuelle (CPI) 1992 and the UK CDPA 1988. This will provide valuable information for the evaluation of how the CDPA 1988 could accommodate copyright protection of LFCs.

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<sup>1135</sup> Volker Jänich, *Geistiges Eigentum – eine Komplementärscheinung zum Sacheigentum?* (Mohr Siebeck 2002) 109.

<sup>1136</sup> Andreas Ebert-Weidenfeller, 'Germany' in Dennis Campbell (ed), *World Intellectual Property Rights and Remedies Laws with Commentary*, Vol 1, §18:26 (R 7/2015); Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 221 et seqq and 246 et seq; Gerda Müller, 'Der Schutzbereich des Persönlichkeitsrechts im Zivilrecht' *VersR* 2008, 1141, 1149.

<sup>1137</sup> § 13 UrhG 1965; Berne Convention 1886, art 6bis(1).

<sup>1138</sup> § 14 UrhG 1965; Berne Convention 1886, art 6bis(1).

<sup>1139</sup> § 12 UrhG 1965.

<sup>1140</sup> § 25 UrhG 1965.

<sup>1141</sup> § 39 UrhG 1965.

<sup>1142</sup> § 42 UrhG 1965.

### 7.3.1. General principles of copyright protection

#### 7.3.1.1. Work of the mind

Article L111-1 of the CPI 1992 stipulates the author of a work of the mind shall enjoy in that work, by the mere fact of its creation, an exclusive incorporeal property right - meaning copyright - enforceable against all. Article L111-2 CPI 1992 adds that a work shall be considered created, irrespective of any public disclosure, by the mere fact of the realization, i.e. the author's creative act. No administrative formalities are required.

The CPI 1992 does not define what a work of the mind (*'œuvre l'esprit'*) is, just like the CDPA 1988 does not define the term 'work'. However, CDPA 1988 ss 1, 3-8 specify categories of works that are protected by copyright, if the other copyright criteria are fulfilled. The CPI 1992 too provides a list of categories in Article L112-2. It is a non-exhaustive list, as the words 'notamment comme' make clear.<sup>1143</sup> This is emphasised by Article L112-1 CPI 1992 which states that the provisions of the CPI 1992 shall protect the rights of authors in *all* works of the mind, *whatever* their kind, form of expression, merit or purpose.<sup>1144</sup> Hence, the CPI 1992 does not attempt to restrict creativity and creations to narrow groups of works leaving no room for new types of creations that might otherwise attract copyright protection. Hence, fictional characters are capable of copyright protection too.<sup>1145</sup> Indeed, despite the conceivable option to protect a LFC character as a literary work or part of a literary work, LFCs are not categorised as either. Fictional characters are instead regarded as an entity in themselves and copyright protected as such in France.<sup>1146</sup>

<sup>1143</sup> Article L112-2 CPI 1992: 'Sont considérées *notamment comme* œuvres de l'esprit au sens du présent code:' (emphasis added). Notamment = especially, notamment comme = such as.

<sup>1144</sup> Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 75; Kathie D Claret, 'France' in Dennis Campbell (ed), *World Intellectual Property Rights and Remedies – Laws with Commentary*, Vol 1, § 17:26 (R 5/2013); Caroline Carreau, 'Mérite et droit d'auteur' (1981) 109 RIDA 3, 10.

<sup>1145</sup> *de Villiers et Sté GECEP c Soton*, Cass, 1<sup>ère</sup> ch civ, 5 mai 1993, (1993) 158 RIDA 205, 206 (The court reviewed whether de Villiers' LFC had enough substance to be original.); *Sté RSCG c Marceau et Baronnie*, CA Versailles, 1<sup>ère</sup> ch, 9 juillet 1992, (1993) 158 RIDA 208, 211 et seqq; *Sté Gaumont and Luc Besson c Sté Publicis Conseil and Sté Française du Radiotéléphone*, CA Paris, 4<sup>ème</sup> ch, 8 sept 2004 [8]; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 176.

<sup>1146</sup> *Sté Gaumont and Luc Besson c Sté Publicis Conseil and Sté Française du Radiotéléphone*, CA Paris, 4<sup>ème</sup> ch, 8 sept 2004 [8]; *Sté Edgar Rice Burroughs Inc c Sté d'Achat Moderne Samond*, TGI Paris, 21 janvier 1977, (1978) 95 RIDA 179, 180; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 200.

### 7.3.1.2. Record of a work - Ideas and their expression

Moreover, like in Germany, but unlike in the UK where a work needs to be fixed in some way in order to benefit from copyright protection,<sup>1147</sup> there is no such requirement under French IP law.<sup>1148</sup> Like recorded works, unrecorded works must be original.<sup>1149</sup> The UK requirement that a work must be recorded in order to be eligible for UK copyright protection reflects the fact that the CDPA 1988 is directed at the expression of ideas instead of the idea itself. However in France, the same principle applies, although fixation is not required. French copyright law does not protect ideas either, but the expression of ideas.<sup>1150</sup> Therefore, there must be sufficient evidence that a work exists, though it is not recorded - which makes proving that a work has been infringed more difficult - and that it has the character of a work.<sup>1151</sup> Regardless, works of the mind do not need to be recorded in order to enjoy copyright under the CPI 1992. The absence of such a corresponding rule in the French CPI 1992 renders it unsurprising that something slightly 'ethereal' like LFCs are covered by copyright in France. The term 'ethereal' has been chosen here in reference to LFCs, because a LFC is not always straightforward. A LFC is described throughout a book or series of books not merely e.g. from a third person vantage point, but is also defined by the words that the author puts into the LFC's mouth and the acts the author has her LFC perform, and development a LFC may go through. That makes it difficult to distinguish between the idea of a LFC and the expression of a LFC. A LFC can be courageous without that being written down explicitly in the book. It may be apparent from the LFC's behaviour. By setting down in a book what a LFC does and thinks, the LFC is expressed. For copyright to vest in any work the creator must be able to demonstrate

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<sup>1147</sup> CDPA 1988 s 3(2).

<sup>1148</sup> Iona Silverman, 'Copyright and fashion: friends at last?' (2013) EIPR 637, 640.

<sup>1149</sup> *Lopez c Philibert*, Cass, 1ère ch civ, 13 nov 2008, (2009) 220 RIDA 404, 408; André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][a] (Pub 399, Rel 28-12/2016); André Lucas, 'Case Comment France: Intellectual Property Codes art.L.113-7, art.L.122-2-2, art.L.212-2 "Être et Avoir (To Be and to Have)"' (2010) 41 IIC 101, 102; Amélie Blocman, 'France: The Rights of the Central Figure in a Documentary' (*IRIS Légipresse*, 2004) <<http://merlin.obs.coe.int/iris/2004/10/article22.en.html>> accessed 13 October 2015. The general originality requirement is mentioned in Article L112-3 CPI 1992 in relation to derivative works and Article L112-4 CPI 1992 regarding titles.

<sup>1150</sup> André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b][i] (Pub 399, Rel 28-12/2016).

<sup>1151</sup> *Ibid* § 2[1][a].

more than just time spent and labour invested in the creation of the work, but more importantly, personal creativity.<sup>1152</sup>

### 7.3.1.3. The subjectivity of originality

It is maintained in *International Copyright Law and Practice*, Vol 1 that the principle that ‘courts must refrain from assessing the merits of works ... notably prevents courts from subjecting protection to the aesthetic evaluation of a work. There would be no legal certainty if copyright turned on the subjective views of a judge.’<sup>1153</sup> Judges should not be able to refuse copyright protection to a work just because, e.g. it advocates the questionable views of its creator. In France, a character is protectable separately from the underlying work in which the character ‘lives’. To be protected, the fictional character has to be original, and it must have an independent identity emanating from the character’s name, physical appearance, speech, and/or its ‘private life’.<sup>1154</sup> These criteria appear objective enough. However, the originality requirement itself may be a source of subjectivity. Originality arises when the author exercises her creative choice during the process of creating the work and the work was thereby imprinted with the author’s personality. The author must have left her personal ‘imprint’/‘signature’ in the work.<sup>1155</sup> When a judge considers creativity, can this not also be regarded as a value

<sup>1152</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 177; Eleonora Rosati, ‘Originality in US and UK copyright experiences as a springboard for an EU-wide reform debate’ (2010) 41 IIC 524, 531.

<sup>1153</sup> André Lucas, Pascal Kamina and Robert Plaisant, ‘France’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b][iii][C] (Pub 399, Rel 28-12/2016); Caroline Carreau, ‘Mérite et droit d’auteur’ (1981) 109 RIDA 3, 8.

<sup>1154</sup> *Gosciny v Uderzo*, Cass, 1ère ch civ, 6 juil 2000, note by André Kéréver in (1996) 169 RIDA 197, 220. Although this case concerned AFCs, the judgment makes clear that the same criteria apply to LFCs. André Kéréver states explicitly:

the judgment confirms that a “character” in stories or fictional adventures constitutes an autonomous work which is copyrightable in itself to the extent that the character is sufficiently characterized by his, her or its “look”, speech and personality. The work formed by the “character” is endowed with a life of its own: it is separable and distinguishable from the *literary* or artistic works, which through novels, films or cartoons, recount the character’s adventures. (emphasise added)

JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 273 et seq; Patrick Martowicz, ‘France’ in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 121; Jacques Mazaltov, ‘France’ in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 269; Marina Ristich de Groote, ‘Les personnages des œuvres de l’esprit’ (1986) 130 RIDA 19, 22.

<sup>1155</sup> *Lemaitre c Société Guerlain*, CA Paris, 4ème ch, s A, 11 juin 1997 [9]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 76; André Lucas, Pascal Kamina and Robert Plaisant, ‘France’ in Lionel Bently (ed), *International Copyright Law and Practice*,

judgment strictly speaking? Even so, a reasonable degree of objectivity and homogeneity are ensured, because the courts' decision-making process must follow some guiding principles. The more an author copies directly or indirectly from a pre-existing work, the less original the work of the later author is. However, for example where a painter or sculptor adds something to an earlier work, it is sufficient that the new work is not a near-copy of the pre-existing work to find the new work original.<sup>1156</sup> The most important factor for originality is that the work is an intellectual contribution.<sup>1157</sup> This should be clear from Article L111-1 CPI 1992 which grants copyright to '*œuvre l'esprit*' by the mere fact of its creation. Originality will generally only then be an issue in cases concerning factual (scientific and technical) works. Although the author's personality may also be reflected by works of that kind, the author's self-expression is not presumed.<sup>1158</sup> In other cases, a court may often simply assume originality of an elaborate work, such as a literary work, and will do so especially where a work of literary fiction is concerned. Occasionally, the court may ask the plaintiff to prove the originality of each work that was allegedly infringed.<sup>1159</sup> That will commonly not be necessary though, unless the defendant disputes the originality of the plaintiff's work.<sup>1160</sup>

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Vol 1, § 2[1][b][iii][A] (Pub 399, Rel 28-12/2016); JAL Sterling and Estelle Derclaye, 'Protection Criteria' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 348; Eleonora Rosati, 'Originality in US and UK copyright experiences as a springboard for an EU-wide reform debate' (2010) 41 IIC 524, 531; Daniel J Gervais, 'Feist goes global: A comparative analysis of the notion of originality in copyright law' (2002) 49 J Copyright Soc'y USA 949, 968; André Lucas and Pierre Sirinelli, 'L'originalité en droit d'auteur' (1993) 23 La Semaine Juridique - Edition générale I 3681.

<sup>1156</sup> *Gieules c Sagne*, Cass, 1<sup>ère</sup> ch civ, 9 nov 1993, (1994) 161 RIDA 272; André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b][iii][A] (Pub 399, Rel 28-12/2016).

<sup>1157</sup> *CCH Canadian Ltd v Law Society of Upper Canada*, (2004) SCC 13 [20], [2004] 1 RCS 339, 354.

<sup>1158</sup> André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b][iii][A] (Pub 399, Rel 28-12/2016).

<sup>1159</sup> *R c Legendre*, Cass, ch crim, 4 nov 2008 [4]; André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b][iii] (Pub 399, Rel 28-12/2016).

<sup>1160</sup> André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b][iii][A] (Pub 399, Rel 28-12/2016).



## 7.3.2. Specific principles of copyright protection of LFCs

### 7.3.2.1. Name

Article L112-4 CPI 1992 stipulates that titles may be protected by copyright, if they are original. Moreover, even after expiry of copyright, no person may use the title to individualise a work of the same kind under conditions that are likely to cause confusion.<sup>1161</sup> Names are indirectly protected by this provision, because the name of a character may be used as a title, such as *Angélique*.<sup>1162</sup> Another example is, the name of the character ‘Chéri-Bibi’, which was granted copyright protection as early as 2 March 1959 by the TGI Seine.<sup>1163</sup> Hence, the author may even use her copyright in the name of the character to annul the registration of the character’s name as a trade mark by a third party.<sup>1164</sup>

The close relationship between some titles and LFCs is also demonstrated in the Paris Cour d’Appel’s decision on *Les Fantômes de la Comtesse Alexandra*<sup>1165</sup> by Gérard de Villiers. It was held that the author of a LFC which is central to a series of books may, depending on the facts of the case, have copyright in the title common to the series. In this particular case, the title was held to be original, because it contained elements that were material for the identification of the central LFC.<sup>1166</sup> Further, de Villiers’ LFC (la ‘Comtesse Alexandra’) was also held to be protected by copyright. The Cour d’Appel pronounced that the defendant had to pay royalties to the plaintiff for the

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<sup>1161</sup> Interestingly, the wording of Article L112-4 CPI 1992, which concerns copyright of titles, borrows from trade mark law.

<sup>1162</sup> *Sarl Colmax c Sarl Archange International*, CA Versailles, 12ème ch, s 2, 11 janv 2001 [10] et seq; André Lucas, Pascal Kamina and Robert Plaisant, ‘France’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][a] (Pub 399, Rel 28-12/2016); Heijo E Ruijsenaars, ‘Ein urheberrechtlicher Streifzug – Teil 1: Zum Schutz von Comic-Figuren’ (1993) GRUR Int 811, 3; Marina Ristich de Groote, ‘Les personnages des œuvres de l’esprit’ (1986) 130 RIDA 19, 26.

<sup>1163</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 176; Emmanuel Pierrat, ‘Le droit des personnages: pas si élémentaire’ (*Livres Hebdo, Chronique Juridique*, February 2014) <<http://www.livreshebdo.fr/article/le-droit-des-personnages-pas-si-elementaire>> accessed 23 June 2016.

<sup>1164</sup> *Sarl Procidis c Sieur Glattauer*, CA Paris, 4e ch, 26 avril 1977, (1978) 95 RIDA 131, 135 et seq; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 176; Jacques Mazaltov, ‘France’ in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 270.

<sup>1165</sup> *de Villiers et Sté GECEP c Soton*, Cass, 1ère ch civ, 5 mai 1993, (1993) 158 RIDA 205.

<sup>1166</sup> The title of the novel “The Godfather”, on the other hand, was not considered original enough to be protected under copyright, because it did not contain elements that were material for the identification of the central LFC. International Bureau, ‘Character Merchandising’ (WO/INF/108, 1994) Annex I, 2 <[http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo\\_inf\\_108.pdf](http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo_inf_108.pdf)> accessed 20 September 2012.

use of Villiers' LFC in a third party work.<sup>1167</sup> However, the Cour de Cassation overturned the judgment of the Cour d'Appel with regard to the LFC. It held that, although LFCs can be copyrightable in principle, the LFC was not protected by copyright in this particular novel. The court said that the LFC was not original, because the LFC was not sufficiently consistent with its previous description in prior books of the same series.<sup>1168</sup>

That also means that LFCs can be protected by copyright, and also that this particular character ('Comtesse Alexandra') was protected by copyright. However, only the LFC 'Comtesse Alexandra' of the books prior to the case decided by the Cour de Cassation is copyrighted. That means, if a LFC changes<sup>1169</sup> over the course of a series and is less well described in the newer works, the LFC risks losing its copyright. This thesis asserts that when assessing the copyrightability of a LFC, which features in a whole series of books, the description of the LFC in the whole series should be considered. It is natural that LFCs may develop throughout a series of books just like humans develop throughout their lives. The Cour de Cassation made a very good point though by holding that the LFC in a particular, more recent volume, was not copyrighted, because the LFC had changed too much and was as a result like a new LFC, and that this new description of the LFC was not original (unlike the LFC had been in previous volumes).

Not only the names of LFCs, but also the names of AFCs were held to be '*pures creations originales*' (pure original creations) and as such copyright protected. For example, the names 'Astérix', 'Obélix', 'Idéfix' and other character names from comics by Goscinny and Uderzo were protected by copyright against the use in a restaurant for the description of pancakes.<sup>1170</sup> In addition to copyright infringement, the Cour

<sup>1167</sup> *de Villiers c Soton*, CA Paris, 1ère ch, 18 dec 1990.

<sup>1168</sup> *de Villiers et Sté GECEP c Soton*, Cass, 1ère ch civ, 5 mai 1993, (1993) 158 RIDA 205, 206 et seq; André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[4][a] and [b] (Pub 399, Rel 28-12/2016).

<sup>1169</sup> A LFC may change in many ways. For example, the LFC may have a severe accident that leaves the LFC mutilated. The LFC may grow bitter as a result. That means, the LFC's appearance as well as personality have changed. If the LFC then is not portrayed very well, the changed LFC does not attract copyright.

<sup>1170</sup> *Sarl Saint Barth c Sarl Éditions Albert René*, CA d'Aix en Provence, 2° ch, 4 sept 2006 [401-5] (confirming the judgment of the TGI de Grasse of 10 June 2004). This case seems to be an exception, because the names 'Astérix' and 'Obélix' have been components of the titles of the comics, whereas the

d'Appel also confirmed trade mark infringement and ruled that the defendant's acts also constituted unfair competition.

### 7.3.2.2. Character criteria

The following sections will expand on the criteria that are taken into account when considering the copyrightability of a fictional character.

#### 7.3.2.2.1. Physical likeness

Courts pay particular attention to the originality of the character's physical appearance (physical attributes and clothes). In a case concerning the Walt Disney Productions character 'Donald Duck', the Parisian Cour d'Appel scrutinised the differences between 'Donald Duck' and a real duck. Moreover, the characteristics of 'Donald' by itself, that is i.a. his beak, arms, and eyes, were examined in order to find whether this fictional character was original.<sup>1171</sup>

In *Sté Edgar Rice Burroughs Inc c Sté d'Achat Moderne Samond*, the physical characteristics of a LFC were decisive. This case involved an advertisement which made use of a photograph displaying a man wearing merely leopardskin shorts and a lightly clad woman accompanied by a monkey. The physical appearance of the characters, their appearance as a group, and the environment in which they were depicted (monkey, tropical fruit) convinced the Tribunal de Grande Instance de Paris that the image represented the LFC 'Tarzan' and his family, namely 'Jane' and 'Cheeta'. These LFCs were protected by copyright.<sup>1172</sup> Hence, the advertisers needed authorization from the creator of 'Tarzan', Edgar Rice Burroughs.

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names of the other characters were never part of the comics' titles. Even so, the names of these AFCs were held to be copyrightable in this case, too.

<sup>1171</sup> *Walt Disney c X*, Cour d'Appel de Paris, 4e ch, 15 oct 1964 [214] et seq; Jacques Mazaltov, 'France' in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 270; Marina Ristich de Groote, 'Les personnages des œuvres de l'esprit' (1986) 130 RIDA 19, 24.

<sup>1172</sup> *Sté Edgar Rice Burroughs Inc c Sté d'Achat Moderne Samond*, TGI Paris, 21 janvier 1977, (1978) 95 RIDA 179, 180; Jacques Mazaltov, 'France' in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 270.

### 7.3.2.2.2. The nature of the character

In addition to the name and physical appearance of the character, the courts examine the nature of the character. That is the identity, the personality of the fictional character, e.g. whether the character is rather for children or adults, whether it is kind or malicious, etc. ‘Donald Duck’s personality and psychology as well as that of its copy underwent examination by the court in the previously mentioned case in order to decide whether there was copyright infringement.<sup>1173</sup>

In another case, ‘Tintin’ was represented out of character in a theatre play by a party other than the author. To be more specific, he was presented as a person absolutely unable to do anything efficiently instead of his usual imaginative and creative self, fighting adversity.<sup>1174</sup> This constituted an infringement of the moral right of integrity.<sup>1175</sup> Hence, if the court finds that a character is original, then this fictional character is protected against unauthorized copying even when the copy is not an exact copy. A LFC deviates from the original, for example, when the copy portrays the fictive character with a behaviour that is unlike its normal attitude.<sup>1176</sup>

The personality of a fictional character is a fundamental factor in the decision whether the way in which a fictive character is commercially exploited is or is not prejudicial to the name and fame of the character.<sup>1177</sup>

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<sup>1173</sup> ‘Donald’ was described as a sarcastic, irascible coward and a boaster. *Walt Disney c X*, Cour d’Appel de Paris, 4e ch, 15 oct 1964 [215]; Jacques Mazaltov, ‘France’ in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 271.

<sup>1174</sup> *Wolf c Hergé*, CA Paris, 20 décembre 1990, (1992) 151 RIDA 295, 296 et seq; *Hergé c Wolf*, TGI Paris, 1<sup>re</sup> ch, 11 mai 1988, (1989) 142 RIDA 344, 346; Jacques Mazaltov, ‘France’ in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 271.

<sup>1175</sup> *Wolf c Hergé*, CA Paris, 20 déc 1990 (1992) 151 RIDA 295, 297; JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 273 et seq.

<sup>1176</sup> Jacques Mazaltov, ‘France’ in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 271.

<sup>1177</sup> *Ibid* 272.

### 7.3.2.3. Equal criteria for AFCs and LFCs

Like German courts, French courts do not distinguish between AFCs and LFCs. That means, both are treated equally, according to the same principles. Furthermore, it is notable that not only the visual appearance of characters, as would be expected for AFCs, is compared when establishing whether one character is a reproduction of the other. The personality of the character and the manner the AFC displays are relevant too.<sup>1178</sup> For example, ‘Tintin’s inner character traits of this AFC were considered in *Wolf v Hergé*.<sup>1179</sup> That makes sense though, because the AFC was used in a theatre production. The AFC was therefore represented by actors instead of drawings. Moreover, the case concerned the integrity right, meaning for this case, whether or not the character ‘Tintin’ was denatured and the reputation of Hergé (Georges Remi) was negatively affected.<sup>1180</sup>

In *Goscinnny v Uderzo* the personality traits of the cartoon character ‘Astérix’ were taken into consideration by the court as well,<sup>1181</sup> although it would have been simple enough to hold for copyright infringement by simply comparing the outward appearance of the AFC. In fact, the same character was used by the defendant. The defendant, Albert Uderzo, was the co-author of the *Astérix* comic book series. Albert Uderzo and René Goscinny had co-authored several comic books featuring the Gaul ‘Astérix’. Uderzo was the illustrator while Goscinny was the comic editor and writer. Uderzo created new ‘Astérix’ adventures making use of the co-authored characters after Goscinny’s death without the consent of Goscinny’s daughter and heiress Anne, but with the consent of Goscinny’s late wife, heiress and mother of Anne.

The equal treatment of AFCs and LFCs is also confirmed by *Mediafusion v Sorayama*.<sup>1182</sup> The court decided in this case that the design of a female robot with

<sup>1178</sup> Heijo E Ruijsenaars, ‘Ein urheberrechtlicher Streifzug – Teil 1: Zum Schutz von Comic-Figuren’ (1993) GRUR Int 811, iv.

<sup>1179</sup> *Wolf c Hergé*, CA Paris, 20 déc 1990 (1992) 151 RIDA 295, 296 et seq; *Hergé c Wolf*, TGI Paris, 1<sup>re</sup> ch, 11 mai 1988, (1989) 142 RIDA 344, 346 et seq.

<sup>1180</sup> *Wolf c Hergé*, CA Paris, 20 déc 1990, (1992) 151 RIDA 295, 297; *Hergé c Wolf*, TGI Paris, 1<sup>re</sup> ch, 11 mai 1988, (1989) 142 RIDA 344, 347; Heijo E Ruijsenaars, ‘Ein urheberrechtlicher Streifzug – Teil 1: Zum Schutz von Comic-Figuren’ (1993) GRUR Int 811, iv.

<sup>1181</sup> *Goscinnny v Uderzo*, Cour d’appel de Paris, 4e ch B, 19 septembre 1997; Cass, 1<sup>ère</sup> ch civ, 6 juil 2000 dismissing the appeal against the decision of the Cour d’Appel, note by André Kéréver in (1996) 169 RIDA 197, 216-222; JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 273 et seq.

<sup>1182</sup> *Sté Mediafusion c Sorayama*, CA Paris, 4e ch, 11 octobre 1995, (1996) 168 RIDA 320.

human characteristics showed its personality through its facial expression and dress and was therefore protected.<sup>1183</sup> This case makes it very clear that types of characters other than LFCs must also be evaluated according to more than just their visual characteristics. If a character can be perceived visually, that makes it easier though to compare the character and grant copyright protection. Moreover, it is also easier to perceive the inner attributes of a character by their outward appearance. It makes a difference to the reader as well as the courts which have to compare the LFC to another whether the author merely described a LFC as scruffy in that one word, or whether the author depicts the LFC as scruffy by describing the LFC's clothes as dirty and torn, the hair as unkempt, the shoe laces undone, etc. A picture of how the LFC looks is manifested/created much easier by the description of the LFCs appearance. The LFC can be compared to another character quicker by reference to the LFC's physical appearance, especially since being scruffy can be different from one LFC to another.

#### 7.3.2.4. Copyright protection of characters via moral rights

A character naturally enjoys economic as well as moral rights in France.<sup>1184</sup> Interestingly, the majority of the discovered copyright cases concerning fictional characters granted copyright protection via the moral rights. For example, 'Tintin' was protected by the Cour d' Appel in 1990 against the presentation of 'Tintin' with abnormal behaviour in a theatre play instead of being his usual clever self.<sup>1185</sup> The primary criterion is whether the exploitation of the fictional character affects its reputation negatively.<sup>1186</sup> The court held that the moral right of integrity of the character 'Tintin' was infringed by changing the image of the character in the mind of the

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<sup>1183</sup> Ibid 322; JAL Sterling, Michael Hart and Emily Riddle, 'Subject Matter of Protection' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 274.

<sup>1184</sup> See *Chaplin c Chatelus* where the successors to the image rights of the film character Charlie Chaplin were granted damages for infringement of economic as well as moral rights. The well-known image of Charlie Chaplin with his usual attire (bowler hat and cane) and his moustache had been used by the owner of a striptease cabaret club on posters outside and inside the club. *Chaplin c Chatelus*, TGI Paris, 3e ch, 24 janvier 2000, (2000) 186 RIDA 305, 308 et seq; JAL Sterling, Michael Hart and Emily Riddle, 'Subject Matter of Protection' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 274.

<sup>1185</sup> *Wolf c Hergé*, CA Paris, 20 déc 1990 (1992) 151 RIDA 295, 297.

<sup>1186</sup> Patrick Martowicz, 'France' in Heijo Ruijsenaars (ed), *Character Merchandising in Europe* (Kluwer 2003) 121.

public<sup>1187</sup> and ‘corrupt[ing] the ethics’ of the work.<sup>1188</sup> In *Goscinny v Uderzo*, it was held too that it infringes the integrity right to place a character in contexts different from that, which the author conceived, without the creator’s (in this case: the widow of the creator’s) authorization,<sup>1189</sup> especially when the character is being devalued by putting it in a different context.<sup>1190</sup> The court in the robot case *Mediafusion v Sorayama* too held that the integrity of the work had been infringed by using a copy of the robot character in advertisements.<sup>1191</sup>

#### 7.3.2.4.1. France - UK

These cases demonstrate that moral rights and authors are accorded more protection by the French judiciary than in the UK. This is also reflected in French legislation. Unlike UK copyright law, French law emphasises the importance of author’s moral rights to control her work and to be identified with her work regardless of who has ownership of the economic rights.<sup>1192</sup> That is already suggested by the statutory arrangement of the moral rights before the economic rights in the CPI 1992.<sup>1193</sup> This is also indicated by the wording of the first Article in the CPI 1992 (Article 111-1), which states explicitly: ‘This right shall include attributes of an intellectual and moral nature as well as attributes of an economic nature, as determined by Books I and III of this

<sup>1187</sup> *Wolf c Hergé*, CA Paris, 20 déc 1990 (1992) 151 RIDA 295, 297; JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 273.

<sup>1188</sup> André Lucas, Pascal Kamina and Robert Plaisant, ‘France’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 7[1][c][i] (Pub 399, Rel 28-12/2016).

<sup>1189</sup> *Goscinny c Uderzo*, Cass, 1<sup>ère</sup> ch civ, 6 juil 2000, note by André Kéréver in (1996) 169 RIDA 197, 220 and 222; JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 273 et seq. The TGI had already held in the ‘Tintin’ case that the reputation of an author may be harmed, if that author’s fictional character is put into a different context in another work: *Hergé c Wolf*, TGI Paris, 1<sup>re</sup> ch, 11 mai 1988, (1989) 142 RIDA 344, 346 et seq.

<sup>1190</sup> *Sarl Colmax c Sarl Archange International*, CA Versailles, 12<sup>ème</sup> ch, s 2, 11 janv 2001 [17]. This case concerned the use of the LFC ‘Angélique’ (written by Simone and Vsevolod Sergeïvich Goloubinoff under the pseudonym Anne and Serge Golon) in a pornographic video as a sex slave.

<sup>1191</sup> *Sté Mediafusion c Sorayama*, CA Paris, 4<sup>e</sup> ch, 11 octobre 1995, (1996) 168 RIDA 320, 323; JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 274.

<sup>1192</sup> David Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 128; Mira T Sundara Rajan, ‘Moral rights or economic rights?’ in Neil Wilkof and Shammad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 218-221.

<sup>1193</sup> Livre Ier, Titre II, Chapitre I: Droits moraux (Articles L121-1 à L121-9); Livre Ier, Titre II, Chapitre II: Droits patrimoniaux (Articles L122-1 à L122-12).

Code.<sup>1194</sup> The fact that moral rights are more prominent in France than the UK is also backed up historically. Moral rights (and ‘material interests’ = economic rights) were adopted into international law by Article 27(2) of the Universal Declaration on Human Rights (UDHR) and Article 15(1)(c) of the International Covenant on Economic, Social and Cultural Rights (ICESCR). Although the UK voted in favour of the UDHR too on 10 December 1948 in the General Assembly of the United Nations<sup>1195</sup> and signed the ICESCR on 16 September 1968,<sup>1196</sup> France was the driving force behind the recognition of moral rights of authors as a basic human right internationally.<sup>1197</sup> Consequently, France’s Supreme Court, the Cour de Cassation, regards the moral rights as a principle of public policy.<sup>1198</sup> The *ordre public* maintains the basic values of society that cannot be departed from. This is also reflected by Article L121-1 CPI 1992, which stipulates that moral rights are ‘*perpétuel, inaliénable et imprescriptible*.’ Moral rights are inalienable in France, because only the ‘*true creator* should benefit and not some fictitious author, e.g. the producer’.<sup>1199</sup> Naturally, authors also rely more strongly on moral rights protection for their LFCs than the protection economic rights can offer.

For comparison, in the UK, moral rights can be waived<sup>1200</sup> and LFCs are neither protected by the economic nor the moral rights. Hence, a person could create and produce LFC merchandise legally in the UK without requiring a licence from the author of the LFC. That merchandiser, who is not the author, would not be regarded as the ‘true creator’ in France and Germany, where the author can protect her LFCs against unauthorized merchandising via copyright.

<sup>1194</sup> Original French wording: ‘*Ce droit comporte des attributs d’ordre intellectuel et moral ainsi que des attributs d’ordre patrimonial, qui sont déterminés par les livres Ier et III du présent code.*’

<sup>1195</sup> Department of Public Information, ‘Yearbook of the United Nations 1948-49’ 535 <<http://www2.ohchr.org/english/issues/education/training/docs/UNYearbook.pdf>> accessed 18 October 2015.

<sup>1196</sup> Office of the High Commissioner for Human Rights, ‘Status of ratification interactive dashboard’ (OHCHR 1996-2014) <<http://indicators.ohchr.org/>> accessed 18 October 2015. The UK signed in 1968, but ratification took place much later, on 20 May 1976.

<sup>1197</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 168 et seq.

<sup>1198</sup> *Ferrat c Sté Universal Music et Adami*, Cass, ch soc, 10 juil 2002, (2003) 195 RIDA 338; *Barbelivien, Montagné et SNAC c Sté Agence Business*, Cass, 1ère ch civ, 28 janv 2003, (2003) 196 RIDA 414; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 171; Bernard Edelman, ‘Applicable Legislation Regarding Exploitation of Colourized U.S. Films in France: The “John Huston” Case’ (1992) IIC 629, 630.

<sup>1199</sup> Bernard Edelman, ‘Applicable Legislation Regarding Exploitation of Colourized U.S. Films in France: The “John Huston” Case’ (1992) IIC 629, 636.

<sup>1200</sup> CDPA 1988 s 87(2) and (3).



Moreover, the duration of moral rights in the UK is not indefinite. The term of protection for both paternity and integrity right is 70 years from the end of the year of the author's death.<sup>1201</sup> The term for the right to object to false attribution is '20 years after a person's death.'<sup>1202</sup>

In addition, in France, the subjective reaction of the writer to the alteration of the literary work is the determinant when it comes to deciding whether a treatment is prejudicial to the author's reputation.<sup>1203</sup> In fact, in France, the author of the literary work does not need to furnish proof that the act in question did or might have harmed her honour in order to obtain relief against such acts. If an author claims violation of her integrity right, there is a *prima facie* assumption that the defendant did indeed infringe the plaintiff's integrity right. It is then up to the defendant to prove that the treatment in question does not violate the plaintiff's moral right of integrity.<sup>1204</sup> An additional difference to the French procedure is that the standard applied in the UK when considering whether or not a treatment is prejudicial to the plaintiff's reputation is that of an objective notional reasonable consumer instead of the author, who actually suffers the damage to her reputation, because the creation of the literary work was made for a readership.<sup>1205</sup> This does not resonate with the purpose of moral rights, which is the protection of the creator's personality and reputation.<sup>1206</sup> It should also be taken into consideration that if only the public is the judge of an author's integrity right, then the public is also the judge of the author's personality and reputation. It is quite

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<sup>1201</sup> *Ibid* s 86(1).

<sup>1202</sup> *Ibid* s 86(2).

<sup>1203</sup> *Turner Entertainment Co v Huston*, CA Versailles civ ch, 19 Dec 1994; Mira T Sundara Rajan, 'Moral rights or economic rights?' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 220; Simon Newman, 'The development of the German, French and English legal systems—the development of copyright and authors' rights' (2011) 33 EIPR 677, 685; Lauriane Nocella, 'Copyright and moral rights versus author's right and droit moral: convergence or divergence?' (2008) 19 Ent LR 151, 154 et seq; Irini A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 481.

<sup>1204</sup> Mira T Sundara Rajan, 'Moral rights or economic rights?' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 223; André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 7[1][c][i] (Pub 399, Rel 28-12/2016); M K, "'John Huston II'" (1992) 23 IIC 702.

<sup>1205</sup> *Pasterfield v Denham* [1999] FSR 168, 169; *Confetti Records v Warner Music UK Ltd* [2003] EWHC 1274 (Ch) [160]; *Tidy v Trustees of the Natural History Museum* [1994] EWHC T 4562 (Ch) [page 7 lines 6-12]; William Cornish, David Llewelyn, and Tanya Aplin, *Intellectual Property – Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 510; Lauriane Nocella, 'Copyright and moral rights versus author's right and droit moral: convergence or divergence?' (2008) 19 Ent LR 151, 154 et seq.

<sup>1206</sup> Lauriane Nocella, 'Copyright and moral rights versus author's right and droit moral: convergence or divergence?' (2008) 19 Ent LR 151, 154. See also para 5.3.

incredible to expect the public to know the personality of the author and what could harm the author's feelings. This should be the author's prerogative. Wouldn't the author herself not be a more reliable source, to an extent, as to what and what does not harm her honour? That is why the French approach, though seemingly more subjective, is more judicious.

The UK's approach is understandable in so far that it seeks to prevent unforeseeable or even absurd claims from creators and may thereby create more legal certainty. However, the French method is not purely subjective. It also has objective safeguards to prevent creators from abusing moral rights. An author may only exercise her moral rights in compliance with the purpose of the respective moral right.<sup>1207</sup> A court will therefore take the purpose of the moral right in question as well as the specific practical circumstances of the individual case into consideration. This means also that the author's respective moral right shall be balanced against the legal rights others may have, and that the author may not abuse her rights. The French courts make sure that the creator's demands stay within the limits of reason. French courts reject an author's claim, if an author abuses the moral rights. It is an abuse of moral rights, e.g. if the author claims infringement of her moral rights to rid herself of a publishing contract, because she has been offered a more profitable contract.<sup>1208</sup>

Moreover, moral rights cannot invalidate a signed contract between the author and another party. Marcel Allain, the author of the character and eponymous book *Fantômas*, had assigned his adaptation right of the character for films and the creation of new adventures of the character. The contract between the assignor Marcel Allain and the assignee stipulated that if the author was dissatisfied with the adaptation, the titles of the films should inform the audience that these films were merely inspired by the literary works of Marcel Allain, but that these new adventures were not penned by Marcel Allain.<sup>1209</sup> The legatees of the author Marcel Allain, Dames Cacaret, Lacomme and Wastiaux, disagreed with the changes that his character *Fantômas* underwent in the new adventures.<sup>1210</sup> The court held that a writer has two objectives: to achieve

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<sup>1207</sup> *Chiavarino c Sté Spe*, Cass, 1ère ch civ, 14 mai 1991, (1992) 151 RIDA 272, 283 et seq; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 201; Irini A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 499 et seq.

<sup>1208</sup> Irini A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 499 et seq.

<sup>1209</sup> *Sté Nouvelle des Ets Gaumont c Allain*, CA Paris, 23 novembre 1970, (1971) 69 RIDA 74.

<sup>1210</sup> *Ibid* 75.

royalties for the work and the respect for the literary work. As a result of the above clause anticipating the author's dissatisfaction with the adaptation, the reputation of the character was not mistreated by the film producers despite the denaturation of the character. Marcel Allain had restricted his moral rights himself by entering said clause into the contract in which the economic rights were assigned.<sup>1211</sup> By doing so, the author had put himself in a position where he had disabled his moral rights, although the moral rights are inalienable.

It is recommended here to adopt a strategy that combines the benefits of the French and UK procedure. That would be: It shall not be assumed *prima facie* that the author's integrity right is violated, simply because she claims that this is the case. The burden of proof that the author's integrity right has been violated shall lie with the plaintiff (the author), like in the UK. However, the court shall take the subjective view of the author into account, like in France, as long as these stay within the bounds of reason and do not abuse the integrity right.

#### 7.3.2.4.2. France - Germany

The position of moral rights is strong in Germany as well. There are a few differences though. France has a dualistic approach to moral rights, unlike Germany which adopted a monistic approach. 'Dualistic' means that France regards the economic and moral rights of authors as separate rights that protect different sets of rights.<sup>1212</sup> 'Monistic' means that Germany accepts that economic and moral rights are interdependent. This has the consequence that the economic and moral rights will expire together.<sup>1213</sup> In France, moral rights, unlike the economic rights, do not expire

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<sup>1211</sup> Ibid et seq; Jacques Mazaltov, 'France' in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 271 et seq.

<sup>1212</sup> Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 175; Mira T Sundara Rajan, 'Moral rights or economic rights?' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 218; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 170.

<sup>1213</sup> Mira T Sundara Rajan, 'Moral rights or economic rights?' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 216; Mira T Sundara Rajan, 'Moral rights in information technology: a new kind of "personal right"?' (2004) 12 IJLIT 32, 39.

70 years after the author's death.<sup>1214</sup> Moral rights are perpetual under French law.<sup>1215</sup> Hence, the heirs to the author's estate can claim infringement of the deceased author's moral rights indefinitely after her death, not just for a period of 70 years from the end of the qualifying event.<sup>1216</sup>

There is another slight difference between French and German moral rights, which, however, sets both these civil law jurisdictions apart from UK law. The French integrity right also protects the author in situations where the creator's honour or reputation has not been directly damaged, and the material integrity of the work is still intact physically, but the image of the creator and spirit of the work has suffered as a result of the way in which the author's work was shown to the public.<sup>1217</sup> These two limbs of the integrity right are based on *Chaliapine c Union des Républiques socialistes et Sté Brenner* in which the Cour d'Appel in Paris stipulated that neither the form nor the spirit of a work may be deformed or altered.<sup>1218</sup> Although the *Cour de Cassation* has stated that the integrity right can only be infringed through the act of altering the work,<sup>1219</sup> the division of the integrity right into two potentially separately infringing branches is not necessarily replaced by a limitation of the integrity right to just the first limb, the distortion of the substance of the work. The term '*altération*' leaves room for interpretation. An *altération*

<sup>1214</sup> Article L123-1 CPI 1992; § 64 UrhG; Kathie D Claret, 'France' in Dennis Campbell (ed), *World Intellectual Property Rights and Remedies – Laws with Commentary*, Vol 1, § 17:30 (R 5/2013).

<sup>1215</sup> Article L121-1 CPI 1992; Mira T Sundara Rajan, 'Moral rights or economic rights?' in Neil Wilkof and Shamnad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 220; Mira T Sundara Rajan, *Moral rights – Principles, Practices and New Technology* (1<sup>st</sup> edn, OUP 2011) 15; Maria Mercedes Frabboni, 'France' in Gillian Davies and Kevin Garnett (eds), *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 442; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 169; Irimi A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 499 et seq.

<sup>1216</sup> For example, *Pierre Hugo v Editions Plon*, Cour d'Appel Paris, 31 March 2004, (2004) 202 RIDA 292 was brought against the publishing company of a sequel to *Les Misérables* in 2001 by the great-great-grandson of Victor Hugo. Victor Hugo died in 1885. That means the law suit for infringement of the author's moral rights was filed 115 years after the author's death.

In the UK, a defamation claim cannot be brought by the estate of a dead allegedly defamed person. Sallie Spilbury, *Media law* (Routledge-Cavendish 2000) 436.

<sup>1217</sup> Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 182 and 184; Valérie Laure Benabou, 'Rapport de la mission du CSPLA sur les "œuvres transformatives"' (CSPLA, 6 Oct 2014) 43 <<http://www.culturecommunication.gouv.fr/Politiques-ministerielles/Propriete-litteraire-et-artistique/Conseil-superieur-de-la-propriete-litteraire-et-artistique/Travaux/Missions/Mission-du-CSPLA-relative-aux-creations-transformatives>> accessed 8 December 2016; Irimi A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 499 et seq.

<sup>1218</sup> *Chaliapine c Union des Républiques socialistes et Sté Brenner*, CA Paris, 28 juill 1932, (1934) Deuxième Partie 139, 143; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 182.

<sup>1219</sup> *SCAM c Sipriot*, Cass, 1ère ch civ, 6 févr 1996, (1996) 169 RIDA 350, 354; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 182.

may be an alteration of the text of the work itself, but also an alteration of the character of a work. The character of a work is changed, for example, if the work is used in a different context so that the message behind the work has changed as a consequence.<sup>1220</sup> Moreover, cases confirm that the French integrity right may be infringed by either a physical or personal distortion of the work. It was held that the use of a serious work for advertising or political propaganda infringes the integrity right due to the context in which the work was put.<sup>1221</sup> If the spirit of a work is left unaffected in essence, then the integrity right is not infringed, of course.<sup>1222</sup>

The German integrity right, too, regards harm to the creator's intellectual and/or personal relationship with the work an infringement of the creator's integrity right.<sup>1223</sup> In fact, this is even a prerequisite for infringement of the integrity right in Germany.<sup>1224</sup>

#### 7.3.2.4.3. France – Germany - UK

However, the following example will illustrate the enormous difference between the integrity right under French law and UK law: A painting by creator XYZ is exhibited in an unsuitable environment. The idea behind the work and the image the artist wished to convey are misrepresented due to the environment the work is placed in. The audience misunderstands the concept, aura and message of the artist's work. That was so in *Pontoreau, ADAGP c Association Front National*<sup>1225</sup> where the right-wing Front National reproduced artistic works that had recently been bought by the state of France. The Front National objected to this 'squandering of public resources'. The

<sup>1220</sup> *SCAM c Sipriot*, Cass, 1ère ch civ, 6 févr 1996, (1996) 169 RIDA 350, 366-370 note by André Kéréver; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 182.

<sup>1221</sup> Advertising: *Sté Gaumont and Luc Besson c Sté Publicis Conseil and Sté Française du Radiotéléphone*, CA Paris, 4ème ch, 8 sept 2004 [3]; Political propaganda: *Pontoreau, ADAGP c Association Front National*, CA Versailles, 1ère ch, 20 décembre 2001, (2002) 192 RIDA 448 et seq and 451; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 184 et seq.

<sup>1222</sup> *Ferrat, SNAC et autre c Sté GMT Productions et autres*, TGI Paris, 3e ch, 26 novembre 1997, (1998) 177 RIDA 284, 290; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 184 et seq.

<sup>1223</sup> § 14 UrhG 1965; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 221 et seqq and 244; Irini A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 481.

<sup>1224</sup> Irini A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 500.

<sup>1225</sup> *Pontoreau, ADAGP c Association Front National*, CA Versailles, 1ère ch, 20 décembre 2001, (2002) 192 RIDA 448; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 184.

Front National's criticism of the works was politically motivated. The artist's works had become the subject of canvassing (electoral propaganda). That was not the purpose the artist had intended the paintings for. The Cour d'Appel therefore held that the integrity right was violated. The reproduction of the artworks was unlawful.<sup>1226</sup> The artist's integrity right is infringed under German and French law. The integrity right would fail in the UK already because of CDPA 1988, s 80(2)(a) which requires a treatment of the work.<sup>1227</sup> This section defines treatment as 'any addition to, deletion from or alteration to the work'.

Consequently, the chances of succeeding with a copyright case if one takes a moral rights approach may also be higher in France and Germany, at least where the integrity right is concerned. Another supporting factor in that regard for French law is once again that the standard for judging whether a treatment is prejudicial to the author's reputation or honour, is the author's subjective reaction to the alteration or use of the work. The author's subjective reaction must be perceived as reasonable though by the French court.<sup>1228</sup> In contrast, the standard applied in the UK is that of an objective notional reasonable consumer.<sup>1229</sup>

### 7.3.2.5. Economic rights, moral rights and merchandising

La Société Éditions Albert René successfully sued La Société StockArt for copyright infringement of the AFCs 'Astérix' and 'Obélix'. StockArt had reproduced drawings of the characters 'Astérix' and 'Obélix' on T-shirts from postcards bearing these

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<sup>1226</sup> Ibid.

<sup>1227</sup> Irini A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 481.

<sup>1228</sup> *Turner Entertainment Co v Huston*, CA Versailles civ ch, 19 Dec 1994; Mira T Sundara Rajan, 'Moral rights or economic rights?' in Neil Wilkof and Shammad Basheer (eds), *Overlapping Intellectual Property Rights* (1<sup>st</sup> edn, OUP 2012) 220; Simon Newman, 'The development of the German, French and English legal systems—the development of copyright and authors' rights' (2011) 33 EIPR 677, 685; Lauriane Nocella, 'Copyright and moral rights versus author's right and droit moral: convergence or divergence?' (2008) 19 Ent LR 151, 154 et seq; Irini A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 481.

<sup>1229</sup> *Pasterfield v Denham* [1999] FSR 168, 169; *Confetti Records v Warner Music UK Ltd* [2003] EWHC 1274 (Ch) [160]; *Tidy v Trustees of the Natural History Museum* [1994] EWHC T 4562 (Ch) [page 7 lines 6-12]; William Cornish, David Llewelyn, and Tanya Aplin, *Intellectual Property – Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 510; Lauriane Nocella, 'Copyright and moral rights versus author's right and droit moral: convergence or divergence?' (2008) 19 Ent LR 151, 154 et seq.

characters. StockArt claimed that it had bought and paid for the postcards (which were officially licensed products from another company) and would therefore not need a licence from La Société Éditions Albert René to reproduce the characters from the postcard on T-shirts.<sup>1230</sup> StockArt lost its case at the Tribunal de commerce de Paris as well as the appeal to the Cour d'appel de Paris. Both courts agreed that the defendant/appellant had infringed the claimant's/respondent's copyright. By printing the image of 'Astérix' and 'Obélix' from postcards on T-shirts, the defendant/appellant had produced a counterfeit object.<sup>1231</sup> This case dealt with the proprietor's economic rights in AFCs. In some instances, claimant and court resort to the moral rights instead, and the character in question may also be a LFC.

French copyright law and courts treat AFCs and LFCs the same. Both are protectable by copyright according to the same principles. Hence, copyright protects LFCs even against reproduction as a three-dimensional work, for example a puppet or any other merchandising goods, in France.<sup>1232</sup>

The author of a work may herself (through a manufacturer and distributor) create and sell her LFCs in three-dimensional form based on her book. That three-dimensional reproduction of her own work, be it a doll or a shampoo bottle in the form of the LFC, might then attract copyright itself, too. Copyright has been granted not only to non-utilitarian objects, but also to three-dimensional products of a utilitarian nature, such as a bottle opener<sup>1233</sup> and a salad bowl<sup>1234</sup> in France. However, items will attract copyright only in rare cases. It is especially rare that mass manufactured products attract copyright. Moreover, merchandising is commonly performed by third persons, not the author of the character herself. The author usually licenses or assigns her rights

<sup>1230</sup> *Société StockArt Ltd c Société Éditions Albert René Sarl*, CA Paris, 4<sup>e</sup> ch, s A, 14 mai 2003 [4]; *La Société Éditions Albert René c La Société StockArt Ltd* Tribunal de commerce de Paris, 15<sup>e</sup>me ch, 4 mai 2001 [2].

<sup>1231</sup> *Société StockArt Ltd c Société Éditions Albert René Sarl*, CA Paris, 4<sup>e</sup> ch, s A, 14 mai 2003 [5]; *La Société Éditions Albert René c La Société StockArt Ltd* Tribunal de commerce de Paris, 15<sup>e</sup>me ch, 4 mai 2001 [5].

<sup>1232</sup> Jacques Mazaltov, 'France' in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 270; Marina Ristich de Groote, 'Les personnages des œuvres de l'esprit' (1986) 130 RIDA 19, 48-52.

<sup>1233</sup> *Demoiselle Buhler*, Cass ch crim, 9 octobre 1974, (1975) 85 RIDA 176 et seq; André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b][ii][D] (Pub 399, Rel 28-12/2016).

<sup>1234</sup> *L... et Soc anon Interindustries*, Cass, ch crim, 30 oct 1963, (1964) Recueil Dalloz Sirey 678; André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b][ii][D] (Pub 399, Rel 28-12/2016).

(e.g. the right of reproduction) to the third person. Unless an author has assigned her economic rights to another, she can claim copyright infringement of her LFC against an unauthorized character merchandiser producing character items in 2D and 3D herself. If she has assigned the economic rights, then the assignee (the new copyright owner) has the right to sue the unauthorized merchandiser.

Under French law, an author keeps the moral rights even after assigning the economic rights.<sup>1235</sup> These moral rights enable the author to retain control of the merchandising of the character, e.g. the kind of products the character is used on, the way in which these goods are distributed and advertised, as well as the manner in which the LFC is adapted for its commercial exploitation.<sup>1236</sup> Further, the moral rights make it possible for the author to refuse that the LFC shall be exploited, if said exploitation is prejudicial to the character's reputation. For example, the author of 'Colargol',<sup>1237</sup> who had assigned the economic rights, went to court against the use of her character on pots of yoghurt and mustard arguing that these products were inferior and therefore prejudicial to the reputation of their fictional character. However, the court held that since yoghurts and mustard were typically enjoyed by children, the character's reputation did not suffer from its reproduction on those products.<sup>1238</sup> Although the author's claim failed in this case, the case nevertheless makes it clear that the French moral rights under copyright law may under the right circumstances protect LFCs against unauthorized merchandising, like the economic rights under copyright law did in the above mentioned 'Astérix' case.<sup>1239</sup>

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<sup>1235</sup> Article L121-1 CPI 1992; André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 7[4][a] (Pub 399, Rel 28-12/2016).

<sup>1236</sup> Jacques Mazaltov, 'France' in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 271.

<sup>1237</sup> 'Colargol' is a bear created by French-Polish writer Olga Pouchine in the 1950s. The stories were later adapted into a series of children's recordings and a stop-motion animated series.

<sup>1238</sup> *Sarl Procidis c Sieur Glattauer*, CA Paris, 4e ch, 26 avril 1977, (1978) 95 RIDA 131, 138 (Colargol); Jacques Mazaltov, 'France' in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 271.

<sup>1239</sup> See *Société StockArt Ltd c Société Éditions Albert René Sarl*, the first case under this para 7.3.2.5.



## 7.4. Conclusion

LFCs are copyrightable both in Germany and France. Copyright may not only protect against unauthorized use of LFCs in other literary works (or films, theatre plays), but also against unauthorized character merchandise.

In Germany, LFCs abstracted from the underlying work are protected by copyright provided that the LFCs are individual creations themselves.<sup>1240</sup> However, a LFC will only pass the threshold in exceptional cases.<sup>1241</sup> It is the work's individuality that determines whether it will enjoy copyright protection.<sup>1242</sup> Only those (literary) ideas, which have been concretised in an objective expression, are copyrightable. In this context, 'objective' means that everyone reading the ideas in the materialised (literary) work must gather the same information from the work.<sup>1243</sup> This is more challenging with regard to LFCs than AFCs, because even after the reader has 'extracted' the LFC's outer and inner characteristics from the overall text, there is more freedom to the reader's imagination than with regard to AFCs. Regardless, the core criteria for the identification of LFCs by means of which all readers can perceive a LFC objectively have been defined.

While the general criteria for copyright have been regulated by the UrhG 1965 (Copyright Act),<sup>1244</sup> the specific criteria through which a LFC can attain individuality have been set out by the German courts. The particular criteria determining LFC

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<sup>1240</sup> BGH, Urteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178, 180 et seq Rn 24 -30 = BGH GRUR 2014, 258, 260 Rn 24 – 30; OLG Köln, Urteil vom 24.02.2012 – Az: 6 U 176/11 Rn 10; OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11 Rn 8; LG Köln, Urteil vom 10.08.2011 – Az: 28 O 117/11 Rn 16; OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11 Rn 22; LG München I, Beschluss vom 20.07.2011 – Az: 33 O 14810/11 Rn 42 et seq; LG Berlin, Urteil vom 11.08.2009 – Az: 16 O 752/07 Rn 47 and 49 = LG Berlin ZUM 2010, 69, 70 et seq; LG Hamburg GRUR-RR 2003, 233, 240; KG Berlin ZUM 2003, 867, 869; OLG München GRUR 1990, 674, 675 et seq; Bullinger in: Arthur-Axel Wandtke and Winfried Bullinger, *Praxiskommentar zum Urheberrecht* (4<sup>th</sup> edn, C H Beck 2014) § 2 Rn 48; Thomas Dreier and Gernot Schulze, *UrhG Kommentar* (3<sup>rd</sup> edn, C H Beck 2008) § 2 Rn 92; Gunda Dryer, Jost Kotthoff and Astrid Meckel, *Heidelberger Kommentar zum Urheberrecht* (1<sup>st</sup> edn, C F Müller 2004) § 2 Rn 30. See para 7.2.1.2.

<sup>1241</sup> International Bureau, 'Character Merchandising' (WO/INF/108, 1994) Annex I, 2 <[http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo\\_inf\\_108.pdf](http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo_inf_108.pdf)> accessed 20 September 2012.

<sup>1242</sup> Eugen Ulmer, *Urheber- und Verlagsrecht* (3<sup>rd</sup> edn, Springer-Verlag 1980) 119; Volker Kitz, 'Die Herrschaft über Inhalt und Idee beim Sprachwerk' (2007) GRUR-RR 218; NJW-RR 2000, 268, 269 ('Das doppelte Lottchen').

<sup>1243</sup> Manfred Reh binder, *Urheberrecht* (16<sup>th</sup> edn, C H Beck 2010) Rn 59.

<sup>1244</sup> See para 7.2.1.

copyrightability are the LFC's outward appearance, inner character traits, and skills attributed to the LFC.<sup>1245</sup>

The Federal Supreme Court (BGH) made it clear in July 2013 that both the LFC's distinctive personality as well as exceptional external attributes must be copied for there to be copyright infringement in a single LFC.<sup>1246</sup> Prior to the BGH judgment, the majority of courts that had ruled on this issue had found it enough if the most prominent elements of the LFC's external features were reproduced.<sup>1247</sup>

This thesis asserts that this view disregards the general principles of free utilisation. If the individual creative intellectual elements from a pre-existing work, such as a LFC, do not pale in the overall view of the later work, but are instead easily recognized in the new work as coming from the earlier work of another author, then the author of the later work infringes the copyright of the author of the pre-existing work.<sup>1248</sup>

When assessing, whether or not the original LFC has indeed faded out, a stricter approach in favour of the existing work should be adopted rather than a lenient approach in favour of the new work.<sup>1249</sup> Hence, it is here submitted that one can infer from this that copyright in a LFC can be infringed even when only some of its elements are reproduced, as long as those elements represent the LFC without a doubt.

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<sup>1245</sup> BGH, Urteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178, 180 et seq Rn 24 -30 = BGH GRUR 2014, 258, 260 Rn 24 – 30; OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11 Rn 8; LG Köln, Urteil vom 10.08.2011 – Az: 28 O 117/11 Rn 20 et seq; KG Berlin ZUM 2003, 867, 869. See para 7.2.2.

<sup>1246</sup> BGH, Urteil vom 17.07.2013 – Az: I ZR 52/12 = BGH WRP 2014, 178, 180 Rn 25 - 29 = BGH GRUR 2014, 258, 260 Rn 25 – 29. See para 7.2.2.2.7.4.3.

<sup>1247</sup> LFC cases: OLG Köln, Urteil vom 24.02.2012 – Az: 6 U 176/11 Rn 19; OLG Köln, Urteil vom 14.10.2011 – Az: 6 U 128/11 Rn 13; OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11 Rn 34; LG Berlin, Urteil vom 11.08.2009 – Az: 16 O 752/07 Rn 51 = LG Berlin ZUM 2010, 69, 71; AFC case: BGHZ 532, 1, 10. See paras 7.2.2.2.7.1. - 7.2.2.2.7.3. and 7.2.2.2.7.4.2.

<sup>1248</sup> OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11 Rn 26. See also: LG Hamburg, Beschluss vom 28.04.2009 – Az: 308 O 200/09 Rn 9 = LG Hamburg ZUM 2009, 581; LG Berlin ZUM 2003, 60, 61; Helmut Haberstumpf, 'Kapitel 10 Urheberrechtsgesetz § 24 UrhG' in Wolfgang Büscher, Stefan Dittmer and Peter Schiwy (eds), *Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht – Kommentar* (2<sup>nd</sup> edn, Carl Heymanns Verlag 2011) § 24 Rn 10; Willi Erdmann, 'Verwendung zeitgenössischer Literatur für Unterrichtszwecke am Beispiel Harry Potter' (2002) 12 WRP 1329, 1335.

<sup>1249</sup> OLG München, Beschluss vom 10.08.2011 – Az: 6 W 1403/11 Rn 26. See also: LG Berlin ZUM 2001, 608, 612 ('Songs about Harry' case); LG Hamburg, Beschluss vom 28.04.2009 – Az: 308 O 200/09 Rn 9 = LG Hamburg ZUM 2009, 581; Willi Erdmann, 'Verwendung zeitgenössischer Literatur für Unterrichtszwecke am Beispiel Harry Potter' (2002) 12 WRP 1329, 1335. See also para 7.2.2.2.1.

Further, the BGH's view on the irrelevance of the public's recognition of the LFC in the later work is questionable, too.<sup>1250</sup> Despite the potential negative effects of involving a criterion of recognition of the LFC by the public,<sup>1251</sup> the recognition value of a LFC itself has some relevance under the concept of free utilisation. The reason is, that if the public still recognizes the LFC from the earlier work in the later work, then the copied elements from the pre-existing work have not faded out in the later work, regardless of whether these elements are only the LFC's appearance or also its personality attributes.

The German and French system are very similar. Just like the German copyright system, the French copyright system protects LFCs independent of the work they appear in, treats AFCs and LFCs equally,<sup>1252</sup> and applies the same criteria for character copyrightability against copying in other literary or dramatic works<sup>1253</sup> as well as against making use of LFCs for the production and sale of character merchandising objects.<sup>1254</sup>

Apart from the fact that LFCs are protected as literary works in Germany<sup>1255</sup> and as works *sui generis* in France,<sup>1256</sup> the most notable difference is that French courts commonly consider the moral rights when judging copyright protection of LFCs, whereas German courts consider the economic rights – although both have a strong moral rights tradition. The German model is preferable in this regard, because moral rights protection is indefinite in France.<sup>1257</sup> In France, those that inherit works may interfere with economic interests by way of moral rights indefinitely. A LFC would never be truly in the public domain under the French system, whereas in Germany the economic and the moral rights expire after 70 years from the author's death.<sup>1258</sup> Hence, it is not recommended to change the UK's CDPA 1988 s 86 (duration of moral rights), if LFC copyrightability were to be introduced in the UK.

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<sup>1250</sup> See para 7.2.2.2.7.4.3.

<sup>1251</sup> See para 8.3.4.4.

<sup>1252</sup> See paras 7.2.2.2.1 and 7.3.2.3.

<sup>1253</sup> See paras 7.2.2. and 7.3.2.2.

<sup>1254</sup> See paras 7.2.3. and 7.3.2.5.

<sup>1255</sup> See paras 7.2.1.1. and 7.2.2.2.7.3.

<sup>1256</sup> See para 7.3.1.1.

<sup>1257</sup> Article L121-1 CPI 1992.

<sup>1258</sup> § 64 UrhG 1965.

Interestingly, the wording of the provisions that regulate which works are copyright protected under the German UrhG 1965 (§§ 1 and 2) and the UK CDPA 1988 (ss 1 and 3) are more similar to each other than the German UrhG 1965 and the French CPI 1992 (L112), although LFCs are protected in Germany and France under their respective copyright law whereas LFCs are not copyrightable in the UK. This finding supports the option that judicial re-interpretation would be sufficient for the most part. This would require that courts regard LFCs as literary works (like under German law), not works *sui generis* (like under French law, which requires a broader wording of CDPA 1988 ss 1 and 3). However, there is a risk that judicial re-interpretation will not occur. Therefore, it might be a much quicker and safer process, if the legislature introduced a character right into the CDPA 1988. It would not be necessary, though, to insert a new provision into the CDPA 1988. LFCs could be added to the list of works that are included by the term 'literary work' in CDPA 1988 s 3(1). That section could then state as follows:

'(1)In this Part— 'literary work' means any work, other than a dramatic or musical work, which is written, spoken or sung, and accordingly includes— (a) a table or compilation ... (c) preparatory design material for a computer program ...' and (e) sufficiently well developed distinct literary fictional characters.

Canada, France, Germany, and the USA did not find it necessary to take the statutory road. It might take some time for judges to accept the notion of LFC copyrightability, but case-law allows the law to be flexible and adaptable. Making British courts aware of the possibility to accept LFC copyrightability and the benefits of such copyrightability<sup>1259</sup> would be the first step. Every idea starts somewhere and has to be kept alive and promoted.<sup>1260</sup>

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<sup>1259</sup> See para 2.2.

<sup>1260</sup> Sōichirō Honda had to be very patient and suffered many drawbacks before his Model A, an air-cooled two-stroke engine mounted on the frame of a men's bicycle with a bed warming pan as tank, went into mass production.

Although judging the originality of the character criteria might be considered subjective and vague,<sup>1261</sup> the aforementioned countries nevertheless grant copyright to some fictional characters while the UK does not.

In France, there is even a particular element of subjectivity in copyright protection, both from the side of the judge as well as from the side of the creator of a work. Whether the treatment of an author's work is prejudicial to the author's reputation or honour is judged according to the author's subjective reaction to the alteration or use of the work.<sup>1262</sup> Moreover, case-law demonstrates that judges do take merit into account. The judges may not call it merit expressly, but consider merit indirectly by considering 'talent' and claiming that a 'lack of originality would be contradictory to the [work's] indisputable popularity'.<sup>1263</sup> Some subjectivity is inevitable. One can only try to decide matters as objectively as possible following general principles and taking previous case-law into account. France was courageous enough to take the risk for the sake of their cultural heritage. Nonetheless, French creators are by no means starved or inhibited in creating new works. The concerns of individuals opposing copyright protection for LFCs in the UK seem unjustified.

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<sup>1261</sup> Jacques Mazaltov, 'France' in John Adams (ed), *Character Merchandising* (2<sup>nd</sup> edn, Butterworths 1996) 266 et seq.

<sup>1262</sup> *Turner Entertainment Co v Huston*, CA Versailles ch civ, 19 Dec 1994; Simon Newman, 'The development of the German, French and English legal systems—the development of copyright and authors' rights' (2011) 33 EIPR 677, 685; Lauriane Nocella, 'Copyright and moral rights versus author's right and droit moral: convergence or divergence?' (2008) 19 Ent LR 151, 154 et seq; Irini A Stamatoudi, 'Moral rights of authors in England: the missing emphasis on the role of creators' (1997) 4 IPQ 478, 481.

<sup>1263</sup> *Fédération Française de Gymnastique c Cottret*, CA Paris, 4e ch, 20 septembre 1994, (1995) 164 RIDA 367, 370 (referring to *talent* in judging that the photographs in question are protected); *Alain M et Pierre T c Midway Manufacturing Company et l'Agence pour la Protection des Programmes (APP)*, TGI Paris 31<sup>ème</sup> ch, 12 déc 1997, (1998) aout/septembre Expertises 272, 275 (The judge stated that the video game in question was undeniably famous and that a total lack of originality would be contradictory to the games' *indisputable popularity*.); André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b][ii][C] (Pub 399, Rel 28-12/2016; Caroline Carreau, 'Mérite et droit d'auteur' (1981) 109 RIDA 3, 13.

## Chapter 8 – LFCs and the UK copyright criteria

### 8.1. Introduction

After careful evaluation of LFC copyrightability in four different countries, to include highlighting similarities and differences with UK copyright law, this chapter critically evaluates how LFCs could be copyright protected under current UK copyright law - whether judicial re-interpretation of provisions of the CDPA 1988 may be sufficient, or what changes to the CDPA 1988 might be necessary or recommended. LFC copyrightability will be discussed specifically for each general copyright element. *Inter alia* the term ‘literary work’ shall be analysed. Moreover, the ‘new’ originality requirement introduced by the CJEU’s decision in *Infopaq International v Danske Dagblades Forening*,<sup>1264</sup> which requires that a work is the author’s own intellectual creation, shall be evaluated by contrast with the former originality requirement asking for an author’s labour, skill and judgment.<sup>1265</sup> In addition, it shall be debated which of the two originality interpretations is more favourable to LFC copyrightability or whether the new standard does not make any difference to LFC copyrightability.

All provisions named hereafter in this chapter without reference to a specified Act are provisions of the CDPA 1988.

### 8.2. Categorising LFCs

In order to attract copyright a work must fall within one of the categories of works listed in section 1(1), i.e. a literary, dramatic, musical or artistic work, a sound recording, film,

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<sup>1264</sup> Case C-5/08 *Infopaq International v Danske Dagblades Forening* [2009] ECR I-6569, paras 37 and 39.

<sup>1265</sup> The old standard has also been referred to as ‘effort, skill and time’ in *Sawkins v Hyperion Records Ltd* [2005] EWCA Civ 565 [52], ‘time and labour’ in *IPC Magazines Ltd v MGN Ltd* [1998] FSR 431, 432 and 438; ‘work or skill or expense’ in *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273 [291], ‘taste or judgment’ or ‘knowledge, labour, judgment or literary skill or taste’ in *GA Cramp & Sons Ltd v Frank Smythson Ltd* [1944] AC 329, 334, 336 and 341; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 194 and 202; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 44.

broadcast, or typographical arrangement of published editions.<sup>1266</sup> Hence, a LFC would have to be either a whole literary work or a substantial part of a literary work. Alternatively, a LFC might be a work *sui generis* like in France.<sup>1267</sup> These three options will be considered in the following:

### 8.2.1. Literary work

Defining a LFC as a literary work as in Germany<sup>1268</sup> seems the natural choice, as a LFC consists mostly of written words, and often features in literary works such as books, plays and scripts.<sup>1269</sup>

According to section 3(1), “‘literary work’ means any work, other than a dramatic or musical work, which is written, spoken or sung’. This includes tables or compilations, computer programs and databases. The term ‘literary (work)’ basically refers simply to written (‘written, spoken or sung’<sup>1270</sup>) matter - be that handwritten or typed and printed - irrespective of the quality or style of the written piece.<sup>1271</sup> Ideas, thoughts or information must be expressed in the written piece through words<sup>1272</sup> or some other

<sup>1266</sup> Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 76; William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 435.

<sup>1267</sup> *Sté Gaumont and Luc Besson c Sté Publicis Conseil and Sté Française du Radiotéléphone*, CA Paris, 4<sup>ème</sup> ch, 8 sept 2004 [8]; Elizabeth Adeney, *The moral rights of authors and performers* (OUP 2006) 200. See also para 7.3.1.1.

<sup>1268</sup> See para 7.2.2.2.7.3.

<sup>1269</sup> Interestingly, elements of a whole work, such as the storyline, have been regarded as a work itself (not a substantial part) by the District Court of Amsterdam. This Dutch court stated in *Rowling v Uitgeverij Byblos BV* [2003] ECDR 23 at [5] that

a storyline (a worked-out plot) can have an adequate character of its own to be considered a work for the purposes of the [Dutch] Copyright Act [1912]. This is the case when the plot of the story is original and a place is given in the plot to not necessarily original characters and elements.

<sup>1270</sup> Section s 3(1); *Sandman v Panasonic UK Ltd* [1998] FSR 651, 657.

<sup>1271</sup> *University of London Press v University Tutorial Press* [1916] 2 Ch 601, 608; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 78; Jonathan Griffiths, Lionel Bently and William R Cornish, ‘United Kingdom’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[2][a][i] (Pub 399, Rel 28-12/2016); JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 262; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 108 et seq; Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond*, Vol 1 (2<sup>nd</sup> edn, OUP 2006) 413.

<sup>1272</sup> *Anacon Corp Ltd v Environmental Research Technology Ltd* [1994] FSR 659, 660; *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 277; *University of London Press v University Tutorial Press* [1916] 2 Ch 601, 608; Tanya Aplin and Jennifer Davis, *Intellectual property*

form of writing that conveys information.<sup>1273</sup> If an author has not written down the literary work yet, i.e. when it exists only in the author's head, then it does not amount to a protectable literary work in the sense of the CDPA 1988,<sup>1274</sup> because the work was not fixed as required by section 3(2). In very basic terms, LFCs consist of written words (mostly fixed in books) which express the LFCs appearance as well as personality. However, they do so not only directly, but also indirectly. That means, a literary work is more than the sequence of its written down words. Lloyd LJ stated in *Baigent v Random House Group Ltd*, that

The “text“ of a literary work may cover more than the particular words in which it is expressed and extend to its overall content, including the selection, arrangement and development of ideas, theories, information, facts, incidents, characters, narrative and so on.<sup>1275</sup>

The same can be said for characters. Just like a novel is more than its exact words, a LFC is more than specific words. For example, a LFC may be foolhardy without the text ever mentioning explicitly that the character is foolhardy. Instead this character trait may have been described by actions and in the LFC's dialogue. This narrative description may be written down in the book and may therefore be corporeal and fixed, but the personality of the LFC is also, at the same time, to some extent, incorporeal. One may therefore argue that a LFC is not 100 per cent in material form. However, it is suggested that this should be no hindrance to copyright protection, because the LFC is nevertheless perceptible. Moreover, like periphrases, the meaning behind narrative

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*law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 111 et seq; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 108 et seq; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 88.

<sup>1273</sup> *Sandman v Panasonic UK Ltd* [1998] FSR 651, 657; *Anacon Corp Ltd v Environmental Research Technology Ltd* [1994] FSR 659, 660; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 105.

“writing” includes any form of notation or code, whether by hand or otherwise and regardless of the method by which, or medium in or on which, it is recorded, and “written” shall be construed accordingly’. Section 178.

That means, that writing does not have to take the form of common human language, as long as the writing communicates something, is readable and capable of being understood, such as e.g. Morse code and Braille. Even a diagram qualifies as writing, if information can be derived from it. *Sandman v Panasonic UK Ltd* [1998] FSR 651, 657; *Anacon Corp Ltd v Environmental Research Technology Ltd* [1994] FSR 659, 660; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 105 and 115.

<sup>1274</sup> Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 108.

<sup>1275</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [82]; *Baigent v Random House Group Ltd* [2008] EMLR 7 [141].



description can be comprehended by the reader. Just like the reader knows that the periphrase ‘the eye of the law’ denotes ‘the police’, and the periphrase ‘The Almighty’ refers to ‘God’, the readers understand that when a LFC who e.g. is a homeless person and this LFC finds a wallet with £8,000, which he hands in at the lost and found, that among this LFC’s characteristics are honesty and honourableness.

That there is more to the perception of a work than perception via the eye was illustrated very well by Mummery LJ in *Sawkins v Hyperion Records Ltd*. He explained that

in musical copyright the sounds are more important than the notes in the text ... in the approach to infringement. The test of ... reproduction is not a note-by-note textual comparison of the scores. It involves listening to and comparing the sounds of the copyright work and of the infringing work. So it is possible to infringe the copyright in a musical work without taking the actual notes.<sup>1276</sup>

Hence, a LFC is determined by each of its directly and indirectly expressed attributes, but also the overall image of all of these attributes together. In fact, a LFC goes even beyond this. The whole (the LFC) is more than the sum of its components. To use the analogy of Mummery J, like Sawkins’ editorial interventions to music, a LFC should have ‘sufficient aural ... significance to attract copyright protection.’<sup>1277</sup> It is submitted that a LFC has aural significance a) when its author has imbued the LFC with personality, b) when the LFC causes a stimulus in the reader, i.e. if the reader feels what the LFC feels while reading the book, and c) when the LFC is still alive in the reader’s memory after the reader completes reading the book.

National legal terms, that includes the term ‘literary work’ from sections 1(1)(a), 3(1) and (2), should also be interpreted in accordance with international law.<sup>1278</sup> The WIPO Copyright Treaty (WCT) 1996 does not define literary works, but instead concerns computer programs and databases. The closest the WCT gets to literary works is

<sup>1276</sup> *Sawkins v Hyperion Records Ltd* [2005] EWCA Civ 565 [54].

<sup>1277</sup> *Ibid* [56]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 90.

<sup>1278</sup> Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, para 189; Case C-306/05 *Sociedad General Autores y Editores de España (SGAE) v Rafael Hoteles SA* [2006] ECR I-11519, para 35.

Article 4, where it states that ‘Computer programs are protected as literary works within the meaning of Article 2 of the Berne Convention.’ The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) 1994 also does not define what a literary work is, but instead refers to the Berne Convention in Article 9. Article 2(1) of the Berne Convention 1886<sup>1279</sup> stipulates:

The expression ‘literary and artistic works’ shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature...

This article provides examples of mainly literary works, but also mentions that a literary work must be expressed (not just an idea), and that it must be expressed in writing or sound. This last part is consistent with section 3(1).<sup>1280</sup> This section confirms the copyrightability of compilations. It sets forth that “‘literary work’ ... includes— (a) a table or compilation other than a database, (b) a computer program, (c) preparatory design material for a computer program, and (d) a database.’ Section 3(1) was changed on 1 January 1998 by The Copyright and Rights in Databases Regulations 1997, reg 6. This ensures conformity of the CDPA 1988 with the Database Directive.<sup>1281</sup> Instead of creating a new category of works for databases, databases were assimilated into one of the existing categories of works under the CDPA 1988, namely literary works. A new section was inserted, section 3A, which defines what a database is. In the same spirit, LFCs should be assimilated into the CDPA 1988 under one of the existing categories – the category ‘literary work’.

This view is reinforced by the fact that the term ‘literary work’ is broadly defined in both the Berne Convention as well as the CDPA 1988 (Berne: ‘shall include’, CDPA: ‘any

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<sup>1279</sup> Berne Convention for the Protection of Literary and Artistic Works 1886 (as amended on September 28, 1979).

<sup>1280</sup> If the understanding of ‘work’ would vary from international treaty to treaty as well as from country to country, international treaties providing for reciprocity agreements would be undermined. Paul Edward Geller, ‘International Copyright: The Introduction’ in Paul Edward Geller (ed), *International Copyright Law and Practice*, Vol 1, § 4[1][a] (Pub 399, R 24 Oct 2012); Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond*, Vol 1 (2<sup>nd</sup> edn, OUP 2006) 406.

<sup>1281</sup> Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases [1996] OJ L77/20 - 28.

work'). This allows works that have not been listed to attract copyright as a literary work. Hence, it is theoretically possible to protect LFCs per se as literary works.

In addition, the Berne Convention<sup>1282</sup>, EU directives<sup>1283</sup> and EU cases<sup>1284</sup> imply that the categories of works named in the CDPA 1988 shall be interpreted in a way which ensures copyright protection for all 'intellectual creations'.<sup>1285</sup> For one thing, this means that even those kind of creations where the categories may not seem entirely clear shall fall under one of the established categories of works, if the creation in question is an intellectual creation. Hence, a LFC can fall under one of the established categories of works, if it is an intellectual creation. As LFCs consist of written words (mostly fixed in books) which express the LFCs' appearance as well as personality, LFCs are closest to the category 'literary works'. A LFC is a creation of an author's intellect and personality in the sphere of letters,<sup>1286</sup> an 'ordered expression of thought'.<sup>1287</sup> If the author's thoughts and the expression of these thoughts are not ordered, the author's LFC would be inconsistent and have no formed character, that can be compared for similarities to other LFCs from other allegedly infringing authors.

For another thing, this also suggests that individual elements of a copyrighted work are also entitled to copyright (like the underlying work), if those elements, too, are an

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<sup>1282</sup> Berne Convention 1886, art 2(1), (5) and (6); David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 44.

This is backed up by the fact that only the following works are excluded or left to determination by the Convention countries: unfixed works (art 2(2), 'official texts of a legislative, administrative and legal nature, and to official translations of such texts' (art 2(4)), 'news of the day or to miscellaneous facts having the character of mere items of press information' (art 2(8)), and 'political speeches and speeches delivered in the course of legal proceedings' (art 2bis(1)). Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond*, Vol 1 (2<sup>nd</sup> edn, OUP 2006) 412 et seq.

<sup>1283</sup> 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) [2006] OJ L372/12, art 6 (Term of Protection Directive); Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases [1996] OJ L77/20 - 28, recital 15 and art 3(1); Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs [1991] OJ L122/42, art 1(3).

<sup>1284</sup> Case C-145/10 *Painer v Standard Verlags GmbH* [2011] ECR-12533, paras 87; Case C-5/08 *Infopaq International v Danske Dagblades Forening* [2009] ECR I-6569, paras 37 and 39.

<sup>1285</sup> Jonathan Griffiths, Lionel Bently and William R Cornish, 'United Kingdom' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[2][a] (Pub 399, Rel 28-12/2016).

<sup>1286</sup> Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond*, Vol 1 (2<sup>nd</sup> edn, OUP 2006) 403; Christian Handig, 'The copyright term "work" – European harmonisation at an unknown level' (2009) 40 IIC 665, 669.

<sup>1287</sup> JAL Sterling, Michael Hart and Emily Riddle, 'Subject Matter of Protection' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 253.

expression of the author's intellectual creation.<sup>1288</sup> If a constituent element or part of a greater entity is separable, the element in question may constitute a copyright work itself.<sup>1289</sup> Hence, a LFC could be a whole literary work. The fact that authors of LFCs themselves can and do take their LFCs and write new stories about them unrelated to the previous stories proves that LFCs are separable from the original literary work they were created in initially. Not only that, but entire spin-offs, fanfiction and, it is suggested, even character merchandising lines can be created just by copying the LFCs.

AFCs too have been regarded as whole works, although they are commonly contained in cartoons and comics. For example, the AFCs in *Mitchell v BBC* were not regarded as substantial parts. Each AFC was regarded as a whole work.<sup>1290</sup> Hence, it would appear that only copying some elements of these AFCs was a question of substantial copying from whole works.<sup>1291</sup> This is supported by Vitoria as well as Porter who state that each drawing of an AFC may be a separate work and attract a separate copyright.<sup>1292</sup> Further, an AFC is more than just a drawing. For one thing, an AFC is usually not just one drawing in a particular pose. If the AFC was created e.g. for a comic strip and not just a cereal box, then the AFC is a multitude of drawings of one and the same character in an abundance of different poses and different settings. For another thing, the AFC's personality does not come to the fore in mere drawings.

Regarding a LFC per se as a literary work could encourage claims that in a textbook or novel, every individual chapter, page, or sentence may qualify as a literary work. If

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<sup>1288</sup> Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569, paras 38 et seq; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 103; Jonathan Griffiths, Lionel Bently and William R Cornish, 'United Kingdom' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 8[1][a][ii] (Pub 399, Rel 28-12/2016).

<sup>1289</sup> *Coffey v Warner/Chappell Music Ltd* [2005] EWHC 449 [12]; *Coogi Australia Pty v Hysport International Pty Ltd* [1998] 41 IPR 593, 610 (Fed Ct of Aus); Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 103.

<sup>1290</sup> *Mitchell v BBC* [2011] EWPC 42 [5], [8], [22] and [28] et seqq. The claimant's claim failed though, i.a. because the similarities between the defendant's and the claimant's AFCs were generic and nebulous. This case shall be discussed in detail further below at para 8.3.1.

<sup>1291</sup> *Ibid* [22] and [28] et seqq.

<sup>1292</sup> Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1685; Hamish Porter, 'U.K. design copyright and cartoon characters' (2000) 22 EIPR 542, 543.

one considered then whether the whole work, e.g. a sentence had been copied, a finding of copyright infringement would be highly likely, in fact nearly inevitable, if the element to be considered was small enough.<sup>1293</sup> Hence, the above suggestion, that a LFC can be a literary work, carries the risk of cherry picking.<sup>1294</sup> This would deprive the defendant of the defence that what she copied did not amount to a substantial part of the true whole copyright work.<sup>1295</sup> Copyright does not subsist in a legal mille-feuille, i.e. several layers of different literary copyright (novel, LFC). Only one literary copyright can be asserted for a work as a whole.

### 8.2.2. Substantial part

Could it be then that instead of being classified as a whole work by itself, a LFC can amount to a plot-independent substantial part of the underlying work and partake in the copyright of the overall work as such? Case-law confirms that this is possible, at least as plot-dependent substantial parts of the underlying work.<sup>1296</sup> However, this thesis critically evaluates whether and how LFCs can be protected independent from other elements of the underlying work.

At first, treating LFCs per se as only substantial parts, which share in the copyright of the whole literary work, does not seem to be in conformity with copyright protection of an AFC as a unified entity. AFCs are commonly contained in cartoons and comics, and in the above example (*Mitchell v BBC*) each AFC was copyright protected as a whole.<sup>1297</sup> However, the conclusion that AFCs are always protected as whole works is fallacious. It is submitted that, one needs to differentiate more.

The proposal for a children's TV programme in *Mitchell v BBC* contained drawings of a group of characters accompanied by a short synopsis and script for the first episode. Hence, the proposal basically consisted of artistic works (the drawings) and literary

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<sup>1293</sup> Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 197 et seq; Ute Klement, 'Copyright protection of unauthorised sequels under the Copyright, Designs and Patents Act 1988' (2007) 18 Ent LR 13, 17.

<sup>1294</sup> Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 103; *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 277.

<sup>1295</sup> *Coffey v Warner/Chappell Music Ltd* [2005] EWHC 449 (Ch) [8] et seqq.

<sup>1296</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [83]; *Hodgson v Isaac* [2012] ECC 4 [H7] and [82].

<sup>1297</sup> See para 8.2.1.

works (the synopsis and script). Hence, it is arguable that one should consider the format in which a work entered the market.<sup>1298</sup> If the individual characters are released to the public as isolated parts by themselves and not in an encompassing work, then they would be a whole work. That also means, that if a character is a feature in a work, then it would be a substantial part of a whole work. To illustrate this in a more concrete manner:

- If AFCs are incorporated in a comic book, then these would be a substantial part of the comic, like in the ‘Popeye’ case.<sup>1299</sup> Likewise, LFCs would be a substantial part of a novel.
- If AFCs were not placed into another framework, but were more or less stand alone AFCs, like in Mitchell’s proposal for the BBC, then the AFCs would be separate works, not just parts of a larger work. Likewise, LFCs might be separate abstract works, e.g. if an elaborate character profile is devised for a LFC.

This two-pronged conclusion is also in keeping with *Sweeney v Macmillan Publishers Ltd*, in which the High Court held that

Copyright subsisted in [Joyce’s novel] ‘Ulysses’ as a whole. It would also have subsisted in each chapter or indeed each page or perhaps each sentence as written. But as each passage was incorporated into the larger work, it was right to regard the copyright as subsisting in the work as a whole ... rather than in the several constituent parts.<sup>1300</sup>

To conclude, AFCs and LFCs could be both whole works as well as substantial parts of a whole work. It depends on the circumstances. This conclusion also reconciles *Allen v Redshaw*, which considered the AFC ‘Mr Spoon’ from the puppet play *Mr Spoon*

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<sup>1298</sup> Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 198; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 202 et seq.

<sup>1299</sup> *King Features Syndicate Inc v O and M Kleeman Ltd* [1940] Ch 523.

<sup>1300</sup> *Sweeney v Macmillan Publishers Ltd* [2002] RPC 35 [H14] and [33].

on *Button Moon* as a substantial part,<sup>1301</sup> with *Mitchell v BBC*, which considered copyright protection for each AFC of the ‘Bounce Bunch’ as a whole work.<sup>1302</sup>

### 8.2.3. Work *sui generis*

Alternatively, a LFC might be a work *sui generis*. In order for a LFC per se to avail of copyright protection as a work *sui generis*, the CDPA 1988 would have to be wider and more flexibly worded, like the French CPI 1992, as section 1(1) gives no copyright protection to any type of work other than those listed in that provision. The CDPA 1988 contains an exhaustive list.<sup>1303</sup> Section 1(2) explicitly stipulates that “copyright work” means a work of any of those descriptions in which copyright subsists.’ Not only would section 1 have to be changed, if a LFC was going to be acknowledged as a work *sui generis*, but also many other provisions naming certain types of works. For example, section 17(2) stipulates that ‘Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form.’ This catalogue of certain categories of works would have to be extended to works *sui generis* or the restriction to certain types of works would have to be abandoned. The same pertains to the moral rights provisions in sections 77 - 85.

This thesis strives, though, to maintain the CDPA 1988 as it stands as much as possible. If a LFC were to be regarded as a literary work, fewer provisions would require changing.

However, Rosati expressed the opinion that the new EU standard for originality (the author’s own intellectual creation) also determined the meaning of work. The consideration whether a work can attract copyright depends exclusively on whether or not the work is original. The work does not have to fall into a specific category of

<sup>1301</sup> *Allen v Redshaw* [2013] WL 2110623 [28] and [30].

<sup>1302</sup> *Mitchell v BBC* [2011] EWPC 42 [5], [8], [22] and [28] et seqq.

<sup>1303</sup> Jonathan Griffiths, Lionel Bently and William R Cornish, ‘United Kingdom’ in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[2] (Pub 399, Rel 28-12/2016); Iona Silverman, ‘Copyright and fashion: friends at last?’ (2013) 35 EIPR 637; Iona Harding, ‘Fashion and copyright: weaving our way towards increased protection’ (2013) 35 EIPR 183, 187; Christian Handig, ‘Infopaq International A/S v Danske Dagblades Forening (C-5/08): is the term “work” of the CDPA 1988 in line with the European Directives?’ (2010) 32 EIPR 53, 56.

work.<sup>1304</sup> If her understanding were correct, a LFC might be a work *sui generis* after all. Rosati's interpretation would also have the advantage that other non-conventional subject-matter, that does not fit any of the existing categories under the CDPA 1988, may also be copyright protected, if it is its creator's own intellectual creation.<sup>1305</sup> Thereby, it would be ensured that IP law can adapt flexibly to the changing times, technical advances and new types of works. Rosati's view is also supported by the fact that in Joined Cases *FAPL v QC Leisure; and Murphy v Media Protection Services* the CJEU approached the issue of whether or not sporting events are protected by copyright by means of considering the subject-matter's originality and not whether sporting events fall into one of the normative copyrightable categories ('literary, scientific and artistic domain').<sup>1306</sup>

Nevertheless, Rosati's evaluation is not quite sound. Defining a work with the EU's originality standard is not in conformity with the Berne Convention 1886, although the Berne Convention 1886 contains a non-exhaustive list of copyrightable works in Article 2(1). Rather, Article 2(1) of the Berne Convention 1886 implies that the originality of a work is assessed only subsequent to establishing that the form of expression is a 'production in the literary, scientific and artistic domain'. Not only the wording of Article 2(1) suggests this, but also the structure of Article 2. The general types of works are mentioned in the first subsection of Article 2, while the term 'original work' is mentioned as late as subsection 3, after subsection 2 giving jurisdictions a free hand to require fixation of works. That subsection 3, too, requires that the translation or arrangement must have been made of certain types of works – 'music ... a literary or artistic work'. Hence, the categorisation into different types of copyright protected works – be that a

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<sup>1304</sup> Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 5 et seq and 154; Neil Yap, 'The proof is in the plating: copyright protection of culinary arts and reform for the categories of authorial works' (2017) 39 EIPR 226, 229; Estelle Derclaye, 'The Court of Justice copyright case law: quo vadis?' (2014) 36 EIPR 716 et seq; Christian Handig, 'Infopaq International A/S Danske Dagblades Forening (C-5/08): is the term "work" of the CDPA 1988 in line with the European Directives?' (2010) EIPR 53 – 57.

<sup>1305</sup> Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 123 et seq.

<sup>1306</sup> Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, para 97; Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 138.



non-exhaustive or a closed list - has not changed as a result of the harmonised EU originality standard.<sup>1307</sup>

Indeed, the UK has not changed the wording of the relevant sections in the CDPA 1988 since the introduction of the new originality standard by *Infopaq International A/S v Danske Dagblades Forening* in 2009. Brexit makes it very unlikely that the UK will abandon its exhaustive list of copyrightable works in the foreseeable future.

This also prevents opening of the flood gates for undesirable protection and unwanted litigation, which might have arisen, if the UK had to adapt to a non-exhaustive list of works-model as in the French CPI 1992 Articles L112-1 to L112-4, which define the notion of protected works very broadly. There is even litigation in France debating whether perfumes are literary works.<sup>1308</sup> The other side of the coin is that the French approach has the advantage that new types of works do not have to be made fit one of the existing categories of works artificially in order to avail of copyright protection.

### 8.3. Copyright principles, requirements and criteria

Regardless of whether one evaluates copyright infringement by the acts restricted by copyright in relation to the work as a whole or a substantial part of it, the general copyrightability issues are the same. In this section, this thesis will consider the following important elements of copyright: the idea/expression dichotomy,<sup>1309</sup> originality,<sup>1310</sup> and the criteria of a substantial part of a work.<sup>1311</sup>

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<sup>1307</sup> *Abraham Moon & Sons v Thornber et al* [2012] EWPC 37 [99]; Estelle Derclaye, 'Assessing the impact and reception of the Court of Justice of the European Union case law on UK copyright law: what does the future hold?' (2014) 240 RIDA 17 <[http://eprints.nottingham.ac.uk/3613/2/RIDA\\_article\\_derclaye\\_April\\_2014\\_eprints.pdf](http://eprints.nottingham.ac.uk/3613/2/RIDA_article_derclaye_April_2014_eprints.pdf)> accessed 14 March 2017.

<sup>1308</sup> Copyright protection to perfumes was denied in *Bsiri-Babir c Haarmann et Reimer*, Cass civ I, 13 juin 2006, [2006] ECDR 28 [H3] and [4] and *Sté Senteur Mazal v SA Beauté prestige internationale* Cass civ I, 1 juillet 2008 (after copyright had been granted in the first instance), because a perfume is merely the result of applied know-how and not a creation within the meaning of the CPI. Unknown, 'Case Comment - France: Intellectual Property Code, arts.L.112-1, L.112-2 - "Fragrance of a Perfume II"' (2010) 41 IIC 234; Iona Silverman, 'Copyright and fashion: friends at last?' (2013) 35 EIPR 637, 641.

<sup>1309</sup> See para 8.3.1.

<sup>1310</sup> See paras 8.3.2. et seq.

<sup>1311</sup> See para 8.3.4.

### 8.3.1. Idea/expression dichotomy

One of the best known, but also challenging, principles in copyright law is the idea/expression dichotomy. Its purpose is to strike a balance between protection of an author's rights and the interests of the public.<sup>1312</sup> Though vague, the idea/expression dichotomy also contributes to the definition of 'work'. It is the expression of ideas, but not ideas themselves. Ristich de Groote stated with regard to LFCs under French law that a 'character results from a process of elaboration that starts with an idea and ends up as a tangible result, a product of the materialized reflection of the author.'<sup>1313</sup> Under UK copyright law, a tangible result requires fixation of the material as opposed to being merely in an author's head, which would be just an idea. Every element that is recorded, e.g. by putting words on paper, is the expression of an idea on the author's part unless the material found its way into a work accidentally or as a result of force.<sup>1314</sup> Whether this expression attracts copyright depends on whether it meets the *de minimis* threshold and originality requirement. These requirements will be discussed further below in this chapter.

In principle, ideas, facts, styles, procedures, concepts and general themes themselves are not protectable by copyright<sup>1315</sup> to ensure that one person does not monopolise knowledge in general or e.g. biographical or historical research on specific topics.<sup>1316</sup> However, the development of an idea as well as the selection, arrangement, structure<sup>1317</sup> and collocation of the raw research material on which the work in question

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<sup>1312</sup> Simon Stokes, *Digital Copyright – Law and Practice* (Hart Publishing 2014) 5; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 189; Karina O'Rourke is of the same opinion in 'Integrity on the web' (2012) EIPR 815, 821.

<sup>1313</sup> Marina Ristich de Groote, 'Les personnages des œuvres de l'esprit' (1986) 130 RIDA 19, 36.

<sup>1314</sup> *Hodgson v Isaac* [2012] ECC 4 [23]; Deming Liu, 'Reflections on the idea/expression dichotomy in English copyright law' (2017) 1 JBL 71, 75.

<sup>1315</sup> *Ogunkoya v Harding* [2017] EWHC 470 [35]; *SAS Institute Inc v World Programming Ltd* [2013] EWCA Civ 1482 [53]; *IPC Media Ltd v Highbury-Leisure Publishing Ltd* [2005] FSR 20 [14]; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 116 fn 191; Deming Liu, 'Reflections on the idea/expression dichotomy in English copyright law' (2017) 1 JBL 71, 72.

<sup>1316</sup> *Baigent v Random House Group Ltd* [2008] EMLR 7 [156]; *Ravenscroft v Herbert* [1980] RPC 193, 203 and 205; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 57.

<sup>1317</sup> *Reshaun Michael Massey (Child) v Dinamo Productions Limited* [2012] EWPC 27 [24]; *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [85].

is based may be original and protected by copyright.<sup>1318</sup> The banal stock elements ‘just’ have to be combined creatively to attract copyright.<sup>1319</sup>

One might argue that LFCs imitate life by making use of people’s characteristics like some works make use of facts. Facts are not protected by copyright, as those itself do not leave freedom for individual creation. However, the manner in which use is made of facts and the way in which they are expressed are copyrightable. For that reason, the artistic selection and arrangement of objects found in ‘nature’ in the claimant’s photograph was found to be an original work in *Temple Island Collections Ltd v New English Teas Ltd*,<sup>1320</sup> despite the photograph’s individual elements being common. Arranging iconic buildings or images together was only a common idea. The technique of highlighting one of the iconic objects, in this case a bus, in red while the backdrop is displayed in black and white, is not unique either.<sup>1321</sup> However, the composition of the entire photograph was an original expression of a combination of common ideas. Hence, the claimant’s photograph was protected by copyright.

Likewise, copyright protection was granted for works such as solicitors’ directories,<sup>1322</sup> a chronological list in combination with a football fixture list,<sup>1323</sup> and timetable indices.<sup>1324</sup> All of these (except for the photograph) have in common that they are compilations of information. LFCs, too, could be described as a compilation of

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<sup>1318</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [83] and [85]; *Baigent v Random House Group Ltd* [2008] EMLR 7 [145] and [156]; Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 199; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 53; Jennifer Davis, *Intellectual property law* (4<sup>th</sup> edn, OUP 2012) 49 et seq.

<sup>1319</sup> JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 286.

<sup>1320</sup> *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 [51]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 126.

<sup>1321</sup> *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 [49].

<sup>1322</sup> *Waterlow Publishers Ltd v Rose* [1995] FSR 207, 208; Andrew McGee, Alexandrine Cerfontaine and Gary Scanlan, ‘Creativity and Form as Grounds for Copyright Protection in English Law’ (2001) *Commercial Liability Law Review* 73, 75.

<sup>1323</sup> *Football League v Littlewoods Pools Ltd* [1959] Ch 637, 638. However, the Court of Appeal held in a more recent decision, following the CJEU, that football fixture lists do not attract copyright. *Football Dataco Ltd and Others v Brittens Pools Ltd and Others* [2011] ECDR 9 [H4].

<sup>1324</sup> *Blacklock & Co, Ltd v Pearson, Ltd* [1915] 2 Ch 376; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 121; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 200; William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 436.

information which is found throughout a novel. The difference with the above examples is that the information used for LFCs is not factual, but fictional, even though it imitates life. A LFC is a combination of fictional information on the LFC which the author has made up to create the LFC. The collection and arrangement of existing material does not have to be factual to be deemed a compilation, but can also be of a fictional nature. Even if LFC copyrightability were to be established, this would not mean that the creator of the LFC would get a quasi-monopoly<sup>1325</sup> in representing the individual traits of the character as such. Birss J's comment in *Temple Island* supports this view. He stated that the creator of a copyright protected photograph of a well known building, such as Westminster Abbey, did not receive a monopoly in representing Westminster Abbey as such.<sup>1326</sup> This thesis asserts that by combining the selected individual character traits LFCs are capable of attracting copyright, too ('combination of fictional facts'-approach). Only by combining the selected individual character attributes are these capable of forming a mental image in the reader's mind (the product of the individual pre-existing characteristics).

Commonly, a LFC's particular combination of character traits, and not their exact description in words from the underlying book, are reproduced i.a. in fanfiction and character merchandise products. LFC copyrightability benefits from the fact that copyright in a work can be infringed even if the work was not copied literally, because a LFC's traits are not always stated explicitly, but can be gleaned from the LFC's actions, words and thoughts.<sup>1327</sup> Without this form of non-literal copying, LFCs could not even potentially infringe copyright. Furthermore, in general, if copyright did not protect works against non-textual copying, a person could easily circumvent copyright

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<sup>1325</sup> *Sawkins v Hyperion Records Ltd* [2005] EWCA Civ 565 [29] et seq.

<sup>1326</sup> *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 [21].

<sup>1327</sup> The following sources discuss non-literal copying in general (not in relation to LFCs specifically). *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [15] and [85]; *Baigent v Random House Group Ltd* [2008] EMLR 7 [H9], [6], [145] and [156]; *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [H5] et seqq, [23] and [25]; Jennifer Davis, *Intellectual property law* (4<sup>th</sup> edn, OUP 2012) 49 et seq; Kristofer Erickson, Martin Kretschmer, Dinusha Mendis et al, 'Copyright and the Value of the Public Domain' (CREATe Working Paper 2015/01) 20 <<https://zenodo.org/record/14975/files/CREATe-Working-Paper-2015-01.pdf>> accessed 20 February 2015.

infringement in another author's work by rewriting the work expressing the same content with different words.<sup>1328</sup>

The courts have to consider the following four steps when determining whether an altered, non-literal copy infringes copyright in the original. With regard to LFCs these four steps translate into:

- a) Is the work from which subject matter has been copied original? Is the LFC as a whole (e.g. character proposal, character profile)<sup>1329</sup> an original work, or is the LFC a part of a larger work (e.g. LFC featuring in a novel)<sup>1330</sup> and is that part original?
- b) Which material do both works share?<sup>1331</sup> - Which features do both LFCs have in common? Is the overall 'picture' the same, or only some of the LFC's features? Did the defendant develop this particular combination of features independently?
- c) Is that shared material just an idea or is it a copyright protectable expression? - Are the features of the LFC just an idea or have they crossed over into expression?<sup>1332</sup>

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<sup>1328</sup> Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 195; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 52.

<sup>1329</sup> See para 8.2.1.

<sup>1330</sup> See para 8.2.2.

<sup>1331</sup> Similarities between the alleged infringing work and the copyright work, in addition to access to the copyright work, are *prima facie* proof for copying of the copyright work. *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [17]; *Baigent v Random House Group Ltd* [2008] EMLR 7 [H9]; *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [41]; *Francis Day & Hunter v Bron* [1963] Ch 587, 612. If the earlier existing novel or LFC is very popular, this might be enough reason to infer access to the earlier copyright work.

Whether the author of the later work e.g. has used similar sources as the author of the earlier work might also explain the similarities. Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 191 et seqq.

Though, the evidence generally focuses on the similarities, the differences are not unimportant. The differences between the alleged infringing work and the copyright work can indicate an independent source. This would constitute evidence in rebuttal of copying. *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [42].

<sup>1332</sup> See para 8.3.1. et seq.

- d) Does the shared copyrightable material amount to a substantial part of the work?<sup>1333</sup> Does the combination of features, which both the claimant's and defendant's LFC have in common, amount to a substantial part of the whole work?

The salient features of the character 'Popeye' were enumerated by the House of Lords in *King Features Syndicate Inc v O and M Kleeman Ltd* – 'namely, the sailor's cap, the nose, the chin, the mouth, the swollen forearms, the baggy trousers, and the enlarged feet.'<sup>1334</sup> It is striking that all of the above are physical features of the character. On the one hand this is understandable, because 'Popeye' is a visual character, an AFC, and the visual attributes can be compared much easier with the appearance of the allegedly infringing character. On the other hand, AFCs usually have personality attributes, too, if they appear in a comic and are not merely an unaccompanied drawing. Copying of those personality traits may not be necessary though. A substantial part may already be infringed, if only physical attributes were copied. Unlike a LFC, an AFC is already clearly, unambiguously outlined by a drawing or series of drawings. As it is more challenging to abstract and compare LFCs from literary works, it is natural to draw on more than just the LFC's appearance in order to have a wider range of the LFC's characteristics which complete the mental picture.

The more specific the author is in her description and characterisation, the less ambiguous a LFC is. When the similarities between the antecedent and the allegedly infringing posterior work have a high level of generality, the chances that a claim for copyright infringement fails are extremely high, because the similarities might be regarded as merely ideas.<sup>1335</sup> Copyright protection was denied, for example, in *Baigent v Random House* due to the generality of the copied elements.<sup>1336</sup> The more specific and elaborate the elements are, which have allegedly been copied (literally or non-

<sup>1333</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [15]; *Baigent v Random House Group Ltd* [2008] EMLR 7 [7].

<sup>1334</sup> *King Features Syndicate Inc v O and M Kleeman Ltd* [1941] AC 417, 432 and 447 (HL).

<sup>1335</sup> *Reshaun Michael Massey (Child) v Dinamo Productions Limited* [2012] EWPC 27 [30]; *Baigent v Random House Group Ltd* [2008] EMLR 7 [H19] and [60] et seq.

<sup>1336</sup> *Baigent v Random House Group Ltd* [2008] EMLR 7 [H19] and [60] et seq; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 213.

literally), the more likely it is that a court will rule that there has been copyright infringement.<sup>1337</sup> However, even if the similarities are at a high level of generality, there is still a possibility that the court will find that copyright was infringed. Birss J stipulated this in *Mitchell v BBC*.<sup>1338</sup> The claimant and creator of the 'Bounce Bunch' lost his claim for copyright infringement by way of deliberate as well as sub-conscious copying against the BBC regardless.<sup>1339</sup>

*Mitchell v BBC* concerned the claimant Michael Mitchell, who drew five multiracial characters, called the 'Bounce Bunch' in 2004 and made one of these characters available online in 2005 and the rest of the characters in 2007. He sent the concept (drawings of the five eco-guardian characters 'Feng', 'Simrita', 'Charlie', 'Yana' and 'Jomo' as well as a synopsis and script for the first episode) to the BBC department for children's programmes between the ages of 6 - 12 in 2007. The BBC decided in May 2008 not to pursue the programme and informed the claimant thereof. Six months later, the BBC commenced broadcasting the animated children's television programme 'Kerwhizz' with three human characters ('Ninki', 'Twist' and 'Kit') each of which has an alien side-kick ('Poop', 'Snout' and 'Caboodle'). The claimant maintained that the BBC infringed his copyright in his artistic work (the drawings of the five characters), whereas the BBC claimed that it created 'Kerwhizz' independently. Judge Birss QC stated that 'Although side by side the characters look quite different and many of the similarities are at a high level of generality, there are a number of points which, *prima facie*, support Mr Mitchell's case.'<sup>1340</sup> Among the similarities between the plaintiff's and defendant's artistic works is that all characters wear some sort of armour with helmets to which mics are attached. The colour scheme and ethnic mix of the plaintiff's and defendant's AFCs are also similar. There are even similarities with regard to a detail. Both, 'Charlie' and 'Twist', are blue suited AFCs and both have a quiff of fair hair. Due to these similarities, Birss J found that the onus of proof shifts to the BBC. However, in the end Birss J found that the similarities were 'at the most nebulous level'<sup>1341</sup> and the BBC could illustrate that the AFCs features were of a 'generic nature'.<sup>1342</sup> Hence, the

<sup>1337</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [15]; *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [27].

<sup>1338</sup> *Mitchell v BBC* [2011] EWPC 42 [54].

<sup>1339</sup> *Ibid* [147]; Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 195.

<sup>1340</sup> *Mitchell v BBC* [2011] EWPC 42 [54].

<sup>1341</sup> *Ibid* [129].

<sup>1342</sup> *Ibid* [128]; Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 195.

claimant could not convince the judge of more than that it was possible for a BBC employee to have seen the ‘Bounce Bunch’ before broadcasting ‘Kerwhizz’. In addition, the BBC had called on ten witnesses who gave evidence that ‘Kerwhizz’ was developed independently of the ‘Bounce Bunch’.

Where to draw the line between an unprotected idea and protected expression of ideas cannot exactly be pointed out.<sup>1343</sup> Although one cannot say with 100 per cent certainty what the outcome of the individual case will be, and although hence the scope of protection is somewhat uncertain, the principle (ideas are unprotected, but their expression is protected) is a basic rule in many jurisdictions,<sup>1344</sup> including the UK. It is also set down in Article 9(2) of the TRIPS Agreement 1994. Despite its opacity, a certain amount of legal certainty can be achieved by following a few general guidelines.

Birss J’s excellent observations in *Mitchell v BBC* on the AFCs’ attributes are particularly useful for this thesis, as it gives many examples of how detailed similarities would have to be and when an element is nothing more than conceptual and therefore still at the idea stage. The BBC illustrated the generic nature of the characters’ features by producing examples of other characters which could also have influenced the creation of the ‘Kerwhizz’ characters and had a feature with the ‘Kerwhizz’ and ‘Bounce Bunch’ in common. For example, ‘Buzz Lightning’ and the *Star Wars* ‘Storm Troopers’ also wear chunky body armour, the space man ‘Lunar Jim’ wears a blue suit and has a blond quiff, the ‘Power Rangers’ are also a group of heroes, each hero of which has been designated its own colour.<sup>1345</sup> For one thing, e.g. body armour is generic. For another thing, when one compares the body armour of the ‘Kerwhizz’ and the ‘Bounce Bunch’ characters, one finds these are different from each other.<sup>1346</sup> The same applies to the mics, stalks, and shoulder grommets. Although there is some similarity, it is merely conceptual.<sup>1347</sup> Other similarities, such as that all the characters have separate fingers, is ‘wholly commonplace’.<sup>1348</sup> Lord Hoffmann had given the same guideline on

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<sup>1343</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [83]; *Baigent v Random House Group Ltd* [2008] EMLR 7 [H11] and [147]; *Plix Products v Frank M Winstone Ltd* [1986] FSR 63, 93.

<sup>1344</sup> JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 254.

Jurisdictions who employ this principle are, e.g. Canada (see para 6.2.1.4.), the USA (Copyright Act 1976, Title 17 § 102(b)) (see para 6.3.1.4), Germany (see para 7.2.1.2.4.), and France (see para 7.3.1.2.).

<sup>1345</sup> *Mitchell v BBC* [2011] EWPC 42 [128].

<sup>1346</sup> *Ibid* [129] et seq.

<sup>1347</sup> *Ibid* [135] et seq.

<sup>1348</sup> *Ibid* [137].



the idea/expression dichotomy. If an 'idea' is commonplace, it is not copyright protected.<sup>1349</sup>

Further, Birss J pointed out that yellow is not an original colour and that there were not many options to choose from.<sup>1350</sup> That means, the fewer choices there are, the more leeway must copyright leave for other creators, so that these will be able to still create something without automatically infringing somebody else's copyright.

Lord Hoffmann also provided an example of commonplace artwork in *Designers Guild v Russell Williams*: a combination of stripes and flowers representing a fabric design.<sup>1351</sup> Consequently, a LFC, which is made up of several character traits like a construction kit, would have to be much more complex, in particular because a judge would have to bear in mind that there are only so many 'bricks' in the 'building set'.

Basically, it is a matter of degree of originality whether a LFC is still at the unprotectable 'mere idea'-stage or whether it is so detailed, that it has metamorphosed into copyright protected expression.<sup>1352</sup>

### 8.3.2. Originality

According to section 1(1)(a), the literary work must be original for it to attract copyright.<sup>1353</sup> The same applies to a (substantial) part of a work.<sup>1354</sup> The reference to

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<sup>1349</sup> *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [26] and [41]; Simon Stokes, *Digital Copyright – Law and Practice* (Hart Publishing 2014) 117; Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1689; Deming Liu, 'Reflections on the idea/expression dichotomy in English copyright law' (2017) 1 JBL 71, 78.

<sup>1350</sup> *Mitchell v BBC* [2011] EWPC 42 [140].

<sup>1351</sup> *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [26]; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 53; Deming Liu, 'Reflections on the idea/expression dichotomy in English copyright law' (2017) 1 JBL 71, 78 et seq.

<sup>1352</sup> *Nova Productions Ltd v Mazooma Games Ltd, Nova Productions Ltd v Bell Fruit Games Ltd* [2007] EWCA Civ 219 [33]; Jennifer Davis, *Intellectual property law* (4<sup>th</sup> edn, OUP 2012) 50.

<sup>1353</sup> *Sawkins v Hyperion Records Ltd* [2005] EWCA Civ 565 [31]; *Godfrey v Lees* [1995] EMLR 307, 308 (regarding a musical work); Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 88.

<sup>1354</sup> Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569, para 39; *SAS Institute Inc v World Programming Ltd* [2015] ECDR 17 [H14]; Tanya Aplin and Jennifer Davis,

work under this heading shall refer to both a work as a whole as well as a substantial part of it.

Without originality, a work would not be protected by copyright. Literary merit is not required for a literary work to be copyright protected.<sup>1355</sup> The courts are arguably free from any obligation to consider the work's aesthetic quality.<sup>1356</sup> The purpose for which the work was created is arguably not relevant either.<sup>1357</sup> Neither does the originality requirement demand that a work is innovative.<sup>1358</sup> Instead, copyright is concerned with the expression of thought. The work shall not be copied from the work of another author. The work shall originate from the author and be an independent creation.<sup>1359</sup> However, to say that the legal concept of originality only requires that a work must stem from the author of the work in question would mean to equate the term 'original' with the term 'to originate'. Instead, originality was<sup>1360</sup> measured by skill, labour and judgment, which were invested in the creation of the work by its author.<sup>1361</sup> By merely

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*Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 123; Lionel Bently and Brad Sherman, *Intellectual Property Law* (4<sup>th</sup> edn, OUP 2014) 204.

<sup>1355</sup> *Sawkins v Hyperion Records Ltd* [2005] EWCA Civ 565 [31]; *Walter v Lane* [1900] AC 539, 548; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 55; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 88; Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond*, Vol 1 (2<sup>nd</sup> edn, OUP 2006) 404 and 413; Deming Liu, 'Of originality: originality in English copyright law: past and present' (2014) 36 EIPR 376, 377.

<sup>1356</sup> Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond*, Vol 1 (2<sup>nd</sup> edn, OUP 2006) 404.

This shall be discussed in more further down in this chapter. See para 8.3.4.3.

<sup>1357</sup> Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond*, Vol 1 (2<sup>nd</sup> edn, OUP 2006) 404; Christian Handig, 'The copyright term "work" – European harmonisation at an unknown level' (2009) 40 IIC 665, 669.

This is also affected by the discussion on substantiality later in this chapter. See para 8.3.4.3.

<sup>1358</sup> *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890 [19]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 117; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 192; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 44; Neil Yap, 'The proof is in the plating: copyright protection of culinary arts and reform for the categories of authorial works' (2017) 39 EIPR 226, 227; Deming Liu, 'Of originality: originality in English copyright law: past and present' (2014) 36 EIPR 376, 377.

<sup>1359</sup> *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890 [19]; *University of London Press, Ltd v University Tutorial Press, Ltd* [1916] 2 Ch 601, 608 et seq; Gillian Davies and Kevin Garnett, *Moral rights* (2<sup>nd</sup> edn, Sweet & Maxwell 2017) 96 et seq; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 44; Deming Liu, 'Of originality: originality in English copyright law: past and present' (2014) 36 EIPR 376, 377; Eleonora Rosati, 'Originality in US and UK copyright experiences as a springboard for an EU-wide reform debate' (2010) 41 IIC 524, 531; Christian Handig, 'The copyright term "work" – European harmonisation at an unknown level' (2009) 40 IIC 665, 675.

<sup>1360</sup> As will be discussed in more detail later, due to EU case-law etc., the current sole criterion for originality of a work in all EU member states is that the work is the author's own intellectual creation.

<sup>1361</sup> *Signature Realty Ltd v Fortis Developments Ltd* [2016] EWHC 3583 [51]; *JHP Ltd v BBC Worldwide Ltd* [2008] EWHC 757 [732]; *Express Newspapers Plc v News (UK) Ltd* [1990] 1 WLR

requiring that a work is not copied from another's work and that the work also exhibits a degree of skill and labour, the originality threshold in the UK was lower than in continental European countries such as Germany, which requires 'creative originality' (*Schöpfungshöhe* = level of creativity),<sup>1362</sup> and France, which also requires an element of creativity.<sup>1363</sup> Despite this higher level of originality that is required in these jurisdictions, LFCs are copyrightable there.

EU law sought to harmonise the originality requirement. The new standard for 'originality' is that the work must be the author's own intellectual creation.<sup>1364</sup> This criterion can be found in several EU Directives<sup>1365</sup> and EU case-law.<sup>1366</sup> Directive 91/250/EEC Article 1(3) stipulates that 'A computer program shall be protected if it is original in the sense that it is the author's own intellectual creation.'<sup>1367</sup> Directive 96/9/EC Article 3(1) stipulates that 'In accordance with this Directive, databases which,

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1320, 1326 (Ch D); *Ladbroke (Football), Ltd v William Hill (Football), Ltd* [1964] 1 WLR 273, 277 et seq; *University of London Press, Ltd v University Tutorial Press, Ltd* [1916] 2 Ch 601, 604, 609 and 611; Eleonora Rosati, 'Originality in US and UK copyright experiences as a springboard for an EU-wide reform debate' (2010) 41 IIC 524, 537.

<sup>1362</sup> Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 120; Mira T Sundara Rajan, 'Moral rights in information technology: A new kind of "personal right"' (2004) 12 Int J Law Info Tech 32, 45; Gerhard Schricker, 'Farewell to the "Level of Creativity" (Schöpfungshöhe) in German Copyright Law?' (1995) 26 IIC 41.

<sup>1363</sup> 'Case comment – France: Intellectual Property Code, art.L.111-1; copyright protection of a conceptual work of art – "Paradis" (2009) 40 IIC 485 (case comment on *Bettina Rheims v M Jakob Gautel and ors*).

<sup>1364</sup> Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 123; David I Bainbridge, *Information Technology and Intellectual Property Law* (6<sup>th</sup> edn, Bloomsbury Professional 2014) 25; Alison Struthers, 'Copyright protection for magic tricks: a danger lurking in the shadows?' (2017) 39 EIPR 136, 140; Andreas Rahmatian, 'European copyright inside or outside the European Union: pluralism of copyright laws and the "Henderian paradox"' (2016) 47 IIC 912, 927; Deming Liu, 'Of originality: originality in English copyright law: past and present' (2014) 36 EIPR 376, 381.

<sup>1365</sup> Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs [1991] OJ L122/42, art 1(3); Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases [1996] OJ L77/20, art 3(1); 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) [2006] OJ L372/12, art 6.

<sup>1366</sup> Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569, paras 34 - 39; C-393/09 *Bepečnostní softwarová asociace – Svaz softwarové ochrany v Ministerstvo kultury* [2010] ECR I-13971, paras 45 et seq; Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, paras 97 et seq; Case C-145/10 *Eva-Maria Painer v Standard VerlagsGmbH, Axel Springer AG, Süddeutsche Zeitung GmbH, SPIEGEL-Verlag Rudolf AUGSTEIN GmbH & Co KG and Verlag M DuMont Schauberg Expedition der Kölnischen Zeitung GmbH & Co KG* [2011] ECR I-12533, paras 87 et seq; Case C-604/10 *Football Dataco v Yahoo! UK Ltd* [2012] ECDR 10, para 37; Case C-406/10 *SAS Institute Inc v World Programming Ltd* [2012] CMLR 4, para 45.

<sup>1367</sup> Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs [1991] OJ L122/42, art 1(3).

by reason of the selection or arrangement of their contents, constitute the author's own intellectual creation shall be protected as such by copyright.'<sup>1368</sup> Article 3(1) of the Directive on the legal protection of databases was implemented in the UK in section 3A(2). It reads as follows: 'For the purposes of this Part a literary work consisting of a database is original if, and only if, by reason of the selection or arrangement of the contents of the database the database constitutes the author's own intellectual creation.'

The CJEU held in *Infopaq* that the act of storing and printing an extract (here consisting of eleven keywords) from newspaper articles during a data capture process, could be a reproduction within the meaning of InfoSoc Directive Article 2, provided that the captured elements were 'the expression of the intellectual creation of their author'.<sup>1369</sup> The CJEU followed this decision in *Bezpečnostní softwarová asociace* regarding graphic user interfaces. The CJEU held that such an interface can be copyright protected as a work, if it is the own intellectual creation of the author.<sup>1370</sup> The same criterion was confirmed once again in *FAPL Ltd v QC Leisure* and *Karen Murphy v Media Protection Services Ltd*.<sup>1371</sup> However, sporting events, in particular football matches, were not considered intellectual creations. Sporting events have to follow rules. The rules of the game leave no latitude for creative freedom.<sup>1372</sup> The same standard was applied in *Painer v Standard VerlagsGmbH* to portrait photographs of

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<sup>1368</sup> Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases [1996] OJ L77/20, art 3(1).

<sup>1369</sup> Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569, para 51; Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 104; Estelle Derclaye, 'Infopaq International A/S v Danske Dagblades Forening (C-5/08): wonderful or worrisome? The impact of the ECJ ruling in *Infopaq* on UK copyright law' (2010) EIPR 247, 248.

<sup>1370</sup> C-393/09 *Bezpečnostní softwarová asociace – Svaz softwarové ochrany v Ministerstvo kultury* [2010] ECR I-13971, para 46; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 76; Iona Harding, 'Fashion and copyright: weaving our way towards increased protection' (2013) 35 EIPR 183, 188; Andreas Rahmatian, 'Originality in UK copyright law: the old "skill and labour" doctrine under pressure' (2013) 44 IIC 4, 8; Mireille van Eechoud, 'Along the road to Uniformity – Diverse Readings of the Court of Justice Judgments on Copyright Work' (2012) 3 JIPITEC 60, 64.

<sup>1371</sup> Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, paras 97 et seq.

<sup>1372</sup> *Ibid*, paras 96 - 99. Although the CJEU denied copyright protection to football games, it acknowledged copyright in broadcasts or parts thereof, such as the opening video sequence, the anthem of the Premier League, a film of compiled highlights of football matches [para 149].

Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 76; Deming Liu, 'Of originality: originality in English copyright law: past and present' (2014) 36 EIPR 376, 383.

Natasha Kampush.<sup>1373</sup> The CJEU also held in *SAS Institute Inc v World Programming Inc* with regard to functionalities of a computer program and the SAS programming language that the national court had to determine ‘whether the reproduction of those elements constitutes the reproduction of the expression of the intellectual creation of the author of the user manual for the computer program’.<sup>1374</sup>

Ten years after the Database Directive, the Term of Protection Directive came into force. This Directive confirms too, but for photographs, that ‘Photographs which are original in the sense that they are the author’s own intellectual creation shall be protected’.<sup>1375</sup>

Although the ‘author’s own intellectual creation’ has been mentioned only in some specific directives, this criterion does not only apply to computer programs and databases. This criterion applies to all works which are copyright protected under the CDPA 1988, i.e. literary, musical, artistic, dramatic works, etc.<sup>1376</sup> Derclaye opined that the originality requirement was only harmonised for three types of works, namely computer programs, databases and photographs.<sup>1377</sup> So does Höppner.<sup>1378</sup> However,

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<sup>1373</sup> Case C-145/10 *Eva-Maria Painer v Standard VerlagsGmbH* [2011] ECR-12533, paras 87 - 89; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 125; Kevin Bercimuelle-Chamot, ‘The party claiming copyright infringement in a photograph must first prove its originality’ (2015) 10 *Journal of Intellectual Property Law & Practice* 734; Eleonora Rosati, ‘First Circuit applies idea/expression dichotomy and originality to news photographs’ (2013) 8 *Journal of Intellectual Property Law & Practice* 356, 357; Mireille van Eechoud, ‘Along the road to Uniformity – Diverse Readings of the Court of Justice Judgments on Copyright Work’ (2012) 3 *JIPITEC* 60, 67.

<sup>1374</sup> Case C-406/10 *SAS Institute Inc v World Programming Inc* [2012] 3 CMLR 4, paras 68 et seqq.

<sup>1375</sup> 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) [2006] OJ L372/12, art 6.

<sup>1376</sup> Case C-5/08 *Infopaq International v Danske Dagblades Forening* [2009] ECR-6569, paras 30 - 35, 37 et seqq; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 123; JAL Sterling and Estelle Derclaye, ‘Protection Criteria’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 349 and 384 et seq; Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 4; William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 440; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 198.

<sup>1377</sup> Estelle Derclaye, ‘Assessing the impact and reception of the Court of Justice of the European Union case law on UK copyright law: what does the future hold?’ (2014) 240 *RIDA* 5 et seq <[http://eprints.nottingham.ac.uk/3613/2/RIDA\\_article\\_derclaye\\_April\\_2014\\_eprints.pdf](http://eprints.nottingham.ac.uk/3613/2/RIDA_article_derclaye_April_2014_eprints.pdf)> accessed 14 March 2017.

<sup>1378</sup> Thomas Höppner, ‘Reproduction in part of online articles in the aftermath of *Infopaq* (C-5/08): *Newspaper Licensing Agency Ltd v Meltwater Holding BV*’ (2011) 33 *EIPR* 331, 332.

this can be easily countered. The CJEU had concluded in *Infopaq* that Article 2(a) of the InfoSoc Directive regarding the reproduction right for authors and their works intended copyright liability only for ‘subject-matter which is original in the sense that it is its author’s own intellectual creation.’ Recital 4 of the InfoSoc Directive states indirectly that the purpose of this Directive is to harmonise the legal framework on copyright and related rights as it will foster substantial investment in innovation and creativity.<sup>1379</sup> Recital 4 does not refer exclusively to computer programs, databases and photographs. In fact, it does not refer to any particular categories of works. Hence, all types of works, which the individual member states chose to protect within the framework of the Berne Convention 1886, have to adhere to the same originality requirement. Moreover, the *acquis communautaire* should be interpreted autonomously and uniformly,<sup>1380</sup> because one of the purposes of the copyright directives in general is the harmonisation of copyright law in the EU member states.<sup>1381</sup> If the originality standard was different for each of the above directives, there would be different levels of harmonisation (definition A of originality for works subject to directive A, definition B of originality for works subject to directive B).

Therefore, the CJEU harmonised the originality requirement for all types of works. Moreover, the CJEU stated in *Infopaq* that a part of a work can only amount to an infringing reproduction, if that part itself is original, i.e. the author’s own intellectual creation.<sup>1382</sup> Silverman believes that this harmonisation meant at the same time that the CJEU had ‘collapsed the originality requirement into the notion of “work”’.<sup>1383</sup> If

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<sup>1379</sup> 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, [2001] OJ L167/10, recital 4; Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569, para 8; Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 106 et seq.

<sup>1380</sup> Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, para 188; Case C-467/08 *Padawan SL v SGAE* [2010] ECR I-10055, para 32; Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569, para 27; Case C-306/05 *SGAE v Rafael Hoteles SL* [2006] ECR I-11519, para 31; Case 327/82 *Ekro BV Vee- en Vleeshandel v Produktschap voor Vee en Vlees* [1984] ECR-I 107, para 11; Case C-245/00 *Stichting ter Exploitatie van Naburige Rechten (SENA) v Nederlandse Omroep Stichting (NOS)* [2003] ECR I-1251, para 23; Christian Handig, ‘The “sweat of the brow” is not enough! – more than a blueprint of the European copyright term “work”’ (2013) 35 EIPR 334; Christian Handig, ‘The copyright term “work” – European harmonisation at an unknown level’ (2009) 40 IIC 665, 671.

<sup>1381</sup> Christian Handig, ‘The copyright term “work” – European harmonisation at an unknown level’ (2009) 40 IIC 665, 671.

<sup>1382</sup> Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569, para 38.

<sup>1383</sup> Iona Silverman, ‘Copyright and fashion: friends at last?’ (2013) 35 EIPR 637, 642.

anything that is the author's own intellectual creation is a work, then its copyright protection would not depend on what category of work it is. The CDPA's closed list of works would not make sense anymore, and changing the CDPA 1988 to an open list would be mandatory. There is doubt whether the CJEU had meant this. Not everything that is an intellectual creation is a work. For example, a scientific theory (outside the confines of a literary work) can be an intellectual creation, but not a work. Copyright does not extend to ideas, that includes scientific theories, according to TRIPS 1994 Article 9(2) and WIPO Copyright Treaty 1996 Article 2.

Consequently, national copyright systems may retain an exhaustive list of works, as long as these reflect Articles 1 and 2(1) of the Berne Convention 1886 according to which artistic and literary works are protected.<sup>1384</sup> The new standard for determining originality of the acknowledged categories of works shall be applied to all of these works.

UK cases that are to be decided need to reflect this definition. UK cases decided prior to these EU directives and EU decisions have to be interpreted in accordance with these. However, the Court of Appeal declared in *NLA v Meltwater* that this will not lead to a change of the traditional labour, skill and judgment approach.<sup>1385</sup> If there is a difference at all, then the EU test is stricter than the domestic one.<sup>1386</sup>

The idea of a creativity element in the originality requirement is not entirely new to the UK. The defendant in *Interlego AG v Tyco Industries, Inc*<sup>1387</sup> had already tried to convince the Privy Council back then that originality does not require the work to be 'new in the absolute sense'.<sup>1388</sup> There must be creative input by the creator of the

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<sup>1384</sup> This includes every production in the literary, artistic and scientific domain, regardless of its form or mode of expression.

<sup>1385</sup> *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890 [20]; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 196; Iona Harding, 'Fashion and copyright: weaving our way towards increased protection' (2013) 35 EIPR 183, 188.

<sup>1386</sup> Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 196; Deming Liu, 'Of originality: originality in English copyright law: past and present' (2014) 36 EIPR 376, 381.

<sup>1387</sup> *Interlego AG v Tyco Industries, Inc and others* [1989] AC 217.

<sup>1388</sup> *Ibid* 232.

work,<sup>1389</sup> but it is a matter of degree whether a work is original.<sup>1390</sup> This defendant voiced the opinion that the skill and labour that somebody expends in copying another's work (e.g. by the choice of source material and the choice of words used to express the work) is irrelevant.<sup>1391</sup> The Privy Council concurred mostly. It did not accept that a person's skill and labour were entirely irrelevant. The House of Lords, too, still pointed out in *Designers Guild v Russell Williams* that a work must be an original product of skill and labour,<sup>1392</sup> which means that more than skill and labour is required for originality. However, the Privy Council acknowledged in *Interlego* that skill and labour alone were not sufficient to bestow originality on a work and its author. The additional requirement for originality of a work as per the Privy Council was that there had to be alterations which changed the work materially.<sup>1393</sup> Even a small alteration could transform a work, which copied substantially from the earlier work, into an original work, if the alteration is material in relation to the totality of the earlier work. This is a question of degree.<sup>1394</sup> Originality is a question of degree.<sup>1395</sup> So are the taking of a substantial part and copyright infringement. It is submitted that the Privy Council's view that skill and labour is insufficient to judge a work's originality is correct arguably, but the approach it took was erroneous. Rather than modifications, the court should have considered the similarities of the works in question.

In order to establish whether a later work has infringed copyright in the earlier work by copying a substantial part of the earlier work, the courts commonly compare the

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<sup>1389</sup> Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, para 98; Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 5.

<sup>1390</sup> Estelle Derclaye, 'Assessing the impact and reception of the Court of Justice of the European Union case law on UK copyright law: what does the future hold?' (2014) 240 RIDA 12 <[http://eprints.nottingham.ac.uk/3613/2/RIDA\\_article\\_derclaye\\_April\\_2014\\_eprints.pdf](http://eprints.nottingham.ac.uk/3613/2/RIDA_article_derclaye_April_2014_eprints.pdf)> accessed 14 March 2017.

<sup>1391</sup> *Interlego AG v Tyco Industries, Inc and others* [1989] AC 217, 232.

<sup>1392</sup> *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [2] et seq; Simon Stokes, *Digital Copyright – Law and Practice* (Hart Publishing 2014) 7.

<sup>1393</sup> *Interlego AG v Tyco Industries, Inc and others* [1989] AC 217, 263; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 115; Andreas Rahmatian, 'Originality in UK copyright law: the old "skill and labour" doctrine under pressure' (2013) 44 IIC 4, 13.

<sup>1394</sup> *Interlego AG v Tyco Industries, Inc and others* [1989] AC 217, 263.

<sup>1395</sup> *Nova Productions Ltd v Mazooma Games Ltd, Nova Productions Ltd v Bell Fruit Games Ltd* [2007] EWCA Civ 219 [33]; Estelle Derclaye, 'Assessing the impact and reception of the Court of Justice of the European Union case law on UK copyright law: what does the future hold?' (2014) 240 RIDA 12 <[http://eprints.nottingham.ac.uk/3613/2/RIDA\\_article\\_derclaye\\_April\\_2014\\_eprints.pdf](http://eprints.nottingham.ac.uk/3613/2/RIDA_article_derclaye_April_2014_eprints.pdf)> accessed 14 March 2017; Jennifer Davis, *Intellectual property law* (4<sup>th</sup> edn, OUP 2012) 50.



elements both works have in common as well as the differences between the works.<sup>1396</sup> However, the differences do not have much bearing. Differences should only be identified to ascertain the similarities.<sup>1397</sup> The copied common parts determine whether a substantial part has been copied in relation to the whole work.<sup>1398</sup>

Even then, a court may find the later work instead of the earlier work original. If e.g. the common parts are too general or, recognizable, but insignificant in relation to the whole work, the later work is original. This comparison and analysis is a natural consequence of the fact that a work must originate from an author to be original. A material alteration and thus originality of the later work is also the result of that author's own choices, i.e. the selection and arrangement of the material, even if the material comes from a common source.<sup>1399</sup>

Earlier cases had already found that copyright does not only protect the skill and labour that the author invests in creating her work, but also the skill and labour which the author employs in selection and compilation.<sup>1400</sup> Later cases adopted this approach too.<sup>1401</sup> For example, Lord Hoffmann highlighted in *Designers Guild v Russell Williams* that the author's choice and the cumulative effect of the material is relevant for the qualitative assessment of copyright material.<sup>1402</sup> The author's choice of elements, words and their combination makes a work individual and gives it a personal mark. Hence, it seems as if the UK's originality requirement was quite close to the requirement of intellectual creation for originality introduced by EU case-law.

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<sup>1396</sup> *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [41].

<sup>1397</sup> Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 263.

<sup>1398</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 166.

<sup>1399</sup> Lionel Bently and Brad Sherman, *Intellectual Property Law* (4<sup>th</sup> edn, OUP 2014) 199.

<sup>1400</sup> *Ravenscroft v Herbert* [1980] RPC 193, 194; *Harman Pictures NV v Osborne* [1967] 1 WLR 723, 732; *Elanco Products Ltd v Mandops (Agrochemical Specialists) Ltd and Another* [1979] FSR 46, 48 and 52; *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 277 HL; Caroline Turner and Alys Lewis, 'Sequel rights: are fictional characters, plots and themes protectable?' (*Harbottle & Lewis LLP*, Sept 2008) 10 <<http://www.legal500.com/developments/5437>> accessed 07 November 2016.

<sup>1401</sup> *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 [18], [20] and [70]; *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [82]; *Baigent v Random House Group Ltd* [2008] EMLR 7 [141].

<sup>1402</sup> *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [25].

Some UK courts have adopted the ‘creativity standard’ as a consequence of *Infopaq* and subsequent CJEU rulings, which followed *Infopaq*.<sup>1403</sup> However, some scholars argue that the new standard is equivalent to the former skill, labour, judgment standard. For example, Torremans maintains that the old standard (skill, labour, judgment) and the new standard (the author’s own intellectual creation) may be (almost) identical despite its different phraseology.<sup>1404</sup> He refers to *The Newspaper Licensing Agency Ltd v Meltwater Holding BV*. Therein, the Court of Appeal concurred that *Infopaq* did not affect the meaning of the term ‘originality’.<sup>1405</sup> The term ‘original’ does not mean that the work must be innovative, but that it originated from the author.<sup>1406</sup> The court states explicitly that:

an ‘intellectual creation’ ... clearly relates such creation to the question of origin not novelty or merit. Accordingly, I do not understand the decision of the European Court of Justice in *Infopaq* to have qualified the long standing test established by the authorities.<sup>1407</sup>

As skill and judgment refer to a human author’s application of her human intellect when creating the work,<sup>1408</sup> Jackson LJ’s and Torremans’s view are reasonable. Indeed, some courts continue to apply the labour, skill, and judgment test.<sup>1409</sup> Proudman J makes no reference to the new originality standard and instead states in *Future Publishing Ltd v The Edge Interactive Media Inc* that originality requires ‘the

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<sup>1403</sup> *Ogunkoya v Harding* [2017] EWHC 470 (IEPC) [32]; *Starbuck v Patsystem (UK) Ltd* [2017] EWHC 397 [63] et seq; *John Kaldor Fabricmaker UK Ltd v Lee Ann Fashions Ltd* [2015] ECDR 2; *Hodgson v Isaac* [2012] ECC 4 [78], [80] and [82].

<sup>1404</sup> Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 189 and 199. Torremans speaks first of ‘almost identical concepts’ on page 189. Later, on page 199, he writes that ‘The actual difference may be very small or non-existent’.

<sup>1405</sup> Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 115.

<sup>1406</sup> *The Newspaper Licensing Agency Ltd and others v Meltwater Holding BV and others* [2011] EWCA Civ 890 [19].

<sup>1407</sup> *Ibid* [20]; Andreas Rahmatian, ‘Originality in UK copyright law: the old “skill and labour” doctrine under pressure’ (2013) 44 IIC 4, 28.

<sup>1408</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 41.

<sup>1409</sup> *Taylor v Maguire* [2013] EWHC 3804 [6] and [8]; *Forensic Telecommunications Services v The Chief Constable of West Yorkshire Police* [2012] FSR 15 [84] and [94]; *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 [31]; JAL Sterling and Estelle Derclaye, ‘Protection Criteria’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 386.

expenditure of more than negligible or trivial effort or relevant skill in the creation of the work'.<sup>1410</sup>

This is supported by Birss J in *Temple Island*.<sup>1411</sup> He referred to both the 'own intellectual creation' as well as 'the skill and labour of the author' when establishing that the claimant's black and white photograph, showing the Houses of Parliament and a red bus crossing the bridge, was original. He seemed to think that both concepts are interchangeable. Birss J's exact words were that copyright in a photograph may be infringed by recreating the photographed scene, 'when the skill and labour of the author (or in *Infopaq* terms the author's intellectual creative effort) went into creating the scene which was photographed'.<sup>1412</sup> This passage from Birss J's judgment suggests, arguably, that the UK's skill and judgment test is an equivalent of the 'own intellectual creation' test.

Although Clarke J does not explicitly equate the new with the old standard in *Taylor v Maguire*, he too applies a combination of the old and new standard.<sup>1413</sup> He states that a work is original, if the author 'has made an original contribution in creating it – for example by applying intellectual effort in its creation'.<sup>1414</sup> He continues then that the work must be the result of the author's (here: artist's) 'independent skill and labour'.<sup>1415</sup> It is striking that after having mentioned the old standard, he goes ahead and lists the detailed choices the artist had to make for the creation of the papercuts. The term 'choice' is a component characteristic of the new originality standard.<sup>1416</sup> True to his combination style, Clarke J concludes that 'All of these choices bring the Claimant's

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<sup>1410</sup> *Future Publishing Ltd v The Edge Interactive Media Inc and others* [2011] EWHC 1489 [10]. More than trivial effort or relevant skill in the creation of the work was also required in *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565 [85] ('beyond mere servile copying'); *Autospin (Oil Seals) Ltd v Beehive Spinning* [1995] RPC 683, 694; *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 287.

<sup>1411</sup> *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 126.

<sup>1412</sup> *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 [31].

Arnold J also applies both the new and old originality standard in *Forensic Telecommunications Services v The Chief Constable of West Yorkshire Police* [2012] FSR 15 [84] and [94].

Floyd J applies his own test ('judgment, taste or discretion'), but also accepts that 'the author's own intellectual creation' test should be applied as well. *Football Dataco Ltd v Britten Pools Ltd* [2010] EWHC 841 [86] et seq and [91].

<sup>1413</sup> *Taylor v Maguire* [2013] EWHC 3804.

<sup>1414</sup> *Ibid* [6].

<sup>1415</sup> *Ibid* [8].

<sup>1416</sup> *Ibid* [20].

independent labour and skill to the finished work.’<sup>1417</sup> Like the above-mentioned decisions in *Temple Island v New English Teas*, *NLA v Meltwater Holding BV* and *Future Publishing v The Edge*, this suggests that Clarke J regards the old and the new standard as equivalents, or at least did not accept that the new standard replaced the skill and labour requirement.

Bainbridge is also of the opinion that there is only a semantic difference between ‘skill and judgment’ and ‘the author’s own intellectual creation’. He maintains that the fact that UK copyright law denies protection to trivial works, such as single words or titles, supports his view.<sup>1418</sup> Not everyone will agree with this argument. For one thing, headlines were held capable of attracting copyright in *NLA v Meltwater*.<sup>1419</sup> In principle, ‘what is not copied is original’.<sup>1420</sup> A work did not have to be unique to attract copyright.<sup>1421</sup> It was up to the *de minimis* principle to prevent too broad copyright protection. The *de minimis* threshold in the UK was so low that even solicitors’ directories enjoyed copyright protection in the past.<sup>1422</sup>

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<sup>1417</sup> Ibid.

<sup>1418</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 44. In agreement: Reuben Stone, ‘Copyright protection for titles, character names and catch-phrases in the film and television industry’ (1996) 5 Ent LR 178, 179.

<sup>1419</sup> *The Newspaper Licensing Agency Ltd and others v Meltwater Holding BV and others* [2011] EWCA [22] and [28], confirming *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2010] EWHC 3099 [71] and [85]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 82 et seq.

*Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 286 maintains that copyright in titles will neither be granted as a rule nor should it be denied in general. He cites *Francis Day & Hunter Ltd v Twentieth Century Fox Corpn* [1940] AC 112, 123 (As a general rule, a title is not copyrightable by itself, but it could be of such an important character that it attracts copyright. That was not so under the facts of the case.); *Lamb v Evans* [1893] 1 Ch 218, 224 and 227 (The headings of books were subject to copyright protection.); *Dick v Yates* [1881] 18 Ch 76, 89 (An original title can attract copyright, but in the present case did not.)

The following decision also believes that copyright protection of titles should not be excluded per se, but that the title would need such qualities which warrant its recognition as a literary work instead of just an invented word. *Exxon Corporation v Exxon Insurance Consultants International Ltd* [1982] Ch 119, 138.

<sup>1420</sup> William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 439.

<sup>1421</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 44.

<sup>1422</sup> *Waterlow Publishers Ltd v Rose* [1995] FSR 207, 208; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 200 et seq; Andrew McGee, Alexandrine Cerfontaine and Gary Scanlan, ‘Creativity and Form as Grounds for Copyright Protection in English Law’ (2001) *Commercial Liability Law Review* 73, 75.

Ricketson and Ginsburg too equate creativity with originality, and aver that creativity is unconcerned with aesthetic quality. They maintain that creativity refers to the way in which a work comes into being, an act of intellectual creation.<sup>1423</sup> However, Birss J disagreed in the 2012 judgment *Hodgson v Isaac*, although he still referred to ‘skill’ and spoke of ‘the intellectual effort of creation’. Birss J stated clearly that whether the elements copied from a literary work are an expression of the author’s intellectual creation is a question of quality (rather than quantity) just like skill and labour was a matter of quality and importance of the element in relation to the whole work.<sup>1424</sup> Hence, the new and old standard are the same at least in that respect.

Davies et al in *Copinger*, too, believe that at least ‘there is no difference of substance’ between the creativity element of the author’s own intellectual creation and the exercise of an author’s skill and judgment.<sup>1425</sup> Both involve the process of choosing.<sup>1426</sup> However, as not every investment of skill involves creativity, it is the element of judgment that is rather like the element of creativity.<sup>1427</sup> Moreover, choice *per se* is not the same as original or as the act of creating something.<sup>1428</sup> A choice itself must be

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<sup>1423</sup> Sam Ricketson and Jane Ginsburg, *International Copyright and Neighbouring Rights – The Berne Convention and Beyond*, Vol 1 (2<sup>nd</sup> edn, OUP 2006) 404.

<sup>1424</sup> *Hodgson v Isaac* [2012] ECC 4 [78], ‘skill’ [77] ‘intellectual effort of the author’ [80] and [82]. In agreement: Estelle Derclaye, ‘Assessing the impact and reception of the Court of Justice of the European Union case law on UK copyright law: what does the future hold?’ (2014) 240 RIDA 14 <[http://eprints.nottingham.ac.uk/3613/2/RIDA\\_article\\_derclaye\\_April\\_2014\\_eprints.pdf](http://eprints.nottingham.ac.uk/3613/2/RIDA_article_derclaye_April_2014_eprints.pdf)> accessed 14 March 2017.

In agreement: *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890 [24]; Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 78.

<sup>1425</sup> Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 203.

Yap still believes in 2017 that ‘It is uncertain whether *Infopaq* has altered the standard of originality’. Neil Yap, ‘The proof is in the plating: copyright protection of culinary arts and reform for the categories of authorial works’ (2017) 39 EIPR 226, 228.

Harding agrees that the EU originality test is the correct test to use in the UK, but that this new test essentially has the same requirements as the former skill, labour, judgment test. Iona Harding, ‘Fashion and copyright: weaving our way towards increased protection’ (2013) 35 EIPR 183, 188. Torremans agrees that, although the new standard requires creativity, it is very much like the old standard. Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 199.

<sup>1426</sup> Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 203; Neil Yap, ‘The proof is in the plating: copyright protection of culinary arts and reform for the categories of authorial works’ (2017) 39 EIPR 226, 227.

<sup>1427</sup> Estelle Derclaye, ‘Assessing the impact and reception of the Court of Justice of the European Union case law on UK copyright law: what does the future hold?’ (2014) 240 RIDA 9 <[http://eprints.nottingham.ac.uk/3613/2/RIDA\\_article\\_derclaye\\_April\\_2014\\_eprints.pdf](http://eprints.nottingham.ac.uk/3613/2/RIDA_article_derclaye_April_2014_eprints.pdf)> accessed 14 March 2017.

<sup>1428</sup> Agustin Waisman, ‘Revisiting originality’ (2009) 7 EIPR 370, 375; Estelle Derclaye, ‘Assessing the impact and reception of the Court of Justice of the European Union case law on UK copyright law: what

creative. Otherwise it would be an unprotected unoriginal choice.<sup>1429</sup> Moreover, the UK standard would not let mere labour or effort suffice for originality either.

Hence, Davies et al acknowledge that a gap between the author's own creation and labour or effort exists, but that 'the practical effect of this difference may be very limited'.<sup>1430</sup> Rahmatian agrees that the practical difference of the application of the new originality requirement is minimal.<sup>1431</sup> Both tests would lead to the same result in most cases,<sup>1432</sup> especially since the national courts are given leeway when applying the new test.<sup>1433</sup>

If then the new and old standard are not equivalent after all, the skill, labour, judgment test cannot be applied any more. A strong argument in favour of this view is that, according to *Bezpečnostní softwarová asociace*, the national courts may not apply any other criteria than the author's own intellectual creation when determining whether the work is eligible for copyright protection according to the CJEU.<sup>1434</sup> The new originality standard was acknowledged e.g. in *John Kaldor Fabricmaker UK Ltd v Lee Ann Fashions Ltd*<sup>1435</sup> as well as other UK cases.<sup>1436</sup> Hacon HHJ stated that a work is entitled to copyright protection, if it is the 'expression of the intellectual creation of the author of the work'.<sup>1437</sup> He added that in that particular case, though, it did not make a difference under the given facts whether the old or new originality standard was

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does the future hold?' (2014) 240 RIDA 9 <[http://eprints.nottingham.ac.uk/3613/2/RIDA\\_article\\_derclaye\\_April\\_2014\\_eprints.pdf](http://eprints.nottingham.ac.uk/3613/2/RIDA_article_derclaye_April_2014_eprints.pdf)> accessed 14 March 2017.

<sup>1429</sup> Estelle Derclaye, 'Assessing the impact and reception of the Court of Justice of the European Union case law on UK copyright law: what does the future hold?' (2014) 240 RIDA 13 <[http://eprints.nottingham.ac.uk/3613/2/RIDA\\_article\\_derclaye\\_April\\_2014\\_eprints.pdf](http://eprints.nottingham.ac.uk/3613/2/RIDA_article_derclaye_April_2014_eprints.pdf)> accessed 14 March 2017.

<sup>1430</sup> Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 203.

<sup>1431</sup> Andreas Rahmatian, 'Originality in UK copyright law: the old "skill and labour" doctrine under pressure' (2013) 44 IIC 4, 30.

<sup>1432</sup> Ibid 31.

<sup>1433</sup> Ibid 30.

<sup>1434</sup> Case C-393/09 *Bezpečnostní softwarová asociace – Svaz softwarové ochrany v Ministerstvo kultury* [2010] ECR I-13971, para 45; Adolf Dietz, 'Germany' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[1][b] (Pub 399, Rel 28-12/2016); David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 44.

<sup>1435</sup> *John Kaldor Fabricmaker UK Ltd v Lee Ann Fashions Ltd* [2015] ECDR 2.

<sup>1436</sup> *Ogunkoya v Harding* [2017] EWHC 470 (IEPC) [32]; *Starbuck v Patsystem (UK) Ltd* [2017] EWHC 397 [63] et seq.

<sup>1437</sup> *John Kaldor Fabricmaker UK Ltd v Lee Ann Fashions Ltd* [2015] ECDR 2 [21].

applied.<sup>1438</sup> That means, the judge did not regard the old and new standard as identical. It just so happened that either standard would have arrived at the same outcome of the case due to the facts of the case.

The differing interpretations of *Infopaq* and subsequent rulings of the CJEU, which followed *Infopaq*, had resulted in inconsistent decisions in the UK and therefore uncertainty among potential plaintiffs and defendants. The natural consequence was that the Court of Appeal of England and Wales referred the following question to the CJEU in *Football Dataco v Yahoo!*: '[D]oes "author's own intellectual creation" require more than significant labour and skill from the author, if so what?'<sup>1439</sup> The answer to this question confirmed that the new standard is indeed a new standard for the UK. Both AG Mengozzi and the CJEU itself are in favour of that view. They make clear that the UK and the EU originality test are not the same and that the new originality standard follows the continental tradition.<sup>1440</sup> The author's own intellectual creation involves more than a consideration of origin.<sup>1441</sup> AG Mengozzi explains that the difference is that 'a "creative" aspect' is required under the new standard.<sup>1442</sup> A work is creative, if it reflects the author's personal touch as a result of the author's free and creative

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<sup>1438</sup> *Ibid.*

<sup>1439</sup> Case C-604/10 *Football Dataco v Yahoo! UK Ltd* [2012] ECDR 10, para 24.

<sup>1440</sup> For example in France, originality requires creativity. An author's work is creative, when the author has imprinted the work with her personality and thereby has given the work her individual signature. *Lemaitre c Société Guerlain* CA Paris, 4ème ch, s A, 11 juin 1997 [9]; André Lucas, Pascal Kamina and Robert Plaisant, 'France' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 1, § 2[1][b][iii][A] (Pub 399, Rel 28-12/2016); Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 63; Iona Silverman, 'Copyright and fashion: friends at last?' (2013) 35 EIPR 637, 641 et seq; Eleonora Rosati, 'Originality in a work, or a work of originality: the effects of the Infopaq decision' (2011) 33 EIPR 746, 747; Daniel J Gervais, 'Feist goes global: A comparative analysis of the notion of originality in copyright law' (2002) 49 J Copyright Soc'y USA 949, 968; André Lucas and Pierre Sirinelli, 'L'originalité en droit d'auteur' (1993) 23 La Semaine Juridique - Edition générale I 3681.

<sup>1441</sup> Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 5.

<sup>1442</sup> Case 604/10 *Football Dataco Ltd and others v Yahoo! UK Limited* [2012] ECDR 10, Opinion of AG Mengozzi, para 35.

choices.<sup>1443</sup> This personal touch is present in the work, if the work is the product of the author's unique abilities and echoes the author's personality.<sup>1444</sup>

Therefore, the mere application of skill or effort is insufficient for making a database a copyright protected intellectual creation.<sup>1445</sup> The CJEU followed the Advocate General.

[T]he fact that the setting up of the database required ... significant labour and skill of its author ... cannot as such justify the protection of it by copyright ... if that labour and that skill do not express any originality in the selection or arrangement of that data.<sup>1446</sup>

Hence, something more than just skill and effort is required for a finding of an intellectual creation protected by copyright. The CJEU followed AG Mengozzi's view that an author expresses her creative ability in an original manner by making free and creative choices, and leaving her individual personal touch on the work.<sup>1447</sup> That a work must have its author's personal touch is also underpinned by the fact that 'legal

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<sup>1443</sup> Ibid 40; Neil Yap, 'The proof is in the plating: copyright protection of culinary arts and reform for the categories of authorial works' (2017) 39 EIPR 226, 227 et seq; Andreas Rahmatian, 'European copyright inside or outside the European Union: pluralism of copyright laws and the "Henderian paradox"' (2016) 47 IIC 912, 927.

<sup>1444</sup> Case C-145/10 *Eva-Maria Painer v Standard VerlagsGmbH* [2011] ECR-12533, paras 88 and 92; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 125; Mira T Sundara Rajan, 'Moral rights in information technology: A new kind of "personal right"' (2004) 12 Int J Law Info Tech 32, 36.

<sup>1445</sup> Case 604/10 *Football Dataco Ltd and others v Yahoo! UK Limited* [2012] ECDR 10, Opinion of AG Mengozzi, paras 35 and 45; Andreas Rahmatian, 'European copyright inside or outside the European Union: pluralism of copyright laws and the "Henderian paradox"' (2016) 47 IIC 912, 928.

Handig agrees that, if the work lacks this personal touch, no amount of skill, labour, and judgment will suffice for copyright protection of the work. Christian Handig, 'The "sweat of the brow" is not enough! – more than a blueprint of the European copyright term "work"' (2013) 35 EIPR 334.

<sup>1446</sup> Case C-604/10 *Football Dataco v Yahoo! UK Ltd* [2012] ECDR 10, para 42; JAL Sterling and Estelle Derclaye, 'Protection Criteria' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 385; Andreas Rahmatian, 'European copyright inside or outside the European Union: pluralism of copyright laws and the "Henderian paradox"' (2016) 47 IIC 912, 928.

<sup>1447</sup> Case C-604/10 *Football Dataco v Yahoo! UK Ltd* [2012] ECDR 10, para 38; Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 107; JAL Sterling and Estelle Derclaye, 'Protection Criteria' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 385; William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 440; Deming Liu, 'Of originality: originality in English copyright law: past and present' (2014) 36 EIPR 376, 384.

In this connection, the CJEU invoked the prior decisions in *Infopaq* and *Painer*. Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569, para 45; Case C-145/10 *Eva-Maria Painer v Standard VerlagsGmbH* [2011] ECR-12533, paras 87 et seq and 92; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 123 and 125.



protection for moral rights assumes that the work is an extension of its author's personality'.<sup>1448</sup>

The terms 'creation' and 'personal touch' suggest a level of individuality that makes the work distinctive and distinguishable from pre-existing works.<sup>1449</sup> Basically, the term 'own intellectual creation' also means that the author of the work must have engaged in human mental activity and that this must have been distinct from the works others have created.<sup>1450</sup> If author A of a work chooses the expression that her work takes, instead of copying from another author's work, then author A has applied her intellect and brought her own intellectual creation into being.<sup>1451</sup>

To conclude, the new standard has raised the bar of originality,<sup>1452</sup> and the skill, labour and judgment test is gradually being supplanted by the author's own intellectual creation test.<sup>1453</sup> It is suggested that LFCs are copyrightable despite the raised bar of originality, which follows the continental model. German and French copyright law already offer copyright protection to LFCs. Now that the UK is using the same standard, one might rethink copyrightability of LFCs in the UK. The fact that the bar has been set higher does not reduce the chances of LFC copyrightability. In fact, it could have the opposite effect, because one of the reasons for denying LFC copyrightability in the UK

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<sup>1448</sup> Mira T Sundara Rajan, 'Moral rights in information technology: A new kind of "personal right"?' (2004) 12 Int J Law Info Tech 32, 48. This is a German concept. See para 1.5.2.

<sup>1449</sup> Christian Handig, 'The copyright term "work" – European harmonisation at an unknown level' (2009) 40 IIC 665, 672.

<sup>1450</sup> William Cornish, David Llewelyn and Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (8<sup>th</sup> edn, Sweet & Maxwell 2013) 439.

<sup>1451</sup> Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 199.

<sup>1452</sup> *SAS Institute Inc v World Programming Ltd* [2013] EWCA Civ 1482 [37]; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 126; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 199; Deming Liu, 'Of originality: originality in English copyright law: past and present' (2014) 36 EIPR 376, 381.

<sup>1453</sup> Case C-604/10 *Football Dataco v Yahoo! UK Ltd* [2012] ECDR 10, para 42; Case 604/10 *Football Dataco Ltd and others v Yahoo! UK Limited* [2012] ECDR 10, Opinion of AG Mengozzi, para 35; JAL Sterling and Estelle Derclaye, 'Protection Criteria' in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 385; Alison Struthers, 'Copyright protection for magic tricks: a danger lurking in the shadows?' (2017) 39 EIPR 136, 140; Deming Liu, 'Of originality: originality in English copyright law: past and present' (2014) 36 EIPR 376; Thomas Höppner, 'Reproduction in part of online articles in the aftermath of *Infopaq* (C-5/08): *Newspaper Licensing Agency Ltd v Meltwater Holding BV*' (2011) 33 EIPR 331, 332; Estelle Derclaye, '*Infopaq* International A/S v Danske Dagblades Forening (C-5/08): wonderful or worrisome? The impact of the ECJ ruling in *Infopaq* on UK copyright law' (2010) EIPR 247, 248; Stephen Vousden, '*Infopaq* and the Europeanisation of Copyright Law' (2010) WIPO Journal 197, 207 et seqq.

was that it would be too difficult to distinguish between copyrightable and non-copyrightable LFCs.<sup>1454</sup> The new originality standard brings new criteria to be considered. These make it safer for judges to decide whether a LFC attracts copyright, and easier to distinguish between copyrightable and non-copyrightable characters.

The CJEU made clear that a work can only then be the author's intellectual creation, if the creator has room for creative freedom.<sup>1455</sup> That means also that 'originality is based on the plurality of options, where the author has the possibility of selection'.<sup>1456</sup> The CJEU already stipulated in *Painer* as well as *FAPL v QC Leisure* that the author's own creativity should be understood as requiring the exercise of creative freedom.<sup>1457</sup> Authors of LFCs certainly have creative freedom and make use of it by choosing, after some deliberation, from a pool of physical attributes and personality characteristics which determine the LFC's beliefs, thoughts and behaviour. Simply amassing information for a work takes effort, but is not creative. However, the selection of that information, the deliberation on which elements to choose, and the weaving of this information into new stories filtered through its author's thoughts and emotions, makes a work creative. It is submitted that, likewise, through the choice of character attributes and words as well as their combination, the author of the LFCs makes an intellectual creation. This choice must be exercised freely, i.e. independent from another author's work. Here, UK courts should be on familiar ground, and follow the principles used when determining whether a whole work or substantial part of it was copied by another author's work or whether the later work was created independently from the earlier work.

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<sup>1454</sup> See para 2.1.

<sup>1455</sup> Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, para 98; Adolf Dietz, 'Germany' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, § 2[1][b] (Pub 399, Rel 28-12/2016); Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 202; Neil Yap, 'The proof is in the plating: copyright protection of culinary arts and reform for the categories of authorial works' (2017) 39 EIPR 226, 227; Estelle Derclaye, 'Assessing the impact and reception of the Court of Justice of the European Union case law on UK copyright law: what does the future hold?' (2014) 240 RIDA 9 <[http://eprints.nottingham.ac.uk/3613/2/RIDA\\_article\\_derclaye\\_April\\_2014\\_eprints.pdf](http://eprints.nottingham.ac.uk/3613/2/RIDA_article_derclaye_April_2014_eprints.pdf)> accessed 14 March 2017.

<sup>1456</sup> Christian Handig, 'The "sweat of the brow" is not enough! – more than a blueprint of the European copyright term "work"' (2013) 35 EIPR 334, 338.

<sup>1457</sup> Case C-145/10 *Eva-Maria Painer v Standard VerlagsGmbH* [2011] ECR-12533, paras 86 - 89; Joined Cases C-403/08 and C-429/08 *Football Association Premier League Ltd v QC Leisure; Karen Murphy v Media Protection Services Ltd* [2011] ECR I-9083, para 98; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 125; Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 5.

### 8.3.3. The potential effect of Brexit on originality

UK copyright law might fall back on the old originality standard - the skill, labour, judgment test – after the Brexit, as the new standard has not been fully embraced by UK courts yet. For example, Michaels, sitting as a Deputy Enterprise Judge, did not even mention ‘the author’s own intellectual creation’ standard in her 2016 decision in *Minder Music Ltd v Sharples*, but instead judged whether the adaptation of the existing musical work ‘Touch Sensitive’ attracted copyright according to the exercise of ‘skill and labour’.<sup>1458</sup> Michaels referred back to the 2005 judgment in *Sawkins v Hyperion Records* in that regard as if there had been no *Infopaq* ruling [2009] and subsequent rulings following *Infopaq*, which established the new originality standard.

A change from the new back to the old originality standard could be easily accomplished without a change of the CDPA 1988, because s 1(1) refers to original literary and other works without defining the term originality. The skill, labour and judgment requirement has also never been explicitly mentioned in the text of the CDPA 1988. The only section in the CDPA 1988 that makes reference to the author’s own intellectual creation is s 3A(2) concerning databases. An Act of Parliament would be necessary to repeal this originality standard regarding databases. However, this provision might be preserved. The White Paper from the Department for Exiting the EU stated in March 2017 that all the laws, which the UK made to implement EU directives, will be preserved.<sup>1459</sup>

The fate of s 3A(2) does not affect the general new originality standard, because section 3A only applies to databases. Consequently, the general originality standard could fall back on the old skill, labour, judgment standard much sooner, if the UK courts decided to apply the old, traditional standard again.

One might even argue that the UK had no intention of fully adapting to the new originality standard anyway, because the CDPA 1988 only mentions that a database

<sup>1458</sup> *Minder Music Ltd v Sharples* [2016] FSR 2 [10] and [69].

<sup>1459</sup> Department for Exiting the European Union, *Legislation for the United Kingdom’s withdrawal from the European Union* (White Paper, Cm9446, 2017) 14.

is original if the selection and arrangement of content constitutes the author's own intellectual creation. The term 'original' in section 1(1), however, remained unchanged.

What effect would that reversion to skill, labour, judgment requirement have on the likelihood of LFC copyrightability? As the skill, labour, judgment threshold is lower than the author's own intellectual creation threshold, LFCs would satisfy the originality standard with greater ease. However, that is only so in theory. What would have to change in the UK is the court's attitude towards and acceptance of LFC copyrightability, rather than the definition of originality.

### 8.3.4. Criteria of a substantial part of a work

#### 8.3.4.1. Same treatment of the whole and a part?

According to section 16(3), the elements copied from a copyright work in the alleged infringing work must amount to a substantial part of the work in order to infringe copyright. The CJEU pointed out in *Infopaq* that the parts of a work have to be treated like the whole of a work. That means, that parts are protected by copyright, if they too are original, i.e. the author's own intellectual creation. In fact, Directive 91/250/EEC Article 1(3), Directive 96/9/EC Article 3(1), and Directive 2006/116/EC Article 6 state: 'No other criteria shall be applied to determine their eligibility for that protection.'<sup>1460</sup> 'No other criteria' refers to 'no criteria besides the new originality standard shall be applied'. That would mean, if the part of a work is the author's own intellectual creation, then it would be eligible for copyright protection.<sup>1461</sup>

Does that mean for national law that parts, such as LFCs, do not have to amount to a substantial part anymore and that the criteria applied to evaluate substantiality are not applicable anymore? Proudman J maintained in *NLA Ltd v Meltwater Holding BV* that 'originality rather than substantiality is the test to be applied to the part extracted. As a

<sup>1460</sup> Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs [1991] OJ L122/42, art 1(3); Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases [1996] OJ L77/20, art 3(1); 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) [2006] OJ L372/12, art 6.

<sup>1461</sup> *Ogunkoya v Harding* [2017] EWHC 470 [32]; *Hodgson v Isaac* [2012] ECC 4 [78]; Iona Harding, 'Fashion and copyright: weaving our way towards increased protection' (2013) 35 EIPR 183, 187; Jennifer Davis and Alan Durant, 'To protect or not to protect? The eligibility of commercially used short verbal texts for copyright and trade mark protection' (2011) 4 IPQ 345, 349.

matter of principle this is now the only real test.<sup>1462</sup> Later in this judgment, Proudman J argues though that, although the test of quality has been restated, it has not changed much.<sup>1463</sup> Proudman J's decision was confirmed by the Court of Appeal. LLJ Jackson and Elias also make clear that the substantiality test still applies and that it is 'one of quality not quantity'.<sup>1464</sup> This suggests that both criteria are still applied in the UK.

Furthermore, not only does section 16(3) still state that the elements copied from a copyright work in the alleged infringing work must amount to a substantial part of the work in order to infringe copyright, but also courts are in fact still considering the substantiality of parts of a whole work.<sup>1465</sup>

### 8.3.4.2. Character formula

The copyrightability of LFCs might be assessed as follows:

Firstly, the copied elements must be copyright protected original expression of the author's intellectual creation,<sup>1466</sup> not ideas.<sup>1467</sup> Vitoria writes that an author may create an imaginary world, and that other authors may subsequently use the 'formula' of the world to create new stories set in the same universe.<sup>1468</sup> This is what fanfiction writers generally do. It is submitted that Vitoria's idea of a formula of the world in novels can be adopted for fictional characters itself. The character formula or character pattern

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<sup>1462</sup> *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2010] EWHC 3099 [69]; Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 113; Eleonora Rosati, 'Originality in a work, or a work of originality: the effects of the Infopaq decision' (2011) 33 EIPR 746, 751.

<sup>1463</sup> *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2010] EWHC 3099 [81]; Eleonora Rosati, 'Originality in a work, or a work of originality: the effects of the Infopaq decision' (2011) 33 EIPR 746, 751.

<sup>1464</sup> *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890 [24]; Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 114.

<sup>1465</sup> *Ogunkoya v Harding* [2017] EWHC 470 [32] et seq and [50]; *John Kaldor Fabricmaker UK Ltd v Lee Ann Fashions Ltd* [2015] ECDR 2 [H5]; *Hodgson v Isaac* [2012] ECC 4 [77] et seq, [80] and [82]; *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890 [24].

<sup>1466</sup> *SAS Institute Inc v World Programming Ltd* [2010] EWHC 1829 [244] and [263]; Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569, para 39; Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 204 et seq.

<sup>1467</sup> *Baigent v Random House Group Ltd* [2008] EMLR 7 [H13]; Gillian Davies, Nicholas Caddick and Gwilym Harbottle, *Copinger and Skone James on Copyright*, Vol 1 (17<sup>th</sup> edn, Sweet & Maxwell 2016) 102.

<sup>1468</sup> Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1688.

does not only matter for the copyrightability of a LFC in general, but also to the copyright protection of the substantial part of a LFC, because the cumulative effect of the similarities should be taken into account.<sup>1469</sup> Cumulatively, the similarities may amount to a reproduction of the character pattern.

It is this character formula the courts have to extract first and then, in the second step, compare it to the character formula used by the alleged copyright infringer. The courts can then establish whether or not the defendant's character is similar to the plaintiff's character. Since the overall effect of the similarities altogether has to be considered, even a party who imprecisely copied a LFC may potentially be found to have infringed the author's copyright.

What then are the character criteria which form the character formula? An essential element of an AFC is the graphic presentation, which consists of the AFC's shape and body parts, facial features, hair style, colour combination, and, especially in case of heroes, their costume. In addition to that, an AFC can have other visual attributes, such as a typical walk or certain gestures.<sup>1470</sup> Costumes are a double-edged sword for fictional characters. On the one hand, the AFC risks identity loss without their costume. On the other hand, the costume makes the AFC very memorable and easily recognizable by the public.<sup>1471</sup> However, a costume does not have to be drawn to become original and memorable. What a costume looks like or how a person moves can be described in words which form an image in the individual reader's mind. The better the description and the more unique the selection of the character combination is, the more unified is the image in all readers' minds.

The appearance of a character will be the same in any country for one and the same AFC and LFC. However, the name may differ from country to country.<sup>1472</sup> For example, 'Donald Duck' is called 'Donald Duck' in English, French and German, but is called 'Paperino' in Italian. His nephews 'Huey, Dewey and Louie' are called 'Tick, Trick und Track' in German, 'Riri, Fifi et Loulou' in French, and 'Qui, Quo, Qua' in Italian. The same applies to some of the LFCs created by British best-selling author Sir Terry

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<sup>1469</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 166.

<sup>1470</sup> Heijo E Ruijsenaars, 'Ein urheberrechtlicher Streifzug – Teil 1: Zum Schutz von Comic-Figuren' (1993) GRUR Int 811, 2.

<sup>1471</sup> Marina Ristich de Groote, 'Les personnages des œuvres de l'esprit' (1986) 130 RIDA 19, 24.

<sup>1472</sup> Heijo E Ruijsenaars, 'Ein urheberrechtlicher Streifzug – Teil 1: Zum Schutz von Comic-Figuren' (1993) GRUR Int 811, 2.

Pratchett. The LFC ‘Ronald Saveloy’ is called ‘Ronald Zervelatwurst’ in German. Even though names of characters per se are commonly not copyright protected, except occasionally under French law if they coincide with the title of the underlying work,<sup>1473</sup> names of fictional characters should play a role when two characters are being compared. Strong similarities of the LFCs’ names by themselves are not conclusive, but could be taken as a piece of circumstantial evidence. That means that the name of a LFC alone is not a sufficiently safe criterion for establishing whether or not a character has been copied. However, a LFC’s name is an identifying element of the LFC and should therefore be factored into the comparison of two characters, although a name can be easily changed. If the pre-existing character and the allegedly infringing character are so much alike even down to the name and the author has not even bothered to change the character’s name, it is very unlikely that the two characters in question were created independently from each other.

Apart from the physical attributes, an AFC and a LFC have inner characteristics, which are revealed by the actions and reactions of the character. Internal characteristics are the character’s personality, inner attributes, intellectual and physical abilities as well as miscellaneous other attributes, which shape the character’s identity, such as the character’s profession, past experiences, and origin. A character may also have recognition value due to its relationship to other characters.<sup>1474</sup> For example, ‘Sherlock Holmes’ has a sidekick, ‘Dr Watson’. A character may also be characterised and recognized by a figure of speech typical for the character and used repeatedly by the character or a phrase the character has become closely associated with,<sup>1475</sup> such as Sherlock Holmes’ ‘Elementary.’ or ‘when you have eliminated the impossible, whatever remains, however improbable, must be the truth’. The use of certain gadgets or vehicles may also have recall value. ‘James Bond’ is known for his use of flashy elegant sportscars, whereas ‘Batman’ prefers extremely fast, highly armoured mostly black futuristic cars or a bat-shaped aircraft. Just like the original features of an AFC determine its copyrightability, so should the original attributes of a LFC determine its copyrightability.<sup>1476</sup> These criteria are naturally not just relevant for the copyrightability

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<sup>1473</sup> See para 7.3.2.1.

<sup>1474</sup> Heijo E Ruijsenaars, ‘Ein urheberrechtlicher Streifzug – Teil 1: Zum Schutz von Comic-Figuren’ (1993) GRUR Int 811, 2.

<sup>1475</sup> Ibid.

<sup>1476</sup> Gary Scanlan, ‘Derivative aspects of character and perceived attributes in persona as forms of intellectual property: Part 2’ (2004) 15 Ent LR 1, 5 et seq.

of the LFC as a whole, but also for the evaluation of whether a substantial part of these has been reproduced illegally and copyright was infringed.

### 8.3.4.3. Non-character specific substantiality criteria

Whether a substantial part has been copied is a question of judgment or impression. Various factors have to be taken into account. These factors have varying degrees of importance.<sup>1477</sup> Lord Scott acknowledged in *Designers Guild v Russell Williams* that it is challenging to give precise reasons why the court concluded that the copied material is or is not a substantial part. He also conceded that there may be ‘borderline cases over which reasonable minds may differ’. The court could only specify the factors and facts that were relevant for the court’s decision.<sup>1478</sup> This makes the decision comprehensible and repeatable.

Factors for an assessment of the copied elements’ substantiality include ‘the nature and extent of the copying, ... the importance, as well as the amount, of what has been copied ... and the nature of the respective works’<sup>1479</sup> as well as the degree of originality.<sup>1480</sup> Other surrounding factors play a part too, such as the relationship between the parties (e.g. are they competitors) or the reasons for copying the part taken (e.g. for parody, degradation, or the defendant simply wanted to save herself the effort of creating something herself).<sup>1481</sup>

The importance of the copied part relative to the copyright work and not the defendant’s work, means that a substantial part has been taken e.g. if a key element or key combination has been copied. If that copied key element is unaltered, i.e. it is written with the same words as in the original, this is an even stronger indication of substantiality. That is so regardless of the fact that this key element may very well appear small in comparison to the work in its entirety.<sup>1482</sup> Quality is of greater

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<sup>1477</sup> *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [18].

<sup>1478</sup> *Ibid.*

<sup>1479</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [83]; *Baigent v Random House Group Ltd* [2008] EMLR 7 [143]. This includes the consideration of whether the work is a work of fiction or information.

<sup>1480</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [85].

<sup>1481</sup> Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 199 et seq; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 156.

<sup>1482</sup> Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 264.



significance than quantity in this context.<sup>1483</sup> This quality criterion is not the same as aesthetic quality, because it follows objective criteria that are open to scrutiny (key element, degree of alteration) whereas aesthetics are a matter of taste and therefore subjective.

As for quantity, maybe a fixed rule for the number of descriptors of which a LFC must consist, such as at least X descriptors of the LFC's appearance, Y descriptors of the LFC's personality, etc. might be introduced in order to establish when a LFC attracts copyright. Then a fixed percentage of what constitutes a substantial part of the LFC would fit into the same pattern. However, a LFC should not be reduced to a checklist of traits. A fixed number rule and, in particular, a percentage rule of what constitutes a substantial part would not make sense, because then copyists could merely copy so much that they stay within the limits of what is permitted percentage-wise, but nevertheless copy very distinct, memorable, commercially valuable parts of a LFC without infringing the creator's copyright. A strict percentage rule would preclude an evaluation of the content by its importance to the overall work. That means, the percentage rule might preclude copyright protection of LFCs which have a very unique combination of characteristics, but which consist of an insufficient percentage of characteristics relative to the overall work. Under these circumstances, authors who did such a good job that even a small number of character attributes form a very creative, well put together character would be 'punished'. The flexibility of the 'quality over quantity'-approach makes it possible to protect any original LFC on a case by case basis upon its individual facts regardless of its number of characteristics.

Quantity is not entirely negligible, though. It is just that the quality of what has been copied plays a much more material role.<sup>1484</sup> Just as one cannot determine for all cases when the subject matter in question is just an idea and when it is a protectable expression, the exact percentage of copied elements amounting to a substantial part cannot be laid down in general. There are indications, though. For example, if a larger

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<sup>1483</sup> *John Kaldor Fabricmaker UK Ltd v Lee Ann Fashions Ltd* [2015] ECDR 2 [22]; *Hodgson v Isaac* [2012] ECC 4 [23] et seq; *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890 [24]; *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] ECDR 10 [43]; *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273 (Lord Reid at 276, Lord Hodson at 288, Lord Pearce at 293); Eleonora Rosati, *Originality in EU Copyright – Full Harmonization through Case Law* (Edward Elgar 2013) 78; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 155.

<sup>1484</sup> *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 276; Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 200; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 262.

part 'survives in the new work', i.e. if the earlier work is still recognizable as the earlier work in the later work or the earlier and later work are virtually identical, then quantity is very likely to lead to a finding of substantiality.<sup>1485</sup> However, how much material exactly amounts to a substantial part has to be established for each individual case based on the individual facts.<sup>1486</sup> Due to the qualitative element, the substantial part does not have to be a considerably large part, but can sometimes be a quantitatively small part. There is a strong indication for copying in a case e.g. when certain features are so unique that it is highly unlikely that both parties arrived at the same result independently from each other,<sup>1487</sup> or there is a multitude of small details that both works have in common.<sup>1488</sup> The more unique and distinct, endowed and saturated with the author's personality the LFC is on the whole, the fewer qualitative elements will form a substantial part.

#### 8.3.4.4. Reader recognition requirement

As indicated in the above section, this thesis asserts that recognition of a LFC is an additional element for the evaluation of substantiality. It is not only an indicator of quantity, but also of quality. The smaller the combination of LFC attributes, which is still recognized by the public as representing a certain LFC, the more creative the author was when devising that LFC. That also suggests that the quality of the combination of attributes was higher.<sup>1489</sup>

The test of recognition does not replace the originality standard, of course. It is an additional cornerstone in a series of guidelines that enable a judge to decide on a LFC's copyrightability and its infringement by another party. It is submitted that the recognition factor is an element of both the substantiality requirement (as just explained) as well

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<sup>1485</sup> *Schweppes Ltd v Wellington Ltd* [1984] FSR 210, 211; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 262.

<sup>1486</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [83] and [85]; *Baigent v Random House* [2008] EMLR 7 [148]; *Hawkes & Sons (London) Ltd v Paramount Film Service Ltd* [1934] Ch 593, 603; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 262.

<sup>1487</sup> Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 260.

<sup>1488</sup> *Ibid.* That alone, however, is not enough to establish copying of a substantial part. A multitude of common unimportant details is merely an indication of copying. *Nova Productions Ltd v Mazooma Games Ltd and ors, Nova Productions Ltd v Bell Fruit Games Ltd* [2007] EMLR 14 [H4].

<sup>1489</sup> This is only one possible conclusion though. Other factors have to be taken into account as well, such as how much advertising the novel in which the LFC features received and how popular the work is.

as the originality requirement. Originality does not only arise due to having and making individual choices, but also the result – the combination of choices which make a work identifiable and recognizable.

Canadian copyright law applies the criterion of recognition of the fictional character by the public.<sup>1490</sup> This criterion has also been put forward by McGee and Scanlan.<sup>1491</sup> Ristich de Groote, too, writes that the ‘Inaptitude of a character to be recognized outside its customary environment ... would be a flagrant demonstration of its lack of originality.’<sup>1492</sup> One can therefore conclude from this that de Groote also advocates for an element of LFC recognition in order for it to be a copyright protected original substantial part of a LFC.

However, the fact that the intellectual creation must be the author’s ‘own’ does not compel a conclusion of a requirement of recognizability by the public. The term ‘own’ merely suggests that the author must have come up with the character combination herself and not have copied it from somebody else. A LFC can be the author’s ‘own’ regardless of whether or not the general public would know immediately upon comparing two LFCs whether both LFCs in question were created independently from each other (and therefore both were lawfully created, owned, and protected), or whether one of the LFCs is a reproduction of the other LFC (and therefore an infringing copy).

‘[O]wn’ and ‘creation’ also suggest that the author must have left her personal, creative stamp on the LFC. However, whether or not the public realizes that an author has left her personal touch on a LFC does not change the fact that an author has imbued her LFC with her personal choices. A LFC can have its author’s personal touch without a vast majority of the public even knowing the work. Of course, if the public does indeed recognize the LFC of the plaintiff in the defendant’s work, then this is one factor suggesting copyright infringement. The question whether the public correctly recognized the plaintiff’s LFC in the defendant’s work would then have to be addressed. The court must compare the attributes of both parties’ LFCs in any event

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<sup>1490</sup> See para 6.2.2.

<sup>1491</sup> Andrew McGee and Gary Scanlan, ‘Copyright in character’ (2003) JBL 470, 478 et seq.

<sup>1492</sup> Marina Ristich de Groote, ‘Les personnages des œuvres de l’esprit’ (1986) 130 RIDA 19, 26.

regardless of whether or not the actual public recognized the LFC. Hence, the criterion of recognition by the actual public is not quite appropriate.

The criterion of recognition by the public means that the more popular a character (and its substantial parts) is, the more likely it is that the average member of the public will recognize the character (and its substantial parts). Hence, it is suggested that the criterion for determining whether a substantial amount of a LFC's characteristics were copied should not be the LFC's recall value and actual recognition by the general public, but rather an average hypothetical reader's ability to recognize the LFC of author X in the allegedly copied parts in author Y's work. The average reader would actually have read the work and be familiar with the LFC from the pre-existing work. The general public would have been unfamiliar with a less known LFC. Less known works and their LFCs might still be original. Originality does not depend on the public's knowledge and recognition of a work, or a work's plain sales figures. Hence, in order to avoid discriminating against less popular, but still original works, this altered recognition-test is proposed.

As LFCs are smaller combinations of words than e.g. a novel, the risk of depleting the pool of available character attribute combinations is higher. Therefore, a more stringent condition for copyright protection of a LFC is arguable in order to keep a balance between the recognition of an author's copyright in a LFC on the one hand, and the interests of other authors in writing new works and the public on the other hand. However, this might entail that other smaller works, such as poems, would have to follow the same principle, unless one would find a valid reason for treating some smaller works differently from other smaller works. It does not seem sensible to apply a different *de minimis* threshold to smaller works than to larger works, in particular as this would bear the risk of cherry picking as explained above.<sup>1493</sup>

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<sup>1493</sup> See para 8.2.1.

### 8.3.4.5. An element of predictability

Should the strict element of character predictability also be required for LFC copyrightability? Jeremiah reasons that ‘a character acquires distinct personality when it has been delineated to such an extent that its behaviour is relatively predictable. Hence under this theory, when such a character encounters a new situation, it can be expected to act in a manner that is typical for that character and therefore unsurprising.’<sup>1494</sup>

Indeed, the term ‘character formula’, which has been proposed above, suggests predictability (or at least a certain amount of predictability). The appearance of a LFC is commonly static in literary works, but may also be subject to change due to aging, sickness, accident, or other changed circumstances. A LFC’s behaviour is much more subject to the element of unpredictability. If a LFC acts differently from its usual self and differently than a hypothetical reader expects from this LFC, would the LFC still be recognizable? That depends on the strength/quality of the other characteristics. AFCs can attract copyright regardless of their personality. As LFCs are not visually presented (except by the written word), personality attributes are more important for LFCs than for AFCs. A LFC’s behaviour is dictated by the LFC’s personality. If a LFC is presented by another party in a manner which is uncharacteristic for the LFC, then there is a risk that the LFC would not be recognized as LFC X. The more atypically the LFC’s personality is portrayed by the alleged infringer, the more distinct and ‘catchy’ (or detailed) must the remaining combination of attributes of the LFC (name, appearance, catchphrases, accent, etc.) be in order to amount to a substantial part of the LFC.

The fact that copyright protection requires at least the reproduction of a substantial part, plus the flexible way a substantial part is determined, demonstrate that some flexibility is expected and thus permissible. Hence, a strict predictability element should not be required of LFCs. A LFC’s unpredictability could be part of the LFC’s construct anyway. Moreover, a character formula should leave a bit of room for character development, so as not to restrict the author’s creative freedom.

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<sup>1494</sup> Joanna R Jeremiah, *Merchandising Intellectual Property Rights* (Wiley 1997) 229.

#### 8.3.4.6. Character dictating genre and plot

McGee and Scanlan proposed the following test for copyright in a character:

- a) The fictional character must have been endowed with some specificity.
- b) The medium (i.e. the novel, play, or film) must be subordinate to the character.
- c) The fictional character must dictate the nature of format/genre or plot of its medium.<sup>1495</sup>

The first and second requirement are excellent. However, the third condition would mean that ‘Sherlock Holmes’ could only ever appear in a story of crime fiction, and anyone reproducing ‘Sherlock Holmes’ e.g. in a war drama or historical novel about chemistry would not infringe copyright. McGee and Scanlan’s test is also more or less only applicable to the mediums they mentioned – novel, drama and film, but certainly not to character merchandising, as figurines etc. do not tell a story.

A central aspect of the research question of this thesis is to find a way to protect LFCs per se independent of the underlying work, i.e. neither bound by the plot and other aspects surrounding LFCs nor bound by the form a copy may take. The main reason for considering LFCs independent of the plot is to critically evaluate how authors of LFCs could be copyright protected against unauthorized character merchandisers like their artistic counterpart, AFCs. Hence, LFCs should not be bound by genre either. This criterion is unsuitable for the purpose of this thesis.

#### 8.3.4.7. Intentional copying

McGee and Scanlan raise an interesting point though. They suggest that copyright in a character or its substantial part should only then be infringed, if the act of copying was intentional.<sup>1496</sup> Subconscious copying would then not infringe copyright anymore,

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<sup>1495</sup> Andrew McGee and Gary Scanlan, ‘Copyright in character, intellectual property rights and the internet: Part 1’ (2005) 16 Ent LR 209, 213 et seq; Andrew McGee and Gary Scanlan, ‘Copyright in character, intellectual property rights and the internet: Part 2’ (2006) 17 Ent LR 15, 16.

<sup>1496</sup> Andrew McGee and Gary Scanlan, ‘Copyright in character, intellectual property rights and the internet: Part 1’ (2005) 16 Ent LR 209, 212.

at least not in fictional characters. That would mean that LFCs and other elements of novels as well as novels or journal articles themselves are treated differently. That is arguably sensible regardless, because their situation is not quite the same. As LFCs are smaller constructs than e.g. a novel, the risk of depleting the pool of available character attribute combinations is higher. Therefore, a more stringent condition for copyright protection of a LFC and its substantial part might be called for in order to strike a balance between the recognition of an author's copyright in a LFC on the one hand, and the interests of authors about to write a work and the public on the other hand.

However, this would entail that LFCs are also treated differently from other smaller works, such as poems, or that courts would have to follow the example of LFC copyrightability and apply the requirement of intention also to other smaller works or parts. This would upset the *de minimis* principle. Either a work meets this threshold or it does not, but there are not two different *de minimis* levels for smaller and more comprehensive works or parts thereof. Moreover, the requirement of intent has the disadvantage that only deliberate cashing in on somebody else's work would infringe copyright, and not the actual cashing in on somebody else's work. A positive aspect, however, is that other authors and merchandisers would be less apprehensive and timid when creating a new literary work or item for sale.

#### **8.4. Main areas of potential copyright infringement of LFCs**

Copyright can be infringed by

- a) reproduction of a two-dimensional work in two dimensions as well as
- b) reproduction of a two-dimensional work in three dimensions (and vice versa).

The main area of concern regarding the use of copied LFCs in relation to group A is fanfiction, and in relation to group B it is unauthorized character merchandise. These two fields shall be illuminated in the following:

- a) to see why it is important to copyright protect LFC, and

- b) to see what further legal changes might be necessary in order to copyright protect LFCs.

There is somewhat of an overlap between two- and three-dimensional reproduction of a LFC where an unauthorized person sells or makes available online a CAD file, i.e. a literary reproduction of a LFC from a book, for reproduction of the same by means of a 3D printer. This faces the same issues and shall follow the same principles as described below under the character merchandising heading.

#### **8.4.1. Fanfiction**

LFCs are so far only protected by copyright if they are reproduced together with the plot, incidents and other story elements as a substantial part of the literary work.<sup>1497</sup> Hence, some fanfiction can infringe copyright. However, it is also very popular among fanfiction writers to copy just some of the LFCs and put these in a new 'world', e.g. with LFCs from other works. As LFCs by themselves are not protected by copyright, authors could not protect themselves against fanworks like that, even if they were of a commercial nature (which is rare, but not unheard of). Some authors may look on fanfiction favourably as they feel flattered by their fanbase and also appreciate the promotional effect fanfiction has on the canon. However, not all authors take kindly to fanfiction, e.g. because they feel that their chances of writing sequels to their works is diminished by fanfiction that might have already covered what the original author had planned to work on or has just written. Hence, their economic interests in new works are threatened. Moreover, some authors may have an interest in being able to exercise some kind of control over fanfiction, especially from the point of view of moral rights of authors.<sup>1498</sup> Therefore, authors may feel that what is worth copying, is worth protecting. As LFCs are so far left unprotected as insubstantial parts of the whole work, the question arises whether the repeated taking of insubstantial parts over a period of time could be protected by copyright. Fanfiction authors often write several works centring on their favourite LFCs from a single source and keep taking elements of the underlying work (sometimes adding more LFCs from the source or writing new stories of different pairings from the single source). Fanfiction authors may also take LFCs from different

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<sup>1497</sup> See paras 1.1.2.2.7. - 1.1.2.2.7.

<sup>1498</sup> See para 5.4.3.2.2.



works of the same author from the same canon (same series), but also new series of the same original author. It was held that repeated copying of insubstantial parts may infringe copyright, if the different acts of copying can be seen as a single act and cumulatively amount to a substantial part.<sup>1499</sup> Relevant factors in the consideration are whether the copied elements were used for the same purpose, the period of time in which the copying occurred, as well as whether it was a repeated act of 'systematic copying'. Bainbridge maintains that at least in case of several instances of copying from a single work, this should be regarded as a continued act of copying.<sup>1500</sup>

However, this might stretch the wording of section 16(3) which requires 'an act restricted by copyright ... in relation to the work as a whole or any substantial part of it' a bit wide. The indefinite article 'an' in relation to the act, the definite article 'the' in relation to work as well as the indefinite article 'a' in relation to the part, which was e.g. copied, indicates a single act restricted by copyright in relation to a single source. Treating the repeated copying of parts, which in fact are many acts of copying, as one act of copyright infringement blurs the lines of what one act of infringement is. Consequently, it also negatively affects the degree of penalty as the following hypothetical example illustrates. Defendant D was held to have infringed copyright by reproducing several commonplace parts from different works or from the same work at different times, if all these acts are regarded as one act so that the individual parts amount to a substantial part. As a consequence, defendant D is ordered by the court to give up all copies, to pay damages as well as to desist from any further copying. Injunctive relief is enforceable by penalty. That means, if defendant D copies another commonplace part from the same work, the penalty will be triggered, because the act of copying would have to be added to the single act of continued copying, even though by itself the copied part is insubstantial. This demonstrates the danger of this 'combined single act'-construct. There is a risk that the defendant would be deprived of the substantial part defence with regard to any part of a work. The single act-construct does not cover only LFCs, but any other part of a work, regardless of how insignificant it is by itself. The net of copyright infringement is cast too wide. Too much

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<sup>1499</sup> Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569, paras 49 et seq; *Electronic Techniques Anglia Ltd v Critchley Components* [1997] FSR 401, 410; Lionel Bently and Brad Sherman, *Intellectual Property Law* (4<sup>th</sup> edn, OUP 2014) 202; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 161.

<sup>1500</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 161.

material that would normally be in the public domain would be caught in that net. Hence, the application of this construct should be avoided.

If LFCs were explicitly mentioned in the section 3(1) which gives examples of literary works, or if the courts acknowledged LFCs specifically as substantial parts of a whole work, resorting to the above construct with its potential adverse effects would be unnecessary. This would also ensure that not only those instances are covered by copyright protection where a fanfiction writer copies LFCs and other parts from different works or one and the same work on several occasions, but also those where only the LFC is copied and by only the one act.

#### 8.4.2. Character merchandising issues

Copyright protection of LFCs against unauthorized character merchandising involves even more issues. In the UK, copyright protects artistic, two-dimensional works against copying in three-dimensional form.<sup>1501</sup> Making a 3D model from an artistic work, such as a drawing of a cartoon character qualifies as an act of copying.<sup>1502</sup> Indeed, the creator of the cartoon character ‘Popeye’ had prevented another from continuing to manufacture and sell unauthorized merchandise articles, such as mechanical ‘Popeye’ dolls and brooches, based on his copyright in the artistic work, the character ‘Popeye’.<sup>1503</sup> Consequently, one may assume that fictional characters per se are protected by copyright against unauthorized character merchandising. However, it is not quite that straightforward.

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<sup>1501</sup> Section 17(3); David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 163; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 6.

<sup>1502</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 163.

<sup>1503</sup> *King Features Syndicate Inc v O and M Kleeman Ltd* [1938] K 477, [1940] Ch 523.

However, the Court of Appeal allowed the appeal against the High Court’s ‘Popeye’ decision, stipulating that design prevented copyright according to the Copyright Act 1911. *King Features Syndicate Inc v O and M Kleeman Ltd* [1940] Ch 806, 815, 827 (CA). The House of Lords, again, allowed the appeal against the appeal, thereby confirming the decision of the High Court. *King Features Syndicate Inc v O and M Kleeman Ltd* [1941] AC 417 (HL).

### 8.4.2.1. Section 17(3) and the dimensional shift of LFCs

For one thing, section 17(3) pertains only to artistic works. Literary works are not protected against dimensional shift, i.e. the making of a three-dimensional copy of a two-dimensional work and vice versa.<sup>1504</sup> However, some academic commentators suggest that even that is possible. Adams et al claim that Laddie J did not rule out the possibility that a work in three dimensions may infringe copyright in a two-dimensional literary work in *Autospin (Oil Seeds) v Beehive Spinning*.<sup>1505</sup> Indeed, this can be surmised from Laddie J's judgment. He did not deny the claim for copyright infringement by pointing towards section 17(3), but instead argued that the plaintiff's charts (a literary work) say virtually nothing about the shape of the three-dimensional seal. This implies that, in Laddie J's view, the copyright in the literary description of the charts could have been infringed by the creation of the seal in three dimensions, if the literary work had been much more elaborate and precise than is commonly the case with literary works.<sup>1506</sup> In theory, it is very reasonable to require a LFC to be described very well in order to be reproduced as a three-dimensional object, such as a puppet. Moreover, section 17(2) maintains, also in respect of literary works, that a work is copied by being reproduced in any material form.<sup>1507</sup> One might argue, that 'any material form' includes the reproduction of a three-dimensional work as a two-dimensional work, as well as the reproduction of a two-dimensional work as a three-dimensional work.<sup>1508</sup> However, as just mentioned, this dimensional shift rule is solely applicable to artistic works, not literary works. Not only the wording of section 17(3), but also the structure of section 17 make clear that section 17(3) is the qualifying exception (which is specific to artistic works) to section 17(2) (which relates to literary, dramatic, musical and artistic works). Hence, in order to protect three-dimensional exploitation of LFCs, the wording of section 17(3) would have to be changed to include 'literary and artistic work(s)'. However, this change might not be enough.

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<sup>1504</sup> *Foley Ltd v Elliott* [1982] RPC 433; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 165; Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 449.

<sup>1505</sup> *Autospin (Oil Seeds) v Beehive Spinning* [1995] RPC 683; John N Adams, Julian B Hickey, Guy Tritton, *Merchandising Intellectual Property* (3<sup>rd</sup> edn, Tottel 2007) 15 fn 2.

<sup>1506</sup> *Autospin (Oil Seeds) v Beehive Spinning* [1995] RPC 683, 701.

<sup>1507</sup> Section 17(2); *HRH Prince of Wales v Association Newspapers Ltd* [2007] 3 WLR 222 [156].

<sup>1508</sup> Section 17(3).

### 8.4.2.2. The limits of section 17(3)

*BBC Worldwide Ltd v Pally Screen Printing Ltd*<sup>1509</sup> demonstrates that section 17(3) is limited by section 51. This case concerns the ‘Teletubbies’. BBC Worldwide owns the IPRs in the TV programme named after these characters. The defendants printed images of these characters on garments and sold this character merchandise. The first group of garments depicted artwork which was substantially identical to a photographic image of the ‘Teletubbies’. The photograph, on which the artwork was based, had been published in 1997 in the June issue of BBC Toybox. A second set of garments showed four ‘spherical puppet-like characters’ accompanied by catchphrases of the ‘Teletubbies’.<sup>1510</sup> These were an indirect reproduction of the Teletubby puppets through television.

Laddie J held that the defendants’ artwork on the garments was, without a doubt, a substantial reproduction of the artwork created for the ‘Teletubby’ TV programme.<sup>1511</sup> Even so, this case had a different, more complex and nuanced outcome than the ‘Popeye’ case. Due to a change of copyright and design law on 1 August 1989, artistic copyright could not be infringed anymore by reproducing a drawing in three dimensions (by making an article), if that article is not itself an artistic work and is instead subject to a design right.<sup>1512</sup> This is the essence of the then newly introduced section 51. Section 51(1) stipulates that ‘It is not an infringement of any copyright in a design document ... to make an article to the design or to copy an article made to the design.’ That means, in principle, if a plaintiff’s drawings were intended for the creation of (mass-produced) articles, and were a design document instead of an artistic work as a result, then the defendant could rely on the defence provided by section 51(1).<sup>1513</sup>

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<sup>1509</sup> *BBC Worldwide Ltd v Pally Screen Printing Ltd* [1998] FSR 665.

<sup>1510</sup> *Ibid.*

<sup>1511</sup> *Ibid* 668 (with regard to the first group of garments) and 669 (with regard to the second group of garments).

<sup>1512</sup> David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 163, Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 441.

<sup>1513</sup> *Mackie Designs Inc v Behringer Specialised Studio Equipment (UK) Ltd* [2000] ECDR 445, 446 and 453; JAL Sterling, Michael Hart and Emily Riddle, ‘Subject Matter of Protection’ in JAL Sterling, *Sterling on World Copyright Law* (4<sup>th</sup> edn, Sweet & Maxwell 2015) 258; Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 212; Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1750; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 443.

The defendants in the 'Teletubbies' case relied on section 51(1). This defence succeeded with regard to both the first and the second group of garments.<sup>1514</sup> The print on the second group of garments indirectly reproduced the 'Teletubby' puppets via the television programme. The drawings of the 'Teletubby' characters were design documents for the creation of puppets for a TV series, and therefore articles rather than artistic works.<sup>1515</sup> Hence, the defendants had made a copy of an article ('Teletubby' puppets) made to the design (drawing of the 'Teletubby' characters).

The images on the first group of garments were based on a photograph of the 'Teletubbies' which had been published in the magazine BBC Toybox. No claim of copyright in the photographs was put forward. As the photograph had been taken of the 'Teletubby' puppets on the set of the TV programme, the image on the garments bearing a copy of that photograph was basically an indirect reproduction of the 'Teletubby' puppets once again. Hence, it was a reproduction of a copy of an article made to the design of the 'Teletubby' puppets. Consequently, the defence under section 51(1) applied.<sup>1516</sup>

A ruling that can be distinguished from *BBC Worldwide Ltd v Pally Screen Printing Ltd* is *Allen v Redshaw*.<sup>1517</sup> In this case, the main character, 'Mr Spoon', had been designed for the creation of a puppet for theatre puppet shows like the 'Teletubbies' had been designed for the creation of a TV programme.<sup>1518</sup> Even so, 'Mr Spoon' was protected by copyright against the reproduction of an image looking like 'Mr Spoon' and 'Button Moon' on T-shirts, mugs and other character merchandising items,<sup>1519</sup> while the 'Teletubbies' were not. Hence, the question arises whether, and if not, then why, the same principles were not applied in *Allen v Redshaw*, or whether there was a compelling reason for the different outcome.

Unlike in the 'Teletubbies' case, the plaintiff and creator of 'Mr Spoon' had not only drawn design documents of 'Mr Spoon', but had also drawn paintings featuring the

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<sup>1514</sup> *BBC Worldwide Ltd v Pally Screen Printing Ltd* [1998] FSR 665, 672.

<sup>1515</sup> Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 442.

<sup>1516</sup> *BBC Worldwide Ltd v Pally Screen Printing Ltd* [1998] FSR 665, 672.

<sup>1517</sup> *Allen v Redshaw* [2013] WL 2110623.

<sup>1518</sup> *Ibid* [2].

<sup>1519</sup> *Ibid* [30].

characters for the show. The paintings do not change the fact though that the drawings of 'Mr Spoon' were created so that the 'Mr Spoon' puppet could be made for the puppet show. Both, a painting of a character as well as a photograph of characters, are design documents within the meaning of section 51(3) and should therefore receive the same treatment. That would mean that the paintings and drawings of 'Mr Spoon' were excluded from copyright. Then why did Recorder Michaels decide that the defendant had infringed the plaintiff's copyright? This different outcome can be explained rather easily: The defendant in *Allen v Redshaw* did not raise the defence of section 51(1). Courts do not automatically look for all potential defences a defendant might have. It is the defendant's responsibility to do so. Hence, there are no significant tensions between *Allen v Redshaw* and *BBC Worldwide v Pally Screen Printing*. Consequently, the above principles outlined in *BBC v Pally* still apply.

#### 8.4.2.3. General principles of protection

In summary, the general principles that can be inferred from the above cases are as follows:

Normally, in situations of theoretical dual protection by copyright and design law, copyright infringement bars infringement in the design according to section 236.<sup>1520</sup> However, that is only so as long as section 51 does not apply according to which a defendant (unauthorized copyist) may defend herself against the plaintiff (and creator). Hence, the creator's success in a claim for copyright infringement depends on the purpose for which a character was drawn.

If the drawing of characters was intended for the creation of industrially manufactured items, such as puppets, then section 51 limits copyright.<sup>1521</sup>

If, on the other hand, a plaintiff's drawings were intended as artistic works, e.g. for a comic, then these are protected by copyright. Copyright also vests in an artistic work that was intended for surface decoration<sup>1522</sup> e.g. on a mug, key chain or poster,

<sup>1520</sup> Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 799 et seq.

<sup>1521</sup> Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1685 and 1750.

<sup>1522</sup> *Parker v Tidball* [1997] FSR 680, 694 et seq; Jonathan Griffiths, Lionel Bently and William R Cornish, 'United Kingdom' in Lionel Bently (ed), *International Copyright Law and Practice*, Vol 2, §

because section 51(3) excludes surface decoration from the section 51(1) defence against copyright infringement. This is further confirmed by section 213(3)(c) which states that ‘Design right does not subsist in surface decoration.’

That means for AFCs, if a particular AFC has been drawn for mass production of the AFC images on lunch boxes, pyjamas, and other surface decoration character merchandise, then an unauthorized character merchandiser printing identical or substantially similar images on bedding or pyjamas or making lookalike figurines, too, infringes copyright in the artistic copyright of the author of the AFC or other rightsholder.

Not only two-dimensional, but also three-dimensional surface decoration is excluded from the scope of unregistered design right and instead is protected by copyright.<sup>1523</sup> This means, drawings of an AFC, which is a model for e.g. embroidery on a pullover with beads featuring an AFC, are subject to copyright protection. Examples where actual three-dimensional objects themselves, not objects attached to another object (like beads on a pullover), might be surface decoration and thus excluded from the defence provided by section 51(1) against copyright are prostheses and attire worn by an actor for the film production of *Mary Shelley’s Frankenstein*.<sup>1524</sup> Mann QC stated that ‘it is impossible ... to conclude ... that copying it [the creature] ... would not be an infringement [of copyright].’<sup>1525</sup> The High Court, Court of Appeal and Supreme Court decided differently though in *Lucasfilm v Ainsworth*. The helmets of the ‘Stormtroopers’ from the *Star Wars* films had been created primarily as part of the ‘Stormtroopers’ costume for the film. Therefore, the courts held that the helmets primarily had a utilitarian function,<sup>1526</sup> although the helmet also reinforced the characteristics and

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2[4][c][ii] (Pub 399, Rel 28-12/2016); Mary Vitoria et al, *Laddie, Prescott and Vitoria – The Modern Law of Copyright and Designs*, Vol 2 (4<sup>th</sup> edn, LexisNexis 2011) 1750 and 1753.

<sup>1523</sup> *Dyson v Qualtex* [2006] RPC 31 [76]; *Jo y Jo v Matalan Retail Ltd* [2000] ECDR 178, 191; *Mark Wilkinson Furniture Ltd c Woodcraft Designs (Radcliffe) Ltd* [1998] FSR 63, 72 et seq; Lionel Bently and Brad Sherman, *Intellectual property law* (4<sup>th</sup> edn, OUP 2014) 783 et seq; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 446.

<sup>1524</sup> *Shelley Films Ltd v Rex Features Ltd* [1994] EMLR 134, 135.

<sup>1525</sup> *Ibid* 143.

<sup>1526</sup> Dinusha Mendis, “‘The clone wars’: episode 1 – the rise of 3D printing and its implications for intellectual property law – learning lessons from the past?” (2013) EIPR 155, 166.

message of the ‘Stormtrooper’ characters (menace, anonymity, their allegiance and force).<sup>1527</sup>

#### 8.4.2.4. Term of protection

In the past, the copyright owner of the artistic work only received 25 years of protection against industrial mass production of the work according to section 52(2).<sup>1528</sup> The copyright owner had therefore only 25 years from the end of the calendar year (as opposed to the usual 70 years) to exploit the copyright in the artistic work either herself or by licensing others to produce character merchandise. The AFCs had therefore been fair game to unauthorized character merchandisers when this 25 year period came to an end. As this shortened term of copyright for mass-produced artistic works conflicted with the purpose of the Term of Protection Directive,<sup>1529</sup> this term of 25 years was extended to 70 years after the author’s death by repealing section 52. Hence, the length of copyright is the same now for all artistic works, whether mass-produced or not.<sup>1530</sup> This legislative change is the result of the Enterprise and Regulatory Reform Act 2013 s 74 which was passed in April 2013, and whose purpose is to boost the UK’s economy. It took effect on 28 July 2016.

It was a laudable step to deal with this anomaly regarding the term of protection of industrially applied artistic works (including AFCs) which are copyright protected. A next step could be to model the protection of literary works (including LFCs) on the protection granted to AFCs against unauthorized character merchandising. This would require a statutory change of sections 17(3) and 51(1), because these two sections only pertain to artistic works. They make no reference to literary works. Consequently,

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<sup>1527</sup> *Lucasfilm v Ainsworth* [2008] ECDR 17 [121] (High Court), [2010] ECDR 6 [51] and [53] (Court of Appeal), [2012] 1 AC 208 [44] and [47] (Supreme Court); Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 212.

<sup>1528</sup> This section used to be applicable when more than 50 copies were made of the artistic work.

<sup>1529</sup> The purpose of this Directive is to ensure the harmonisation of the duration of copyright and related rights. 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) [2006] OJ L372/12, recital 3.

<sup>1530</sup> Rachel Collins, ‘UK copyright protection for designers to be extended in April 2020’ (*DACS*, 25 Feb 2015) <<https://www.dacs.org.uk/latest-news/uk-to-extend-copyright-protection-for-designers?category=For+Artists&title=N>> accessed 28 January 2017.



a creator is not copyright protected against the mass production of unauthorized character merchandise based on a LFC, as opposed to creators of AFCs who are copyright protected to the extent described above.

#### **8.4.2.5. The adaptation right and character merchandising**

An alternative option to changing the provision on copying would be to expand the provision on the restricted act of making an adaptation, namely section 21. One possibility would be to change this provision explicitly in a way that covers activities of unauthorized character merchandisers. For example, a section 21(3)(a)(iv) could be added to section 21 stating that the process of making or applying a version of a literary work which is converted into an artistic work or a design document for the purposes of character merchandising was an act restricted by copyright. Another option would be to phrase section 21(3)(a)(iii) in a very open way covering both the conversion of a literary work for the purposes of creating a comic book in whatever medium (book, newspaper, magazine, etc.) as well as for the purposes of character merchandise. Section 21(3)(a)(iii) would then state for example: ‘In this Part “adaptation“ (a) in relation to a literary work ... means— the process of making and/or applying a version of a literary work which is converted into an artistic work for any (commercial) purpose.’ Alternatively, section 21 could be turned into an illustrative provision instead of keeping it as a closed list. It would merely be necessary to add the two words ‘in particular’ in section 21(3)(a). The wording would then read as follows: ‘In this Part “adaptation“ (a) in relation to a literary work ... means in particular—’, leaving the rest of section 21(3)(a) as it is. However, not only section 21(3), but section 1(1) currently contains also a closed list. It would be unreasonable to go against this pattern, since there are less drastic options – a change of section 17(3), or at least ‘just’ an explicit addition to section 21 in relation to making character merchandise. Moreover, turning section 21 into a non-exhaustive list would leave section 21 rather vague. Without any clear reference to character merchandising, it may not be evident that creating a three-dimensional object from a two-dimensional work can be classified as the act of making an adaptation, in particular since this is already covered with regard to artistic works by section 17(3). Section 17 would require little changing in comparison to section 21(3). Section 17(3) already refers to the making of a copy in three dimensions of a two-dimensional work and vice versa in relation to artistic works. Hence, it would be

consistent to include the making of a copy in three dimensions of a two-dimensional work in relation to literary works in section 17(3) instead of creating a similar subsection under section 21(3). One and the same act should not be the restricted act of 'copying' with regard to artistic works while the same act would be the restricted act of 'making an adaptation' with regard to literary works. Hence, an added subsection to section 21(3) does not make much sense. A change of section 17(3) is the only appropriate proposition.

Until the above proposed changes are made to sections 17(3) and 51(1), the two different types of character merchandise (one based on AFCs, and one based on LFCs) will not be on an equal footing.

## 8.5. Conclusion

A LFC could potentially be regarded as a substantial part of a whole work as well as a whole work itself. Which of the two it is would depend on whether the LFC features in a larger encompassing work, such as a novel, or whether the LFC is stand-alone e.g. as a character proposal for a TV programme, which consists of no more than the description of the character.<sup>1531</sup>

As a LFC can be a whole work as well as a substantial part of a work, one has to differentiate as follows when judging the substantiality of a LFC:

- a) If the LFC is incorporated into a novel, which is generally the case, the copied elements of the pre-existing LFC would have to amount to a substantial part of the larger work, the book, when determining copyright infringement.

That would mean that the novel would have to be original as well as the LFC, and the copied parts would have to be substantial in relation to the novel.

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<sup>1531</sup> See para 8.2.1. et seq.

- b) If the LFC is to be presented in isolation, e.g. in a character profile, then the question whether a substantial part of the LFC was copied would arise.

That would mean that the LFC and the character profile would have to be original, and the copied character attributes must be a substantial part of the overall character.

A LFC or substantial part of it is original, if it is the author's own intellectual creation. The new originality requirement means more than just independent creation of the work originating from its author. Since *Infopaq* and *Football Dataco*, originality requires creativity, meaning that the work must reflect the author's personal touch as a result of the author's free and creative choices, which in turn emanate from the author's unique abilities and personality.<sup>1532</sup> This suggests a level of individuality that makes the work distinctive and distinguishable from pre-existing works.<sup>1533</sup> Hence, a LFC must be an individualised and identifiable creation of the author's mind.

LFCs consist of different categories of attributes from which the author chooses and assembles her intellectual creation.<sup>1534</sup> These are the following:

- a) the LFC's name,
- b) the LFC's appearance (e.g. style of attire, fashion after which beard is groomed, eye colour),
- c) the LFC's personality (e.g. flamboyant, but secretive; curious, but not adventurous),

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<sup>1532</sup> Case C-5/08 *Infopaq International v Danske Dagblades Forening* [2009] ECR I-6569, para 37; Case C-604/10 *Football Dataco v Yahoo! UK Ltd* [2012] ECDR 10, para 38; Case 604/10 *Football Dataco Ltd and others v Yahoo! UK Limited* [2012] ECDR 10, Opinion of AG Mengozzi, para 40; Case C-145/10 *Eva-Maria Painer v Standard VerlagsGmbH* [2011] ECR-12533, paras 88 and 92; Tanya Aplin and Jennifer Davis, *Intellectual property law: text, cases, and materials* (3<sup>rd</sup> edn, OUP 2017) 125. See also para 8.3.2.

<sup>1533</sup> Christian Handig, 'The copyright term "work" – European harmonisation at an unknown level' (2009) 40 IIC 665, 672.

<sup>1534</sup> See para 8.3.4.2.

- d) other outward characteristics, such as abilities (e.g. skilled at calming agitated clients, amazing at closing sales, sporty and agile), interests (e.g. picking alpine gentian, playing harp and horn), and actions (e.g. nursing a clowder of cats back to health), and
- e) other inward characteristics, such as thoughts and a belief system (e.g. the LFC is a strong advocate for world peace, naïve, bible-abiding to some extent, turns the other cheek when hit, but when the proffered other cheek is in fact hit as well, he turns *American Streetfighter*).

Each of these characteristics, regarded individually, might be commonplace. Regardless, a whole work or substantial part of it may be copyright protected, if the collection, selection and arrangement of literary material is original and forms a substantial part of the work.<sup>1535</sup> Hence, the LFC as a work or substantial part must be original both in its expression and in its composition.

The combination of the constituent parts forms the ‘character formula’ or ‘character pattern’.<sup>1536</sup> Even so, it is here suggested, that the LFC’s behaviour must not be wholly predictable so that the author still has some freedom to develop the LFC.<sup>1537</sup> If one of the character’s features changes at some point, the LFC might still be recognizable as that same LFC. Moreover, if predictability of a character was an absolute requirement, a copyist could avoid copyright infringement by imprecise copying. However, this would violate sections 16(1)(a), (3)(a) and 17(1) according to which the reproduction of a substantial part suffices for copyright infringement.

It should be sufficient, if the author has endowed the LFC with some specificity, and that the LFC is still recognizable to a hypothetical average reader.<sup>1538</sup>

Copyright protection against unauthorized character merchandising is particularly challenging.<sup>1539</sup> The reason is that whether a fictional character is protected by

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<sup>1535</sup> *Allen v Bloomsbury Publishing Plc* [2010] EWHC 2560 [83]; *Baigent v Random House* [2008] EMLR 7 [145]; David I Bainbridge, *Intellectual Property* (9<sup>th</sup> edn, Pearson 2012) 47.

<sup>1536</sup> See para 8.3.4.2.

<sup>1537</sup> See para 8.3.4.5.

<sup>1538</sup> See para 8.3.4.4.

<sup>1539</sup> See para 8.4.2.

copyright against the unauthorized reproduction in the form of industrially manufactured character merchandise depends on the initial purpose of the item for which the character was created.

Those AFCs, which were initially intended for a comic, cartoon or similar work, as well as AFCs which were created as surface decoration are protectable by copyright against unauthorized character merchandise. Only those AFCs, where the AFC was initially intended to be industrially mass-produced as articles with eye appeal (instead of cartoons, comics, and illustrations), are unprotected by copyright against unauthorized character merchandise. If the drawing of the AFC was made as a model for an article, then design right applies, unless that article is a sculpture or work of artistic craftsmanship.<sup>1540</sup> Works of artistic craftsmanship and sculptures require at least some element of artistic expression and must have been intended as works of art.<sup>1541</sup> Works (be that an object or model drawings for the creation of objects) starting out as something intended for industrial mass-production are not works of art.

Copyright protection of artistic works (including AFCs) under the above conditions should be extended to literary works (including LFCs) under the same conditions. This would require the following changes to sections 17(3) and 51(1):

- a) According to section 17(3), copying of a two-dimensional artistic work includes the making of a copy in three dimensions. ‘Literary works’ could be added to the wording. Section 17(3) could then be phrased as follows: ‘In relation to a *literary or* artistic work copying includes the making of a copy in three dimensions of a two-dimensional work and the making of a copy in two dimensions of a three-dimensional work.’

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<sup>1540</sup> *BBC Worldwide Ltd v Pally Screen Printing Ltd* [1998] FSR 665, 668 and 672; John N Adams, Julian B Hickey and Guy Tritton, *Character Merchandising* (3<sup>rd</sup> edn, Tottel Publishing 2007) 6; Sallie Spilsbury, *Media law* (Routledge-Cavendish 2000) 441.

<sup>1541</sup> *Lucasfilm v Ainsworth* [2008] ECDR 17 [121] (High Court), [2010] ECDR 6 [51], [53] and [70] (Court of Appeal), [2012] 1 AC 208 [44] (Supreme Court). Sculptures are artistic works, which were created for their visual appeal, while design covers items and documents that were created for their utilitarian properties (which may or may not have eye appeal too). Works of artistic craftsmanship also require artistic quality. Paul Torremans, *Holyoak and Torremans Intellectual Property Law* (8<sup>th</sup> edn, OUP 2016) 212 et seq.

- b) Alternatively, the wording of section 17(3) could be changed to encompass LFCs explicitly. However, that would be a more restrictive option. Moreover, it would be inconsistent to mention LFCs expressly, while AFCs are covered by the term ‘artistic work’. By adding ‘literary works’ to section 17(3) both types of works, artistic and literary, would be put on an equal footing.
- c) Section 51(1) should also be extended to apply to literary works as well. The wording could then be as follows: ‘It is not an infringement of any copyright in a design document ... embodying a design for anything other than a *literary or* artistic work ... to make an article to the design or to copy an article made to the design.’<sup>1542</sup>

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<sup>1542</sup> This wording is based on the current, shortened, wording of section 51(1). Only the words ‘literary or’ were added.

## Chapter 9 – Recommendations and Conclusions

### 9.1. Introduction

This thesis established in chapter 1 that copyright law only offers plot-dependent protection to LFCs, i.e. LFCs are only protected by copyright in the UK in combination with other plot elements.<sup>1543</sup>

This causes authors to be unprotected by copyright if a LFC is used independent from any other plot elements of a novel. That could be e.g. in non-commercial fanfiction, but also in commercial literary works or films, which pull LFCs from different novels together and create a new work. Even fanfiction has seen its commercialization via Amazon Publishing's fanfiction platform 'Kindle Worlds' in the USA on 27 June 2013.

The financial gain an author may have a right to, if LFCs per se were copyright protected independent from the original work, would be even greater from character merchandise, which exploits a character's name, appearance, and to an extent, even personality. Character merchandising is a multi-million dollar business. Revenue from character merchandise may even exceed the revenue from the underlying book and/or film as was established in chapter 2.<sup>1544</sup>

### 9.2. Research objective

This thesis sought to remedy the above described situation. Since authors could not protect their LFCs by copyright plot-independently, the first research objective of this thesis was to evaluate whether the implementation of copyright protection for LFCs is necessary. That means, it was critically evaluated first whether authors and their LFCs already receive sufficient protection by means other than copyright, namely trade mark law and actions for passing off. Chapter 3 confirmed the suspicion that trade mark law in relation to LFCs is inadequate, while chapter 4 substantiated the challenges an

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<sup>1543</sup> See paras 1.1.2.2.4. – 1.1.2.2.7.

<sup>1544</sup> See para 2.2.6.

author would face in an action for passing off as set out in RQ 1.b below.<sup>1545</sup> These were corroborated in chapter 5. Due to the double nature of copyright, which grants its proprietor economic as well as moral rights, chapter 5 critically evaluated the overlap of moral rights and an action for passing off. Though an action for passing off was successful in a case that also concerned the false attribution of authorship,<sup>1546</sup> this case nevertheless reinforced that a claim for infringement of moral rights is preferable in general to an action for passing off, because the last-mentioned involves a heavier burden of proof for the individual.<sup>1547</sup> That means, a comparison of moral rights and actions for passing off rather came to the conclusion that an action for passing off would be more inconvenient rather than inadequate in this respect.

After establishing in line with expectations that neither trade mark law nor actions for passing off equip an author with the desired protection of their LFCs, the second research objective, how LFCs per se could be protected by copyright, was approached in chapters 6 - 8. Chapter 6 sought inspiration in the common law jurisdictions Canada and the USA, both of which offer copyright protection to LFCs. Chapter 7 followed suit to ascertain how the civil law jurisdictions Germany and France protect LFCs by copyright. The findings from these chapters strengthened the hypothesis that LFC copyrightability would be possible in the UK, too.

The main research objective behind chapter 8 was to critically evaluate the practical issues of applying copyright to LFCs and to propose recommendations on how current copyright law might be changed. While analysing the individual requirements of copyright in the UK and in the above mentioned foreign jurisdictions which offer LFC copyrightability, the different options of how LFC copyrightability could be implemented under UK copyright law was considered. A strategy developed and culminated in the objective target for the implementation of LFC copyrightability not to offer a solution requiring a complete overhaul of the CDPA 1988, but instead to work with the familiar, current unwritten principles and written provisions.<sup>1548</sup> With this in view, the changes proposed are kept as least disruptive as possible and are modelled to suit current

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<sup>1545</sup> See para 9.3.

<sup>1546</sup> See para 5.5. on *Clark v Associated Newspapers Ltd* [1998] 1 WLR 1558, in which both an action for passing off and a claim for false attribution of authorship succeeded.

<sup>1547</sup> See paras 5.5., 4.4.2. and 4.4.3.

<sup>1548</sup> See para 1.5.2.



provisions and the legislator's style, i.e. the wording and structure of sections and subsections of the CDPA 1988, so as to preserve the balance of UK copyright law.<sup>1549</sup>

In pursuit of practical considerations regarding the protection of LFCs, not only the practical implementation of character copyrightability was critically evaluated, but also the practical considerations for the exploitation of LFCs were taken into account. Parties already exploiting or intending to reuse LFCs of an author face the challenge how to find the licensor, as well as finding out in the first place whether or not licences are offered for the LFC in question or whether the LFC is in the public domain. This was the most challenging part of this thesis. Fortunately, the strategy applied in terms of the recommendations regarding the implementation of LFC copyrightability – i.e. working with what exists - proved to be very useful in this regard, too. That meant looking into the possibilities of extending PLSclear, but also the possibilities and efforts necessary for extending the British Library's digitization project of images which are in the public domain to a public domain repository of literary works or creation of a public domain registry.

### **9.3. Research Questions and Answers**

The principal research question raised in chapter 1 is:<sup>1550</sup>

To what extent are trade mark law and actions for passing off appropriate and sufficient for the protection of LFCs, and does current UK copyright law have the potential to grant copyright protection for LFCs per se, independent of the work they feature in originally?

This main research question was divided into the following research questions:

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<sup>1549</sup> See para 9.3.

<sup>1550</sup> See para 1.3.

## **RQ 1: Do trade mark law and actions for passing off protect authors against unauthorized use of their LFCs sufficiently?**

The first two-pronged research question asks whether LFCs are already sufficiently protected by trade mark law or actions for passing off. The purpose of this question is to establish whether a critical evaluation and implementation of LFC copyrightability is justified. Therefore, RQ 1.a and RQ 1.b, which consider trade mark law and actions for passing off one at a time in the following, cover the first research objective of this thesis.

### **RQ 1.a: Does trade mark law protect authors against unauthorized use of their LFCs sufficiently?**

The protection trade mark law offers authors against the unauthorized use of their LFCs is inadequate and impractical.

First, a LFC per se cannot be registered as a trade mark. Only the registration of its name might be possible.

Second, trade mark protection of a LFC's name is fraught with issues, in particular regarding the origin function. LFCs face many difficulties satisfying the origin function, i.e. the main function of a trade mark.<sup>1551</sup> For example, if the name of the LFC is very well-known, there is the risk that the name may have passed on into the language, i.e. has become a generic term describing the character, not denoting its author. A sign which is devoid of any distinctive character cannot be registered as a trade mark according to TMA 1994 s 3(1)(b).<sup>1552</sup>

Third, whether or not a LFC's name is descriptive depends on the type of goods in relation to which it is used. A LFC's name may serve as a trade mark for books and films, because some form of control of the proprietor of the mark would be guaranteed. However, the situation is non-uniform with regard to character merchandise. For example, the name of a LFC on image carriers such as posters and figurines might be

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<sup>1551</sup> See paras 3.6.2. and 3.6.3.2.

<sup>1552</sup> See para 3.6.3.2.

regarded as descriptive, while the name of a LFC on T-shirts and mugs may be regarded as badges of allegiance identifying a certain trade source.<sup>1553</sup>

Fourth, the likelihood of a successful trade mark registration may be at its highest when the name of the character is unknown. At that stage, the author will usually not have the financial capacity to market merchandising goods herself, and third parties would commonly not be interested in taking out a licence for producing and selling merchandise of an unknown character, because the profit margin is too low.

Fifth, ironically, when character goods are produced first and then made into a film or cartoons to promote the goods,<sup>1554</sup> then the trade mark rights may all be owned by one legal or natural person, the producer of the toys and other goods. However, when a book or film is published initially and afterwards goods with the characters are produced, which is usually the case, then it is more difficult for the creator of the character to also have the rights regarding the merchandise. Hence, not only are LFCs disadvantaged compared to AFCs, but also when the LFC is created before the goods as compared to when the character goods are created first and the book follows.

Sixth, characters and their names may be regarded by the public as merely decorative instead of indicating a source.<sup>1555</sup> In the past, some courts and academic commentators denied that the public has an awareness of character merchandising.<sup>1556</sup> The decision in ‘Betty Boop’ on the other hand accepted that the public has an awareness of character merchandising.<sup>1557</sup> However, this does not mean that a universal assumption can be made that the buying public will always associate the name of a LFC with its author and assume that the author has licensed the product. It just so happened in this case that the successors of the originator of the character ‘Betty Boop’ are the proprietors of the character’s name and image. It is still common though that traders, not authors, own a trade mark in the name of a fictional character.

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<sup>1553</sup> See paras 3.6.3.2.1. - 3.6.3.2.2.3. and 3.7.

<sup>1554</sup> That was the case with ‘Transformers’ by Mattel. The ‘He-man’ series, too, was produced to promote a line of new toys.

<sup>1555</sup> See para 3.6.3.1.

<sup>1556</sup> *Linkin Park LLC’s Trade Mark Application* [2006] ETMR 74 [38]; *BBC v Pally Screen Printing* [1998] FSR 665, 674; *Elvis Presley Trade Marks* [1997] RPC 543, 554; Helen Norman, *Intellectual Property Law* (2<sup>nd</sup> edn, OUP 2014) 514; Catherine Colston and Jonathan Galloway, *Modern Intellectual Property Law* (3<sup>rd</sup> edn, Routledge 2010) 740.

<sup>1557</sup> *Hearst Holdings Inc and Another v A.V.E.L.A. Inc & Others* [2014] EWHC 439 (Ch) [110] and [166] et seq.

The reason why the successors of the originator of ‘Betty Boop’ won the trade mark case was not because they had the copyright in the original cartoons. The successors of the originator of the AFC won the case, because they had put an effort into educating the public that ‘Betty Boop’ character goods came from them. Moreover, there had been only one single source of ‘Betty Boop’ merchandise until the defendants had started distributing and licensing ‘Betty Boop’ clothing. Therefore, nothing much has changed. Whoever is first to successfully register a trade mark for the name of a fictional character may enforce trade mark rights against others. As there is no copyright in LFCs or their name, the author of a LFC cannot object to trade mark registration by claiming to own an earlier right.<sup>1558</sup>

**RQ 1.b: Do actions for passing off protect authors against unauthorized use of their LFCs sufficiently?**

Copyright is also better suited for the protection of the author and her LFC than an action for passing off.

First, copyright vests automatically upon the creation of the original work. Goodwill, which is one of the three main elements of an action for passing off, requires proof and may change over the course of time. Copyright is a static, reliable positive IPR, while the tort of passing off only grants the negative right to sue a person who damages the goodwill of another by misrepresentation. Goodwill depends on many factors, such as the traders’ service and the quality of goods, but also, especially with regard to character merchandising items, on the public’s whimsical interest in the fictional character. Therefore, goodwill can dwindle quickly, but it may also last indefinitely. The consumers and other traders and authors would have more legal certainty if LFCs were copyright protected for a certain continuous period of time.<sup>1559</sup>

Second, like trade mark law, an action for passing off also suffers from the fact that a general awareness of the public that character merchandise is associated with the

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<sup>1558</sup> TMA 1994 s 5(4)(b).

<sup>1559</sup> See paras 4.4.1. – 4.4.3.1.

creator of the LFC cannot be universally assumed. It must be proven for each case based on the individual facts.<sup>1560</sup> Copyright is free from this issue.

Third, although the ‘common field of activity’-doctrine was abandoned and is now only an ‘evidential factor’, it can still have quite an impact, because whether or not the parties operate businesses in the same area of activity is an indication for a real possibility of confusion. Confusion is part of the very basis of the tort of passing off. Therefore, a significant evidential burden in relation to misrepresentation and a real likelihood of damage is placed upon the plaintiff, in particular where the plaintiff and defendant do not operate in the same field of business.<sup>1561</sup>

Fourth, a claim for passing off can only succeed, if the claimant can prove goodwill. The person claiming and establishing goodwill does not necessarily have to be a licensor, or licensed trader. Hence, it can happen that an unauthorized exploiter of a fictional character wins a case against an officially licensed exploiter.<sup>1562</sup>

Fifth, copyright is also more advantageous to authors where moral rights and an action for passing off overlap, because an action for passing off requires more evidence.<sup>1563</sup> For example, in a claim of paternity in a work, in contrast to an action for passing off, an author does not have to prove misrepresentation or actual customer confusion in a work. Furthermore, the author’s right to object to false attribution is actionable per se, unlike an action for passing off. A plaintiff claiming false attribution does not have to prove actual damage or a likelihood of damage either.

As both trade mark law and actions for passing off are not well suited for the protection of LFCs, it is justified to turn to an alternative form of protection – copyright. Copyright does not require administrative formalities, such as application for and registration of this right. Further, copyright was devised for the protection of authors and their works specifically. It is the second research objective of this thesis to critically evaluate and establish how exactly LFCs could be protected by copyright, i.e. whether the current

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<sup>1560</sup> See para 4.4.7. et seqq.

<sup>1561</sup> See para 4.4.6. et seq.

<sup>1562</sup> See para 4.4.5.2.

<sup>1563</sup> See paras 5.5. and 4.4.2. et seq.

copyright law is sufficient or whether changes might be necessary, and if so, which exactly are recommended.<sup>1564</sup> This is covered by RQ 2 - RQ 4.

**RQ 2: May a LFC per se be copyright protected as a work *sui generis*, a literary work or a substantial part of a copyright protected literary work?**

The second research question, which consists of three parts, asks whether LFCs can be classified as a work *sui generis*, a literary work or a substantial part thereof. The purpose of this question is to establish whether the categories of works according to the CDPA 1988 would have to be expanded, or whether it would be possible for courts to interpret an existing category to cover LFCs.

It was suggested by Rosati that the subject matter for which copyright protection is sought does not have to fall into a specific category of work. She argued that the consideration whether a work can attract copyright depends exclusively on whether or not the work is original. However, this would not be in conformity with the Berne Convention 1886, as the wording of Article 2(1) and its structure imply.<sup>1565</sup> Furthermore, the CDPA 1988 has maintained its list of categories in s 1(1) despite the advent of the new originality standard by the CJEU's decision on *Infopaq* in 2009.

Therefore, the following three parts of the second research question ask and answer individually whether a LFC could be a work *sui generis*, literary work or substantial part of a literary work.

**RQ 2.a: May a LFC per se be copyright protected as a work *sui generis*?**

If a LFC per se did not fit in any of the existing copyright categories of works, it would have to be a work *sui generis*. As a consequence, the CDPA 1988 would have to be wider and more flexibly worded like the French CPI 1992,<sup>1566</sup> because s 1(1) of the CDPA 1988 grants copyright only to works of the descriptions mentioned in that provision. It is an exhaustive list. In addition to CDPA 1988 s 1(1) and (2), any other

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<sup>1564</sup> See para 1.2.

<sup>1565</sup> See para 8.2.3.

<sup>1566</sup> See para 7.3.1.1.

provision that makes reference to the main categories of works, such as CDPA 1988 ss 17(2) and 77 - 85 would require extending to works *sui generis*.

However, this thesis strives to preserve the wording and structure of the CDPA 1988 as far as possible. Fewer legal changes would be required, if LFCs were literary works.

### **RQ 2.b: May a LFC per se be copyright protected as a literary work?**

Among all categories of works, LFCs are closest to literary works. In fact, LFCs could easily be regarded as literary works. A literary work is subject matter that is 'written, spoken or sung', but is neither a dramatic nor a musical work.<sup>1567</sup> LFCs consist of words expressed, in most cases, in a novel or other recorded work of words. The challenge is to extract the LFC from the work, because a LFC leaves its footprints throughout a work, in the direct description of the LFC's attributes as well as the indirect description of the LFC's attributes. The last-mentioned refers to the attributes that can be derived by the reader from what the LFC thinks, believes, says and does in the literary work. As many of a LFC's attributes are perceived indirectly, a LFC would benefit greatly from the fact that literary works can be copied directly, i.e. word for word, or indirectly, i.e. the meaning behind the words is copied, not the actual words in their actual order. Consequently, the category of literary works is ideal for LFCs.<sup>1568</sup>

However, LFCs are rarely an entity by themselves. LFCs appear typically in novels. If a book contains a collection of poems, then this is a compilation, a work consisting of several literary works. By contrast, a LFC or different parts of it can be found throughout a novel, and not just one separate, LFC-dedicated section of a novel. Therefore, even though a LFC arguably can be extracted as an entity from a novel, it is not a literary work itself when contained in a novel. It is then a part of a literary work.

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<sup>1567</sup> CDPA 1988 s 3(1).

<sup>1568</sup> See para 8.2.1.

### **RQ 2.c: May a LFC per se be a substantial part of a copyright protected literary work?**

Copyright in the underlying work is only then infringed if the reproduced part (here a LFC) is a substantial part of the work. Whether a new work copied substantially from the pre-existing work by featuring the same LFC in the new work, is decided upon many judging criteria. Among these are i.a. the quality rather than the quantity of the part (here the character elements) copied, the importance of the LFC relative to the pre-existing copyright work, the nature of the earlier and later work, and the degree of originality.<sup>1569</sup>

The substantiality criterion was not changed by the new originality standard.<sup>1570</sup> The substantiality criterion was re-affirmed by LLJ Jackson and Elias in the Court of Appeal's decision in *NLA v Meltwater*.<sup>1571</sup> CDA 1988 s 16(3) also still requires that the reproduced elements must amount to at least a substantial part of the earlier work. Otherwise copyright in the underlying work is not infringed by the subsequent work.

Therefore, this thesis argues that a LFC is not always a literary work and not always a substantial part. In terms of how a LFC can be classified, much depends on the kind of work in question.<sup>1572</sup> Where an author writes a character profile before starting with a novel and painstakingly keeps to the character profile moulding the story around it, the character profile of a LFC is a whole literary work itself. Some authors launch right into the story of a work, without prior creation of the LFCs. They develop the LFCs in the novel while the story is in the process of creation. With the evolving story, the LFCs 'grow', too. Then, the LFC is a substantial part of a literary work.

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<sup>1569</sup> See para 8.3.4.3.

<sup>1570</sup> See para 8.3.4.1.

<sup>1571</sup> *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890 [24].

<sup>1572</sup> See para 8.2.2.



### RQ 3: How can a court distinguish between copyrightable and non-copyrightable LFCs?

Simply put, copyrightable LFCs are original, non-copyrightable LFCs are not. However, what makes a LFC original? According to the CJEU's 'new' originality standard, a work is original, if it is the author's own intellectual creation.<sup>1573</sup> The new originality standard, which arguably sets the bar to copyright higher than the former skill, labour, judgment test,<sup>1574</sup> is no hindrance to LFC copyrightability. In fact, jurisdictions such as Germany<sup>1575</sup> and France<sup>1576</sup> had already been using this new higher originality standard before it was introduced for the whole of the EU, and LFCs are copyrightable in these jurisdictions regardless.<sup>1577</sup>

The new originality standard requires that the subject matter in question reflects the author's personal touch, which the author derives from the freedom of choices and individual exercise of this freedom. It is the individuality that arises from this act of creation which makes the work distinctive and distinguishable from pre-existing works.

Content reflects the author's choice of elements and words (unless it was consciously or subconsciously copied from another work). That goes for LFCs as for an entire story. Like a story is made up of story elements, such as fictional characters, place and time, and other story elements, LFCs are also made up of elements – character elements chosen by the author from the pool of outward attributes (appearance) and inward attributes (personality),<sup>1578</sup> which form a 'character pattern'.<sup>1579</sup> It is the selection and combination of these identity features, the interplay of these attributes as well as their expression in the text that makes a LFC an author's intellectual creation. One has to look beyond the succession of written words and look at the overall 'picture' that emerges, if one considers all attributes together as an entity. Therefore, it is submitted that the originality of a LFC can be judged not just by the exercise of the author's choice of individual attributes itself, but also by the LFC's aural significance emanating from the combination of character components, the character pattern.<sup>1580</sup> A LFC has aural

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<sup>1573</sup> See para 8.3.2.

<sup>1574</sup> See para 8.3.2.

<sup>1575</sup> See para 7.2.1.2.

<sup>1576</sup> See para 7.3.1.3.

<sup>1577</sup> See paras 7.2.2. and 7.3.2.

<sup>1578</sup> See paras 6.2.2., 6.3.2., 7.2.2., and 7.3.2.

<sup>1579</sup> See para 8.3.4.2.

<sup>1580</sup> See para 8.2.1.

significance when the LFC stimulates feelings and mental pictures of the LFC in the reader, i.e. when the reader has a feeling of having shared the LFC's life or when the LFC has touched the reader's life. Indicators of this having taken place are, that the reader wishes to know more about the LFC's 'life', or that the reader's life was even influenced by the LFC.

#### **RQ 4: Is current copyright law capable of covering LFCs per se by judicial re-interpretation, or are legislative changes necessary to the CDPA 1988?**

The short answer to this research question is that a combination of judicial re-interpretation of terminology used in the current provisions and principles as well as some legal changes to the CDPA 1988 is necessary in order to offer authors plot-independent copyright protection of their LFCs.

The long answer to this complex question detailing the changes proposed by this thesis is found in the following recommendations.

## **9.4. Recommendations**

### **9.4.1. Recommended judicial re-interpretation of the CDPA 1988**

First, a LFC should be categorized as a 'literary work' or 'substantial part' thereof depending on the purpose and originality of the LFC.<sup>1581</sup>

Second, whether a LFC is original, i.e. whether the LFC is the author's own intellectual creation should be measured by LFC specific identification criteria. These are, as demonstrated by Canadian,<sup>1582</sup> US,<sup>1583</sup> German,<sup>1584</sup> and French<sup>1585</sup> courts, the LFC's appearance (i.a. physique, hair style, attire, posture, glasses, cigarette brand, gadgets and other noteworthy external features) and its personality including the LFC's

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<sup>1581</sup> See para 8.2.1. et seq.

<sup>1582</sup> See para 6.2.2.

<sup>1583</sup> See para 6.3.2.

<sup>1584</sup> See para 7.2.2.

<sup>1585</sup> See para 7.3.2.

thoughts, beliefs, actions and skills. This should also include the LFC's name. Names by themselves should remain unprotected by copyright, but as an identification criterion of a LFC the name might be copyright protected.<sup>1586</sup>

Third, when comparing the pre-existing and the later LFC, the deciding court should outline the attributes of both LFCs, so that the decision is comprehensible and repeatable.<sup>1587</sup>

Fourth, when determining whether the LFC or LFC elements reproduced by the alleged infringer amount to a substantial part of the copyright protected work, reader recognition of the copied elements should be considered.<sup>1588</sup> Rather than considering recognition by the general public following the Canadian copyright regime, a slightly different approach should be adopted. Whether the allegedly infringed LFC is recognized in the allegedly infringing work by an average hypothetical reader (instead of the wide public) is more appropriate.<sup>1589</sup>

#### **9.4.2. Recommended additions to the CDPA 1988**

First, AFCs are copyright protected as artistic works not only against two-dimensional, but also three-dimensional copying.<sup>1590</sup> In order to put LFCs on an equal footing, so that a LFC as a literary work or substantial part thereof can also be copyright protected i.a. against unauthorized character merchandising, the wording of CDPA 1988 ss 17(3) and 51(1) would have to be changed. Not much change to the wording is required.

- a) CDPA 1988 s 17(3) could be changed to: 'In relation to a *literary or* artistic work copying includes the making of a copy in three dimensions of a two-

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<sup>1586</sup> See para 8.3.4.2.

<sup>1587</sup> See para 8.3.4.3.

<sup>1588</sup> See paras 7.2.2.2.7.4.3. and 8.3.4.4.

<sup>1589</sup> See para 8.3.4.4.

<sup>1590</sup> See paras 8.4.2.1. and 8.4.2.3.

dimensional work and the making of a copy in two dimensions of a three-dimensional work.<sup>1591</sup>

- b) CDPA 1988 s 51(1) could be phrased as follows: 'It is not an infringement of any copyright in a design document or model recording or embodying a design for anything other than a *literary or* artistic work or a typeface to make an article to the design or to copy an article made to the design.'<sup>1592</sup>

Second, it would also be recommendable to expand the scope of the paternity right to cover the possession or dealing with a work or copy of a work in the course of business.<sup>1593</sup> This restricted act could be added by way of a subsection to CDPA 1988 s 77 modelled after CDPA 1988 ss 83(1)(b) and 84(5)(a). According to CDPA 1988 s 83(1)(b), the right to object to derogatory treatment of the author's literary work or part thereof is infringed if a person e.g. sells an article which the vendor has reason to believe is or knows to be an article infringing the integrity right.<sup>1594</sup> The right to object to false attribution is also infringed according to CDPA 1988 s 84(5)(a), if a person possesses or deals with a copy of a work in the course of business, which contains a false attribution.<sup>1595</sup>

It may be argued that the introduction of LFC copyrightability independent of the plot causes overprotection. The balance between the author's interests and the interests of the public should be kept. Establishing plot-independent copyright protection of LFCs tips the scales in favour of authors. This thesis demonstrated that there are very good reasons for introducing this protection. However, when you add something you may also have to remove something for the purpose of balance. This can be achieved e.g. by shortening the period of protection or via copyright exceptions.

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<sup>1591</sup> The italicised words are the addition to this section.

<sup>1592</sup> Again, the italicised words are the addition to this section.

<sup>1593</sup> See para 5.4.1.3.3.

<sup>1594</sup> See para 5.4.3.3.

<sup>1595</sup> See para 5.4.2.3.

The copyright term for all literary, dramatic, musical or artistic works is currently 70 years from the end of the calendar year in which the author dies.<sup>1596</sup> If copyright protection for LFCs as such alone were offered for 50 years, then there would be an untoward discrepancy between the copyright term for whole literary works such as novels (including their substantial parts) and LFCs (be they a literary work themselves or a substantial part of it). It would be more consistent on a UK national level, if the copyright term for all works and their substantial parts were only 50 years. This would be sufficient to satisfy the requirements of the Berne Convention 1886, which requires that its contracting parties grant at least 50 years of copyright protection for literary works after the authors death.<sup>1597</sup> However, under EU law the copyright term for literary works is 70 years after the authors death.<sup>1598</sup> Hence, the option of reducing the copyright term in the UK is not very viable. The possibility that this might happen in the future after Brexit cannot be entirely ruled out, though.

Introducing a copyright exception as a counterweight to LFC copyrightability appears the more practicable option. Two options spring to mind:

- a) a private copying exception as proposed by Hargreaves and Gowers,<sup>1599</sup>
- b) a UGC exception as under Canadian copyright law.<sup>1600</sup>

Member States of the EU may provide exceptions to the reproduction right, but on the condition that rightsholders receive fair compensation.<sup>1601</sup> A private copying exception had been introduced in the UK on 1 October 2014.<sup>1602</sup> CDPA 1988 s 28B permitted that hard copies and electronic copies i.a. of literary works and substantial parts thereof

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<sup>1596</sup> CDPA 1988 s 12(1) and (2).

<sup>1597</sup> Berne Convention 1886, art 7(1).

<sup>1598</sup> 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 [2006] OJ L 372/12, art 1(1).

<sup>1599</sup> Ian Hargreaves, 'Digital Opportunity – A Review of Intellectual Property and Growth' (May 2011) 48 <<http://www.ipo.gov.uk/ipreview-finalreport.pdf>> accessed 3 October 2011; 'Gowers Review of Intellectual Property' (December 2006) 4 et seq <<http://www.official-documents.gov.uk/document/other/0118404830/0118404830.pdf>> accessed 25 February 2014.

<sup>1600</sup> Section 29.21 of the CA 1985. See para 6.2.3.

<sup>1601</sup> 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 [2001] OJ L167/10, recital 38 and art 5(2).

<sup>1602</sup> The Copyright and Rights in Performances (Personal Copies for Private Use) Regulations 2014, SI 2014/2361, reg 1(1).

could be made for private use without infringing copyright, if the copy in question is the individual's own copy or a personal copy of that work made by the individual. Furthermore, the copy must have been made for the individual's private use. Its use may be neither directly nor indirectly commercial.<sup>1603</sup> However, this private copying exception provided no compensation mechanism for rightsholders<sup>1604</sup> unlike in other European countries, such as Germany, France, Belgium and Austria.<sup>1605</sup> BASCA and other music industry stakeholders applied for Judicial Review, which succeeded on 19 June 2015.<sup>1606</sup> The Secretary of Business, Innovation and Skills believed it was not necessary to institute a compensation or levy scheme, because he was of the view that a private copying exception can be introduced into the CDPA 1988, which caused zero or only minimal harm to rightsholders.<sup>1607</sup> Green J and the claimants agreed that, if indeed no or no material harm were caused, it would not make sense to implement a compensation scheme, as zero compensatory payments would be made under those circumstances.<sup>1608</sup> However, Green J later found that the evidence relied upon by the Secretary of State was inadequate as to whether pricing-in will lead to minimal or no harm, or whether it 'leaves some harm ... and if so whether this residual harm is *de minimis*'. It was not defined what is meant by the term '*de minimis*'.<sup>1609</sup> As a result, the private copying exception was quashed on 17 July 2015.<sup>1610</sup>

This leaves the abovementioned option b), the introduction of a fair dealing exception for non-commercial user-generated content modelled on section 29.21 of the Canadian

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<sup>1603</sup> CDPA 1988 s 28B(1) and (5).

<sup>1604</sup> *R (on the application of British Academy of Songwriters, Composers and Authors) v Secretary of State for Business, Innovation and Skills* [2015] EWHC 1723 [182].

<sup>1605</sup> WIPO, 'International Survey on Private Copying' (2015) 30 et seqq, 37 et seqq, 74 et seqq and 81 et seqq <[http://www.wipo.int/edocs/pubdocs/en/wipo\\_pub\\_1037\\_2016.pdf](http://www.wipo.int/edocs/pubdocs/en/wipo_pub_1037_2016.pdf)> accessed 14 November 2016.

<sup>1606</sup> *R (on the application of British Academy of Songwriters, Composers and Authors) v Secretary of State for Business, Innovation and Skills* [2015] EWHC 1723 [316].

<sup>1607</sup> *Ibid* [182].

<sup>1608</sup> *Ibid* [183] et seqq. and [205].

<sup>1609</sup> *Ibid* [265], [268] and [270] et seq.

<sup>1610</sup> *R (on the application of British Academy of Songwriters, Composers and Authors) v Secretary of State for Business, Innovation and Skills* [2015] EWHC 2041 [11].

CA 1985.<sup>1611</sup> The first Canadian copyright law of 1921 was inspired by UK copyright law.<sup>1612</sup> This time, UK copyright law can take inspiration from Canadian copyright law.

A fair dealing exception for UGC is beneficial to both rightsholders and fans. It gives e.g. fanfiction writers as well as creators of 3D fan works the legal freedom to create non-commercial UGC. This provision applies not only to a private environment, but even if the individual communicates the UGC to the public. One condition is that said work is non-commercial and does not have a substantial adverse financial or other adverse effect on the exploitation of the pre-existing original work or an existing or potential market for that work or substantial parts of that work either. Another condition is that the source work and its author are named as such by the creator of the UGC. This has the benefit for the author of the source material that she can use the advertising effect of the fanworks for herself, and does not have to worry that the fanwork will be confused with her work. Even so, to ensure that the author of the source can still fight back, if the UGC has an unsavoury non-commercial adverse effect on her and her work, this exception should not affect the moral rights.<sup>1613</sup> That means, the author can still make use of the moral rights, in particular the integrity right, even against use of her source work in non-commercial UGC.<sup>1614</sup>

Due to the fact that UGC under such a fair dealing exception would not infringe an author's economic rights, if it is non-commercial and has no adverse effect, financial or otherwise, on the source work, business models like Kindle Worlds, which commercialize fanfiction, would still require a licence from the rightsholder. Further, CAD files based on original source material, which are made available e.g. on Yeggi or Thingiverse for free, might also infringe copyright when the popularity of the fanwork affects sales of the original.<sup>1615</sup>

Some UGC may be parody, caricature or pastiche. This is already covered by CDPA 1988 s 30A. However, s 30A covers commercial as well as non-commercial parody. A

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<sup>1611</sup> See para 6.2.3.

<sup>1612</sup> See para 6.1.

<sup>1613</sup> See para 6.2.3.

<sup>1614</sup> With regards to commercial works, the moral rights apply anyway, as the UGC exception only refers to non-commercial works.

<sup>1615</sup> See para 5.4.1.3.1.

newly introduced CDPA 1988 s 30B should be a) wider in so far as it would cover also UGC that is not of a parodic nature, and b) narrower in so far as it would only cover UGC works that are non-commercial or do not negatively affect the underlying work in any other way.

Therefore, for the sake of balancing diverging interests, the final legal addition proposed to the CDPA 1988 by this thesis is a UGC fair dealing exception with the following wording:

‘(1) Fair dealing with a work for the purposes of user-generated content does not infringe copyright in the work.

(2) Copyright in a work is not infringed by the use of subject-matter of the existing work for the creation of a new work provided that the new work is made solely for a non-commercial purpose and does not have a financial or other substantial adverse effect on the actual or potential exploitation of the pre-existing work.’

## 9.5. Key conclusions

The following key conclusions regarding the implementation of plot-independent LFC copyrightability can be drawn from the above:

Trade mark law and actions for passing off are unsuitable and insufficient for the protection of authors’ interests in their LFC per se. Trade mark law is unsuitable, because the only aspects of a LFC for which a trade mark may be applied for is the LFC’s name. The LFC as such does not qualify for any of the traditional and non-traditional trade marks. Trade mark law is insufficient, i.a. because even though a LFC’s name may in theory be registered as a trade mark, in particular trade mark’s origin function can stand in the way of trade mark registration. Further, trade mark registration regarding character merchandise objects is non-uniform. Whether or not a LFC’s name is descriptive would depend on the type of goods in relation to which it is used.

The issue with actions for passing off rather lies in the greater efforts that are required from the claimant in an action for passing off, and the fact that though an action for passing off might protect a LFC under limited circumstances, it may not necessarily be



the author who benefits from this protection, but a trader who makes unlicensed use of the LFC.<sup>1616</sup> This makes an action for passing off inappropriate rather than inadequate for the protection of an author's interest in her LFC.

A more appropriate protection could be secured for LFCs in the UK by means of copyright. There is no absolute reason why LFCs should not be protected by copyright independent of the plot of the work they feature in originally. Foreign jurisdictions, e.g. Canada, the USA, France and Germany prove that LFCs are not always ideas, but may instead be original literary works or a part thereof, or even a work *sui generis*. With the EU-wide implementation of the same originality standard that is applied in France and Germany, a LFC should also be capable of being regarded as an original literary work, substantial part of such, or a work *sui generis* in the UK. The first two options were regarded as preferable to a work *sui generis* in this thesis, and it was suggested that whether a LFC is one or the other, a literary work or a substantial part of one, depends on the form it takes. In most cases a LFC will be a part of a literary work, though. In this context, it was also submitted that when determining whether a substantial part was copied it would be recommendable to consider whether the average hypothetical reader would still be able to recognize the LFC in the new work despite some changes to the LFC and despite the fact that the original LFC was extracted from its original context.

Considering the potential financial gain from character merchandise and the proposed recommendations above, it became clear that even a few legal changes could have a big impact on authors. Of the proposed additions to the legal text of the CDPA 1988 itself only a change to the wording of CDPA 1988 ss 17(3) and 51(1) is necessary to ensure that authors could not only protect their LFC against unauthorized use in two dimensions, but also against unauthorized use in three dimensions. All other proposed additions to the CDPA 1988 are simply either for the sake of creating further harmony among a set of rights (adding a subsection to the paternity right with regard to possession or dealing with a work or copy of a work in the course of business) or for

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<sup>1616</sup> See para 4.4.5.2.

the sake of maintaining a balance between the interests of authors and the public's interests (adding a fair dealing exception specifically for non-commercial UGC).

## 9.6. Suggestion for future development

Once LFC copyrightability would be implemented, it might take parties using or intending to use LFCs some time to 'acclimatise' to LFC copyrightability. This process could be sped up by extending a system that is already in place. PLSclear facilitates licences for the use of text extracts, chapters, poems, diagrams, or tables. This system could be extended to licensing LFCs, should the UK be ready to accept LFC copyrightability in the future. The same system might also assist in making the decisions on copyrightable and non-copyrightable LFCs. Some issues, though, require attention.<sup>1617</sup>

First, at present, not all publishing houses, that includes even the major publishing company HarperCollins, make full use of PLSclear.<sup>1618</sup> Second, many self-published authors may not even know about PLSclear. Hence, their literary works including LFCs would not be listed on PLSclear. Third, many people in the business of character merchandising may not be aware of the existence and possibilities of PLSclear.

Fourth, the biggest issue with PLSclear is that it is a licensing service. As such, only copyrighted works can be listed in PLSclear's database. It does not determine whether a work (LFC) is copyrightable. One option would be to add a provision to the CDPA 1988 which gives PLSclear the power to appoint administrators to decide which LFC is copyrighted and which not, very much like the role played by trade mark administrators. One may not have to go that far though, because PLSclear already handles requests for reuse of text extracts. That means, decisions are being made whether those extracts require licensing or can be used without.<sup>1619</sup> It is suggested that PLSclear could administer requests for reuse of LFCs in the same procedure. This would, of course, imply decisions on the LFC's copyrightability. Copyright vests

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<sup>1617</sup> See para 3.5.2.

<sup>1618</sup> See para 3.5.2.

<sup>1619</sup> Whether these decisions are made individually and manually or generally and automatically based on a certain number of words is not clear. However, deciding on an extracts copyright protection based just on its lengths would violate the 'quality before quantity'-principle.

automatically in the UK, and in principle it is for the courts to decide whether a party truly owns copyright in the disputed work and whether the other party has infringed copyright. This would not change, even if PLSclear would extend its operations to LFCs. The courts would retain the power to review the facts, including PLSclear's decisions, and make a legally binding decision, if a dispute arose. As PLSclear facilitates licences, its decisions can be reviewed specifically by the Copyright Tribunal which is empowered to decide on cases involving licensing bodies,<sup>1620</sup> including prospective licences.<sup>1621</sup>

Further legal certainty could be provided, i.a. for creators of transformative works, by installing a 'triple safety net'. In addition to the licensing service offered by PLSclear and public domain calculators,<sup>1622</sup> a digital public domain registry could be implemented.<sup>1623</sup> The British Library would be predestined to administer such a digital public domain registry. The British Library already keeps a record of and stores one copy of each book, periodical and newspaper that is published in the UK. In addition, the British Library is already in the process of creating an online accessible repository of digital images of prints, drawings, maps, art works and photographs, etc. The same could be done for literary works which are in the public domain.

Hence, the ingredients for facilitating licensing of LFCs and for providing more legal certainty regarding character copyright are there. It is only a matter of reaching out and availing oneself of the opportunities.

\*\*\*\*\*--- The End ---\*\*\*\*\*

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<sup>1620</sup> PLSclear is a service run by PLS, which is a licensing body.

<sup>1621</sup> CDPA 1988 s 125.

<sup>1622</sup> See para 3.5.3.

<sup>1623</sup> See para 3.5.3.

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BGHZ 532, 1

BGHZ 122, 53

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GRUR 2014, 258

GRUR 2011, 134

GRUR 2004, 855

GRUR 2004, 855

GRUR 2004, 65

GRUR 2002, 958

GRUR 1999, 984

GRUR 1997, 833

GRUR 1997, 832

GRUR 1997, 128

GRUR 1995, 47

GRUR 1994, 206

GRUR 1994, 191

GRUR 1993, 34

GRUR 1992, 510

GRUR 1990, 674

GRUR 1990, 270

GRUR 1986, 458

GRUR 1981, 520

GRUR 1978, 302

GRUR 1971, 588

GRUR 1963, 485

GRUR 1963, 40

GRUR 1961, 631

GRUR 1960, 144

GRUR 1959, 379

GRUR 1958, 354

GRUR 1957, 395

GRUR 1956, 432

GRUR Int 1999, 884

GRUR-RR 2011, 447

GRUR-RR 2008, 44

GRUR-RR 2008, 388

GRUR-RR 2008, 37

GRUR-RR 2007, 226

GRUR-RR 2004, 285

GRUR-RR 2003, 233

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WRP 2014, 178

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ZUM 2011, 77

ZUM 2011, 151

ZUM 2010, 69

ZUM 2009, 581

ZUM 2008, 709

ZUM 2004, 853

ZUM 2003, 867

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