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Superheroes: An Overview of Protecting Characters Under the Law

Try to imagine a superhero. Did you envision a large man in tights? How about superpowers, an arch nemesis, or a name ending in “-man?” Did you envision Spider-man, Superman, or Batman? Maybe you thought of Wolverine or the Incredible Hulk?

If you are like me, and grew up with these characters, the mere mention of their names will not only bring forth visions of their physical traits, but also their respective histories, personalities and adventures. Each of these unique characters began life in a comic book and has since been redrawn by numerous artists. They have been featured in popular movies and television shows, both live and animated. Each of these characters has also been featured in several of their own video games. The popularity of these superheroes has led to the creation of countless merchandise items bearing their name or likeness. Action figures, lunch boxes, toothbrushes, clothing, multivitamins, and underwear have all borne the mark of superheroes.

How do we know these characters so well? Why is Superman the only Superman? To a certain degree, the legal protection afforded these superheroes has allowed them to remain so well known. Copyright, trademark, unfair competition, and design patent protection are the chief legal avenues utilized by character owners to maintain exclusive rights in their creations.

Through the example of the superhero, this paper will explore the legal implications of creating, owning, and maintaining a character.

Copyright

-Copyright for characters in general-

Copyright protection extends to original works of authorship fixed in a tangible medium of expression.¹ The copyright act also specifically denies protection for ideas, regardless of the form in which it appears.² These basic subject matter requirements present the vital issue of whether a creative work is an unprotectable idea or protectable expression. For characters not specifically granted protection under copyright, this idea/expression dichotomy can be very tricky. The fixed and original books, movies, or other artwork the characters appear in will generally receive copyright protection. However, at the same time, many characters within a story can be unprotectable ideas in the public domain. For example, the character Darth Vader is protectable under copyright because it is a sufficiently unique expressive element found within the fixed media of the *Star Wars* series.³ But, I would have trouble maintaining the same argument for the character of “Court Reporter #2” who appears in the movie *Batman Begins*. Unlike Vader, “Court Reporter #2” has no name, no personality, no significant physical features and could easily be mistaken for “Court Reporter #1.”

In *Nichols v. Universal Pictures Corp.*,⁴ the first major case where a court had to deal with this problem, Judge Learned Hand struck down an infringement claim partially based on the similarity of the characters found in the two plays in question. The court found that although characters can receive copyright protection, the characters in this case were not subject to copyright protection because they were not expressive elements separate from the story. The

¹ §102

² Id

³ *Ideal Toy Corp. v. Kenner Products Division of General Mills Fun Group, Inc.*, 443 F.Supp. 291. Although the court discusses the general issue of character copyright it declines to say whether Vader is copyrighted character. The court goes on to find non-infringement based on the lack of similarity between Vader and the action figure in question.

⁴ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir.), cert. denied, 282 U.S. 902 (1930).

court referred to the characters as prototypical “stock figures,” and “so faintly indicated as to be no more than stage properties.” In other words, stock characters, or characters with no real development, are merely ideas under the copyright code that belong in the public domain. As Judge Hand explained, “the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.” The Nichols decision also took a practical approach to the problem, noting that playwrights would be unable to create even the most trivial characters if another play contained the same role.

Hand’s approach has come to be known as the “delineation test,” as it seeks to separate idea from expression based on how well developed or delineated the character is. The character of Tarzan, created by Edgar R. Burroughs, has been judged copyrightable under this standard.⁵ In an infringement action instituted by Burroughs, the New York District Court discussed the extent of copyright protection afforded to Tarzan as a preliminary matter. The court found that the original literary work “Tarzan of the Apes” not only received protection for its plot, but also for the well delineated character of Tarzan. The court’s analysis of Tarzan’s expressive elements was very clear: “Tarzan is the ape-man. He is an individual closely in tune with his jungle environment, able to communicate with animals yet able to experience human emotions. He is athletic, innocent, youthful, gentle and strong. He is Tarzan.”⁶

The delineation test is not the only analysis that has been employed by courts to determine the copyrightability of characters. In Warner Brothers Pictures, Inc. v. Columbia Broadcasting System, Inc.,⁷ the Ninth Circuit created the unpopular “story being told” test based

⁵ Burroughs v. Metro-Goldwyn-Mayer, Inc., 519 F.Supp. 388, (S.D.N.Y. 1981), aff’d, 683 F.2d 610 (2d Cir.1982).

⁶ Id. at 391

⁷ Warner Brothers Pictures, Inc. v. Columbia Broadcasting System, Inc., 216 F.2d 945 (9th Cir. 1954).

in part on the Nichols case. In this case, the court determined the Sam Spade character from *The Maltese Falcon* did not deserve copyright protection separate from the story he appeared in. The court stated, “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.” On this basis the court found that the Spade character could only be considered a vehicle for telling the story and therefore not subject to copyright. Many legal authorities have difficulty with this “story being told” test because it seems to never allow copyright to apply to characters.⁸ Only works that devote themselves to a character, in lieu of a plot, would seem to meet this standard.

Despite the confusing wording in the Warner Brothers case, the “delineation” test and the “story being told” test use a similar analysis to determine if a character can be protected by copyright. They both seek to prevent characters that are too generic (“chessmen”) from receiving copyright protection, while affording copyright to more expressive characters. Nimmer follows the same analysis, finding that the standard for character copyright is whether the character is “sufficiently developed” or “distinctly delineated.”⁹ Whether a court chooses to use the verbiage of one test over another does not change the central analysis that was identified by Nimmer; that is they all aim to protect only those characters that have developed an original expressive identity beyond the story they appear in.

-For Superheroes-

Any of these character copyright tests make it difficult for literary characters to obtain copyright protection. As seen in the Nichols and Sam Spade cases, many literary characters are stock characters or characters whose only identity is a vehicle for the progression of the story.

⁸ See 1-2 Nimmer on Copyright § 2.12 notes 13-18.

⁹ Id.

The words, actions and thoughts of the stock character as expressed in the words of the book might be protected, but the characters themselves may only be a generic construction (an idea) used by countless prior authors.

Unlike literary characters, a superhero is usually created in a comic book that contains both a written story and two-dimensional artwork depicting the story. This additional visual identity can often provide the delineation necessary for copyright protection. In a case following the Nichols and Warner Bros. decisions the Ninth Circuit faced an attack on the copyright protection afforded to Disney characters.¹⁰ The court said, “while many literary characters may embody little more than an unprotected idea, a comic book character, which has physical as well as conceptual qualities, is more likely to contain some unique elements of expression.” Thus, an artistic visual existence provides superheroes a head start over other characters when seeking copyright protection.

The visual existence of a superhero may often grant it the status of a well-delineated expressive character, but the idea/expression dichotomy will still affect the copyright analysis. Many general superhero features fall into the realm of ideas: super powers, an alter ego, a costume, an arch-nemesis, etc. These public domain superhero components are particularly important in infringement cases. To find infringement, a court must determine if a substantial similarity exists between the expressive elements of the works in question.¹¹ While conceptually separating out the non-expressive ideas, a court will look to the similarity between the visual

¹⁰ Walt Disney Productions v. Air Pirates, 581 F.2d 751 (9th Cir. 1978).

¹¹ Reyher v. Children's Television Workshop, 533 F.2d 87, 90-91 (2d Cir.), cert. denied, 429 U.S. 980, 97 S.Ct. 492, 50 L.Ed.2d 588 (1976); Nichols v. Universal Pictures Corp., 45 F.2d 119 at 121.

resemblance and the totality of the characters' attributes and traits.¹² In Warner Bros. Inc. v. American Broadcasting Companies, Inc.,¹³ the owners of the Superman character sued the makers of a television show for infringement. The show, titled *The Greatest American Hero*, was essentially a Superman parody featuring a bumbling superhero named Ralph Hinkley who wore red tights. The court took great care to fully flush out and compare the traits of each character. The court determined that while the Hinkley character might remind some people of Superman, “the total perception of all the ideas as expressed in each character is fundamentally different.” The court noted that many of the attributes shared by the characters were in fact unprotectable ideas. However, the court refused to abandon an analysis of these traits because the unique combination of unprotectable ideas can constitute protectable expression.¹⁴

Although Superman failed in his attempt to topple *The Greatest American Hero*, he was able to defeat the sinister Wonderman. In Detective Comics v. Bruns Publications,¹⁵ the owners of the Superman comic books successfully sued the publishers and creators of a rival comic book (*Wonderman*) for infringement. After studying the *Wonderman* comic book, the court determined that the only difference between the two characters was that Wonderman was dressed in a predominantly red costume, while Superman wore his traditional blue outfit. They each had the same powers, the same personality, and most importantly to the court, Wonderman was depicted doing the same things that the Superman character was known for. Both characters were pictured running off into the night, crushing a gun with a bare hand, reflecting bullets, jumping over buildings, and ripping open steel doors. The creators of Wonderman went beyond

¹² Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp., 562 F.2d 1157, 1167 n. 9, 1169 (9th Cir.1977).

¹³ Warner Bros. Inc. v. American Broadcasting Companies, Inc., 720 F.2d 231 (C.A.N.Y.,1983).

¹⁴ Id at 243.

¹⁵ Detective Comics v. Bruns Publications, 111 F.2d 432.

the general ideas that all comic book creators are allowed to utilize to appropriate the expressive elements of the Superman character.

There is confusion about how, or if, copyright can be afforded to component parts of a character. According to some courts copyright is available not only for characters (often as an expressive component part of another work), but also for the expressive component parts that significantly aid in identifying the character.¹⁶ Thus, Freddy Krueger's glove as seen in *Nightmare on Elm Street* has been granted copyright protection.¹⁷ Other courts will look to the similarity in icons and accessories but this is the first to grant copyright protection to an individual accessory. Superhero catch phrases are probably not protected under copyright law, but the court in the *Greatest American Hero* case suggested Superman's "Look, in the sky, it's a..." phrase had been protected under copyright.¹⁸ Trademark protection should probably be relied on to prevent these types of infringement.

The owners of copyright are granted several specific exclusive rights by the copyright code. While the rights of reproduction and distribution are certainly significant, the right to create derivative works is especially important for superhero copyrights. As mentioned above, superheroes in comic book form can be redrawn by numerous artists, they can appear in different forms in different media, and can otherwise be transformed into countless variations. The right

¹⁶ New Line Cinema Corp. v. Russ Berrie & Co., Inc., 161 F. Supp. 2d 293; and New Line Cinema Corp. v. Easter Unlimited, Inc., Not Reported in F.Supp., 1989 WL 248212, E.D.N.Y., 1989. Both cases cited Dallas Cowboys, etc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 204 (2d Cir.1979), for this proposition. Dallas Cowboys was a *trademark* case where the features of a cheerleading uniform sufficiently indicated sponsorship or origin. The New Line cases are now cited for the *copyright* protection of character accessories.

¹⁷ New Line Cinema Corp. v. Russ Berrie & Co., Inc., 161 F. Supp. 2d 293.

¹⁸ The Warner Bros. court, 720 F.2d 231 at 236, cited D.C. Comics, Inc. v. Crazy Eddie, Inc., 205 U.S.P.Q. 1177 (S.D.N.Y.1979), as the opinion that granted copyright in Superman's phrase. The opinion actually found that the defendant's commercial had thoroughly infringed upon the entirety of a Superman trailer; the phrase was not mentioned in the opinion. Justin Hughes, Size Matters (Or Should) In Copyright Law, 74 Fordham L. Rev. 575 (2005).

to prepare derivative works is what prevents an infringer from creating their own derivation on a copyrighted character. For example, a hopeful artist, Sapon, submitted a sketch titled “The New Batman” to DC comics in hopes they would use his design for a revamped Batman comic.¹⁹ Some fifteen years later, DC introduced a new Batman incarnation in the *Batman Beyond* series that Sapon believed infringed on his submitted work. Sapon sued DC for infringement and lost because DC never granted Sapon the right to create derivative works based on their Batman character. It was Sapon that was the infringer.²⁰ Thus, derivative work protection ensures that a superhero owner not only owns the right to the original incarnation of a character, but also any derivations thereof.

Trademark , Unfair Competition and Design Patents

-Trademark and Unfair Competition-

Marvel comics is likely the largest owner of superhero characters. With over five thousand characters, Marvel refers to itself as the “world’s largest character-based entertainment company.”²¹ Like many character owners, Marvel is able to exploit the commercial potential of all these characters through publishing, licensing and merchandising. Along with the copyright interests in their superheroes, Marvel has other means to protect their characters in commerce.

Trademark and unfair competition law provide protection for distinct characters used to identify a source of goods.²² The basic elements of a trademark claim are ownership of the mark and likelihood of confusion. An unfair competition claim, based on confusion of sponsorship, is so similar that courts usually decide the two issues in unison.²³ Courts have determined that trademark protection can be applied to character names, nicknames, slogans, symbols,

¹⁹ Sapon v. DC Comics, Not Reported in F.Supp.2d, 2002 WL 485730, S.D.N.Y.,2002.

²⁰ Also see Anderson v. Stallone, 11 USPQ2D 1161 (C.D. Cal. 1989).

²¹ http://www.marvel.com/company/index.htm?sub=about_current.htm

²² Lanham act § 43(a), 15 U.S.C. s 1125(a).

²³ Warner Bros. Inc. v. American Broadcasting Companies, Inc., 720 F.2d 231.

appearance and costumes, but not for physical abilities or personality traits.²⁴ Many superhero characteristics used in commerce are inherently distinctive or suggestive and do not need a secondary meaning to be a distinct identifier of goods.²⁵ Thus, many cases turn on the issue of whether the use of the mark caused confusion in the marketplace. For example, Marvel was able to prevent a multivitamin producer from naming their newest product “Iron Man.” Marvel owns a valid trademark in their Iron Man character, a man who wears a robotic metal suit. Despite the existence of numerous other Iron Man trademarks, and the seeming descriptive nature of the name (he is, after all, a man in iron), the court found the mark to be a strong one.²⁶ They then rested their decision on the grounds there would be a likelihood of confusion because Marvel had already entered the multivitamin business with the Spider-Man character.²⁷

Although copyright and trademark are independent forms of protection, both copyright and trademark protection will often apply to superhero media.²⁸ So, when a superhero owner sues an infringer they often bring both copyright and trademark/unfair competition claims simultaneously. This has played an important role in the court’s analysis of the issues of substantial similarity and consumer confusion. In nearly every superhero case, the opinion deals first with copyright infringement and then trademark and other claims. Thus, the substantial similarity question will usually come first and trademark confusion analysis will usually follow. Since these two questions are so similar the court will usually adopt the substantial similarity

²⁴ DC Comics, Inc. v. Filmation Associates, 486 F. Supp. 1273, 1277, 206 U.S.P.Q. 112 (S.D.N.Y. 1980); characters in video games can be protected as non-functional design features. Midway Mfg. Co. v. Dirkschneider, 543 F. Supp. 466, 214 U.S.P.Q. 417 (D. Neb. 1981); DC Comics, Inc., 689 F.2d 1042.

²⁵ Cadence Industries Corp. v. Kerr, 225 U.S.P.Q. 331 (T.T.A.B. 1985).

²⁶ Some other Ironman products include watches, tools, robots, and cabinets.

²⁷ Cadence Industries Corp. v. Kerr, 225 U.S.P.Q. 331 (T.T.A.B. 1985).

²⁸ Trademark will continue to run after copyright has expired. Frederick Warne & Co. v. Book Sales, Inc., 481 F. Supp. 1191, 205 U.S.P.Q. 444 (S.D.N.Y. 1979).

answer for the question of consumer confusion.²⁹ For example, in the *Greatest American Hero* case, copyright, trademark and unfair competition claims were brought against the defendant.³⁰ After the court found the copyright claims could not stand because there was no substantial similarity they moved on to the trademark claims. Noting the similarity between the two questions the court said, “the absence of substantial similarity leaves little basis for asserting a likelihood of confusion.”³¹ Following the same analysis that found no substantial similarity between *Greatest American Hero* and Superman, the court determined there could be no confusion about which work belonged to whom.

Action figures and toys are lucrative merchandising options for popular characters, so it is not surprising that many cases revolve around action figure infringement. In one case a court was called onto determine whether the action figure Knight of Darkness from “Star Team” infringed upon Darth Vader from “Star Wars.”³² The court dealt with the copyright claim first, and determined that the Knight of Darkness character was not substantially similar to Vader. Turning to the trademark and unfair competition claims, the court explicitly acknowledged the similarity between the two claims: “the Court has already discussed at some length the similarities between the toys themselves and the movie characters in connection with the allegation of copyright infringement. The “lay-observer, substantial similarity test” applied on that claim is virtually identical to the comparable unfair competition standard.”³³ Thus, the court

²⁹ The Freddy Kruger case presents the exception to the rule. New Line won on the issue of copyright infringement but lost the trademark claims because there was no consumer confusion. *New Line Cinema Corp. v. Russ Berrie & Co., Inc.*, 161 F. Supp. 2d 293.

³⁰ *Warner Bros. Inc. v. American Broadcasting Companies, Inc.*, 720 F.2d 231.

³¹ *Warner Bros.* at 246, quoting *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d at 918.

³² *Ideal Toy Corp. v. Kenner Products Division of General Mills Fun Group, Inc.*, 443 F.Supp. 291.

³³ *Id.* at 306.

denied relief because with no substantial similarity between the characters, there could be no confusion as to the source of the goods.

Mattel has faced similar problems when enforcing trademark infringement claims related to their “Masters of the Universe” toy line (made famous by the He-Man character). In one case Mattel sued a company named Remco that released a set of competing action figures called the “Warlords.”³⁴ The “Warlords” had different names, heads, and clothing, but they used the same plastic torso as the “Masters of the Universe.” Despite evidence that Remco used the He-Man torso as their prototype, the court found that the “Warlords” did not infringe Mattel’s copyright or infringement rights. First, the court determined the torso could not be protected under copyright law. A muscle-bound torso is only an idea, the court reasoned, and the minimal expressive elements that existed on these two torsos were not substantially similar. Turning to the trademark claims, the court (unsurprisingly) found that He-Man’s musculature had not developed secondary meaning and that consumers would not confuse the “Warlords” with the “Masters of the Universe.”

- Design Patents-

Trademark and unfair competition are invaluable tools for protecting merchandise and superhero products. Another, somewhat less useful, method for protecting merchandise is afforded through patent law. Aside from useful inventions, patent law grants protection to a person who has "invented" a new, original, and ornamental design for an article of manufacture.³⁵ This type of protection does not apply to purely artistic works, rather it is only appropriate for utilitarian objects or industrial designs. Toys with unique characteristics can fall

³⁴ The “Warlords” characters were licensed from DC comics. Mattel, Inc. v. Azrak-Hamway Intern, Inc., 724 F.2d 357.

³⁵ 35 U.S.C.A. § 73.

under this standard, so it is not uncommon for design patents to cover superhero toys. Unlike trademark or copyright, a design patent infringement case is determined by the similarity between the design patent drawings, not the commercial embodiment of the patented design. For example, in one case involving character merchandising, a plastic duck manufacturer's design was held invalid because the earlier design of Disney's Donald Duck anticipated it.³⁶ A design patent is not the most utilized method for character protection, as copyright and trademark cover more ground, but it is a valid option nonetheless.

Conclusion: Contracts and Licensing

As a final note, it is important to remember that the creation and use of superhero characters may give rise to copyright, trademark, and patent protection, but contractual relationships will more frequently than not define the scope of ownership. Whether it is a comic book artist contracting away all of his rights in a hero he created, or a massive co-branding deal involving a movie, video game, and action figure line, the importance of a well drafted contract cannot be understated. Characters should always be treated separately from the work as a whole to guarantee the correct interests have been transferred or retained.³⁷

A superhero, protected under the various legal avenues discussed in this paper, and well-defined in any contractual agreements, can provide entertainment to kids of all ages and super-sized profits for its owner.

³⁶ Nickerbocker Plastic Co. v. Allied Molding Corp., 184 F.2d 652.

³⁷ Warner Brothers Pictures, Inc. v. Columbia Broadcasting System, Inc., 216 F.2d 945 (9th Cir. 1954).