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Copyright Protection for Fictional Characters: Balancing Creativity and Legality

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ABSTRACT

The ever engaging fantasy of the fiction has always been a part of IP regime. The question related to the protection given to the characters which are associated with the fiction puts an imperative obligation on the makers of such fiction that, whether they want to protect such characters independently of the work in which they are being imbedded or not? This concept goes beyond the normal protection given to the works of the author under the copyright regime. Generally speaking, the very aim of defining this kind of protection is to facilitate the authors to get the additional benefits which may arise in the independent utility of the characters. The courts are of the view to define such rights on the basis of the relevancy of the characters with regards to their description that they can be identified independently and their association with the story. The main issue in the copyrightability of the character is the application of the tests given by the courts and are they sufficient enough to provide protection to the characters? This paper analyses the evolution of protection given to characters and gradually goes into the intricacies of the concept. Later it delves into the Indian court's interpretation and implications of such protection. Moreover, the scheme of paper also analyses the tests being evolved by the courts and their applicability in the respective fields which puts an obligation on the courts of other jurisdiction to be cautious before following precedents related to protection of characters under IP laws.

Keywords: Intellectual Property Right, Fictional Character, Copyright, Trademark, Copyrightability of Characters, Copyright Issues.

I. INTRODUCTION

Sherlock Holmes, the name comes in our mind at first when we follow the fantasy of detective world. A mystery solver, who has been providing detective consultancy services for 127 years but in the year 2014, he has faced the most strenuous case of his life, "The Question of Public Domain".² The court was asked to balance the conflicting interest between the creator and the people who wanted to use the character in their works. Perusing the present case the U.S. Court of Appeals for the Seventh Circuit has reached to a conclusion that the copyright given

¹ Author is a Senior Research Fellow at Faculty of Law, University of Lucknow, India.

² *Klinger v. Conan Doyle Estate Ltd.*, 755 F.3d 496 (7th Cir. 2014).

to the character of Sherlock Holmes has now come into the purview of public domain hence the character is permitted to be used in any other work.³

Intellectual property law is designed to motivate and incentivize the authors to create original artistic, literary and other works of creativity which make an addition in the world's rich and proliferating culture. Fictional characters are regarded as valuable commodities.⁴ The whole world recognises the influence of fictional characters in their life henceforth resulting in a "fandom"⁵. The authors of fictional characters get the legal protection to exclude others from using, exploiting, abusing and reaping financial benefits from their creations for the time being it comes into the public domain.⁶ Copyright law only protects the works which have been fixed in some tangible form, such as fictional characters posed with an expression and creativity, nonetheless, invisible intellectual ingenuity is unprotected. This is known as the "idea/expression dichotomy."⁷ This dichotomy is applied to establish which aspect of a character is subject to copyright protection. The author has made an attempt to determine the viability of the tests which has been previously evolved and adopted by the courts of different jurisdiction. In furtherance of pertinence of the test the author tries to relate the contextual relevancy of the literary characters and graphical characters. Meanwhile, the author tries to highlight the relevancy of cases which have been followed by various jurisdictions in order to grant copyright protection to fictional characters. The author has tried to analyse the applicability and drawbacks in the precedents. Moreover, the paper delves into the recent developments in the field of copyrightability of fictional characters.

II. COPYRIGHT VIS A VIS CHARACTER: RELATION AND CONFLICTING INTEREST

A. Concept of Copyright and Copyrightability

The intellectual property law is based on the concept that the holder of the Intellectual Property rights or the author should be incentivize for his/her creation. The support given is mainly for the creation, innovation, inventiveness and further creativity in literal and artistic field.⁸ The protection of authors' original creations, in essence allowing them to uphold the

³ *Id.* 503.

⁴ Bashayer Al-Mukhaizeem, "Copyright Protection of Fictional Characters in Film: U.K. and U.S. Perspectives" 5 UK L. Student Rev. 1 (2017).

⁵ A fandom is a subculture composed of fans characterized by a feeling of empathy and camaraderie with others who share a common interest.

⁶ Feldman, "Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection" 78 California Law Review 689 (1990).

⁷ Sourav Kanti De Biswas, 'Copyrightability of Characters' 9 Journal of Intellectual Property Rights 148 (2004) see also, *R.G. Anand v. M/s. Delux Films & Others* (1978) SCC (4) 118.

⁸ K.D. Raju, *The Intellectual Property Rights & Competition Law: A Comparative Analysis* 21 (Eastern Law House, 2014).

integrity of these creations and maintain a sense of control over their subsequent development, purports to be governed by copyright law regime.⁹ The first United States Supreme Court ruling on copyright¹⁰ has asserted on the exclusive property rights in the works of the authors which should be backed by the laws. Meanwhile, the exclusive right of learned men to reproduce, publish, and sell the matter and form of their literary and artistic work has its origins in the English common law and the early enactments of Parliament.¹¹ “Underlying the common law protection, is the recognition that a property status should attach to the fruits of intellectual labour”.¹² Copyright arises in any original work¹³ of authorship that is expressed in a tangible form. At least some “intellectual invention” must be there for the entailment of originality requirement.¹⁴ However, the US Supreme Court held that the degree of originality required in an independent creation can be minimal although creative in its own field.¹⁵ Nevertheless, a selection or arrangement of individually non copyrightable elements may give rise to a copyright, albeit only in the creative arrangement.¹⁶

B. Copyrightability of Fictional Characters

Prospero¹⁷, unlike his own creator, produced his visions solely for enlightenment. He accepted that his characters and their stories would fade away although his creator did not want his characters, stories, and ideas to fade away. Similarly no creator would want to let their work vanish and lose its authenticity, nonetheless, it's their livelihood.¹⁸ In the present world, characters are very often the most valuable portion of the particular work or properties of which they are a part of.¹⁹ Meanwhile, to some extent it is very apt to say that, the principle value is more in characters and less in the story.

A character is not a unitary concept, but rather consists of two dissimilar parts, a name and a

⁹ U.S. Constitution, art. 1, s. 8, cl. 8. See also; The Copyright Act, 1957 (Act 14 of 1957), s. 13.

¹⁰ *Wheaton v. Peters* (1834) 33 U.S. 591.

¹¹ *Id.* at 19, “An act for the encouragement of learning, by vesting the copies of printed books in the authors or purchasers of such copies, during the times therein mentioned.” see also, James L. Turner, “It's a Bird, It's a Plane or Is It Public Domain: Analysis of Copyright Protection Afforded Fictional Characters” 22 S. Tex. L.J. 341 (1982).

¹² *Bevan v. CBS*. (1971) 329 F. Supp. 601, 608. see also, Scott B. Cherrin, “Part II: Television Series & Motion Pictures: Copyright Protection of Fictional Characters & (and) Plots” 1 Det. C. L. Ent. & Sports L. F. 55 (1994).

¹³ 17 U.S.C., s. 102. See also; The Copyright Act, 1957 (Act 14 of 1957), s. 13.

¹⁴ *Burrow-Giles Lithographic Co. v. Sarony* (1884) 111 U.S. 53, 57-58. see also, Missy G. Brenner, “Shadow of the Batmobile: Character Copyright after DC Comics v. Towle” 57 Santa Clara L. Rev. 481 (2017).

¹⁵ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.* (1991) 499 U.S. 346.

¹⁶ *Id.* at 348.

¹⁷ A fictional character of William Shakespeare's play *The Tempest*.

¹⁸ B W F Brown, “Concepts - How to Protect Them” The LES ANZ Conference (1990). see also, G. P. McLay, “Whither the Shadow: The Copyright Protection of Concepts, Characters and Titles” 21 Victoria U. Wellington L. Rev. 335 (1991).

¹⁹ *Kurlan v. Columbia Broadcasting System, Inc.* (1953) 40 Cal. 2d 799, 819 (Carter, J.). see also, Nimmer, “Copyright and Quasi-Copyright Protection for Characters, Titles and Phonograph Records” 59 T.M. REP. 63 (1969).

characterization or personality portrait.²⁰ The protection of the characters is being jeopardized because of the failure or unwillingness to recognize that a character actually consists of two separable and legally dissimilar parts. The first is the character 'name', and the second, a set of 'physical attributes' and 'personality' traits sometimes called as a characterization or a personality portrait.²¹

Dubiety as to the copyrightability of fictional characters arose in *Warner Bros. v. Columbia Broadcasting System*²² in US District Court for the Southern District of California, wherein the author *Dashiell Hammett* assigned the television and motion picture rights to two distinct works featuring the character Sam Spade. The court was of the view that once an author concedes the use of characters appeared in one work, assigning rights to the same character in a different story will constitute unfair competition if the work materially mitigates its commercial worth by demeaning or mortifying them so as to make public falsely believe the source of work. In the present case, the court decided that a second Spade project would not relegate the character so that the public would be in disbelief so as to the exploitation of Sam Spade. Even the court did not hold that the defendants were involved in any 'passing off' in order to put the public in deception so as the original work belongs to them.

Therefore, the court has ultimately decided that there was no infringement of copyright with respect to the unfair competition doctrine.²³ However, the above case is not one of its own kinds, as in the year 1930, the US court of appeals in *Nichols v. Universal Pictures Corp.*,²⁴ has provided a different cognition to determine the protection. Before this case it was assumed that the characters were protected as part of the work in which they were embedded. The question of substantial similarity arose so as to determine the infringement of the protected work; the inspired or similar work must have some significant similarity.

In *Nichols*, Judge Hand held that in order to get the protection the character must be 'distinctively delineated.'²⁵ The tests related to fixation of characters for copyright protection has been evolved in the above two cases. Copyrightability of the character becomes significant as the common interests of the creator, licensees and advertisers in the property is

²⁰ E. Fulton Brylawski, "Protection of Characters-Sam Spade Revisited" 22 Bull. Copyright Soc'y U.S.A. 77 (1974).

²¹ Waldheim, 'Mickey Mouse-Trademark or Copyright?' (1964) 54 T.M. REP. 865.

²² (1954) 216 F.2d 945(9th Cir.).

²³ Scott B. Cherrin, "Part II: Television Series & Motion Pictures: Copyright Protection of Fictional Characters & (and) Plots" 1 Det. C. L. Ent. & Sports L. F. 55, 60-61 (1994).

²⁴ (1930) 45 F.2d 119.

²⁵ *Id.* at 121 ("[T]he less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly."). see also, Zahr K. Said, "Fixing Copyright in Characters: Literary Perspectives on a Legal Problem" 35 Cardozo L. Rev. 769, 829 (2013).

very much dependent upon the surety of protection and the prevention of the concerned work or property from unauthorised use by the third party as the authorised owners might lose some indispensable rights for example economic rights by its unwarranted use. As a result it becomes necessary to determine what kind of work is copyrightable compared to what is not.

III. KINDS OF CHARACTER: IMPLICATION OF COPYRIGHT LAW AND CONTEXTUAL RELEVANCY OF THE CHARACTER

A. Character and Its Kinds

In common parlance there are two kinds of characters one is 'Fictional and another is Graphical'²⁶. Characters are protected under the copyright law, although, the probability of having an express provision is less. However, the courts of different jurisdiction have come to the rescue to establish principles to protect such creations. Moreover, the applicability of copyright protection varies from case to case. In case of graphical characters it is quite evident that, the characters, which could be presented in any pictorial form like cartoons or other diagrammatic form. The visual representation can be easily understood by the spectator. Whereas in case of fictional character, it is a 'word portrait'²⁷ having physical attributes and the literal elements of the character which resides in the mind of the reader. Meanwhile, pictorial representations are more identifiable than the literary characters to the public. Thus, the former could get the copyright protection more easily as well as independent of its context.

B. Implication of Copyright Law on Copyrightability of Characters

The application of degree of "substantial similarity" is required to establish the claim of infringement rather than copyrightability per se.²⁸ However, the courts have to analyse such works separately from their context. In Indian context the works in which copyright subsists is the original literary, dramatic, musical and artistic work²⁹ whereas under United States copyright protection subsists in original works of authorship fixed in any tangible medium of expression³⁰ which includes literary works, pictorial, graphic and sculptural works etc. The US copyright regime is inclusive of more subject matters rather than Indian copyright law.

The protection of characters is complicated because they have a "tangible existence only in

²⁶ *Supra* note 6.

²⁷ *Id.*

²⁸ Melville B. Nimmer, David Nimmer, *Nimmer on Copyright* 2.12, 2-172.32 (Matthew Bender & Co. ed. 1999).

²⁹ The Copyright Act, 1957 (Act 14 of 1957), s. 13.

³⁰ 17 U.S.C., s. 102.

the specific words, pictures, and sounds created by their author."³¹ However, the interpretation with regards to copyrightability of the character is solely dependent on the courts. Meanwhile, the Indian Copyright Law or any other copyright law would only facilitate the objective interpretation based on definitions and provisions. The subjective interpretation depends on the courts where they consider the viability of the case and apply their discretion based on legal discourse.

The question arises whether a character is eligible to draw protection separately from the story in which they are embedded or not. Nevertheless, the US courts have evolved two tests in order to determine the copyrightability of the characters:

1. Test 1- Sufficiently Delineated Test

Usually a character is protected under copyright law within the context of the work in which it appears. Such works are protected under copyright laws. In the year 1930³² the US court reached to a conjecture that a character could be sufficiently delineated from a work and is able to get the copyright protection independently from the associated work. Certain characters have such distinct persona and characteristics which becomes memorable for the spectator. There is "Gargantuan and his gargantuan appetite", "King Tantalus and his tantalizing punishment."³³

The distinctively delineated test depends upon the concept "the more developed a character is, the more probability of protection to that character."³⁴ This has developed a two facet test in order to determine the infringement of the character. Firstly, whether the said character has been created with sufficient distinctiveness in order to avail the protection. The character must be sufficiently developed to be constituted as more than an idea, then only it is capable of being protected. The second facet is, whether "the alleged infringer copies such development and not merely a broader and more abstract outline."³⁵ The question of infringement arises only when there is "actual copying of the expression"³⁶ rather than imitation of ideas or applying the character in a general way.

The case of *Detective Comics, Inc. v. Bruns Publication*³⁷ is one of the precedents in which the US Court of Appeals has found that the copyright in the *Action Comics* which has featured

³¹ Leslie A. Kurtz, "The Independent Legal Lives of Fictional Characters" Wis. L. REV. 429, 430 (1986).

³² *Nichols v. Universal Pictures Corp* (1930) 45 F.2d 119.

³³ *Supra* note 30.

³⁴ *Supra* note 27.

³⁵ *Id.*

³⁶ Jasmina Zecevic, "Distinctly Delineated Fictional Characters That Constitute the Story Being Told: Who Are They and Do They Deserve Independent Copyright Protection" 8 Vand. J. Ent. & Tech. L. 365 (2006).

³⁷ *Detective Comics, Inc. v. Bruns Publication* (1940) 111 F.2d 432.

the character *Superman*, was infringed by the *Wonderman* comics owned by the defendants. The copying of the character was more than something ‘general inspiration’ from the pre-existing work. Similarly, in the case of *Hill v. Whalen & Martell*³⁸ where the cartoon characters *Mutt* and *Jeff* were copied as *Nutt* and *Giff*. The US District Court held that the defendants have copied not only the ‘physical characteristics’ but also the ‘elements of their personalities’.³⁹ Henceforth, this test establishes that the character shall be subject to the public domain if it is not adequately developed apart from the work in which it is embedded.

2. Test 2- Story Being Told Test

The work of an author is surrounded on a milieu on which he develops the plot. In the continuance of making the storyline different from others’ creation he develops certain attributes in his work which may consist of various characters and their specific qualities. There is a possibility that the whole story may revolve around those characters.

Meanwhile, considering the above proposition the court has developed a new concept in the case of *Warner Bros. v. Columbia Broadcasting System*.⁴⁰ In this case the court has conceived that a character is an indispensable part of a story being told but if “the character is only the chessman in the game of telling the story it is not within the area of copyright protection.”⁴¹ Prof. Nimmer argues that a “story devoid of plot, wherein character study constitutes all, substantially, all of the work,”⁴² seems improbable as a result this will exclude all literary characters from independent protection. If the character is outside the scope of the story then re-use of that character shall be considered as non- infringing.

The decision of US District Court of 9th circuit in the above case has limited the scope of protection of literary characters under copyright law. The Court found that *Hammett*, the original author had the right to put his characters in other works and assign them to other parties, notwithstanding the fact that *Warner* had the rights to the original story, because the character was not itself copyrightable:

*“We conclude that even if the Owners assigned their complete rights in the copyright to [Maltese Falcon], such assignment did not prevent the author from using the characters used therein, in other stories. The characters were vehicles for the story told, and the vehicles did not go with the sale of the story.”*⁴³

³⁸ *Hill v. Whalen & Martell* (1914) 220 F. 359 (S.N.D.Y.).

³⁹ *Supra* note 30 at 446.

⁴⁰ (1954) 216 F.2d 945(9th Cir.).

⁴¹ *Id* at 950.

⁴² *Supra* note 27.

⁴³ *Warner Bros. v. Columbia Broadcasting System* (1954) 216 F.2d 945(9th Cir.).

In recognising the ‘story being told test’, courts have made a remark that an over- protection given to the characters will serve as the “opposite of the copyright statute's purpose which is to encourage the production of the arts.”⁴⁴ Meanwhile, in the cases of *James Bond*⁴⁵ and *Rocky*⁴⁶ the court applied the “story being told test”. However, the court also gave recognition to an analysis of “sufficiently delineated test.” Furthermore, it is inferred that the fictional or literary character, may be difficult to be protected as they are *in toto* dependent upon the imagination of a reader but “story being told” test might be instituted in order give them copyright protection.

IV. APPLICABILITY OF TEST 1 & TEST 2: INDIAN CONTEXT & RELEVANCY IN RELATION TO NON- LITERAL ELEMENTS OF A CHARACTER AND DRAWBACKS

A. Applicability and Indian Cases/Scenarios:

The applicability of the test 1 and test 2 depends upon case to case as each case constitute different facts, characters, plot and other ancillary things, which helps a work to be recognised by the public. Test 1 is applied mainly in the context of graphical characters on the other hand Test 2 is more applicable to fictional characters or literary characters as these characters are devoid of any visual representation. There are very few cases in Indian context in which the court considered the copyright protection for characters. However, neither Indian courts have applied such tests in any case nor any precedents have evolved from Indian jurisdiction to protect characters.

In *Malayala Manorama v. VT Thomas*⁴⁷ the Kerala High court gave protection to the character though it was not given directly as the issue was of the ownership of copyright on a character, not the copyrightability of the character per se. In this case the court was of the view that characters could be given copyright protection irrespective of their story in which they have been introduced. However, in *Malayala* case, apparently no test was applied and the court didn't give any kind of prescribed principles through which the copyrightability of a character could be determined. It was based on the question of ownership of a copyright, whether certain cartoons developed by the cartoonist before being employed in a publishing house can be claimed as cartoonist's copyright.

A controversy related to performers' right over producers' right, arose due to Viacom18's public notice related to the character named ‘Gutthi’. This was to notify the artist that the use

⁴⁴ *Walt Disney Productions v. Air Pirates* (1978) 581 F.2d 751 (9th Cir).

⁴⁵ *Anderson v. Stallone* (1989) No. 87-0592 WDK, (U.S. Dist).

⁴⁶ *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.* (1995) 900 F. Supp. 1287 (C.D. Cal.) 1296.

⁴⁷ *Malayala Manorama v. VT Thomas* (1989) AIR Ker 49.

of character named ‘Gutthi’ in any other show or form shall be considered as an infringement of IP rights of the production house. Although, the artist has not taken any legal discourse to dispute the claim raised by Viacom¹⁸. However, Indian copyright law has explicitly laid down u/s 38A (2) that,

“Once a performer has, by written agreement, consented to the incorporation of his performance in a cinematograph film, he shall not, in the absence of any contract to the contrary, object to the enjoyment by the producer of the film of the performer’s right in the same film.”⁴⁸

S. 38A (2) makes it abundantly clear that the performers’ rights detailed in s. 38A(1) are enjoyed by the producers of a cinematographic film once an artist’s performance is incorporated in the film.

The Delhi High Court in *Raja Pocket Books v. Radha Pocket Books*⁴⁹ decided that, the character “Nagesh” was infringing upon the character “Nagraj”. The Court’s analysis was based on the interpretation of section 51 of the Copyright Act in *R.G.Anand v. Delux Films*⁵⁰. The Court observed that grant of copyright is confined to form, manner, arrangement and expression of the author and that in cases where different authors take inspiration from the same source, similarities are bound to creep in, which need not amount to infringement of the first author’s copyright. The court did not deal with the copyrightability of the character “Nagraj”. Hence, the inference was made directly on the basis of ‘comparative analysis’ of both the characters. Without going into the aspect of copyrightability this could not be ascertained whether the following character shall get the copyright protection or not.

Another comparative aspect came in *Arbaaz Khan v. North Star Entertainment Pvt. Ltd.*⁵¹, the Bombay High Court held that, the character of ‘Chulbul Pandey’ does not have any distinctive attributes and the plaintiffs failed to establish sufficient unified characteristics in its own character compared to the character of ‘Gabbar Singh’.

The above cases involved the issue of alleged infringement in the same field of work but what would be the outcome in cases involving different field of work. What if the characters are being used to promote any product or services completely different from their associated work? This is known as ‘merchandising the character’. In *Star India Pvt. Ltd. v. Leo Burnett*⁵², the Bombay High Court dealt with an alleged infringement of copyright where the characters

⁴⁸ The Copyright Act, 1957(Act 14 of 1957), s. 38A (2).

⁴⁹ (1997) 40 DRJ 791.

⁵⁰ (1979) SCR (1) 218.

⁵¹ 2016 (67) PTC 525 (Bom)

⁵² 2003 (27) PTC 81 (Bom)

of a TV serial were portrayed in a TV commercial. The court interpreted the *section 14(d)(i), The Copyright Act, 1957*⁵³. The court opined that,

*“The expression to make a copy of the film would mean to make a physical copy of the film itself and not another film which merely resembles the film. The making of another film is not included under section 14(d)(i) and such other film, even though it resembles completely the copyrighted film, does not fall within the expression ‘to make a copy of the film’.”*⁵⁴

Moreover, on the issue of passing off, plaintiffs were unable to prove that, any character in the serial have acquired any public recognition or reputation or an independent life of its own separately from its position as a character in the serial. There is no material on record to show that any character in the serial has become a commodity in its own right, independently of the film/serial.⁵⁵

The decisions of Indian Courts involved homogeneous issues. Courts have generally juxtaposed two characters to decide the copyright protection. However, there are very few cases where the courts have dealt with the issue of copyrightability of a character per se, independent of any comparative aspect. In *Star India* case, Bombay High Court gave few indirect references⁵⁶ of the foreign precedent (‘sufficiently delineated test, story being told test’). However, the concerned law in the Indian context is still in nascent stage, hence, there is a probable chance of advancement in the right direction.

B. Relevancy in relation to Non-Literal Elements of a Character

Non- Literal elements of a character are not defined explicitly, though, they have a prominent role in building the character. “*Mr. Citizen*” a cartoon character developed by the legendary cartoonist B.V. Ramamurthy can be associated with the graphical character though it does not possess any such qualified attributes which are explicitly recognisable. Similarly, the cartoon “*Common Man*”, a creation of renowned cartoonist R.K. Laxman which has a specific dressing style but no such different characteristics which is lucidly defined in that character. The main question arises, whether there is any Test which is applicable for the protection of

⁵³ S. 14. Meaning of Copyright.— For the purposes of this Act, “copyright” means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely:—

(d) in the case of a cinematograph film,—

(i) to make a copy of the film, including—

(A) a photograph of any image forming part thereof; or

(B) storing of it in any medium by electronic or other means;

⁵⁴ *Supra* note 51.

⁵⁵ *Id.* at 62.

⁵⁶ *Id.*

non- literal elements of a character. Pragmatically speaking, there is no such method or principle which could be applied in order to protect the non-literal elements. Test 1 and Test 2 are applicable to only characters' explicit attributes which differentiate them from others. Both the cartoons could be subject to copyright protection as they have been presented in such a way which makes them different from others. Hence, presentation also makes difference in a way it can save the characters non-literal elements. But giving protection to the non-literal elements directly could result in discouragement of other creators which will be opposite to the objective of the copyright law. Non- Literal elements are more or less a subjective aspect of a character which is dependent on the court's interpretation. If the transformation of non-literal elements into the literal elements of a character is possible then it could be protected under copyright law. Thus, in *stricto sensu*, the non-literal elements cannot be granted copyright protection.

C. Drawbacks/Shortcomings of Test 1 and Test 2

Development of copyright law is incessant, though, there are precedents but it could not be considered as undeviating principle as there is always a transformative aspect involved in the cases. The "distinctively delineated test" (Test1) consists of some snags which tend to appear after its application by the court. The main problem lies with "unreliable judicial application and tendency to over-protect literary characters."⁵⁷ This test has very restricted application as it says the more developed the character is the more protection shall be available. Apart from this it does not qualify to provide any direction. Judges tend to act as "literary critics" who, on the basis of their discretion may decide which character is protectable and which needs sufficient distinctiveness.⁵⁸

In *Burroughs v Metro-Goldwyn-Mayer Inc*⁵⁹, U.S. District Court for the Southern District of New York, went into explaining the concept of Test 1. In this case the court explained what may constitute as "distinct delineation" by giving the descriptive details regarding the personality of 'Tarzan' which resulted in the copyright protection of the character. However, the present case was devoid of any comparison with any other character. It was solely decided upon the merit with regard to use of said character in other works. On the contrary many jurists have observed that "an attempt to determine the extent of a character's development, without making comparisons, leads to abstract and fruitless speculation."⁶⁰ The differentiation

⁵⁷ Samuel J. Coe, "The Story of a Character: Establishing the Limits of Independent Copyright Protection for Literary Characters" 86 Chi.-Kent L. Rev. 1313 (2011).

⁵⁸ *Supra* note 35 at 372.

⁵⁹ (1981) 519 F. Supp. 388 (S.D.N.Y.).

⁶⁰ *Supra* note 30.

between a character more developed and a less developed, makes it difficult for the courts to decide on the “independent protection” to any character.⁶¹

Criticism of “story being told test” (Test 2) is not much different from the Test 1. Meanwhile, a jurist pointed out, “what this distinction between a character that constitutes ‘the story being told’ and one that is ‘only the chessman in the game of telling the story’ is supposed to mean, and how any court could conceivably use it, to divide protected from unprotected characters.”⁶² Moreover, what gives a federal judge the aesthetic credentials to draw this line? Consequently, both the tests have some shortcomings in their application.

The question arises which one is the most appropriate method to apply to give the copyright protection. Perhaps, both the tests were applied as “supplementary or in combination”⁶³ to each other. Nevertheless, Test 2 “has not been used or applied widely”⁶⁴ throughout various jurisdictions. It could be inferred that the “distinctively delineated test” is more applicable than the “story being told” test, in case of copyrightability of a character as the former has been applied by the courts widely with an explanation, whereas, in most of the cases the later test has been used collectively with the former one.

V. CONCLUSION

From the above analysis it could be inferred that the “copyrightability of a character” is one of the contentious aspect of the copyright law. The courts have to balance the conflicting interest between copyright and its fair use. The courts should analyse the cases before relying on the precedents. Firstly, the copyrightability of a character shall be established on the basis of precedents and concerned laws. Later, the comparative analysis shall be considered by the courts to decide on ‘substantial similarity’ between the two characters. Nevertheless, Indian courts have missed this process, either they decide the copyrightability per se or directly compare the two characters, to decide on copyright protection.

As far as the tests for determination of protection of character is concerned, “sufficiently delineated test” is more applicable than the “story being told test”. As the former has been widely accepted and can be applied more efficiently than the later. Both have different subject matter in relation to type of character on which they are being applied. Test 1 is generally applicable to graphical characters whereas the Test 2 has its application on fictional characters or literary characters. Further, when we look into the concept of protection of non-literal

⁶¹ *Supra* note 35.

⁶² Francis Nevins, “Copyright + Character = Catastrophe” 39 J. COPYRIGHT SOC'Y U.S.A. 315 (1992).

⁶³ *Shaw v. Lindheim* (1990) 919 F.2d 1353 (9th Cir.); see also, *Anderson v. Stallone*, (1989) No. 87- 0592 WDK, (U.S. Dist.).

⁶⁴ *Supra* note 5.

elements of a character it becomes difficult to apply any of the above test thus it shall be left on the merits of the cases.

The main aim of the intellectual property law is to incentivize and encourage the creator and to motivate other people to move forward in the right direction. Hence, the growth shall not be stagnated it must be continuous. Meanwhile, providing protection to a character is not only the issue of recognition of a particular character but in the present scenario it includes the commercial benefits associated with that character. A creator strives to utilize his hard work and labour poured into his creations. Simultaneously, the courts should refrain themselves by granting over- protection to the characters. This will not suffice the purpose of the copyright law. Consequently, it will only mitigate the chances of proliferation of new works.

VI. SUGGESTIONS

Copyrightability of the character shall not be confined to these precedents only. The scope of protection must be left to case to case to basis. These precedents might be considered as a primary source for determination but the interpretation shall not be restricted. Further, Indian copyright law should inculcate explicit provisions which shall help in facilitating the protection to characters.

Moreover, the protection of character is not constricted to only recognition of the creator of that character; it has another fold which is related to commercial aspect. In all these cases, we saw that it was easier to decide copyright infringement of characters because the parties were in the same or related field of activity which in fact allowed the Court to analyse and impute motives behind the use of characters. However, if a particular fictional character, and a popular one at that, were to be used to sell a product which is nowhere near the field of the activity in which the character was originally used, would it still amount to copyright infringement of the character?

Hence, if an effective protection cannot be given under copyright the court may take recourse to the trademark laws and unfair competition principles as observed in the Indian cases like *Disney Enterprises Inc. & Anr. vs. Santosh Kumar & Anr.* [C.S.(OS) 3032/2011] where Delhi High Court passed an injunction order that the defendant shall be restricted from selling stationery items associated with the plaintiff's work as there was no such distinction between the items and the public would associate both as plaintiff's work. Similarly in *Disney Enterprises Inc. & Anr. vs. Gurcharan Batra & Ors* [C.S.(OS) No.607/2006], the Delhi High Court put an injunction on the defendants to sell such items like school bags having the names and likenesses of the plaintiffs' characters viz. Mickey Mouse, Minnie Mouse, Goofy, Pluto

and Daisy Duck. Thus, such protection to the characters must be given with proper caution having legal discourse and precedents which involves all the intricacies defined in different regimes of IP rights.
