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The Hollywood Circuit's Protection of the Batmobile Provides an Uncertain Future for First Amendment Protections

Nicole Geiser

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THE HOLLYWOOD CIRCUIT’S PROTECTION OF THE BATMOBILE PROVIDES AN UNCERTAIN FUTURE FOR FIRST AMENDMENT PROTECTIONS

Nicole Geiser

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INTRODUCTION

Characters are the driving force behind every story. The audience experiences the story through its characters by relating to the character’s circumstances, beliefs, hopes, and ambitions. Characters also

provide inspiration, whether it is a young girl inspired by the strength and independence of Wonder Woman, or a new author, inspired to create new characters and stories of his or her own. So, how do we protect these characters? Should they be afforded copyright protection? If so, how should we determine which characters are protectable? The key here is to find the correct balance between protecting certain characters from being copied and exploited while also providing new authors with ideas to stimulate creativity further.

Some circuit courts have created different tests to determine whether a character is subject to protection under copyright law.¹ The Second Circuit has used the “Character Delineation” test to protect characters who have sufficient detail and uniqueness.² The Ninth Circuit, on the other hand, has been inconsistent when deciding which test to use.³ During the onset of copyright protection for characters, the Ninth Circuit created the *Sam Spade* test to protect characters who constitute the story being told.⁴ However, after some circuit court decisions casted

¹ This comment will primarily analyze the tests created in the Second and Ninth Circuits; however, other circuit courts have also gone through the analysis of whether a character is copyrightable. In *Gaiman v. McFarlane*, the Seventh Circuit concluded that a character could be copyrightable if descriptive enough. 360 F.3d 644, 660 (7th Cir. 2004). This sounds very similar to the Second Circuit’s character delineation test. Here, Neil Gaiman sued Todd McFarlane, seeking a declaration of ownership of comic-book characters from *Spawn* No. 9. Id. at 648. The three main characters in question here are Medieval Spawn, Angela, and Count Nicholas Cogliostro. Id. at 650. When analyzing whether stock characters should get copyright protection, the court stated that “[i]t would be difficult to write successful works of fiction without negotiating for dozens or hundreds of copyright licenses, even though such stereotyped characters are the products not of the creative imagination but of simple observation of the human comedy.” Id. at 660. Therefore, if the character is not a stock character and is distinctive enough, the character is protectable under copyright law. Id.; see also *Klinger v. Conan Doyle Estate, Ltd.*, 755 F.3d 496, 502–03 (7th Cir. 2014) (“The more vague, the less ‘complete,’ a character, the less likely it is to qualify for copyright protection.”).

² See *Detective Comics, Inc. v. Bruns Publ’ns, Inc.*, 111 F.2d 432, 433–34 (2d Cir. 1940) [hereinafter “*Detective Comics*”].

³ See *Warner Bros. Pictures, Inc. v. Columbia Broad. Sys., Inc.*, 216 F.2d 945, 950–951 (9th Cir. 1954) [hereinafter “*CBS*”]; *Walt Disney Publ’ns v. Air Pirates*, 581 F.2d 751, 754–55 (9th Cir. 1978), *cert. denied* 439 U.S. 1132 (1979) [hereinafter “*Air Pirates*”]; *Olson v. Nat’l Broad. Co., Inc.*, 855 F.2d 1446, 1452 (9th Cir. 1988) [hereinafter “*Olson*”].

⁴ *CBS*, 216 F.2d at 950–51.

doubt onto the *Sam Spade* test,⁵ some district courts choose to apply both the “Character Delineation” test and the *Sam Spade* test out of an abundance of caution.⁶ Following the confusion as to which test to apply, the Ninth Circuit created a new three-part test in *DC Comics v. Towle*.⁷ However, in its decision, the Ninth Circuit never expressly overruled the *Sam Spade* test.⁸ Instead, it created a test that broadens copyright protection to microworks, thus impacting First Amendment protections.⁹

This Comment analyzes the potentially damaging impact the Ninth Circuit’s decision in *Towle* could have on modern copyright law and the First Amendment. Part I will provide an overview of modern copyright law, challenges faced when deciding the level of protection that should be afforded to characters, and the important difference between literary characters and visually depicted characters and how it can affect the degree of protection allowed. Part II will discuss the history of character copyright, specifically, the different tests adopted by circuit courts and the impact each one has on the protection of characters. Part III will analyze the Ninth Circuit’s decision to create a new three-part test in *Towle*, its negative impact on modern copyright law, the dangerous implications of protecting microworks, and the effect on First Amendment protections. Finally, Part IV will provide a proposal to create a new copyright test for characters and limitations on the broad application of copyright protection in all aspects of copyright law.

I. OVERVIEW OF COPYRIGHT LAW

The Copyright Act of 1976 is the primary basis for copyright law and outlines what is subject to copyright protection.¹⁰ Section 102 of the Copyright Act provides protection “in *original* works of authorship *fixed*

⁵ See *Air Pirates*, 581 F.2d at 754; *Olson*, 855 F.2d at 1452.

⁶ See *Anderson v. Stallone*, No. 87–0592 WDK-GX, 1989 WL 206431 at *7–8 (C.D. Cal. April 25, 1989); *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1290 (C.D. Cal. 1995).

⁷ *DC Comics v. Towle*, 802 F.3d 1012, 1021 (9th Cir. 2015) [hereinafter “*Towle*”].

⁸ *Id.*

⁹ See Matthew D. Bunker & Clay Calvert, *Copyright in Inanimate Characters: The Disturbing Proliferation of Microworks and the Negative Effects on Copyright and Free Expression*, 21 COMM’N L. & POL’Y 281–300 (2016), <https://www.tandfonline.com/doi/abs/10.1080/10811680.2016.1184908>.

¹⁰ 17 U.S.C. § 102.

in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”¹¹ The Act specifically lists eight works of authorship that are entitled to copyright protection: “(1) literary works; (2) musical works; (3) dramatic works; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.”¹²

The two main aspects to remember is “originality” and “fixation.”¹³ Originality is the *sine qua non* of copyright.¹⁴ In order to get protection under copyright law, “a work must be original to the author.”¹⁵ You also need fixation to qualify for copyright protection.¹⁶ Generally, fixation will not be an issue when discussing the copyrightability of characters because they are all fixed in a movie, television show, book, etc., because “[a] work consisting of sounds, images, or both, that are being transmitted, is ‘fixed’ . . . if a fixation of the work is being made simultaneously with its transmission.”¹⁷ Therefore, to get copyright protection, the work must be original and fixed “in a tangible medium of expression.”¹⁸

¹¹ *Id.* (emphasis added).

¹² *Id.*

¹³ *Id.*

¹⁴ *Feist Publ’ns, Inc. v. Rural Telephone Serv. Co., Inc.*, 499 U.S. 340, 345 (1991) [hereinafter “*Feist Publ’ns*”]. See Elizabeth Ruiz Frost, *Latin in Legal Writing: When to Use It, How, and What It Means*, OR. STATE BAR BULL. (2016) (“*Sine qua non*: Used to connote essence. For example, ‘clarity is the *sine qua non* of good writing.’”).

¹⁵ *Feist Publ’ns*, 499 U.S. at 345.

¹⁶ *Id.* at 355.

¹⁷ *Legal Information Institute*, CORNELL L. SCH. (last visited Feb. 21, 2020), https://www.law.cornell.edu/wex/fixed_in_a_tangible_medium_of_expression (“Under the Copyright Act,

a work is fixed in a tangible medium of expression ‘when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.’”); see 17 U.S.C. § 101.

¹⁸ *Legal Information Institute*, *supra* note 17.

A. *Purpose of Copyright Law*

The primary purpose of creating copyright protection is to protect an author's creativity and freedom of expression while also allowing his or her work to be available to the public.¹⁹ Article I, Section 8, Clause 8, of the United States Constitution permits Congress the power "[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."²⁰ Ownership of a copyright provides authors with a temporary monopoly over their work unless there is an overriding public interest.²¹ The main overriding interests are to encourage creativity and freedom of expression, along with non-profit and educational interests.²²

B. *Literary Characters vs. Visually Depicted Characters*

The main works of authorship observed in this Comment are literary works, motion pictures, and other audiovisual works. There is an important difference between literary characters and visually depicted characters.²³ Literary characters are generally introduced in a written format, such as a book or novel.²⁴ Visually depicted characters generally appear in visual formats, such as comic books, motion pictures, or

¹⁹ *Purpose of Copyright Law*, S. ILL. UNIV., <https://lib.siu.edu/copyright/module-01/purpose-of-copyright-law.php> (last updated Feb. 13, 2020).

²⁰ U.S. Const. art. I, § 8, cl. 8.

²¹ *Purpose of Copyright Law*, *supra* note 19.

²² *Id.*

²³ See Dean D. Niro, *Protecting Characters Through Copyright Law: Paving a New Road Upon Which Literary, Graphic, and Motion Picture Characters Can All Travel*, 41 DEPAUL L. REV. 359, 369–70 (1992) ("Protectable elements of visually depicted characters differ in many respects from protectable elements in literary characters. The most evident difference is that literary characters are less concrete than cartoon characters. Protectable literary characters must be developed verbally to the point at which the character's response to incident becomes predictable, whereas visually depicted characters can be sketched with a 'few strokes of the pen and need not possess any behavioral attributes.'") (citations omitted).

²⁴ *Id.* at 359 (referring to "literary characters, such as Ebenezer Scrooge" for example).

television shows.²⁵ Often, however, literary characters become visually depicted when they are taken from a book and placed into a television show or movie, which improves the probability that they will gain copyright protection.²⁶ It is important to distinguish between literary characters and visually depicted characters, as they generally are not afforded the same protections.²⁷

Providing copyright protection for a literary character presents greater challenges because the character's description is often spread out over the book and can be hard to distinguish.²⁸ Also, readers will interpret the description differently and use their imagination to come up with their own interpretation of how the character looks and acts.²⁹ Visually depicted characters, however, are depicted in detail on screen exactly how the author intends.³⁰ Little imagination by the viewers, if any, is needed.³¹ However, courts have made it clear that just because a character is visually depicted, does not mean they automatically get copyright protection.³² To determine whether a character can get copyright protection, courts have created several different tests.

²⁵ See *id.* at 374 ("The character's visual element provides something concrete and tangible that can be the subject of objective comparison.").

²⁶ See *Air Pirates*, 581 F.2d 751, 755 (9th Cir. 1978) ("Judge Stephens recognized that it is difficult to delineate distinctively a literary character. When the author can add a visual image, however, the difficulty is reduced.").

²⁷ See *Niro*, *supra* note 23, at 370 ("A graphically depicted character conveys a concrete, physical image. Unlike literary characters, which can only be pictured in a person's mind, cartoon characters may be seen through one's eyes. The characterization of a cartoon figure is acquired through its physical depiction: facial expressions, anatomical features, and attire. The public can readily predict how a cartoon character will appear in successive works. Thus, a cartoon character's concrete expression allows for easy comparison to infringing works.") (citations omitted).

²⁸ See *id.*

²⁹ See *Gaiman*, 360 F.3d at 660–61 ("The description of a character in prose leaves much to the imagination, even when the description is detailed—as in Dashiell Hammett's description of Sam Spade's physical appearance in the first paragraph of *The Maltese Falcon*. Even after all this, one hardly knows what Sam Spade looked like. But everyone knows what Humphrey Bogart looked like. A reader of unillustrated fiction completes the work in his mind; the reader of a comic book or the viewer of a movie is passive.").

³⁰ See *id.*

³¹ See *id.*

³² See *Olson*, 855 F.2d 1446, 1452 (9th Cir. 1988).

II. HISTORY OF CHARACTER COPYRIGHT

In 1931, Judge Learned Hand first conceptualized the idea that characters, literary or graphic, could be afforded copyright protection in *Nichols v. Universal Pictures*.³³ In *Nichols*, Judge Hand introduced the idea that characters may be entitled to copyright protection independent from the main work's plot.³⁴ Following Judge Hand's ruling in *Nichols*, the Second Circuit created the "Character Delineation" test, which it has consistently applied.³⁵ The Ninth Circuit, on the other hand, has been more unpredictable with its rulings.

In 1954, the Ninth Circuit created the "Story Being Told," or *Sam Spade*, test to implement a stricter test instead of using the Second Circuit's lenient "Character Delineation" test.³⁶ A couple of circuit court decisions, however, demonstrated that the court started to move towards the use of the Second Circuit's "Character Delineation" test, which caused a lot of confusion for the lower courts.³⁷ Many district courts were unsure which test to apply and would either follow the "Character Delineation" test or utilize a combination of both tests.³⁸ The Ninth Circuit then created another test in *Towle* without expressly overruling its decision in *Sam Spade*.³⁹

A. "Character Delineation" Test

Nine years after Judge Hand's ruling in *Nichols*, the Second Circuit, in *Detective Comics*, created the "Character Delineation" test, where copyright protection is granted to characters significantly developed to be recognizable on their own.⁴⁰ In *Detective Comics*, the creator of

³³ *Nichols v. Universal Pictures*, 45 F.2d 119, 120–23 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931).

³⁴ *Id.* at 121.

³⁵ *See Detective Comics*, 111 F.2d 432, 433–34 (2d Cir. 1940); *see, e.g., Salinger v. Colting*, 607 F.3d 68, 73 (2d Cir. 2010).

³⁶ *CBS*, 216 F.2d 945, 951 (9th Cir. 1954).

³⁷ *See Air Pirates*, 581 F.2d 751, 754–55 (9th Cir. 1978), *Olson*, 855 F.2d at 1452.

³⁸ *See Anderson v. Stallone*, No. 87–0592 WDK-GX, 1989 WL 206431 at *7–8 (C.D. Cal. April 25, 1989); *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1291 (C.D. Cal. 1995).

³⁹ *Towle*, 802 F.3d at 1021.

⁴⁰ *Detective Comics, Inc.*, 111 F.2d at 433–34.

“Superman” filed suit for copyright infringement against another comic book publisher for their similar superhero, “Wonderman.”⁴¹ Both characters are superheroes with great strength and speed. Both heroes dress in regular clothing in an attempt to hide their powers, but underneath is a “skintight acrobatic costume.”⁴² The only difference between the two superhero characters is that Superman has a blue costume, and Wonderman has a red costume.⁴³ The court found that “[s]o far as the pictorial representation and verbal descriptions of ‘Superman’ are not a mere delineation of a benevolent Hercules, but embody an arrangement of incidents and literary expressions original with the author, they are the proper subjects of copyright and susceptible of infringement.”⁴⁴ Therefore, the court held that Superman could be copyrightable so long as the character is sufficiently delineated to stand on its own and is not merely a stock character.⁴⁵ This test is very lenient, meaning that it is relatively easy for authors to get copyright protection.⁴⁶

B. “Story Being Told”/Sam Spade Test

The Ninth Circuit, dissatisfied with the leniency of the Second Circuit’s “Character Delineation” test, created the “Story Being Told” test, also known as the *Sam Spade* test, in *CBS*.⁴⁷ In *CBS*, the Ninth Circuit held that the literary character Sam Spade was not subject to copyright protection because the character was not the “story being told.”⁴⁸ Instead, the Sam Spade character was a stock character—a character that plays a supporting role to the story, and is merely a vehicle for the story told.⁴⁹ Under the *Sam Spade* test, a character must be able to stand-alone from the rest of the story, such as the plot, setting, and other characters.⁵⁰ A stand-alone character is one without which the story would not make

⁴¹ *Id.* at 433.

⁴² *Id.*

⁴³ *Id.*

⁴⁴ *Id.* at 433–34

⁴⁵ *Id.*

⁴⁶ *Warner Brothers, Inc. v. Am. Broad. Co.*, 720 F.2d 231, 241–42 (2d Cir. 1983) [hereinafter “*Am. Broad. Co.*”] (providing that proper character delineation is seen when “the visual perception of the character tends to create a dominant impression against which the similarity of a defendant’s character may be readily compared, and significant differences readily noted.”).

⁴⁷ *CBS*, 216 F.2d 945, 950–51 (9th Cir. 1954).

⁴⁸ *Id.* at 950.

⁴⁹ *Id.* The court in *CBS* described stock characters as vehicles for the story told that do not go with the sale of the story. *Id.*

⁵⁰ *Id.*

sense.⁵¹ James Bond is a good example of a stand-alone character. Without James Bond, you would not have a James Bond film.⁵² On the other hand, characters such as “M,” or “Moneypenny,” are important characters in James Bond, but they are not the story being told. You can still have a James Bond film without “M” or “Moneypenny.”

The *Sam Spade* test is strict, and significantly limits the copyrightability of a character to only very prominent characters.⁵³ Specifically, the test “limits copyright protection to those characters which embody the story in which they appear.”⁵⁴ Following the Ninth Circuit decision in *CBS*, a couple of circuit court decisions hinted that the court was moving away from the *Sam Spade* test and towards the “Character Delineation” test.⁵⁵ This caused a lot of confusion in many of the lower district courts, who were unsure which test to apply.⁵⁶ Some resorted to applying both the *Sam Spade* test and the “Character Delineation” test.⁵⁷

C. Ninth Circuit Court Cast Doubt on *Sam Spade* Test.

Some courts have decided to apply the *Sam Spade* test to literary characters only and apply the “Character Delineation” test to visually depicted characters.⁵⁸ In *Air Pirates*, the plaintiff, Walt Disney Productions, alleged that the defendant, Air Pirates, infringed its copyright by creating graphic depictions of over seventeen of plaintiff’s characters and using them in comic books.⁵⁹ The Ninth Circuit held that the *Sam Spade* test did not preclude copyright protection of the Disney comic book characters.⁶⁰ The court held it is difficult for a literary character to gain

⁵¹ See *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1297 (C.D. Cal. 1995).

⁵² *Id.*

⁵³ See Samuel J. Coe, *The Story of a Character: Establishing the Limits of Independent Copyright Protection for Literary Characters*, 86 CHI.-KENT L. REV. 1305, 1306 (2011).

⁵⁴ *Id.*

⁵⁵ See *Air Pirates*, 581 F.2d 751, 754–55 (9th Cir. 1978); *Olson*, 855 F.2d 1446, 1452 (9th Cir. 1988).

⁵⁶ See *Stallone*, 1989 WL 206431 at *7–8; *Metro-Goldwyn-Mayer*, 900 F. Supp. at 1290.

⁵⁷ See *Am. Honda Motor Co.*, 900 F. Supp. at 1296.

⁵⁸ See *Air Pirates*, 581 F.2d at 754–55; *Olson*, 855 F.2d at 1452.

⁵⁹ *Air Pirates*, 581 F.2d at 753.

⁶⁰ *Id.*

copyright protection because the characters' look is subject to the imagination of the reader.⁶¹ However, the court pointed out that because the comic book character includes a visual image, it is easier to recognize the delineation of the character.⁶² Because of this, the Ninth Circuit found "a comic book character, which has physical as well as conceptual qualities, is more likely to contain some unique elements of expression."⁶³ The court's decision in *Air Pirates* appears to severely limit the application of the *Sam Spade* test to literary characters, while applying the "Character Delineation" test to visually depicted characters.⁶⁴ The Ninth Circuit's opinion in *Olson* further perpetuates the confusion of what test should be applied.⁶⁵

In *Olson*, the author of the television series "Cargo," brought a copyright infringement claim against NBC, contending there was substantial similarity between the characters of the television series "The A-Team" and "Cargo."⁶⁶ The court in *Olson* begins its analysis with the "Story Being Told" test by citing the court in *CBS*.⁶⁷ According to the court in *CBS*, "[I]f 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."⁶⁸ Under this test, the court in *Olson* determined that the characters did not constitute the story being told.⁶⁹ After its analysis of the "Story Being Told" test, the court recognized that cases prior to *CBS* allowed copyright protection for sufficiently delineated characters.⁷⁰ However, the "Cargo" characters were only depicted in a couple of lines, and even though they were "lightly sketched," their descriptions were not enough to warrant protection.⁷¹ Therefore, even if the "Character Delineation" test was to be applied, "the 'Cargo' characters were not protectable even under the more lenient standards adopted elsewhere."⁷² It

⁶¹ *Id.* at 755.

⁶² *Air Pirates*, 581 F.2d at 755.

⁶³ *Id.*

⁶⁴ *Id.*

⁶⁵ *Olson*, 855 F.2d at 1451.

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.* at 1452 (quoting *CBS*, 216 F.2d 945, 949–50 (9th Cir. 1954)).

⁶⁹ *Id.* at 1453.

⁷⁰ *Id.* at 1452. *See also* *Nichols v. Universal Pictures*, 45 F.2d 119, 121 (2d Cir. 1930) ("[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.").

⁷¹ *Id.* at 1452–53.

⁷² *Id.* at 1452.

appears that the court here accepted the *Sam Spade* test, and although they went into an analysis of the “Character Delineation” test, they also referred to it as “the more lenient standard[] adopted elsewhere,” thus, seemingly discrediting the test.⁷³

D. Application of both the “Character Delineation” and Sam Spade Tests

Following the *Air Pirates* and *Olson* decisions, district courts became confused as to what test should be applied. Due to the confusion, several district courts applied both the “Character Delineation” test and the “Story Being Told”/Sam Spade test.⁷⁴ In *Anderson v. Stallone*, the court analyzed the copyrightability of the characters from the “Rocky” movies.⁷⁵ Sylvester Stallone wrote the motion pictures, *Rocky* I, II, and III, in which he also played the leading role of Rocky Balboa.⁷⁶ A screenwriter named Timothy Anderson wrote a treatment for a fourth *Rocky* movie using the same characters in the first three films.⁷⁷ On a cross-claim from Anderson’s misappropriation claim, Stallone alleged copyright infringement (among other allegations).⁷⁸ The court found the “more restrictive ‘Story Being Told test’ was inapplicable to the facts of the case.”⁷⁹ However, out of an abundance of caution, the court then applied both tests.⁸⁰ Therefore, the court found that the Rocky character “constituted the story being told” because you cannot have a Rocky movie without Rocky.⁸¹ Consequently, the court held that Rocky was sufficiently

⁷³ *Id.*

⁷⁴ *Anderson v. Stallone*, No. 87–0592 WDK-GX, 1989 WL 206431, at *7–8 (C.D. Cal. April 25, 1989); *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1290 (C.D. Cal. 1995).

⁷⁵ *Anderson*, 1989 WL 206431 at *7.

⁷⁶ *Id.* at *1 (“In May of 1982, while on a promotional tour for the movie *Rocky* III, Stallone informed members of the press of his ideas for *Rocky* IV.”).

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ *Id.* at *7.

⁸⁰ *Id.* at *8.

⁸¹ *Anderson*, 1989 WL 206431 at *8.

delineated to afford copyright protection because the character is described in extensive detail throughout all three movies.⁸²

In *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, plaintiff, Metro-Goldwyn-Mayer (MGM) filed suit against American Honda Motor Company for violating its intellectual property rights to the James Bond character in its new commercial.⁸³ The commercial portrays a villain in a high-tech helicopter chasing a young, well-dressed, flirtatious couple in a Honda vehicle.⁸⁴ After the villain jumps out of the helicopter and onto the car with his metal arms, the male driver releases the car's roof, sending the villain into space.⁸⁵ In the court's analysis of whether the James Bond character is copyrightable, it states that the "Ninth Circuit is unclear as to when visually-depicted characters such as James Bond can be afforded copyright protection."⁸⁶ The court recognizes that the Ninth Circuit created the story being told test in the *Sam Spade* case, where the court deemed that a character can only be copyrightable if they are the story being told.⁸⁷ However, the court goes on to note that two Ninth Circuit decisions, *Air Pirates* and *Olson*, brought the story being told test into question.⁸⁸ Since no Ninth Circuit decision after *Olson* clarified what test should be applied, the court analyzed the copyrightability of James Bond under both the *Sam Spade* test and the character delineation test.⁸⁹ Under the story being told test, the court believed the James Bond character is similar to the Rocky character in Stallone, "[a] James Bond film without James Bond is *not* a James Bond film."⁹⁰ Under the character delineation test, even though the James Bond character changed in appearance over the years and from film to film, it is "a testament to the fact that Bond is a unique character whose

⁸² *Id.* "All three Rocky movies focused on the development and relationships of the various characters [T]he focus of these movies was the development of the Rocky characters." *Id.*

⁸³ *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co., Inc.*, 900 F. Supp. 1287, 1291 (C.D. Cal. 1995).

⁸⁴ *Id.* at 1291–92.

⁸⁵ *Id.*

⁸⁶ *Id.* at 1295.

⁸⁷ *Id.*

⁸⁸ *Id.* at 1295–96; *see also Walt Disney Publ'ns v. Air Pirates*, 581 F.2d 751, 755 (9th Cir. 1978); *Olson v. National Broadcasting Co., Inc.*, 855 F.2d 1446, 1451–52 (9th Cir.1988).

⁸⁹ *Metro-Goldwyn-Mayer, Inc.*, 900 F. Supp. at 1295–96 (C.D. Cal. 1995); *see Air Pirates*, 581 F.2d 751, 755 (9th Cir. 1978); *Olson*, 855 F.2d 1446, 1451–52 (9th Cir. 1988).

⁹⁰ *Metro-Goldwyn-Mayer, Inc.*, 900 F. Supp. at 1296.

specific qualities remain constant despite the change in actors.”⁹¹ Therefore, the court concluded that the James Bond character is copyrightable under either the *Sam Spade* test or the character delineation test.⁹²

Presumably, to avoid the breadth of the character delineation test, the restrictions of the *Sam Spade* test, and the confusion from applying both tests, the Ninth Circuit created another test, referred to in this comment as the *Towle* test.⁹³ However, the Ninth Circuit failed to overrule its decision in *Sam Spade* and did not expressly state whether the *Towle* test is solely for visually depicted characters or if it can apply to literary characters as well.⁹⁴ Also, because the court did not overrule the *Sam Spade* test, there will likely be even more confusion as to what test is relevant.

III. ANALYSIS

Prior to the court’s decision in *Towle*, the Ninth Circuit was in a state of confusion, trying to discern which test to apply, and, unfortunately, it still is. This analysis will discuss (1) the Ninth Circuit’s incorrect reliance on precedent; (2) the court’s decision in *Towle*; and (3) the impact of the *Towle* decision on modern copyright law and the First Amendment, including the protection of microworks, the idea/expression dichotomy, fair use, and the overbreadth doctrine. Finally, this analysis will conclude with a summary of the positives and negatives of current character copyright tests and a proposal for the Ninth Circuit to implement a different test.

A. Precedent: *Halicki*

In *Towle*, the Ninth Circuit incorrectly relied on precedent and completely ignored the purpose of copyright law. The precedent relied on by the court in *Towle* was from *Halicki Films, LLC v. Sanderson Sales and*

⁹¹ *Id.* “Like Rocky, Sherlock Holmes, Tarzan, and Superman, James Bond has certain character traits that have been developed over time through the sixteen films in which he appears.” *Id.* at 1296–97.

⁹² *Id.*

⁹³ See discussion *infra* Section IV(B).

⁹⁴ *Id.*

Marketing.⁹⁵ The issue in *Halicki* was whether the car “Eleanor” is a copyrightable character.⁹⁶ The original film, *Gone in 60 Seconds*, featured a yellow 1971 Fastback Ford Mustang named Eleanor.⁹⁷ Halicki advertised the original film on DVD and VHS and sold baseball hats and toy cars with the name and likeness of the Eleanor car.⁹⁸ In 1995, Halicki entered into an agreement with Hollywood Pictures⁹⁹ for an option¹⁰⁰ to purchase the rights to remake the original film.¹⁰¹ Five years later, Disney exercised that option and released a remake of *Gone in 60 Seconds*, which also featured a yellow car named Eleanor.¹⁰² In the remake, Eleanor was referred to and transformed to represent a 1967 Shelby GT-500.¹⁰³ Defendant, Carroll Shelby, developed a variant of this car along with Ford Motor Company.¹⁰⁴ Following the release of the remake, the defendant obtained the trademark to Eleanor for “automobiles and structural parts of automobiles.”¹⁰⁵ After obtaining the trademark, defendant, Carroll Shelby, entered into a licensing agreement with Unique Motorcars, Inc. to use the trademark.¹⁰⁶ Unique Motorcars began selling merchandise resembling the car Eleanor, that appeared in the remake.¹⁰⁷

Halicki brought suit against defendants for creating “replicas of Eleanor from ‘Gone in 60 Seconds,’ and using the term ‘Eleanor’ in relation to the film ‘Gone in 60 Seconds.’”¹⁰⁸ Defendants relied on the

⁹⁵ *Towle*, 802 F.3d 1012, 1020 (9th Cir. 2015); *see also* *Halicki Films, LLC v. Sanderson Sales and Marketing*, 547 F.3d 1213, 1216 (9th Cir. 2008).

⁹⁶ *Halicki*, 547 F.3d at 1217.

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ *Id.* Hollywood Pictures is a division of Walt Disney. *Id.*

¹⁰⁰ *See Option (Entertainment Law) Law and Legal Definition*, USLEGAL (last visited Feb. 18, 2020), <https://definitions.uslegal.com/o/option-entertainment-law/> (“The term ‘option’ as used in the entertainment industry, is an agreement entered upon between two parties that must come into force by a specific time.”).

¹⁰¹ *See Halicki*, 547 F.3d at 1218.

¹⁰² *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ *Id.*

¹⁰⁶ *Id.*

¹⁰⁷ *Id.*

¹⁰⁸ *Id.* Plaintiffs’ claims consist of: “(1) copyright infringement; (2) common law trademark infringement; (3) federal unfair competition/false advertising, in violation of 15 U.S.C. § 1125 et seq.; (4) statutory unfair competition, in violation of CAL. BUS. & PROF. CODE § 17200 et seq.; (5) intentional interference with prospective economic advantage; (6) negligent

“story being told” test, arguing that Eleanor is not “the story being told” but is “simply a car.”¹⁰⁹ However, the court recently recognized “copyright protection for characters” in *Olson* that have “displayed consistent, widely identifiable traits.”¹¹⁰ The district court in *Halicki* never examined the question of whether “Eleanor” could be considered a character and, if so, whether it is protected under copyright.¹¹¹ However, the district court, when addressing the issue of whether the remakes of “Eleanor” were a derivative, implied that the car would be “deserving of copyright protection.”¹¹² In its analysis, the Ninth Circuit found that the car “display[s] consistent, widely identifiable traits,” and can be viewed as “especially distinctive.”¹¹³ However, because this is fact-sensitive, the court remanded the issue to the district court to determine whether “Eleanor” was protected under copyright.¹¹⁴ On remand, the district court determined that the defendants failed to present evidence that “Eleanor” was a useful article, nor established that there was a lack of originality.¹¹⁵

B. *DC Comics v. Towle*

DC Comics is the copyright owner for the comic books featuring Batman and, of course, the Batmobile.¹¹⁶ Mark Towle, defendant, creates replicas of the Batmobile, which he admitted, are a copy of the Batmobile as depicted in the 1966 television show and 1989 movie.¹¹⁷ DC Comics

interference with prospective economic advantage; (7) constructive trust/accounting; (8) declaratory relief pursuant to 15 U.S.C. § 1119, in the form of an order from the District Court instructing the United States Patent and Trademark Office to cancel the Carroll Hall Shelby Trust's registration of the ‘Eleanor’ mark; and (9) declaratory relief in the form of a judgment declaring that Defendants do not have a right in the ‘Eleanor’ or ‘Gone in 60 Seconds’ marks by virtue of the registration of the ‘GT-500’ mark.” *Id.* at 1219.

¹⁰⁹ *Id.* at 1224.

¹¹⁰ *Id.*; see *Olson*, 855 F.2d 1446, 1451–52 (9th Cir. 1988); *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1175 (9th Cir. 2003) (“Characters that have received copyright protection have displayed consistent, widely identifiable traits.”).

¹¹¹ See *Halicki*, 547 F.3d at 1224.

¹¹² *Id.* at 1225.

¹¹³ *Id.*

¹¹⁴ *Id.*

¹¹⁵ *Halicki v. Carroll Shelby Int’l*, No. CV 04–08813 SJO-PJWx, 2009 WL 10669478 (C.D. Cal. Aug. 12, 2009) (denying Defendants’ motion for partial summary judgment).

¹¹⁶ *Towle*, 802 F.3d 1012, 1015 (9th Cir. 2015).

¹¹⁷ *Id.* at 1017.

filed suit against Mark Towle for infringing its copyright to the Batmobile.¹¹⁸ Towle presents two arguments.¹¹⁹ First, Towle argues that the Batmobile is not subject to copyright protection.¹²⁰ In part, because the Batmobile's appearance has changed over the years, that at times the Batmobile has "appeared without its signature sleek 'bat-like' features."¹²¹ For example, in the 1988 comic book, the Batmobile is depicted as an armored tank, and in 1989 it was a Batmissile.¹²² The court, however, concluded that "a consistent appearance is not as significant in our analysis as consistent character traits and attributes," and that it is similar to a character changing costumes.¹²³ Second, Towle argues that DC Comics does not own the copyright of the Batmobile for its appearance in neither the 1966 television show nor the 1989 movie.¹²⁴ The court, looking to the Copyright Act, which states that "copyright ownership 'vests initially in the author or authors of the work,' which is generally the creator of the copyrighted work[.]" concluded that DC does own the copyright to the Batmobile.¹²⁵

The court looked to their decision in *Halicki*, stating that "[w]e have previously determined that an automotive character can be copyrightable."¹²⁶ Thus, the court looked to the precedent set in *Halicki* that an automobile can be considered a character.¹²⁷ In *Halicki*, the court stated that "[w]e have held that copyright protection is available only 'for characters that are especially distinctive.'"¹²⁸ To qualify for protection under this standard, a character must be "'sufficiently delineated' and display 'consistent, widely identifiable traits.'"¹²⁹ In *Halicki*, the court

¹¹⁸ *Id.*

¹¹⁹ *Id.* Towle also presented the argument that determining the copyrightability of a character is a question of fact, not law. *Id.* The court disagreed, stating that "[w]hether a particular work is subject to copyright protection is a mixed question of fact and law subject to de novo review." *Id.* at 1022.

¹²⁰ *Id.* at 1017.

¹²¹ *Id.* at 1022.

¹²² *Id.*

¹²³ *Id.*

¹²⁴ *Towle*, 802 F.3d at 1017 (9th Cir. 2015).

¹²⁵ *Id.* at 1023–24 (quoting 17 U.S.C. § 201(a)).

¹²⁶ *Id.* at 1019.

¹²⁷ *Id.* at 1020.

¹²⁸ *Id.* (quoting *Halicki*, 547 F.3d at 1224).

¹²⁹ *Id.* (quoting *Toho Co., Ltd. v. William Morrow & Co., Inc.*, 33 F. Supp. 2d 1206, 1215 (C.D. Cal. 1998)). The court in *Towle* uses the example of a standard magician as a character not sufficiently delineated to warrant copyright protection. "A masked magician dressed in 'standard magician garb' whose role

found that “a character may be protectable if it has distinctive character traits and attributes, even if the character does not maintain the same physical appearance in every context.”¹³⁰ After looking to their decision in *Halicki*, the court determined that the Batmobile is not a stock character.¹³¹ However, instead of using the “Character Delineation” test as the court did in *Halicki*, the court created a three-part test to determine whether a character is entitled to copyright protection.¹³² The *Towle* test has three elements: “First, the character must generally have physical as well as conceptual qualities. Second, the character must be sufficiently delineated to be recognizable as the same character whenever it appears Third, the character must be especially distinctive and contain some unique elements of expression.”¹³³

Regarding the first factor, the court found that, because the Batmobile had been visually depicted in comic books, television shows, and motion pictures, it had “physical as well as conceptual qualities.”¹³⁴ Second, the Batmobile is easily recognizable, and even though certain aspects have changed over the years, it has maintained its unique “bat-like” appearance with “high-tech gadgets and weaponry used to aid Batman in fighting crime.”¹³⁵ The Batmobile’s character traits have also remained consistent as a “‘crime-fighting’ car with sleek and powerful characteristics that allow Batman to maneuver quickly while he fights villains.”¹³⁶ Therefore, the second element was met.¹³⁷ Third, the Batmobile is “Batman’s loyal

‘is limited to performing and revealing the magic tricks,’ for example, is not ‘an ‘especially distinct’ character differing from an ordinary magician in a manner that warrants copyright protection.’” *Id.* (quoting *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1175 (9th Cir. 2003)).

¹³⁰ *Id.* at 1020 (quoting *Halicki*, 547 F.3d at 1224).

¹³¹ *Id.* at 1022.

¹³² *Id.* at 1021.

¹³³ *Towle*, 802 F.3d at 1021 (9th Cir. 2015) (citations and internal quotations omitted).

¹³⁴ *Id.*

¹³⁵ *Id.*

¹³⁶ *Id.* “[T]he Batmobile always contains the most up-to-date weaponry and technology.” *Id.* Also, “the Batmobile in the 1966 television series possesses a ‘Bing-Bong warning bell,’ a mobile Bat-phone, a ‘Batscope, complete with [a] TV-like viewing screen on the dash,’ and a ‘Bat-ray.’ Similarly, the Batmobile in the 1989 motion picture is equipped with a ‘pair of forward-facing Browning machine guns,’ ‘spherical bombs,’ ‘chassis-mounted shinbreakers,’ and ‘side-mounted disc launchers.’” *Id.* at 1022.

¹³⁷ *Id.* at 1021.

bat-themed sidekick” and has a unique and recognizable name.¹³⁸ Because the Batmobile is not a stock character, it is, therefore, “especially distinctive.”¹³⁹ Thus, after applying the three-part test, the court concluded that the Batmobile is a character and qualifies for copyright protection.¹⁴⁰

IV. WHAT DOES THIS MEAN FOR MODERN COPYRIGHT LAW AND THE FIRST AMENDMENT?

The new three-part test created in *Towle* is the Ninth Circuit’s attempt to clarify the necessary elements for copyrighting a character. The leniency of the “Character Delineation” test led the Ninth Circuit to create the *Sam Spade* test, and the strictness of the *Sam Spade* test led the Ninth Circuit to create the *Towle* test.¹⁴¹ Many have criticized the decision in *Towle* for lack of clarification¹⁴² and criticized the court for failure to distinguish which characters fall under the new test.¹⁴³ While these are all valid criticisms of the decision in *Towle*, the main underlying theme is the new test’s damaging effect on the First Amendment. The main concern is that the *Towle* decision might represent overprotective copyright law infringing on the First Amendment by protecting microworks, which favor creators over the public.¹⁴⁴

The Copyright Clause and the First Amendment foster creativity and freedom of expression. Ideally, these two parts of the Constitution work hand in hand to ensure greater artistic, technological, and scientific

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ See *Nichols v. Universal Pictures*, 45 F.2d 119, 120–23 (2d Cir. 1930); *Detective Comics, Inc.*, 111 F.2d 433–34; *CBS*, 216 F.2d 945, 954 (9th Cir. 1954); *Towle*, 802 F.3d at 1021.

¹⁴² See Katherine Alphonso, *DC Comics v. Towle: to the Batmobile! Which Fictional Characters Deserve Protection Under Copyright Law*, 47 GOLDEN GATE UNIV. L. REV. 5 (2017) (“[T]he three-part test merely combines three standards already in use. It offers little clarification as to what constitutes ‘especially distinctive’ and ‘sufficiently delineated.’”).

¹⁴³ See *id.* (“[T]he three-part test only covers fictional characters depicted in comic books, television shows, and movies. As it does not clearly apply to literary works, characters such as Oberyn Martell, Bigger Thomas, Behemoth, and Mary Katherine Blackwood are left extremely vulnerable to plagiarism.”) (citations omitted); see also Missy G. Brenner, *Shadow of the Bat[mobile]: Character Copyright After DC Comics v. Towle*, 57 SANTA CLARA L. REV. 481 (2017).

¹⁴⁴ See Bunker, *supra* note 9.

advancement.¹⁴⁵ Copyright law was created to “[t]o promote the progress of science and useful arts,”¹⁴⁶ while the First Amendment provides that “Congress shall make no law . . . abridging the freedom of speech, or of the press.”¹⁴⁷ Some may attempt to argue that copyright and the First Amendment actually conflict with each other because copyright was created to protect individual works while the First Amendment was created to protect the public’s interest as a whole. However, following the Supreme Court’s decision in *N.Y. Times Co. v. Sullivan*,¹⁴⁸ that statement is not true. In *Sullivan*, the Court concluded that “[t]he interest of the public . . . outweighs the interest of . . . any other individual.”¹⁴⁹ Therefore, what happens when one starts to undermine the primary purpose of the other?

A. Protection of Microworks

For several reasons, the court’s decision in *Towle* can put an unnecessary strain on the relationship between copyright law and the First Amendment, and it all starts with the protection of microworks. A large component of copyright law is to protect the ideas of authors, but the primary purpose is to promote creativity and expression of ideas.¹⁵⁰ However, the protection of microworks and small creations goes against this very purpose.¹⁵¹ As Justice O’Connor wrote, “The primary objective of copyright is not to reward the labor of authors, but ‘[t]o promote the Progress of Science and useful Arts.’”¹⁵² The protection of microworks “can throw off the balance of other copyright doctrines that act to protect free speech interests within copyright law.”¹⁵³ Intellectual Property

¹⁴⁵ David L. Hudson Jr., *Copyright & the First Amendment*, FREEDOM F. INST. (Aug. 5, 2004), <https://www.freedomforuminstitute.org/2004/08/05/copyright-the-first-amendment/>.

¹⁴⁶ 17 U.S.C. § 102.

¹⁴⁷ U.S. CONST. amend. I.

¹⁴⁸ *N.Y. Times v. Sullivan*, 376 U.S. 254, 721–22 (1964).

¹⁴⁹ *Id.* See also *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (“The immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.”).

¹⁵⁰ See *Purpose of Copyright Law*, *supra* note 19.

¹⁵¹ See *id.*

¹⁵² *Feist Publ’ns, Inc.*, 499 U.S. at 349.

¹⁵³ *Bunker & Calvert*, *supra* note 9.

professor, Justin Hughes stated that “commentators have expressed concern about intellectual property law becoming too ‘finely grained’—with claims of independent property protection being draped over smaller and smaller pieces of creativity, innovation, and expression.”¹⁵⁴ What Professor Hughes referred to is called Microworks.¹⁵⁵ One of the primary implications of protecting microworks is its effect on idea/expression dichotomy and fair use, two key doctrines that limit copyrightable subject matter.¹⁵⁶

B. Idea/Expression Dichotomy

One of the key limitations on a copyrightable subject matter is the idea/expression dichotomy, in which “copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by the work.”¹⁵⁷ In other words, copyright protection can extend to the expression of ideas but not to ideas alone, because they are often too broad.¹⁵⁸ For example, if copyright could protect instructions for entering a sweepstake, there are not many other ways to convey the instructions without infringing another’s copyright.¹⁵⁹ Another

¹⁵⁴ Justin Hughes, *Size Matters (or Should) in Copyright Law*, 74 FORDHAM L. REV. 575, 575 (2005).

¹⁵⁵ *Id.* at 576.

¹⁵⁶ *See id.*

¹⁵⁷ *Feist Publ’ns, Inc.*, 499 U.S. at 349–50; *see also* Leslie A. Kurtz, *Copyright: The Scènes à Faire Doctrine*, 41 FLA. L. REV. 79, 83 (1989) (“The distinction between ideas and expression provides a way of reconciling two competing interests -- the interest in rewarding ingenuity and the interest in allowing the public to benefit from new works by other authors on the same subject.”); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1264 (11th Cir. 2001) (“It is partly through this idea/expression dichotomy that copyright law embodies the First Amendment’s underlying goal of encouraging open debate and the free exchange of ideas.”); *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556 (1985) (“[C]opyright’s idea/expression dichotomy ‘strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression.’”).

¹⁵⁸ Kurtz, *supra* note 157, at 82 (“As Justice Brandeis said, ‘the noblest of human productions—knowledge, truths ascertained, conceptions, and ideas—become, after voluntary communication to others, free as the air to common use.’”) (quoting *International News Serv. v. Associated Press*, 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting)).

¹⁵⁹ *Brenner, supra* note 143; *see Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 678–79 (2d Cir. 1967) (holding that sweepstakes rules could not be

good example of the importance of idea/expression dichotomy is the copyright for Superman.¹⁶⁰ If the court were to find a man in a skin-tight suit who fights crime, to be copyrightable, we might not have superheroes like Spiderman, Captain America, or Batman.¹⁶¹ However, if the character is portrayed in a sufficiently unique way and provides specific and detailed expressions that make the character easily recognizable apart from the original work, the character will most likely gain copyright protection.¹⁶²

The *scènes à faire* doctrine is somewhat of an expansion on the idea/expression dichotomy. The Honorable Leon Yankwich describes *scènes à faire*, stating that “when you are dealing with a common idea, no matter how different the treatment may be, common elements will appear in both products.”¹⁶³ The decision in *Towle* can significantly impact both doctrines because it provides protection for small works. As stated above, the First Amendment provides for freedom of speech and freedom of expression, and the Copyright Act extends those freedoms to authors of new works as well.¹⁶⁴ But if the court continues to broaden its copyright protection to microworks, there will be a decrease in content available in the public domain for the public to use and build off of.¹⁶⁵ The idea/expression doctrine and the *scènes à faire* doctrine only work if authors are provided the opportunity to work off other authors’ ideas.¹⁶⁶

copyrighted because the “subject matter would be appropriated by permitting the copyrighting of its expression.”).

¹⁶⁰ See *Detective Comics*, 111 F.2d 432, 433–34 (2d Cir. 1940).

¹⁶¹ See *id.* (“So far as the pictorial representations and verbal descriptions of ‘Superman’ are not a mere delineation of a benevolent Hercules, but embody an arrangement of incidents and literary expressions original with the author, they are proper subjects of copyright and susceptible of infringement because of the monopoly afforded by the act.”).

¹⁶² See *id.*

¹⁶³ Leon R. Yankwich, *Originality in the Law of Intellectual Property (Its Meaning from a Legal and Literary Standpoint)*, 11 F.R.D. 457, 462 (1952) (“The French refer to them as *scènes à faire*, that is, scenes which *must* follow a certain situation.”).

¹⁶⁴ See 17 U.S.C. § 102; U.S. Const. amend. I.

¹⁶⁵ Bunker & Calvert, *supra* note 9.

¹⁶⁶ See Kurtz, *supra* note 157.

C. *Fair Use*

Another key limitation on the scope of copyrightable subject matter is the doctrine of fair use. Maintaining the correct balance between copyright law and the first amendment is primarily preserved by the doctrine of fair use.¹⁶⁷ Fair use is one of the most common defenses to copyright infringement and “is one of copyright’s key internal free speech safeguards that obviates the need for direct First Amendment intervention into copyright doctrine.”¹⁶⁸ Fair use originated as common law until it was enacted in the 1976 Copyright Act, which states:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit 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.¹⁶⁹

The primary goal of the fair use doctrine is to provide others with the opportunity to comment on or criticize another’s work without threat of infringement.¹⁷⁰ The fair use doctrine is extremely flexible from a case

¹⁶⁷ Bunker & Calvert, *supra* note 9.

¹⁶⁸ *Id.*

¹⁶⁹ 17 U.S.C. §107.

¹⁷⁰ See Ned Snow, *Proving Fair Use: Burden of Proof as Burden of Speech*, 31 CARDOZO L. REV. 1781 (2010) (“The doctrine of fair use purports to ensure that copyright law does not trample rights of speakers whose expression employs copyrighted material.”).

by case basis.¹⁷¹ According to Matthew Bunker and Clay Calvert, “granular copyright protection for microworks, including protection for *nonhuman* characters, is a disturbing innovation that not only makes little sense, but also threatens fair use rights and shrinks the public domain.”¹⁷² The more the court protects small works of creativity, the less new authors can use in their own works.¹⁷³ For example, if the court protects the “Allspark” from the movie *Transformers*, then no one else could use an object that looks like a box with scribe on the surface. It is unrealistic and impacts First Amendment freedom of expression protections.

The third fair use factor, “the amount and substantiality of the portion used in relation to the copyrighted work as a whole,” creates the most concern for freedom of expression following the decision in *Towle*.¹⁷⁴ The amount and substantiality used refers to the amount that was taken from the original work and whether that portion was substantial to the work as a whole.¹⁷⁵ For example, in *Harper & Row*, defendants took only 300 words from President Ford’s memoir, but those words were considered to be the “heart of the Ford work,” and were the most important portions of the speech.¹⁷⁶ As copyright law becomes broader and provides protection for smaller and smaller works, the ability to have fair use protection shrinks because “[w]hat might have been a relatively modest borrowing from an entire work can suddenly become nearly ‘everything’ when the ‘work’ is redefined from the literary or graphic creation in its entirety to one character within it.”¹⁷⁷ Therefore, the scope of freedom of expression is significantly reduced under fair use because the amount and substantiality standards are being reduced, which in turn affects the general public’s ability to be creative with other authors’ works.¹⁷⁸

The decision in *Towle* also has a significant impact on the “transformative” portion included in the first element by the court in

¹⁷¹ *Id.* at 1786.

¹⁷² Bunker & Calvert, *supra* note 9 (emphasis added).

¹⁷³ *See id.*

¹⁷⁴ 17 U.S.C. § 107.

¹⁷⁵ *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 587 (1994) (“[T]his factor calls for thought not only about the quantity of the materials used, but about their quality and importance.”).

¹⁷⁶ 471 U.S. at 564–66, 568.

¹⁷⁷ Bunker & Calvert, *supra* note 9.

¹⁷⁸ *See id.*

Campbell.¹⁷⁹ In order for a work to be transformative, the new work must add something new, with a new purpose, character, expression, meaning, or message.¹⁸⁰ In *Campbell*, the defendant from 2 Live Crew took the line, "Oh, Pretty Woman," from Roy Orbison and added new lyrics and other parodic elements to critique the original song.¹⁸¹ However, imagine if "plaintiff had characterized that one borrowed lyric line as the 'work' in question."¹⁸² In other words, instead of looking at the copyright of the song as a whole, the court could look at the copyright to the single lyric. If this were so, the borrowed portion, "Oh, Pretty Woman," would not be transformed at all.¹⁸³ Using this analysis to determine fair use of the copyright of the Batmobile instead of the movie as a whole, the issue of transformation would be evaluated differently.¹⁸⁴ If someone took the Batmobile without transforming it at all and placed it in an entirely different setting, plot, and storyline, the Batmobile itself still would not be transformed.¹⁸⁵

The Fair Use doctrine allows other authors to be creative and think outside of the box by allowing them to comment on, criticize, report, and teach without being held liable for infringement.¹⁸⁶ This doctrine was meant to work cohesively with the First Amendment by allowing other authors and creators to use existing work, transform it, add new elements, expressions, and originality to make something new. The entertainment industry is the essence of free speech and freedom of expression. Movies, television, comic books, and novels are all mediums that allow authors to express their ideas, opinions, dreams, and

¹⁷⁹ *Campbell*, 510 U.S. at 579.

¹⁸⁰ *Id.* ("Although such transformative use is not absolutely necessary for a finding of fair use, the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright, and the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use."). *Id.*

¹⁸¹ *Id.* at 572.

¹⁸² Bunker, *supra* note 9.

¹⁸³ *Id.*

¹⁸⁴ *Id.*

¹⁸⁵ *See id.* ("While it is true that not all transformative uses require aesthetic alteration, actual transformation of some sort is still called for in many fair use decisions. And because transformative use plays such an important part in contemporary fair use determinations, this poses a real danger to the viability of successful borrowings in cases in which microworks are recognized.").

¹⁸⁶ 17 U.S.C. § 107.

originality. And yet, the Hollywood Circuit¹⁸⁷ comes out with a decision that could have serious implications on the expression of those ideas by protecting microworks.

D. Overbreadth Doctrine

The next issue that could have a large impact on the idea/expression dichotomy is the indication by the court's decision in *Towle* that copyright law is becoming overly broad. The "overbreadth doctrine" was created to allow a party "to bring a facial challenge to a statute despite the fact that the application of the statute to the litigant under the facts of the case does not violate the Constitution."¹⁸⁸ This doctrine is unique because a court "may condemn a statute which comprehends a range of applications against privileged activity even though the interests it promotes outweigh the infringement of First Amendment liberties."¹⁸⁹ The doctrine provides that if regulation of speech is too broad or the language is not specific to what it is supposed to apply to or protect, it can have a significant impact on expression in aspects the law was never intended to touch.¹⁹⁰

In 1940, the court first recognized overbreadth in *Thornhill v. Alabama* and *Cantwell v. Connecticut*.¹⁹¹ In *Thornhill*, the court held that a state cannot "impose penal sanctions on peaceful and truthful discussion of matters of public interest" and that the mere "danger of injury to an

¹⁸⁷ The "Hollywood Circuit" is referencing the Ninth Circuit. The Ninth Circuit's jurisdiction extends across the west, including Hollywood, CA, the entertainment capital of the world. See *Los Angeles – the Entertainment Capital of the World*, LIVING OUT LOUD (Jan. 5, 2018), <https://www.lol-la.com/los-angeles-the-entertainment-capital-of-the-world/>.

¹⁸⁸ Luke Meier, *A Broad Attack on Overbreadth*, 40 VAL. UNIV. L. REV. 113 (2005).

¹⁸⁹ *The First Amendment Overbreadth Doctrine*, 83 HARV. L. REV. (1970).

¹⁹⁰ Richard Parker, *Overbreadth*, THE FIRST AMEND. ENCYCLOPEDIA (last updated Sept. 2017), <https://www.mtsu.edu/first-amendment/article/1005/overbreadth>; see *The First Amendment Overbreadth Doctrine*, *supra* note 189 ("Many are so broadly drafted that the range of possible applications violating the first amendment is substantial. The principal responsibility for attacking the constitutional defect of overbroad coverage rests with the courts.").

¹⁹¹ *Thornhill v. Alabama*, 310 U.S. 88, 105 (1940); *Cantwell v. Connecticut*, 310 U.S. 296, 309 (1940).

industrial concern is neither so serious nor so imminent as to justify the sweeping proscription of freedom of discussion.”¹⁹² Here, the court struck down a law using the overbreadth doctrine that was far too sweeping.¹⁹³ The law was intended to stop unlawful loitering surrounding businesses with the intent to influence others, however, the law brought serious First Amendment violations and had significant impacts on free speech concerning public interest matters.¹⁹⁴ In *Cantwell*, the court found that a state cannot “unduly suppress free communication of views, religious or other, under the guise of conserving desirable conditions.”¹⁹⁵ The original intent of the statute was to prevent solicitation of money for charities and religious groups.¹⁹⁶ However, the overbreadth of the statute provided for serious limitations on freedom of religion and freedom of speech.¹⁹⁷ The statute at issue was far too sweeping in its application and allowed for too much discretion.¹⁹⁸

The key to avoiding overbreadth claims is to ensure that the application of the statute is tailored toward its specific purpose and to ensure its application will not negatively impact first amendment rights.¹⁹⁹ Regarding the application of copyright protection for characters, if granted leniently, it could hinder other authors’ ability to build off the ideas of copyrighted material, thereby creating a monopoly over ideas and creations.²⁰⁰ On the contrary, if copyright protection is too strict, it will hinder the authors’ ability to protect their creations.²⁰¹ There needs to be a balance between allowing the author to continue to develop and publicize his or her work, while also leaving enough baseline, or general, materials and ideas for new authors to build off of and create new works. The Overbreadth doctrine remains an important argument against wide-sweeping statutes that have serious implications on First Amendment protections.

¹⁹² *Thornhill*, 310 U.S. at 103–04.

¹⁹³ *Id.* at 91.

¹⁹⁴ *Id.* at 103–04.

¹⁹⁵ *Cantwell*, 310 U.S. at 309.

¹⁹⁶ *Id.* at 301–02.

¹⁹⁷ *Id.* at 303.

¹⁹⁸ *Id.*

¹⁹⁹ See Parker, *supra* note 190. (“As the Court ruled in *Gooding v. Wilson* (1972), these implications include leaving grievances to fester and foisting the “chilling effects” of regulation upon those whose speech is protected by the Constitution.”).

²⁰⁰ See *Detective Comics*, 111 F.2d 432, 433–34 (2d Cir. 1940).

²⁰¹ See *CBS*, 216 F.2d 945, 950–51 (9th Cir. 1954).

V. PROPOSED TEST

So, which test, if any, should be applied to determine what characters are afforded copyright protection? The *Sam Spade* test provides a strict test that significantly limits the protection of characters under copyright law.²⁰² This test is beneficial in that it allows for more characters to be in the public domain, thus, allowing for new authors to build-off of existing characters.²⁰³ However, this also means significantly less protection for the authors' works.²⁰⁴ The "Character Delineation" test, on the other hand, is a more lenient test that grants protection for characters who are significantly delineated and recognizable on their own.²⁰⁵ Under this test, it is much easier for authors to get copyright protection.²⁰⁶ On the contrary, because this test is more lenient, it opens up the door for more microworks to obtain copyright protection.

A slight trend towards using trademark law solely has been emerging. Instead of creating a new copyright test, "trademark law could be used to protect those characters or distinctive non-character elements--such as the Batmobile."²⁰⁷ When DC Comics went after Towle for infringement, it was primarily to protect the sale of merchandise of the Batmobile and preserve its right to make derivatives and prevent public confusion.²⁰⁸ All of which are primary protections provided under trademark law.²⁰⁹ However, the issue with this reasoning is the movement from one form of intellectual property law to another. Another issue with using trademark law instead of copyright is that trademark protection does not expire.²¹⁰ This would go against the entire purpose of copyright law, First Amendment protections, and the idea/expression dichotomy.²¹¹ The purpose of these is to allow for certain protections of authors' works but also to allow others to build off that work and create new works.²¹² Therefore, for the court to move from copyright law to trademark would

²⁰² *See id.*

²⁰³ *See id.*

²⁰⁴ *See id.*

²⁰⁵ *See Detective Comics*, 111 F.2d at 433–34.

²⁰⁶ *See id.*

²⁰⁷ Brenner, *supra* note 143.

²⁰⁸ *Id.*

²⁰⁹ *Id.*

²¹⁰ *Id.*

²¹¹ *See* Matthew D. Bunker & Clay Calvert, *supra* note 9.

²¹² *See id.*

be too much of a leap and would further undermine the purpose behind copyright law.

What about applying a combination of the *Sam Spade* test and the “Character Delineation” test? The only reason the courts began applying both tests was that they were confused as to which test to apply to certain characters, literary or visually depicted. The application of both tests to a single character would only perpetuate the confusion because the character might be sufficiently delineated, and this satisfies the “Character Delineation” test, but they might fail under the *Sam Spade* test because they are not the story being told. So, are they copyrightable or not? However, let us not dismiss the idea of using both tests. If the Ninth Circuit had made it explicitly clear to apply the “Story Being Told”/*Sam Spade* test to literary characters, characters primarily described in writing, and the Second Circuits “Character Delineation” test to visually depicted characters, characters seen in comic books, film, television, etc., a lot of the confusion for subsequent circuit court and district court decisions would have been avoided. The court should also include an asterisk for this rule and place a restriction on the copyright protection of inanimate objects. If we were to apply the “Character Delineation” test with the asterisk, the Batmobile might satisfy the test, but it would fail under the exception.

VI. CONCLUSION

Copyright law has changed and evolved immensely over the years, “[i]t was once a limited, specialty field affecting a relatively narrow audience, an important industry, and a small bar of practitioners. That is no longer true.”²¹³ Modern copyright law is becoming more and more complicated and dense with the constant emergence of new technology and ideas. And with this change, copyright law has become overly broad. Until recently, you could not sing “Happy Birthday” in any public forum without infringing Warner/Chappell Music’s copyright.²¹⁴ And now, following the decision in *Towle*, the court is providing copyright protection for a car, an inanimate object. To summarize some of the court’s decisions as stated above, courts have found characters like

²¹³ *Copyright: Principles, Law and Practice* Paul Goldstein Little Brown & Co. (800-759-0190), 1989, 31-JUN HOU. L. 49 (1994) (reviewed by Raymond T. Nimmer, Houston Lawyer).

²¹⁴ Alyssa Hertel, *Restaurant Employees Can Finally Sing Happy Birthday to Its Customers*, CHI. KENT J. INTELL. PROP. (Mar. 1, 2016), <https://studentorgs.kentlaw.iit.edu/ckjip/restaurant-employees-can-finally-sing-happy-birthday-customers/>.

Sam Spade and members of the A-Team not copyrightable, but inanimate objects like the car Eleanor or the Batmobile, are protected under copyright law. Where does the line get drawn? What is next? “Harry Potter’s wand, Thor’s mystical hammer, or even places such as Buffy the Vampire Slayer’s Sunnydale may now be independently copyrightable.”²¹⁵ The creation of this new test was the Ninth Circuit’s failed attempt at clarifying the proper means of providing copyright protection for characters. However, the new test only further perpetuates the confusion and provides for some serious implications against First Amendment protections. Protecting the author’s expression of their ideas is important, but it essential to protect the public’s First Amendment rights. Therefore, the Ninth Circuit should adopt the “Story Being Told”/*Sam Spade* test for literary characters, and the “Character Delineation” test for visually depicted characters, with an asterisk stating that there is no copyright protection for inanimate objects. The use of both these tests for different types of characters provides a suitable balance between protecting authors’ rights and allowing for more work to be in the public domain.

²¹⁵ Matthew D. Bunker & Clay Calvert, *supra* note 9.