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# **Protection Of Fictional Characters Vis-À-Vis Trademark Laws In India And The Us**

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## **Abstract**

Fictional characters have long served in public minds as marks of association for particular works or companies or in certain cases even people, simultaneously they have also been subject of imagination in new settings and contexts by the public. In such situations it becomes imperative to protect such characters, especially when their unauthorized use can lead to confusion in the public. This article explores the protection of such fictional characters under trademark law in the US and India on basis of statutes and case laws. Furthermore, the article goes on to draw a line of difference between protection afforded by trademarks and copyrights in respect of such characters. The article concludes that while both trademark law affords protection, it is lacking and has voids. It is suggested that, the trademark law and copyright law compliment and supplement each other to a certain extent , hence a combination of both the laws needs to be used to for optimal protection and for minimizing the voids in protection of such characters. Fictional and Graphic Characters are typically protected by copyright in the context of the work they are featured in. Even though such characters can never be completely removed from the original work they were first featured in, as the work and plot elements will always form a part of their personality, mannerisms, and physical description, the readers can often associate and identify the characters independent of the work featuring them. For instance, characters such as Sherlock Holmes, Tarzan, Mickey Mouse, Superman, etc. are better known than the works in which they appear.

Even people who haven't watched any of the films featuring James Bond would associate him with Agent 007. A character may thus live in the general perception of the people, detached to a certain extent from any individual work.<sup>1</sup> A fictitious character contains not only components of creative expression protected by copyright, but also the capability to function as a symbol of identification and attract public favor in the marketplace.<sup>2</sup> In such circumstances, it becomes difficult to protect characters merely by copyright law and this is where a trademark comes into play. The law of trademarks deals with a character's ability to represent a specific origin of goods or services, rather than with its qualities of development and individualization.<sup>3</sup>

This article aims to provide an overview of the protection provided by trademarks to such protection in the US and India, while analyzing the relationship between trademark law and copyright law in the same context. The author suggests that while both trademark and copyright laws provide protection to the fictional, the most efficient method of protecting such characters would be a combination of both.

## **Protection Of Fictional Characters As Trademarks In US** **And India**

In the United States of America, trademarks are governed by both, the state common law and federal statutory law. The Lanham Act of 1946,' provides protection to qualifying marks and registered marks. According to the US Supreme Court interpreting Lanham Act, requirements for a mark to qualify as a trademark' are as follows:

“(1) a 'symbol,'

(2) 'use[d] . . . as a mark,'

(3) 'to identify and distinguish the seller's goods from goods made or sold by others,' but that it not be 'functional’”<sup>4</sup>

Section 43(a) of the Lanham Act states that:

“Infringement occurs when: any word, term, name, symbol, or device..., or any false designation of origin...

<sup>1</sup> *DC Comics v. Unlimited Monkey Business, Inc.* 598 F. Supp. 110, 118 (N.D. Ga. 1984)

<sup>2</sup> Goldstein, 'Derivative Rights and Derivative Works in Copyright' (1982-83) 30 J. COPYRIGHT SOC'Y OF THE U.S.A. 209, 224

<sup>3</sup> Leslie A Kurtz, 'The Independent Legal Lives of Fictional Characters' (1986) 1986 Wis L Rev 429, 474

<sup>4</sup> *Qualitex Co. v. Jacobson Prods. Co.* 514 U.S. (1995)

*(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or*

*(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographical origin of his or her or another person's goods, services, or commercial activities ....”*

Section 43(a) of the Lanham Act thus emphasizes on preventing the instances of marketplace misunderstanding in regards to the point of origin or association of any particular goods and services and it focuses on protecting distinctive marks and those which as a result of this distinctiveness are easily recognizable by consumers. Trademark law, therefore, asks for not only the distinctiveness of the mark but also, that the mark has an ‘established in a given priority marketplace.’<sup>5</sup>

While a fictional character cannot be trade marked for its own protection alone,<sup>6</sup> it may act as a symbol or mark when used to indicate the origin of a product. This is due to the above-noticed emphasis of trademark law on the protection of marks associated with a source in a marketplace and the prevention of consumer confusion.

Trademark law generally utilizes a two-prong test when it comes to the protection of fictional characters as trademarks:

*“1. The character must achieve a secondary meaning*

*2. The creator must show a likelihood of consumer confusion”<sup>7</sup>*

The first test is a test of ‘Secondary Meaning’, When a character has obtained “secondary meaning," the infringement leads the consumer to assume that the owner/creator has licensed the use of that character for production, merchandising, etc.<sup>8</sup> As Anderson observes *"Secondary meaning is an association in the minds of the buying public between the name of the product and product itself or its source”<sup>9</sup>*

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<sup>5</sup> Benjamin M Arrow, 'Real-Life Protection for Fictional Trademarks' (2010) 21 Fordham Intell Prop Media & Ent LJ 111, 119

<sup>6</sup> Peter Shapiro, 'The Validity of Registered Trademarks for Titles and Characters After the Expiration of Copyright on the Underlying Work (1984) 31 ASCAP Copyright Law Symposium 69, 88-89

<sup>7</sup> Kenneth E Spahn, 'The Legal Protection of Fictional Characters' (1992) 9 U Miami Ent & Sports L Rev 331, 342

<sup>8</sup> Robert E. Anderson, 'Alternatives to Copyright Law Protection of Graphic Characters: The Lanham Act and Antidilution Statutes' (1991) 13 HASTINGS COMM. & ENT. L.J. 184

<sup>9</sup> Ibid.



For instance, Disney is instantly identified as a source of Mickey Mouse. Mickey Mouse therefore has attained a secondary meaning.

This protection might, nevertheless, miss the mark for characters identifiable with more than a one work, defeating the objective of giving trademark protection, i.e., identifying the source of the products and preventing ambiguity in the minds of consumer with respect to the as source.<sup>10</sup>

Furthermore, only those aspects of a character that enable the public to connect the character with a particular origin may be protected under trademark.<sup>11</sup> Elements which have been held protectable by courts in various cases are as follows:

1. Character Name

In case of *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.*<sup>12</sup> despite the fact that Wyatt Earp was an actual person as well as a historical figure, it was concluded that the plaintiff had established secondary meaning and thus had the right to trademark protection in the name "Wyatt Earp." The court acknowledged that the character's name's commercial value was almost entirely attributable to a television program created by the plaintiff, as well as the plaintiff's substantial and proactive licensing program, that drove 'Wyatt Warp' into mainstream discourse and public imagination. The secondary connotation created by the plaintiff's utilization of the Wyatt Earp name entitled the plaintiff to prohibit the defendant from promotion and sales of the Earp costumes post expiry of the license.<sup>13</sup>

In another case of, *Patten v. Superior Talking Pictures*<sup>14</sup> the defendant was using a fictional character called Frank Merriwell in their film. The plaintiff had created 1236 stories based on a character by that name. The characters of the plaintiff and defendant bore no other resemblance in their personalities. However, the court determined that the name of the character had already become exclusively associated in the public mind with the plaintiff's authorship and enjoined the defendant from using the name under unfair competition principles.

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<sup>10</sup> *Universal City Studios v. Nintendo Co.* 746 F.2d 112 (2d Cir. 1984)

<sup>11</sup> *DC Comics, Inc. v. Filmation Assocs.* 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980)

<sup>12</sup> *Wyatt Earp Enterprises, Inc. v. Sackman, Inc* 157 F. Supp. 621 (S.D.N.Y. 1958)

<sup>13</sup> Amanda Schreyer, 'An Overview of Legal Protection for Fictional Characters: Balancing Public and Private Interests' (2015) 6 *Cybaris Intell Prop L Rev* 50. 66

<sup>14</sup> *Patten v. Superior Talking Pictures*, 8 F. Supp. 196 (S.D.N.Y. 1934)

It is thus clear that when protecting a character's name as a trademark, the court looks into whether the character has attained a secondary meaning in the mind of the public and whether the name is associated with a particular source by the public.

## 2. Costumes Worn by Characters<sup>15</sup>

Costumes are an important element for fictional characters, especially when there is a graphical or visual representation of the same. For instance, anyone who has read or watched Harry Potter will instantly associate a red and gold striped scarf with a lion figure with Gryffindor's house, or someone who follows comic books will associate a Spiderman costume with Marvel. This is because costumes have a special visual and aesthetic appeal which makes them an important element of characters. The court in *Warner Bros. Inc. v. Rooding* prohibited the proprietor of a movie theatre from diving from a helicopter costumed as Batman on the day of the movie's premiere. The day the stunt was done and of the stunt demonstrated to the court defendant's clear intent to abuse the plaintiff's rights in the trademark "*in the form of a Batman costume*"<sup>16</sup>

## 3. Phrases or Slogans Used by/in context to the Fictional Characters

Catch Phrases such as Bugs Bunny's "What's Up Doc?" (registered trademark) or the phrase "Look, up in the sky, it's a bird, it's a plane, it's Superman," is closely connected with the character and public has come to associate them with the characters. Phrases are especially important when it comes to character merchandising as their use can cause public confusion, even when other elements of the character are not in use. In the *Unlimited Monkey Business*<sup>17</sup> case, the court considered the promotional use of the "It's a bird, it's a plane" phrase as a persuasive factor in deciding that the defendant had misappropriated D.C Comic's trademark in Superman

## 4. Visual Representation of Character's

Character visual representations are also protected under trademark law.

For instance, in the case of *Conan Properties Inc. v. Conans pizza Inc.*, the defendant's "Conans Pizza" chain, whose dishes, signage, promotional materials, and overall atmosphere featured a barbarian-like man who closely resembled the plaintiff's "Conan

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<sup>15</sup> Schreyer (n 13) 67

<sup>16</sup> *Warner Bros. Inc. v. Rooding* 1989 WL 76149 at \*3-\*4 (N.D. Ill. 1989)

<sup>17</sup> 598 F. Supp. 110 (N.D. Ga. 1984)

the Barbarian" character, was found to have infringed on the image of the trademarked character. It was concluded that the eateries' strong, unmistakable ambiance of Conan the Barbarian could lead clients astray and make them believe that the establishment was connected or authorized by the owners of the particular character in question.<sup>18</sup>

Similarly, in *Warner Brothers v. American Broadcasting Company*, the court stated that the picture of a cartoon character and its certain attributes can serve as a trademark to indicate the source of an entertainment product.<sup>19</sup> Following this decision, the aesthetic appearances of fictional characters have been frequently safeguarded.<sup>20</sup> As a result of the above-stated cases it is clear that the courts have started to acknowledge fictional characters' unique potential to serve as a source-identification symbol.<sup>21</sup>

Moreover, where a character becomes associated with specific work in public consciousness courts usually restrict others from the usage of the character in subsequent fictional works. Trademark protection is granted to such well-known characters on the premise that the public would assume that the creators of the original work produced, or at the minimum approved, the subsequent work.<sup>22</sup>

In case of *DC Comics, Inc. v. Unlimited Monkey Business* the characters of Superman and Wonder Woman were protected from unauthorized use in new works, namely the singing telegram business.<sup>23</sup> The court stated that -

*"The exploitation of well-known fictional characters through merchandising agreements has become almost universal, creating a public expectation that merchandise displaying elements of a fictional character is at least sponsored by the owner of the character."*<sup>24</sup>

Thus, the court determined that the characters in question were distinct and unique marks due to their "universal recognition," "widespread popularity," and "extensive goodwill." The court determined that there was a possibility of confusion and granted relief based on the acquired distinctiveness of the marks and the resemblance of the defendant's singing telegram mark.

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<sup>18</sup> *Conan Properties, Inc. v. Conans Pizza, Inc.* 752 F.2d 145, 148 (5th Cir. 1985)

<sup>19</sup> *Warner Bros., Inc. v. Am. Broadcasting Co.* 720 F.2d 231, 246 (2d Cir. 1983)

<sup>20</sup> *United Features Syndicate v. Sunrise Mold Co.* 569 F. Supp. 1475, 1480 (S.D. Fla. 1983)

<sup>21</sup> Kathryn M Foley, 'Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide' (2009) 41 Conn L Rev 921, 946

<sup>22</sup> *Ibid* 947.

<sup>23</sup> *Unlimited Monkey Business* (n 1)

<sup>24</sup> *Foley* (n 23) 949

Under Indian Law, trademarks are protected under Trademarks Act 1999. Trademarks are protected under Indian law by the Trademarks Act 1999. According to Section 29 of the act, a registered trademark proprietor can preclude others from using a deceptively similar or identical mark on goods and services without the owner's authorization. The authors or owners protect their rights and the goodwill associated with their character by registering it as a trademark under the Trademark Act of 1999. They can also profit commercially by licensing their use of a trademark to a third party.

The passing-off remedy can be claimed in the case of an unregistered mark based on the following factors: the creation of goodwill in the trademark, the defendant's abuse, and the plaintiff's loss of business or harm to reputation as a consequence of the infringement of the rights in the mark.

*In the case of Disney Enterprises Inc. & Anr. Vs. Santosh Kumar & Anr.*<sup>25</sup> the Delhi High Court ruled the respondent accountable for promoting products featuring Hannah Montana, Winnie the Pooh, and other characters. The applicant possessed merchandising privileges. The Court determined that there was a strong connection between the applicant's claims and the aforementioned characters, which is why any mention of these characters instantly brings to mind the applicants to the consumers.

### **Trademark Protection: Fails And Saves**

Even though fictional characters are traditionally protected by copyright law, trademark law provides several advantages over its character protection. One of them is broader protection. While copyright protection exclusively protects fictional characters in the context of literary work, trademark law offers protection to the character even when it is observed outside the context of the original piece of work featuring it. Thus protected "elements" are broader under a trademark than a copyright regime and as discussed above can at times be inclusive of elements like the name, aesthetic visual appearance and outfits, character-related utterances, and even signs, emblems, and design features.<sup>26</sup>

Trademark protection of fictional characters further gives multiple advantages to both the consumer and the trademark holder.

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<sup>25</sup> CS(OS) 3032/2011

<sup>26</sup> Spahn (n 7) 343

As observed by Foley, such protection “reduces consumer search costs and consumer confusion while at the same time providing incentives for trademark owners to maintain quality and promote goodwill”. However, when fictional characters cease to function as a marker for distinguishing the source work, granting trademark protection to such characters takes away such fictional characters from the public domain needlessly.<sup>27</sup>

On the same note, a pitfall presented by the employment of the above-discussed test for granting trademark protection to the fictional character is that a fictional character is unable to obtain protection unless it has acquired a “secondary meaning.” Such a requirement while capable of protecting the well-established characters is ineffective and often forms a void in instances where such protection is required by new characters, unsuccessful works, most literary works, or even well-established characters that are not associated with a particular source in the public mind.<sup>28</sup>

Spahn goes on to observe that even if a character develops wide recognition such protection may be denied if the plaintiff fails to show that a possibility of confusion amongst the public exists. Trademark, therefore, places increased burdens of proof on the creator and may still not protect many characters or character elements.<sup>29</sup>

It should be emphasized that even though copyright law and trademark law are often discussed in exclusion of the other while discussing the protection of fictional characters, the protection offered by them does not exclude the other, due to differences in the objectives of protection. Kurtz observes that -

*“The law of trademarks .... is not an alternative basis for protecting a character as literary property. Copyright protects creative expression, which allows the public to benefit from the labour of authors. It is not necessary to provide additional incentives, under the law of trademarks ... to persuade authors to create or to encourage investment in the production of original expression. When using the name or other identifying indicia of a character is likely to confuse the public and lead to the appropriation of good will, however, trademark .... provides a more flexible form of protection than copyright. Unlike copyright, it does not provide protection for a fixed term, but only as long as a character or its distinctive elements continue to signify a single source to the public.”*<sup>30</sup>

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<sup>27</sup> Foley (n 23) 949

<sup>28</sup> Spahn (n 7) 344

<sup>29</sup> ibid

<sup>30</sup> Kurtz (n 3) 494

Kurtz has further observed that

*“.... unlike copyright protection, which exists as soon as the work containing the character is fixed, protection under trademark ... is granted only when a newcomer's use of the plaintiff's character is likely to cause public confusion. The remedies provided under the law of trademarks and unfair competition are also more flexible than those provided by the copyright”*<sup>31</sup>

It is therefore clear from the above observation that the nature and object of protection afforded by copyright and trademark is different, and therefore while it might be tempting to pit the two intellectual property regimes against each other as they are often done, using them in a cohesive IP protection strategy and will prove to be of a greater benefit.

As Foley states -

*“The life cycle of the intellectual property protection of fictional characters can be broken down into two distinct stages. The first stage involves concurrent copyright and trademark protection, while the second stage involves trademark protection persisting after the expiration of the copyright term.”*<sup>32</sup>

An important concern regarding affording concurrent protection to fictional characters under both copyright and trademark regime is the excessive removal of fictional characters from the public domain post expiration of the term of copyright as well as possible disruption of ‘The doctrine of Fair Use’<sup>33</sup>.

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<sup>31</sup> Ibid 495

<sup>32</sup> Foley (n 23) 953

<sup>33</sup> Ibid

## **Conclusion**

Therefore, the discussion above clearly shows that fictional characters can be protected under trademark law if they have attained a secondary meaning and are associated with a single source. While trademark protection does have some concerns attached to it, it can serve as a strong source of protection for both the public and the trademark creators/owners, especially when seen in the context of character merchandising and the rapid growth of fandom culture. It is therefore submitted that the trademark law can be used concurrently with the copyright law to form a cohesive and strong IP protection strategy for fictional characters.

