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Persona; Character Copyrights and Merger;s Role in the Evolution of Entertainment Expressions

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PERSONA–CHARACTER COPYRIGHTS AND MERGER’S ROLE IN THE EVOLUTION OF ENTERTAINMENT EXPRESSIONS

ABSTRACT

Millions of people tuned in to Comedy Central’s The Colbert Report to learn about the state of our nation from the renowned satirical character, Stephen Colbert. Millions more tuned in to watch the same Stephen Colbert make his return on CBS’s The Late Show with Stephen Colbert. However, after his first television revival, Viacom quickly shut down any possible future return, claiming that it, not Stephen Colbert the actor, held the copyright to the character Stephen Colbert. While this is not the first time that an actor was ineligible to maintain control over a persona–character he crafted, this incident exposed that copyright law does not have a means of protecting characters who become a true extension of the living, breathing actor.

The law does not allow the content of an idea to be protected, nor does it allow protection when an otherwise protected expression has merged with an idea. The policy behind this prohibition is to allow creativity to flourish so society benefits. When the line is blurred between an actor and a character so much that the character is inextricably linked to the actor, the law should label the idea and the expression merged. By relying on the merger doctrine as a personal affirmative defense in a greater capacity than courts have recognized previously, the actor can maintain control over a character that has become his counterpart.

This Comment defines what qualifies as a character and what makes the character eligible or ineligible for copyright protection. This Comment proposes placing characters on a spectrum, from those that are granted full copyright protection to those that are denied legal security. When the line is not clear regarding whether a character is an original expression or is a persona of the actor, this Comment suggests utilizing the merger doctrine as a personal affirmative defense to eliminate a studio’s inflexible copyright control and to release the character into the actor’s shared control.

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INTRODUCTION

“So it is with a heavy heart that I announce that thanks to corporate lawyers, the character of Stephen Colbert host of ‘The Colbert Report,’ will never be seen again.”¹ These words by Stephen Colbert officially put his character in a grave—that is, the Stephen Colbert persona—character we all know and love who provided witty satire concerning political developments and current events four days a week for nine years and 1,446 episodes.² The talk show host went on to proclaim, “I cannot reasonably argue that I own my own face or name. And as much as I would like to have that guy on again, I can’t.”³

While Stephen Colbert is just one example of an actor who decided to take the high road and kill a character rather than face legal consequences, the ordeal brought to light an area of copyright law that has a significant gap. This gap mainly involves what happens when a character and an actor become so inextricably linked that copyright may not provide sufficient protection. This area of law is largely unexplored because most parties end up settling when a legal issue arises. However, legal scholars have developed many theories regarding how to manage character copyright control, which serves as the basis for this Comment.

As our entertainment industry becomes much more personal with the advent of reality TV, social media, satirical shows, and the like, it is harder for consumers to differentiate between the real figures and the characters that they portray. Characters are no longer purely fictional beings. The line between reality and scripted television and film has become obliterated with shows like *The Hills*⁴ and *The Bachelor* and *The Bachelorette*⁵ that construct personas for

¹ Sarah K. Burris, *Comedy Central Sues Stephen Colbert for Playing Himself on CBS: “I Do Not Own My Face or Name,”* RAWSTORY (July 28, 2016, 7:18 AM), <http://www.rawstory.com/2016/07/comedy-central-sues-stephen-colbert-for-playing-himself-on-cbs-i-do-not-own-my-face-or-name/>.

² See *The Colbert Report*, COMEDY CENT., <http://www.cc.com/shows/the-colbert-report> (last visited Oct. 2, 2016).

³ Burris, *supra* note 1. Viewers may wonder why the satire has continued even though “Stephen Colbert” is Viacom’s intellectual property. The actor and corporate lawyers found a loophole that allows his identical twin cousin, Stephen Colbert, to appear on air, by concocting a backstory: “[O]ur moms were identical twins, who married identical twin husbands, then had sex at the exact same moment and gave us the same name . . . this is my first appearance on television ever!” *Id.*

⁴ See Was “*The Hills*” Fake? Lauren Conrad Weighs In, HUFFINGTON POST (Oct. 16, 2012, 3:57 PM), http://www.huffingtonpost.com/2012/10/16/was-the-hills-fake-lauren-conrad_n_1971118.html. Although the show began as an intimate peek into the stars’ lives, Audrina Patridge explained, “[I]t kind of started transitioning into being guided and manipulated and us kind of coming up with storylines and things.” *Id.*

their casts. As the idea and the expression of the idea (i.e., the tangible character) become nearly synonymous, as with Stephen Colbert and “Stephen Colbert,” should copyright’s strict standards become more flexible to recognize the persona–character in the entertainment industry?

At the highest level, protecting these persona–characters⁶ allows for more creative and artistic expressions without fear of losing the rights to valuable figures. Although many may not acknowledge it, entertainment is one of the most important facets of modern life.⁷ Stripping actors of the right to use the persona that they crafted increases the potential to stifle innovation and creates a rigid environment in which emerging artists struggle to succeed. Because copyright law is meant to encourage artists and promote creative expression,⁸ society will be at a detriment without some extended protections. It is important to balance the competing interests between a copyright holder’s investment with an actor’s rights to a character, particularly when it is nearly impossible to sever the actor–character association. The reasons for solving this problem go beyond protecting that singular actor’s investment: this scenario also extends toward protecting established and emerging artists who strive to make a name for themselves in the competitive entertainment industry.

This Comment explores the following three questions that arise from this tenacious problem. Where should we draw the line that severs the connection between a character and an individual? Is this a spectrum of rights that can shift depending on a character’s developmental stage? What are the implications of utilizing merger as an affirmative defense and implementing a limited-scope license to an actor? This Comment proposes that actors like Stephen Colbert can use the merger doctrine in a limited scope, as a personal

⁵ See Jaclyn Hendricks, “*The Bachelorette*” Is All a Lie, N.Y. POST (July 22, 2015, 9:42 PM), <http://nypost.com/2015/07/22/the-bachelorette-is-all-a-lie/> (“Reality TV is so close to scripted TV at this point It takes a sophisticated set of skills to be able to manipulate those emotions out of people.”).

⁶ This Comment seeks to limit its arguments to the protection of persona–characters. The use of “persona–character,” “persona,” and “character” to describe the work that is inextricably linked to the actor may be used interchangeably. For a discussion regarding the nuances, see *infra* Section I.B.

⁷ Ann C. Foster, *Movies, Music, and Sports: U.S. Entertainment Spending, 2008–2013*, BLS: BEYOND NUMBERS, Mar. 25, 2015, at 1 (discussing how much the average American spends on entertainment annually, resulting in an average annual spending of \$2,482 in 2013).

⁸ *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’ Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.”).

affirmative defense, to continue portraying persona–characters that are deeply associated with their individual identities.

This Comment proceeds in four Parts. Part I provides background material regarding the extent of copyright’s protection of characters in motion pictures or television series. It begins by defining what a character is legally. Then, it discusses what it means for a character to be copyrightable and whether a character can be separated from the work as a whole, creating its own protectable entity. Next, this Part discusses what happens when copyright protection fails, specifically providing an in-depth examination of the merger doctrine. Lastly, it addresses the potential for the right of publicity to displace copyright when characters and actors become indistinguishable.

Part II identifies the tension between copyright and the right of publicity regarding character ownership. First, this Part places characters on a spectrum, from fully copyrightable to fully unprotected. The law is most unpredictable when characters are placed in the middle of the spectrum, largely relating to persona–characters. Second, it suggests a way to fill the gap by relying on the underutilized merger doctrine as a personal affirmative defense.

Part III raises and negates possible objections to using the proposed merger affirmative defense theory, highlighting two prominent alternatives for handling control disputes. The first objection includes joint authorship credit and the second objection includes claiming work made for hire.

Part IV suggests that the limited-scope merger essentially creates a royalty-free license for an actor that can be incorporated contractually at the beginning of character development. This Part concludes by highlighting how temporal conditions and public perceptions can cause an actor and a character to merge and unmerge throughout the life span. By recognizing the fluidity of a character, protections can be extended appropriately while preserving the quality of the expression.

I. BACKGROUND

Movies and television shows are filled with classic characters—from Superman to Dorothy to Harry Potter—that resonate deeply with the public for various nostalgic reasons. Characters are not only important to the viewing public, but are also invaluable assets to the studios and actors who bring them

to life.⁹ The legal protection available to use a character in original and derivative works depends on the strength of the character and its severability from the actor. This Part examines the complexities of defining characters and explains why characters are valuable assets to the person or entity that has copyright ownership.

A. *What Is a Character?*

To understand what a character is in our complex entertainment world, it is crucial to examine how the definition of “character” has evolved in recent years from standard stock figures to amorphous persona–characters. At the most basic level, the simple dictionary definition of a “character” includes “the way someone thinks, feels, and behaves: someone’s personality” and “the personality or part which an actor recreates.”¹⁰ The essence of all characters ultimately boils down to an individual personality.

As character development begins, the creator must determine the level of importance the character is to the story. This determination is critical for future copyright claims. A major or central character is one that is “vital to the development and resolution of the conflict,” while a minor character is one that simply assists the major characters in the plot’s development.¹¹ These characters can be either static or dynamic and can be either flat or round.¹² Characters that are more dynamic and round tend to be more memorable because they “engage the reader’s imagination and empathy, making it

⁹ See generally Jeff MacGregor, *Meet Lin-Manuel Miranda, the Genius Behind “Hamilton,” Broadway’s Newest Hit*, SMITHSONIAN MAG. (Nov. 12, 2015), <http://www.smithsonianmag.com/arts-culture/lin-manuel-miranda-ingenuity-awards-180957234/>. Although Lin Manuel Miranda was inspired to create *Hamilton* based on the historical figure Alexander Hamilton, “[h]is secret is that he writes in service of character, to advance story. . . . Without having to contrive event or fabricate plot he breathes life into history and Alexander Hamilton, animates him, stands him up and makes him sing, makes him human for a couple of hours.” *Id.* As of June 2016, the creation of these characters and this story earned Miranda \$79.8 million in ticket sales alone since opening night on Broadway, indicating the value that comes with creative development. Valentina Sainato, *Lin-Manuel Miranda Net Worth 2016: How Much Is Lin-Manuel Miranda Worth Now?*, COLLEGE CANDY (June 17, 2016, 3:04 AM), <http://collegecandy.com/2016/06/17/lin-manuel-miranda-net-worth-how-much-is-lin-manuel-worth-money-broadway-hamilton-actor/>.

¹⁰ *Character*, MERRIAM-WEBSTER, <http://www.merriam-webster.com/dictionary/character> (last visited Oct. 31, 2016).

¹¹ *Types of Characters in Fiction*, LEXICONIC, <http://learn.lexiconic.net/characters.htm> (last visited Oct. 31, 2016).

¹² *Id.* A static character does not change in the course of the story, while a dynamic character does change over time as a result of the plot’s events. *Id.* Similarly, a round character has a complex personality featuring a range of emotions and thoughts to create depth, while a flat character has one basic and shallow type of personality. *Id.*

possible for the reader to imagine him or herself in the character's shoes."¹³ In other words, the more distinct, complex, and identifiable a character is, the greater opportunity it has to resonate with the general public.¹⁴

Characters in fictional stories are easy to identify, as they used to and continue to dominate all entertainment arenas. As one scholar explains, "A fictional character's unique identity can be imagined as occupying a position along a delineation continuum ranging from vague idea to well-defined individuality."¹⁵ A fictional character has a novel name, a unique physical and visual appearance, and distinctive mannerisms.¹⁶ Fictional characters exist in all media forms. Literary characters are brought to life by an author's use of descriptive words paired with the imagination of a reader—a common example is Harry Potter, "the boy who lived."¹⁷ Motion picture characters are brought to life by the words of a screenwriter and the mannerisms of an actor.¹⁸ For example, Elle Woods is a fictional character who is not associated inherently with Reese Witherspoon, the actor that portrays her, but instead is identifiable as a peppy, blonde sorority girl turned law student.¹⁹

After defining what a character is, it is important to understand what a character is not. A character is not a real-life person, for example, a historical or prominent figure in a biography or documentary. While this seems intuitive, it is necessary to state explicitly because of the ever-changing structure of our entertainment world.

The prominence of social media and new forms of reality-based entertainment have blurred the idea of what constitutes a character. Reality television celebrities often claim that they are not actors and are simply

¹³ Ginny Wiehart, *Learn About Round Characters in Fiction*, BALANCE, <https://www.thebalance.com/what-is-a-round-character-in-fiction-1277101> (last updated Nov. 12, 2017).

¹⁴ *Id.* Round characters are created by "employ[ing] a number of tools or elements . . . includ[ing] description and dialogue. A character's responses to conflict and his internal dialogue are also revelatory and create a multi-dimensional character." *Id.*

¹⁵ David B. Feldman, Comment, *Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection*, 78 CALIF. L. REV. 687, 690 (1990).

¹⁶ *See id.*

¹⁷ *See generally* J.K. ROWLING, HARRY POTTER AND THE SORCERER'S STONE (1998). While Harry Potter began as a literary character, he also was brought to life in film, giving the character an even more defined place in popular culture.

¹⁸ *See* Stephen Clark, *Of Mice, Men and Supermen: The Copyrightability of Graphic and Literary Characters*, 28 ST. LOUIS U. L.J. 959, 961 (1984) ("[P]ersonality traits and mannerisms . . . could be said to make up the characters underlying the graphics.").

¹⁹ *See generally* LEGALLY BLONDE (Metro-Goldwyn-Mayer July 13, 2001).

inviting viewers to observe their real-life behavior.²⁰ Under this classification, they would not be characters. However, due to producer manipulation and a desire for fame, many of these stars create their own persona, an intermediary between a real person and a character.²¹ Constructive personas became particularly clear when the cast of *The Hills* revealed how the fights, romance, and overall conversations were all fake and heavily scripted.²² Although Lauren Conrad, Heidi Montag, Audrina Patridge, and the rest of the cast appeared to be real-world individuals, their television existence was nothing more than “a constructed persona—in effect, a character.”²³

Constructing personas helps reality stars, social media influencers, and A-list celebrities to improve their brands and target specific audiences to increase likeability.²⁴ A persona is defined as “an individual’s social facade or front that . . . reflects the role in life the individual is playing.”²⁵ Similar to reality stars’ personas, actors who play recurring roles, although not true personas, create confusion in the minds of viewers simply because the association between character and actor is hard to sever. When this occurs, the actor “become[s] ‘inextricably identified’ with the role.”²⁶ When an actor and a character are inextricably linked, controversy arises regarding legal rights and ownership.²⁷

²⁰ See Lindsay Korotkin, Note, *Finding Reality in the Right of Publicity*, 2013 CARDOZO L. REV. DE NOVO 268, 272 (2013).

²¹ See *id.* at 272–73.

²² See Was “*The Hills*” Fake? Lauren Conrad Weighs In, *supra* note 4. During the ten-year anniversary special, secrets from production were revealed, including that “MTV would predict what plot lines would go on, down to drama-filled stares across the room. Lauren called the scripts ‘super creepy.’” Neha Prakash, “*The Hills*”: 9 Secrets We Learned from the 10-Year Anniversary Special, “*That Was Then, This Is Now*,” TEEN VOGUE (Aug. 2, 2016, 10:05 PM), <http://www.teenvogue.com/story/the-hills-that-was-then-this-is-now-secrets>.

²³ See Korotkin, *supra* note 20, at 273 (emphasis omitted).

²⁴ See Scott Huntington, *Using Personas in Your Social Media Marketing*, CHI. NOW: SMALLBIZBLOG (Jan. 11, 2017, 12:25 PM), <http://www.chicagonow.com/small-biz-blog/2017/01/using-personas-in-your-social-media-marketing/>; see also John Brubaker, *Grow Your Brand by Creating an Alter Ego*, ENTREPRENEUR (Aug. 12, 2015), <https://www.entrepreneur.com/article/249456> (providing steps to develop your own alter ego, including determining why you want an alter ego, figuring out the personality of your alter ego, creating a distinct image, writing your alter ego’s origin story, picking a name, and being different from your own identity).

²⁵ *Persona*, MERRIAM-WEBSTER, <http://www.merriam-webster.com/dictionary/persona> (last visited Jan. 9, 2018).

²⁶ Daniel Margolis, Note, *Cheers to the Church Lady: Resolving the Conflict Between Copyright and the Right of Publicity*, 1996 ANN. SURV. AM. L. 627, 649 (1996).

²⁷ See *id.* at 630–31. This article highlighted, in part, how Dana Carvey was so inextricably linked to the Church Lady character that another actor would be unable to replace him, creating a severability problem and potential copyright claim. See *id.* This is similar to Stephen Colbert’s non-severable character due to his

B. What Is a Copyrightable Character?

A character's copyrightability can be placed on a spectrum, from an individual that is original and creative and guaranteed copyright protection, to an individual that is deemed a stock figure and tossed into the public domain.²⁸ Among the requirements for copyright are the elements of originality and fixation;²⁹ therefore, the more distinct the character is, the more likely it will receive copyright.

Fictional characters that are original can sometimes be "distinctly delineated" from the work as a whole.³⁰ This means they are "uniquely developed and novel in some way to be capable of copyright protection."³¹ Animated or pictorial characters are the most susceptible to this classification since they are brought to life through pictures rather than words or actions.³² Literary characters also have the ability to fall under this category, although it is more difficult because they are brought to life solely by words.³³ Because the literary descriptions conjure up different images in the minds of different readers, a character must be particularly distinct from the plot to be eligible for copyright.³⁴ Alternatively, a character in motion pictures can be distinct when

recurring persona on *The Colbert Report*, paired with the use of his real name and overall being. For a more in-depth discussion of both scenarios, see *infra* Part II.

²⁸ For a discussion about the public domain, see Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 966–67, 975–77 (1990) (explaining that the public domain includes work created before the copyright statutes were enacted, work covered in an expired copyright, and work unprotected from copyright such as facts or ideas).

²⁹ 17 U.S.C. § 102 (2012).

³⁰ See Eric Lee, Note, *Titan Sports, Inc. v. Hellwig: Wrestling with the Distinction Between Character and Performer*, 3 TUL. J. TECH. & INTELL. PROP. 155, 157 (2001).

³¹ *Id.* (citing *Titan Sports, Inc. v. Turner Broad. Sys., Inc.*, 981 F. Supp. 65, 68 (D. Conn. 1997)).

³² See generally *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958, 962 (9th Cir. 2011) (recognizing Betty Boop as a separate character copyright from the works in which she is featured); *Warner Bros. v. Am. Broad. Cos.*, 720 F.2d 231, 241 (2d Cir. 1983) (considering a character's physical attributes as well as his attributes and traits in deciding whether the character is protectable); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 754–55 (9th Cir. 1978) (holding that defendant infringed upon plaintiff's copyrights in the graphic images).

³³ See Zahr K. Said, *Fixing Copyright in Characters: Literary Perspectives on a Legal Problem*, 35 CARDOZO L. REV. 769, 770–72 (2013); 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, 368–69 (2006).

³⁴ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d. Cir 1930) (explaining that literary characters that are distinct can be copyrighted, using Shakespeare's *Twelfth Night* characters as an example); *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 519 F. Supp. 388, 391 (S.D.N.Y. 1981) (holding that the character Tarzan from the story *Tarzan of the Apes* was independently copyrightable from the work as a whole); see also Said, *supra* note 33, at 770–72; Zecevic, *supra* note 33, at 368–69.

the mannerisms, intonation, and overall characterization are severable from the actor.³⁵

If a character meets the distinctive prerequisite, it can be protectable under copyright laws. Copyright law protects the tangible expression of an idea, not the idea itself.³⁶ The Copyright Act of 1976 (Copyright Act) provides a detailed framework for the rights that authors of original creative works are entitled to employ.³⁷ Among these entitlements, authors have “exclusive rights to reproduce, distribute, display, and perform their work, as well as the right to make derivative works from their original.”³⁸

Because the purpose of copyright law is to promote creativity and artistic progress,³⁹ a character is only eligible for a valid copyright if it is independently distinct from the entire work as a protectable expressive element.⁴⁰ Characters can obtain a copyright independent of the work as a whole if the character can satisfy one of two main tests: (1) the “distinctive delineation test” or (2) the “constitutes the story being told test.”⁴¹

The first of these tests, the distinctive-delineation analysis, was derived by the Court of Appeals for the Second Circuit in *Nichols v. Universal Pictures Corp.*,⁴² a copyright infringement case. The court was tasked with determining, in part, whether the defendant infringed upon the plaintiff’s characterization of a Jewish woman and an Irish man’s romantic relationship.⁴³ Ultimately, Judge Learned Hand wrote the majority opinion stating, “It follows that the less developed the characters, the less they can be copyrighted; that is the penalty

³⁵ See *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431, at *6-7 (C.D. Cal. Apr. 25, 1989) (holding that the *Rocky* characters were so highly developed that they earned copyright protection); see also Benjamin A. Goldberger, *How the “Summer of the Spinoff” Came to Be: The Branding of Characters in American Mass Media*, 23 LOY. L.A. ENT. L. REV. 301 (2003).

³⁶ 17 U.S.C. § 102 (2012) (examining portability and profitability of fictional characters and how reusing characters impacts protection standards and business strategies for entertainment conglomerates).

³⁷ *Id.* §§ 101-805.

³⁸ Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 202 (2002) (citing 17 U.S.C. §§ 102, 106).

³⁹ U.S. CONST. art. I, § 8, cl. 8; see also JULIE E. COHEN ET AL., COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 3, 6 (4th ed. 2015).

⁴⁰ See J. Matthew Sharp, Note, *The Reality of Reality Television: Understanding the Unique Nature of the Reality Genre in Copyright Infringement Cases*, 8 VAND. J. ENT. & TECH. L. 177, 181 (2005).

⁴¹ *Said*, *supra* note 33, at 785 (first citing *Warner Bros. Pictures v. Columbia Broad. Sys., Inc.*, 216 F.2d 945, 950 (9th Cir. 1954); then citing *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930)).

⁴² 45 F.2d 119 (2d Cir. 1930). The two plays that the court analyzed for infringement were the plaintiff’s *Abie’s Irish Rose* and the defendant’s *The Cohens and the Kellys*. *Id.* Both stories revolved around a Jewish family and an Irish family with star-crossed lovers. *Id.* However, one was a comedy and the other was a drama. *Id.*

⁴³ *Id.* at 121.

an author must bear for marking them too indistinctly.”⁴⁴ The court held that the competing stories were different as to incident and character, and any similarities between the two stories were solely based on ideas rather than expressions; therefore, there was no copyright infringement.⁴⁵

The second alternative test that courts use, the “constitutes the story being told” analysis, originated in *Warner Bros. Pictures v. Columbia Broadcasting System, Inc.*,⁴⁶ which involved a copyright assignment dispute related to the original author’s character usage in subsequent works. In granting the author the right to use the characters, the court explained, “It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright.”⁴⁷ Because the characters were essential to tell the story, they were not included with the sale of the story.⁴⁸ Essentially, the characters were classified as distinct entities from the overarching story, which allowed for the characters’ independence and continued use in subsequent works.

The “constitutes the story being told” analysis was expanded to include the protection of not only literary characters, but also cartoon characters in *Walt Disney Productions v. Air Pirates*.⁴⁹ The court held that Disney cartoon characters warranted copyright protection because they are clear images “which [have] physical as well as conceptual qualities, [and are] more likely to contain some unique elements of expression.”⁵⁰ In effect, this result could be interpreted as limiting the language and reasoning in *Warner Bros. Pictures* because the cartoon characters were protected regardless of whether they “constitute the story being told.”⁵¹ Articulating the appropriate test regarding severability and protectability impacts the way that a court decides its outcome.

⁴⁴ *Id.*

⁴⁵ *Id.*

⁴⁶ 216 F.2d 945 (9th Cir. 1954). This case involved the copyright in “a mystery-detective story” called *The Maltese Falcon*. *Id.* The facts regarding the assignment are beyond the scope of this Comment; therefore, the discussion of the case will be limited to the copyrightability of the characters.

⁴⁷ *Id.* at 950.

⁴⁸ *See id.*

⁴⁹ 581 F.2d 751 (9th Cir. 1978).

⁵⁰ *Id.* at 755.

⁵¹ *Id.* (internal quotation marks omitted); *see also* *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431, at *6 (C.D. Cal. Apr. 25, 1989).

These tests apply to literary and pictorial characters and their transferability in media,⁵² but the tests can also apply to original characters in cinema. Although not binding authority, the District Court for the Central District of California in *Anderson v. Stallone* analyzed whether the *Rocky* characters could be utilized in derivative cinematic works.⁵³ The court noted that the trilogy did not involve intricate plots and was mainly a character-driven experience.⁵⁴ Furthermore, the characters “were so highly developed and central” to the story that they independently qualified for copyright protection under both the “distinctive delineation” and the “constitutes the story being told” tests.⁵⁵

There are different thresholds depending on the artistic medium in which a character originates. Therefore, courts specifically tend to focus on the preliminary questions: “First, whether the character can be fixed in a tangible medium of expression; and second, whether the character is considered a ‘work of authorship.’”⁵⁶ Then they apply the pertinent test to determine character copyrightability.

The importance of obtaining a viable copyright in a character is especially relevant when understanding the value of derivative works. Section 106(2) of the Copyright Act⁵⁷ grants copyright holders the exclusive right to create derivative works, “including translations, musical arrangements, dramatizations, motion picture adaptations, sound recordings, and other forms ‘in which a work may be recast, transformed, or adapted.’”⁵⁸ The value in a character copyright increases substantially with this exclusive right because the copyright owner has the ability to control future use, the exclusivity to license out the character or to sue for its infringement, and the chance to profit from merchandising opportunities.⁵⁹

Because these exclusive rights are valuable to the copyright owner, the entity funding the development of a character will seek all legal ownership.

⁵² See Said, *supra* note 33, at 785–86.

⁵³ 1989 WL 206431, at *6.

⁵⁴ *Id.* at *8.

⁵⁵ *Id.* at *7–8.

⁵⁶ Margolis, *supra* note 26, at 639 (footnote omitted) (first citing 17 U.S.C. § 101 (1995); then quoting 17 U.S.C. § 102 (1995)). This article went on to explain that motion picture characters are considered an appropriate copyright subject matter because the culmination of work from all different sources is sufficiently qualified as an original work of authorship. *Id.* at 640.

⁵⁷ 17 U.S.C. § 106(2) (2012).

⁵⁸ Rothman, *supra* note 38, at 209 n.31 (quoting 17 U.S.C. § 101 (2002)).

⁵⁹ See Margolis, *supra* note 26, at 637–38; see also Rothman, *supra* note 38, at 210; Feldman, *supra* note 15, at 687–88.

Traditionally, an actor depicting a character or an individual constructing a persona does not have copyright over the character that he portrays due to the “work made for hire” doctrine,⁶⁰ which relinquishes control of a character to the financial entity supporting the production.⁶¹ Unless there is the potential for joint authorship between an actor and a studio, the studio will likely own the copyright via contract.⁶² These contractual limitations affect an actor’s capacity to benefit from a character whose copyright is vested with a studio. Studio ownership means that an actor who is linked to a character cannot continue to use it in subsequent productions. Because some characters are not impactful without the actor’s personification, a loophole is required to salvage characters from rotting on archive shelves.

C. *Limitations on Copyright Protection for a Character*

Although copyright holders hope that their copyright protection is unwavering, a loophole exists that could relinquish some control of inextricably linked persona–characters. The expression of an idea is protectable under copyright law,⁶³ but what happens when copyright is not applicable to a particular character? There is “a corollary maxim that even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.”⁶⁴ This is better known as the merger doctrine.

The merger doctrine balances the competing interests of promoting creative expression with the public interest in the free flow of information and ideas.⁶⁵ Merger arguments arise frequently as a copyright infringement defense and, if successful, ultimately rescind copyright protection.⁶⁶ However, courts

⁶⁰ See 17 U.S.C. § 101 (2012) (defining the “work made for hire” doctrine). For a more detailed analysis of the doctrine, see *infra* Section IV.B.

⁶¹ Margolis, *supra* note 26, at 643 (“[W]hen a character is not written for a specific actor and would not change dramatically if the actor were replaced, the actor’s contribution does not deserve copyright protection as a work of authorship.”).

⁶² *Id.* For further discussion about joint authorship, see *infra* Section IV.A.

⁶³ 17 U.S.C. § 102.

⁶⁴ *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991).

⁶⁵ *Veck v. S. Bldg. Code Cong. Int’l, Inc.*, 293 F. 3d 791, 802 (5th Cir. 2002).

⁶⁶ See Scott Abrahamson, Comment, *Seen One, Seen Them All? Making Sense of the Copyright Merger Doctrine*, 45 UCLA L. REV. 1125, 1126–27 (1998). In a copyright infringement case, a copyright holder must show proof of a valid copyright and demonstrate infringement of protected elements. *Sony Pictures Entm’t, Inc. v. Fireworks Entm’t Grp., Inc.*, 156 F. Supp. 2d 1148, 1155–56 (C.D. Cal. 2001) (“In other words, it is only copying of *copyrightable* elements of a plaintiff’s work that is answerable under the federal Copyright Act.”). Infringement requires a showing of at least substantial similarity, which “refers to similarity of

differ regarding the consequence of a successful merger argument—some believe that the copyright as to that particular element is invalid while others say there is no copyright at all.⁶⁷ Other courts treat merger as an affirmative defense, allowing that particular defendant to use that expression, but not finding the work as a whole ineligible for copyright.⁶⁸

Because of the potential severity of the consequences of using the merger doctrine, courts are apprehensive to apply the doctrine unless a defendant's showing of merger is obvious.⁶⁹ Typically courts look at the similarities between a plaintiff's and defendant's work to determine, somewhat arbitrarily, whether the idea and expression are so intertwined as to make the defendant's work not a copy, but rather a use of a generic concept.⁷⁰ To differentiate between an idea and an expression, one scholar explained:

An idea is a thought, a mental conception or image. When "expression" is an abstraction, it is of the same nature as an idea. The difference is one of degree, not of type. In this area, copyrights approach "what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtle and refined, and, sometimes, almost evanescent."⁷¹

Because the line between idea and expression is amorphous, merger should be used sparingly but appropriately. Although copyright promotes creativity, merger is necessary to allow individuals to use expressions that otherwise have limited means of display.⁷² This concept is comparable to *scènes à faire*, in

expression, not merely similarity of ideas or concepts." *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398 (9th Cir. 1997); *see also* 17 U.S.C. § 102(b).

⁶⁷ *Bateman v. Mnemonics, Inc.* 79 F.3d 1532, 1546 n.28 (11th Cir. 1996) ("Compatibility and other functionality challenges to originality . . . are applied so as to deny copyright protection to a particular work or portion of a work." (emphasis added)); *see also* COHEN ET AL., *supra* note 39, at 96–97.

⁶⁸ COHEN ET AL., *supra* note 39, at 96–97. This Comment will focus on using the merger doctrine in its capacity as an affirmative defense to accomplish the favorable policies of allowing actors to use the characters they invest in and allowing studios to profit from the characters' continued use.

⁶⁹ *See* Abrahamson, *supra* note 66, at 1146.

⁷⁰ *See id.* at 1134 ("[A]pplication of the doctrine of an idea merging with its expression depend[ed] on the level of abstraction at which the idea is formulated." (second alteration in original) (quoting *Kregos v. Associated Press*, 937 F.2d 700, 707 (2d Cir. 1991))). The article explains how the abstraction test was formulated in *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), to describe the difficulty in finding the line between idea and expression. Abrahamson, *supra* note 66, at 1134.

⁷¹ Leslie A. Kurtz, *Copyright: The Scenes a Faire Doctrine*, 41 FLA. L. REV. 79, 85 (1989) (footnote omitted) (first citing WEBSTER'S NEW TWENTIETH CENTURY DICTIONARY OF THE ENGLISH LANGUAGE UNABRIDGED 901 (2d ed.1983); then quoting *Folsom v. Marsh*, 9 F. Cas. 342, 344 (C.C.D. Mass. 1841)).

⁷² *See* Leslie A. Kurtz, *Speaking to the Ghost: Idea and Expression in Copyright*, 47 U. MIAMI L. REV. 1221, 1223 (1993); Said, *supra* note 33, at 782 ("[I]f a particular work consists of expression that would otherwise be protected, the merger doctrine prevents its copyrightability if the expression is one of a very

which generic elements and details of a scene are not protectable under copyright law.⁷³ Two types of *scènes à faire* are recognized by courts today: (1) scenes that must be included to depict specific situations and (2) scenes that are standard or stock.⁷⁴

The doctrine of *scènes à faire* seeks to promote artistic expression by allowing these generic devices to be used in new original works. A line of cases from the District Court for the Southern District of New York helps illustrate this concept. First, in *Hogan v. DC Comics*, the court compared the plaintiff's unpublished comic book with the defendant's painted novel, both featuring the struggles of a half-vampire, half-human protagonist.⁷⁵ The court found that most of the similarities rendered the ideas and themes unprotected.⁷⁶ Second, in 2011, the court decided *DiTocco v. Riordan*, a case in which the plaintiff and defendant both crafted stories around a quest to get Zeus his signature lightning bolt.⁷⁷ Here, the court noted that the threshold for substantial similarity is high for character traits and held that while the characters in the two stories had similar qualities, the similarities were not copyrightable.⁷⁸ Furthermore, the court noted that Zeus and other mythology-based characters are stock figures in many cultures and need to be available to the general public.⁷⁹ These cases illustrate a roadblock in copyright protection for creative tools.

Scènes à faire does not just guarantee that general themes are publicly available, but also ensures that universal archetypes for characters are accessible.⁸⁰ However, merger is not as broad as *scènes à faire*. Depending on

limited number of ways an idea may be expressed." (citing *Lotus Dev. Corp. v. Paperback Software Int'l*, 740 F. Supp. 37, 58–59 (D. Mass. 1990)).

⁷³ See Kurtz, *supra* note 71, at 80.

⁷⁴ See *id.* at 81; see also *Alexander v. Haley*, 460 F. Supp. 40, 45 (S.D.N.Y. 1978) (defining *scènes à faire* as "incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic").

⁷⁵ 48 F. Supp. 2d 298 (S.D.N.Y. 1999).

⁷⁶ *Id.* at 309–10 ("[I]n comparing two works a court must determine 'whether the similarities shared by the works are something more than mere generalized idea[s] or themes.' The works must share a similarity of expression, such as 'similarities of treatment, details, scenes, events, and characterization,' or a similarity in their 'total concept and feel.'" (second alteration in original) (citations omitted) (first quoting *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48–49 (2d Cir. 1986); then quoting *Reyher v. Children's Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976); and then quoting *Williams v. Crichton*, 84 F.3d 581, 589 (2d Cir. 1996)).

⁷⁷ 815 F. Supp. 2d 655 (S.D.N.Y. 2011).

⁷⁸ *Id.* at 668 ("These stock characters are not copyrightable: heroes frequently have sidekicks, and teenage boys frequently pursue girls of the blond, popular, and athletic variety. In any event, these sidekicks and love interests bear scant resemblance to their counterparts.").

⁷⁹ *Id.* at 669.

⁸⁰ Said, *supra* note 33, at 782; see also Kurtz, *supra* note 71, at 81.

the court's interpretation of merger, the court can either toss characters to the public⁸¹ (along the lines of *scènes à faire*) or it can deem certain characteristics uncopyrightable.⁸² Simply speaking, generic characters are placed into the public domain and may be manipulated for the common benefit, facilitating more artistic, imaginative works. A classic example involves the use of the "ditzzy blonde" as a generic archetype that evolves into iconic and distinctive characters such as Elle Woods,⁸³ Cher Horowitz,⁸⁴ or Phoebe Buffay.⁸⁵

Courts are responsible for drawing the line between what constitutes an idea and what constitutes an expression.⁸⁶ There are several tests that courts can employ to determine whether elements are generic expressions or original expressions, namely the abstraction test,⁸⁷ the pattern test,⁸⁸ the dissection test,⁸⁹ and the "total concept and feel" test.⁹⁰ The outcomes will inevitably vary

⁸¹ *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 36 (1st Cir. 2001) (explaining that the merger doctrine prevented Yankee Candle from holding copyright in its labels; therefore, competitors were free to use the same subject matter on its labels).

⁸² *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 836 (10th Cir. 1993) ("In order to effectuate the purposes behind the copyright laws, it is also appropriate to apply the doctrines of merger and *scenes a faire* to filter out unprotectable elements.").

⁸³ See generally LEGALLY BLONDE, *supra* note 19.

⁸⁴ See generally CLUELESS (Paramount Pictures July 19, 1995).

⁸⁵ See generally *Friends* (Warner Bros. Television 1994–2004).

⁸⁶ See Said, *supra* note 33, at 785.

⁸⁷ Sharp, *supra* note 40, at 184 ("The abstraction test states that the television show should be broken apart into increasingly general levels of abstraction." (citing *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930))); see also Said, *supra* note 33, at 785 (first citing *Warner Bros. Pictures v. Columbia Broad. Sys., Inc.*, 216 F.2d 945, 949 (9th Cir. 1954); then citing *Nichols*, 45 F.2d at 121) (highlighting the cases that developed the character copyright tests).

⁸⁸ Sharp, *supra* note 40, at 185 ("The pattern test seeks to divide the show into a list of expressive elements. From those elements, a pattern is discerned. Any show where this pattern is too similar to another will have infringed upon the expression of the original show." (footnotes omitted)).

⁸⁹ *Id.* ("The dissection test seeks to separate the protected from the unprotected elements, the expression from the idea. There can only be infringement where the protected elements have been copied." (footnotes omitted)).

⁹⁰ *Id.* at 185–86 ("The total concept and feel test does not seek to distinguish between protected and unprotected elements. Rather, it looks at both the underlying idea and the manner in which that idea is expressed to determine if one show is substantially similar to another." (footnotes omitted)). See generally *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 902 (9th Cir. 1987) (looking intrinsically through the perception of children, the court held that a reasonable observer would not infer that the defendant's dolls captured the total concept and feel of the plaintiff's designs); *Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984) (holding that the movie *E.T. the Extra-Terrestrial* did not infringe upon the musical play *Lokey from Maldemar* because there was no substantial similarity between the protectable elements of the works); *Warner Bros. v. Am. Broad. Cos.*, 720 F.2d 231, 241 (2d Cir. 1983) ("In determining whether a character in a second work infringes a cartoon character, courts have generally considered not only the visual resemblance but also the totality of the characters' attributes and traits."); *Jason v. Fonda*, 526 F. Supp. 774, 776–77 (C.D. Cal. 1981) (holding that although the book and the motion picture have similar themes, there are substantial deviations regarding the idea developments in both works so the total concept and feel of the works are substantially dissimilar).

depending on which test is used. The “total concept and feel” test is applied most often for merger issues because the idea and expression are analyzed as interrelated concepts.⁹¹ Merger should be a constant consideration when assessing whether an expression is actually protectable.

D. The Right of Publicity

In situations that are similar to Stephen Colbert’s—when an actor’s name, ideas, and physical appearance are the same as those of the character he represented—the character and actor become inextricably linked. When this happens, the copyrightable character is associated with the individual actor rather than as just a mere character. At this point, when the connection is not neatly severable, the right-of-publicity doctrine—which sounds in tort rather than copyright—comes to the forefront, acting as another potential limitation to perpetuate the use of a character.

While copyright law protects inventive expressions and is federally recognized, the right of publicity aims to protect the individual behind the character and is a state law tort that varies among jurisdictions.⁹² Because the right is not federally recognized, courts determine case outcomes through state statutes and common law precedent, leading to inconsistent and unpredictable judgments.⁹³ Generally the right permits an individual to prohibit others from using his name, likeness, persona, or voice for commercial purposes.⁹⁴ To take advantage of the right of publicity, at least one of the following types of misappropriation must be satisfied: “1) appropriation of one’s name or likeness for advertising or endorsement; 2) unauthorized use of one’s name or likeness on commercial products; 3) appropriation of one’s unique style or characteristics; and 4) appropriation of one’s performance.”⁹⁵ Although this right can apply to any person, celebrities frequently contest it because they

⁹¹ See *Aliotti*, 831 F.2d at 901–02; *Litchfield*, 736 F.2d at 1357; *Warner Bros.*, 720 F. 2d at 241; *Jason*, 526 F. Supp. at 776–77.

⁹² Rothman, *supra* note 38, at 202.

⁹³ Kenneth E. Spahn, *The Right of Publicity: A Matter of Privacy, Property, or Public Domain?*, 19 NOVA L. REV. 1013, 1015, 1017 (1995).

⁹⁴ Rothman, *supra* note 38, at 202 (first citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 1995); then citing 2 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 3.1 (2d ed. 2000)); see also *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (holding that Johnny Carson’s “Here’s Johnny” catchphrase was identifiable enough to cause his right of publicity to be infringed upon when it was used as a slogan for portable toilets, which established that a celebrity’s right of publicity can be infringed even if the celebrity’s name or likeness is not used).

⁹⁵ Spahn, *supra* note 93, at 1016.

have significant profits to lose if anyone can commercially exploit their likeness.⁹⁶

In recognizing this right and the privacy interest at stake, there is the potential that the right of publicity can supersede copyright, which can create significant problems in intellectual property law.⁹⁷ These problems manifest when an actor asserts right-of-publicity control over a copyrightable character that is also inextricably linked to the actor's personal identity, as best illustrated by two seminal cases, *Lugosi v. Universal Pictures*⁹⁸ and *McFarland v. Miller*.⁹⁹

In *Lugosi*, the heirs of the famous actor Bela Lugosi—who acted as the most emulated portrayal of Dracula—sued Universal Pictures for using his characteristics and likeness as Count Dracula in subsequent merchandising opportunities.¹⁰⁰ Although this case has since been superseded by California statute, the California Supreme Court's debate still remains relevant:

Justice Mosk opined that an actor may only possess a proprietary interest in an “original creation” played by its “creator,” as opposed to Chief Justice Bird's assertion that the right of publicity should extend to appropriations of the actor's likeness in his or her portrayal of a fictional character because the portrayals of the characters “may well be considerably more important than protection for the individual's ‘natural’ appearance.”¹⁰¹

Lugosi stands as a testament to the many ways that the right of publicity can be interpreted, namely as a property right, privacy right, work product, or copyright.¹⁰²

While the value of a fictional character was addressed in *Lugosi*, the value of a persona was recognized in *McFarland v. Miller*,¹⁰³ a seminal development

⁹⁶ See Rothman, *supra* note 38, at 202–04.

⁹⁷ Peter K. Yu, Note, *Fictional Persona Test: Copyright Preemption in Human Audiovisual Characters*, 20 CARDOZO L. REV. 355, 366–67 (1998) (discussing fictional personas and human personas and whether they are protected under the Copyright Act or the right of publicity). The problem of copyright preemption over the right to publicity is beyond the scope of this Comment and involves an analysis of the Supremacy Clause of the United States Constitution. For background on the Supremacy Clause, see generally U.S. CONST. art. VI, cl. 2.

⁹⁸ 603 P.2d 425 (Cal. 1979).

⁹⁹ 14 F.3d 912 (3d Cir. 1994).

¹⁰⁰ 603 P.2d at 427.

¹⁰¹ Angela D. Cook, Note, *Should Right of Publicity Protection Be Extended to Actors in the Characters Which They Portray*, 9 DEPAUL-LCA J. ART & ENT. L. 309, 317 n.34 (1999) (citations omitted) (first quoting *Lugosi*, 603 P.2d at 431 (Mosk, J., concurring); then quoting *id.* at 445 (Bird, J., dissenting)).

¹⁰² For an in-depth explanation on each of these proposals, see Spahn, *supra* note 93, at 1022–27.

in right-of-publicity jurisprudence. In *McFarland*, a restaurant owner was sued for naming his restaurant after a character named “Spanky” in the television show *Our Gang* (later known as the *Little Rascals*).¹⁰⁴ Not only did the restaurant owner name the restaurant “Spanky McFarland’s,” but he also displayed memorabilia from the series, perpetuating the unauthorized use of the character.¹⁰⁵ Although the initial contract between the actor and the studio relinquished the actor’s control over everything but the name of the character, the Court of Appeals for the Third Circuit held that a material issue of fact existed over who had the right to the character based on the associational element.¹⁰⁶ The court reasoned that while originality plays a role, “[w]here an actor’s screen persona becomes so associated with him that it becomes inseparable from the actor’s own public image, the actor obtains an interest in the image which gives him standing to prevent mere interlopers from using it without authority.”¹⁰⁷

Characters overlap with the actors who develop them at a more frequent pace in the present entertainment industry, allowing for more right-of-publicity cases to potentially arise. The goal of bringing these issues to light is to protect the actor’s investment in a character from whom they are entitled to profit.¹⁰⁸ While right-of-publicity jurisprudence is somewhat unpredictable, it is useful to recognize how associational rights could impact character copyright disputes.

II. THE TENSION BETWEEN COPYRIGHT AND RIGHT OF PUBLICITY IN CHARACTER PROTECTION AND WAYS TO FILL THE GAP

Characters continue to evolve throughout entertainment history, leading to the occasional overlap of copyright and the right of publicity and creating tension about which doctrine controls disputes. Gap-filling measures can help ease this tension. Utilizing the competing legal doctrines that govern characters in the entertainment industry, this Part places characters and expressions on a spectrum to demonstrate how copyright protection changes as associations advance. It seeks to explain what happens when the line is blurred and the character is no longer distinct from the actor bringing him to life. This Part

¹⁰³ 14 F.3d 912 (3d Cir. 1994).

¹⁰⁴ *Id.* at 914.

¹⁰⁵ *Id.* at 916.

¹⁰⁶ *See id.* at 921.

¹⁰⁷ *Id.* at 920.

¹⁰⁸ This Comment mostly refers to copyright’s role in the character spectrum, but for an in-depth understanding of the right to publicity’s role in the spectrum, see Cook, *supra* note 101, at 315–17, 317 n.34.

suggests that when the overlap occurs, the merger doctrine can fill the legal gap to allow the characters to continue to be used by their living counterparts.

A. The Character Spectrum and the Rights Associated with Persona Protection

Characters are more fluid now than ever. On one end of the character spectrum lies the fully copyrightable character that is guaranteed full protection under federal law.¹⁰⁹ At the opposite end of the character spectrum, there is the living, breathing person who exists onscreen in biographies or documentaries, appearing in his individual capacity, undisputedly not as a character.¹¹⁰ In the second situation, the character takes on more of a news, rather than entertainment, value.¹¹¹ The gray area exists in the middle of the spectrum where typecast characters, reality-star constructed personas, and characters inextricably linked to actors dominate entertainment channels. The gray area is particularly important to focus on because no clear solution currently exists that allows both the studio and the actor to benefit.

Traditionally, copyright law protects characters; however, when the association reaches the middle ground, as discussed above, the law is unclear as to when the actor can gain right-of-publicity access to the character.¹¹² “At its heart, the value of the right of publicity is associational. People link the person with the items the person endorses and, if that person is famous, that link has value.”¹¹³ Because of this link, the courts appear to recognize persona rights: “Under current right of publicity precedents, an individual actor, athlete, or singer can sue the owner of a restaurant, bar, or store that shows her performance for a violation of her right of publicity with a good chance of prevailing.”¹¹⁴

¹⁰⁹ See *supra* Section I.B.

¹¹⁰ See Ryan Westerman, Comment, *As Seen on TV: Your Compromising Cameo on National Reality Programming*, 12 J. MARSHALL REV. INTELL. PROP. L. 403, 412–13 (2013).

¹¹¹ See *id.* (highlighting the case *Best v. Berard*, 776 F. Supp. 2d 752 (N.D. Ill. 2011), which explains that a person who was pulled over and recorded for a TV series was not entitled to protection due to the newsworthiness of the appearance).

¹¹² See *supra* Section I.D.

¹¹³ *McFarland v. Miller*, 14 F.3d 912, 919 (3d Cir. 1994) (holding that there was a genuine issue of material fact as to whether the actor was so inextricably linked with the character as to warrant right-of-publicity protection).

¹¹⁴ Rothman, *supra* note 38, at 217; see also *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (holding that robots modeled after the actors' characters presented material issues of fact with regard to the right of publicity); *McFarland*, 14 F.3d at 914 (holding that the right of publicity extended to a character who was inextricably linked to the actor); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir.

Certain states allow the coverage of personas under the right of publicity, which protects the idea of a person.¹¹⁵ If this view of persona is accepted, then allowing protection “contravenes the Copyright Act’s explicit grant of ideas to the public.”¹¹⁶ But, a persona can also be a performance and character creation, as indicated by the admissions of reality television celebrities.¹¹⁷ This classification could change the remedies available to the actor, further blurring the line between which intellectual property doctrine applies.

Classification along this spectrum is important because the individual and the character differ in regard to the types of protections each may receive.¹¹⁸ The Court of Appeals for the Ninth Circuit began to analyze the overlap in intellectual property doctrines in the case *Wendt v. Host International, Inc.*¹¹⁹ John Ratzenberger and George Wendt, the actors behind the iconic *Cheers* characters Cliff Clavin and Norm Peterson, respectively, sued Host International for opening up a chain of airport bars that featured animatronic robots based on the characters.¹²⁰ The animatronics were considered a derivative work of the original copyright, which traditionally would be at the discretion of the copyright holder.¹²¹ However, the court held that there was a likelihood of confusion between the characters and the animatronic robots because the robots embodied the persona of the characters.¹²² Based on this decision, the court established a precedent that actors who are heavily identified with their characters potentially have rights that supersede copyright.¹²³

1983) (holding that Johnny Carson’s right of publicity was affected when a port-a-potty company used “Here’s Johnny” as their slogan to take advantage of Carson’s recognition).

¹¹⁵ Rothman, *supra* note 38, at 223.

¹¹⁶ *Id.* at 224 (citing 17 U.S.C. § 102(b) (2002)).

¹¹⁷ *See Was “The Hills” Fake? Lauren Conrad Weighs In*, *supra* note 4; *supra* notes 20–23 and accompanying text.

¹¹⁸ *See Westerman*, *supra* note 112, at 412–13 (citing *Best v. Berard*, 776 F. Supp. 2d 752, 754 (N.D. Ill. 2011), in which the court ruled that the individual who was arrested and displayed on reality television without written consent was not entitled to protection because the public concern outweighs the individual’s right to publicity); *supra* Section I.B.

¹¹⁹ 125 F.3d 806 (9th Cir. 1997).

¹²⁰ *Id.* at 809.

¹²¹ *See* 17 U.S.C. §§ 102, 106 (2012); Rothman, *supra* note 38, at 210–11.

¹²² *Wendt*, 125 F.3d at 812–14; *see also* Rothman, *supra* note 38, at 211 (“[T]he Ninth Circuit’s holding in *Wendt* demonstrates the current legal view that right of publicity claims are not preempted by copyright law even when they prevent the creation of authorized derivative works.”).

¹²³ The Ninth Circuit’s holding caused some controversy amongst copyright scholars. *See* Rothman, *supra* note 38, at 202 (explaining that this decision could affect merchandising rights and creative potential for subsequent works).

Wendt presented that courts are willing to recognize persona protection for characters and actors. But what happens when the actor plays a substantial role in creating a character, so much so that the character can only be rightfully played by that one actor? Prior to Colbert's ordeal, Dana Carvey, a comedian and former *Saturday Night Live* (*SNL*) cast member, faced a similar problem with his character the "Church Lady."¹²⁴ In 1996, Carvey attempted to use the Church Lady on his prime-time comedy show.¹²⁵ NBC interfered and said that the Church Lady was its intellectual property and could not be played by Carvey outside of the network.¹²⁶ Choosing to relinquish control of the character, Carvey announced on his show that the Church Lady would be replaced by her gay nephew who is very similar—"I can play the relatives, but not the characters."¹²⁷

While this case was not litigated, it revealed the lack of protection for actors who help create a character and, under current precedent, are unable to continue using it personally. The Church Lady likely would not have been as big of a success or as identifiable of a character had it not been for Carvey's characterization. By denying the actor any right in the persona-character, a long-term problem relating to diminished incentive to create could arise if the rewards are minimal for substantial developmental investment.

Persona-character protection should be granted when the persona is an extension of the actor, such that they bear the same name, same mannerisms, and same look.¹²⁸ "When an actor plays himself or herself as a character, the character shares the actor's identity. Therefore, these situations present the strongest argument for right of publicity's extension to cases of character misappropriation."¹²⁹ This is where the largely unexplored territory lies—

¹²⁴ See Margolis, *supra* note 26, at 630; Catrina Dennis, "SNL": Watch Dana Carvey Return as Church Lady to Rant About Election: "Jesus Is Not on the Ballot," WRAP (Nov. 5, 2016, 10:36 PM), <http://www.thewrap.com/snl-watch-dana-carvey-return-church-lady-rant-election-jesus-not-ballot-video/>. The Church Lady made her debut in 1986 and was a regular character on the hit show until 1990. Dennis, *supra*. The character is an opinionated Catholic grandmother figure who preaches her conservative ways, utilizes distinct catchphrases, and breaks into song. *Id.* Carvey was the only actor to portray the character. *Id.* He continues to make random appearances in character on *SNL*. *Id.*

¹²⁵ Margolis, *supra* note 26, at 630; see also Associated Press, *Dana Carvey to Bring Out "Church Lady's" Kin*, TULSA WORLD (Mar. 4, 1996, 12:00 AM), http://www.tulsaworld.com/archives/dana-carvey-to-bring-out-church-lady-s-kin/article_79eadb24-7c7b-5384-8b7d-9e6dfbe14768.html (last updated Sept. 20, 2013, 12:10 AM).

¹²⁶ Margolis, *supra* note 26, at 630.

¹²⁷ Associated Press, *supra* note 125.

¹²⁸ Yu, *supra* note 97, at 408 (proposing a "fictional persona" test in which courts decide copyright preemption issues by assessing whether "an average lay observer can recognize from the audiovisual character a personality that is substantially different from the actor's human persona").

¹²⁹ Cook, *supra* note 101, at 315.

Stephen Colbert being the most recent example. Promoting artistic expression is a fundamental American value that should be encouraged, particularly when one particular actor is the only person who could do justice to a specific character.

B. Utilizing Merger to Fill the Spectrum's Gray Area

In complex cases in which the right of publicity and copyright overlap on the character spectrum, namely when persona–characters are represented, the most effective resolution to the conflict is to utilize merger in the personal affirmative defense context. Because copyright's overarching purpose is to promote creativity so authors can enrich the public with new works, the merger doctrine would allow a character, such as Stephen Colbert or the Church Lady, to be used by the actor in addition to the studio or network.¹³⁰ By focusing on the affirmative defense purpose of merger, a studio's interests can still be protected because its investment is safe from entering the public domain and the copyright's extension to the actor would be non-transferrable with a finite set of rights.

Copyright protection was once very clear: there had to be a literal copying of a copyrighted work for there to be an infringement.¹³¹ But, with the expansion of copyright, there is less room for subsequent authors to be inspired by predecessors.¹³² By arguing that the expression can take only a limited number of forms, actors that play characters in the gray area of the spectrum can argue merger to reclaim the persona–character for future personal use.¹³³ If the actor wins based on the affirmative defense, “there is no ‘monopoly over the unparticularized expression of an idea at such a level of abstraction or generality as unduly to inhibit independent creation by others.’”¹³⁴ For this defense to work appropriately, the “independent creation by others” should only extend to the one actor to ensure that studios do not lose all copyright and continue to invest in future creative works without the fear that any individual can claim a right to the expression.

Characters today take many different shapes and forms, exposing an issue that likely was not contemplated when the Copyright Act was adopted.¹³⁵ The

¹³⁰ See Kurtz, *supra* note 72, at 1223.

¹³¹ *Id.* at 1226.

¹³² *Id.* at 1227–28.

¹³³ *Id.* at 1233, 1243.

¹³⁴ *Id.* at 1243 (quoting *Gund, Inc. v. Smile Int'l, Inc.*, 691 F. Supp. 642, 644 (E.D.N.Y. 1988)).

¹³⁵ See *supra* Section I.A.

public's association between characters and actors overlaps frequently. If this occurs, then the idea and the expression would not be severable, and merger would force the copyright to be extended.¹³⁶ When a character and an actor conjure up the same image in the public's mind, the expression of the idea can only take that specific form.

For example, if Stephen Colbert's case had been litigated, he could have asserted merger as his personal affirmative defense. The idea (a satirical news anchor) and the expression of the idea (the character Stephen Colbert) can take limited forms because Stephen Colbert (the actor) is the only person who conjures up this character in the public's mind.¹³⁷ Although actors try to get around the studio's control by reinventing the character slightly,¹³⁸ merger is the best defense available to save, rather than archive, the original character. This solution would allow (1) the actor to benefit from his labor of developing a persona-character, (2) the studio to benefit from still holding the copyright, and (3) the public to benefit from continuing to hear new commentary on the current state of national and international affairs from a beloved character.

Another example of merger's necessity is based on the popularity of the Church Lady's cameos on *SNL*. In May 2016, she returned to *SNL* and garnered over 2.5 million views on YouTube,¹³⁹ and then reprised her role in November 2016 and earned over 1.5 million views on YouTube.¹⁴⁰ Not only does the large number of YouTube views explain her popularity, but the millions who tuned in to watch the sketches live also attest to her place in pop culture.¹⁴¹ Because Carvey is the only person who can properly convey this

¹³⁶ *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1st Cir. 1988) ("Some ideas admit of only a limited number of expressions. When there is essentially only one way to express an idea, the idea and its expression are inseparable and copyright is no bar to copying that expression. [Even w]hen the idea and its expression are not completely inseparable, there may still be only a limited number of ways of expressing the idea." (citations omitted)).

¹³⁷ See Brian Steinberg, *Viacom Wishes the Real Stephen Colbert Would Leave the Old Stephen Colbert Alone*, VARIETY (July 28, 2016, 10:22 AM), <http://variety.com/2016/tv/news/stephen-colbert-late-show-viacom-cbs-1201825647/>; see also Eriq Gardner, *Can Viacom Really Stop Stephen Colbert from Playing "Stephen Colbert?"*, HOLLYWOOD REP. (July 28, 2016, 12:40 PM), <http://www.hollywoodreporter.com/thresq/can-viacom-stop-stephen-colbert-915340>.

¹³⁸ Steinberg, *supra* note 137.

¹³⁹ Saturday Night Live, *Church Lady Cold Open – SNL*, YOUTUBE (May 8, 2016), <https://www.youtube.com/watch?v=YHyW0N5f7zQ>.

¹⁴⁰ Saturday Night Live, *Weekend Update: Church Lady on the Election – SNL*, YOUTUBE (Nov. 6, 2016), <https://www.youtube.com/watch?v=p5JK-en8kW8>.

¹⁴¹ Nellie Andreeva, *"Saturday Night Live" Ratings Stay Strong with Host Benedict Cumberbatch on Eve of Elections*, DEADLINE (Nov. 6, 2016, 10:35 AM), <http://deadline.com/2016/11/saturday-night-live-ratings-benedict-cumberbatch-1201849713/>.

character, by allowing the idea (an outspoken, devout church lady) to merge with the expression (Carvey's characterization of the Church Lady), the public benefits from the perpetuation of the character in entertainment.

Although these are just two examples of ways that a character and an actor can become inextricably linked, they emphasize why the merger doctrine needs to be utilized more in copyright law. This prescription would achieve three key goals. First, it allows studios to invest in characters without fear of giving up all control in litigious battles. This, in turn, establishes credibility for the studio's reputation by showing empathy toward its employees. Second, it allows actors to work without fear that their contributions will be undervalued, thereby establishing a more creative environment. Third, it allows the public to witness the continued existence of its favorite characters in the entertainment world. Essentially, everyone involved in the creative process benefits through promoting the limited-scope merger.

III. POSSIBLE OBJECTIONS TO USING THE MERGER DOCTRINE

While merger can be the solution to filling copyright's gap in persona-character protection, courts are hesitant to rely on the merger doctrine, fearing that excessive use will stifle creativity.¹⁴² This reluctance often results in courts relying on old solutions, namely joint authorship and work made for hire.¹⁴³ However, joint authorship and work made for hire require specificity that may fill only part of the gap.¹⁴⁴ This Part explores the objections and explains why merger is either better or necessary to protect personas.

A. *Joint Authorship to Allow for Equal Ownership*

Authorship is a copyright requirement that is used to establish who actually owns the copyrighted material with the ability to benefit from the property's commercial value.¹⁴⁵ "The Copyright Act recognizes three different types of

¹⁴² See Abrahamson, *supra* note 68, at 1147; *supra* Section I.C.

¹⁴³ See generally Abraham Bell & Gideon Parchomovsky, *Copyright Trust*, 100 CORNELL L. REV. 1015 (2015) (arguing that courts use a rigid system to determine authorship in collaborative works including joint authorship or work-made-for-hire doctrines).

¹⁴⁴ See 17 U.S.C. § 101 (2012) (describing the statutory requirements for work made for hire); *id.* § 106 (describing the default rules of joint authorship); see also Bell & Parchomovsky, *supra* note 143, at 1030 ("[E]very time a work results from multiple contributions that are not otherwise covered by the work-made-for-hire and joint authorship doctrines, the work is prima facie a collective work, covered by many copyrights, with only a limited copyright for the organizer." (citing § 101)).

¹⁴⁵ See 17 U.S.C. § 102; Teresa Huang, Note, *Gaiman v. McFarlane: The Right Step in Determining Joint Authorship for Copyrighted Material*, 20 BERKELEY TECH. L.J. 673, 675 (2005) (explaining that if joint authorship is achieved, it affords the authors equal rights in exploiting, copying, or licensing the work).

authorship: sole authorship, joint or co-authorship, and employer authorship”¹⁴⁶ Authorship belongs to anyone who was the originator of a work—the person who created the piece from its origin.¹⁴⁷ In the context of persona—characters, the important determination is whether joint authorship would apply in situations in which the actor contributed to a character enough to make the two inextricably linked.

The requirements for what qualifies as a joint authorship are highly contested. To begin with, the Copyright Act does not clearly define the threshold for joint authorship credit, solely choosing to define what constitutes a joint work—“a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”¹⁴⁸ The statutory language creates the following elements: “(1) [A] copyrightable work, (2) two or more ‘authors,’ and (3) the authors must intend their contributions be merged into inseparable or interdependent parts of a unitary whole.”¹⁴⁹ The disagreement regarding character copyrightability involves having the proper intent at the time of the work’s creation.¹⁵⁰

Having the requisite intent is a fact-intensive inquiry that can lead to inadvertent results. A classic example of joint authorship miscommunication was in *Aalmuhammed v. Lee*,¹⁵¹ when the Ninth Circuit analyzed several cases to determine criteria for joint-authorship intent.¹⁵² This case involved the

¹⁴⁶ COHEN, ET AL., *supra* note 39, at 137; see 17 U.S.C. § 201.

¹⁴⁷ See 17 U.S.C. § 201(a); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884) (“So, also, no one would now claim that the word writing in this clause of the Constitution, though the only word used as to subjects in regard to which authors are to be secured, is limited to the actual script of the author, and excludes books and all other printed matter.”); see also *Aalmuhammed v. Lee*, 202 F.3d 1227, 1233 (9th Cir. 2000) (“In a movie this definition, in the absence of a contract to the contrary, would generally limit authorship to someone at the top of the screen credits, sometimes the producer, sometimes the director, possibly the star, or the screenwriter—someone who has artistic control.”).

¹⁴⁸ 17 U.S.C. § 101; Huang, *supra* note 145, at 673.

¹⁴⁹ *Aalmuhammed*, 202 F.3d at 1231 (referring to 17 U.S.C. § 101).

¹⁵⁰ This Part assumes that the character met the standards listed in Section I.B. and qualifies for copyright. This Part focuses on intent because the debate over control, if litigated, would come down to this issue.

¹⁵¹ 202 F.3d 1227, 1234–35 (9th Cir. 2000).

¹⁵² *Id.*; see also *Thomson v. Larson*, 147 F.3d 195 (2d Cir. 1998) (holding that a contributing playwright for *Rent* was not considered a coauthor because the scriptwriter never manifested his intent for coauthorship); *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061 (7th Cir. 1994) (holding that the actors were unable to identify copyrightable contributions to the work and were not joint authors); *Childress v. Taylor*, 945 F.2d 500 (2d Cir. 1991) (rejecting joint authorship because the plaintiff’s contributions were based on facts and research which were not copyrightable material and she never intended to be a coauthor). See generally Huang, *supra* note 145, at 678–79, 678 n.35 (proving that these cases were based on Professor Goldstein’s copyrightability test, which highlights intention to coauthor and the contribution of separately copyrightable materials).

movie *Malcolm X* based on the novel *The Autobiography of Malcolm X*.¹⁵³ The plaintiff was asked to consult on the film because he had special knowledge regarding Muslim culture and Malcolm X himself.¹⁵⁴ He changed scenes and lines to make the production more accurate and wanted joint-authorship credit for his contributions.¹⁵⁵ The court denied joint-authorship credit due to the lack of intent, supported by the Ninth Circuit’s test that requires both parties “‘superintend[.]’ the work by exercising control” and make manifestations of their shared intent to be coauthors, and that “the audience appeal of the work turn[.] on both contributions and ‘the share of each in its success cannot be appraised.’”¹⁵⁶ Essentially, to be joint authors, both individuals need to be aware that their contributions are going toward a singular, copyrightable work at the beginning of the partnership.

If control and intent are the most important standards with which joint authorship is gauged, then characters would seemingly be an easy battle to win for the studio. This is largely because the studio would be the one that actually created the show and the characters. At its inception, an actor would not have had control of a character. While he may have intent to be a coauthor, it likely would not be shared intent.

But the decision in *Gaiman v. McFarlane*¹⁵⁷ changed the joint-authorship analysis. The defendant published a comic book series and later asked the plaintiff to write editions of the series without explicit mention of work made for hire.¹⁵⁸ The Court of Appeals for the Seventh Circuit modified existing law and held that coauthorship does not require that each contribution be copyrightable if intent to create a copyrightable end product existed.¹⁵⁹ Therefore, “the expression of the merged ideas of all the contributors in a fixed, tangible medium” is the protectable product.¹⁶⁰

¹⁵³ *Aalmuhammed*, 202 F.3d at 1229.

¹⁵⁴ *Id.*

¹⁵⁵ *Id.* at 1230.

¹⁵⁶ *Id.* at 1234 (footnote omitted) (first quoting *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 61 (1884); then citing *Thomas*, 147 F.3d at 202; and then quoting *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1994)) (noting that control is the most important factor).

¹⁵⁷ 360 F.3d 644 (7th Cir. 2004).

¹⁵⁸ *Id.* at 649–50.

¹⁵⁹ *Id.* at 661 (“Gaiman’s contribution may not have been copyrightable by itself, but his contribution had expressive content without which Cogliostro wouldn’t have been a character at all, but merely a drawing. The expressive work that is the comic-book character Count Nicholas Cogliostro was the joint work of Gaiman and McFarlane—their contributions strike us as quite equal—and both are entitled to ownership of the copyright.”).

¹⁶⁰ Huang, *supra* note 145, at 675. This thinking is largely based on the Nimmer approach to joint authorship, which requires that each author “make more than a ‘de minimis’ contribution to the resulting

Returning to persona–character protection, a joint-authorship claim could easily be available when the *Gaiman* approach is adopted. Whether the contributions of an actor were minimal (i.e., bringing the scripted words to life and permitting the use of his features) would not matter concerning ownership—an actor would have equal rights with a studio to use a character in derivative works because intent to create a copyrightable end product existed.¹⁶¹ However, reliance on the pre-*Gaiman* approach would mean that the script and the expression of the script would both need to be copyrightable materials and the actor would have needed to contribute at the character’s initial creation, not just in the performance phase.¹⁶² Clearly there is unpredictability in the application of joint-authorship standards.¹⁶³

Additionally, because joint authorship is a pre-creation consideration, no room exists to add a coauthor later in the character’s life span. This has implications that would exclude the possibility of persona–character protection. The inflexibility of the joint-authorship doctrine means that the merger doctrine’s affirmative defense is a better solution. Merger’s use would create flexibility in a fickle industry and prevent extensive litigation in the long run.

B. Work Made for Hire That Eliminates Any Potential Claim to Ownership

Perhaps the most common objection to increased reliance on the merger doctrine is that the actor is an employee of the studio and all work is work made for hire. However, even if the actor is a Hollywood heavyweight, the studio’s bargaining power substantially outweighs any actor’s power.¹⁶⁴ The entertainment industry is a business, with all parties seeking to make money. But work made for hire, although common practice, unfairly advantages the

copyrighted work.” *Id.* at 677 (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 6.07 (12th ed. 2004)). This is still the minority view regarding joint authorship, with most courts still favoring the copyrightability approach for its ease in application. Timothy J. McFarlin, *Father(s?) of Rock & Roll: Why the Johnnie Johnson v. Chuck Berry Songwriting Suit Should Change the Way Copyright Law Determines Joint Authorship*, 17 VAND. J. ENT. & TECH. L. 575, 589–91 (2015) (highlighting the “Childress” test and the “mastermind” test as the dominant judicial analyses).

¹⁶¹ See *Gaiman*, 360 F.3d at 661.

¹⁶² See *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231 (9th Cir. 2000).

¹⁶³ McFarlin, *supra* note 160, at 590.

¹⁶⁴ See Jen Chaney, *A Hollywood Agent Explains How Negotiations Work and Why Actresses Get Paid Less*, COSMOPOLITAN (Feb. 23, 2016), <http://www.cosmopolitan.com/entertainment/movies/a53911/hollywood-agent-pay-gap-interview/> (explaining how Hollywood negotiations work and how studios tend to control the conversations); see also Yu, *supra* note 97, at 395, n.252 (highlighting the criticism that work made for hire has incited amongst scholars).

studio, while the actor completes most of the heavy lifting by bringing audience appreciation for the character.¹⁶⁵

The Copyright Act defines “work made for hire” as either “work prepared by an employee within the scope of his or her employment” or “work specially ordered or commissioned for the use as a contribution to a collective work.”¹⁶⁶ To use the doctrine, the actor does not need to be a formal employee, but can also be a formal independent contractor.¹⁶⁷ Without a specific contractual provision, there is a presumption “that the mutual intent of the parties is that the title to the copyright shall be in the person at whose instance and expense the work is done.”¹⁶⁸ For the presumption to be invoked, there must be credible evidence that the work was done at the instance and expense of the commissioning party.¹⁶⁹ The instance test is used to determine “whether ‘the motivating factor in producing the work was the employer who induced the creation.’”¹⁷⁰

The impact of work made for hire on constructed personas and linked characters is best illustrated by the District Court for the District of Connecticut’s decision in *Titan Sports, Inc. v. Hellwig*.¹⁷¹ James Hellwig was a World Wrestling Entertainment superstar who later decided to join World Championship Wrestling instead and wanted to bring his former character with him.¹⁷² Prior to the move, Hellwig legally changed his name to Warrior, adding another dimension into the question of intellectual property ownership.¹⁷³ The overarching issue was whether the wrestling association, Titan, or the wrestler, Hellwig, owned the intellectual property rights associated with Hellwig’s character the “Ultimate Warrior.”¹⁷⁴

¹⁶⁵ Chaney, *supra* note 164.

¹⁶⁶ 17 U.S.C. § 101 (2012).

¹⁶⁷ *Gaiman v. McFarlane*, 360 F.3d 644, 650 (7th Cir. 2004). If the person does not qualify as a formal employee, work made for hire can be contracted for if “the commissioning party pays the author a monthly stipend, pays health and other fringe benefits during the time the author works on the project, and exercises overall though not necessarily daily supervision.” *Id.*

¹⁶⁸ *Dolman v. Agee*, 157 F.3d 708, 712 (9th Cir. 1998) (quoting *Lin-Brook Builders Hardware v. Gertler*, 352 F.2d 298, 300 (9th Cir. 1965)).

¹⁶⁹ See *Twentieth Century Fox Film Corp. v. Entm’t Distrib.*, 429 F.3d 869, 877 (9th Cir. 2005); *Dolman*, 157 F.3d at 712.

¹⁷⁰ *Twentieth Century Fox Film Corp.*, 429 F.3d at 879 (quoting *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 206 F.3d 1322, 1326 (9th Cir. 2000)).

¹⁷¹ No. 3:98-CV-467 (EBB), 1999 WL 301695 (D. Conn. Apr. 26, 1999).

¹⁷² Daniel Bilsky, *From Parts Unknown: WWE v. Jim Hellwig in the Ultimate Battle for Character Copyright*, 19 MARQ. SPORTS L. REV. 419, 419 (2009).

¹⁷³ *Id.* at 420.

¹⁷⁴ *Titan Sports*, 1999 WL 301695, at *1.

Titan sought a declaratory judgment that would give copyright ownership of the wrestler's character under work made for hire.¹⁷⁵ The court never decided the merits of the case and rejected the motion to dismiss, arguing that a jury must decide whether copyright infringement occurred.¹⁷⁶ But the decision highlighted the implications of whether it is proper for an employer to own the rights to a persona-character.¹⁷⁷ The character and the wrestler have become synonymous, allowing the merger doctrine to take over, replacing copyright protection with the right of publicity in the character.¹⁷⁸

In these situations, similar to Hellwig and the running example of Stephen Colbert, even if work made for hire dominates the copyright question, relying on merger to override exclusive copyright would overcome this objection. Because it would be impractical to eliminate work made for hire whenever an actor felt a connection with a character, this method should be employed only when the characters and the actors are inextricably linked.

IV. SOLUTIONS TO THE CHARACTER COPYRIGHT GAP AND MERGER'S ROLE IN THE CHARACTER LIFE SPAN

A character typically does not begin as the counterpart of the actor that crafted him, indicating that the control of a character has the potential to shift over time. Entertainment is a constantly evolving medium—what was popular one day is unpopular the next and vice versa.¹⁷⁹ Copyright law needs to evolve with the entertainment world. This Part highlights potential solutions to fill copyright's gap—particularly how using the personal affirmative merger defense extends a royalty-free license to an actor and how the control over the character can shift over time.

¹⁷⁵ *Id.* at *1–2 (introducing the contract and later addendum signed by both parties in the dispute).

¹⁷⁶ *Id.* at *14.

¹⁷⁷ Bilsky, *supra* note 172, at 419–20.

¹⁷⁸ *Contra id.* at 434 (“Even if a court were to accept this argument, The Ultimate Warrior was likely not Hellwig’s sole creation, and even if he were the character’s driving, creative force, the character was still a work made for hire, entitling WWE, as Hellwig’s employer, to copyright ownership.”).

¹⁷⁹ *E.g.*, Brett Gold, *How Family Guy Got Canceled Twice and Still Made Seth MacFarlane a Star*, MOTLEY FOOL (Feb. 1, 2014, 8:11 PM), <http://www.fool.com/investing/general/2014/02/01/how-family-guy-got-canceled-twice-and-still-made-s.aspx> (explaining how *Family Guy* came back into the entertainment arena simply because fans supported the show); *A Look at Star Trek*, TELEVISION OBSCURITIES (Sept. 1, 2006), http://www.tvobscurities.com/articles/star_trek_look/ (discussing how *Star Trek* went from a cancelled television series to a cult phenomenon).

A. *Merger as an Affirmative Defense Creates Royalty-Free Licenses to Combat Change of Control Issues*

Merger as a personal affirmative defense results in providing an actor rights to the persona–character that are equal to the rights of a studio, allowing both parties to retain control over licensing a character to third parties. In effect, this grants an implied, or royalty-free, license to the actor.¹⁸⁰ One scholar defined an implied nonexclusive license in intellectual property:

[It] arises when (1) a person (the licensee) requests the creation of a work, (2) the creator (the licensor) makes the particular work and delivers it to the licensee who requested it, and (3) the licensor intends the that [sic] licensee-requestor copy and distribute his work.¹⁸¹

Because the result of merger’s use creates this license, studios can avoid litigation altogether by issuing an implied license for the persona–character to the actor during the initial contractual phases. “While a copyright owner may expressly grant a license to use the copyrighted work, a nonexclusive implied license can be granted verbally or implied from conduct.”¹⁸² This pre-litigation solution that uses the results of merger without its defensive purpose eliminates control issues and future litigation, fosters creativity without fear of losing all ownership, and “prevents the problem of parties who have specifically made contributions on commission for a particular purpose totally preventing the party who paid for the work from using any of it.”¹⁸³

Actions taken within the scope of a valid implied license are an affirmative defense to copyright infringement and are best illustrated in the case *Latimer v. Roaring Toyz, Inc.*¹⁸⁴ The issue in *Latimer* was whether a foreign company exceeded the scope of an implied license that was granted by a photographer.¹⁸⁵ After assessing the three-prong test for an implied license, the Court of Appeals for the Eleventh Circuit held that there was an implied

¹⁸⁰ Michael Landau, *Joint Works Under United States Copyright Law: Judicial Legislation Through Statutory Misinterpretation*, 54 IDEA 157, 219 (2014).

¹⁸¹ *Id.* (quoting *Lulirama, Ltd. v. Access Broad. Servs., Inc.*, 128 F.3d 872, 879 (5th Cir. 1997)).

¹⁸² *Teter v. Glass Onion, Inc.*, 723 F. Supp. 2d 1138, 1147 (W.D. Mo. 2010) (first citing *Pinkham v. Sara Lee Corp.*, 983 F.2d 824, 831 (8th Cir. 1992); then citing 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 10.03[A] at 10–36.1 (3d ed. 1995)).

¹⁸³ Landau, *supra* note 180, at 219 (using *Thomson v. Larson*, 147 F.3d 195 (2d Cir. 1998), as an example by stating that “had Thomson attempted to enjoin all use of her contributions to *Rent*, the Larson heirs could have brought up the ‘implied license’ doctrine”).

¹⁸⁴ 601 F.3d 1224 (11th Cir. 2010).

¹⁸⁵ *Id.*

license, but noted that the scope of the license was still a question of fact.¹⁸⁶ To establish the scope, limiting instructions are required to be imposed upon the grant of the implied license.¹⁸⁷ These implied licenses allow original owners to control how secondhand use is handled with regard to subsequent works and successive owners.

Paired with an implied license is the idea of a royalty-free license. The royalty-free license is mostly discussed in the patent context, but can apply to copyright,¹⁸⁸ especially when dealing with the copyrightability of inextricably linked characters. With a royalty-free license, the original creator of the work waives the right to compensation and the right to refuse a license to that particular license holder.¹⁸⁹

Due to the loss of coveted rights, many question the benefit to a studio in issuing a royalty-free license. In some cases, such as when the character and actor are synonymous, confusion in the marketplace can arise—whether it is between a studio and an actor in control disputes or between audiences and an actor–character in recognition respects. This remedy can prevent administrative and legal problems for all involved¹⁹⁰ because a finite set of rights would attach to the royalty-free license.¹⁹¹ Since the issue concerns ownership of the character by either the studio or the actor, this method of combating control can be highly beneficial to eliminate any confusion in the marketplace.

The character’s life is incredibly ephemeral and can change quickly. While everyone involved in the character’s creation wants to profit, it is still necessary to draw lines to make sure the use is equitable for all who contribute. The goal is to protect everyone’s investment, from a studio’s interest in developing characters in a television series or movie to an actor who brought the character to life so much so that they are forever linked. By allowing an

¹⁸⁶ See *id.* at 1236–38.

¹⁸⁷ See *id.* at 1238.

¹⁸⁸ See Eli Greenbaum, *Puzzles of the Zero-Rate Royalty*, 27 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1 (2016); David J. Teece & Edward F. Sherry, *Standards Setting and Antitrust*, 87 MINN. L. REV. 1913, 1954–55 (2003).

¹⁸⁹ See Greenbaum, *supra* note 188, at 7–8; Teece & Sherry, *supra* note 188, at 1955 (“From an economic standpoint, there is no necessary reason why the appropriate ‘price’ (royalty rate) for use of the patented technology should be zero, as it is in a royalty-free license, merely because that technology was incorporated into a standard.” (emphasis omitted)).

¹⁹⁰ See Teece & Sherry, *supra* note 188, at 1954 (explaining that administration of a royalty-free license is administratively simple; whereas, a traditional royalty rate requires substantial monitoring costs).

¹⁹¹ Mark A. Lemley, *Intellectual Property Rights and Standard-Setting Organizations*, 90 CALIF. L. REV. 1889, 1944–47 (2002) (highlighting the requirements and limitations for royalty-free licensing).

actor to obtain a non-transferrable royalty-free license, there would be no dispute about control. This solution prevents upheaval and is a contractual solution to avoid placing characters in the archives while keeping the original copyright intact.

B. Shifting Control Between the Studio and the Actor During a Character's Life Span

The character that begins its existence as unknown can one day shift to be incredibly well-renowned. The first time an actor comes to set as a particular character, the actor and character are seen as separate entities; there is no relationship between the two yet. But, five seasons of a series or one successful movie later, the actor and character can become one and the same to audiences. Issues concerning persona–character control likely only arise at the peak of the character's popularity. Flash-forward ten years after the show's cancellation—the actor and character could be completely non-existent in the public perception because the character is not remembered or the actor separated himself from the character by moving on to a new role. In theory, the character and actor can merge and unmerge, causing control issues throughout his life span.

It has been argued that media companies should be entitled to character copyrights because they are ever-changing entities that adapt to the current temporal conditions.¹⁹² However, the actor's contribution should also be considered in the character's evolution to meet society's entertainment demands. Media companies undoubtedly invest in the characters they greenlight, but actors also invest their creativity and time to focus on bringing a character to life, often sacrificing other opportunities in the process.¹⁹³ When a character and an actor are linked and a persona–character develops, the media company is not the only one that deserves credit. The actor should be entitled to persona protection that coincides with the studio's copyright. Balancing character control evolves into a symbiotic relationship between studios and actors that promotes the key societal interest of fostering endless creative expressions.

¹⁹² See Vincent James Scipior, Comment, *The Amazing Spider-Man: Trapped in the Tangled Web of the Termination Provisions*, 2011 WIS. L. REV. 67, 87–88 (2011).

¹⁹³ See Anjelica Oswald, *These Famous Roles Were Almost Played by Completely Different Actors*, BUS. INSIDER (Apr. 6, 2016, 3:14 PM), <http://www.businessinsider.com/famous-roles-actors-turned-down-2016-4/> (presenting examples of actors who have had to decline roles due to other commitments).

Because these societal interests are always changing, merging and unmerging of persona–characters is common; therefore, the effectiveness of an actor’s ownership entitlements depend on the time in which the claim is brought to light.¹⁹⁴ For example, Julia Louis-Dreyfus is notably linked with playing Elaine on *Seinfeld*.¹⁹⁵ Over the years, she detached herself from this character and reinvented herself as a well-respected actress winning awards for her role in *Veep*.¹⁹⁶ In theory, she unmerged from the original character that made her a household name. Meanwhile, Michael Roberts, who played Kramer on *Seinfeld*, has been virtually unable to differentiate himself from the character, turning to unsuccessful stand-up comedy routines to make it in the industry again.¹⁹⁷ He has not shed his Kramer persona–character, but there is always the potential to do so if the right role comes along. Finally, Jerry Seinfeld, creator and lead actor on *Seinfeld*, is quite literally one and the same with the character he portrayed—the two have the same name, the same mannerisms, and the same career, among other similarities.¹⁹⁸ Despite any differences between the actor and character, the similarities outweigh the differences, and the idea that he will ever be severable from his character is

¹⁹⁴ Typecast characters traditionally have the biggest issues regarding merging and unmerging because they are continually cast as similar, yet different roles. See generally Jason Serafino, *The 10 Most Typecast Actors of All Time*, COMPLEX (Nov. 26, 2012), <http://www.complex.com/pop-culture/2012/11/10-most-typecast-actors-of-all-time/>.

¹⁹⁵ *Julia Louis-Dreyfus*, IMDB, <http://www.imdb.com/name/nm0000506/> (last visited Jan. 5, 2017). *Seinfeld* ran from 1989 to 1998 and was a huge success among fans and critics, earning a total of seventy-one wins and 182 nominations at various award shows during its tenure on-screen. *Seinfeld: Awards*, IMDB, http://www.imdb.com/title/tt0098904/awards?ref_=tt_awd (last visited Feb. 2, 2017). See generally *Seinfeld* (West-Schapiro 1989–1998).

¹⁹⁶ Kevin Fallon, *Emmys 2016: How Veep’s Julia Louis-Dreyfus Pulled Off the Funniest Comedy Moment of the Year*, DAILY BEAST (Aug. 28, 2016, 1:00 AM), <http://www.thedailybeast.com/articles/2016/08/28/emmys-2016-how-veep-s-julia-louis-dreyfus-pulled-off-the-funniest-comedy-moment-of-the-year.html>.

¹⁹⁷ See Andrew Gumbel, *Racism in Comedy: Kramer’s Sense of Humour Failure*, INDEPENDENT (Nov. 22, 2006, 12:07 AM), <http://www.independent.co.uk/news/world/americas/racism-in-comedy-kramers-sense-of-humour-failure-425291.html>; Morgan Sennhauser, *What Happened to Michael Richards – What’s He Doing Now Update*, GAZETTE REV. (Jan. 27, 2016), <http://gazetterevue.com/2016/01/happened-michael-richards-whats-now-update/>.

¹⁹⁸ *Jerry Seinfeld*, BIOGRAPHY, <http://www.biography.com/people/jerry-seinfeld-9542107#return-to-stand-up> (last updated Apr. 29, 2015). Jerry Seinfeld, the actor, developed the concept for the television show with Larry David, to tell the untold story about life in New York City—a “show about nothing.” Larry Getlen, *The Backstage Drama That Nearly Brought Down “Seinfeld,”* N.Y. POST (July 10, 2016, 1:04 AM), <http://nypost.com/2016/07/10/the-backstage-bickering-that-almost-brought-down-seinfeld/>. The characters were modeled after Seinfeld and David and people they interacted with throughout their lives in New York City. *Id.*; see also Yu, *supra* note 97, at 412–13 (“Obviously, there are many overlapping characteristics between the fictional persona of the ‘Jerry Seinfeld’ character and Jerry Seinfeld’s human persona, since the actor was supposed to play himself in the television show. Nonetheless, there are still many differences between the two personae.”).

nearly impossible to fathom, meaning the idea and expression are fully merged.

Considering the changes in the life span of a character and an actor's role in its development, there may be a time when copyright is not appropriate for persona protection and the right of publicity should supersede copyright.¹⁹⁹ However, right-of-publicity jurisprudence is unpredictable, so if studios do not want to risk losing copyright on these persona–characters, then merger and implied licenses should handle the shifting life spans.

The Copyright Act itself has not been overhauled since 1976, yet the ever-changing nature of the entertainment industry requires creative solutions to previously unforeseen problems related to the increased development of persona–characters.

CONCLUSION

The entertainment industry today focuses intently on transforming actors into brands.²⁰⁰ Actors are no longer valued solely for their craft, but must develop into a public persona that perpetuates through choosing roles that enhance their credibility, finding strategic endorsements, and exposing their lives to the paparazzi. Because of this industry-wide branding trend, the copyright issues related to ownership of persona–characters could become much more prevalent in the coming years. Taking advantage of personal affirmative defense merger principles can prevent future litigation and force these control discussions to be a negotiation tactic. The goal is to allow characters to continue to live on even if they are no longer on the original platform from which they derived success. For the sake of promoting creativity and fostering artistic expression, the time is now to form a cooperative

¹⁹⁹ See generally Yu, *supra* note 97.

²⁰⁰ See Kevin Harrington, *Celebrity Branding Is Making a Comeback - Tips for Success*, FORBES (Aug. 18, 2014, 3:24 PM), <http://www.forbes.com/sites/kevinharrington/2014/08/18/celebrity-branding-is-making-a-comeback-tips-for-success/#2e4568d76ea2> (“Celebrity branding . . . is all about using a celebrity’s position of prominence to start a conversation.”).

relationship between studios and actors and to recognize the value of persisting persona–characters in entertainment.

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