



# THE IP PRESS LAW REVIEW

*Volume 1 Issue 1 April 2022*

FOLLOW US AT



[www.theippress.com](http://www.theippress.com)

## **DISCLAIMER**

The views and opinions expressed in The IP Press Law Review are strictly those of the authors. All efforts have been taken to ensure that no mistakes or errors creep into this peer-reviewed journal. Discrepancies, if any, are inadvertent.

All the submissions are protected by copyright under The Indian Copyright Act of 1957. No user is authorized to copy or reproduce the content except for 'educational use'. Any person referring to the work of this Law Review is required to give due credit to the author and The IP Press with proper citations.

Published by  
The IP Press  
2021-2022

# EDITORIAL BOARD

## ADVISORY BOARD

**Prof. Dr. S. Rama Rao**  
Microsoft Chair of IP, GNLU  
Ex-Director, WIPO

**Prof. Dr. Shobhalata V. Udupudi**  
Professor  
Tamil Nadu National Law University

**Dr. Sonal Shankar**  
Faculty of Law  
Allahabad University

**Sheela Ramkumar**  
Advocate  
High Court of Hyderabad  
Wordict-IP

## EDITORIAL BOARD

**Charu Srivastava**  
Assistant Professor  
UPES School of Law

**Dr. Ashwini Siwal**  
Assistant Professor  
Faculty of Law, University of Delhi

**Dhruv Grover**  
IP Litigation Attorney  
High Court of Delhi

**Dr. Avishek Chakraborty**  
Assistant Professor  
School of Law, Christ University, Bengaluru

**Soumya Singh Chauhan**  
Assistant Professor  
Jindal Global Law School

**Ana Carolina Nogueira**  
Associate  
Demarest Advogados, Brazil

**Ankeeta Gupta**  
Ph. D. Scholar. Faculty of Law  
University of Delhi

**Vaibhavi Pandey**  
Senior Associate  
IPR & Dispute Resolution  
Khaitan & Co.

**Bijetri Roy**  
Managing Director & Chief Strategist  
Ins-PIRE

**Himani Jaruhar**  
National Law University Odisha

**Vivek Basanagoudar**  
Jindal Global Law School

# EDITORIAL NOTE

Intellectual Property is the key driver to propel the economic growth of a nation. Hence, understanding IP gains utmost significance not only from a business point of view but also from a socio-economic perspective. We as nationals of any country should be vigilant in protecting and defending our IP rights. However, there are multiple issues and challenges that need discussions, and reforms. The IP Press Law Review (IPPLR) is an initiative of The IP Press to extend our objectives of spreading awareness on the issues concerning intellectual property rights and related laws. It aims to promote study and research in the field of intellectual property laws in the form of academic literature. This issue reflects some of the key concerns of the Intellectual property regime both under national and international parlance. It is envisioned to embody some of the most brainstorming insights that help readers to grasp the discourse around contemporary developments in the field of Intellectual Property Law. Throughout the year, the editorial board has reviewed the papers with multiple rounds of editing to ensure quality and standard.

This issue presents intriguing issues and challenges pertaining to intellectual property law in the national as well as the international regime. The first paper encapsulates the protection of personality rights under Intellectual property laws and briefly presents the status of multiple jurisdictions. The second paper discusses a pertinent issue of protection of fictional characters that have been a cause of concern in many disputes. The author discusses the theoretical framework and analyses various tests laid down by the judiciary.

The third paper explores religion as a subject and object of the trademark. The author determines the legality of the trademark of religious symbols for private companies and religious organisations. The fourth paper presents a policy discussion on the overlap between trademark and functionality doctrine. The fifth submission deals with the congruence of intellectual property assets in combination and corporate restructuring wherein the author states that IP has immense power to help businesses to grow and hence its valuation becomes an important aspect of commercialization of IP. The sixth paper demonstrates how open-ended section 57 of the Copyright Act, 1957 is which leads to ambiguity. The author asserts reforms in the current provision of moral rights. The seventh paper discusses the recent dissolution of the intellectual property appellate board in the backdrop of the Tribunal Reform Bill, 2021. The eighth paper discusses the relevance of IP Due diligence and suggests quarterly checks and steps carry out the due diligence process to combat the closing down of businesses and lifelong losses. The ninth paper presents analyses of the patent denials in the biotechnology sector and their impact on the industry. The tenth paper presents an interesting analysis of trademarkability of non-conventional trademarks due to hindrances of graphical representation and discusses multiple judgements of the European courts. The last two items present an analysis of two landmark cases, one Monsanto case and two, Phonpe v. Bharatpe trademark tussle.

Happy reading!

---

- 1 PROTECTION OF PERSONALITY AND IMAGE RIGHTS- A COMPARATIVE ANALYSIS**  
*Lucy Rana, Shilpi Saran*
- 12 ANALYSIS OF PROTECTION GIVEN TO FICTIONAL CHARACTERS AND ITS OWNERS IN COPYRIGHT LAW-**  
*Aishwarya Srivastava*
- 33 TRIALS AND TRIBULATIONS OF TRADEMARKING RELIGION IN INDIA**  
*Pavitra Naidu*
- 47 TRADEMARK ANALYSIS IN PERSPECTIVE OF THE FUNCTIONALITY DOCTRINE**  
*Konark Pratap Gupta*
- 61 THE CONGRUENCE OF INTELLECTUAL PROPERTY ASSETS IN COMBINATION AND CORPORATE RESTRUCTURING-**  
*Shantanu Sharma, Prutha Bhavsar*
- 73 MORAL RIGHTS AND ITS SHORTCOMINGS IN INDIA**  
*Vrishti Shami*
- 81 JUSTIFYING THE DISSOLUTION OF THE INTELLECTUAL PROPERTY APPELLATE BOARD IN THE BACKDROP OF THE TRIBUNAL REFORM BILL, 2021**  
*Anirudha Sapre*
- 97 IP DUE DILIGENCE: COMBATTING WINNER'S CURSE!-**  
*Harsha Aswani*

- 118 DENIAL OF PATENTS IN THE BIO-TECHNOLOGY SECTOR AND ITS CONSEQUENCES ON INDUSTRY DEVELOPMENT**  
*Aryan Shah*
- 129 NON-CONVENTIONAL MARKS: GRAPHICAL REPRESENTATIONS AND CONTEMPORARY PROBLEMS**  
*Doyita Mukherjee*
- 142 MONSANTO CO V. STAUFFER CHEMICAL CO: THE EXPERIMENTAL USE EXCEPTION**  
*Anusrita Ranjan*
- 146 A CRITICAL NOTE ON THE DELHI HIGH COURT'S RULING IN THE PHONEPE VERSUS BHARATPE TRADEMARK TUSSE**  
*Ritwik Guha Mustafi*

## ANALYSIS OF PROTECTION GIVEN TO FICTIONAL CHARACTERS AND ITS OWNERS IN COPYRIGHT LAW

---

Aishwarya Srivastava\*

### ABSTRACT

*An unauthorized use of literary and artistic work by means of reproduction of the work amounts to infringement of Copyright law and hence the law provides protection from the same. These works are composed of several elements that can be illustrated as characters in a story and the protection of these characters under copyright law is still dubious. These characters are given certain names that are imaginary or made up and protection of these invented names under copyright law is not allowed, as the name would not classify as an original work of literature. However, these fictional characters are not just names in the story but they are the essence of the story and are much more than just names. These fictional characters are sketched persons and personalities that are defined in words by means of imagination and they can be distinguished from one another with their unique description of looks, manners and the way they speak and communicate themselves. The issue of protection to these fictional characters has been a cause of disagreement in many disputes. This paper presents the theoretical framework along with the analysis of case laws of different courts concerning the copyrightability of characters.*

*Keywords: Fictions, copyrights, graphical characters, fictional characters, infringement.*

---

\*Aishwarya Srivastava, Associate, AZB Partners.

## 1. INTRODUCTION

Only when a fictional character fits in every requirement for it to be protected under Copyright then would the question of its copyrightability stand essential. Some of the fictional characters for instance would be Mickey Mouse, Minions, Donald Duck, Sherlock Holmes, Jon Snow, Batman etc. These characters are now so famous that they are almost a part of our lives like a real person. These characters are available in various forms in the market. Their business expands to not only the shows in which they feature but to applications for mobile phones, games, soft toys, clothing lines, movies etc. Therefore, all these various platforms provide revenue to the owners of the characters from different means of businesses as many as possible. For instance, Disney who is the owner of Mickey Mouse, so as to protect it, also objected the painting of Mickey that was painted on the walls of a Hallandale, Florida day care centre.

The owners of these characters have crossed lengths protecting their creations in their capacity of being an artist because these characters are their figment of imaginations and ideas that are brought into expression. These expressions have unique qualities, attributes and characteristics that are created by the artist using his intellect, labour and idea and thus the protection to the outcome of the same should be granted to him. Such protection prevents misappropriation of the creation by third parties and provides the original creator the right to exploit it at first.

Likewise, the licensees and the advertisers to whom authorization has been granted by the owner of the character, have equal rights in protection of the character from the misappropriation of the character by third parties. Any such misappropriation would result in economic loss to the interested parties and this would restrict their legal rights to the character. Hence, the question of protection of intellectual property arises here with respect to characters.

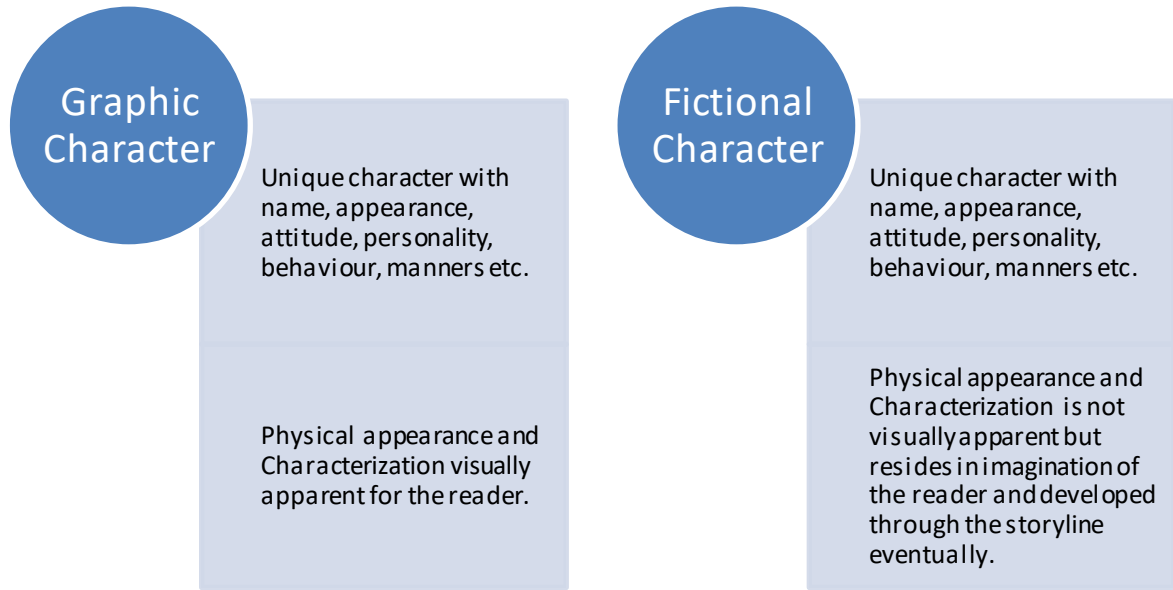
Therefore it is important to examine the aspect that when a character would fall under the ambit of legal protection by the originator. This is the most imperative issue that floats in the current era as well. Another qualm that originates is with the respect to the characters that have already entered the public domain but has been at the same time used in a new work, which is separately copyrighted. Hence it must not be disregarded that not just protection under copyright law that can be taken recourse to but protection also under the trademark law and competition law can be proved to be pertinent in this context.



## 2. TYPES OF CHARACTERS

There are two types of characters:

1. Graphic Characters
2. Fictional Characters



The differentiation between the two types of characters is of pertinent nature because the level and kind of protection given to both these characters by the court is different in nature and such protection is provided in different levels. The protection involves certain tests that have been laid down by the court for resolving the copyright protection to be given to the character.

### A. Graphic Character

These characters are portrayed by means of a cartoon or other form of representation in graphic mode. They are created in a manner that their physical appearance and the character that they are playing are perceptible to the people reading it. Such graphic characters would include characters like Superman or Mickey Mouse or Goofy or Minions, Donald Duck, or any other cartoon represented in the graphical mode.



These are cartoon characters named Minions. They fall under category of Graphic characters. Image source: See [here](#)

i. Copyright protection

Protection to graphic characters under Copyright law would not fall under the heading ‘artistic work’ as the artistic work would not cover the change in character’s personality and evolution of character through various episodes that the artist would create. Artistic work as defined under the Copyright Act, 1957 means:

- “(i) a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possess artistic quality;
- (ii) a work of architecture; and
- (iii) any other work of artistic craftsmanship”<sup>29</sup>

Thus as per the above meaning of artistic work, it would include only drawings of the characters that would depict the expressions that the artist intends to portray. Anything that cannot be expressed by its depiction through drawings or any other visual expressions but can only be imagined by the mind of human would not be protected under copyright law. Henceforth the

---

<sup>29</sup> Indian Copyright Act 1957, s 2(c).

different temper, humour and persona that the character would play and hold would not fall under the category of ‘artistic work’ and thus would not be protected under Copyright Law.

There are various case laws that would show how the courts have been more cooperative and moderate while passing judgments that dealt with protection of graphic characters, which are more visually expressive under copyright law, in comparison to protection of fictional characters that are more based upon the perception of the human mind.

In the leading case of *Hill v Whalen Mortell*<sup>30</sup>, it was held by the court that the lead characters Nutt and Giff were clear imitation of the characters that plaintiff owned namely Mutt and Jeff. Consequently, it was decided by the Court that the production house of that theatre committed copyright infringement by copying the cartoons that were owned by the Plaintiff as the characters Nutt and Giff were exact carbon copy of the original characters Mutt and Jeff and such direct association between the characters was identified by all. Thus it can be summarized from this case that such interlinking between the cartoon characters that a normal audience is able to identify is not accepted under the law and is regarded as infringement of copyright as this is an unauthorized use of one’s intellectual creation.

In another case that took place in the year 1940, *Detective Comics v Bruns Publication*<sup>31</sup>, a character called ‘Wonderman’ was created by the defendants which was strikingly similar to the existing well known cartoon called ‘Superman’.

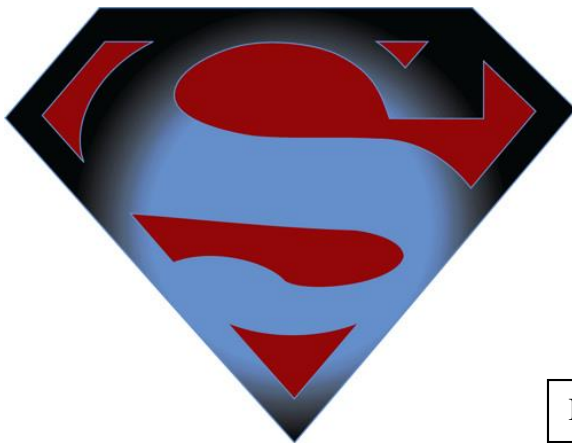


Image Source: See [here](#).

---

<sup>30</sup>*Hill v Whalen Mortell* 220 F 359 (S D NY, 1914).

<sup>31</sup>*Detective Comics v Bruns Publication* 111 F 2d 432 (2d Cir, 1940).

All the attributes of Wonderman were similar to that of Superman, whether it was about his physical strength and appearance or about his emotional and sensitive side, Wonderman resembled Superman in most ways and the problem was that Superman was already a well-known cartoon character existing before Wonderman was created. Therefore, in this case it was decided by the court that the defendant had reproduced more than just the general nature and design from the ‘Superman’ and has also used without any authorization of the complainant, the details in pictures of the cartoon character and the literature too. Thus, this hindered the protection that was so granted to the Complainant’s copyrighted character. Hence, the plea of providing protection to general ideas etc. of a character was rejected by the Court. It said that the protection could be granted only when the features of the character is depicted in full volume and that the character must be converted into an expression rather than being just an idea. Copyright protection is not granted on ideas solely and therefore expression of the character in sufficient details was required. Only the theory of a man with supernatural powers of that of a superhuman would not suffice the requirements of a copyright protection. However, if this theory is compiled with unique details and features like they have defined for ‘Superman’ then that theory would be said to have been given an expression. Thus, it was concluded that any person can develop any cartoon character with supernatural powers and it would be protected under copyright law but the condition remains same that the character should not be a pure copy of an existing character like Superman. It should be a new expression of an old idea of a character with superhuman powers. This case lays down very important points for distinguishing between idea and expression and copyrightability of graphical characters having different expression.

Another significant case was that of *Walt Disney v Air Pirates*<sup>32</sup>. In this case, the complaining party argued that the defendants have depicted the Disney characters in an inappropriate setting. The Court applied the 2-step test to identify that whether there is an infringement of copyright or not.

---

<sup>32</sup>*Walt Disney Productions v Air Pirates* 581 F. 2d 751 (9<sup>th</sup> Cir, 1978), cert. denied; 439U.S. 1132 (1979).

ii. Test to identify graphic character's copyright infringement

The two- step test involved the following steps:

- i) Visual Similarities
- ii) Similar Personalities

That is, in this test, firstly it would be observed that whether both the characters are visually similar or not. If yes, then there is an infringement in the first step itself. However, if the characters are not visually similar then the next step would be to compare and analyse the personalities of the respective cartoon characters. If both the personalities are similar then that would amount to infringement and if not then that wouldn't amount to unauthorized use of copyright. This second step is done with the 'Character delineation' test. The Judge Learned Hand in the judgment of the case *Nichols v Universal Pictures* developed this test<sup>33</sup>. "The Character delineation test means whether the particular character is sufficiently and distinctively delineated so that it warrants. Protection. Judge Hand states that 'It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for making them too indistinct.'" <sup>34</sup>In the former case, the defendants were found guilty and hence were held liable for infringement of copyright.

Both the latest two cases discussed above divulge into the fashion of the courts that they have been following. They disclose that only when a graphic character has its own individuality and a specific personality, which is unique and never seen before, then can a copyright protection be granted to such graphical characters. However, they must be sufficiently developed and must not be similar to any other existing characters. They must be so unique that when audience looks at the character, they must be able to recall the original unique character, which is this one and not any other character. This is an essential requirement that needs to be fulfilled for an expression, which has developed from an idea to be granted a copyright protection. Without fulfilment of this imperative attribute, a graphic character would not be recognized as new and copyrightable and would not be granted any copyright protection thereof.

---

<sup>33</sup>*Nichols v Universal Pictures corp* 45F2d 119 (2d Cir 1930), cert denied, 282 US, 902 (1931).

<sup>34</sup>Sourav Kanti De Biswas, 'Copyrightability of Characters' (2003) 9 Journal of Intellectual Property Rights 150.

“A graphic character is considered to be much more easily perceivable and more apparent for the reader. Hence, the courts have been more inclined to grant protection to them than to pure fictional characters.”<sup>35</sup>Hence, it can be said that the only way of providing protection to graphic characters would be by making their presentation distinctive and exclusive. Without the specific quality in the graphic characters, their expression would not stand valid and the idea would be considered merely an idea without any legal protection.

In India, there has been only one case that identified a cartoon character to be protected under the Copyright Act, 1957. The case is *Malayala Manorama v VT Thomas*<sup>36</sup>. In this case, Mr. Thomas created a cartoon character for this Magazine. After Mr. Thomas quit the magazine, the magazine continued to use the cartoons and thus Mr. Thomas filed a suit for infringement of copyright. The court decided the case in favour of Mr. Thomas and it permitted him to continue his work. His work included sketching the characters in Toms Boban and Millan despite of the fact that he was no more employed there. Mr. Thomas got protection over the copyright of the characters and his drawings and the publishing house was not allowed to impose their copyright over the same. The reasoning given by the High Court was that as the characters were created by Mr. Thomas before he joined the magazine and he has been working on the characters from before itself, thus it is he who would hold copyright over the character and he would have the right to exploit his copyright and not the magazine. There were no efforts inputted by the publishing house in creation of the character therefore they would not be getting any copyright over the character. The right of the magazine would only extend to the work that has been done by Mr. Thomas during the course of his employment as during the employment, he has been working in the capacity of an employee and the work was being published on the work of the defendant.

The court drew a distinction between the drawing that was made by using the cartoon character and the cartoon character independently and concluded that the drawings that were made by using the cartoon character, copyright of those designs would stay with the publishing house under the ambit of artistic work however with regards to the character solely, then copyright over just the character would lie with Mr. Thomas. Hence the publishing house was not allowed to use character for the new episodes after the termination of employment of Mr. Thomas. The publishing house

---

<sup>35</sup> *ibid.*

<sup>36</sup> *Malayala Manorama v VT Thomas* AIR 1989 Ker 49.

was denied the right to create new episodes with the help of different employees by using the same character.

The Court approved for copyrightability over the graphic characters but it did not mention the circumstances under which such copyright may be given to the characters. The details of the reason and other details that must be kept in mind or that must be present for a copyright to be given to a graphic character were not given by the court.

After all that is said above, it can be inferred that on application of the Nichols test in the current scenario, the characters 'Boban and Molly' would have got protection under copyright but at that time the Court did not directly provide copyright protection to these graphic characters as with time the awareness spread and it was understood that all these graphic characters that are created and published are being recognized and read by a lot of readers due to their pictorial and literary description that is distinctive in nature. The distinctive nature of the characters make them unique to be caught and identified by the readers and viewers and hence could have been granted legal protection under copyright. Even the attribute of these characters being so well-known and effective that viewers were able to identify them out of the lot and hence it can be said that they affected the humans and left their imprints on the mind of the viewers and as the graphic characters 'Boban and Molly' were adequately descriptive and defined, they were enough to be granted a copyright protection.

#### B. Fictional Character

These characters are depicted through words. They are created in a manner that their physical appearance and the character that they are playing is perceptible to the people who are reading it. By reading it refers here that fictional characters are depicted through the several pages of a book and they cannot be described in a single paragraph and no reader can perceive a fictional character by reading a single paragraph or a single line. These fictional characters are also termed as literary characters and these would include characters like Jon Snow, James Bond, and Harry Potter etc. who are first portrayed in the form of words in a book rather than by a graphical representation.

## 1. Harry Potter

"Harry had always been small and skinny for his age...Harry had a thin face, knobbly knees, black hair, and bright green eyes."



Description of Harry Potter in the book by the author J.K. Rowling.

Image source: See [here](#)

Characters represented through words are trickier to depict and falls on the notion of imagination of a person whereas such is not in the case of a graphical character that is already pictorially depicted and hence copyright protection to these pictorial representations is easier than in comparison to the literary characters and hence the question of copyrightability of these characters still stand dubious. Thus, it can be said, "Since images are more identifiable than literary descriptions, pictorial characters are more easily protected independent of their original context."<sup>37</sup>

### i. Copyright Protection

The protection of literary work under copyright is legal but the question still remains that whether the character that has been used in a literature before, is it allowed protection only under that

---

<sup>37</sup>Davidow Lawrence L, 'Copyright protection for fictional characters: a trademark- based approach to replace Nichols' (1984) 8Colum.-VLA J.L.& Arts 513,544.



particular work or whether its scope outreaches the boundaries of work and the character is protected separately too. This situation has still not been clarified and the uncertainty is still there.

If we for an instance grant protection to a literary character then it would create certain hurdles and dilemmas because in such situation of protected fictional character, any other original literary work that is legal and protected under copyright cannot use the fictional character of another some other author, in their storyline as this would amount to infringement of copyright of that particular fictional character. However, this particular fictional character is not pictorial or its expression is not visible but imagined and a creation of mind that is derived from reading the particular lines. Hence, the question remains unanswered as to what a literary character or a fictional character that is protected under copyright law, comprise of. Several commentators have asked this question and they have expressed a variety of their opinions and suggestions to explain the constituents of a copyrighted fictional character or a literary character. Among the many commentators, it was stated by Mr. David B Feldman that “A fictional character has three identifiable and legally significant components:

- Its name,
- Its physical or visual appearance and,
- Its physical attributes and personality traits or Characterization.”<sup>38</sup>

“While the concept of what would be required for a character to be protected in its own right developed, the standard against which the concept was to be measured varied.”<sup>39</sup>

To clear the confusion further, an example may be used. Taking any literary character such as “James Bond” for instance, there may come a time when people would not remember the storyline or the plot that has been provided in the story but the character of the story would remain unforgettable. This is because when a character is described in full detail then such personality tends to stay in the imagination of the reader. This very essence of ‘staying in the mind of the reader’ of the fictional character brings out its actual value. This is the value of the particular literature and talent of the author that needs to be protected. The authors must get their fictional characters protected for the value their characters possess and when there is a chance that of such

---

<sup>38</sup> Feldman David B, ‘Finding a Home for Fictional Characters: A proposal for Change in Copyright Protection’ (1930) 78 CLR687.

<sup>39</sup>Biswas (n 6).

characters being used by other creative artists in books, or television series or movies or documentaries or paintings or doodles or any other platform of expression then the protection of such fictional characters under copyright law becomes even more imperative in nature. If not protected then there are chances that the original author of the character may lose out on the revenue that would be gained from the business of the character on various platforms and hence by properly controlling and protecting the fictional character, the profits and revenues generated from it may increase in favour of the creator of the character or the publisher of the character.

“For protection of fictional characters, there are three means of legal bodies that in consonance to each other provide protection to fictional characters. These different bodies are Copyright, Trademark and unfair competition. They overlap each other and thus the courts has been deliberating upon union of these three distinct bodies and thus form a new body that would be an outcome of the three and would purely work for the protection of literary character or fictional characters. But the issue still remains as even this theory of convergence of three legal bodies exists, but as far as fictional characters are concerned, they wouldn't be that expressive as graphic characters are and this theory applies better to the graphic characters.”<sup>40</sup>

ii. Test to identify fictional character's copyright infringement

Like graphic characters, fictional characters also involve a twofold test to identify any infringement of the copyright and also to identify fictional character on whole. These tests lay down the requirements for a fictional or a literary character to fall under the ambit of protection of copyright. The standard against which the concept was measured has varied and hence through several case laws the same would be illustrated.

Following are the two tests that are involved:

1. The Distinct Delineation Standard Test
2. The Story Being Told Test

---

<sup>40</sup> Michael Todd Helfand, 'When Mickey Mouse Is as Strong as Superman: The Convergence of Intellectual Property Laws to protect fictional literary and pictorial characters' (1992) 44 Stan.L.Rev. 623.

a. The Distinct Delineation Standard Test

This test evolved in the case of *Nichols v Universal Pictures*<sup>41</sup> is applicable in identifying the copyrightability of fictional characters as well. This test is also termed as the Character Delineation Test and this test requires that the character must be well developed and described with clear traits that makes it unique and identifiable. In this case, Nichols was the plaintiff who alleged that the defendant, who is the Universal, has copied the characters from her play and has used similar characters in their film. The dilemma that arose was about protection of fictional character and the judges were perplexed about making fictional characters protected under their original work that is the expression. However, the ideas were out in open and there was no penalty to be imposed upon the usage of the idea of the characters.

The characters can be supernatural in their attribute but the features, and personality trait and their emotional being, their appearance and everything that makes them appear unique to the reader should not be copied, as that would not fall under the ambit of public domain. Hence the character must have a distinct delineation for it to get protected under the law. It was explained by the Judge Learned Hand that the more distinctively a character is portrayed that is, more details used in depicting a character, more distinctive the character would be and hence protection would be possible to be given to the character. Whereas if the character is less identifiable and has not been described in full lengths and breadths then such characters are less distinctive and do not require much protection.

Hence, it can be said that all depends upon the way of expression of the character. In the above-mentioned case, the Judge held that the characters were not very similar. The ideas behind the characters were same but their expressions were different and this made their distinct delineation equal to the character, which has not been defined before. The character is only said to be copied when they are taken directly from a fully developed work and such authorization is not legal in nature.

In another judgment of “*Anderson v Stallone*”<sup>42</sup>, the use of ‘character delineation’ test has been made to prove protection to the fictional characters. There is a story based on the character of ‘Rocky’ that has been written by the appellant. This character has already made an appearance

---

<sup>41</sup>*Nichols v Universal Pictures Corp* 45 F 2d 119 (2d Cir. 1930), Cert denied, 282 US 902 (1931).

<sup>42</sup>*Anderson v Stallone* 11 USP 1 2d 1161(C.D. Calif, 1989).

before in the movie series ‘Rocky’ so there already exist a character called ‘Rocky’. The appellant went to Sylvester Stallone and he tried selling his story to him which had this character ‘Rocky’ in it. Mr. Stallone is famous for his work in the original ‘Rocky’ movie series and thus when he was offered by the appellant to work in ‘Rocky IV’ then there was a full issue that arose with respect to infringement of copyright of the character ‘Rocky’ by the appellant. The appellant denied all the allegations on the ground that the character Rocky is not copyrightable and hence he cannot be said to have infringed any law.

The judgment ruled out by the court favoured the plaintiff instead of the defendant on the ground that the in the movie ‘Rocky’, the characters whether physical or emotional, they all were plotted with incredible specifications therefore, the character was fully descriptive and would fall under the realm of delineation of the character. The Court also stated “this court has no difficulty ruling as a matter of law that the Rocky characters are delineated so extensively that they are protected from bodily appropriation when taken as a group and transposed into a sequel by another author.”<sup>43</sup>

Recalling the views of one of the commentators who said “A literary character can be said to have a distinctive personality, and thus to be protectable, when it has been delineated to the point at which its behavior is relatively predictable so that when placed in a new plot situation, it will react in ways that are at once distinctive and unsurprising.”<sup>44</sup>

Therefore as far as this test is concerned, it can be concluded that a fictional character should be delineated that is it should be well described, well developed and should be identifiable to the viewers. These are some important requirements for a fictional character to get a copyright protection. However, sometimes providing a full description which is unique, detailed, describes the personality, attitude and as the story unfolds it gets even clearer, is tough because ‘word portraits’ depends upon how the viewer envisions it in his brain and hence some courts are not able to differentiate between fictional characters due to which protection to these characters also gets affected.

---

<sup>43</sup>ibid.

<sup>44</sup>Helfand (n 12) 128.

b. Another test is the Story Being Told Test.

It is the second test and it replaced the ‘Distinctively Delineated Character Test’. This test came from the case *Warner Brothers v. Columbia Broadcasting System*.<sup>45</sup> The rights to the characters of the book were given by the author of ‘The Maltese Falcon, Mr. Dashiell Hammett, to the Warner Brothers. Thereafter, CBS also gained rights from Mr. Hammett and not just rights but also exclusive rights to Detective Sam Spade’s character which was quite famous during that time. Eventually CBS was sued by Warner Brothers for using the character but the court decided after observing that the character Detective Sam Spade was not the lead character of the story and neither did he carry the storyline forward and hence the Court gave its judgment in favor of CBS allowing them to use the character and such usage would not amount to infringement of copyright of Warner.

The Court held that “no character is protectable under the copyright law unless the character is extremely well-delineated as to constitute ‘the story being told’ rather than merely being a ‘chess man in the game of telling the story’”.<sup>46</sup> Thus, it can be inferred from the judgment that the court requires that the protection would be given to the character around whom the story would spin and who is the main essence of the story and without whom the story would not stand what it does at the moment. The character should be crucial and should move the story forward and the story should move around him. Then only such characters that are literary or fictional in nature would be given copyright protection.

There are some other cases too that were decided under this test. *Universal City Studios v Kamar Industries*<sup>47</sup>. In this case, the character ET was granted protection under copyright because the plaintiff’s movies’ lead role was that of ET’s and the whole story of the movie revolved around the character ET. The character was detailed and specific and was identifiable enough to be granted copyright protection for.

In other case of *Warner Bros v Film Ventures International*<sup>48</sup>, the famous movie Exorcist was involved. There was a character ‘Regan’ in the movie that was the reason of the suit. The court

---

<sup>45</sup>*Warner Bros Pictures Inc v Columbia Broadcasting Sys Inc* 216 F 2d 945, 104 US P Q 103 (9<sup>th</sup> Cir. 1954), cert. denied, 348 US 971, 99 L Ed 756, 75 S.Ct. 532 (1955). Also known as SamSpade Case.

<sup>46</sup>*ibid* at 950, 104 US P Q at 107.

<sup>47</sup>*Universal City Studios v Kamar Indus* 1982 Copyright LDecisions (CCH) 25,452 (SD Tex. 1982).

<sup>48</sup>*Warner Bros v Film Ventures International* 403 F Supp. 522, 525, 189, US PQ 591, 593 (C.D. Cal. 1975).

denied copyright protection to the character 'Regan' as the movie did not absolutely revolve around it and neither did the character take the storyline of the movie forward.

However, this test's decision was not widely accepted by all the courts as there is some issue with discrepancy and therefore the Ninth Circuit has also stepped back from using the 'story being told' test in determining the copyright infringement in their cases. The main problem with this test is that it only focuses on the story without any plot and it envisions that the character in question is the one that composes of all the work in the film. That is, without the character, the film would have no meaning. This rule excludes all the other characters that may not be playing the lead role but are equally creative and the creator has put in equal efforts in describing them. However, on application of this test, the side characters lose their protection to copyright because of the fact that the story does not revolve around them. Hence, there is a need to dilute the standard of this test.

In the case of *Air Pirates*, the court gave its judgment in favour of the plaintiff and held that the decision given in the "Sam Spade"<sup>49</sup> case was "based on the recognition that 'It is difficult to delineate distinctively a literary character...put another way...many literary characters may embody little more than an unprotected idea.' Therefore, it appears that even if the 'story being told standard' is not met, the character can be copyrighted, provided it is sufficiently developed and finely drawn so as to cross the line from 'idea' to 'expression'."<sup>50</sup>

Now arises the idea-expression dichotomy which refers to the question that when does an idea really become an expression? We have explained above that an idea and an expression are two different categories where a person cannot get a copyright over an idea but they can get copyright over an expression of that idea. Literary characters usually are expressions of these ideas, as they would have certain physical qualities, certain conceptual details about how they talk, think and feel and some distinctiveness that would make them appear different from the rest of the characters. A literary character is developed through words and can be seen visually through imagination by reading those words. Hence, when an idea is covered with a mixture of all the above attributes and qualities that are stated above then it does not stay just an idea anymore. The idea now has become an expression of the same idea and this expression would fall under the domain of copyright protection. We have discussed certain case laws above that explain that a character would be

---

<sup>49</sup>*Warner Bros Pictures Inc* (n 17).

<sup>50</sup>*Biswas* (n 6) 153.

considered as an expression when it is well developed and delineated and thus the ‘character delineation test’ is where the idea is converted into an expression and thus gets protected under law.

### 3. DIFFICULTY IN APPLICATION OF THESE TESTS

There are reasons that can be stated for justifying why the distinct delineated test is difficult to apply. Some of them being that this test lacks clarity as in this test judges are supposed to take the role of literature analytics and critically analyse the material and character and thus there is a possibility always that the application of this test would be not right and would result in overprotection of the literary character or no protection of the literary character at all. This test basically deals in extremes and it cannot be totally relied upon as it is not necessary that it will protect the characters that are developed completely either. According to this test, the conclusion that can be drawn is that the more precise, clear, developed and shaped a character is, more would be the amount of protection that the character would need. Less developed characters are given less protection as there can be interpretations and similar description of characters involving the same less amount of features and thus providing protection to these characters with less amount of description would not be very helpful and would increase complications for the judges. Thus, this is all what the test provides and does not give any more leads and guidance beyond this point.

The major drawback of the distinct delineated test is that the main feature or aspect or the amount of uniqueness that would make a character distinctively delineated and enough to provide them with the protection under copyright law has not been provided and mentioned under this test.

Therefore, the problem and confusion still exists with respect to the amount of distinctiveness in description of a character that would be enough to warrant the character’s right solely to the creator of the character. It somehow reflects the arbitrary decision making power that is there in the hands of the Judges to decide whether a character should be given protection or not. It is the judges who decide it according to their perceptions and analysis and this perception and analysis has no standard to match so that it can be a uniform structure to decide for warrant of protection to the characters. These judges act in the capacity of critics of literature and take decisions according to their own will and perceptions with respect to the aspect that whether a fictional character is deserving enough to get protection under copyright law or not and that whether a particular literary character has been developed sufficiently to be granted protection under copyright law.

There have been several contemplations made by judges. One of them being Justice Stewart. When he was asked about how he decides that whether a character is distinctly delineated and sufficiently developed then said that he decides when he sees it, that is, he decides so when he sees the literary character and then according to what it seems to him about the uniqueness in description of the character and the development of the character and that whether such character deserves protection under copyright or not.

In the case *Burroughs v. Metro-Goldwyn-Mayer*<sup>51</sup> discusses the issues that deal with the clarity of decision making and articulation as to whether a particular fictional character is distinctively delineated or not and what makes it so. The case dealt with the protection under copyright over a literary character 'Tarzan' and the decision given by the court did not provide any reasons whatsoever of the grounds on which they gave the decision. It was held by the court that the fictional character Tarzan is copyrightable as it consists of both the attributes that are required for it to be copyrightable. It is distinctively delineated and was sufficiently developed and hence the character was held to be copyrightable. However, the question that arises here is what were the attributes that made the character so distinctively delineated, identifiable, and developed? This was not answered by the court and was not even mentioned in the judgment that was provided by the court. The description of the fictional or literary character 'Tarzan' that was provided by the court did not reflect and describe the reason as to why the literary character 'Tarzan' was held to be distinctively delineated and developed. The following description was provided by the court:

"Tarzan is not a regular man but a mixture of an ape and a man and thus he is an ape-man. He has always stayed in the jungle and therefore he has connections to the jungle environment. He knows how to communicate to the other living beings such as animals birds etc. and has been brought up amongst them. He is yet to feel emotions that humans generally feel. With respect to his personality, he is strong and innocent, gentle and athletic at the same time and also youthful."<sup>52</sup>

This entire portrayal of the literary character 'Tarzan' can very well be related and applied to the description of 'Mowgli' who also is a literary character, brought up amongst the animals and birds,

---

<sup>51</sup>*Burroughs v. Metro-Goldwyn-Mayer* 519 F., Supp. 388 (S.D.N.Y. 1981), aff'd, 683 F.2d 610 (2s Cir. 1982).

<sup>52</sup>*ibid.*



never been in touch with humans, can sync easily with animals and is an innocent, strong, energetic, youthful human.

Thus, by comparing two characters, it can be said that reaching onto the solution as to why protection should be granted to Tarzan by comparison, is better. The comparison would be a better way of providing a convincing and non-arbitrary decision to the court but in this case there was nothing to compare as such as the issue that was raised in this case did not relate to infringement of a literary character. The issue was about the granting of right for usage of the character protected under copyright. Now the role of the court was to establish that whether the literary character Tarzan was descriptive enough such that it could be covered under copyright protection for the reason of settling the giving a non-exclusive license to prove that the usage of the literary character 'Tarzan' was correct and a right under the law of copyright. For this reason, it can be terminated under the provisions of the Copyright Act.

The confusion with regards to categorizing the characters into the developed and undeveloped category still remains as can be observed from the case above. Whether a character is sufficiently developed or not and how to decide so still remains an unanswered question. Without comparisons between the two characters would result in vague contemplations and with all these problems it has been tough to rate this test of distinct delineation as the right test for determining copyrightability of the character fictional in nature.

Now that the courts have been focusing more on the copyrightability of the fictional character, it can be observed clearly that due to improper guidance, the focus from determining infringement of the character has shifted all the way to the copyrightability of the character because the courts want to protect them. The courts have not been following the comparison rule that states that the two works in question should be compared to reach the decision of infringement of copyright, whereas the court has been concentrating solely on the first part of the Nichols test that dealt with distinctive delineation of a fictional character and sufficient development of the fictional character. The courts only by determining the latter above find out infringement without performing the former and thus take unsatisfactory decisions.

In another case of *Hopalong Cassidy*<sup>53</sup>, court did not focus on the infringement of the fictional character but it concentrated on the copyright of the fictional character. Hopalong was a character in a book. In the book, the personality of the literary character Hopalong was described as a tough, one who confronts and does not back off, one who is always prone to violence and is short tempered and chews tobacco. The book was eventually turned into a film. The film made after the book depicted the character of Hopalong differently. In the film, the character was portrayed emotional; he did not curse and was not how it was portrayed in the book. Even though there was no similarity as such between both the characters, that is, the fictional character mentioned in the book, and, the fictional character shown in the movie; it was held by the court that the literary character that is described in the book is distinctly delineated and therefore if a use of this character is done then such would amount to infringement of copyright. This would not be dependent on the similarity between the story lines but purely on the description and similarity between the two characters.

It was held by the court in this case that the character Hopalong portrayed in the movie had substantially similar traits as that of the literary character described in the book. However, there was not really much similarity between the two characters except for the name of the characters and the background of cowboy theme that was there. The traits and personality of the characters in fact were not similar and therefore it can be concluded that the courts have given their decisions without proper comparisons between the character, that is, the original character and the character that is supposedly infringing the original character, while determining copyrightability of the character. Just by using the phrases ‘distinctively delineated or sufficiently developed’ does not suffice the entire reasoning for the judgment that the judge has arrived upon.

It is necessary to compare the original and the allegedly infringing character so that a proper justification can be provided if a particular character does not get protection under copyright law. Similarly, the ‘Story being told’ test can also be said to have the drawbacks that the distinctive delineated test possesses. In the story, being told test the character that is the main lead around whom the story revolves and who takes the story forward is the criteria for determining the copyrightability of the character. That only this particular character of the story can be granted protection under copyright law. This test is performed separately from the distinctively delineated

---

<sup>53</sup>*Film video Releasing Corporation. v. Hasting* 509 F. Suppp. 60 (S.D.N.Y.), *aff'd*, 668 F.2d 91 (2d Cir. 1981).

test and is not performed in any combination with the distinctive delineation test. Thus, the results that come out from this test are equally confusing and unsatisfactory and therefore the issue stills remains the same.

#### **4. CONCLUSION**

It can be concluded that the graphic characters get their copyright protection comparatively easily than the fictional characters. When it comes to fictional characters, the courts are doubtful as there are tests that are supposed to be performed and the tests in themselves are not so accurate with their solutions that it gets tough for the courts to reach a solution for providing copyright protection to the fictional characters easily. Literary work has been defined under Section 2(n) of the Act where it has been provided with an inclusive meaning altogether. The meaning is supposed to be expressed and written down and then the way and manner in which it is written is what protection is given over. It is not just the character that is important to get protection under copyright but also the way such character takes the story forward is equally important as well.