

COPYRIGHTABILITY OF MOVIE CHARACTERS

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Introduction

Movies have become a part of our daily lives and we also closely relate ourselves with various characters that we see on screen. Those fictional movie characters have a great level of commercial appeal and popularity among the public. This article is premised on the right of protection held by the creators of these characters.

Copyrighting of movie characters helps in curbing the unauthorized exploitation of these creations. But this concept of legal protection has not been well-defined and not widely used in India. Here, the concept of copyrightability of characters and infringement of such copyrights are discussed. In addition to that, the option of trademarking of movie characters has also been explicated.

Recent issues, judgments from various courts and the tests used by courts have been discussed to expound the concept of legal protection for movie characters. A comparison has been made between the US and Indian scenarios for better understanding of the concept and its intricacies. This article tends to explore the copyright law and the alternative doctrines protecting movie characters.

Copyright Law

Copyright is a right given by the law to creators of literary, dramatic, musical and artistic works and producers of cinematograph films and sound recordings. In fact, it is a bundle of rights including, *inter alia*, rights of

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reproduction, communication to the public, adaptation and translation of the work. There could be slight variations in the composition of the rights depending on the work. (Section 14 of the Indian Copyright Act of 1957)

Copyright is available for the following classes of work:

- Original literary, dramatic, musical and artistic works;
- Cinematograph films;
- Sound recordings.²

According to Section 2(f) of the Indian Copyright Act of 1957, “**cinematograph film**” means any work of visual recording on any medium produced through a process from which a moving image may be produced by any means and includes a sound recording accompanying such visual recording and “cinematograph” shall be construed as including any work produced by any process analogous to cinematography including video films.

Obtaining copyrights

The creators put in their imagination and labour to give an expression to the idea of a character. No creator wants his work to be exploited and his primary aim will be to earn all the benefits and make best use of his creation. This is where ‘intellectual property rights’ come into the picture. Copyrighting will give a legal protection to the character and will give the creator a monopoly over his creation.

² A Hand Book of Copyright Law, available at, <http://copyright.gov.in/Documents/handbook.html>

On the question of what type of characters can be copyrighted, David Feldman has written: "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."³

The combination of these three elements determines a character's copyrightability. In simple terms, if a character is found to be unique, well-developed and has a personality of its own, copyright protection is granted to such a fictional movie character.

Ownership of Copyrights

The copyrights of a movie generally vests in the producer of the film. But in the case of *Malayala Manorama v. V.T.Thomas*⁴, it was held that, if the character is first developed as a literary or artistic work independent of such a film, outside the employment of the producer, and is adequately distinct so as to be granted copyright protection, it is the creator therein who is said to have the copyright protection over such characters.

Often, the characters and the actors portraying these characters on the screen become synonymous. For example, when we think about the character 'Baasha', it is Rajnikanth who comes to our mind first. So certain iconic characters are inseparable from the actors/artists who have played them on screen. They continue to perform in the garb of the character in television shows, award functions, in

³ Feldman David: Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection, California Law Review, Page 690, available at <http://scholarship.law.berkeley.edu/cgi/viewcontent.cgi?article=1833&context=californialawreview>

⁴ Malayala Manorama v. V.T.Thomas [AIR 1989 Ker 49], available at, <http://indiankanoon.org/doc/1514026/>

advertisements etc. Therefore, the rights of the producer and the actor/artist remain intertwined, blurring the lines between them.

For example: In the recent ad campaign of 'Lays' titled 'Lay's Best Buddies', the series of advertisements revolves around the "loveable rascal 'Sid'" who was the protagonist in the 2009 Bollywood film 'Wake Up Sid!'

This Lay's commercial is a unique one because unlike other celebrity endorsements, this one actually had the actor (Ranbir Kapoor) play a role from his own film.

Process Involved

The concept of granting copyrights to characters is not well defined and the methods used to grant copyrights to characters in India remains a grey area as the courts in India have not had many occasions to decipher the extent of copyright protection afforded to fictional characters of a cinematograph film. The courts in the US use two tests for deciphering the copyrightability of fictional characters.⁵

- **The Character Delineation Test**

This test, also called as the Nichols Test was laid down in the case of *Nichols v. Universal Pictures Corporation*⁶ and it states that when the character has been developed to such an extent that it can be delineated from the story itself, protection under copyright law may be granted. It is based on the premise that, the less developed the characters are, lesser are the chances that they can be

⁵ Fictional Characters and Copyright Law, an article written by Anand Desai and Shruti Chopra, available at, <http://www.ipera.in/ip-articles/item/91-fictional-characters-and-copyright-law.html>

⁶ *Nichols v. Universal Pictures Corporation* [45 F.2d 119 (2d Cir. 1930)], available at, <http://cyber.law.harvard.edu/people/tfisher/IP/1930%20Nichols.pdf>

copyrighted; and that is the penalty an author must bear for marking them too indistinctly.

In the case of *Anderson v. Stallone*⁷, it is stated that when a character is identified with specific character traits ranging from his speaking mannerisms to his physical characteristics, copyright protection is required to be granted to such characters.

- **The Story Being Told Test**

This test has been laid down in the case of *Warner Bros. Pictures Inc. v. Columbia Broadcasting System*⁸. When a character is an integral part of the story that it is the character itself which constitutes the story being told, copyright protection to that character can be granted. However, if the character is merely a chessman in the game of telling the story he is not within the area of protection afforded by copyright law.

From the above, it can be inferred that if the character can be delineated from the cinematograph film by way of specific character traits that have come to be recognised, and/or the character itself is the basis of the story of the cinematograph film, then copyright protection to the fictional character may be granted.

Infringement of copyrights

Exploitation or unfair use of a work without the authorization or permission of the author/owner is called infringement. Plagiarism and unauthorized character

⁷ *Anderson v. Stallone* [11 U.S.P.Q.2d 1161 (1989)], available at, <https://h2o.law.harvard.edu/collages/31817>

⁸ *Warner Bros. Pictures Inc. v. Columbia Broadcasting System* [216 F.2d 945 (9th Cir. 1954)], available at, <https://h2o.law.harvard.edu/collages/31816>

merchandising are two common methods of infringement involving copyrights of characters. Replication of characters for the purposes of review or parody is allowed under Section 52 of the Indian Copyright Act, 1957.

Character merchandising is ‘the adaptation or secondary exploitation of the essential personality features (such as the name, image or appearance) of a character by the creator of a fictional character or by one or several authorized third parties in relation to various goods and/or services with a view to creating in prospective customers a desire to acquire those goods and/or to use those services because of the customers’ affinity with that character.’⁹

Simply, character merchandising may be understood as a form of trademark licensing by which the creator of a fictitious character licenses the right to use the character with respect to merchandising of goods/services.

Nowadays, the producers/creators want to make full use of their creations and earn everything possible with a character’s popularity. They produce and sell merchandise on their own or they sell the licence to a merchandiser. In the 1930s, Walt Disney initiated character merchandising for the first time by granting licenses for the manufacture and distribution of mass market merchandise (posters, T-shirts, toys, badges and drinks) with the use of its famous characters like Mickey Mouse, Minnie and Donald.¹⁰

Unauthorized use of characters which have commercial appeal and public recognition on the merchandise sold by a person to earn profits with the character’s popularity would give rise to a claim of copyright infringement.

⁹ World Intellectual Property Organisation’s report on Character Merchandising, page 6, available at, http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo_inf_108.pdf

¹⁰ World Intellectual Property Organisation’s report on Character Merchandising, page 6, available at, http://www.wipo.int/export/sites/www/copyright/en/activities/pdf/wo_inf_108.pdf

For example: Amul advertisements are known for their excellent depiction of some of the burning issues in the country and also for the movie spoofs that they create. The use of famous movie characters on their advertisements might give rise to a claim for character merchandising.

Here are a couple of interesting cases involving the copyrights of movie characters:

- ***Sholay Media and Entertainment Pvt Ltd. v. RGV Productions Pvt. Ltd:***

The Delhi High Court slapped a fine of Rs. 10 Lakhs as punitive damages on Director Ram Gopal Varma for "intentionally and deliberately" coming out with the remake of the 1975 blockbuster 'Sholay', for violating the exclusive copyright vested with Sholay Media and Entertainment Pvt Ltd and for misusing the characters of Gabbar Singh, Jai, Veeru, Radha.¹¹

Justice Manmohan Singh:

*"The publicity material coupled with the impugned film, gives an overall impression that it is a remake of the film Sholay. The use of similar plot and characters in the impugned film coupled with use of the underlying music, lyrics and background score and even dialogues from the original film Sholay amounts to infringement of copyright of the film Sholay."*¹²

The movie was initially titled 'Ram Gopal Varma ke Sholay' and it was later renamed as 'Ram Gopal Varma ki Aag' after a suit was filed against RGV Productions Pvt. Ltd for infringement of copyrights of the movie title possessed by

¹¹ 'Ram Gopal Varma Fined 10 Lakhs For 'Distorting and Mutilating' Sholay', available at, <http://movies.ndtv.com/bollywood/ram-gopal-varma-fined-10-lakhs-for-distorting-and-mutilating-sholay-1212905>

¹² Sholay Media and Entertainment Pvt Ltd. v. RGV Productions Pvt. Ltd [CS (OS) 1892/2006], Para 36, available at, <http://lobis.nic.in/ddir/dhc/MAN/judgement/31-08-2015/MAN24082015S18922006.pdf>

Sholay Media and Entertainment Pvt Ltd. And after eight years, RGV Productions was sued again by Sholay Media and Entertainment Pvt Ltd. for infringement of copyrights of the story, music, dialogues and characters and that resulted in the recent judgment.

- *DC Comics v. Mark Towle*¹³:

The 9th Circuit Court of appeals in the US ruled that the ‘Batmobile’ is entitled to copyright protection as it is sufficiently distinctive to be protected as a work of authorship. Mark Towle runs a business called Gotham Garage, where he sells replicas of cars featured in movies and television shows. DC Comics sued him for copyright infringement in 2011 for selling replicas of the Batmobile from the 1960s TV show and 1989 Batman movie.¹⁴

Trademark Law

In addition to protecting a character under copyright law, a character can also be protected under trademark law as well. Characters as entertainment products function as marks that are recognized under the trademark law.

According to Section 2(i) (zb) of the Trademarks Act, 1999, “a trademark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others.”

Trademark law will not permit a graphic character to be trademarked solely for its own protection. It does permit the character's name and likeness to be

¹³ DC Comics v. Towle [No. 13-55484 (9th Cir. 2015)], available at, <http://cases.justia.com/federal/appellate-courts/ca9/13-55484/13-55484-2015-09-23.pdf?ts=1443027958>

¹⁴ ‘DC Comics Is Entitled to Copyright on Batmobile, Appeals Court Rules’, an article written by Eriq Garnder, available at, <http://www.hollywoodreporter.com/thr-esq/dc-comics-is-entitled-copyright-826678>

trademarked when the function of that trademark is to indicate the source of the products and services bearing that mark. This protection could prevent the exact duplication of the trademark owner's character or the imitation of that character where the likely result is to cause public confusion, mistake or deception with regard to source of the products or services that carry the indicia of the character.¹⁵

Trademark law can be used to protect distinct names, sounds, phrases associated with a fictional character, if the same are capable of being represented graphically. The owner of a trademark has the exclusive ownership rights over the same, including the right to commercially exploit it, and to further license the trademark as a means of commercial exploitation.

Where a fictional character has been granted such trademark protection and acquired such goodwill where the character has come to be identifiable in the minds of the public, and be associated with that particular character itself, the owner of the trademark has the exclusive right to benefit from the use of the character on goods and services, i.e. character merchandising.

For a fictional character to be granted trademark protection, it is essential that the character acquires a secondary meaning and distinctiveness. Further, any claim of infringement must show that use of such a fictional character, or its protected elements, if not restrained, would cause a likelihood of confusion, thereby diluting the commercial viability, reputation or brand equity of the trademark in question.

For example: MGM Studios, producers of the popular film series, 'Rocky', issued a Cease and Desist letter against a Mrs. Rebecca Schaefer, a US resident who had

¹⁵ 'Strategic Plan to Protect and Profit from Fictional Characters in Audiovisual Works', an article written by Jamie N. Pitts, available at, <http://www.hg.org/article.asp?id=18088>

planned to organize a 50 kilometer race. The race titled ‘Rocky 50k Fat Ass Run’ organized by Mrs. Schaefer was supposed to roughly retrace the steps of Rocky Balboa's training run in *Rocky II*.

The title of the race infringes the trademark of the name and the character ‘Rocky’ belonging to the movie studio. Mrs. Schaefer was told by producers of the film that the failure to rename the title and remove all references to Rocky would result in legal action. She's now inviting new names and ideas for her race on Facebook.¹⁶

Conclusion

Every creator deserves the right of his creation to be protected. Mere ideas of characters do not get copyright protection. Only when these ideas become an expression, the characters are granted copyright protection. Thus, a well delineated character can be granted copyright protection. But the category under which a character can be granted copyright protection still remains a mystery. It cannot be placed directly under the category of artistic work or literary work. There are no express provisions in Indian law which could grant copyright protection to movie characters and that suggests the need for establishing a separate legal category specifically for the protection of these characters.

¹⁶ ‘MGM Lawsuit Threat to Force Rocky 50K to Change Its Name’, an article written by Dan McQuade, available at, <http://www.phillymag.com/be-well-philly/2014/09/23/rocky-balboa-50k-name-change-mgm-lawsuit-threat/>