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Reproductive Freedom: Striking a Fair Balance between Copyright and Other Intellectual Property Protections in Cartoon Characters

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**REPRODUCTIVE FREEDOM:
STRIKING A FAIR BALANCE BETWEEN
COPYRIGHT AND OTHER INTELLECTUAL
PROPERTY PROTECTIONS
IN CARTOON CHARACTERS**

LAURIE RICHTER¹

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INTRODUCTION

Reproductive freedom, or lack thereof, has restricted some womens’ decision-making abilities when it comes to having children.² Individuals are clearly being deterred from making their own decisions when it comes to their bodily right to privacy.³ However, there are also people and small businesses losing their First Amendment rights in other ways, and they are being prevented from making their own reproductive choices in a completely different sense.⁴

What I am talking about is the current state of affairs regarding copyright law and the fair use exception. Stable intellectual property laws

1. M.B.A. University of Florida, projected December 2009; Juris Doctor, St. Thomas University School of Law, May 2006; M.S. Decision and Information Sciences, University of Florida, 2001; B.S., University of Florida, 2000; I sincerely thank my real property professor, Carol L. Zeiner, for her discussion, review, and confidence in drafting this article.

2. DOROTHY ROBERTS, KILLING THE BLACK BODY: RACE, REPRODUCTION, AND THE MEANING OF LIBERTY 3–4 (1997). Specifically, pregnant substance abusers, notably “[p]oor women, who are disproportionately Black” have been prosecuted for attempting to have children. *Id.* at 152–53. The 1996 federal welfare reform law permits states to enact child exclusion laws by “ending the New Deal Federal guarantee of cash assistance.” *Id.* at 202.

3. *Id.* at 197.

4. *Cf. id.* at 5 (stating that policies regarding reproductive freedom do not only affect Black Americans).

must be promulgated in order to allow for a harmonious relationship between individuals and large, greedy, corporate intellectual property owners so that individuals attempting to create a new art form will be able to do so without staying up at night worrying about the threat of a lawsuit. It has been said that “[t]he diversity and vitality of our culture depends on . . . maximiz[ing] artistic and intellectual freedom.”⁵ Therefore, we must find neutral ground between those who own a stake in intellectual property, and those who wish to enjoy it or otherwise expand upon an idea that may have been created decades ago.

The purpose of this article is to express the reasons why copyright statutes should be overhauled to provide explicit rights reserved to the public, as opposed to the present structure of copyright law, which provides rights to a copyright owner, subject to the many exceptions that have sprung up over the past few years.⁶ Some of these exceptions, which seem to have engulfed the basic premise of copyright theory, are the broadly framed but vague protections offered by the fair use doctrine.⁷ These rights include the right of a lawful owner of a copy to *sell or otherwise dispose of the copy* without the authority of the copyright owner, and the right of creative persons to independently create any work, even if it ends up being an exact copy of the original version.⁸ The fact that authors enjoy

5. MARJORIE HEINS, “THE PROGRESS OF SCIENCE AND USEFUL ARTS”: WHY COPYRIGHT TODAY THREATENS INTELLECTUAL FREEDOM 1, 3 (2d ed. 2003), *available at* <http://www.fepproject.org/policyreports/copyright2d.pdf>.

6. *Id.* at 2.

7. *Id.* at 11.

8. John Moetelli, *The Copyright of Visual Art*, THE U.S. COPYRIGHT OFFICE, 2004, <http://www.uspatentinfo.com/copyright.html>. Couple those exceptions with the recent detailed legislative initiatives in copyright law such as Section 117 of the Copyright Act, The Digital Millennium Copyright Act (DMCA), and the Copyright Term Extension Act, and after all the exceptions have been applied and compared to general copyright theory, it clearly leaves some people in the dark about where to draw the line between what is fair use versus what is deemed a prohibited use. *Id.* The Computer Software Copyright Amendments of 1980, codified as Section 117 of the Copyright Act, “permits the owner of a copy of a computer program to make an additional copy of the program solely for archival purposes.” *Id.* The DMCA, passed in 1998, along with the Sonny Bono Copyright Term Extension Act (the CTEA or the Act), which extended copyright protection for another twenty years, was intended to “update copyright law for the digital age” by detailing regulations that online service providers must follow to obtain protection from liability for infringement. *Id.* The DMCA prohibits circumventing “a technological measure that effectively controls access to a work protected” under the Copyright Act. 17 U.S.C. § 1201(a)(1)(A) (2008). The DCMA was envisioned to protect copyright owners of digital media when sneaky people try to break into digital locks and freely distribute copyrighted material. Brett Burney, *Chasing Virtual Pirates with the Digital Millennium Copyright Act*, 23 GP SOLO 40, 41 (2006). The DMCA only prohibits unauthorized access to a copyrighted work; it does not prevent unauthorized copying of a copyrighted work so that the fair use doctrine maintains teeth. *Id.* at 42. In a recent decision, a statutory award of \$6,018,700.00 in damages under the DMCA against a small online retailer was deemed fair because the retailer

increased term lengths for their copyrighted items essentially increases restrictions to the general public regarding property rights. Moreover, the exclusivity that the copyright holders are now able to enjoy does not seem to benefit anyone but large companies and perhaps Congress. This article will clarify why and how copyright law should be revamped, by focusing in on one type of creative work, cartoon characters. Contemporary theories of copyright law will be contrasted to historical underpinnings and case law concerning the copyrightability of characters. Additionally, this Comment will analyze the migration of cartoon characters into trademark law.⁹

Part I reviews the role played by federal copyright law in the area of cartoon characters, and assesses the impact that the characters will have on the economy in the coming years as artists, individuals, and businesses begin to prepare for the release of extremely famous characters into the public domain, as they are being taken out of concealment from public use.¹⁰ Likewise, this Comment will point out that although children's entertainment is a competitive market internationally, there are still many opportunities for individuals and corporations here in America, but only if we loosen the rigid and complex laws currently in place.¹¹ To be sure, if the public is not allowed to parody, copy or transform cartoon characters when they are legally supposed to enter the public domain, when the

was aware that he was violating the DMCA when he sold copyright infringing devices, any uncertainty as to the exact amount sold was the result of the alleged infringer's own conduct, and the award was necessary to discourage wrongful conduct by other retailers. *Sony Computer Entm't Am., Inc. v. Filiplak*, 406 F. Supp. 2d 1068, 1075–76 (N.D. Cal. 2005).

9. Noting also the fact that the Framers of the Constitution felt the “public domain to be a vital part of the cultural landscape.” Franklin Harris, *Copyright Case Has Implications for Future of Entertainment*, Oct. 17, 2002, <http://home.hiwaay.net/~tfharris/pulpculture/columns/021017.shtml>. Copyright law generally involves art, culture, and imagination, which is why there are many unknowns associated with it, and there is also the fact that it is constantly changing. Marjorie Heins, *The Next Frontier: “Intellectual Property” and Intellectual Freedom*, THE FREE EXPRESSION POLICY PROJECT, Oct. 18, 2002, <http://www.fepproject.org/commentaries/coloradointellprop.html>.

10. The Founding Fathers “wanted to fill up the public domain as quickly as possible and ensure a constant flow of fresh information.” Larry Downes, *‘Free the Mouse’ for Creativity’s Sake*, USA TODAY, Oct. 7, 2002, http://www.usatoday.com/news/opinion/editorials/2002-10-07-oplede_x.htm.

11. Katherine Hendricks & Paul F. Norris, *Multimedia and Entertainment Law Protection*, http://www.hllaw.com/a_lawprotection.html (last visited Oct. 30, 2004). “Due to the love and affection of the American public for fictional characters, the motion picture industry has long recognized the economical importance of protecting these characters through copyright.” Daniel M. Faco, *Copyright Extension and the Motion Picture Industry—The Rationality Behind the Bono Act*, Spring 1999, <http://www.hottopos.com/harvard3/daniel.htm> (last visited Oct. 30, 2004). There is a “long-term impact on innovation and entertainment” when copyright laws are extended to cartoon characters. Downes, *supra* note 10.

depictions finally do enter the public domain, the public will have no choice but to exploit a company's good name or to place the cartoon characters in situations they otherwise would not find themselves in.¹²

In Part II, the article will provide an overview of the intellectual property protections available to characters and will focus on how corporations are preparing themselves and protecting ownership rights to their characters.¹³ The last aspect of Part II highlights how corporations are beginning to control other areas of the character industry in order to secure the most market share now, before it is too late and they lose total control over their character monopolies.¹⁴ What is not protected by copyright seems to be covered by either trademark protection or unfair competition laws, and the article will also observe that in the end, what is actually being sent into the public domain amounts to very little.¹⁵

Finally, Part III of the article proposes an alternative to our current system of copyright law with regard to the doctrine of fair use. The proposal centers on the current circuit split regarding the fair use doctrine as applied to trademark law, and specifically the adoption of the fair use law currently in place in the Second, Tenth, and D.C. Circuits, in which the courts require a showing of willful infringement before profits are awarded.¹⁶ This theory will prove that the public may utilize characters, while simultaneously providing corporations the protection and incentives they need to continue to profit in a competitive marketplace.¹⁷ It should

12. Lloyd L. Rich, *Protection of Fictional Characters*, 1998, <http://www.publaw.com/fiction.html>. Graphical characters and cartoons are part of our culture, and their exploitation has become a normal occurrence. *Id.*

13. "Maybe we ought to stop coddling the Scrooge McDucks and free Steamboat Willie." James Surowiecki, *Righting Copywrongs*, THE NEW YORKER, Jan. 21, 2002, http://www.newyorker.com/printable/?talk/020121ta_talk_surowiecki.

14. *Id.* For example, Disney intimidated daycare centers in Florida that painted characters on their walls, which were similar to Disney's own characters, in a way discouraging free advertising. *Id.* Thus, merely "creating a balloon version of a popular character" may cause copyright and trademark infringement. Todd Neufeld, *Is It Legal to Create Balloon Versions of Popular Characters?*, BALLOONS AROUND THE WORLD, 2008, <http://www.balloonhq.com/column/tn/apr02>.

15. Rich, *supra* note 12 (noting that the overlapping protection that copyright, trademark and unfair competition law provides has virtually developed a new body of law which is intended only to protect fictional characters) (citing Michael Todd Helfand, *When Mickey Mouse Is as Strong as Superman: The Convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters*, 44 STAN. L. REV. 623, 623 (1992)).

16. Debra Resnick, *Maximum Copyright Statutory Damages Award Gives Meaning to the Word "Justice,"* 24 NO. 1 INTEL. PROP. L. NEWSL. 16, Fall 2005, at 18; *see also* Golan v. Gonzales, 501 F.3d 1179, 1195 (10th Cir. 2007) ("[Fair use defense] allows the public to use not only facts and ideas contained in copyrighted work, but also expression itself in certain circumstances.").

17. *Id.* at 1188. Legislators have in the past, attempted to balance the competing interests of

also drastically reduce the amount of litigation currently flooding our system regarding this gray area. In conclusion, the article will demonstrate that conflict arises when a copyright ends, forcing intellectual property owners to rely largely on trademark protection, and therefore, copyright law should integrate with some of the successful trademark theories. This alternative will enhance the uniformity of intellectual property laws, decrease confusion among judicial circuits considering these issues today, and provide stability and reassurance to individuals and small businesses who gamble everyday when they attempt to paint a picture of a cartoon on a preschool wall or distribute depictions of cartoon characters to the students in their classes for educational purposes.

I. THE FOUNDATION OF CARTOONS AND COPYRIGHT

A. THE CARTOON AS A COPYRIGHTED WORK

A protectable fictional character is: (1) an idea or a general concept; (2) the “*expression* or detailed development of an idea;” or (3) a name.¹⁸ Original cartoon characters are protected from copying¹⁹ at the moment

the corporations that own the copyright, with the interests of the public, who feel that they have a right to use technology in order to enjoy characters in any way they would like to. *Id.* at 1194.

18. Helfand, *supra* note 15, at 623 (citing Leon Kellman, *The Legal Protection of Fictional Characters*, 25 BROOK. L. REV. 3 (1958)).

19. To the extent that there is a valid copyright, the owner is afforded a virtual monopoly because they have the exclusive rights to reproduce, copy, sell, publish, display, perform, adapt, and license the work to others. See 17 U.S.C. § 106 (2004). The U.S. Copyright Act specifically enumerates six rights that the owner of a copyright has the exclusive interest in. *Id.*; *Columbia Pictures Indus., Inc. v. Redd Home, Inc.*, 749 F.2d 154, 158 (3d Cir. 1984) (noting that because the rights granted by section 106 are separate, distinct, and severable from one another, even if one is granted, it does not waive any of the other exclusive rights); see M. Elaine Buccieri, *Cause of Action for Copyright Infringement Under the Federal Copyright Act of 1976, as Amended*, 9 CAUSES OF ACTION 2d 65 (2008); see also Heins, *supra* note 5, at 4 (“Even during the *limited time* of copyright protection, the *exclusive right* is not perfect or absolute.”). The copyright will attach to a work, such as a character, when it is created or first fixed in a tangible medium. 17 U.S.C. § 101 (2004). Thus, anything from an e-mail to a doodle on a napkin is automatically copyrighted the moment it is *fixed in a tangible medium*. See Robert S. Boynton, *The Tyranny of Copyright?*, N.Y. TIMES, Jan. 25, 2004, <http://www.nytimes.com/2004/01/25/magazine/25COPYRIGHT.html?ex=1390366800&en=9eb265b1f26e8b14&ei=5007&partner=USERLAND>. Therefore, it has been claimed that registration of a copyright is not needed since protection will likely exist in any circumstance. See 17 U.S.C. § 408(a) (2004) (“Registration is not a condition of copyright protection.”); see also *Rottlund Co. v. Pinnacle Corp.*, No. 01-1980, 2004 U.S. Dist. LEXIS 16723, at *24 (D. Minn. Aug. 20, 2004) (citing *Arthur Rutenberg Homes, Inc. v. Drew Homes, Inc.*, 29 F.3d 1529, 1531 (11th Cir. 1995) (pointing out that copyright protection exists whether or not the item is registered since registration is a separate issue from the existence of the copyright itself)). The main difference between when a work is registered versus not registered is that if it is registered, the owner may

they are first fixed in a tangible form.²⁰

Judge Learned Hand first articulated the standard of whether characters should be afforded copyright protection in the case of *Nichols v. Universal Pictures Corp.*²¹ In *Nichols*, Judge Hand suggested that characters should be fully developed and carefully articulated before they should be considered for protection.²² Additionally, Judge Hand noted “the

elect statutory damages in addition to the remedies available if the work is not registered such as an injunction, recovery of profits, and other provable damages. Moetteli, *supra* note 8. The reason most copyright owners will seek a registration is not because it is required in order to own the copyright, but rather because it helps to enforce the rights under the copyright with the United States Copyright Office. See 17 U.S.C. § 411 (2005).

20. 17 U.S.C. § 101 (2004). The mere fact that an infringer transforms an image from two dimensional to three dimensional does not allow them to escape liability for creation of the unauthorized derivative work. Moetteli, *supra* note 8. Title 17 of the United States Code, specifies what can be classified as copyrightable. See 17 U.S.C. § 101 (2004). The eight classes of artistic works of authorship that may be copyrighted on a federal statutory basis are: (1) literary works; (2) musical works; (3) dramatic works; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. See 77 AM. JUR. *Trials* § 449, § 6, 11 (2008) (citing Registration of Copyright, 37 C.F.R. § 202.3(b) (2008)) (noting that literary works include “writings, letters, prints, pictures, paintings, photographs, pictorial illustrations, statutes, and other artistic productions, as well as musical, dramatic, and literary compositions, either written or printed . . . [which] includes at least all matter copyrightable under the federal statute” and generalizing that works of visual arts include both published and unpublished works such as 2-D and 3-D works of fine, graphic, and applied arts; photos, prints, reproductions, maps, globes, charts, technical drawings, diagrams, models and graphic labels and advertisements); see also GREGORY J. BATTERSBY & CHARLES W. GRIMES, *THE LAW OF MERCHANDISE AND CHARACTER LICENSING* 7 (2003) (citing 17 U.S.C. § 102(a)(5)) (asserting that the specific artistic rendition of a particular character is protectable only under the copyright laws, as a *pictorial or graphic work*); see also 17 U.S.C. § 102 (1988); Hendricks & Norris, *supra* note 11 (stating that animating cartoons are often protected by copyright); 77 AM. JUR. *Trials* § 449, § 11 (2008). Although not specifically enumerated in the statute, cartoons, cartoon characters, and the like are also protectable under copyright laws and represent one of the most profitable segments of statutorily protected copyrightable works. See 17 U.S.C. § 102 (pointing out that characters may fall under any of the following statutory categories: (1) literary works; (2) musical works; (3) dramatic works; and (4) pictorial, graphic and sculptural works); see also *Walt Disney Prod. v. Air Pirates*, 345 F. Supp. 108, 113 (N.D. Cal. 1972) [hereinafter *Walt Disney Prod. I*] (holding that the graphic depiction of cartoon strip and comic book characters are generally protected as component parts of copyrighted works); DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.12 (1998) (recognizing that the prevailing view is to afford copyright protection to characters even though there has been some inconsistency in the cases).

21. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121–22 (2d Cir. 1930).

22. *Id.* at 121. Although the plaintiff alleged that a copyright in her play, concerning a marriage between a Jewish man and an Irish woman and the resulting difficulties between both families, was infringed by defendant’s movie about the marriage of an Irish man and a Jewish woman, Judge Hand determined that none of the plaintiff’s characters were developed fully enough to be copyrighted. *Id.* at 121–22. This standard is often referred to as the *well-developed character test*, and another test that is applied in some courts to determine the standard of whether a character is sufficiently developed to be awarded a copyright, is called the *story being told test*. Hefland, *supra* note 15, at 632. That test defines a character as able to be copyrighted if it will

less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”²³ If that were still the bright line rule defining when infringement occurs in a copyright sense versus when the use is deemed fair use, we may not be facing the situation we are in now. That is, individuals racing to the copyright office for new versions of previously created characters that add no value or interest to their past counterparts, in an effort to avoid copyright infringement litigation.²⁴

constitute the story being told. Id. To be copyrighted, the original work must be sufficiently developed and refined beyond a fact or idea since anyone may freely copy another’s facts or ideas. *See* 77 AM. JUR. *Trials* 449 §9 (2008) (explaining that the requirement of originality need not be particularly stringent and only requires the author to select and arrange independently and display a minimal level of creativity); *see also* 17 U.S.C. § 102(b); *Rottlund Co.*, No. 01-1980, 2004 U.S. Dist. LEXIS 16723, at *47 (citing *Feist Publications, Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344 (1991)) (“Facts and ideas are not entitled to copyright protection.”); *CDN Inc. v. Kapes*, 197 F.3d 1256, 1259 (9th Cir. 1999) (detailing that the originality required to afford copyright protection is a minimal level); *Welles v. Columbia Broad. Sys., Inc.*, 308 F.2d 810, 814 (9th Cir. 1962) (holding that in order to be protected by copyright, the author’s mode of expression must be original); *Malkin v. Dubinsky*, 203 N.Y.S.2d 501, 506 (N.Y. Sup. Ct. 1960) (referencing originality as that the main factor to consider under the United States Constitution in determining if a matter is copyrightable); Christine Nickles, *The Conflicts Between Intellectual Property Protections When a Character Enters the Public Domain*, 7 UCLA ENT. L. REV. 133, 139 (1999) (citing *Titan Sports v. Turner Broad. Sys.*, 981 F. Supp 65, 68 (D. Conn. 1997)) (determining that a character must be sufficiently developed to be worthy of copyright protection); Harvard Law Review Association, *The Protection Afforded Literary and Cartoon Characters Through Trademark, Unfair Competition, and Copyright*, 68 HARV. L. REV. 349, 356 (1954) (generally stating that statutory copyright protects expressions and not ideas); 77 AM. JUR. *Trials* 449 § 6 (citing *Golding v. R.K.O. Pictures*, 35 Cal. 2d 690, 695 (Cal. 1950)) (copyright protection does not extend to ideas, but only to the form or mode of expression); Ronald L. Panitch, *Course Overview: Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel*, SH085 A.L.I.-A.B.A. 361, 378 (2003) (Continuing Legal Education A.L.I.-A.B.A. Course of Study) (mentioning that the exact degree of originality required for copyright protection has not been clearly defined by the courts or the legislature).

23. *Nichols*, 45 F.2d at 121. Judge Learned Hand went into great detail to define the moment at which an idea is no longer too vague or abstract where it is not merely an idea being protected, so that the work may become “sufficiently concrete or detailed to constitute protected expression.” *Rottlund Co.*, No. 01-1980, 2004 U.S. Dist. LEXIS 16723, at *47 (quoting *Sparaco v. Lawler, Matusky, Skelly, Eng’rs, LLP*, 303 F.3d 460, 469 (2d Cir. 2002)). *See also Nichols*, 45 F.2d at 121 (discussing the definition of copyright protection and stating that “[n]obody has ever been able to fix that boundary, and nobody ever can”). More recently, it was held characters, particularly Mickey Mouse or James Bond, are sufficiently developed since there is a visual image immediately associated with it. *See Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co., Inc.*, 900 F. Supp. 1287, 1303 (C.D. Cal. 1995) (finding that James Bond character requires greater protection of the fictional works).

24. There is no bright line rule as to exactly how developed or refined a character is required to be before its form of expression can be considered for copyright protection; it is usually determined on an individual basis. *See NIMMER, supra* note 20, at § 2.12 (stating that it would be too restrictive if there were *hard and fast rules* as to how developed a character must be in order to be considered copyrightable); *see also* United States Patent and Trademark Office, *What Are*

The 1914 case of *Hill v. Whalen & Martell* held that a defendant's mere use of a plaintiff's copyrighted cartoon was sufficient to label it as copyright infringement, regardless of the defendant's intent to spoof or criticize the cartoon if subsequent characters were extremely similar to those originally created by the copyright holder.²⁵ In *Hill*, the main characters of the show in question were virtually exact replicas of the plaintiff's characters; even their names mirrored the names of the copyrighted characters.²⁶ The court held that the attempted "defense of parody or burlesque was clearly invoked in bad faith, as an attempt to justify a taking designed substantially to satisfy the demand for the copyrighted original," and further held that the copies directly affected and injured the plaintiff's original artwork and probably reduced the public demand for it.²⁷

More recently, a California District Court ruled that when a *counter-culture* comic book used seventeen popular characters in overt sexual and drug situations, it too should be deemed copyright infringement.²⁸ The defendants in that case placed "well-known Disney cartoon characters in incongruous settings where they engaged in activities clearly antithetical to the accepted Mickey Mouse world of scrubbed faces, bright smiles and

Patents, Trademarks, Servicemarks, and Copyrights?,

<http://www.uspto.gov/web/offices/pac/doc/general/whatis.htm> (stating that copyrights protect the form of expression and not the subject matter).

25. *Hill v. Whalen & Martell*, 220 F. 359, 359-60 (D.N.Y. 1914). The case concerned two cartoon characters which, in just three short years, generated an estimated \$60,000.00-\$70,000.00 in royalties. *Id.* at 359. Further, that case articulated that a possible test to be used to measure whether the use is permitted or forbidden is, "whether or not so much as has been reproduced as will materially reduce the demand for the original. If it has, the rights of the owner of the copyright have been injuriously affected." *Id.* at 360. However, that case went on to disqualify as an act of infringement a "criticism of the original work, which lessen[s] its mone[tary] value by showing that it was not worth seeing or hearing" *Id.* The court acknowledged that copyrighted works are subject to fair criticism, regardless of whether it is serious or humorous criticism. *Id.* Additionally, the court asserted that quotations may be taken from characters and characters may be "described by words, representations, pictures, or suggestions." *Id.*

26. *Hill*, 220 F. at 359. The names used by the defendant were *Nutt* and *Giff* and the court felt that their competition against *Mutt* and *Jeff* would decrease the audience's interest in the original characters since people would no longer spend their money to view the original characters after seeing the copies. *Id.* at 359-60. Likewise, everybody understood the replica characters to be in substantial harmony with the characters created by the original artist. *Id.* at 359.

27. *Berlin v. E.C. Publications*, 329 F.2d 541, 544-545 (2d Cir. 1964) (quoting *Hill*, 220 F. 359, 359).

28. *Walt Disney Prod. v. Air Pirates*, 581 F.2d 751, 752-760 (9th Cir. 1972) [hereinafter *Walt Disney Prod.* 2]; see also Justin Hughes, "Recoding" *Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923, 984-85 (1999) (citing to another use of Disney characters in a sexual manner).

happy endings.”²⁹ The characters in the *Air Pirates Funnies* magazine were said to be extraordinarily similar to Disney characters, and like the characters in *Hill v. Whalan & Martell*, they even had the same or similar names as Disney’s copyrighted characters.³⁰

On appeal, the Ninth Circuit affirmed, ruling that Mickey Mouse and other Disney characters are protectable characters, even outside the stories in which they appear, because the characters had “widespread public recognition.”³¹ The Court attributed this to the fact that “a comic book character, which has physical as well as conceptual qualities, is more likely to contain some unique elements of expression” and be fully developed than other typical literary characters.³² As such, these cartoon characters are said to be more copyrightable. The Court further restricted the defendants by noting that since they could have expressed their ideas without replicating the copyrighted characters, not even the First Amendment would protect them.³³

However, this holding was not without its critics. Some believed the cartoon *funnies* should have remained protected since they were not being distributed to children.³⁴ Likewise, those who strongly support protection for parodies have stated that the adult magazine’s intent and market was clearly in stark contrast to the audience that Disney was attempting to target, and therefore, the consumer groups did not overlap—posing no threat to Disney.³⁵ For example, “[s]omeone interested in reading a Disney

29. *Walt Disney Prod. 2*, 581 F.2d at 753 (1978) (quoting *Note, Parody, Copyrights and the First Amendment*, 10 U.S.F. L. REV. 564, 571 (1976)); see also Hughes, *supra* note 28, at 984 (noting that the image of Mickey Mouse may “suffer disutility when [the] wholesome cultural [icon] is suddenly recoded to express more prurient interests of the society”); cf. Matthew A. Kaplan, *Rosencrantz and Guildenstern Are Dead, but Are They Copyrightable?: Protection of Literary Characters with Respect to Secondary Works*, 30 RUTGERS L.J. 817, 843 (1999) (stating that copyright laws may allow the authors “to ignore the market” and public demand).

30. *Walt Disney Prod. 1*, 345 F. Supp. at 110; see also Helfand, *supra* note 15, at 628 (noting that the “Walt Disney Company does not permit its licensees to ‘depict Mickey Mouse in an unattractive manner, such as drinking liquor’” (quoting *Walt Disney Co. v. Best*, No. 88 CIV. 1595 (SWK), 1990 WL 144209 *1 (S.D.N.Y. Sept. 26, 1990))).

31. *Walt Disney Prod. 2*, 581 F.2d at 757–58. In *Walt Disney Prod. 2*, the Ninth Circuit showed an active willingness to protect Disney characters in particular. See *id.* at 751; see also Helfand, *supra* note 15, at 643–644 (discussing Ninth Circuit opinions); see also *Walt Disney Prod. 1*, 345 F. Supp. at 113 (noting that the characters have “achieved a high degree of ‘recognition’ or ‘identification.’” (“)).

32. *Walt Disney Prod. 2*, 581 F.2d at 755.

33. *Id.* at 759; see also 18 AM. JUR. 2D *Copyright and Literary Property* § 238 (2008) (noting that copyright cases have rejected First Amendment defense).

34. Hughes, *supra* note 28, at 984–985.

35. *Id.* at 985 (citing Subeil Joseph Totah, *In Defense of Parody*, 17 GOLDEN GATE U. L. REV. 57, 74 (1987)); see also Nimmer, *supra* note 20, at 13-208 (“[T]he function of the copyrighted work is not undermined by parody, as the owner will typically not exploit the

comic book would not turn to Air Pirate Funnies instead, and vice versa. . . . Therefore, [these groups argued,] the fair use defense should be permitted, even if there is near verbatim copying of the original.”³⁶

B. THE ECONOMIC IMPACT OF CARTOONING AND CONTEMPORARY COPYRIGHT CASE LAW

The financial value of a character will usually endure well after its introduction to the market. As such, cartoon characters clearly have an enormous economic impact on society.³⁷ With the advent of the Internet

potential market for skewering his own property.”).

36. Hughes, *supra* note 28, at 985 (quoting Totah, *supra* note 35, at 74).

37. See Daphne Lee, *Beloved Bear of Little Brain*, THE STAR ONLINE, Oct. 10, 2004, <http://thestar.com.my/news/archives/story.asp?ppath=%5C2004%5C10%5C10&file=/2004/10/10/features/9073256&sec=features>; see also Helfand, *supra* note 15, at 626 (“Licensing fictional characters and selling products featuring these characters generates billions of dollars a year.”). Extremely profitable fictional characters have been the inspiration for other things, such as toys, dolls, action figures, lunchboxes, calendars, posters, paintings, figurines, teapots, magazines, pencils, book publishing, newspapers, comic books, costumes, clothing, dishes, wallpapers, bedspreads, furniture, board games, web sites, video games, fast food restaurants, theme parks and resorts, property development, cruise lines, home videos, television shows and cable television, record labels and music publishing, theatrical production, sports franchises, radio broadcasting, film distribution, movies and movie sequels. See, e.g., ketupa.net Media Profiles Disney, <http://www.ketupa.net/disney.htm> (last visited Sept. 18, 2008) (indicating Disney holdings in the areas mentioned). Many of the aforementioned items may be considered “useful articles,” and possibly not subject to copyright protection. See, e.g., Chosun Int’l, Inc. v. Chrisha Creations, Ltd., 413 F. 3d 324, 328 (2d Cir. 2005) (finding separable elements in a Halloween costume eligible for copyright protection may be copyrightable, even if the costume as a whole is not copyrightable based on its utility). The court found that although clothing articles are traditionally useful articles, features of the clothing that are conceptually separable from the utility of the clothing are copyrightable. *Id.* Since the financial value of characters normally lasts well past their original appearance, there is much at stake for various parties. Rich, *supra* note 12. The Electronic Frontier Foundation’s (EFF[’s]) goal is to force characters into the public domain when they expire, and therefore the EFF has been protesting against the Consumer Broadband and Digital Television Promotion Act, which desires to create even more barriers for individuals to be able to copy previously copyrighted works. Graeme W. Austin, *Does the Copyright Clause Mandate Isolationism?*, in 26 COLUM. J.L. & ARTS 17, 18 (2002); see also Jason Krause, *The Education of Larry Lessig*, A.B.A. J., Jan. 2004, at 39–40 (construing Lessig’s point that the Congressional Research Service estimates that only two percent of works published between the years of 1923–42 have any commercial value, and the other 98 percent are also restricted so that we may protect the other two percent and profitability for those copyright owners). Recently, the United States Copyright Office has stated overall that the only works that have ended up in the public domain are those that were published or copyrighted prior to January 1, 1923, and in which the copyright has expired by law. U.S. Copyright Office, *How to Investigate the Copyright Status of a Work*, Circular 22, <http://www.copyright.gov/circs/circ22.html>. The EFF has been a leading force in promoting alternatives to the controlled copyright system that we are familiar with today. Heins, *supra* note 5, at 45. Many projects have been developed which are aimed at housing parodies and protests against corporate trademark owners in an effort to “protect free expression against unwarranted

and greater access to historically restricted media, interest in vintage figures has skyrocketed in recent years, and the demand for certain characters will likely grow indefinitely for years to come.³⁸

In 1998, the Walt Disney Company lobbied to Congress for a longer copyright term, and after fighting tooth and nail to retain ownership of Mickey Mouse when the character's copyright registration was set to expire, Disney eventually achieved the results it long-awaited.³⁹ That year, the corporate giant known for its trademarked mouse ears, managed to extend copyright protection on its copyrighted work for an additional twenty (20) years, and in the process, expanded copyright terms for all others as well.⁴⁰ In just two (2) years, Disney spent more than \$6.3

legal threats" *Id.*

38. See generally Lee, *supra* note 37 (stating that Winnie the Pooh currently earns Disney approximately one billion dollars per year, which amounts to the same as Mickey Mouse, Minnie Mouse, Donald Duck, Goofy, and Pluto combined).

39. Joseph P. Liu, *Copyright and Time: A Proposal*, 101 MICH. L. REV. 409, 421 (2002) (quoting Robert P. Merges, *One Hundred Years of Solicitude: Intellectual Property Law 1900–2000*, 88 CAL. L. REV. 2187, 2236 (2000)) (noting that an extension "was the Walt Disney Company's 'highest priority' in the 1998 legislative session of Congress."). Described as one of the leading sponsors of the entertainment industry's interests, the late singer and Republican congressman Sonny Bono, lobbied for the Copyright Term Extension Act (the CTEA or the Act), which was signed into law on October 27, 1998. Mark Rose, *Copyright and Its Metaphors*, 50 UCLA L. REV. 1, 2 (Oct. 2002). Lawrence Lessig has stated: "Washington is obsessed with intellectual-property rights. It lives under the mistaken idea that stronger IP always means a stronger economy. No doubt it means larger campaign contributions, but whether it means a better market is a tougher question." Lawrence Lessig, *The Problem with Patents*, THE INDUSTRY STANDARD, Apr. 23, 1999, <http://www.lessig.org/content/standard/0,1902,4296,00.html>.

40. See Liu, *supra* note 39, at 421–22; see also Katherine C. Spelman et al., *Copyright Current Developments 2004*, 799 PRAC. L. INST. 129, 233 (July 2004). Under the CTEA, the limited time of copyright is now the author's life plus seventy (70) years for individuals, and ninety-five (95) years for most copyrights held by corporations. Christina N. Gifford, *The Sonny Bono Copyright Term Extension Act*, 30 U. MEM. L. REV. 363, 379 (2000). This means that a copyright can now survive for another twenty (20) years after the owner has died, leaving control of the character to his or her heirs. *Id.* at 383. Therefore, any work that would have entered the public domain in 1998 will now remain under copyright protection until December 31, 2018. Liu, *supra* note 39, at 413. Also, any copyright that was already in its renewal term at the time that the Act became effective was afforded a copyright term of ninety-five (95) years from the date the copyright was originally secured. 17 U.S.C. § 304 (2004). However, under no circumstances will the Act protect any work that has already entered the public domain. Jaime Davids, *Eldred v. Ashcroft: A Critical Analysis of the Supreme Court Decision*, 13 DEPAUL-LCA J. ART & ENT. L. 173, 174 (2003). Likewise, valuable songs such as *Happy Birthday to You* and *This Land Is Your Land* also had their copyrights extended due to the CTEA. Kembrew McLeod, *Confessions of an Intellectual: Danger Mouse, Mickey Mouse, Sonny Bono, and My Long and Winding Path as a Copyright Activist-Academic*, LOOKSMART, Feb. 2005, http://www.findarticles.com/p/articles/mi_m2822/is_1_28/ai_n13716974/print. Since the purpose of extending copyright is to properly protect the author from derivative works that reflect badly on the author personally, it makes little sense to extend copyright for so long after the

million⁴¹ on the cause, and it appears to have paid off since the result was the creation of the CTEA.⁴² Due to the passage of the CTEA, the 1928 copyright to Mickey Mouse as originally seen in the short animated film STEAMBOAT WILLIE,⁴³ which was originally set to expire in 2003, is now the sole possession of the Walt Disney Company until 2023.⁴⁴ As such, Disney will generate enormous profits for many more years based solely on maintaining this one character.

Because the First Amendment aims to forbid improper restraints on voluntary public expression of ideas, the Amendment seeks to shield individuals who wish to speak or publish, when others desire that person refrain from doing so.⁴⁵ The relationship between the First Amendment and the Copyright Clause in particular, was examined in detail in *Harper & Row Publishers v. Nation Enterprises*, where it was declared that “it should not be forgotten that the Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one’s

author’s death or to extend protection on innocent art and harmless children’s songs.

41. Davids, *supra* note 40, at 200; see Mark R. High, *Disney Directors Survive Attack on Magic Kingdom: Learning from the Trial Court’s Opinion*, BUS. LAW TODAY, Jan./Feb. 2006, at 19–22 (calculating Disney’s earnings in 1996 to be almost \$19 billion).

42. Davids, *supra* note 40, at 200; see Chris Sprigman, *The Mouse That Ate the Public Domain: Disney, the Copyright Term Extension Act, and Eldred V. Ashcroft*, FINDLAW, Mar. 5, 2002, http://www.news.findlaw.com/commentary/20020305_sprigman.html.

43. Liu, *supra* note 39, at 410 n.2. Although Mickey Mouse would fall into the public domain, this only refers to Mickey Mouse as he originally appeared in the original animated film STEAMBOAT WILLIE, as other likenesses of Mickey Mouse would still be under Disney’s control. Downes, *supra* note 10. Vanpelt submits that due to a technicality, Disney published the 1928 version of Mickey Mouse without the proper copyright notice attached to the films and materials. Lauren Vanpelt, *Mickey Mouse—A Truly Public Character*, Spring 1999, <http://www.public.asu.edu/~dkarjala/publicdomain/Vanpelt-s99.html>. The limitations period in which to rectify the omission has since elapsed, and Disney can no longer file infringement claims based on that omission. *Id.* As a result of its omissions and inaction, Disney actually forfeited its copyright claims to Mickey Mouse and the Mouse has actually fallen into the public domain where all are free to copy and enjoy him—although many are unaware of that fact. *Id.*

44. Lui, *supra* note 39, at 415–16.

45. *Harper & Row, Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 559 (1985). In a 6-3 opinion delivered by Justice O’Connor, the Court reasoned that the Nation’s use of verbatim excerpts from an unpublished manuscript was not fair use of the material. *Id.* at 548–49. The Court asserted that because the work was unpublished, that was a key, although not necessarily a determinative factor, tending to negate the defense of fair use. *Id.* at 551. The pertinent facts of the case are that in 1977, former President Ford contracted with Harper & Row, Publishers, Inc. to publish his memoirs and they negotiated an agreement with *Time Magazine* for the right to extract over 7,500 words from Ford’s rendition of his pardon of former President Richard Nixon. *Id.* at 539. Before *Time* released their article, another source provided *The Nation Magazine* with the still unpublished Ford manuscript. *Id.* As a result, *The Nation Magazine* beat *Time Magazine* to the publication. *Harper & Row*, 471 U.S. at 539. *Harper & Row* sued *The Nation Magazine*, alleging violations of the Copyright Revision Act of 1976. *Id.*

expression, copyright supplies the economic incentive to create and disseminate ideas.”⁴⁶

A more recent Supreme Court analysis of the Copyright Clause came from the United States Supreme Court in *Feist v. Rural Telephone*.⁴⁷ In a 9–0 decision which reversed the trial and appellate courts, the Court acknowledged that in order “[t]o qualify for copyright protection, a work must be original to the author.”⁴⁸ The Court set the threshold level of creativity extremely low; thus, even a slight amount of originality will ordinarily suffice to qualify for copyright protection.⁴⁹ However, the Court in *Feist* went on to declare that “the mere fact that a work is copyrighted does not mean that every element of the work may be protected.”⁵⁰

On the other hand, in 2001, the District Court of Columbia found that there is no First Amendment right to make a commercial use of another’s copyrighted work or to otherwise exploit it; and that the *limited times* language in the Copyright Clause of Section 1 of the United States Constitution is not a substantive limit on Congress’s enumerated legislative powers.⁵¹ That Court went on to explain that there was nothing in the

46. *Harper & Row*, 471 U.S. at 558; Austin, *supra* note 37, at 26.

47. *Feist Publications, Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991); Austin, *supra* note 37, at 21.

48. *Feist Publications*, 499 U.S. at 345 (citing *Harper & Row*, 471 U.S. at 547–49). “Original, as the term is copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.” *Id.* For a discussion of the word original, consider *Rottlund Co. v. Pinnacle Corp.*, No. 01-1980, 2004 U.S. Dist. LEXIS 16723, at *86 (D. MN. Aug. 20, 2004) (citing *Feist Publications*, 499 U.S. at 345). In this opinion delivered by Justice O’Connor, the Court held that the names, towns, and telephone numbers copied by Feist were not original works to the original publisher of the material, Rural, and therefore were not protected by the copyright in Rural’s white and yellow pages directory. *Feist Publications*, 499 U.S. at 363. The white pages Rural originally published were held not to have satisfied the minimum constitutional standards for copyright protection because the information contained in them lacked the requisite originality, as the phonebook company had not selected, coordinated, or arranged the facts in an original way. *Id.* at 363. “Because Rural’s white pages lack the requisite originality, Feist’s use of the listings cannot constitute infringement,” Justice O’Connor wrote. *Id.* Recently, one court held that the originality requirement for obtaining a copyright is “an extremely low threshold,” and that a rhythm track that Pfizer used in one of their commercials was an infringement because the original author’s one-minute recording of one-bar percussion patterns played twenty-seven times in a row was sufficiently original to deserve copyright protection. *Vargas v. Pfizer, Inc.*, 418 F. Supp. 2d 369, 370–72 (S.D.N.Y. 2005).

49. *Feist Publications*, 499 U.S. at 360.

50. *Id.* at 348.

51. *Eldred v. Reno*, 239 F.3d 372, 378 (D.C. Cir. 2001) [hereinafter *Eldred 1*], *cert. granted*, *Eldred v. Ashcroft*, 534 U.S. 1160 (2002) [hereinafter *Eldred 2*], *aff’d*, *Eldred v. Ashcroft*, 537 U.S. 186 (2003), , 538 U.S. 916 (2003) [hereinafter *Eldred 3*]; Caren L. Stanley, *A Dangerous Step Toward the Over Protection of Intellectual Property: Rethinking Eldred v. Ashcroft*, 26 HAMLINE L. REV. 679, 684 n.29 (2003).

Constitution to suggest that “a term of years for a copyright is not a *limited time* if it may later be extended for another *limited time*.”⁵²

Even though various petitioners challenged the constitutionality of the CTEA, in 2003, the United States Supreme Court in a 7-2 decision affirmed the lower court’s ruling in *Eldred v. Ashcroft*.⁵³ Writing for the Court, Justice Ginsburg held that Congress did not exceed its powers or violate the First Amendment in enacting CTEA provisions to extend copyright terms for existing or future copyrighted works because the parties in that case had no First Amendment right to exploit the copyrighted works of others.⁵⁴ Further, the Court reasoned that Congress had the authority to extend the terms of copyrights since the Copyright Clause does not mandate the length of time to be forever *fixed* or *inalterable*, and the Act did not go so far as to create a perpetual copyright.⁵⁵ The Court further noted that Congress yielded to a “consistent historical practice of applying newly enacted copyright terms to future and existing copyrights”⁵⁶ The Court blindly deferred to Congress’s exercise of authority in making the policy decisions that underlie the CTEA’s term extensions, and went so far as to maintain that Congress did not transgress constitutional limitations.⁵⁷ Thus, in applying the rational basis test, which favors constitutionality and judicial restraint, the Supreme Court confirmed that Congress rationally exercised its powers in enacting the CTEA.⁵⁸ Further, the Court held that it was beyond the Court’s domain “to second-guess

52. *Eldred 1*, 239 U.S. at 379.

53. Stanley, *supra* note 51, at 687. After the twenty (20) year extension was implemented by the CTEA, publishers of public domain works brought a lawsuit claiming that the extension violated the Copyright Clause as well as the First Amendment of the United States Constitution. *Id.* at 683. Briefs filed in the case sought to clarify the meaning of the term *limited times* as prescribed by the Constitution. Austin, *supra* note 37, at 23. Certiorari was additionally denied in *Kahle v. Gonzales*, a case in which the Ninth Circuit held that provisions of the CTEA that changed from discretionary to automatic the renewal and subsequent extension of copyrights for works created between 1964 and 1977, did not alter traditional contours of copyright protection, so as to require a determination under *Eldred*, of whether the provisions violated the free speech rights of persons who were utilizing works that had fallen into the public domain. *Kahle v. Gonzales*, 487 F.3d 697, 699–700 (9th Cir. 2007).

54. Stanley, *supra* note 51, at 687. Heins, *supra* note 9 (noting that generally, only the copyright holder has a “First Amendment interest in a copyrighted work” (quoting *Eldred 1*, 239 F.3d at 375)).

55. *Eldred 3*, 537 U.S. at 199. See also Stanley, *supra* note 51, at 688.

56. *Eldred 3*, 537 U.S. at 204.

57. *Id.*

58. *Id.* at 204–05, 227. It was claimed to be rational because the legislation was rationally related to the interest of providing uniformity with the European Union (“EU”), which established a copyright term of life plus 70 years. *Id.* Furthermore, Congress rationally projected that a longer term would encourage copyright holders to invest in the restoration and public distribution of their works. *Id.*

congressional determinations and policy judgments [such as this], however debatable or arguably unwise they may be.”⁵⁹ Therefore, because there was no apparent violation of the *limited times* clause, the Court felt that Congress should not be prevented from extending copyright as much or as often as it likes.⁶⁰ As a result, it appears that Congress may “freeze the public domain indefinitely.”⁶¹ Unfortunately, counsel for *Eldred* never challenged the law as having unconstitutional effects, but rather claimed that the law itself was draconian and unconstitutional on its face. However, he has since stated that he would like another chance to explain and defend his interests, and retrospectively, would likely have argued for unconstitutional effects.⁶²

Justice Stevens provided the first dissent in *Eldred*. He believed the CTEA was unconstitutional since it didn’t fulfill the twin aims of the Copyright Clause: (1) to grant limited monopolies to artists in order to increase creativity, while (2) promoting science and the useful arts by mandating that expired copyrights enter the public domain.⁶³ Justice Stevens argued that the CTEA unreasonably transfers wealth from the public to authors and their heirs and that the public’s ultimate interest is ignored; frustrating the underlying purpose of the Copyright Clause because corporate and individual interests are not in alignment.⁶⁴

The other dissenting opinion came from Justice Breyer, who observed that although we should not destroy copyright protection altogether, we should be cautious of expanding its duration in fear of possible damaging consequences for our culture.⁶⁵ In his dissenting opinion, Justice Breyer wrote about the CTEA:

This statute will cause serious expression-related harm. It will likely restrict traditional dissemination of copyrighted works. It will likely

59. *Eldred* 3, 537 U.S. at 208, 212. Broad judicial deference has been provided to the legislative branch in copyright law because it has been said that it is “generally for Congress, not the courts, to decide how best to pursue the Copyright Clause’s objectives.” *Id.* at 212. In fact, Congress’s limits have yet to be determined. See *Schnapper v. Foley*, 667 F.2d 102, 112 (D.C. Cir. 1981). As such, copyrighted work currently can be parodied, commented, criticized, reported, caricatured, and even recorded within certain vague limits not yet clearly defined by the courts or legislature. Heins, *supra* note 9.

60. *Eldred* 3, 537 U.S. at 214.

61. Heins, *supra* note 5, at 2.

62. Krause, *supra* note 37. Larry Lessig, the attorney for the plaintiff in *Eldred*, will face the future by focusing on the fact that the current copyright laws have no renewal provisions, and so the law prevents copyrighted works from ever entering the public domain regardless of the creator’s intent. *Id.*

63. Stanley, *supra* note 51, at 693–694 (citing *Eldred* 3, 537 U.S. at 223).

64. *Id.* at 712 (citing *Eldred* 3, 537 U.S. at 227).

65. *Eldred* 3, 537 U.S. at 265–66 (Breyer, J., dissenting). See also Sprigman, *supra* note 42.

inhibit new forms of dissemination through the use of new technology. It threatens to interfere with efforts to preserve our Nation's historical and cultural heritage and efforts to use that heritage, say, to educate our Nation's children. It is easy to understand how the statute might benefit the private financial interests of corporations or heirs who own existing copyrights. But I cannot find any constitutionally legitimate, copyright-related way in which the statute will benefit the public. Indeed, in respect to existing works, the serious public harm and the virtually nonexistent public benefit could not be more clear.⁶⁶

C. COPYRIGHT THROUGH THE YEARS

As "An Act for Encouragement of Learning," the Statute of Anne of 1710 was the first English Copyright statute, and many authors have credited it with creating what is known as modern copyright law.⁶⁷ The Statute's purpose was to provide copyrights to authors and to break any possible monopoly that booksellers had, however, it also assisted in the development of the first American copyright statute, the Act of May 31, 1790, which protected books, charts, and maps for fourteen (14) years from the date of publication.⁶⁸ As opposed to starting the clock at the date of publication like the previous Copyright Acts did, the Act of 1976 was amended so that works created by individuals were protected from the date of the creation of the work,⁶⁹ for a term of fifty (50) years after the author's

66. *Eldred* 3, 537 U.S. at 266 (Breyer, J., dissenting).

67. Statute of Anne, 1710, 9 Ann., c. 19 (Eng.); see Austin, *supra* note 37, at 43; see also Dennis S. Karjala, *Distinguishing Patent and Copyright Subject Matter*, 35 CONN. L. REV. 439, 524 (2003). The language of the 1790 Act afforded protection exclusively to books, charts, and maps, for fourteen (14) years from the date of publication, which was later renewable for an extra fourteen (14) years if the author survived the first term. Austin, *supra* note 37, at 43; see William L. Heyman, Annotation, *Prospective Assignment of Renewal Rights in Copyright*, 2 A.L.R. 3d 1403 § 3 (2004). Later, the Act of February 3, 1831 enlarged the benefits of copyright protection as it increased the original term to twenty-eight (28) years from the date of publication so that the total term, including the fourteen (14) year renewal period amounted to forty-two (42) years. *Id.* The current Act, the Copyright Act of March 4, 1909, extended the renewal term portion to twenty-eight (28) years and also enlarged the pool of people who are eligible to apply for a renewal if the author dies before the end of the original term. *Id.* Nonetheless, since renewal is based on the duty of copyright owners to take a proactive positive action in order to keep their work protected, many cartoons are now in the public domain due to the fact that their owners were lazy or forgetful in their efforts to renew or maintain their copyrights, not because the author actually intended for their work to be released to the public domain. Posting of Eminovitz to Big Cartoon Forum, http://forum.bcdm.com/forum/gforum.cgi?post=30532;search_string=warner%20brothers%20frequency;guest=3247128#30532 (July 26, 2004, 12:43 EST).

68. Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124; see HEYMAN, *supra* note 62; see also Stanley, *supra* note 51, at n.83 (noting that the Act of 1790 was modeled after the British Statute of Anne).

69. William M. Hart & Jenifer deWolf Paine, *An Overview of the Copyright Law*, 783 PRAC.

death.⁷⁰

Copyright protection was intended to provide protection to a creator, against others who attempted to appropriate that work as their own.⁷¹ The Copyright Clause, Article I, Section 8, Clause 8 of the United States Constitution, provides the legal foundation for the protection of federal copyright as its initial sole purpose was “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁷² Another function of copyright that has been argued

L. INST 7, 75 (2003). Generally, copyright actions involve proof by the plaintiff that another person had access to their valid copyrighted material, and that actionable copying in fact occurred. *Moore v. Columbia Pictures Indus., Inc.*, 972 F.2d 939 (8th Cir. 1992). Access is generally established by showing that a defendant “had an ‘opportunity to view or to copy.’” *Id.* at 942. Usually, the plaintiff must prove there was at least a “reasonable possibility” of access. *Id.* As Nimmer explains, after a reasonable possibility to view has been established, this is equated to actual access and “this conclusion properly goes to the ultimate issue of copying, and not to the subordinate issue of access.” *Rottlund Co. v. Pinnacle Corp.*, No. 01-1980, 2004 U.S. Dist. LEXIS 16723, at *74 (quoting NIMMER, *supra* note 20, at § 13.02[A], at 13-16). Actionable copyright has been determined upon whether the drawings’ expression is similar to another previously created copyrighted work. *Rottlund Co.*, No. 01-1980, 2004 U.S. Dist. LEXIS 16723, at *78 (citing *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987)). This so called “intrinsic test” depends on the response of an ordinary, reasonable person. *Id.* at 79; 77 AM. JUR. *Trials* § 449 (2004). However, the defendant will then be allowed to present evidence of copyright invalidity and raise any defenses that may apply. *Rottlund Co.*, No. 01-1980, 2004 U.S. Dist. LEXIS 16723, at *62 (“[C]opying may be proven either by direct evidence or by demonstrating circumstantial evidence establishing ‘access and *substantial similarity* of the two works.’” (quoting *Nelson v. PRN Prod., Inc.*, 873 F.2d 1141, 1142 (8th Cir. 1989))).

70. *Hart & Paine*, *supra* note 69, at 75. Prior to the enactment of the CTEA, most works were only protected for the life of the author plus fifty (50) years under the 1976 Copyright Act. *Id.* In 1976, Congress drew distinctions between works created by individuals, anonymous persons, pseudonyms, and work-for-hire authors. *Stanley*, *supra* note 51, at 699. In works created anonymously, pseudonym works, or works made for hire, the term was seventy-five (75) years from the date of publication, or one hundred (100) years from the date of creation, whichever occurred first. *Id.*

71. *The Protection Afforded Literary and Cartoon Characters Through Trademark, Unfair Competition, and Copyright*, 68 HARV. L. REV. 349, 350 (1954).

72. U.S. CONST. art. I, § 8, cl. 8. For example, Supreme Court Justice Joseph Story believed that the purpose of the Clause was to “admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint.” Joseph Story, 3 COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES §1147 (1833); see Heins, *supra* note 9 (stating that a monopoly will control the profit that authors, artists, and scientists are awarded due to their creativity, but only for a temporary time period). In delineating a fixed time frame, it is clear that the Framers of the Constitution wished not to stifle creativity, but to encourage it, by avoiding excessively long monopolies. *Stanley*, *supra* note 51, at 706-07; see Sprigman, *supra* note 42 (noting that in an 1813 correspondence between Jefferson and Madison, both men classified copyrights as monopolies, necessary evils which were only valid for limited periods and only in order to increase invention, therefore providing just enough incentive to create, nothing more, and thereafter allowing ideas to flow freely as nature intended). Specifically, by including the *limited times* language, the Copyright Clause was intended to spur

extensively of late is “to balance the rights of creators against the public benefits resulting from unrestricted access to creative works.”⁷³ Determining where to draw the line between the freedoms afforded to the public against the author’s rights has proven to be an overwhelming task which will surely lead to years of costly and high profile legal battles.⁷⁴

Due to the enactment of the CTEA, the Copyright Act presently affords expanded protection to copyrighted characters that were created on or after January 1, 1978.⁷⁵ Protection will begin at the work’s creation and

innovative ideas by guaranteeing that copyrighted works enter the public domain as soon as the period of exclusivity expires. *Id.*

73. See Cecil C. Kuhne, III, *Forcing the Copyright Genie Back into the Bottle: Public Policy Implications of Copyright Extension Legislation*, 33 SW. U. L. REV. 327, 328–30 (2004) (quoting *Harper & Row, Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 558 (1985)) (noting that since copyright has been described as *the engine of free expression*, the Copyright Clause of the Constitution must attempt to strike a precise balance between providing financial incentives and rewards for copyright owners and artists to create original works (by granting exclusive rights to them), and must also be wary of allowing eventual public access to those works (by limiting the duration of the creators’ exclusive rights)); see also Joyce Slanton, *A Mickey Mouse Copyright Law?*, WIRED NEWS, Jan. 13, 1999, <http://www.wired.com/news/politics/0,1283,17327,00.html> (“[T]here needs to be a balance between financially encouraging artists to create and having works become available to the public domain for widespread use, free from restrictions.”).

74. However, many believe that copyright has significantly gone astray from the Framers original meaning. Austin, *supra* note 37, at 36 (citing Kevin D. Galbreath, *Forever on the Installment Plan? An Examination of the Constitutional History of the Copyright Clause and Whether the Copyright Term Extension Act of 1998 Squares with the Founders’ Intent*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1119 (2002)); see, e.g., *Eldred I*, 239 F.3d at 381 (Sentelle, J., dissenting) (commanding that Congress exceeded the scope of legitimate power under the Copyright Clause because an extension violates the *limited times* language of the Constitution and because it does not “promote the Progress of Science and useful Arts”); see also Kuhne, *supra* note 73, at 330. The public domain has been called the fourth “free-expression safety valve” since it makes works available for “republishing, translating, selling, copying, or performing as soon as the *limited time* of copyright expires.” Heins, *supra* note 9. The four free-expression safety valves are: (1) the idea/expression dichotomy; (2) the fair use doctrine; (3) the first sale doctrine; and (4) the public domain. *Id.* Absent copyright protection, or when a copyrighted item falls into the public domain, anyone may copy or sell the likeness for whatever they fair. Downes, *supra* note 10.

75. Sprigman, *supra* note 42. All work created prior to 1978 will be in its renewal terms in 2006. Gloria C. Phares, *Copyright Licensing*, 787 PRAC. L. INST. 145, 218 (2004). The date of January 1, 1978 is significant because before that year, United States law defaulted to a non-copyrighted status for creative works. Therefore, any failure to comply with copyright notice provisions would result in the work falling into the public domain automatically on its publication. However after that date, merely omitting a copyright notice does not result in an automatic forfeiture of the copyright. See Moetteli, *supra* note 8. Today, copyright status is the default for all *original* works of authorship *fixed* in a tangible medium. See *id.* (defining *original* as an original expression, not copied from another, and defining *fixed* as “embodied in a copy or phonorecord by or under the authority of the author, and is sufficiently permanent and stable to permit it to be perceived, reproduced, or otherwise communicated for more than a merely transitory period of time.”). This proves that the law now generally seems to favor copyrights not falling into the public domain unless the owner expresses an overt interest in it falling into public

endure until seventy (70) years after the author's death.⁷⁶ Given the expanded scope of protection, corporate bodies have been extremely aggressive in asserting their right to control their copyrighted works.⁷⁷

Unfortunately, the enactment of the CTEA has led to a battle between two strong opposing forces. On the one hand, there are free speech advocates who want the material to be made public for all to use at the earliest possible date. They oppose extension because the public may not be exposed to many art forms as a result of copyright extension. For example, they claim films will not be restored; books will not be republished; concerts will not be held; and even that educational programs may be halted.⁷⁸ On the other end of the spectrum are of course the copyright owners who urge for even greater copyright extensions.

Individuals who believe that the CTEA overstepped its bounds believe it is primarily a constitutional infringement upon the literal meaning of the phrase *limited times*.⁷⁹ They believe it has lost its objective meaning from the original term which was limited to fourteen (14) years, renewable for another 14 years, as set in 1790 by the original copyright law.⁸⁰ These critics believe that after a limited time and once it falls into public domain, the expression of a character must be free to be used, sold,

domain.

76. 17 U.S.C. § 302(a) (2004); see 77 AM. JUR. *Trials* § 449, § 2 (2004); see also Austin, *supra* note 37, at 23. These works are protected for twenty-eight (28) years in their first term, with a second or *renewal* term of sixty-seven (67) years since they are still covered by the 1909 Act. Hart & Paine, *supra* note 69, at 75. This follows the bifurcate term of the 1909 Act, which was amended and incorporated into the 1976 Act. *Id.* The original 1909 Act only provided for the original term of protection plus a renewal term of twenty-eight (28) years. *Id.* However, an exception lies in works made for hire. Kuhne, *supra* note 73, at 335. For works made for hire, work anonymously made, or made under a pseudonym, "the term is ninety-five (95) years from the publication or one-hundred twenty (120) years from creation, whichever expires first." *Id.* These are works such as comic book characters, where the employer is the owner of the copyright to all the characters that are drawn by any of their employees or artists, since the employer specifically commissioned the work. 17 U.S.C. § 201(b) (1976); see also Archie Comic Publications, Inc. v. DeCarlo, 258 F. Supp. 2d 315, 333 (S.D.N.Y. 2003) (defining a work made for hire is one that must fit into one of nine categories, is specially ordered or commissioned, and all parties must expressly agree that it constitutes a work for hire). With these works, the copyright owner or corporate body must actually renew the copyright. 17 U.S.C. § 304 (2004).

77. Heins, *supra* note 5, at 4.

78. Austin, *supra* note 37, at 47; see also Karjala, *supra* note 67, at 454 n.59 (noting that "[s]ome Irving Berlin copyrights date from the 1920's, and he did not die until 1989. If the life plus 70 system had been in effect during his lifetime, some of his copyrights would have endured for 130-135 years.").

79. *Eldred* 3, 537 U.S. at 193.

80. Harris, *supra* note 9; see Heins, *supra* note 5, at 12; see also Heins, *supra* note 9; Kuhne, *supra* note 73, at 328.

reproduced, or exploited in any way the public chooses.⁸¹ Another basis they have cited to limit terms is the fact that deceased authors created many of the works at issue, and these creators are not likely to advance the goal of increasing creativity anytime soon.⁸² More than ever, copyright appears to be a “one-way ratchet, covering more works and granting more rights for a longer time.”⁸³ Therefore, it appears that even if Congress were to extend the length of copyright for a hundred years or even in perpetuity, that time period may still be classified as a *limited* time.

Since individuals are unable to afford the exorbitant royalty fees being charged by copyright and license holders, they are unable to exploit most characters.⁸⁴ Therefore, if and when they do pay these ludicrous royalty fees, the price of the goods they are selling will likely be passed along to the end user.⁸⁵ Further, “[r]emoving these works from the public domain works a huge uncompensated wealth transfer from ordinary citizens to Disney, Time Warner and other holders, corporate and individual, of preexisting copyrighted material . . . [and] produces a net social loss by restricting [the] overall level of use of this material.”⁸⁶ In the end, the extension denies access to creative works for a longer period of time, and copyright owners endure no additional obligations; as such, it provides an unnecessary windfall to greedy copyright owners, resulting in harm to the general public because we are stripped of creative artistic ideas, both freeform and computer generated.⁸⁷

It is important to note that 1998 was not the first time copyright extension was granted.⁸⁸ Since 1960, large entertainment companies have obtained copyright extensions eleven times, and ironically, many of the extensions were granted immediately before the copyright on a Disney

81. See *id.* at 344–45.

82. Downes, *supra* note 10 (citing Eric Eldred, who runs a free internet library and argued that the extension among dead creators can’t encourage more work to be created).

83. Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L. J. 535, 543 (2004).

84. Hendricks & Norris, *supra* note 11.

85. See generally *id.* (discussing fees and royalties).

86. Richard A. Epstein, *Constitutionality of Copyright Term Extension: Congress’s Copyright Giveaway*, WALL ST. J., Dec. 21, 1998, <http://homepages.law.asu.edu/~dkarjala/OpposingCopyrightExtension/commentary/jhornAP.html>; see also Stanley, *supra* note 51, at 708 (stating that extensions of copyrights harm the public). Continued expansion has been stated to only benefit corporations and not actual creators, while it deprives the public of a rich cultural heritage. See Harris, *supra* note 9. Harris has also drawn an analogy between Dracula and Santa Claus and stated since their introduction into the public domain our cultural heritage has benefited and inventors have found lucrative value. *Id.*

87. Stanley, *supra* note 51, at 708.

88. See Surowiecki, *supra* note 13.

character was set to expire.⁸⁹ And since there is no law explicitly preventing another extension, opponents are disturbed by the possibility that Disney may just achieve yet another extension before Mickey Mouse is set to be released into the public domain in 2023.⁹⁰ In essence, this would allow Disney to rest on its laurels without any new development, and would defeat the purpose that the legislation was intended to achieve; the promotion of useful arts.

Because creative works can be copied rather easily, one goal of copyright law is to regulate the industry and prevent others from using a copyrighted work without first compensating the author or obtaining their approval.⁹¹ In the same vein, it has been claimed that offering a longer copyright term offers greater incentives for companies to finance the creation of new works because as the character generates economic activity and popularity, new ventures are pursued.⁹² Proponents of the CTEA such

89. Jane Black, *A Case to Define the Digital Age*, BUS. WK., Sept. 27, 2002, http://www.businessweek.com/technology/content/sep2002/tc20020927_7367.htm; see also Downes, *supra* note 10; see also Sprigman, *supra* note 42.

90. See Kuhne, *supra* note 73, at 328. See also Harris, *supra* note 9 (stating that before 2024, Disney will be back in Congress requesting another extension).

91. See 17 U.S.C. § 106 (2004). Section 106(a) is also known as the Visual Artists Rights Act. Moetteli, *supra* note 8. Its purpose is to protect the moral rights of the creator of the work against “mutilation or other derogatory action in relation to the work that would prejudice the author’s honor or reputation” during the author’s lifetime. *Id.* This section further expands an author’s rights so that only they may claim ownership of the work, while preventing distortion, mutilation, or other modifications of the work which would be prejudicial to their reputation or the work’s stature. *Id.*

92. Krause, *supra* note 37, at 40. In addition, the *Eldred* Court maintained that a longer copyright term would increase incentives to authors who compete in the United States by creating a uniform standard with the European Union (“EU”) so that intellectual property laws are in conformity. Liu, *supra* note 39, at 410; see also Stanley, *supra* note 51, at 700–701 (stating that harmonizing the United States and European Union copyright terms, the United States will benefit). The ultimate goal was to improve trade benefits and fair payment for works created in the United States, however, the longer term was not as beneficial to the United States as it was intended to be because trade wars were repeatedly threatened between and among the countries. Epstein, *supra* note 86; see also Liu, *supra* note 39, at 410 (reinforcing the importance of harmonizing copyright laws). On the other hand, critics of the Act have noted that because EU copyrights are now protected in the United States for another twenty (20) years, American consumers are harmed twice, “once for domestic and once for European work.” Epstein, *supra* note 86. The Act’s opponents have also noted that it burdens the free speech right that the First Amendment affords us, by limiting expression and hampering arts that would otherwise be available in the public domain, and as a result they claim it advances no significant governmental interest. Sprigman, *supra* note 42; see also Heins, *supra* note 9 (listing the three legal theories of *Eldred*’s case). In *Luck’s Music Library, Inc. v. Gonzales*, the court, in citing *Eldred*, stated that the expected benefits of creating new works are greater if Congress can remedy the loss of copyright protection for works that have accidentally or unavoidably fallen into the public domain. *Luck’s Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1264 (D.C. Cir. 2005). Therefore, Congress is permitted to remove works from the public domain, even if removing the

as copyright owners, movie studios, publishers, recording companies and in particular Disney, have stated numerous other reasons why extension is a wise idea.⁹³ Their goal is for a single person or corporate entity to maintain control over a character so that various versions of the same character are not being promoted.⁹⁴ That way, only one entity may make decisions about which adaptation is promoted at a given time, “for example, evil Mickey, Mickey in space, an[d] Asian Mickey.”⁹⁵ These individuals and companies further explain that works may be neglected and innocent characters may easily be placed into an entirely different storyline when there is nobody with dominant control who is motivated enough to preserve them and ensure their original personality is maintained.⁹⁶ The incentive for creating new works such as sequels and other derivative works has also ironically been cited as a reason to grant exclusive rights to a copyright owner.⁹⁷ Due to disagreement on the subject, cartoons are presently being represented by attorneys.⁹⁸ As such, we also wonder whether cartoons will someday have their own psychologists who can analyze and defend their unique personalities, or whether a better alternative would be to place the burden on neutral and detached intellectual property magistrates.

In reality, the Walt Disney Company’s position is threatened as it attempts to demonstrate an interesting point about fair use. To be sure, many of Disney’s most successful films were based on stories, music, and characters that were actually taken from the public domain. Disney seemingly paid nothing to the owners of these works, and it was able to fully exploit the characters.⁹⁹ However, the value of these characters did

work from the public domain does not provide any incentive to create new works or promote the progress of science. *Id.* at 1263–64.

93. Liu, *supra* note 39, at 421.

94. *Id.* at 437.

95. *Id.* Although there is nothing stopping someone who wants to create another version of a similar talking mouse, a copyright will prevent others from too closely copying the exact traits and persona of Mickey Mouse in particular. See [thefreedictionary.com](http://www.thefreedictionary.com/p/copyright), <http://www.thefreedictionary.com/p/copyright> (last visited October 6, 2008) (defining the term copyright).

96. See Heins, *supra* note 9.

97. See *id.*; see also Liu, *supra* note 39, at 431. See generally William F. Patry & Richard A. Posner, *Fair Use and Statutory Reform in the Wake of Eldred*, 92 CAL. L. REV. 1639, 1658–59 (2004) (reasoning that the majority of royalties are made before the end of a copyright term, so tacking on years at the end of an already long copyright term has only negligible effects on the incentive to create a copyrighted work in the first place).

98. See generally Patry & Posner, *supra* note 97, at 1639–60.

99. See Christine Nickles, *The Conflicts Between Intellectual Property Protections When a Character Enters the Public Domain*, 7 UCLA ENT. L. REV. 133, 152 (1999); see also Downes, *supra* note 10. Take for example, *Cinderella* and *Snow White and the Seven Dwarfs*, which were borrowed from the *Brothers Grimm Fairy Tales*; *Fantasia*, which was originally composed by

not diminish after being used by Disney, which is precisely what Disney claims will happen to its works the moment they enter the public domain.¹⁰⁰ However, in an effort to maintain its ever present monopolies, Disney continues to spend great resources to keep its creations out of the public domain for as long as possible.¹⁰¹

The ongoing copyright debate stems from divergence in legal interpretation.¹⁰² The public domain has been defined as the “repository of works which are ineligible for copyright, were created before copyright law existed, have had their copyrights expire, or have been freely given to the public by their authors.”¹⁰³ Upon the lapse of a copyright when a copyrighted work enters the public domain, it may be reproduced and imitated, so long as the work is merely provided with a new name.¹⁰⁴ As such, depending on how one defines the terms *limited times*, public

Bach, Tchaikovsky and Beethoven among others; the *Hunchback of Notre Dame* as adapted from Victor Hugo’s work; the *Jungle Book* akin to Rudyard Kipling’s *Jungle Book*; the *Little Mermaid*, which was initially written by Hans Christian Anderson; *Alice in Wonderland*; *Beauty and the Beast*; *Hercules*; *Pinocchio*; and *Pocahontas*, just to name a few. See Davids, *supra* note 40, at 200; see also Liu, *supra* note 39, at 440; see also Jane Black, *A Case to Define the Digital Age*, BUS. WK., Sept. 27, 2002; see also Sprigman, *supra* note 42; see also Krause, *supra* note 37. It has also been said that the movie STEAMBOAT WILLIE itself was a direct parody of Buster Keaton’s movie STEAMBOAT BILL, JR. Jesse Walker, *Mickey Mouse Clubbed: Disney’s Cartoon Rodent Speaks Out on the Eldred Decision*, Reason Online, Jan. 17, 2003, <http://www.reason.com/links/links011703.shtml>.

100. See Downes, *supra* note 10.

101. *Id.* Keep in mind that all this lobbying followed the 1995 appointment by Disney chairman, Michael Eisner, of his longtime acquaintance, Michael Ovitz, to serve as the president. High, *supra* note 41, at 19. Only a year later, Ovitz was fired, and ultimately received a reported \$140 million in executive compensation for approximately 12 months worth of unsatisfactory work. *Id.* Apparently, Disney has become enthralled with money grubbing and demystified by tales about morality. See *id.* However, in the trial judge’s analysis of the decision by the officers and directors to hire Ovitz, their decision was made in good faith and not in an illegal manner, thus following the corporation’s goal to create wealth and encourage risk taking. *Id.* at 21–22 (citing *In re the Walt Disney Co. Derivative Litigation*, Consol. C.A. 15452 (Del. Ch. Aug. 9, 2005)).

102. See Krause, *supra* note 37.

103. Kuhne, *supra* note 73, at 329 n.4 (quoting Jon M. Goran, *Normative Copyright: A Conceptual Framework for Copyright Philosophy and Ethics*, 88 CORNELL L. REV. 1278, 1316 (2003)); see *Harvey Cartoons v. Columbia Pictures Indus., Inc.*, 645 F. Supp. 1564, 1573 (S.D.N.Y. 1986) (holding that the Ghostbusters logo wasn’t substantially similar enough to the Fatso ghost character (part of a trio of the *Casper, The Friendly Ghost* family) of 1955 (when it was originally copyrighted) so it was not deemed to be an infringement)); see, e.g., Keating et al., *supra* note 40, at 176–77 (2004) (citing *Matthew Bender & Co. v. West Publ’g Co.*, 158 F.3d 674 (2d Cir. 1998)) (holding that failure to renew a copyright will forfeit the original and the edited versions to the public domain at expiration of the copyright); see also Liu, *supra* note 39, at 439 (stating that when copyright terms expire they can be freely copied, built upon, transformed, recast, re-imagined, and distributed by others without paying a royalty to the owner of the copyright).

104. See Helfand, *supra* note 15, at 673–74.

domain, and fair use, it may be fair to say that the Constitution's framework is slowly being eroded.

II. INTELLECTUAL PROPERTY RIGHTS AVAILABLE TO CHARACTERS

Copyright, trademark, and unfair competition law generally regulate characters. However, contract, publicity, and unfair competition laws also commonly control, especially if a licensing agreement or commercial venture is involved.¹⁰⁵ The convergence of these laws, as well as the lack of distinction among them, leaves individuals and corporations unclear as to what each protects.¹⁰⁶ Former Walt Disney attorney, Franklin Waldheim, stated that we may be able to distinguish between copyright and trademark uses because "[w]hen [a] copyrighted character is used in such a way that it becomes something more than an adornment of the article but suggests to the purchaser that the article comes from a certain source, the character then achieves a trademark significance."¹⁰⁷

When one offers for sale or distribution,¹⁰⁸ unauthorized, illegal,

105. See, e.g., *Edgar Rice Burroughs, Inc., v. MGM*, 205 Cal. App.2d 441, 452 (Cal. Ct. App. 1962) (holding that since a new production was substantially similar to the original production within the meaning of the contract, and the contract clearly allowed for unlimited remakes of the same story without material changes, that there was no copyright dispute); see Rich, *supra* note 12; see also Lanham Act § 43(a) (1946) (describing false designations of origin and false description or representation). However, federal copyright or trademark laws will usually preempt claims such as unfair competition or misappropriation. See *Kodadek v. MTV Networks, Inc.*, 152 F.3d 1209, 1212 (9th Cir. 1998) (affirming summary judgment for the creator of *MTV's Beavis and Butthead* show, since the cartoon artist's unfair competition claim was preempted based on the artist's cartoon characters and sale of merchandise derived from the drawings implicating rights equivalent to copyright privileges).

106. Helfand, *supra* note 15, at 641. For dilution to apply there must be: (1) an unauthorized use of the character; (2) language or some visual that will be seen as confusing; and (3) dilution of the distinctiveness of the value of the mark as it is used over time. Hughes, *supra* note 28, at 1004–05. Hughes noted that a dilution statute was applied in *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031 (N.D. Ga. 1986), and because *Garbage Pail Kids* was an intentional joke on Cabbage Patch Kids and was intended to "create[] an undesirable, unwholesome, or unsavory mental association with the plaintiff's mark," the plaintiff in the case had shown a likelihood of success of prevailing under Georgia's anti-dilution statute. *Id.* at 1005. Some may argue that because it was not Disney that was involved in that case, the Cabbage Patch Kids Company got the short end of the stick, whereas if a card company creating Masochist Mouse Magnets for instance was ripping off Disney, Disney would have surely prevailed. See *id.*

107. Franklin Waldheim, *Mickey Mouse—Trademark or Copyright?*, 54 TRADEMARK REP. 865, 866 (1964); see also R. Anthony Reese, *The Public Display Right: The Copyright Act's Neglected Solution to the Controversy over RAM "Copies,"* 2001 U. ILL. L. REV. 83, 96 (2001).

108. E.g., *In re Napster, Inc. Copyright Litig. v. Hummer Winblad Venture Partners*, 377 F. Supp. 2d 796, 802 (N.D. Cal. 2005) (the court found that actual dissemination must be proven to sufficiently prove infringement based on unlawful distribution of a copyrighted work).

pirated or counterfeit copies of a copyrighted item, they are liable for copyright infringement.¹⁰⁹ In order to discourage wrongful conduct, compel restitution, and mandate reparation for injury, once infringement is proven, a plaintiff may elect statutory damages instead of seeking either actual damages or disgorgement of profits by a defendant.¹¹⁰ Statutory damages, may, in a court's discretion, be assessed in the range of \$750 to \$30,000 for each incident of infringement.¹¹¹ If however, the infringement has been deemed to be willful,¹¹² statutory damages may be assessed in amounts up to \$150,000 per incident.¹¹³ Additionally, a plaintiff whose copyright has been infringed may request a court to enjoin the defendant. Subject to the provisions of Section 1498 of Title 28, in order to uphold the public interest in protecting a copyright,¹¹⁴ courts will regularly grant temporary and final injunctions if the court deems the injunction to be "reasonable to prevent or restrain infringement of a copyright."¹¹⁵ And,

109. *Arista Records, Inc. v. Beker Enterprises, Inc.*, 298 F. Supp. 2d 1310, 1312 (S.D. Fla. 2003) (citing *Walt Disney v. Video 47*, 972 F. Supp. 595, 601 (S.D. Fla. 1996)).

110. *Id.* at 1312 (citing *F.W. Woolworth Co. v. Contemporary Arts*, 344 U.S. 228, 233 (1952)).

111. *Id.* (citing 17 U.S.C. § 504(c)).

112. "Willful infringement has been described as when the infringer acted with 'actual knowledge or reckless disregard for whether its conduct infringed upon the plaintiff's copyright.'" *Id.* (citing *Original Appalachian Artworks, Inc. v. J.F. Reichert, Inc.*, 658 F. Supp. 458, 464 (E.D. Pa. 1987)).

113. 17 U.S.C. § 504(c)(2) (2004). In order to "discourage wrongful copyright infringement and bring justice to copyright owners by encouraging them to bring copyright lawsuits," one court awarded a copyright owner the maximum \$150,000 statutory damage award, plus \$285,000 in attorney fees and costs. *See Resnick, supra* note 16 (citing *Design Tex Group Inc. v. U.S. Vinyl Mfg. Corp.*, No. 04 Civ. 5002, 2005 U.S. Dist. LEXIS 18276, at *14 (S.D.N.Y. Apr. 28, 2005) (court's opinion on damages dated Aug. 22, 2005)). The case is rare because not many courts have declared such an award, and also because the court found the infringing company and its principal owner jointly and severally liable for the infringing conduct and damages. *Id.*

114. *Arista Records, Inc.*, 298 F. Supp. 2d at 1314 (citing 17 U.S.C. § 502(a)).

115. *Id.* at 1314–15 (noting because new works are continually created, they too would be vulnerable to infringement if an injunction were limited to existing works, therefore injunctions in copyright cases must cover works to be created in the future as well) (citing *Princeton Univ. Press v. Michigan Document Servs., Inc.*, 99 F.3d 1381, 1392 (6th Cir. 1996); *Olan Mills, Inc. v. Linn Photo Co.*, 23 F.3d 1345, 1349 (8th Cir. 1994); *Autoskill Inc. v. National Educational Support System, Inc.*, 994 F.2d 1476, 1499 (10th Cir. 1993)). However, the Copyright Act does not supply all the remedies that a district court may fashion. To be sure, once the Act is invoked, "the Supreme Court has recognized that the scope of a district court's equitable powers to remedy past wrongs is also broad, for 'breadth and flexibility are inherent in equitable remedies.'" *Louis C. Bechtle & Geoffrey L. Beauchamp, The Courts and Internet Piracy After Grokster*, INTELL. PROP. NEWSL. (ABA Sec. of Intell. Prop. Law, Chicago, IL), Winter 2006, at 13 (2006). The remedies have gone so far as to include the impoundment and destruction of the infringing works. 17 U.S.C. § 503; *see also Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) ("[The limited grant] is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired."). Because federal courts

more often than not, under Section 505 of the Copyright Act, full costs, including reasonable attorney's fees,¹¹⁶ are awarded to the prevailing party "in order to: (1) deter future copyright infringement; (2) ensure that all holders of copyrights which have been infringed will have equal access to the court to protect their works; and (3) penalize the losing party and compensate the prevailing party."¹¹⁷

Trademark law is usually aimed at performing four main functions, including to: (1) "identify one seller's goods and distinguish them from goods sold by others;" (2) "signify that all goods bearing the trademark come from a single, albeit anonymous, source;" (3) "signify that all goods bearing the trademark are of an equal level of quality;" and (4) "[serve] as a prime instrument in advertising and selling goods."¹¹⁸ For a character to become trademarked, it must have a secondary meaning so that a consumer automatically associates the character with a certain company, product, or service because the "*likelihood of confusion*" is great.¹¹⁹ Therefore, since virtually everyone relates Mickey Mouse and the Mickey Mouse symbol with Disney, this is a commercially valid trademark.¹²⁰ Trademark law

have inherent authority to remedy situations involving copyright infringement, when Congress enacted the CTEA, it not only protected large corporations even more than they were protected in the past, but it further revoked some of that power and authority that the courts were initially granted in order to remedy the harm. *Id.* at 433–34. See also Darcy L. Jones, *As Congress Giveth, So Congress Taketh Away: The Supreme Court Assures Congressional Authority to Retroactively Extend Copyright Terms in Eldred v. Ashcroft*, 55 Mercer L. Rev. 779, 780 (2004) (providing further detail on the CTEA).

116. *Arista Records, Inc.*, 298 F. Supp. 2d at 1316 (citing *Micromanipulator Co. v. Bough*, 779 F.2d 255, 259 (5th Cir. 1985)); *Broadcast Music, Inc. v. Dano's Restaurant Systems, Inc.*, 902 F. Supp. 224, 227 (M.D. Fla. 1995); *Jobete Music Co., Inc. v. Hampton*, 864 F. Supp. 7, 10 (S.D. Miss. 1994)). Under the Copyright Act, "prevailing defendants are entitled to equal consideration for the award of fees as 'a successful defense of a copyright infringement action may further the policies of the Copyright Act every bit as much as a successful prosecution of an infringement claim by the holder of a copyright.'" *Silberstein v. Fox Entertainment Group, Inc.*, 536 F. Supp. 2d 440, 443 (S.D.N.Y. 2008).

117. *Arista Records, Inc.*, 298 F. Supp. 2d at 1315–16 (citing 17 U.S.C. § 505; *A&N Music Corp. v. Venezia*, 733 F. Supp. 955, 959 (E.D. Pa. 1990)).

118. Helfand, *supra* note 15, at 635–36 (1992) (citing 1 J. THOMAS MCCARTHY 2D, *Trademarks and Unfair Competition* § 3:1, at 104 (1984 & Supp. 1988)).

119. Rich, *supra* note 12.

120. See *Walt Disney Co. v. Best*, No. 88 CIV. 1595 (SWK), 1990 U.S. Dist. LEXIS 12604, at *1 (S.D.N.Y. Sept. 24, 1990) (stating "Mickey Mouse is more than just an animated cartoon character; he has become the most recognizable symbol of Walt Disney"); see also Rich, *supra* note 12 (providing the example of Mickey Mouse and Superman); Helfand, *supra* note 15, at 671 (asserting that characters are synonymously associated with their sources when the source is *hard wired* in the public consciousness). Absolute associations may typically arise when: (1) a single source uses a character in works for trademark purposes during a majority of its copyright term; (2) its use of the mark continues after the character enters the public domain; (3) the owner reviews the quality of goods being licensed; and (4) the owner polices the mark and pays careful attention to any unauthorized uses of its mark. *Id.* Helfand further points out that because Walt

further provides that any person who reproduces, counterfeits, copies, or imitates a trademarked product which is likely to confuse, cause mistake, or deceive, shall be liable for infringer's profits, actual damages, costs, and attorney's fees.¹²¹

Because cartoon and other pictorial characters are often associated with the creator, a combination of copyright, trademark and unfair competition law will oftentimes be used to protect these works.¹²² The major benefit of dual protection is that a copyrightable character will not be excluded from trademark protection merely because it has fallen into the public domain.¹²³ Another advantage is that trademark rights do not expire as long as the mark qualifies for protection; therefore it is in the owner's best interest to attempt to obtain trademark rights in conjunction with their copyright.¹²⁴

Disney's Mickey Mouse is often times used in its labels and the extent of the Mickey Mouse logo has been used in corporate letterhead, envelopes, and other materials, the character itself may sometimes stand in place of the corporate name. *Id.* Just a couple of years ago, Mickey Mouse was honored as the proud Grand Marshal of the Rose Bowl Parade. Reed Saxon, *Mickey Mouse to Lead Rose Bowl Parade*, USA TODAY, Nov. 17, 2004, http://www.usatoday.com/life/people/2004-11-17-mickey-mouse_x.htm. The only other non-humans that have been afforded that right were Kermit the Frog and Charlie McCarthy. *Id.* Mickey even tossed the coin before the 91st Rose Bowl football game. *Id.* Apparently Disney is attempting to get every last cent out of their coveted cartoon before the possibility arises that they may be mandated to open up the floodgates to others to use Mickey's namesake. *See Walt Disney Co.*, No. 88 CIV. 1595 (SWK), 1990 U.S. Dist. LEXIS 12604, at *1.

121. 15 U.S.C. § 1114 (1)(a)(b); *see also* Elizabeth L. Plitzuweit, *Supreme Court Denies Certiorari in Contessa: Courts Remain Split in Determining Standard for Awarding Profits in Trademark Infringement Cases*, INTELL. PROP. NEWSL. (ABA Sec. of Intell. Prop. Law, Chicago, IL), Winter 2006, at 5, *reprinted in* INTELL. PROP. NEWSL. (ABA Sec. of Intell. Prop. Law, Chicago, IL), Winter 2008, at 5, <http://www.abanet.org/intelprop/newsletter/IPLWinter08.pdf> (noting that Section 43 of the Lanham Act distinguishes remedies available to a plaintiff based on whether the mark is infringed (citing Lanham Act § 43; 15 USC 1125)). That article points out that if a plaintiff shows that a defendant willfully diluted the plaintiff's famous mark then the plaintiff will be entitled to disgorgement of the defendant's profits. *Id.* *See also* Helfand, *supra* note 15, at 636.

122. *See* Helfand, *supra* note 15, at 658–59 (citing Frederick Warne & Co. v. Book Sales, Inc., 481 F. Supp. 1191 (S.D.N.Y. 1979)); *see also* Rich, *supra* note 12 (discussing the convergence theory). Such is the case with Disney characters. *Id.*

123. Helfand, *supra* note 15, at 658–59. That way, when the copyright expires and the character enters the public domain, the owner will still have intellectual property rights on which to rely. *Frederick Warne*, 481 F. Supp. at 1197.

124. Rich, *supra* note 12; *see* Helfand, *supra* note 15, at 665–66 (stating that “trademark and unfair competition cannot substitute for the greatly diminished protection against unauthorized expressive or ornamental uses”); *see also* Michael H. Davis, *Extending Copyright and the Constitution: “Have I Stayed Too Long?”*, 52 FLA. L. REV. 989, 1009 (2000) (the Supreme Court “considered the scope of the copyright clause and found that despite the constitutional clause’s expansive breadth, the terms and purposes of copyright were not wide enough to include trademarks” (quoting *States v. Steffens*, 100 U.S. 82 (1879))).

With any good legal theory, there are of course exceptions.¹²⁵ For instance, in copyright law, there are exceptions to an owner possessing exclusive rights.¹²⁶ For starters, the exclusive rights of a copyright owner are limited in duration.¹²⁷ Likewise, an owner of a lawfully made copy is entitled to “sell or otherwise dispose of” that copy, without any authority from the copyright owner, and may even display the copy to people present where the copy is located.¹²⁸ Another exception to the exclusive rights of the owner is that individuals may create any work, and if it happens, by mere chance, to appear as a mirror image of the original author’s previously created work, the original author will not have any recourse except the almost irrefutable inference that because the two depictions are so similar, the work was illegitimately copied.¹²⁹

The main exception to the exclusive rights granted to a copyright owner is the fair use doctrine.¹³⁰ Generally, reproduction of a work is deemed to be fair use if the work is being copied for non-commercial purposes such as “criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research . . .”¹³¹ Then again, while educational use is not a commercial use, that type of use is deemed unfair use when it materially takes away from the profits which the copyright holder has a reasonable expectation of receiving.¹³² The Supreme

125. See Moetteli, *supra* note 8.

126. *Id.*

127. *Id.*

128. *Id.* (pointing out that the copy owner may not broadcast the image to people at other locations besides where the copy is located).

129. *Id.*

130. *Id.*

131. 17 U.S.C. § 107 (2008). The United States Copyright Code regarding the fair use exception states:

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

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

Id.

132. Moetteli, *supra* note 8 (protecting the author of educational texts because if the work is a teaching aid, then the intended consumer is a student or teacher and if there was no right to exclude use for educational purposes, there would be no incentive to write textbooks and the

Court attempted to explain *fair use* under the Copyright Act by stating “[t]he crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the [protected] material without paying the customary price.”¹³³ Instead of basing the fair use exception on this vague standard, Posner opined that we should deem any use of a work as a fair use if the original author does not reasonably act to give notice to others that his work is protected by copyright.¹³⁴

Of note is the fact that the fair use defense is available only after the defendant begins to defend himself in court, after he, as a possibly innocent infringer, is pressured to spend money on a lawyer.¹³⁵ This of course makes the fair use exception virtually untenable to well-intentioned individuals who happen to not be wealthy.

The concept of fair use, which originated within the idea of copyright law, has also extended into trademark law.¹³⁶ Thus, people can now copy,

like). Professors and teachers who teach courses on not only art and science but also on copyright, popular music, and pop culture must be able to make certain copyrighted materials available without worrying about getting sued. *See also* McLeod, *supra* note 40 (noting that sampling is not a new idea; in 1961, a young American musician and composer created a piece titled *Collage #1* in which he cut up and reassembled portions of Elvis Presley’s recordings, including the popular hit *Blue Suede Shoes*).

133. *San Francisco Arts & Ath., Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 541 n.19 (1987) (citing *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 562 (1985)).

134. Posting of James DeLong to The Progress and Freedom Foundation, Center for the Study of Digital Property IP Central Weblog, http://weblog.ipcentral.info/archives/2004/09/posner_eldred_a.html (Sept. 22, 2004, 14:01 EST).

135. 15 U.S.C. § 1115 (2004); *see, e.g.*, *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124 (2004) (holding that the “defendant has no independent burden to negate the likelihood of any confusion in raising the affirmative defense that a term is used descriptively, not as a mark, fairly, and in good faith”); *see, e.g.*, *Int’l Stamp Art, Inc. v. Unites States Postal Service*, 456 F.3d 1270, 1274 (11th Cir. 2006) (holding that “[a] fair-use defense is established if a defendant proves that its use is ‘(1) other than as a mark, (2) in a descriptive sense, and (3) in good faith’”). The court further noted that a legal standard has not been developed for good-faith in the arena of trademark infringement. *Id.*; *Horphag Research Ltd., v. Pellegrini*, 337 F.3d 1036, 1041 (9th Cir. 2003) (holding, that “the classic fair-use defense ‘applies only to marks that possess both primary meaning and a secondary meaning and only when the mark is used in its primary descriptive sense rather than its secondary trademark sense’” and the “nominative fair use analysis acknowledges that it is often virtually impossible to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose without using the mark.” (internal quotation marks omitted)).

136. *See* 18 AM. JUR. 2D *Copyright and Literary Property* § 238, at 570 (2004) (noting that the First Amendment defense has not been accepted in cases where there was copying of well known cartoon characters that could have been parodied without virtually copying the character). No circuit has ever protected an artist from copyright infringement based on the First Amendment’s freedom of expression clause, although it has played a role in the fair use defense. *Id.* Thus, the First Amendment will not protect someone who parodies a work from being held liable for infringement. *See Walt Disney Prod. v. Air Pirates*, 581 F.2d 751, 758–59 (9th Cir.

quote, and publish copyrighted or trademarked works in order to criticize or parody it.¹³⁷ Fair use has been understood to restrict censorship and allow the First Amendment to be interpreted in a broad context, permitting culture to thrive as well as to prevent publishers and authors from suppressing commentary on their works.¹³⁸ For example, the controversial rap artist Two Live Crew was granted fair use, in the copyright context, of the Roy Orbison song “Oh! Pretty Woman,” when they parodied the song in an overtly offensive manner.¹³⁹ Likewise, Mattel’s famous Barbie Doll was not granted constitutional protection under trademark law, when a pop music band, Aqua, put out a song that made a mockery of the doll and attached a degrading image to women.¹⁴⁰ Thus, the concept of free-expression has taken precedence over intellectual property in various arenas.¹⁴¹ Lately however, it appears as though individuals are granted less deference when it comes to the concept of fair use.

The fair use controversy has recently extended to what is known as *sampling*. For example, “[i]n early 2004, underground hip-hop artist Danger Mouse produced a pop-music [album] he named the *Grey Album* . . . [where he] spent more than 100 hours chopping up instrumental fragments from the Beatles’ *White Album*, adorning them with vocals from Jay-Z’s recently released *Black Album*.”¹⁴² Although Danger Mouse

1978). Author Kembrew McLeod has registered the phrase *freedom of expression* with the U.S. Patent and Trademark Office in order to express the absurdity of copyright laws. McLeod, *supra* note 40, at 88. Similarly, Fox News was awarded *Fair and Balanced* and was able to use the registration in order to sue satirist Al Franken when he used it in the title of his recent book without Fox’s permission. *Id.* Lastly, how can we forget about Donald Trump registering and in essence owning the phrase *you’re fired*. Eric Dash, ‘Fired’ Topped by ‘Hired’ at the Trademark Office, N.Y. TIMES, Aug. 30, 2004, <http://query.nytimes.com/gst/fullpage.html?res=9805E0DA1F3EF933A0575BC0A9629C8B63>.

137. See Heins, *supra* note 9.

138. Heins, *supra* note 5, at 8–9. The Supreme Court has described parody as a form of criticism within the realm of copyright law. *Lingering Confusion About the Use of Marks in Domain Names of Web Sites that Critique or Parody*, INTELL. PROP. L. NEWSL. (ABA Sec. of Intell. Prop. Law, Chicago, IL), Winter 2006, at 23 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 567, 579 (1994)). “If . . . viewers understand that what they are seeing is a parody and is not affiliated with, or endorsed by, the mark holder—then they are not likely to be confused . . . ,” and the parody has done its job. *Id.* (citing *Dr. Seuss Enterprises, L.P. v. Penguin Books U.S.A., Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997)). In those situations, the parody is effective and diminishes the risk of consumer confusion “by conveying [only] just enough of the original design to allow the consumer to appreciate the point of parody.” 5 J. THOMAS MCCARTHY, *Trademarks and Unfair Competition* § 31:153, 31-257 (4th ed., 2004) (citing *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001)).

139. Heins, *supra* note 5, at 9.

140. *Id.* at 10.

141. See Heins, *supra* note 9.

142. McLeod, *supra* note 40, at 79.

received a cease-and-desist letter from EMI (representing the Beatles), countless individuals have defended Danger Mouse's actions and declare that there is "no way any Beatles fan would choose to download the Danger Mouse remix in lieu of purchasing a Beatles record, and the same is true of Jay-Z's fan base."¹⁴³ Copyright owners insist that it is illegal to sample without permission under the current copyright system, even if the sampler offers to pay royalties; however, ever since the Copyright Act of 1909 was established, it has been acceptable for musicians to record their own versions of a song and remake another's music by registering the cover and paying an appropriate licensing fee or simply by parodying the song.¹⁴⁴ However, if the Danger Mouse case is reviewed in the same manner as *Walt Disney Productions v. Air Pirates*, intent will be disregarded, and even though the consumer markets do not directly overlap, not even the First Amendment or the right to parody will likely protect Danger Mouse.

Since the Disney Empire is so vast, classifying which intellectual property domain a character such as Mickey Mouse falls under, presents a daunting task. A movie starring Mickey Mouse possesses copyright protection, while Mickey Mouse, the character, is a strong trademarked symbol, which is protected under trademark law as long as Disney is willing to defend the depiction.¹⁴⁵ Therefore, some have wondered why Disney fought so hard to retain copyright protections for just an additional twenty (20) years, while they nonetheless have infinite trademark rights.¹⁴⁶ One explanation is that without the copyright extension, people would be free to create new Mickey Mouse cartoons and derivative works, without asking permission, and without paying licensing fees. They would be subject only to forgiving trademark laws because the original version of

143. *Id.* at 80. Thus, because there is no commercial diminution in market share for either party, there is no viable claim, especially since both the Beatles and Jay-Z likely profited out of the whole deal because they were given free publicity. *Id.* at 80.

144. *Id.* at 80. This goes to show that copyright law seems to be more concerned with semantics than with actual conflict of use. *Id.* Likewise, the high cost of licensing limits the range of choices and the number of samples that smaller artists have been able to obtain. *Id.* at 87.

145. See Slashdot, *Appeals Court Rejects Copyright Extension Challenge*, <http://slashdot.org/articles/01/02/16/1850229.shtml> (Feb. 16, 2001, 14:34 EST).

146. See 15 U.S.C. § 1058(a) (2004); see also 15 U.S.C. § 1059(a) (2004) (providing the procedure for renewal of registration). Although overlapping protection is permitted in the case of Mickey Mouse, the Court normally rejects claims for overlapping copyright and trademark protection. See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (rejecting trademark protection when the copyright expired because it would create a "species of perpetual . . . copyright, which Congress may not do."). It is important to note that for the most part, copyright and trademark protection exist separately because copyright law does not protect symbols or advertising designs and names. Although Mickey Mouse is an expressive work, thus, falling under copyright protection, it is also a trademark for the Walt Disney Company.

Mickey Mouse, as he debuted in STEAMBOAT WILLIE, would be free of copyright protection and back in the public domain.¹⁴⁷ Likewise, because their characters have very strong trademarks, they could have faced the possibility of losing the rights to their trademarks if their names became diluted or overused when people began to feel freer to use and exploit the images.¹⁴⁸ Finally, Disney would have been forced to police their products, names and marks to ensure that they did not become weak or unstable and as a result, released into the public domain due to their own negligence.¹⁴⁹

The union of trademark, copyright, patent and other intellectual property protections tends to benefit corporations and owners because creators reap all the benefits; but the union should protect individuals and those who wish to parody and fairly use the depictions because the public's rights under the Constitution are currently being withheld.¹⁵⁰ As a result of the convergence of copyright and trademark law, individuals are restricted as to the scope of fair use, and limited as far as authorization from owners.¹⁵¹ This is because there is no term length under trademark law, and copyright has been protecting virtually everything as of late, so the "result is that the longest protection term is linked to the widest possible scope of protection without regard to the underlying qualities of the character."¹⁵²

147. See Slashdot, *supra* note 145. Most argue that once a copyright of an original story or cartoon ends, others can use the character's appearance or description, and possibly its name. Helfand, *supra* note 15, at 654.

148. See *id.* at 670. For strong marks such as the Mickey Mouse trademark, the owner, in this case Disney, must do everything in its power to ensure that their works are not being sent into the public domain prematurely. See *id.* Therefore, Disney seeks to shelter the public from using their characters in paintings or in any other media in order to prevent confusion from possibly arising among the general public. See *id.* The issue of confusion must be considered by trademark owners to enable them to take preventative measures to protect their intellectual property from falling into the wrong hands and losing the rights to claim sole ownership of the mark. See Slashdot, *supra* note 145. It is important to note that Disney will nonetheless retain powerful trademark protections that remain in effect long after the expiration of the copyright for a character such as Steamboat Willie. *Id.*

149. See Hughes, *supra* note 28, at 1003; see also PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 241 (5th ed., Foundation Press 2004) (1973) (addressing King-Seeley Thermos Co. v. Aladdin Industries, Inc. 321 F.2d 577, 581 (2nd Cir. 1963)). This excerpt proves that company and product names such as that of escalator, yoyo, linoleum, nylon, kerosene, corn flakes, dry ice and trampoline have become such common words that they have been incorporated into our standard vocabulary and lost their trademark rights. *Id.* at 244-45. The example in the text shows an advertisement for the Xerox Corporation asking customers to use the word *photocopy* instead of *Xerox* in order to preserve its trademark privileges. *Id.* at 245. As another example, if the term *Mickey Mousing around* or another such term became so over used that it actually began to endanger the original meaning of Mickey Mouse, the Disney Company would possibly be in jeopardy of losing its trademark rights.

150. See Helfand, *supra* note 18, at 653.

151. See *id.*

152. *Id.* at 653-54.

III. PROPOSAL: AN ALTERNATE METHOD TO MEASURE FAIR USE

Section 43 of the Lanham Act sets forth the standard for actionable trademark infringement and distinguishes the remedies available to a plaintiff based on whether the mark is infringed or diluted.¹⁵³ Although copyright awards are meant to deter illegal conduct and encourage copyright owners to pursue their claims to preserve the originality and value of their works, it appears as if nobody is protecting an individual's right to use a copyrighted work without forcing the individual to resort to their attorney each time they do so. For example, the court in *Design Tex Group Inc. v. U.S. Vinyl Mfg. Corp.*, granted a \$435,000 award to a willful copyright infringer.¹⁵⁴ This is the type of award that could easily result in the end of one's business career. Therefore, in a situation involving one of Disney's coveted copyrights, Disney would essentially be able to put an ignorant defendant out of business before the defendant even knew what hit him.

The fair use exception to the Copyright Act is vague as there is no clear standard to determine whether a use should be deemed fair or unfair. As such, it is an appropriate time to review the doctrine as applied to trademark law and consider applying it to copyright law. The primary reason that the fair use doctrine should be uniformly applied to both copyright and trademark law, is that when a character such as Mickey Mouse enters the public domain, loses copyright protection, and retains solely trademark protection, conflict will inevitably arise based upon who is claiming the fair use and at what time they invoke the rule. In some instances, a use may be considered fair use under copyright's fair use doctrine and not under trademark's or vice versa, and the fair use doctrine should thus be aligned across the board before Mickey Mouse creates havoc. Our courts have never before been in a situation where a character of such prominence and economic stature will be protected solely under trademark, after being duly protected by copyright and trademark law. Although jurisdictions are currently split regarding whether trademark remedies require that there is a showing of willful infringement on the part of the defendant, it appears that one circuit's analysis is directly on point with the notions of fair play and substantial justice.¹⁵⁵

Similar to the application of the fair use doctrine with regard to

153. See 15 U.S.C. § 1125(a)–(e) (2008).

154. See Resnick, *supra* note 16, at 16 (citing *Design Tex Group Inc. v. U.S. Vinyl Mfg. Corp.*, No. 04 Civ. 5002, 2005 U.S. Dist. LEXIS 18276, at *14 (S.D.N.Y. Aug. 24, 2005)).

155. See Plitzuweit, *supra* note 121, at 5.

copyright law, according to the Third, Fifth, Sixth, Seventh, and Eleventh Circuits, “disgorgement of an infringer’s profits is [currently] not contingent on a showing that the infringer willfully infringed the plaintiff’s mark.”¹⁵⁶ Consequently, the courts in those circuits have the broad ability to prove infringement and cite virtually everyone for trademark infringement, regardless of their intent. As such, almost any attempt to use another’s mark could result in disgorgement of earnings. If applied to copyright law, this option would appear to fly in the face of the original construction of the Copyright Clause.

In contrast, the First and Ninth Circuits focus solely on whether the parties are in direct competition with one another, and if so, a court *may* award an infringer’s profits even where bad faith is not shown.¹⁵⁷ This approach appears to accurately position the plaintiff against the defendant in the sense that they must be in the same line of business for infringement damages to be awarded, alleviating the problems we observed with *Walt Disney Productions v. Air Pirates* and *Danger Mouse*. However, this approach likewise allows infringement damages even where bad faith is not shown. Once again, this is in direct contrast to the Framers’ intent of allowing copyright to be the engine of free expression.¹⁵⁸

Finally, the Second, Tenth, and D.C. Circuits require a showing of willful infringement before profits are awarded.¹⁵⁹ Equitably speaking, this appears to be the best approach, and would likely meld well with copyright’s fair use doctrine. It would ensure that the defendant is not an unsuspecting naïve individual who will be slapped with a huge fine, equating to an expensive lesson, which could possibly put him out of business. This theory will also allow the public to utilize characters while simultaneously providing corporations the protection and incentives they need to continue profiting in a competitive marketplace.

156. *Id.*; see *Galiano v. Harrah’s Operating Co.*, No. 00-0071 Section: E/5, 2004 U.S. Dist. LEXIS 8265, at *13 (E.D. La. May 11, 2004) (“Copyright ownership is shown by proof of originality and copyrightability in the work as a whole and by compliance with the applicable statutory formalities.” (quoting *Engineering Dynamics, Inc. v. Structural Software*, 26 F.3d 1335, 1340 (5th Cir. 1994))).

157. *Plitzuweit*, *supra* note 121, at 7–8; see *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 928 (9th Cir. 2005) (noting that the plaintiff bears the ultimate burden of proof in a trademark infringement action to prove the mark is valid and not generic, and must prove the validity of a trademark as a *threshold issue*).

158. *Harper & Row, Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 558 (1985); see *Austin*, *supra* note 37, at 26 (stating “[i]n our haste to disseminate news, it should not be forgotten that the Framers intended copyright itself to be the engine of free expression.”); see *Heins*, *supra* note 5, at 2 (describing copyright as *the engine of free expression*).

159. *Plitzuweit*, *supra* note 121, at 6.

Because jurisdictions are clearly split on whether willfulness is a prerequisite for an award of profits for violations of Section 43(a) of the Lanham Act, plaintiffs have been increasingly forum shopping. Thus, after plaintiffs' attorneys consider this jurisdictional split, courts in the Third, Fifth, Sixth, Seventh, and Eleventh Circuits are likely to become flooded with potential problems deciphering the infringement issues. If we are to mandate a showing of willful infringement before the copyright fair use exception can be invoked, it is probable that we will drastically reduce the amount of litigation currently flooding our system with regard to this gray area.

CONCLUSION

There is no doubt that there is a conflict between copyright law, as currently written, and with the concept the Framers were attempting to incorporate into the First Amendment. Intellectual property rights "result from changes in economic values that stem from . . . new technology and . . . new markets."¹⁶⁰ Although individuals have faced hardships in an effort to make use of a particular copyrighted work prior to its entrance into the public domain, copyright reform is constantly developing, which should assist these people, even though technological uncertainty has been growing. Resolving the conflicting claims of opposing parties will require policymakers to strike a *difficult balance* between rewarding the owners of works of creative ideas, and the competing interests of society "in the free flow of ideas, information, and commerce."¹⁶¹ It appears as though the equilibrium will never be achieved unless individuals begin to value an author or corporation's welfare more than social welfare and the greater good. Since conflicts between rigid copyright control and free expression are at the forefront of the intellectual property battleground, it is time that the legislature synchronize the ideals between artists, creators, and corporations who wish to shield their property, on the one hand, and public interest groups, scholars, and librarians who urge the movement toward a greater free flow and sharing of creative works.¹⁶²

Issues concerning copyright, trademark, and the public domain are rarely clear-cut, and frequently overlap. As such, protection seems to ignore many of the rules initially developed for copyright or trademark law,

160. Ben Depoorter, *The Several Lives of Mickey Mouse: The Expanding Boundaries Of Intellectual Property Law*, 9 VA. J.L. & TECH. 4, ¶ 147 (2004).

161. Heins, *supra* note 5, at 2 (quoting *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984)).

162. *See id.* at 2–4.

individually. Clearly, there is no simple answer to the issue of copyright protections and defining a cut-off as to what is to be protected under copyright law versus trademark law. The public domain, which was originally intended to benefit future creators, is gradually being eroded because corporate owners, as well as an author's beneficiaries, are inheriting copyrights and copyright seems no longer to be about directly rewarding an author for his work. As a result, the work will last well beyond the life of the creator or the audience that originally experienced the creation. In the information age, "the benefits of an expansive public domain are easily recognized," regardless of the restraints Congress attempts to impose on the free exchange of ideas and information.¹⁶³ The Justices in the *Eldred* case were committed to deferring to Congress's decisions concerning copyright authority, and as such, we are experiencing unknown effects of the CTEA as copyright becomes intertwined with trademark protections.¹⁶⁴ Given that Congress is afforded broad discretion in matters of intellectual property, legislation may be written and interpreted in such a way that could feasibly allow the judiciary to extend protections for infinite durations, which is bound to stifle creativity.

Western society, including corporate America, generally borrows ideas from existing sources; therefore, it appears that the extension of copyright appears to be a permitted threshold of thievery from artists who wish to use others' work to enhance culture and creativity.¹⁶⁵ The main point is that although it is far from perfect, the system of intellectual property does regulate the industry. However, if more people were permitted access to work, more people would benefit from the work. Radical action is not needed as it would have a chilling effect on industry. Thus, there is no reason to completely overhaul or eliminate the system simply because a small number of corporations abuse their positions;

163. Davids, *supra* note 40, at 174.

164. See Todd John Canni, *Promoting Progress Through Perpetual Protection: The Struggle to Place Limits on Congress' Copyright Power*, 53 CATH. U. L. REV. 161, 207–08 (2003); see also Helfand, *supra* note 18, at 623 (noting that in the 70's, a transition began wherein courts began to view copyright, trademark, and unfair competition claims as though they were equal and interrelated, and as such, the distinctions of the intellectual property laws became nonexistent when applied to fictional characters).

165. See Jack Kapica, *Copyright and the Mouse: How Disney's Mickey Mouse Changed the World*, MICKEY NEWS, Oct. 8, 2004, http://www.mickeynews.com/News/DisplayPressRelease.asp_Q_id_E_1084Copyright; see Posting of ItyRazor and The Cunctator to Slashdot, <http://slashdot.org/articles/01/02/16/1850229.shtml> (Feb. 16, 2001, 11:17 EST) (arguing that games, movies, songs, and other creative works slip out of production and slowly deteriorate into nothing because of the restrictions in copyright, and that by the time a copyright expires and derivative works can be created, there are no surviving copies to copy from).

however, we do need to develop bright line rules that will help decipher what is an acceptable use and fix the fair use doctrine once and for all. Essentially, we must only create sustainable improvements in intellectual property protection and end the cycle of corporate greed and Congress's sovereign rule that has been usurping American ideologies of late. This will remind us that freedom of speech is far more important than how effectively one lobbies for a cause.