COMMENT ON DENNIS S. KARJALA, HARRY POTTER, TANYA GROTTER, AND THE COPYRIGHT DERIVATIVE WORK

Edmund W. Kitch†

The Copyright statute provides no explicit protection for "characters."\(^1\) The statute lists as examples of the protected works of an author literary works, musical works, dramatic works, pantomimes, choreographic works, pictorial, graphic and sculptural works, motion pictures, sound recordings and architectural works.\(^2\) The statute explicitly excludes from protection any "idea, procedure, process, system, method of operation, concept, principal, or discovery."\(^3\) Nothing about characters.

For the reader unfamiliar with the structure of copyright law, it is useful to go through the analysis that has led courts to decisions that support the statement that copyright law protects characters. The protection that the courts have found in the statute is of a special and limited scope. It is important to understand this scope in order to address the issues that Professor Karjala raises in his paper.\(^4\)

Characters get protection from copyright as the result of two basic principles of copyright that are assumed but not explicitly stated by the statute.

The first is that copyright protects the expressive details of an author's work. Technically, it is not correct to say that "characters" are protected by copyright.\(^5\) What are protected are the elements of detailed expression, which may come together to create a character—its appearance, its style of expression, and its biography. Thus, to take a simple example, the name of a

\(^1\) See generally 17 U.S.C.A. § 102 (West 2005).


\(^3\) 17 U.S.C.A. § 102(b).


\(^5\) Thus I agree completely with Karjala's statement on page 24 that "The argument is... available, to any country that wishes to make it, that neither Berne nor TRIPS actually requires protection of literary characters, independent of the works in which those characters appear." Id. at 24. However, for the reasons explained in the text, protection of the "work" automatically protects against reproduction of the characters through use of the protected details by which the character is evoked.
character, by itself, is not protected by copyright. In the face of the copyright on J.K. Rowling's Harry Potter, one is perfectly free to write a story about another Harry Potter, perhaps a lonely ceramicist who lives in a cave.

The second principle is that the quantitative relationship between the copyrighted work and the matter taken from it by the alleged infringer has no relevance to the infringement inquiry. Although an alleged infringer has, for instance, taken a small part of a large novel, it is still infringement if he has taken the protected expression in that small part. Thus even a minor character, if described in detail and if that detail has been copied by the alleged infringer, is an infringement even though the character appears in only a few pages of a thousand page book, or if the character has only a minor part in the story. The protected elements are not protected against copying unless the copier creates another work with use of the detailed expression that makes the work appear to be substantially similar to the audience for a work of that type.

A well-known pair of opinions, both written by Judge Learned Hand, are often used to illustrate the operation of these principles.

In the first of the cases, Nichols v. Universal Pictures Corp., Judge Hand held that the defendant's motion picture The Cohens and The Kellys did not infringe the plaintiff's play Abie's Irish Rose. Although both centered on a young romance and the resulting interplay between two families, one Jewish and one Irish, Hand found that the resemblances were limited to general themes or ideas, which were not protected. In much quoted dictum he said:

If Twelfth Night were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his

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6. See 37 C.F.R. § 201.1(a) (2003) ("The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained: (a) Words and short phrases such as names . . . ."); see also Paul Goldstein, Goldstein on Copyright § 2.7.3 (Aspen 3d ed. 2005) ("Courts withhold protection from – and the Copyright Office regulations prohibit registration for – words and short phrases such as names, titles and slogans.").

7. This principle works in reverse as well, that is it does not matter what relative importance the alleged infringement has in relation to the work which includes the infringement. The exclusive right to prepare derivative works, under 17 U.S.C.A. § 106(2) (West 2005), extends whatever rights are conferred by the copyright to different languages and media (i.e., to cover translations or a movie version), but does not affect these basic principles.

8. 45 F.2d 119 (2d Cir. 1930).

9. See generally id.

10. Id. at 120–22.

11. Id. at 122.
characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's "ideas" in the play, as little capable of monopoly as Einstein's Doctrine of Relativity, or Darwin's theory of the Origin of Species. It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.\textsuperscript{12}

The \textit{Nichols} decision contrasts with Judge Hand's later decision in \textit{Sheldon v. Metro-Goldwyn Pictures Corp.}\textsuperscript{13} In that case the plaintiffs held copyright in the play \textit{Dishonored Lady}.\textsuperscript{14} They claimed that the movie entitled \textit{Letty Lynton} was an infringement of their copyright.\textsuperscript{15} Judge Hand held that it was, relying on close similarities in several scenes of the movie with scenes in the copyrighted work.\textsuperscript{16} Conceding that not everything in the movie infringed, he said, "it is enough that substantial parts were lifted; no plagiarist can excuse the wrong by showing how much of his work he did not pirate."\textsuperscript{17}

One ironic consequence of these principles is that a character portrayed graphically may have more effective copyright protection than a character portrayed in a novel. The reason is that the comic strip character—say Mickey Mouse or Superman—will be represented by a detailed drawing. If the drawing is copied, those details will be protected.\textsuperscript{18} A character in a novel, on the other hand, will be portrayed in words. If different words are used to create a similar character, it is less likely to be copyright infringement.

Professor Karjala concludes that the protection afforded to characters by modern copyright law has gone too far.\textsuperscript{19} He reminds us that questions of the scope of copyright protection involve an important trade-off between providing incentives to authors and protecting the public domain for the use of all.\textsuperscript{20} His principal illustration of copyright gone to far is the Dutch litigation involving the Tanya Grotter stories.\textsuperscript{21} Because there is no available report of the Dutch decision, and because the Tanya Grotter

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\item[12.] \textit{Id.} at 121.
\item[13.] 81 F.2d 49 (2d Cir. 1936).
\item[14.] \textit{Id.} at 49.
\item[15.] \textit{Id.}
\item[16.] \textit{Id.} at 50–56.
\item[17.] \textit{Id.} at 56.
\item[19.] \textit{See} Karjala, \textit{supra} note 4, at 38.
\item[20.] \textit{Id.} at 22.
\item[21.] \textit{Id.} at 18–20.
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stories are available only in Russian, it is impossible for me (as I do not speak Russian) to determine on what grounds the Dutch court decided the case. Under the principles of American copyright law, it would not be copyright infringement for Dimitri Yemets, inspired and amazed by the success of the Harry Potter series of books, to write a series of books about another character, Tanya Grotter, who shared with Harry the attributes of being young, being different, and having magical powers. Nor would it be actionable for him to truthfully advertise such a book as “The Russian Harry Potter,” meaning a book with similar themes that has enjoyed a similar success in Russia. On the other hand, he could not (without infringing the copyright on the Harry Potter series) use in his books details and sequences of events that closely tracked details and sequences of events in the Harry Potter series. This would be true even if the books also contained significant new and different material. If the Tanya Grotter book was of the first sort, then the Dutch decision was in error under the standards of American copyright law (but not necessarily of Dutch law). If the book is of the second sort, then the decision was correct.

It is not clear whether Professor Karjala’s argument is that the Dutch court applied the American standard (or more likely, a similar Dutch standard) incorrectly, or that the American standard as outlined above itself leads to undesirable results. In either case, he argues that the outcome of the case provides protection that is undesirably broad from a social point of view. He provides several arguments in support of this view.

One argument is that some fictional characters become “cultural icons” which enter the common culture and thus should become the property of all. This is reminiscent of the theoretically interesting but seldom applied doctrine in trademark law that a trademark term that becomes generic – becomes a word in the language that represents a kind of thing rather than an indication of origin (example: aspirin) loses its function as a trademark. In trademark law, this is a logical consequence of the requirement that a trademark function as an indication of origin. By definition, if the word has become generic it is no longer a trademark. Importing this idea into copyright law would be a doctrinal innovation.

One issue would be the relevant culture to use in measuring the iconic status of a character. Several observations in Professor Karjala’s paper suggest a special concern for cultures where the author is unable due to her

22. See supra text accompanying notes 13–17.
23. See supra note 17 and accompanying text.
24. See Karjala, supra note 4, at 33–34.
25. See generally id. at 33–38.
26. Id. at 17, 19, 26, 38.
own cultural limitations to make the character relevant to other symbols in the culture. Thus it is suggested that J.K. Rowling, an Englishwoman who speaks English, is unable to properly embed Harry Potter in Russian or Indian culture. Authors in those cultures should be free to do what she is culturally unable to do, write a Russian or Indian version. So would the test then be whether Harry Potter is a Russian or an Indian cultural icon? And if so, how could this be if J.K. Rowling is unable to properly embed Harry Potter in those cultures? And is Russian or Indian culture so dependent on imports from other cultures that Russian or Indian law should encourage importation, rather than creating incentives for creating culturally specific and original cultural figures? Wouldn’t a rule that made Harry Potter free for Russian and Indian authors to use simply encourage the importation of popular Western “cultural icons?” And what does the fact that Harry Potter is well known in, say England and the United States, have to do with the status of the work’s copyright protection under Russian or Indian law?

Another theme of the discussion is that “Rowling and her publishers have. . .[been] more than adequately recompensed for the creative stories that she has shared with the public.” This suggests that the test for when a character has become a “cultural icon” should be financial. The copyright could be used to generate enough, but not too much revenue. But how would this amount be set, and by whom? The economic analysis is complicated by the fact that the enterprise of creating successful popular characters is like other risky activities such as searching for mineral deposits. Some efforts, ex post, will be extraordinarily remunerative because of the luck or skill of the searcher or author, while the efforts of many others will yield nothing. Are the costs to be covered those of the successful prospector or author, or of all prospectors and authors, including all the failures? Is the argument that Rowling, like those fortunate enough to own oil as its market price recently increased, has garnered “windfall” profits unnecessary to create investment incentives, and that the law should be adapted either through taxation or the limitation of copyright to ensure that the profits are only “enough” rather than “windfall?”

Professor Karjalainen understands the difficulties involved in incorporating his concerns into copyright law. He seems to argue for an expanded fair use doctrine, but he does not discuss what the doctrinal contours of this expanded fair use doctrine would be. Would it be limited to characters, and if so, how would protection of characters be distinguished from protection of the expressive details of the author’s original work? He sees a connection

27. Id. at 35–36.
28. Id. at 35; see also reference to “excess value.” Id. at 26.
to "our acceptance of a fair use exemption for parody" in that such an exemption allows others to make their own use of the work of an author.\(^{29}\) However, it is quite debatable whether such an "exemption" exists in copyright law.

In the end, Professor Karjala comes down to two modest suggestions. First, that courts should "be more cautious about injunctions against the distribution of creative derivative works involving protected characters in new stories."\(^{30}\) I agree that courts should be cautious about injunctions, but it is not clear to me why they should only be cautious about injunctions involving characters. And in the absence of an injunction, an author who would like to make infringing use of a character drawn from the work of another would still be faced with damages of an unpredictable and potentially large amount. Surely that alone is in most cases sufficient to deter the infringement. And it means that the courts would then be required to undertake the difficult task of measuring those damages based on hypothetical estimates of the world that would have existed had the infringement not occurred. That is, of course, the very reason that courts have tended to grant injunctions in these cases.

His second suggestion is that courts should take the infringement analysis seriously.\(^{31}\) Indeed they should, for the highly specific factual inquiry into whether protected expression has or has not been taken in a specific case is at the very heart of the balance embedded in copyright law. It is respect for the importance of this inquiry which will leave "any idea, procedure, process, system, method of operation, concept, principle, or discovery"\(^{32}\) free for all to use, while affording to authors the exclusive right to reproduce and adapt their particular works of expressive authorship.

\(^{29}\) Id. at 36.

\(^{30}\) Id. at 39.

\(^{31}\) Id.

\(^{32}\) 17 U.S.C.A. § 102(b) (West 2005).