



Program Title _____
 Date Presented _____ Inn Year _____
 Presenting Inn _____ Inn Number _____
 Inn City _____ Inn State _____
 Contact Person _____ Phone _____
 E-mail Address _____

Please consider this program for the Program Awards: Yes No This program is being submitted for Achieving Excellence: Yes No

Program Summary:

Indicate the legal focus and be concise and detailed in summarizing the content and setup of your program. Please attach additional sheets if necessary.

Program Materials:

The following materials checklist is intended to insure that all the materials that are required to restage the program are included in the materials submitted to the Foundation office. **Please check all that apply and include a copy of any of the existing materials with your program submission:**

Script Articles Citations of Law Legal Documents Fact Pattern List of Questions Handouts
 PowerPoint Presentation CD DVD Other Media (Please specify) _____

Specific Information Regarding the Program:

Number of participants required for the program _____ Has this program been approved for CLE? Yes No
 Which state's CLE? _____ How many hours? _____

Recommended Physical Setup and Special Equipment:

i.e., VCR and TV, black board with chalk, easel for diagrams, etc. When submitting video, please indicate the length of all videos. i.e., 30 or 60 min.

Comments:

Clarify the procedure, suggest additional ways of performing the same demonstration, or comment on Inn members' response regarding the demonstration.

Program Submission Form

Roles:

List the exact roles used in the demonstration and indicate their membership category; *i.e.*, Pupil, Associate, Barrister or Master of the Bench.

Role	Membership Category

Agenda of Program:

List the segments and scenes of the demonstration and the approximate time each step took; *i.e.*, "Introduction by judge (10 minutes)."

Item	Time

Program Awards: *Please complete this section only if the program is being submitted for consideration in the Program Awards.*

Describe how your program fits the Program Awards Criteria:

Relevance: How did the program promote or incorporate elements of our mission? (*Fostering Excellence in Professionalism, Ethics, Civility, and Legal Skills*)

Entertaining: How was the program captivating or fun? _____

Creative and Innovative: How did the program present legal issues in a new way? _____

Educational: How was the program interesting and challenging to all members? _____

Easily Replicated: Can the program be replicated easily by another Inn? Yes No This program is: Original Replicated

Questions:

Please contact Christina Hartle at (703) 684-3590 ext 105 or by e-mail at chartle@innsofcourt.org.

Please include ALL program materials. The committee will not evaluate incomplete program submissions.

Atlanta IP Inn of Court

Program Materials for
Extending IP Protection on Literary
Characters: An IP Mystery

Presented on February 19, 2014

Special Thanks to Our Host



MEUNIER CARLIN & CURFMAN LLC

INTELLECTUAL PROPERTY LAW

Additional thanks to our Pupilage Group Chairs

Greg Carlin of Meunier Carlin & Curfman

Jennifer Miller of McKesson

Program Summary:

This program involved a review of the growing area involving the protection of literary characters. The skits and scenes predominately focus on the Sherlock Holmes character created by Sir Arthur Conan Doyle. A portion of his works have fallen into the public domain, but the skits review how the works and image of Sherlock Holmes and other characters can be protected through copyright and trademark. The skit is divided into multiple scenes. The first is a game show where three contestants explain who is the real Sherlock (e.g., variations on the character that are protected and not protected), where a judge explains the differences. Scene 2 is a Trademark review panel where Sherlock explains the qualities that make him entitled to a Trademark. The third is an arbitration where the parties debate a ripped off version of Sherlock. The program allows for a great deal of entertainment and legal discussion on the tests to determine if and how the Sherlock character and other characters (e.g., Superman) are protectable.

Setup:

The setup can be as simple as a panel presentation, table and 4-5 chairs with a screen for a powerpoint presentation. It is usually best for a few members to get appropriate attire to depict the Sherlock character (e.g., hat, overcoat, magnifying glass, pipe, etc.)

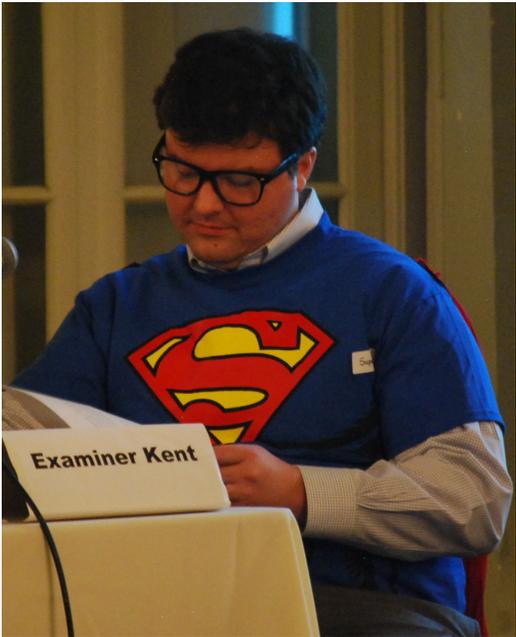
Scene introduction and potential Q&A sessions should take place between scenes as the transition from one to the other follows a similar theme (i.e., protecting the Sherlock Holmes mark) but deal with drastically different protection schemes and analysis.



Panel of Sherlock Holmes Characters and how they have changed over the years



Rodgers Lunsford as the Real Sherlock



Clark Wilson as Examiner Clark Kent



Warren Thomas (a/k/a Watson) arbitrates his right to use a character that looks like Sherlock Holmes

Pupilage Group 4 Presentation – Scene 1

Title

To Tell the Truth: Copyright Edition

Synopsis

The first scene of the presentation is a game show styled after the long-running game show “To Tell the Truth.” Three actors will play different versions of Sherlock Holmes: pre-1923, post-1923, and modern day. The three versions of Sherlock will describe who they are based on story elements from their respective time periods. Each Sherlock will also provide an argument why they are copyright protected. The contestant on the game show will be a federal district court judge. After each Sherlock has described who he is, the contestant will have to identify the copyright protected elements of each Sherlock and provide the legal reasoning for his conclusion. The contestant wins if he correctly identifies the copyright protected elements of each Sherlock.

Actors

Pre-1923 Sherlock: Rodgers Lunsford

Post-1923 Sherlock: ?????

Modern Day Sherlock (Knock Off): ?????

Clerc O. Corts (Game Show Host): ?????

Judge Al Wayz Wright: (Contestant): Andy Koelz

Narrator: Greg Carlin

Props

Game show music

Applause sign

3 Sherlock costumes

Script

Intro: Game show music...

Narrator: And now from the Imperial Ballroom studio located in Midtown Atlanta, it's "To Tell the Truth: Copyright Edition"! Here's your host, Clerc O. Courts!

[Applause sign]

Host: Thank you...Thank you! You're beautiful! Such a great studio audience! So happy to have you here! Today's contestant will be trying to determine the copyright protected elements of our three characters. But before we meet him, let's meet our three characters!

[Applause sign]

Host: What is your name number one?

Pre: My name is Sherlock Holmes.

Host: What is your name number two?

Post: My name is Sherlock Holmes.

Host: What is your name number three?

Modern: My name is ... KHAN. *[mimicking recent Star Trek movie:*

<http://www.youtube.com/watch?v=b8Sa6oUUByE>]

Host: Uh, no, Mr. Cumberbatch, that was your character in the most recent Star Trek movie. Don't you mean...?

*[Modern crouches over table or podium mimicking third picture down:
<http://www.avclub.com/article/here-are-some-pics-of-benedict-cumberbatch-doing-m-106616>]*

Modern: I am fire... I am death!

[Host is getting exasperated.]

Host: No, Mr. Cumberbatch, that was your role as the dragon Smaug in the recent Hobbit movie. Perhaps your role as a detective ... in a BBC television series ...?

[Host motions toward other two Sherlocks as a clue.]

[Modern looks at other two.]

Modern: I am Sherlock?

Host: *[in relief]* That's the one.

Host: One or more of these characters is copyright protected and each has sworn to tell the truth regarding their distinguishing story elements. And now, let's meet our contestant, a United States district court judge, The Honorable Al Wayz Wright.

CLAPPING (Audience, Characters, and Contestant) [Someone holds up an "APPLAUSE" sign like it's a live studio audience]

Host: Welcome Judge Wright. Your job is to determine the copyright protected elements of each Sherlock you just met. Let's begin with some brief background. Follow as I read from the order of Judge Ruben Castillo. "Sir Arthur Conan Doyle authored four novels and fifty-six short stories featuring the fictional characters of detective Sherlock Holmes and his friend and colleague Dr. John H. Watson. Sir Arthur Conan Doyle first introduced these characters in 'A Study in Scarlet,' which was first published in *Beeton's Christmas Annual* in 1887 and first released in the United States in 1890. The four novels and forty-six of the fifty-six short stories were first published in the United States on various dates prior to January 1, 1923." The ten short stories remaining under copyright were published after January 1, 1923. Are you ready to begin Judge Wright?

Judge Wright: So excited to be on the show! Big fan! Big fan! I'm ready to begin.

Host: A brief reminder. Each version of Sherlock claims to be copyright protected. Your job is to determine what is protected and what is not protected. Lets hear from each of our Sherlocks. Sherlock number one...

Pre: My name is Sherlock Holmes and I was published in Sir Arthur Conan Doyle's works prior to January 1, 1923. I'm of Greek ancestry and I live on Baker Street. I make my profession as a detective. Not to brag, but I'm a pretty good. I'm known for my aptitude for disguise, amateur boxing skills, skill in baritsu (martial arts), and skill in chemistry. I'm also known for drug use and being a loner with erratic eating habits.

Host: Excellent! Now tell me why you are copyright protected.

Pre: Elementary! I'm copyright protected because my character was continually developed throughout the entire canon of stories. The copyright protecting the ten stories published after January 1, 1923 should extend to my character and the story elements pertaining to my character.

Host: Now that we've heard from our first character, you need to identify what elements of this character are copyright protected.

Judge Wright: Well, to state it simply, none of the elements Sherlock number one described are copyright protected. The story elements were first set forth in works published prior to January 1, 1923, and the copyright has expired on those works. The story elements contained within these works are in the public domain. Sherlock number one makes a novel argument that characters developed throughout a series of works remain under copyright protection until the final copyrighted story enters the public domain. However, the argument isn't persuasive. Where an author has used the same character in a series of works, some of which are in the public domain, the public is free to copy story elements from the public domain works.

Host: Ding ding ding! You're correct! Now let's hear from Sherlock number two. Tell us about yourself.

Post: My name is Sherlock Holmes and I was published in Sir Arthur Conan Doyle's works after January 1, 1923. A lot of what the first Sherlock said applies to me too. But there are additional story elements that pertain to me that originated in the stories published after January 1, 1923. For example, I've since retired from my detective agency, which occurred in a story published in 1926, and new characters have been introduced in these works.

Host: Interesting! Why are these new story elements protected?

Post: When you have eliminated the impossible, whatever remains, *however improbable*, must be the truth. My character contains story elements that are copyright protected because elements first introduced after January 1, 1923, warrant copyright protection as increments of expression. You see, the works produced after January 1, 1923 are still copyright protected. The fact that I've since retired from my detective agency is a story element that is protected. In addition, newly introduced characters are also protected.

Host: Judge Wright, what do you think?

Judge Wright: I agree with Sherlock number two. Increments of expression contained in copyrighted works warrant copyright protection. The Seventh Circuit Court of Appeals has held, “The Copyright Act specifically grants the author of a derivative work copyright protection in the incremental original expression he contributes as long as the derivative work does not infringe the underlying work.” *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 518 (7th Cir. 2009). The Seventh Circuit has further explained, “[T]he only originality required for a new work to be copyrightable is enough expressive variation from public-domain or other existing works to enable the new work to be readily distinguishable from its predecessors.” *Id.* at 521. The Copyright Act defines a derivative work as “a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted.” 17 U.S.C. § 101. Therefore, subsequent works in a series that feature the same character are derivative works.

District court’s have defined increments of expression to include storylines, dialogue, characters, and character traits. With respect to Sherlock number two, his retirement constitutes an increment of original expression that originated in a derivative work subject to copyright protection. This story element is protected by copyright. In addition, new characters introduced in the works are protected by copyright. However, the other story elements that are in the public domain do not receive renewed copyright protection based on their inclusion in a derivative work.

Host: You’re right again! Excellent analysis! This is by far the most knowledgeable contestant we’ve ever had on the show! Now we have our final Sherlock. Please tell us about yourself Sherlock number three...

Modern: My name is Sherlock Holmes and I am from the BBC' contemporary adaptation of Sir Arthur Conan Doyle's works. The first episodes aired in 2010. The series uses elements from the original works that are in the public domain, such as the Baker Street address and the inclusion of my adversary Moriarty. However, the series is set in present time and I use modern technology to assist me in solving crimes. There are other changes as well. For example, Dr. John Watson, my trusty assistant, served in the military in Afghanistan rather than in the Second Anglo-Afghan War.

Host: Now why are you copyright protected?

Modern: Dear God. What is it like in your funny little brains? It must be so boring.

[BBC Sherlock is known for his arrogance; this is a quote from the show.]

Host: Excuse me?

Modern: Fine. My portrayal of Sherlock clearly contains originality, the sine qua non of copyright protection. The elements added that reach the level of originality required are protected by copyright.

Host: Judge, what do you think?

Judge Wright: I agree, but there are two important qualifications to my agreement.

First, copyright protection of a derivative work never extends to the expression of the original work. Others are free to copy the original despite any use of the elements from the original in the new derivative work, the BBC television series. As noted in section 103(b) of the Copyright Act, any copyright protection in a derivative work extends only to the material contributed by the author of that work. Thus, the copyright in the original elements of the derivative work cannot affect or enlarge the scope, duration, ownership or subsistence of any copyright protection in the pre-existing material.

Second, there is some disagreement about the level of originality required for copyright protection to attach to derivative works. A few cases, most notably Gracen v. Bradford Exchange out of the Seventh Circuit, have held that derivative works must meet a higher level of originality in order to gain copyright protection. They reason that difficulties in distinguishing between two derivative works based on the same pre-existing work create a need for a higher level of originality before derivative works can acquire copyright protection. Other courts have criticized the more stringent requirements and held that derivative works only have to meet the same level of originality as non-derivative works.

Host: Wow! That's correct! You've done it again! Expert reasoning! I want to thank our audience and today's contestant. You've been fantastic!

Pre: A copyright doesn't protect me as much as I would like. I need to see if I can acquire trademark protection.

END SCENE

Pupilage Group 4 Presentation – Scene 2

Actors

Pre-1923 Sherlock “Sherlock”: Rodgers Lunsford

Examiner Clark Kent: Clark Wilson - **[He is wearing Superman costume]**

Judge Oliver Wendell Holmes: Jessica Glajch

Judge Moriarty: Laura Deines - **[He is wearing an overcoat and cap, and holding a pipe.]**

Judge Downy: Aaron Bourgeois

Props:

Original Sherlock costume

Superman costume

Overcoat, cap and pipe for Judge Moriarty

Name tags for “Examiner Kent,” “Judge Oliver Wendell Holmes,” “Judge Moriarty,” and “Judge Downy”

Sherlock beer/wine

Script

Sherlock: I stand before this panel today to appeal the examiner's decision to deny trademark rights for my character, Sherlock Holmes. I have been a much-loved character for over 100 years. Over the last several decades, my popularity has grown enormously and I have acquired virtually universal recognition among members of the public. I have enjoyed remarkable commercial success, producing substantial revenue for author Sir Arthur Conan Doyle.

I have a strong mark, and it is entitled to trademark protection. In the minds of consumers, the Sherlock Holmes mark is associated with my character in Doyle's novels or sponsorship by Doyle. Use of the mark by other entities would cause confusion and deceive the public as to the source and sponsorship of the products being offered.

My name is also highly distinctive. It has become inseparable from my character's identity. When consumers hear my name, they conjure up images of Doyle's original character.

In addition, my costume has become associated with Doyle's original character. I wear an unmistakable "deerstalker cap." This is no ordinary hat, but a hat with a unique pattern and a unique shape, complete with a front flap and a back flap. It stands out and is easily recognizable. I also carry a pipe. Although many characters carry pipes, my pipe is particularly unique. It has a long handle with a significant curve, making it distinguishable from other pipes. The combination of these items, including my deerstalker, my pipe, and my overcoat constitute "distinctive packaging" unique to my character.

Furthermore, the tagline, "Elementary my dear Watson" is distinctive. This particular phrase is widely recognized by members of the public. When consumers hear it, they conjure up the image of Doyle's great detective Sherlock Holmes [*points to himself*]. Allowing others to use this phrase would create a likelihood of confusion among the public as to the source of the products and indicate an inaccurate affiliation with Doyle's original Sherlock Holmes character.

In summary, the Board should reverse the examiner's decision and grant rights in the Sherlock Holmes mark.

EXAMINER KENT: The “Sherlock Holmes” mark is **not sufficiently distinct** to warrant trademark protection. Although the name “Sherlock” *[use finger quotes]* identifies a fictional character, it **also** identifies **many other** products as well. Sherlock Holmes’s **costume** is not distinctive because it consists of **ordinary items**, like a coat, a pipe, and a hat. As for the phrase “Elementary, my dear Watson,” how can it be associated solely with the original Sherlock Holmes character when the original character **never even uttered this phrase?** The phrase, “Elementary, my dear **fellow**, quite elementary” was in fact **first** used in a 20th century novel that was **completely unrelated** to Sherlock Holmes. Only **then** did the Sherlock Holmes **movies** start using the phrase, “Elementary, my dear Watson.”

The “Sherlock Holmes” mark is **also** not entitled to protection because it does not indicate to consumers a **single source of origin**. Sherlock Holmes has **many** sources of origin. Although Doyle was **one** author of Sherlock Holmes novels and short stories, there are numerous **other** Holmes authors, including well-known **American** novelist Nicholas Meyer. In addition, Sherlock Holmes appears in both books and movies. In fact, nowadays many **more** consumers associate Sherlock Holmes with movies than with Doyle’s books. Based on these **Super** arguments, the “Sherlock Holmes” mark is not entitled to trademark protection.

Judge Holmes: Uncle Sherlock, why should the name “Sherlock Holmes” be entitled to trademark protection? Sherlock is clearly associated with other products. The name Holmes is associated with many people who are arguably more recognizable than Doyle’s character, for example, me.

Sherlock: Well, my dear nephew Oliver Wendell, my name, Sherlock Holmes, is clearly distinctive. Although other recognizable people bear the name Holmes, there is no other widely recognized “Sherlock Holmes.” The name is uniquely associated with Doyle’s creation. To allow others to use my name would inaccurately indicate an association with my original character in Doyle’s books.

Examiner Kent: *[Pulling out a Sherlock beer and popping it open.]* There are **too many** other products that bear the names “Sherlock” and “Holmes” *[finger quotes]* for these names to be considered **distinctive**. Although connoisseurs of literature think of the Sherlock Holmes character when they hear the name “Sherlock,” connoisseurs of **parties and fun** will think of of Sherlock’s beer, wine ... and liquor.

Judge Moriarty: How can Sherlock’s pipe be distinctive when Popeye carries a nearly identical pipe?

Sherlock: Sherlock’s pipe is no ordinary pipe, but rather it is unique and recognizable, particularly in its shape. Popeye carries a corncob pipe that has an ordinary shape. The pipe has a straight handle and resembles any other average pipe. On the other hand, Sherlock’s pipe stands out and can be easily distinguished from other pipes. It has an extraordinarily long handle with a unique and significant curve that sets it apart from other pipes.

Examiner Kent: Sherlock carries an ordinary **pipe**. Although he argues that its shape it unique, anyone can easily obtain an **identical** pipe by going on **Ebay**. There is **nothing distinctive** about a long-handled pipe.

Judge Moriarty: Is Sherlock Holmes’s visual appearance really packaging, or rather features of Sherlock’s character that are not truly distinct and should not receive trademark protection?

Sherlock: Sherlock’s costume may constitute packaging. The product is my character, and my pipe, overcoat, and cap are the trade dress, or the packaging in I am presented. However, even if these items are features of the Sherlock Holmes character rather than packaging, the features are still entitled to trademark protection. This combination of features- my deerstalker, my uniquely shaped pipe, and my overcoat are distinctive and are understood by the public to refer to the original Sherlock Holmes character. Allowing others to use this combination of features will likely deceive the public as to the source or sponsorship of the goods.

Examiner Kent: Sherlock’s **costume** is clearly not distinctive. Compare his costume to one that is **truly distinctive**, *[stand up and face audience]* for example, that of Superman. I wear a **unique** blue suit and an **unusual** five-sided shield **emblazoned** with the **strong** letter “S.” This costume unmistakably signifies ... “**Superman.**” *[breathy and smile]* I wear a **red cape** because I am a **superhero** ... and because ordinary members of the public tend to avoid colorful capes. On the other hand, **Sherlock Holmes** wears a **tweed overcoat** just like the ones that **thousands** of ordinary Americans have purchased at **haberdasheries**. There is just **nothing** distinctive about Holmes’ costume.

Judge Downey: How can the phrase “Elementary, my dear Watson” be entitled to trademark protection when it is merely a series of common words used in the English language? Wouldn’t preventing others from using such words in their businesses be detrimental? Furthermore, how can “Elementary, my dear Watson” be associated with the original Sherlock Holmes character if he never uttered this phrase?

Sherlock: Although the individual words may be commonplace, the tagline, “Elementary, my dear Watson,” is distinctive and is entitled to protection. In Doyle’s books, my character referred to Watson as “my dear Watson” and I always used the word “elementary.” As I have become increasingly popular and readily recognizable, consumers have irreversibly associated the phrase “Elementary, my dear Watson” with my character.

Examiner Kent: The phrase, “Elementary, my dear Watson,” does **not** belong to Doyle’s Sherlock Holmes character. It is merely a **series of everyday** words. And it was not even originally **used** by Sherlock Holmes. It should **not** be entitled to trademark protection.

Judge Holmes: What is the single source indicated by the Sherlock Holmes mark? Isn’t it true that Sherlock Holmes has many sources, including numerous authors and several film studios?

Sherlock: Although many authors have written about my character, and several movies have been produced, the public recognizes the “Sherlock Holmes” mark as being associated with Doyle’s original character. Although consumers are aware that many Sherlock books and movies exist, they associate Sherlock Holmes with Sir Arthur Conan Doyle. Therefore, the “Sherlock Holmes” mark indicates only a single source.

Examiner Kent: There is **no single source** for the Sherlock Holmes mark. **Many different** authors have written about Sherlock Holmes, and each author represents a **different** source of origin. There’s also no single source of origin because Sherlock Holmes is associated with both books and films.

[Judges huddle together to discuss the verdict]

Judge Holmes: Our decision is 2-to-1, the applicant entitled to trademark protection for the name “Sherlock Holmes,” for Sherlock Holmes’s visual appearance, and for the tagline, “Elementary, my dear Watson.”

END SCENE

SCENE 3:

SHERLOCK VS. MORIARTY, INC.: THE MEDIATION

THE MEDIATION

A Table is positioned in the center of the room with three seats. One seat is for the Mediator, another for Sherlock, and the third for Moriarty, Inc.'s mystery representative (Watson).

Sherlock is sitting at table awaiting Mediator and Moriarty, Inc.'s representative. A mediation is about to take place in an attempt to resolve Sherlock's suit filed against Moriarty, Inc. Sherlock is wearing all of his "trademarked" elements, such as his hat, pipe, and cloak.

Actors

Sherlock: Rodgers Lunsford

Mediator: Suzanne Shope

Watson: ???? - **dressed as Sherlock**

Props

2 Sherlock costumes

Mediator's notepad

"W" sticker for hat

MEDIATOR

Hi, my name is Madea. Madea Ater.

[extends hand to Sherlock]

SHERLOCK

Hello there, darling. I'm Sherlock. Sherlock Holmes, and I could not be more pleased to make your acquaintance.

MEDIATOR

Pleased to meet you. I'm ready to mediate the hell out of this dispute.

SHERLOCK

I'm ready to get this case behind me and stop these thieves at Moriarty, Inc., from stealing my, well...from stealing me from me.

MEDIATOR

Why don't we wait for Moriarty, Inc.'s representative to arrive before we start discussing the substance of this case, okay?

SHERLOCK

Sure sure.

MEDIATOR

Thank you

SHERLOCK

So, have you any idea who will be attending on behalf of Moriarty, Inc? I'm very interested in learning the identity of these dastardly thieves.

MEDIATOR

[looking at pad]

It appears that Moriarty, Inc's founder, who is also its chief executive officer and principal author, will be attending this mediation on behalf of the company.

SHERLOCK

Excellent! I can finally learn who has been stealing my life's work from me.

[Watson, with an evil grin, enters the room dressed identically to Sherlock. Sherlock has a look of surprise, shock and betrayal]

WATSON

[extends hand to Mediator]. Hi there, I am Watson, the founder and CEO of Moriarty, Inc., the fastest growing, most creative and most dynamic media organization in the world. I am personally attending this mediation regarding these frivolous claims lodged by this trivial buffoon. *(points at Sherlock with a dismissive and disgusted look on his face)*

MEDIATOR

Well. Thank you for being here.

SHERLOCK

[incredulous]. WATSON! YOU are behind Moriarty, Inc?

WATSON

The one and only. *[arrogantly puffing his pipe]*

SHERLOCK

What the, how the, who the? How COULD you?

WATSON

How could I what?

SHERLOCK

DO this to me? You're supposed to be my assistant!

WATSON

Your ASSISTANT?? You are a buffoonish fool! A foolish buffoon!

SHERLOCK

WHAT?

MEDIATOR

OK, OK, everyone. Let's calm down and discuss this like adults.

WATSON

I'm TIRED of living in your shadow. I have ALWAYS been the true brains behind this operation and I can't put up with your bumbling incompetence any longer!

MEDIATOR

Gentlemen, gentlemen, relax. Let's discuss these issues calmly and without fighting about it. I'm sure we can come to an understanding where everyone leaves happy. Why don't we discuss some of the substantive issues that are the subject of your ongoing litigation?

SHERLOCK

Well, first of all, WATSON is wearing the exact same deerstalker as me, which the Trademark Trial and Appeal Board has ruled is a protectable element of my character under trademark law.

WATSON

Oh yeah?! How about now? *[turns hat sideways]*. Now it's a different hat.

SHERLOCK

All you did was turn it sideways! And by the way, it's called a "deerstalker," not a hat.

WATSON

OK, how about NOW? [*slaps a big "W" sticker on the hat right on his forehead*]

SHERLOCK

Well, I guess it's a little different now. Plus you look completely silly, so I'm on board with that.

MEDIATOR

Good, good. Alright, it looks like we're making progress here. Man, I'm just an awesome mediator. What else are we arguing about here?

SHERLOCK

OK, what about the pipe? EVERYONE associates the pipe with ME.

WATSON

So you're saying you invented the pipe?

SHERLOCK

No, I'm saying, as the TTAB helpfully explained, that trademark protection can extend to a wide range of elements, including a character's COSTUME, and that the pipe is a part of my COSTUME!!

WATSON

You gave me this pipe for solving that Baskervilles matter for you and for not telling anyone else about it, you buffoon!

SHERLOCK

It is still part of what makes me me!

WATSON

Fine. Whatever. Smoking's bad for you anyways. *[tosses the pipe across the table at Sherlock]*.

MEDIATOR

Alright! Looks like we're forging ahead. I rule at mediating. What's next?

SHERLOCK

OK, how about the overcoat? That is MY overcoat? I mean literally. I think he stole it from my closet. It actually has my name written on it.

WATSON

[checks tag on jacket]. Oh, so it is. Well, I can just go buy another one just like it.

SHERLOCK

[Extremely angry]

You can't do that! That is a part of my costume! My look! My style! My panache! My je ne sais quoi! As the TTAB explained, my costume, including my overcoat, is a protectable element of my character under trademark law!! *[pounds fist on the table...then pounds fist again for comedic effect]*.

[Mediator and Watson looking at him like he's crazy]

[looks at Mediator] This is an OUTRAGE, your honor! *[pounds fist again]*

MEDIATOR

I'm not a judge.

SHERLOCK

OUTRAGE, I say!

MEDIATOR

Super. *[with a condescending look on the mediator's face]*

WATSON

Listen, it's cold outside. People wear coats when it's cold. You want to stop me from wearing a coat while I'm solving mysteries FOR YOU, mysteries that you are too DENSE to solve yourself, even if it's 20 degrees outside? Are you crazy?

SHERLOCK

YES!

WATSON

Yes you're crazy?

SHERLOCK

No, yes I want you to stop wearing my coat!

MEDIATOR

OK, OK, calm down Sherlock. What if Watson agrees to wear a different coat when it's cold outside? Meaning a coat with a different design?

[speaking more quickly to confuse Sherlock] Or, what if he wears the coat, but not the deerstalker? Or he can wear the deerstalker sideways with the "W" on it but not wear the coat, but he can wear the coat along as long as it's below 45 degrees but no deerstalker in that scenario. Or the other way around? The reverse? Upside down? Right side up?

SHERLOCK

I don't know... *[looking confused]*

MEDIATOR

[cutting Sherlock off]...Good, then it's settled. Wow, I'm so good at my job.

WATSON

[Watson removes jacket and tosses it at Sherlock]. This jacket is horrible anyways. You can have it. I need something fancier. It's too...elementary for me, anyways.

SHERLOCK

THAT'S MY CATCHPHRASE!!

WATSON

Oh, man, here we go. *[eyes rolling]*. What now?

SHERLOCK

As the TTAB helpfully taught us, key phrases can also be an element of a character that is protectable under trademark law. And EVERYONE associates the phrase "Elementary" with one character. This guy! *[two thumbs pointed at himself]*

WATSON

Now you're claiming that you own the word "elementary?" You are literally insane.

MEDIATOR

OK, we're really doing a good job here today, guys. I just can't believe how much I rock at mediating. Let's move on.

SHERLOCK

OK, what about the copyrighted elements of my story?

MEDIATOR

You mean the post-1923 elements of the Sherlock Holmes universe?

SHERLOCK

Yes, as we learned, certain elements of mine and other characters are still protected by copyright and Watson needs to stop plagiarizing them!

WATSON

Oh, come on, you crybaby. What else do you want from me?

SHERLOCK

You need to stop using the post-1923 elements of the Sherlock Holmes characters!

WATSON

Like what?

SHERLOCK

Your background as an athlete!

WATSON

[palms up, shrugging, looking around at the audience as if to say "is he crazy," and then looking down at himself and his gut] Do I LOOK like an athlete?? Fine, I'll cut that from the story

SHERLOCK

What about my retirement from the detective agency?

WATSON

Sounds good. Instead, I'll off you in a horrible accident in my stories.

SHERLOCK

The character of your second wife?

WATSON

Done. Never liked that old hag anyways.

[few moments of awkward silence, everyone looking around at everyone on the table.]

MEDIATOR

Ooookey dokey. Looks like we've made a lot of progress here today, gentlemen. I think we have agreed on a lot of points and are pretty close to a settlement. Why don't we call it a day and have your lawyers exchange proposed settlement agreements?

SHERLOCK

Fine, but I still hate you, Watson. You traitor.

WATSON

The feeling is mutual you ungrateful twit! You still cannot accept that I was the one who actually solved all of those mysteries for you!

MEDIATOR

Now boys, let's be nice to each other. We're all adults here. Let's shake hands.

SHERLOCK

[begrudgingly]. Oh, FINE. *[extends hand to Watson]*

WATSON

Oh, alright. *[extends hand to Sherlock]*

MEDIATOR

Good boys. Man I am just the best at mediating, aren't I?

[Question and Answer session led by moderator, possibly fielding suggestions from the audience regarding how Watson can "design around" the copyrighted and potentially trademarked elements of Sherlock Holmes and how the Conan Doyle Estate can better protect the Sherlock Holmes

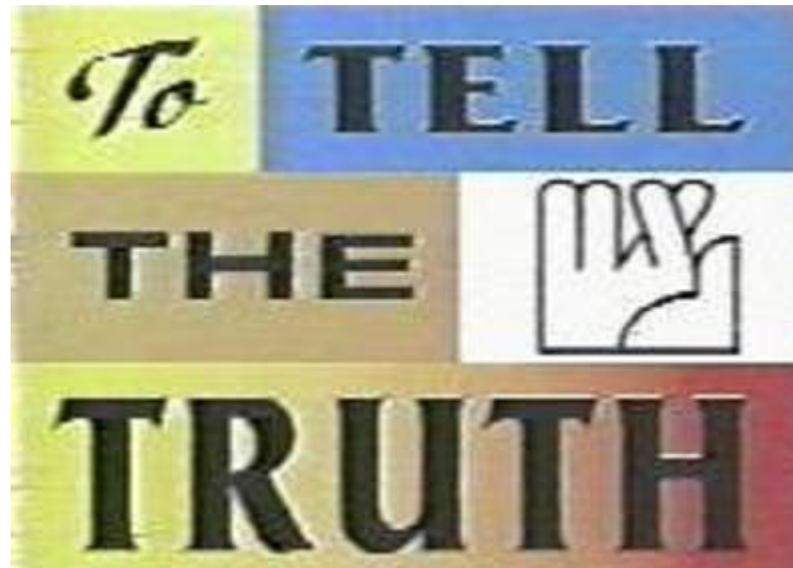
universe.]

THE END

Extending IP Protection on Literary Characters: An IP Mystery

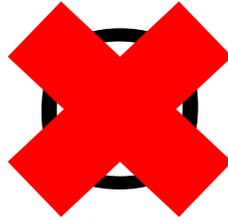


SCENE ONE:



Pre-1923 Sherlock Holmes

- **Argument:** Characters developed throughout a series of works remain under copyright protection until the final copyrighted story enters the public domain.



- “Where an author has used the same character in a series of works, some of which are in the public domain, the public is free to copy story elements from the public domain work.” *Klinger v. Conan Doyle Estate, Ltd.*, No. 13-CV-1226, 2013 WL 6824923 at *6 (N.D. Ill. Dec. 23, 2013).

Post-1923 Sherlock Holmes

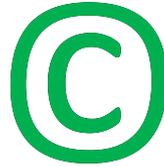
- **Argument:** Works produced after January 1, 1923, are still protected by copyright. Therefore, story elements first introduced after January 1, 1923, warrant copyright protection as increments of expression.



- “The Copyright Act specifically grants the author of a derivative work copyright protection in the incremental original expression he contributes as long as the derivative work does not infringe the underlying work.” *Schrock v. Learning Curve Int’l., Inc.*, 586 F.3d 513, 518 (7th Cir. 2009).
- “[T]he only originality required for a new work to be copyrightable is enough expressive variation from public-domain or other existing works to enable the new work to be readily distinguishable from its predecessors.” *Id.* at 521.
- A derivative work is “a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted.” 17 U.S.C. § 101.

Modern Day Sherlock Holmes

- **Argument:** Contemporary adaptation of Sherlock Holmes contains originality, the sine qua non of copyright protection.



- **Qualification One:** Copyright protection of a derivative work never extends to the expression of the original work. As noted in section 103(b) of the Copyright Act, any copyright protection in a derivative work extends only to the material contributed by the author of that work.
- **Qualification Two:** There is disagreement regarding the level of originality required for copyright protection to attach to derivative works.
 - **Higher Level of Originality:** The Seventh Circuit has held that derivative works must meet a higher level of originality in order to gain copyright protection. See *Gracen v. Bradford Exchange*, 698 F.2d 300 (7th Cir. 1983).
 - **Same Level of Originality:** Other circuits have criticized the more stringent requirements and held that derivative works have to meet only the same level of originality as non-derivative works.

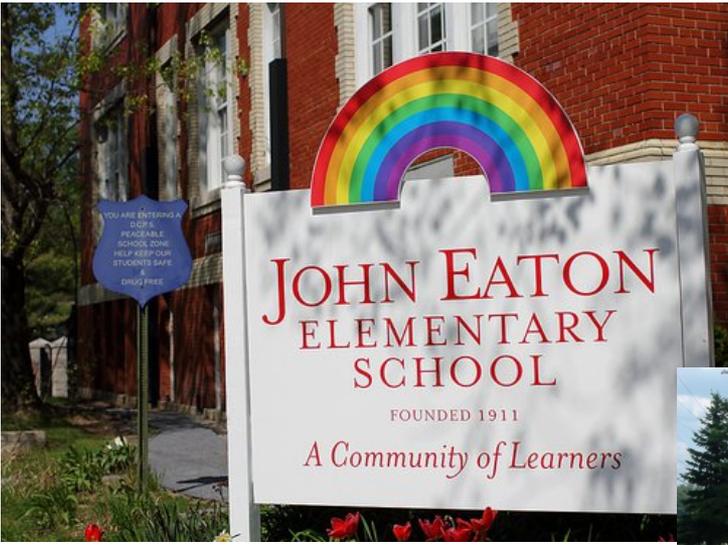
SCENE TWO:











SCENE THREE:
Sherlock v. Moriarty, Inc.:
The Medication

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MEMORANDUM

TO: IP Inn of Court – Atlanta Chapter

FROM: Pupilage Group 4

DATE: February 19, 2014

RE: *Klinger v. Conan Doyle Estate, Ltd.*, 2013 U.S. Dist. LEXIS 180493 (N.D. Ill. Dec. 23, 2013) – Summary

I. Summary

Plaintiff Leslie S. Klinger (“Klinger”) brought a copyright action against Defendant Conan Doyle Estate, Ltd. (“Conan Doyle”), seeking a declaratory judgment that various characters, character traits and other story elements from Sir Arthur Conan Doyle's Sherlock Holmes stories are free for the public to copy without infringing Conan Doyle's rights under the Copyright Act. On December 23, 2013, Judge Ruben Castillo issued an order ruling that stories published prior to 1923 were in the public domain but that ten later published stories were still under copyright protection.

Sir Arthur Conan Doyle authored four novels and fifty-six short stories (collectively, “the Canon”) featuring the fictional characters of detective Sherlock Holmes and his friend and colleague Dr. John H. Watson. *Klinger v. Conan Doyle Estate, Ltd.*, 2013 U.S. Dist. LEXIS 180493 (N.D. Ill. Dec. 23, 2013). Doyle first introduced these characters in “A Study in Scarlet,” which was first published in *Beeton’s Christmas Annual* in 1887 and first released in the United States in 1890. *Id.* The four novels and forty-six of the fifty-six short stories were first published in the United States on various dates prior to January 1, 1923. *Id.* The ten short stories remaining under copyright protection are:

1. The Illustrious Client (1924)

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2. The Blanched Soldier (1926)
3. The Three Gables (1926)
4. The Sussex Vampire (1924)
5. The Three Garridebs (1924)
6. The Creeping Man (1923)
7. The Lion's Mane (1926)
8. The Veiled Lodger (1927)
9. Shoscombe Old Place (1927)
10. The Retired Colourman (1926)

II. Klinger's Arguments

Klinger is the co-editor, along with Laurie R. King, of *A Study in Sherlock*, an anthology of new and original short stories by contemporary authors. *Id. at* *4. The stories in *A Study in Sherlock* were inspired by the Canon and feature various characters and story elements from the Canon. *Id.* Klinger and King are also the co-editors of a sequel to *A Study in Sherlock*, currently titled *In the Company of Sherlock Holmes*, which is another collection of new and original short stories featuring various characters and story elements from the Canon. *Id. at* *5. Klinger requested a declaration regarding the copyright status of a list of specific characters, character traits, dialogue, settings, artifacts, and other story elements in the Canon (the “Sherlock Holmes Story Elements¹”). Klinger argued that the Sherlock Holmes Story Elements are free for public use because the stories in which the elements were first introduced have entered the public domain. *Id. at* *18.

III. Doyle's Arguments

Conan Doyle did not dispute that the works that comprise the Canon, with the exception of the Ten Stories, are in the public domain. *Id. at* *19. Conan Doyle made a “novel legal argument” by claiming that “the characters of Sherlock Holmes and Dr. Watson continued to be

¹ The Sherlock Holmes Story Elements were listed in Klinger's Complaint and are included with this document.

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developed throughout the copyrighted Ten Stories and therefore remain under copyright protection until the final copyrighted story enters the public domain in 2022.” *Id.* If the Court agreed, it could not find that the Sherlock Holmes Story Elements are in the public domain because they would include character attributes that are still under copyright protection. *Id. at* *20. Conan Doyle also argued that to hold otherwise would “dismantle Sir Arthur Conan Doyle’s characters into a public domain version and a copyrighted version.” *Id. at* *23.

IV. Castillo’s Holding

A. Pre-1923 Sherlock Holmes Story Elements

The Court relied on *Silverman v. CBS, Inc.*, 870 F.2d 40, 50 (2d Cir. 1989) to conclude that the Pre-1923 Story Elements are free for public use. In *Silverman*, the Second Circuit held that where scripts from a radio show had entered the public domain and others were protected by copyright a party is entitled to use the public domain material without a license. *Klinger, at* *20. However, *Silverman* also established that the “increments of expression” contained in the post-1948 radio scripts and television scripts that further delineated the characters and story were protected by CBS’s copyright. *Id. at* *21. The Court applied the rationale in *Silverman* to Sir Arthur Conan Doyle’s Canon and determined that only the “increments of expression” added by the Ten Stories were protected by copyright. *Id. at* *22. Thus, the Court concluded that the Pre-1923 Story Elements are free for public use. *Id. at* *23. This holding effectively creates two versions of Conan Doyle’s characters: a public domain version and a copyrighted version

B. Post-1923 Sherlock Holmes Story Elements.

The Post-1923 Story Elements pertain to the characters Dr. Watson and Sherlock Holmes and include: (1) Dr. Watson’s second wife, first described in the 1924 short story “The Illustrious

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Client”; (2) Dr. Watson's background as an athlete, first described in the 1924 short story “The Sussex Vampire”; (3) and Sherlock Holmes' retirement from his detective agency, first described in the 1926 short story “The Lion's Mane.” *Id. at* *26. The Court utilized *Silverman* to rebut Klinger’s argument that “any material first introduced in the Ten Stories does not complete the characters of Sherlock Holmes or Dr. Watson and therefore does not qualify for copyright protection.” *Id.* The Court noted that the analysis does not “distinguish between elements that ‘complete’ a character and elements that do not; instead, the case law instructs that the ‘increments of expression’ contained in copyrighted works warrant copyright protection.” *Id.* The Court then denied Conan Doyle’s argument that the works in the Canon, including the Ten Stories, meet the definition of derivative works and held that the “increments of expression test” would apply. *Id. at* *31.

Klinger argued that “the Post-1923 Story Elements are not susceptible to copyright protection because they are events, not characteristics.” *Id. at* *33. However, the Court held that the Post-1923 Story Elements are protected because Klinger failed to provide any evidence that the Post-1923 Story Elements are not susceptible to copyright protection. *Id.* The Court then summarized Klinger’s motion for summary judgment into two required propositions: (1) the Pre-1923 Story Elements are in the public domain and are thus available for public use, and (2) the Post-1923 Story Elements are events that are not essential to the story or characters of Sherlock Holmes and Dr. Watson and therefore do not constitute incremental expression susceptible to copyright. *Id.* The Court held that Klinger met the first proposition but failed to meet the second proposition. Thus, the Court granted Klinger’s motion as to the Pre-1923 Story Elements and denied it as to the Post-1923 Story Elements. *Id. at* *35.

TO: PUPILAGE GROUP 4

FROM: GROUP 3

RE: COPYRIGHT PREEMPTION OF TRADEMARK CLAIMS

DATE: 1/22/14

ISSUE:

If Sherlock asserts claims for trademark infringement and unfair practices in federal court, may Mory Arty, Inc. defend such claims on the basis of preemption by the Copyright Act?

RELEVANT LAW:

Probably not, assuming Sherlock sufficiently argued for trademark protection in Scene Two. While the language of the Copyright Act of 1976 (“Copyright Act”) states that the Copyright Act preempts state law claims, no such preemption exists with regard to valid trademark claims.

The District Court for the Southern District of New York has held that a copyrightable character in the public domain should not be precluded from trademark protection if the character obtained independent trademark significance. Frederick Warne & Co. v. Book Sales, Inc., 481 F. Supp. 1191, 1196 (S.D.N.Y. 1979). See also Lee Middleton Original Dolls v. Seymour Mann, Inc., 299 F. Supp.2d 892, 900 (E.D. Wis. 2004) (Reasoning that “. . . for a Lanham Act claim to be viable, separate and apart from a Copyright Act claim, something more than a simple copyright notice violation, for example, must be alleged . . . the plaintiff must do more than simply ‘reallege their copyright claims under the guise of the Lanham Act. . .’”). Both copyright and trademark protection may exist without a risk of preemption because the property rights associated with copyright and those associated with trademark are distinct. Frederick Warne, 481 F. Supp. at 1196.

However, the Frederick Warne court focused on a narrow issue, analyzing whether *character illustrations* served to identify the creator. Id. at 1196-97. The court stated that protection under both copyright and trademark law is particularly appropriate for “graphic representations” of characters. Id. at 1196. If illustrations would likely lead the public to believe an alleged infringer’s publication is associated with the creator of the work, such danger of misrepresentation as to the source of the public domain material may establish a claim for unfair competition in trademark. Id. at 1197.

The defendants in Tracy v. Skate Key, Inc. similarly raised the defense of Copyright Act preemption of trademark claims. 697 F. Supp. 748, 750 (S.D.N.Y 1988). The Tracy court reasoned that the Copyright Act did not, in plain terms, preempt Lanham Act claims because the language in the Copyright Act does not “annul[] or limit[] any right or remedies under any other federal statute.” Id. (quoting 17 U.S.C. § 301(d); See also Costar Group Inc. v. Loopnet, Inc., 164 F. Supp.2d 688 (C.D. Md. 2001)(holding, as a preliminary matter, that arguments that the Lanham Act was preempted by the Copyright Act were without merit).

The Fifth Circuit also considered the issue, stating that the federal Copyright Act does not preempt the Lanham Act, nor does the Lanham Act preempt the Copyright Act. Alameda Films SA de CV v. Authors Rights Restoration Corp., Inc., 331 F.3d 472, 482 (5th Cir. 2003). The Alameda court articulated “it is common practice for copyright owners to sue for both infringement under the 1976 Copyright Act and unfair competition under the Lanham Act.” Id. Suing for both types of infringement has not been disallowed on grounds of preemption or impermissible double recovery. Id.

In sum, the overwhelming case law suggests that if Sherlock possesses a valid trademark, a Copyright Act preemption defense to infringement and unfair competition will likely fail. However, the narrow scope of the Frederick Warne court as it applied to graphical illustrations would be difficult to analogize to Sherlock's characteristic stylistic choices such as his pipe and hat. Sherlock would need to persuade the court that the public would likely be misled as to an association between Sherlock and Watson based on Watson's Sherlock-esque wardrobe.

EXCEPTION

Courts have held that copyright law preempts trademark law in cases of "reverse passing off." Goes Lithography Co. v. Banta Corp. 26 F. Supp.2d 1042, 1047 (N.D. Ill. 1998). Reverse passing off occurs when trademarked goods are either (1) reproduced without the trademark and marketed under the infringer's name or (2) mislabeled to hide a product's origin. Id. at 1046. The Goes court determined that reverse passing off claims merely restate copyright infringement claims. Id. Plaintiffs may not allege unfair competition under the Lanham Act if the plaintiff simply sets forth that the reproduction of a copyrighted work misrepresents ownership of that work and causes confusion as to origin. Id. (See Lipton v. Nature Co., 71 F.3d 464, 473 (2d Cir. 1995)(holding that a false copyright notice alone is insufficient to establish a Lanham Act claim); Shaw v. Lindheim, 919 F.2d 1353, 1364-65 (9th Cir. 1990)(declining to extend the Lanham Act to cases in which the Copyright Act provides an adequate remedy, including claims of reverse passing off for substantially similar products).

This is unlikely a case of reverse passing off, since Mory Arty is not simply taking Sherlock's tangible works and placing the name Mory Arty on the cover (or some other similar

act). If that were the case, then the Copyright Act would likely preempt the unfair competition claim.¹

¹ The Supreme Court limited the meaning of “designation of origin” to producers of tangible goods in Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003). Sherlock cannot sue for false designation of origin under the Lanham Act for Mory Arty’s failure to credit his creative works.