

April 2015

Gotham Skylines: The Intersection of Scènes à Faire and Fictional Facts In Comic Books, Graphic Novels, and their Derivative Works

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Recommended Citation

Gavin M. Strube, *Gotham Skylines: The Intersection of Scènes à Faire and Fictional Facts In Comic Books, Graphic Novels, and their Derivative Works*, 5 *Pace. Intell. Prop. Sports & Ent. L.F.* 54 (2015).

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Gotham Skylines: The Intersection of Scènes à Faire and Fictional Facts In Comic Books, Graphic Novels, and their Derivative Works

Abstract

In just a decade and a half since the modern superhero film exploded onto the scene, the comic books and graphic novels that have long been the very definition of a fringe or niche interest, have morphed into a multi-billion dollar film, television and video game empire. The two main players in this industry, Marvel and DC, are owned by juggernauts in the entertainment industry. More importantly, some of these characters have been around for over three-quarters of a century. Readers keyed into intellectual property law, particularly copyright, should begin to see the issue. The copyright protection on these characters will expire in the coming years, and could potentially open up a wide range of other works based on these venerable and valuable properties. While trademark law may provide some limited protections, there may in fact be another way for these characters to be protected.

There are several exceptions to copyright, but the one most applicable to our case is the prohibition against recognizing copyright protection for “Scènes à Faire.” Succinctly put, the doctrine prohibits copyrighting a scene that is indispensable to conveying basic information about the overall copyrighted work. In other words, using a skyline shot of New York City to convey that a film is set in New York City is not copyrightable on its own, even though the rest of the film is certainly eligible for protection. In a similar manner, facts may not be copyrighted. However, fictional facts may be. For example, the fact that Superman was born on the planet Krypton and sent to Earth as a baby to be raised in Smallville by the Kent family are ‘facts’ of a sort, but as fictional facts they are subject to copyright protection.

The world of comic books is full of hypothetical questions regarding competing forces. Can Thor’s hammer (the irresistible force) destroy Captain America’s shield (the immovable object)? Who is faster, Superman or The Flash?

In this mix we bring a legal conundrum to join the debates that swarm around conventions and online message boards. What happens when fictional facts interact with scènes à faire in the manner that occurs in films based on comic books? Which wins, the protectable nature of fictional facts or the generic scenes that are bereft of protection? In this note I will argue that when fictional facts interact with scènes à faire in comic book movies, the previously unprotected scenes gain copyright protectable status. While this may seem a moot point, it is not. The extensive protections offered by copyright will enable those copyright holders to continue exploiting the vast commercial value of those rights for decades to come.

Keywords

copyright, comics, DC comics, scenes a faire, fictional facts, graphic novels, derivative works

PACE INTELL. PROP. SPORTS & ENT. L.F. VOL. 5, ISS. 1 (2015)
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PACE INTELLECTUAL PROPERTY, SPORTS &
ENTERTAINMENT
LAW FORUM

Volume 5

Spring 2015

Issue 1

Essay

**Gotham Skylines:
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In Comic Books, Graphic Novels, and their Derivative
Works**

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Table of Contents

I. INTRODUCTION	55
II. DESCRIPTION OF THE ISSUE.....	57
A. NARROWING THE FIELD	57
B. WHY IT MATTERS.....	58
III. ALTERNATIVE MEANS OF EXPANDING PROTECTION	59
A. EXTENDED COPYRIGHT TERMS	59
B. TRADEMARK PROTECTION	61
IV. SCÈNES À FAIRE AND FICTIONAL FACTS AS A METHOD OF EXTENDING COPYRIGHT.....	63
A. A BRIEF INTRODUCTION TO SCÈNES À FAIRE AND FICTIONAL FACTS.....	64
B. INTEGRATION OF THE TWO CONCEPTS: PAST COURT DECISIONS AND FUTURE PREDICTIONS	66
C. PITFALLS AND WORKAROUNDS	69
V. CONCLUSION	70

I. INTRODUCTION

The lights of one thousand skyscrapers pierce the pitch-black night sky. A city rises from the sea, crowding an island that is 13.4 miles long and at most 2.3 miles wide. The city stretches out, familiar to most in the entire western world. Locals gaze upon the unmistakable shape of One World Trade Center and feel a sense of completeness, a monument to American spirit and the inability of foes abroad to crush that spirit. It is, to many, the center of the universe, the place where dreams come true, the city that never sleeps. But as soon as the viewer knows this is New York City, they are proven wrong. This is not the New York City known by all and beloved by some. This is a dark reflection of The City as a human cultural touchstone. This City is consumed by some shadow that can never be seen head on. Lives are shorter here, more brutal. Criminals rule the streets while the police are unwilling or unable to serve and protect. This is a city protected not by the watchful members of the New York Police Department, but by the Dark Knight. This is Gotham.

There is a scene in Chris Nolan's film, *The Dark Knight Rises*, where an aerial shot of Gotham shows the island city before the film's antagonist destroys the bridges leading into the city. The aerial shot clearly shows Manhattan; the bridges that are destroyed include the George Washington bridge, among other well-known

thoroughfares. The symbolism can be jarring for some, particularly given New York's relationship with the concept of terrorism. It is a film (and a series) uniquely suited to post-9/11 America, and yet it bears the mantle of the modern myth, the Superhero.

While these heroes protect the innocent, who protects them? Perhaps more importantly (for the owners and studios), who protects the vast profit they are capable of generating? In just a decade and a half since the modern superhero film exploded onto the scene,¹ the comic books and graphic novels that have long been the very definition of a fringe or niche interest, have morphed into a multi-billion dollar film, television and video game empire. The two main players in this industry, Marvel² and DC,³ are owned by juggernauts in the entertainment industry. More importantly, some of these characters have been around for over three-quarters of a century.⁴ Readers keyed into intellectual property law, particularly copyright, should begin to see the issue. The copyright protection on these characters will expire in the coming years, and could potentially open up a wide range of other works based on these venerable and valuable properties. While trademark law may provide some limited protections, there may in fact be another way for these characters to be protected.

There are several exceptions to copyright, but the one most applicable to our case is the prohibition against recognizing copyright protection for "Scènes à Faire." Succinctly put, the doctrine prohibits copyrighting a scene that is indispensable to conveying basic information about the overall copyrighted work. In other words, using a skyline shot of New York City to convey that a film is set in New York City is not copyrightable on its own, even though the rest of the film is certainly eligible for protection. In a similar manner, facts may not be copyrighted. However, fictional facts may be. For example, the fact that Superman was born on the planet Krypton and sent to Earth as a baby to be raised in Smallville by the Kent family are 'facts' of a sort, but as fictional facts they are subject to copyright protection.

The world of comic books is full of hypothetical questions regarding competing forces. Can Thor's hammer (the irresistible force) destroy Captain America's shield (the immovable object)?⁵ Who is faster, Superman or The Flash?⁶

¹ X-MEN (20th Century Fox 2000).

² Marvel is owned by Disney. Ben Fritz, *Disney Tells Details of Marvel Entertainment Acquisition in a Regulatory Filing*, L.A. TIMES (Sept. 23, 2009), <http://articles.latimes.com/2009/sep/23/business/fict-marvel23>.

³ DC is owned by Warner Brothers. *DC Entertainment*, WARNER BROTHERS, <http://www.warnerbros.com/studio/divisions/dc-entertainment> (last accessed May 19, 2015).

⁴ ACTION COMICS 1 (Detective Comics June 1938) (the first appearance of Superman).

⁵ MARVEL'S THE AVENGERS (Marvel Studios 2012) (no, it cannot).

⁶ In this author's mind, the Flash is faster. However, other comic book enthusiasts may think otherwise.

In this mix we bring a legal conundrum to join the debates that swarm around conventions and online message boards. What happens when fictional facts interact with scènes à faire in the manner that occurs in films based on comic books? Which wins, the protectable nature of fictional facts or the generic scenes that are bereft of protection? In this note I will argue that when fictional facts interact with scènes à faire in comic book movies, the previously unprotected scenes gain copyright protectable status. While this may seem a moot point, it is not. The extensive protections offered by copyright will enable those copyright holders to continue exploiting the vast commercial value of those rights for decades to come.

I. DESCRIPTION OF THE ISSUE

A. *Narrowing the Field*

To begin with, we must focus our attention on a single company, DC Comics, Inc. This is important for a number of reasons. To begin with, DC and Marvel Comics are the largest producers of comic books and graphic novels in the world. These two companies together command a significant majority in market share,⁷ and they hold the most valuable 'books of business' in the industry. While the two companies trade places from time to time on the top of the sales charts, they are the undisputed kings of the industry.

The main purpose in focusing on DC over Marvel is twofold. First, Marvel sets their comics (and the films based on them) in primarily real world environments. New York is New York, Chicago is Chicago, and so on. The unique and fictional settings in Marvel comics are indisputably original and have yet to be featured prominently in film. Conversely, DC comics feature entirely fictional cities, from Gotham to Metropolis to Central City, Coast City and Star City.⁸ These cities, when they are depicted in audiovisual works, need either massive (and massively expensive) backlots and soundstages, or stand-ins. Stunt cities, so to speak. Chicago has played the part of both Gotham and Metropolis (as has New York), Los Angeles has even played double to Gotham, and Pittsburgh has newly been crowned Central City.⁹

The final reason we are focusing on DC properties is one of time. DC, descended from Detective Comics, is a truly venerable company in the industry. Two of their most popular and enduring characters first debuted in the late thirties,

⁷ Mat Elfring, *Top Selling Comics & Publisher Market Share: August 2014*, COMIC VINE (Sept. 5, 2014), <http://www.comicvine.com/articles/top-selling-comics-publisher-market-share-august-2/1100-149758/> (as of August, 2014, Marvel and DC together commanded 62.98% of the dollar share and 68.41% of the unit share).

⁸ MICHAEL TEITELBAUM ET. AL. THE DC COMICS ENCYCLOPEDIA, UPDATED AND EXPANDED EDITION (2008).

⁹ *The Flash* (CW television broadcast, 2014-2015).

and while Marvel is descended from a contemporary company, the modern incarnation of Marvel began publishing in 1961 with *The Fantastic Four*. Additionally, many of DC's properties are owned wholly by DC, rather than human authors retaining copyrights. The ownership of copyright in Marvel characters, however, is not clear.¹⁰ For that reason, many Marvel copyrights may not expire for decades after Mr. Lee is deceased, while the clock is most definitely ticking on Superman and Batman.¹¹

B. Why It Matters

At first this issue may appear purely academic. However, that is not the case. While it is true that this will not be a testable issue for nearly twenty years, Warner Brothers has already laid out plans for production and development on movies based on DC properties through 2020. The superhero genre is incredibly lucrative, with comic books and graphic novels alone amassing roughly \$870 million in sales in 2013. That figure pales even more when one views the world-wide box office revenue for *Man of Steel*, the most recent Warner Brothers film based on Superman: over \$660 million. That is only one film; in 2013, theatrically released superhero films grossed over three billion dollars¹². Superhero films have become a genre in and of themselves, and some movies are even referred to as “following the Marvel formula.”¹³ That amount of money can make or break companies, and when they acquired Marvel, Disney discovered the goose that laid a golden egg¹⁴. While Warner Brothers and DC have not emulated the runaway success of Marvel, they have nonetheless seen impressive returns. When that much money is at stake, the property must be protected.

Hypothetically, by 2033, after Warner Brothers has poured millions of dollars into development and production of an extensive franchise of superhero characters

¹⁰ *Stan Lee Media Fights Disney for the Iron Man, Spider-Man and X-Men Copyright in Lawsuit*, INQUISITR (Oct. 29, 2014), <http://www.inquisitr.com/1572737/stan-lee-media-fights-disney-for-the-iron-man-spider-man-and-x-men-copyright-in-lawsuit/>.

¹¹ 17 U.S.C. § 302(c) (2012) (copyright expires 95 years after publication, which is 2033 for *Superman*, and 2034 for *Batman*).

¹² BOX OFFICE MOJO, <http://www.boxofficemojo.com/> (last visited Mar. 20, 2015) (showing earnings for *Iron Man 3*: \$1,215,439,994, *Man of Steel*: \$668,045,518, *The Wolverine*: \$414,828,246, *Kick-Ass 2*: \$59,556,104, *Thor: The Dark World*: \$644,783,140, with a total box office gross revenue of \$3,002,653,002).

¹³ Keith Staskiewicz, *Review of Big Hero 6*, ENTERTAINMENT WEEKLY (Jan. 17, 2015, 5:04 PM), <http://www.ew.com/article/2014/11/14/big-hero-6> (perhaps unsurprising for a Disney film based off of a Marvel property).

¹⁴ BOX OFFICE MOJO, <http://www.boxofficemojo.com/> (last visited Mar. 20, 2015) (even 2014's *Guardians of the Galaxy*, based on an obscure group of misfits and anti-heroes, became a surprise hit with a worldwide gross revenue of over \$770 million).

and team ups, another company could make a Superman film, capitalizing on the investments made by Warner Brothers and diluting the market for future films. While recent individual stories will still be protected by copyright, the only law shielding Superman from exploitation by other companies is the rather flimsy shield of trademark protection.¹⁵ In the event this protection of Superman should elapse, Warner Brothers will surely hire a veritable army of intellectual property attorneys, and I am deeply sorry for my fellow classmates and peers who may be among those attorneys, as it may not be necessary. Warner Brothers can essentially block out competing companies from ever being able to make practical use of their characters in a blockbuster film environment in a very simple way. They can use the fictional facts imposed upon scènes à faire to copyright those scenes. In other words, New York City as Gotham is a copyright owned by Warner Brothers, and that copyright will last until at least the year 2108.¹⁶

It is important to note that when (and if) these copyrights expire, the only copyrights that will expire will be in the initial appearances of the characters. Many portions of the character and storylines of the characters have been introduced over decades, and those adaptations will still be under copyright protection.¹⁷ However, with every year that passes, more and more of that original idea will pass into the public domain.

II. ALTERNATIVE MEANS OF EXPANDING PROTECTION

Before launching into a discussion and analysis of combining scènes à faire with fictional facts to create a copyrightable piece of expression, it behooves us to ensure that this is necessary even in the hypothetical and prospective framework being considered. It is true that there are at least two methods of expanding or maintaining the protections held by owners of comic book characters and settings, but neither provides a perfect solution. Whether the focus is on extending the term of copyright or trademark protections, both possibilities come with their own difficulties and drawbacks.

A. *Extended Copyright Terms*

As long as Mickey Mouse has value, copyrights will never expire. That was a quip by my Copyright Law professor, and all joking aside, it holds a grain of truth.

¹⁵ See *infra* part III(B).

¹⁶ The aforementioned scene of New York appeared in the 2013 film, *The Dark Knight Rises*, the copyright of which will expire in 2108, 95 years later. 17 U.S.C. § 302(c) (2012).

¹⁷ I.e., When Superman first appeared, he was a wildly different character than the “last son of Krypton,” now known to comic book fans. While competitors may be wary of exploiting a character many people may not recognize, it is still essential to protect these original properties regardless of the likelihood of needing such protection.

Disney was certainly one of the forces behind the passage of the Sonny Bono Copyright Term Extension Act (CTEA)¹⁸ and its defense in the courts.¹⁹ While Disney's power and influence are not to be denied,²⁰ AOL Time Warner (owner of DC) specifically filed an amicus brief on behalf of the respondent. The main thrust of the CTEA was to extend copyright protections to a term of life plus seventy years for authors or a flat ninety-five years for works created anonymously, under a pseudonym or as works for hire.²¹ This act also added a flat twenty years to already existing copyrights provided they had been properly extended under the earlier copyright regime.

When the CTEA faced a constitutional attack, a great deal of attention was placed on what exactly was meant or intended by the I.P. clause of the U.S. Constitution.²² Justice Ginsburg, writing for the court, determined that the question was a rather simple one. In other words, although the act did extend the term of copyright, that term would still terminate and it was still a "limited time."²³ It seems likely that as the term of certain valuable copyrights approaches their expiration, there will be another push towards extending the copyright term.²⁴

It is worth noting, however, that this method of continuing copyright protection is a stopgap measure at best. The primary hurdle to pass in order to extend the copyright protection term is the sentiment embodied in Justice Stevens' dissent in *Eldred*.²⁵ Stevens asserts that despite the definition of "limited time," extensions of copyright such as the CTEA will eventually extend copyright protection infinitely, creating a congressional overreach that will surpass the original constitutional provision.²⁶ Similarly, Justice Breyer attacked the congressional motivations behind extending copyright, seeing comments by members of Congress as proof of an intent to eventually bypass the constitutional mandate of limited time altogether.²⁷

¹⁸ Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998).

¹⁹ See generally *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

²⁰ Particularly since Disney now owns Marvel and thus has a vested interest in the continuing expansion of copyright protections as they relate to comic book properties.

²¹ Under the previous version of the Copyright Act, these terms were universally twenty years less. Copyright Act of 1976, 94 Pub. L. 553, 90 Stat. 2541 (1976), amended by Copyright Term Extension Act, 112 Stat. 2827.

²² U.S. CONST. art. 1, § 8, cl. 8 ("[t]o promote the Progress of...useful Arts, by securing for *limited Times* to Authors...the exclusive Right to their respective...." (emphasis added)).

²³ *Eldred*, 537 U.S. at 189.

²⁴ Mickey Mouse's copyright protection is to expire in the near future, creating a copyright issue to be addressed.

²⁵ *Eldred*, 537 U.S. at 222 (Stevens, J., dissenting).

²⁶ *Id.* at 223.

²⁷ *Id.* at 256 (Congress did not intend to act unconstitutionally. But, it may have sought to test the Constitution's limits. After all, the statute was named after a Member of Congress, who, as the

While the dissenting opinions were clearly insufficient to sway the majority of the Court, these bits of dicta are nonetheless important as future copyright extensions are contemplated. Should Congress (as a result of the lobbying of influential copyright owners) extend the term of copyright again, eventually the Court will step in to curtail such extensions. It is unclear if this would happen the next time an extension occurs or multiple extensions in the future, but it is nearly inevitable that the Court will in fact begin enforcing the “limited time” constitutional requirement. Because of the level of Supreme Court prognostication required to guess when this will occur, it would be far more secure for copyright owners to seek alternative means of strengthening their copyrights.

B. Trademark Protection

“All characters, their distinctive likenesses and related elements featured in this publication are trademarks of DC Comics.”²⁸ That should end our inquiry right then and there. If these characters have trademark protection, then the creators and owners of the characters can just rely on that, can’t they? Unfortunately, this is not the case. While trademark protections do have at least one benefit over copyright,²⁹ there are numerous other issues that make trademark law ill-suited to the task at hand. Chief among those issues are that some superhero characters may actually not be eligible for trademark. Trademark protections are generally less robust than those afforded to copyright, and the Supreme Court has ruled that subject matter that should fall under copyright law should not receive the benefits of trademark protection because the laws serve entirely different purposes.

Certain superheroes may lack the hallmark of distinctiveness necessary to fend off serious challenges to trademark validity. Since *Abercrombie & Fitch Co. v. Hunting World*,³⁰ four broad categories of textual marks³¹ have been recognized in trademark law.³² While fanciful or arbitrary marks are afforded a wide presumption of validity, generic and descriptive marks are not. Descriptive marks must demonstrate secondary meaning in order to be valid, and generic marks are presumptively invalid and cannot achieve secondary meaning. The majority of superhero names are arguably quite clearly descriptive marks. A man who dresses

legislative history records show, “wanted the term of copyright protection to last forever.” (citation omitted)).

²⁸ GEOFF JOHNS ET AL., JUSTICE LEAGUE VOLUME 1: ORIGIN 4 (Eddie Berganza et al. eds., 2012).

²⁹ 15 U.S.C.A. § 1059 (2012) (trademarks may be perpetually renewed if statutory requirements are met).

³⁰ *Abercrombie & Fitch Co. v. Hunting World*, 537 F.2d 4 (2d Cir. 1976).

³¹ *Id.* (textual marks are words or phrases that an individual or a company seeks to register as a trademark).

³² *Id.* (the four categories include: fanciful marks (often a word with no independent meaning), arbitrary marks (a word with no inherent connection to the product it will mark), descriptive marks (a word describing a product or a service) and generic marks (a generic word or phrase).

up as a bat is Batman. A man with power of water is Aquaman. A woman with incredible super powers is Wonder Woman.

Luckily for the owners of the marks, it is clear that *substantial* secondary meaning has been achieved. In other words, in the United States, people hear the name Batman and assume that the comic book character is being referenced. Meanwhile, some superheroes begin to toe the line between descriptive and generic marks. Green Lantern, for example, quite literally gains his superpowers from a ring powered by a green lantern. Then you have characters whose names are distressingly close to generic marks. A man who can seemingly do anything and exists as an ideal for the world to aspire to is Superman.³³ A villainous take on a clown who exists as a foil for a dour hero is Joker. If these marks are deemed generic, no amount of secondary meaning can save them. They will be invalidated.³⁴

The ease with which an invalid trademark can be stripped of protection is just a single example of the limitations of trademark protection compared to that of copyright. Copyright offers a full suite of rights and protections, including the ability create additional works drawing upon the same creative work. Trademarks, conversely, exist exclusively in the realm of commerce. Having a trademark in Superman allows Warner Brothers to use the popular “S” shield emblazoned on goods and to prevent other business from doing the same. At best, a trademark infringement suit against another writer or film producer could require the infringer to drop the name or symbol.³⁵

The final problem with relying on trademark protection is that the Supreme Court has decided that trademark protection should not overlap with copyright protection.³⁶

[T]he Lanham Act prohibits actions like trademark infringement that deceive consumers and impair a producer's goodwill...The words of the Lanham Act should not be stretched to cover matters that are typically

³³ There is an interesting argument to be made that Superman is a derivative of Nietzsche's *Übermensch*. See generally FRIEDRICH NIETZSCHE, *THUS SPOKE ZARATHUSTRA* (1896).

³⁴ Gotham, originally coined as a term for New York City by Washington Irving in the nineteenth century, is another example of a generic mark.

³⁵ In the 2014 film, *Man of Steel*, the “S” shield was completely redesigned and the word “Superman” was used only once. A competing film could arguably do the same and avoid trademark liability. Without delving too deeply into comic book minutiae, another important departure from the original material occurred. Superman's emblem is generally portrayed as the symbol of his “house” or family. In *Man of Steel* it is described as an alien symbol for hope. This disassociation from previous copyrighted expression could be done in other films as well, preventing a suit alleging copying of the character as it was developed after the initial copyright.

³⁶ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

of no consequence to purchasers. It could be argued, perhaps, that the reality of purchaser concern is different for what might be called a communicative product—one that is valued not primarily for its physical qualities, such as a hammer, but for the intellectual content that it conveys, such as a book or, as here, a video. The purchaser of a novel is interested not merely, if at all, in the identity of the producer of the physical tome (the publisher), but also, and indeed primarily, in the identity of the creator of the story it conveys (the author). And the author, of course, has at least as much interest in avoiding passing off (or reverse passing off) of his creation as does the publisher. For such a communicative product (the argument goes) “origin of goods” in § 43(a) must be deemed to include not merely the producer of the physical item...*The problem with this argument according special treatment to communicative products is that it causes the Lanham Act to conflict with the law of copyright, which addresses that subject specifically.* The right to copy, and to copy without attribution, once a copyright has expired, like “the right to make [an article whose patent has expired]—including the right to make it in precisely the shape it carried when patented—passes to the public.”³⁷

Justice Scalia, in clear and unambiguous terms, rejected the argument that trademark would be used to create a sort of perpetual protection for intellectual property, something clearly prohibited by the United States Constitution.³⁸

In this case, the subject matter in question was nothing less than a full audiovisual program. It is possible to say that, on more narrow scales, the Supreme Court may allow trademark to succeed as an avenue of protection, but several very important distinctions need to be made. The sheer scale of the financial power behind the superhero genre means that ruling in favor of trademark is, in fact, far more broad than this holding, and will likely be discarded by the court.

III. SCÈNES À FAIRE AND FICTIONAL FACTS AS A METHOD OF EXTENDING COPYRIGHT

Having examined alternative avenues to extending or further strengthening the protection currently afforded the owners of the intellectual property in question, our investigation turns to a more novel approach and the crux of this analysis: utilizing the legal principle that fictional facts can be copyrighted (as opposed to the

³⁷ *Dastar Corp.*, 539 U.S. at 32-33 (emphasis added).

³⁸ *Id.* at 37; U.S. CONST. art. I, § 8, cl. 8 (guaranteeing exclusive rights for limited times).

normal rule that facts are unprotectable) to make scènes à faire copyrightable. To begin, a brief overview of the scènes à faire doctrine (in addition to an overview of fictional facts) is necessary, followed by case law that has come close to integrating the concepts.

While this area of legal theory is currently untested, there are legal principles and case law that can be used to formulate future predictions about the success of this integration. An examination of that law will follow, and this note will attempt to lay out a roadmap that will predict on what side the courts will fall should this integration be utilized in an attempt to extend the existing protections afforded by copyright law.

Finally, even if this integration of scènes à faire and fictional facts is successful, there are pitfalls and workarounds that the owners of the intellectual property must be aware of. The only truly ironclad protection for these valuable properties is an extension of the copyright term. Relying on this integration is theoretically possible, but should not be considered a first line of defense. Some of the more glaring pitfalls will be addressed at the end of this section.

A. A Brief Introduction to Scènes à Faire and Fictional Facts

On the surface, the legal principle of scènes à faire is a simple one.³⁹ Certain scenes or situations are inherently necessary to a form of expression, and thus cannot be copyrighted independently of the work as whole. An example would be the use of skyline shots to show that an audiovisual work is set in a given city.⁴⁰ Other examples of scènes à faire include the “indispensable elements” of a genre or category of creative expression.⁴¹ A still image from *The Dark Knight Rises*, alluded to in the introduction, clearly shows the skyline of lower Manhattan.⁴² Bereft of any other significance, this shot falls squarely within the scènes à faire doctrine when used to denote that some activity is occurring in a large city (such as New York City). The creative aspects of the scene are copyrightable, but the use of such a wide shot to inform the viewers of the location of the action is not.

Scènes à faire have their roots in the traditional copyright principle known as the idea/expression dichotomy. Put succinctly, bare ideas cannot be the subject of copyright, but the expression of those ideas can be.⁴³ These indispensable scenes

³⁹ See generally Leslie A. Kurtz, *Copyright: The Scenes a Faire Doctrine*, 41 FLA. L. REV. 79 (1989) (for a more in-depth overview of the scènes à faire doctrine).

⁴⁰ See, e.g., *Castle* (ABC television broadcast 2009-2015) (an example of a modern television show that uses skyline shots of a given city while being filmed in a city with significantly lower operating costs. *Castle* was filmed in Vancouver while portraying New York City.).

⁴¹ Kurtz, *supra* note 39 at 92-94.

⁴² See *infra* Appendix.

⁴³ See, e.g., *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930).

have become ideas in their own right by virtue of their indispensable nature. The common building blocks of a police procedural or a hospital drama, for example, cannot be copyrighted beyond the particular expression of those building blocks utilized in a given creative work. This principle has found its expression in case law as well. When attempting to assert his copyright over certain historical aspects of a book he had published, A.A. Hoehling was stymied by the Second Circuit's determination that such historical information was not copyrightable, as well as the fact that scenes of Germans singing in a beer hall and theories of sabotage were indispensable from a film about the tragic final flight of the Hindenburg.⁴⁴

As *Hoehling* and other case law demonstrates, the scènes à faire doctrine is tied very closely with the bedrock concept that facts cannot be copyrighted.⁴⁵ A fact such as "the earth orbits the sun, which is a star located in the Milky Way galaxy" cannot be the subject of copyright, because these facts are fully and squarely within the public domain.⁴⁶ In a manner of speaking, scènes à faire and facts are both concepts and ideas that must be expressed in a creative way to create a copyrightable work, and they remain on their own unprotected. The author of a book detailing a new method of accounting, for example, can certainly own the copyright in his expression of this new method. However, the forms and paperwork used to carry out this method of accounting contains nothing but facts and is indispensable to the art expressed in the book.⁴⁷

These clear-cut legal principles tend to gain a murky quality when the subject of fictional facts arise. Ask any avid trivia-night bar goer and "Han Solo's ship is called the *Millenium Falcon*" is most assuredly a true fact. The entire nature of the subject matter is fictional, however, which changes the legal landscape, particularly as it relates to copyright. Copyright in *Star Wars* lies squarely with its creator and assigns.⁴⁸ Therefore, this "fact" is part and parcel of that copyright and defeats the standard legal principle.

Fictional facts are clearly copyrightable, and an unauthorized use of those facts can be the basis of an infringement lawsuit.⁴⁹ When a fan of J.K. Rowling's *Harry Potter* series of books wished to publish an encyclopedia of information from that series, the facts therein were held to be the creative property of the author and whosoever held the copyright. "Although hundreds of pages or thousands of fictional facts may amount to only a fraction of the seven-book series, this quantum

⁴⁴ *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980).

⁴⁵ *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 347 (1991).

⁴⁶ *See Int'l News Serv. v. Associated Press*, 248 U.S. 215, 248-67 (1918) (Brandeis, J., dissenting).

⁴⁷ *Baker v. Selden*, 101 U.S. 99 (1879).

⁴⁸ Parsing out whether Disney or George Lucas owns these copyrights is not the subject of this note, and would require investigating the contracts signed by the parties.

⁴⁹ *Warner Bros. Entm't Inc. v. RDR Books*, 575 F. Supp. 2d 513 (S.D.N.Y. 2008).

of copying is sufficient to support a finding of substantial similarity where the copied expression is entirely the product of the original author's imagination and creation.”⁵⁰

RDR Books relies on a two-part analysis developed from cases such as *Ringgold v. Black Entm't Television, Inc.*,⁵¹ essentially looking at two levels of copying in order to determine copyright infringement. The first level is quantitative copying, which refers to how much of the material was copied. In *Ringgold*, for example, the copyrighted expression in question was a “story quilt,” and the quilt was copied in its entirety.⁵² Similarly, the court determined in *RDR Books* that a significant portion of the Harry Potter Lexicon involved direct quotations and significant paraphrases of Rowling’s novels.⁵³ The second level of analysis is qualitative copying. Qualitative copying is reminiscent of other “overall look and feel” tests in copyright law, and the inquiry is focused on the alleged infringer’s adoption of the copyright holders general creative effort. As an example, the author of the Harry Potter Lexicon relied exclusively on the creative work and fictional facts created by Rowling.⁵⁴

In one easily imagined situation, a film starring the character of Batman could be found to lack the necessary quantitative copying to find infringement. However, any such film would have to rely on fictional facts and thus could be found to have qualitatively copied the creative efforts that came after the initial character creation.

This example clearly demonstrates that ‘facts’ such as: “Batman lives and fights crime in Gotham City” is a copyrightable portion of the creative work owned by Warner Brothers. Just as clearly, Christopher Nolan’s skyline shot of Manhattan is an unprotectable scène à faire. What then, about the integration of these two ideas? Does Manhattan AS Gotham rise to the level of copyrightable expression?

B. Integration of the Two Concepts: Past Court Decisions and Future Predictions

Perhaps due to the prospective nature of this issue, there is little guidance given through case law that is on all fours with the idea of integrating fictional facts with scènes à faire. Instead, a roadmap of what direction courts will likely take must be constructed from the cases that do exist. These cases include an instance of independently protected sculptural works losing that protection in the context of

⁵⁰ *Warner Bros.*, 575 F. Supp. 2d at 535.

⁵¹ *Ringgold v. Black Entm't TV*, 126 F.3d 70 (2d Cir. 1997).

⁵² *Id.* at 72.

⁵³ *RDR Books*, 575 F. Supp. 2d at 535.

⁵⁴ *Id.* at 536.

fictional facts and independent creative portrayals,⁵⁵ cases that narrow the copyright protection extended to poorly developed characters,⁵⁶ and cases that detail what must be added to scènes à faire to make them no longer incapable of obtaining copyright protection.⁵⁷

In *Leicester v. Warner Bros.*,⁵⁸ the individual who designed towers that were eventually depicted in the film, *Batman Forever*, sued, claiming that his copyright in his sculptural work has violated. The Court of Appeals affirmed a lower court determination that the work was instead an architectural work and afforded more limited protection.⁵⁹ While the ruling was based on the limitations of the protections afforded to architectural works rather than the creation of a new legal concept, some dicta in the opinion provides compelling guidance. “The 801 Tower and the two lantern towers and two smoke towers in the streetwall appear briefly as background in a few scenes in the movie. The building is the Gotham City bank where nefarious deeds occur before Batman comes to the rescue.”⁶⁰ While focusing on the particular usage of a single verb is by no means conclusive, the language is still important. The use of the architecture in an independently copyrightable setting alters the very identity of the original architecture. The fictional facts surrounding the attack on the Gotham City bank altered the original real life setting. Now that building is copyrighted AS the Gotham City bank. This was accepted without discussion or comment by the court⁶¹ and lays the groundwork for copyrighting far more than one building.

An illustrative example of this can be seen, once again, in *The Dark Knight Rises*. The JP Morgan building, well known to many a visitor to New York City’s Financial District, is portrayed as the Gotham Stock Exchange in an early act of the film.⁶² While a photograph of the building would not (in and of itself) be protectable by copyright, the film impresses an artificial identity on the building, and with that new identity comes copyright protection.

Next we move to some limitations on copyright, exemplified in *Idema v. Dreamworks*.⁶³ Copyright can only be extended to those portions of an expression that are original, and while there is only a de minimis showing required, that showing is still needed. “Plaintiffs claim that the...character in the film is the

⁵⁵ *Leicester v. Warner Bros.*, 232 F.3d 1212 (9th Cir. 2000).

⁵⁶ *Idema v. Dreamworks*, 162 F. Supp. 2d 1129 (C.D. Cal. 2001), *aff'd in part, dismissed in part*, 90 F. App'x 496 (9th Cir. 2003), *as amended on denial of reh'g* (Mar. 9, 2004).

⁵⁷ *Lexmark Int'l v. Static Control Components* 387 F.3d 522 (6th Cir. 2004).

⁵⁸ *Leicester*, 232 F.3d 1212.

⁵⁹ *Id.* at 1214.

⁶⁰ *Id.* at 1215 (emphasis added).

⁶¹ *Leicester*, 232 F.3d at 1215.

⁶² *See infra* Appendix.

⁶³ *Idema*, 162 F. Supp. 2d 1129.

substantial equivalent of the...character described only in a one-paragraph character summary at the conclusion [of the book]...However, a couple of sentences of vague description are clearly not enough to create a protectable character under copyright.”⁶⁴ This core concept underlying copyright law would extend to any attempt to copyright generic scenes modified by fictional facts. While this potentially gives rise to some pitfalls or weaknesses in attempting this sort of protection,⁶⁵ the “character” of the cities represented in DC/Warner Brothers properties has been established and developed over decades.⁶⁶

Scènes à faire are not permanently consigned to the land of non-copyrightable material. It is possible to add additional creative elements to something previously deemed to be a generic scènes à faire and create a new, copyrightable whole. While *Lexmark International* does not focus on fictional facts, the case nonetheless describes the level of effort required to elevate previously non-copyrightable material to the sphere of copyrightable expression. The protected work at issue here was a computer program, which is subject to the “abstraction-filtration-comparison test”⁶⁷ and requires a level of dissection in order to determine the actual copyright-eligible aspects of a work. “In trying to discern whether these doctrines apply, courts tend to ‘focus on whether the idea is capable of various modes of expression.’...The question, however, is not whether any alternatives theoretically exist; it is whether other options practically exist under the circumstances.”⁶⁸

Whether it is a choice made in computer code or the development of a story, choice itself is often enough to meet the de minimis standard explained in *Feist*.⁶⁹ Once that standard is met, the subject in question is no longer subject to the scènes à faire doctrine or the merger doctrine, emerging as its own copyrightable expression. It does seem obvious that courts will require a little more of a showing to lock down a portrayal of an iconic city rather than the code used to control toner cartridges. Furthermore, *Lexmark* deals exclusively with the non-utilitarian programming choices that should be exhibited when seeking copyright protection over a computer program and does not speak directly to using fictional facts to do the same thing. However, fictional facts combined with the non-utilitarian choice of a real life city can potentially be used as a functional equivalent.

⁶⁴ *Idema*, 162 F. Supp. 2d at 1186.

⁶⁵ See *infra* part III(C).

⁶⁶ While examples abound in each fictional city used, the most telling is the dichotomy between Gotham and Metropolis. These settings are both intended to represent “the city” as an ideal and as a character. Gotham represents the dark aspects of the city while Metropolis takes on the glorified positive aspects. This “black and white” portrayal, common in comic books, serves to characterize the cities in a far more developed manner than the character at issue in *Idema*.

⁶⁷ See *Computer Associates Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992).

⁶⁸ *Lexmark*, 387 F.3d at 536 (citations omitted).

⁶⁹ *Id.*

When analyzing the various rules outlined above, a new rule can be synthesized. If there is an artistic or creative choice at play in the selection of the scene to be used, and if that choice incorporates creative aspects that are in themselves copyrightable and surpass the bar set by *Idema*, then the supposed scène à faire is no longer a scène à faire. Applying that rule to the facts of comic book films, we would first look to the choices of the film-makers. In his Dark Knight Trilogy, Christopher Nolan clearly made choices that were purely creative. He did not need to use New York as his backdrop. In fact, in earlier films Chicago was the ‘body double’ for Gotham City. He did not need to use one city or the other (or in fact any real city at all, a computer generated or artistic rendering of Gotham worked sufficiently for Burton and Schumaker). The second step of the analysis is to examine the ‘character’ at issue; Gotham City. Throughout decades of interpretation and development, the character of Gotham City has clearly developed beyond “a couple of sentences” as in *Idema*.⁷⁰

The result is an independently copyrightable scene. The true power of this rule, however, is seen when another film-maker attempts to create a Batman film. Chicago has been used as Gotham, as has New York City.⁷¹ Any attempt to portray Gotham using those cities would infringe on the independently copyrightable expression articulated by Christopher Nolan and owned by Warner Brothers. The use of just a few more suitable cities in this manner would result in forcing competing film-makers into a choice between limited and unenviable alternatives; use a less iconic city and thus lose the force of that association, adopt a perhaps far more costly plan of utilizing digital effects to create a city from scratch, or abandon the project altogether.

C. Pitfalls and Workarounds

It is critically important to note that this solution is far from perfect. Setting aside the possibility that a court may be unwilling to adopt this interpretation of integrating scènes à faire with fictional facts, flaws and workarounds (by which a clever film-maker could defeat this concept) still exist.

First and perhaps most importantly, even if courts allow scènes à faire to be modified into copyrightable expression in this way, there are still avenues open to exploit these characters by inventive competitors. Novels, animated films, even potentially video games are potential areas of exploitation. While they have not proven to be nearly as lucrative as the live action films have been, they will remain completely untouched by this method of extending copyright protections.

⁷⁰ *Idema*, 162 F. Supp. 2d at 1186.

⁷¹ BATMAN BEGINS (Warner Brothers Entertainment 2005) (Chicago as Gotham); THE DARK KNIGHT RISES (Warner Brothers Entertainment 2012) (New York as Gotham).

Perhaps more worrisome is the fact that films based on comic books are becoming as much a genre as westerns or noir films.⁷² Scènes à faire are linked to specific types of expression or genres as a matter of definition, and portions of creative works deemed indispensable to one genre will not be scènes à faire in others. As the “superhero” genre becomes more established and recognized as its own category of expression, it will develop its own specific scènes à faire, which may very well include the type of city “stand-ins” described in this note.

Adding to this concern is the likelihood that aggressive use of this method will push these copyrighted scenes right back into the territory of unprotected scènes à faire. Even if the integration concept is legally accepted, implementing it too often and cornering the market on any conceivable city used in this manner will result in the same effect that occurred in *Lexmark*: the application of the scènes à faire and merger doctrines will strip these scenes of their copyright and open up these properties to the very exploitation that the owners sought to prevent.

IV. CONCLUSION

Utilizing fictional facts to transform unprotected scènes à faire into expression protected by copyright has the very real potential to extend copyright protection over comic book characters as it relates to film depictions of them. Because this would be a novel extension of copyright concepts and doctrines, the success of this theory is far from certain. While past cases give insight into the arguments that may succeed, it is not a method that should be relied on exclusively.

Should it be adopted – or even attempted – the most important thing to remember is that this does not constitute bulletproof protection of valuable intellectual properties. When combined with trademark arguments and the potential for extending copyright terms again, it provides an additional avenue to seek further protection, but it will not likely stand on its own.

Perhaps most importantly, this author takes no stance on the wisdom of attempting or relying on this approach. The purpose of this note is to explore the possibilities in seeking further protection on an industry that has evolved from selling five cent comic books to bringing in billions of dollars in revenue on an annual basis. Comic books have evolved from being a niche interest to a true commercial juggernaut, and those who own these properties will need every tool at their disposal to attempt to protect them.

⁷² Mark Hughes, *Why Marvel is Defining the Modern Superhero Film Genre*, FORBES (Oct. 29, 2013, 8:00 AM), <http://www.forbes.com/sites/markhughes/2013/10/29/why-marvel-is-defining-the-modern-superhero-film-genre/>.

PACE INTELL. PROP. SPORTS & ENT. L.F. VOL. 5, ISS. 1 (2015)
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Appendix



Preceding still image is referred to *supra* part IV(A).



Preceding still image is referred to *supra* part IV(B).

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