

## *Branding Culture: Fictional Characters and Undead Celebrities in an Era of “Transpropriated” Media*

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**ABSTRACT (EN):** This chapter explores changes in intellectual property law as part of a changing media ecology that began during the 1970s in which IP law is a medium of control in the digital age. It will be shown that the extension of copyright, trademark, and rights of publicity to fictional characters and authors helps set the boundaries of economic and social expression in the global media environment of the twenty-first century in a process defined by the author as transpropriation, whereby different types of IP protection overlap.

The mechanism or communicative practice associated with this new ecology of information is branding, which is evolving from a technique of marketing to an informal medium of control alongside these changes in the law.

**RÉSUMÉ (FR):** Ce chapitre explore les changements du droit de la propriété intellectuelle en tant qu'écologie changeante des médias, débutant dans les années 1970 au cours desquelles le droit de la propriété intellectuelle devient un moyen de contrôle dans l'ère numérique. Il sera démontré que l'expansion du droit d'auteur, des marques de commerce et des droits de publicité sur les personnages fictifs et les auteurs aide à créer les limites de l'expression économique et sociale dans l'environnement médiatique mondial du 21<sup>e</sup> siècle dans un processus défini par l'auteur comme « la transpropriation », qui se produit lorsque différents types de propriété intellectuelle se chevauchent.

Le mécanisme ou la pratique communicative associée avec cette nouvelle écologie de l'information est la création de l'image de marque, qui s'est développée à partir d'une technique de marketing jusqu'à devenir un moyen informel de contrôle en parallèle aux changements du droit.

## A. INTRODUCTION

On 28 October 2009, a public reading of a unique literary collaboration was staged at Toronto's Bathurst Street Theatre.<sup>1</sup> Expatriate Canadian Dacre Stoker and American screenwriter Ian Holt took elements from Stoker's great-uncle Bram Stoker's unpublished notes to his 1897 novel *Dracula* and wrote an *official sequel* entitled *Dracula the Un-dead*.<sup>2</sup>

The publication of *Dracula the Un-dead* and its public performance by the authors and various actors in period costumes is of particular interest to both media and intellectual property (IP) scholars because the sequel was written, in part, "to right the wrongs done to Bram's original classic."<sup>3</sup> To answer the question of what wrongs had been committed, the authors apologize to their literary audience for "losing the copyright and control of Bram's magnificent and immortal story for almost a century."<sup>4</sup>

While it may seem counterintuitive to hear a writer reclaiming ownership of copyrighted and, indeed un-copyrightable material, Stoker's use of the language of ownership and control in describing both his own and his ancestor's work is consistent with what might be described as the contemporary ecology of IP.

There is a deeply ingrained tendency to talk about various forms of expression as property, to think of the free market as a natural environment, and to think of many, perhaps all, forms of human interaction as fungible and translatable to economic relations. But, we must ask, in what ways is our understanding of IP historically contingent and how is that understanding related to social, economic, and technological conditions in the creative industries?

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1 "Dracula the Un-Dead — A Dramatic Reading w/ Original Music Premieres in Toronto" *MODA Entertainment* (28 October 2009), online: <http://modaentertainment.blogspot.ca/2009/10/dracula-un-dead-dramatic-reading-w.html>; see also *Dracula the Un-dead: The Official Site for the Sequel to the Original Classic*, online: [www.draculatheun-dead.com/Dracula\\_the\\_Un-Dead/Home.html](http://www.draculatheun-dead.com/Dracula_the_Un-Dead/Home.html).

2 Dacre Stoker & Ian Holt, *Dracula the Un-dead* (Toronto: Viking Canada, 2009).

3 *Ibid* at 413.

4 *Ibid*.

In what follows, I argue that as changes in the technologies of communication mediate, shape, or determine the nature of human interaction, IP law can be understood as a technology or technique of mediation between creative expression and the propertization of information. I suggest that the extension of copyright, trademark, and rights of publicity to fictional characters and authors helps set the boundaries of economic and social expression in the global media environment of the twenty-first century in a process of transpropertization whereby different forms of IP protection overlap. Transproperty claims are made and maintained in this mediated environment, in part using a specialized form of communicative activity—branding.

## B. MEDIA ECOLOGY AND TRANSPROPERTIZATION

Media ecology is an approach to the study of communication that focuses on the social and psychological effects of new communication technologies. From this perspective, each communication technology (or medium) has the potential to influence the relationship between technology, representations, and society.<sup>5</sup> For media ecologists, the dominant technology of communication in a society functions as a transformative agent. Indeed, it is common in histories of communication to partition history into periods governed, respectively, by oral tradition, print media, electronic media, and digital technology. The media ecological perspective, also known as *medium theory*, traces its origins to Canadian geographer and economist Harold Adams Innis, and was later popularized by Marshall McLuhan.

Innis wrote that different societies were shaped to a large extent by the particular space-binding or time-binding nature of their dominant medium of communication. Space-binding technologies, such as papyrus, parchment, and paper, helped create empires that needed to exert control over great expanses, while time-binding media, such as stone and clay, were dominant in traditional societies whose control extended not over territory but through time.

Electronic media have changed the media ecology dramatically. Technological tools extend human activity, and shape and control the scale

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5 See Harold Innis, *The Bias of Communication* (Toronto: University of Toronto Press, 1951) and Marshall McLuhan, *Understanding Media: The Extension of Man* (New York: McGraw-Hill, 1964). Other writers associated with media ecology are Walter Ong, Edmond Carpenter, James Carey, Neil Postman, and Mark Poster.

of human association and action. McLuhan argued that as the world was wired into a planetary-wide information grid, it also contracted, becoming a global village. Yet, while McLuhan identified electronic communication with an oral tradition of dialogue and dialectic, traditional values, and philosophical speculation, Innis recognized that the speed and distance covered by electronic communication would likely enhance the process of centralization and imperialistic power, rather than fulfill McLuhan's hope of a new tribal society. Innis also recognized the strong connection between media industries and markets. For Innis, the commercialization of communication created "new oligopolies of knowledge as corporate media acquired increased power to manipulate and direct public opinion."<sup>6</sup>

Political scientist Ronald Diebert adopts a media ecological approach in his analysis of the influence of global communications on international politics. For Diebert, media ecology provides "an open-ended, nonreductionist, thoroughly historicist view of human existence that emphasizes contingency over continuity both in terms of the trajectory of social evolution and the nature and character of human beings."<sup>7</sup>

In the cultural sphere, Henry Jenkins<sup>8</sup> explores how storytelling across different media platforms is emerging as a dominant characteristic of the digital, global entertainment industries. Jenkins describes how media characters appear in film, television, publishing, and promotional outlets as components of an expanded fictional universe. Jenkins calls such cross-platformed cultural properties *transmedia*. He also explores the role of fan communities in supporting media franchises and shaping the meaning of media texts. Optimistically, Jenkins claims that new digital media help create a participatory culture.<sup>9</sup>

Elsewhere, I have argued that the metaphors we use to describe technology, processes of communication, and our sense of communal and per-

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6 Stephen Kline, Nick Dyer-Witherford, & Greig de Peuter, *Digital Play: The Interaction of Technology, Culture, and Marketing* (Montreal: McGill-Queen's University Press, 2003) at 32.

7 Ronald J Deibert, *Parchment, Printing, and Hypermedia: Communication in World Order Transformation* (New York: Columbia University Press, 1997) at 17–18.

8 Henry Jenkins, *Convergence Culture: Where Old and New Media Collide* (New York: New York University Press, 2006) at ch 3.

9 *Ibid* at 3; Lawrence Lessig also discerns the possibility of a participatory RW (read-write) culture emerging in contrast to the R/O (read only) culture dominated by the advocates of the current copyright regime: see Lawrence Lessig, *Remix: Making Art and Commerce Thrive in the Hybrid Economy* (New York: Penguin Press, 2008) at 28 [Lessig, *Remix*].

sonal identity serve as tools that set boundaries for possible interactions.<sup>10</sup> The terms *media* and *mediation* in this sense refer to various technologies and techniques of formalization; media contain or embody the normative social rules that bound the horizon of human interaction<sup>11</sup> and involve various sets of power relations. If we think for a moment of the past 125 years of mass media-created content as the resource pool from which contemporary cultural texts, images, and artifacts are created, we can see the transformation of that cultural pool into an enclosed, privatized space defined and regulated by IP laws and practices that limit our use and, more importantly from my perspective, our understanding of cultural properties.

Following Diebert's analysis of the historically contingent nature of the media landscape, and the use of language and metaphor as a medium of social construction, I will explore an ecological shift in IP law that began at the same time as a shift in the communication mediascape in which elements of fictional properties and their owners are governed by a net of legal protection including copyright, trademark, and the common law right of publicity.<sup>12</sup> Just as Jenkins argues that transmedia cultural texts make no sense unless we examine them across each of the media platforms they occupy, I suggest that in the contemporary communication context it makes sense to see cultural properties as *transpropertied*, where the multi-faceted

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10 Daniel M Downes, *Interactive Realism: The Poetics of Cyberspace* (Montreal: McGill-Queens University Press, 2005); see also Jonathan Zittrain, *The Future of the Internet and How to Stop It* (New Haven: Yale University Press, 2008) and Lawrence Lessig, *Code and Other Laws of Cyberspace* (New York: Basic Books, 1999) for similar discussions of the ways that Internet architecture and computer software "regulate" and mediate human interactions.

11 Other researchers have focused on particular media as the agents of change, and on a broad understanding of "media." From Parsons and Habermas comes the debate over money as a medium of human interaction. Sociologists look at power as a mediating force and, in his insightful discussion of the transformation of the public sphere by the institutionalization of "professional communications" practiced by public relations firms and political spin doctors, Leon Mayhew posits a notion of influence as a concept that mediates human interactions: see Talcott Parsons, "On the Concept of Influence" in Talcott Parsons, ed, *Sociological Theory and Modern Society* (New York: Free Press, 1967); see also Jurgen Habermas, *The Theory of Communicative Action. Lifeworld and System: A Critique of Functionalist Reason*, translated by Thomas McCarthy, vol 2, 3d ed (Boston: Beacon Press, 1985) at 178–85 and Leon H Mayhew, *The New Public: Professional Communication and the Means of Social Influence* (Cambridge: Cambridge University Press, 1997). The common thread in these writers is the understanding that language, technology, and communicative practices shape and limit our actions with regards to the social construction of reality.

12 As my concern is with expression in the creative economy, I will not include a discussion of patent laws here.

character of such intellectual artifacts requires the interaction and protection of formerly distinct forms of IP protection.

### C. CHANGING ORGANIZATION OF THE MEDIA INDUSTRIES

Critical media ecology demonstrates that changes to the mediated environment happen over time and in relation to changes in other aspects of social, economic, and political life. While many argue that dramatic changes to the creative economy and the media environment occurred in the last decade of the twentieth century, it can be shown that change was underway as early as the 1970s. It was during this period that IP legislation and caselaw showed a shift in the nature and language of IP protection.

Political economist Ronald Bettig describes how in the United States “there has always been a tension between the monopolistic character of intellectual property and its normative goal of enhancing the flow of information and ideas.”<sup>13</sup> Indeed, the United States began as a pirate nation, promoting various versions of the free flow of information, and the democratic importance of education, until the second half of the twentieth century when culture came to be seen as exportable and the foundation of an intangible, information economy.<sup>14</sup> Bettig argues that to eliminate competition and to reduce risks associated with the unpredictable nature of media success, companies in the media sector seek “to increase their control over production, distribution, and sales within their market sector, and to increase their economic and political power”<sup>15</sup> in the following ways: through horizontal mergers — characteristic of turn-of-the-twentieth-century mergers; through vertical integration — dominant in the 1920s and 1930s and best demonstrated by the Hollywood studio system and the concentration of film under the control of a few major studios; through conglomeration between the end of World War II and the mid-1970s during which period companies diversified holdings to stabilize incomes without worrying about in-

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13 Ronald V Bettig, *Copyrighting Culture: The Political Economy of Intellectual Property* (Boulder: Westview Press, 1996) at 7–8.

14 See James Boyle, *The Public Domain: Enclosing the Commons of the Mind* (New Haven: Yale University Press, 2008); see also Lewis Hyde, *Common as Air: Revolution, Art, and Ownership* (New York: Farrar, Straus, & Giroux, 2010) on the transformation of copyright from the late eighteenth century to the present.

15 Bettig, above note 13 at 37.

dustry-specific business cycles; and, finally, through cross ownership after the 1970s with a focus on core businesses and related lines.<sup>16</sup>

This last type of industrial organization begins to blur the distinctions between different media and characterizes them all as communications or information industries. To Bettig's periodization we could add a fifth. Since the 1990s global media industries have emerged — first in synergistic conglomeration, then later in a reshuffling in response to technological developments and global economic shocks.

The technological convergence of various forms of media content through digitization is linked to economic globalization in the cultural industries as well as a shift in regulations affecting those industries, including IP laws. Thus, the conditions interacting in a transmediated environment of propertied information were being developed in the 1970s — twenty years before the existence of the commercialized Internet, digital downloading, and the *Digital Millennium Copyright Act*.<sup>17</sup> IP has been a blind spot in writing about the effects of convergence on the media industries.

#### **D. CHANGING METAPHORS IN INTELLECTUAL PROPERTY**

Since the 1970s both policy discussions and copyright cases have used the language of property. Before transformations to IP came to a sort of confluence during that decade, a number of similar ideas about the relationship between creators and the public can be discerned. For Litman, copyright was a bargain between the creator and the public; for Boyle, copyright was a limited monopoly granted in exchange for access to the intellectual or cultural commons; for Hyde, intellectual property actually took the form of a cultural commons (rather than the view that the commons was that which remained after propertization) that allowed for stunted property rights.<sup>18</sup> Each of these views of cultural material was transformed by the practices of the entertainment industries in the twentieth century and by the rise of the information economy which can be categorized by the following conditions: work-for-hire; and the propertization of culture and information and

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16 *Ibid.*

17 *Digital Millennium Copyright Act*, Pub L No 105-304, 112 Stat 2860 (1998).

18 Jessica Litman, *Digital Copyright* (Amherst, NY: Prometheus Books, 2001) [Litman, *Digital Copyright*]; see also Boyle, above note 14; Hyde, above note 14.

the resulting net of overlapping IP protection, which has been applied to cultural and other forms of expression as though they were fungible.

For Hyde, the transformation in IP since the seventies is the result of three factors. First, the rise of a knowledge economy means that it matters for a variety of companies that they be able to control their know-how and their goods: “it matters that the law help them guard the rights that ownership is supposed to bring, especially the exclusive right to charge fees for access.”<sup>19</sup> Second, “[i]n the 1990s, digital copying and the global Internet appeared almost simultaneously, and all of a sudden many of the useful old fences simply disintegrated.”<sup>20</sup> Finally, following the fall of the Soviet Union as an oppositional force to free market capitalism,

the West entered a period of unabashed market triumphalism, during which many things long assumed to be public or common — from weather forecasting to drinking water, from academic science to the “idea” of a crustless peanut butter and jelly sandwich — were removed from the public sphere and made subject to the exclusive rights of private ownership.<sup>21</sup>

For Bettig, IP became a strategic asset in the information economy. For the entertainment industries, copyright laws, in particular rights of copy, distribution, and performance, permit the transfer of ownership claims in information and cultural goods.<sup>22</sup> Increasingly in the entertainment industries it is the transfer of such claims that monetizes IP.

The contemporary media sector is made up of content producers, distributors, and companies that deal in the purchase and exchange of copyrights and trademarks for films, television programs, sound recordings, and books. Kembrew McLeod calls this new commodity cultural software.<sup>23</sup> I refer to this new revenue stream as the cultural industries’ *back catalogue*, a term derived from the recording industry that refers to the previously released stock of recordings owned or controlled by the major record labels. Control of cultural software is tied to consolidation of media ownership as large, globally-situated firms have the resources to purchase and trade the back catalogues of other companies.

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19 Hyde above note 14 at 10.

20 *Ibid.*

21 *Ibid.* at 12.

22 Bettig, above note 13 at 81.

23 Kembrew McLeod, *Owning Culture: Authorship, Ownership, and Intellectual Property Law* (New York: Peter Lang, 2001) at 2.



By the mid-1990s, IP generated close to \$240 billion USD, over 20 percent of world trade.<sup>24</sup> Since our concern here is with the fictional characters that make up a substantial portion of the cultural resource pool, some comic-book-related figures are instructive. By the late 1970s, Marvel generated most of its business through the licensing of Marvel characters for merchandise. Of the \$800 million the movie *Spider-Man* generated, Marvel received more than \$50 million. Similarly, DC Comics generated several billion dollars in income related to Superman between 1969 and 1984.<sup>25</sup> Comic-book-based superhero films are well represented in the top grossing films of all time. Of the top twenty films, Marvel's *Avengers* (2012) ranks third while *Spider-Man* (2002) and *Spider-Man 2* (2004) rank thirteenth and eighteenth. DC Comics's property Batman appears in the *Dark Knight* (2008) at fourth and the *Dark Knight Rises* (2012) at eighth.<sup>26</sup>

The copyright system allows copyright holders to take legal action against unauthorized users of their works (traditionally companies that made unauthorized or unlicensed copies of books, sound recordings, or films for commercial distribution); to transfer rights to other parties; and to recycle their existing stock of properties in derivative works in new mediated forms as a source of royalties. These activities allow copyright owners to recover the costs of initial production, to generate revenue over time, and to monetize in new and innovative ways those works they control. The assumption that copyright is necessary to the smooth functioning of the media has a long history in the US entertainment industries.<sup>27</sup>

## E. COPYRIGHT

Litman suggests that in the late seventies advocates of copyright owners “began to come up with different descriptions of the nature of copyright, with an eye to enabling copyright owners to capture a greater share of the

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24 *Ibid* at 6; see Jeremy Rifkin, *The Age of Access: The New Culture of Hypercapitalism: Where All of Life is a Paid-For Experience* (New York: Putnam, 2000) at 8. Jeremy Rifkin notes that by the end of the 1990s cultural production in the world was beginning to eclipse physical production in commerce and trade.

25 Britton Payne, “Super Grokster: Untangling Secondary Liability, Comic Book Heroes and the DMCA, and a Filtering Solution for Infringing Digital Creations” (2006) 16:3 *Fordham Intell Prop Media & Ent LJ* 939 at 944, n 20.

26 IMDB, “All-Time Box Office: USA,” online: IMDB [www.imdb.com/boxoffice/alltimegross](http://www.imdb.com/boxoffice/alltimegross).

27 Litman, *Digital Copyright*, above note 18 at 23–25.

value embodied in copyright-protected works.”<sup>28</sup> She argues that the shift in metaphors for copyright protection, from the bargained limited monopoly granted to creators to a model of incentives without which the creator will withhold their work, led, ultimately, to a transformation of copyright “into the right of a property owner to protect what is rightfully hers.”<sup>29</sup> According to Litman, “by changing metaphors, we somehow got snookered into believing that copyright had always been intended to offer content owners extensive control, only, before now, we didn’t have the means to enforce it.”<sup>30</sup>

In addition to a shift in the way stakeholders characterize copyright, two new ideas that proved fundamental to the current global IP landscape emerged from changes in the 1976 US revision of copyright. First, the fundamental unit of copyright became the ephemeral copy of information in RAM. An unforeseen consequence of this seemingly minor provision of the statute has come to mean that all computer-mediated communication must conform to copyright rules.<sup>31</sup> Further, the 1976 revision eliminated the registration requirement, meaning that since that date *no new* creations have entered the public domain. According to Hyde, this means that every creative work comes with a presumptive right to exclude. He argues that it is impossible for a work *not* to be thought of as property: “[T]here is no statutory provision whereby a work can be given to the public domain . . . . [T]he law includes a ‘termination of transfer’ provision whereby rights revert to the creator after a certain number of years no matter what licenses or contracts have been signed.”<sup>32</sup>

These two changes to copyright at the dawn of the information economy create what Hyde calls the *second enclosure* wherein “the law grants nearly perpetual private rights to nearly every creative expression appearing in any media now known or yet to be discovered!”<sup>33</sup>

Technology changes the copyright landscape: previously, copyright focused on the relationship between creators of works of authorship and disseminators of them. Computers and the Internet make each computer a potential publisher — copyright must be enforceable to all or it becomes obsolete. It makes sense for copyright holders to argue that unlicensed, pri-

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28 *Ibid* at 79.

29 *Ibid* at 81.

30 *Ibid* at 86.

31 *Ibid* at 28.

32 Hyde, above note 14 at 58.

33 *Ibid* at 59.

vate copying is piracy because all activities in the digital age of technological, economic, and regulatory convergence can be seen as *commercial* activities that fall under the umbrella of the expanding IP regime.

Writers like McLeod and Lessig argue that IP law misunderstands the nature of creative activity<sup>34</sup> (a position I also take), but it is clear that copyright, trademark, and publicity rights are being used in a coherent way in the United States in cases that posit creative work and celebrities as propertized. Let us turn to the two other prongs of cultural propertization: trademark and publicity rights.

## F. TRADEMARK

Trademark is a very different kind of instrument than copyright because there is no “bargain” between the creator and society. Copyright, in the American context, is based in the US Constitution,<sup>35</sup> whereas trademark comes from the regulation of commercial activity first codified in the US *Commerce Act*.<sup>36</sup> The trademark is a sign of ownership and the intent to sell and is outlined in the *Lanham Act*.<sup>37</sup> In particular, Section 43(a) of the *Lanham Act* creates a civil cause of action against any person who identifies his product in a way that is likely to cause consumer confusion regarding the product.<sup>38</sup>

The basis of trademark infringement is that someone else’s use of a particular trademark can confuse consumers, thereby directing profits away from the trademark owner and, potentially, diffusing the impact of the trademark itself. By the 1980s trademark cases under the *Lanham Act* were launched to protect fictional characters, which traditionally fell outside the bounds of copyright law.<sup>39</sup> Unlike copyright, trademarks are valid as long as

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34 McLeod, above note 23; see also Lessig, *Remix*, above note 9.

35 US Const art I, § 8, cl 8.

36 *Act of 4 February 1887*, Pub L No 49-41, c 104, 24 Stat 379 (*Interstate Commerce Act*).

37 *Lanham (Trade-Mark) Act of 1946*, c 540, 60 Stat 427 (codified as amended in 15 USC ch 22) [*Lanham Act*].

38 *Ibid*, s 1125 (a); see also Stephanie Dotson Zimdahl, “A Celebrity Balancing Act: An Analysis of Trademark Protection Under the Lanham Act and the First Amendment Artistic Expression Defense” (2005) 99:4 Nw UL Rev 1817 at 1823.

39 See Lawrence L Davidow, “Copyright Protection for Fictional Characters: A Trademark-Based Approach to Replace *Nichols*” (1984) 8:4 Colum VLA Art & L 513, for an early attempt to show that a trademark theory of character protection might be more suitable than copyright in dealing with fictional characters.

they remain in use, strengthening the sense that trademarks are the property of their owners.

## G. PUBLICITY RIGHTS

The right of publicity has its roots in the right of privacy, articulated by Samuel Warren and Louis Brandeis.<sup>40</sup> As originally conceived, the right of privacy was intended to protect private individuals from intrusion into their lives by the press. Writing seventy years later, William Prosser identified four distinct torts included within the right of privacy: (1) intrusion upon the plaintiff's seclusion; (2) public disclosure of embarrassing private facts; (3) publicity which places the plaintiff in a false light in the public eye; and (4) appropriation of the plaintiff's name or likeness.<sup>41</sup> What has become known as the right of publicity evolved from Prosser's fourth category. Prosser recognized that right of publicity cases generally involved the wrongful or unauthorized use of a celebrity's likeness or name. The focus of the right of publicity is on protecting the celebrity's identity from economic exploitation and providing an incentive for creativity and achievement. "This has led some commentators to observe that a *Lanham Act* claim for false endorsement is practically the federal equivalent of the state protected right of publicity."<sup>42</sup>

Over time, a number of states enacted right of publicity legislation. In some, led by Indiana and Tennessee and a case initiated by the estate of Elvis Presley, a celebrity's publicity rights extend after the death of the celebrity and are "descendible"; that is, they can be exploited by heirs or, as in the case of Presley, companies who purchase those rights.<sup>43</sup>

## H. TRANSPROPERTIED FICTIONAL CHARACTERS

Historically, it was very difficult to obtain IP protection for fictional characters. The test was generally based on the distinctiveness of the characters, and generally the answer was negative. Courts ruled that there was no copyright protection for characters like Sam Spade unless it could be shown that

40 Samuel D Warren & Louis D Brandeis, "The Right to Privacy" (1890) 4:5 Harv L Rev 193.

41 William L Prosser, "Privacy" (1960) 48:3 Cal L Rev 383.

42 Zimdahl, above note 38 at 1825 [footnote omitted].

43 Mark Bartholemew, "A Right is Born: Celebrity, Property, and Postmodern Lawmaking" (2011) 44:2 Conn L Rev 301 at 315-17.

the stories were about the characters to the extent that that the character constituted the story. However, as commentator Leslie Kurtz points out, an author may be free to use his or her characters in new stories (which was the issue between author Dashiell Hammett and Warner Brothers in the *Sam Spade* case), but so is everyone else.<sup>44</sup>

Things changed in the 1970s. Following a DC Comics case,<sup>45</sup> trademark started to be applied to these fictional characters; names, nicknames, physical appearances, and costumes of the superheroes could now be trademarked. For example, George Lucas was able to trademark the Darth Vader, R2D2, and C3PO characters. A new kind of convergence occurred where courts viewed copyright, trademark, and unfair competition claims as though they were coequal and necessarily interrelated.<sup>46</sup> According to Helfand:

Courts have replaced the great uncertainty previously facing character owners with an equally problematic, overly protective doctrine for fictional characters. The distinctions between, and goals of, intellectual property laws that have existed in other contexts have become nonexistent when applied to fictional characters. As a result, the role of public domain doctrine is uncertain.<sup>47</sup>

With greater protection possible for fictional characters, a shift has occurred in the nature of characters considered for protection. Copyright law affords protection for the “expression” of a graphic character. This expression may refer to its appearance or the “pattern” that identifies it. With literary characters the inquiry ordinarily focuses on whether a character is sufficiently distinctive or well-developed to command protection, and whether such distinctive development has been copied.<sup>48</sup> With visual characters, on the other hand, like animated cartoons or comic book heroes, copyright

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44 Leslie A Kurtz, “The Methuselah Factor: When Characters Outlive Their Copyrights” (1994) 11:2 *U Miami Ent & Sports L Rev* 437 at 455 [Kurtz, “Methuselah Factor”].

45 Robert E Anderson, “Alternatives to Copyright Law Protection of Graphic Characters: The Lanham Act and Antidilution Statutes” (1991) 13:2 *Hastings Comm & Ent LJ* 179. In 1978 *Filmation* was sued by DC Comics for using a character very like Plastic Man. As Robert Anderson writes, “[p]rotectable ‘ingredients’ recognized in this circuit include the names and nicknames of entertainment characters, as well as their physical appearances and costumes, but not their physical abilities or personality traits” at 185.

46 See Michael Todd Helfand, “When Mickey Mouse Is as Strong as Superman: The Convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Character” (1992) 44 *Stan L Rev* 623 at 623.

47 *Ibid* [footnote omitted].

48 Kurtz, “Methuselah Factor,” above note 44 at 438.

already finds it easier to afford protection. In the case of visual characters, the test is to compare “the plaintiffs’ and defendants’ characters to see if the similarity between them is sufficient for infringement.”<sup>49</sup> According to Kurtz, “[t]he more an audio-visual character resembles a cartoon character in its physical existence, the more it should be treated as a cartoon character for the purposes of determining copyright infringement.”<sup>50</sup> By the early 1990s the law had become much more hospitable to character protection than it used to be.<sup>51</sup>

According to Moffat, “[t]rademark law now protects much more than just names, words, and logos. Instead, a wide variety of designs, product configurations, and even the overall ‘look and feel’ of a product . . . function as indicators of source [that the ‘look and feel’ points to a particular owner] and are, therefore, protectable under the Lanham Act.”<sup>52</sup>

The tension between expression and property can be seen in the growing importance of trademark and publicity rights cases that challenge aspects of cultural expression that would seem to fall under the umbrella of copyright. Significantly, whereas (at least until the 1970s) the dominant view of copyright was in the form of a bargain between creators and the broader society, trademark was not based on such a bargain — it was commercial policy designed to protect consumers from misleading claims made by commercial entities in the marketplace.

For example, *Universal City Studios v Nintendo Co* involved a dispute over two gorillas — Donkey Kong and King Kong. The various owners of the King Kong mark had diluted the character to the point where the gorilla was too indistinct to be protected. Unfortunately for Universal, multiple parties over the years had granted licences in the character of King Kong for a variety of uses.<sup>53</sup>

A few years earlier in a different action, Universal had argued that King Kong and his story were in the public domain. Now Universal was asserting

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49 *Ibid* at 439.

50 See Leslie A Kurtz, “The Independent Legal Lives of Fictional Characters” (1986) 1986:3 *Wis L Rev* 429 at 471 [Kurtz, “Legal Lives”].

51 Jessica Litman, “Mickey Mouse Emeritus: Character Protection and the Public Domain” (1994) 11:2 *U Miami Ent & Sports L Rev* 429 at 430.

52 Viva R Moffat, “Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection” (2004) 19:4 *Berkeley Tech LJ* 1473 at 1495 [footnote omitted].

53 *Universal City Studios Inc v Nintendo Co Ltd*, 746 F2d 112 (1984); see also Kurtz, “Legal Lives,” above note 50; also see Anderson, above note 45, for discussions of *Universal v Nintendo*.

rights in King Kong, claiming it had acquired these rights through a settlement with the son of the original story's author and claiming secondary meaning and distinctiveness for the character. The court found that the confusion among licensors made it difficult to argue that any consumer could attribute King Kong products to a single source. Universal failed to establish secondary meaning. In a later development in the same case, the district court found that Universal's *Tiger* video game infringed Nintendo's *Donkey Kong* because the tone and feel of *Donkey Kong* was closely replicated in *Tiger*.<sup>54</sup> Still, even though Universal lost in its attempts both to poach and then to protect King Kong, other companies have also practiced manipulative strategies to propertize fictional characters and elements.

For example, in an unusually collaborative move, publishing rivals DC Comics and Marvel jointly registered the terms *superhero* and *supervillain* in 1979. Even though the terms were so commonly used as to be unsupported by trademark claims, no one challenged the trademark registration and it was approved two years later.<sup>55</sup>

Superhero costumes can also be protected — cases involving Superman, Wonder Woman, and Marvel character suits as “skins” in computer games have all been decided in favour of the owners of the trademarks.<sup>56</sup> The issue in such cases is “whether the author has added new, protectable expression to a derivative work not in the public domain. When the author adds such expression, those aspects of the character are still a protected derivative work.”<sup>57</sup> Thus, the development of new costumes, changing the race or gender of a character, or changing relationships in the storyline can either be judged derivative works belonging to the copyright holder or new works that can be afforded protection.<sup>58</sup> Such rights are of significant commercial value.

Take the case of Superman. While the heirs of Jerry Siegel and Joe Shuster will reclaim the copyright to Superman in 2013, these rights do not necessarily extend to the Man of Steel's appearances in other media. In a protracted and complicated legal battle, the heirs reclaimed copyright of characters and story elements, while the defendants (DC Comics and its parent

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54 *Universal City Studios v Nintendo*, 615 F Supp 838 (1985). Nintendo also was awarded damages on its claim for tortious interference with contract, punitive damages, and attorneys' fees; see Kurtz, “Legal Lives,” above note 50 at 492, n 349.

55 Payne, above note 25 at 952–53, n 64.

56 *Ibid* at 952–53 and 992–93.

57 Helfand, above note 46 at 654.

58 Compare the situations of Marv Wolfman and Neil Gaiman.

company Time Warner Inc) were found not guilty of sweetheart deals that diminished the revenues owed the estates of Siegel and Shuster. Siegel's heirs won a 2008 ruling that entitled them to profits earned by DC Comics.<sup>59</sup> However, once the rights revert to the heirs, they would be able to exploit the transmedia potential of Superman in competition with Time Warner.<sup>60</sup> However, two appeal cases in October 2012 and January 2013 saw the 2008 ruling overturned and the claim for copyright termination by the Shuster estate denied.<sup>61</sup>

Similarly, the estates of comic book artists Jack Kirby and Joe Simon sued Marvel for control of characters including the Fantastic Four, the Hulk, and Captain America, all subjects of Hollywood films in the past decade.<sup>62</sup> Such copyright cases create an additional layer of complexity for media companies whose business depends on the exploitation of fictional characters and their transfer between companies engaged in different forms of media.<sup>63</sup> For instance, one can certainly see how *articulations of corporate authorship* play into fan debates over whether or not the Siegel and Shuster estates should regain their rights to Superman, with many fans expressing concern that the quality of the character's representations would inevitably suffer due of their lack of institutional resources and managerial acumen. Sampling fan posts on the web, Santo reports that comic book fans accept the corporate role in producing and maintaining characters over time: "the only reason the Superman character is what it is today (and worth all that

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- 59 Dave McNary, "Warner Bros. wins 'Superman' case" *Variety* (8 July 2009), online: [www.variety.com/2009/biz/news/warner-bros-wins-superman-case-1118005806](http://www.variety.com/2009/biz/news/warner-bros-wins-superman-case-1118005806).
- 60 Die Trich Thrall, "The Final Fate of SUPERMAN: Lawsuit Settled in Favor of Creators Heirs — DC and Warner Brothers Will Lose All Rights in 2013" *Variety* (14 August 2009), online: Die Trich Thrall <http://dietrichthrall.wordpress.com/2009/08/14/the-final-fate-of-superman-lawsuit-settled-in-favor-of-creators-heirs-dc-and-warner-brothers-will-lose-all-rights-in-2013>.
- 61 Eriq Gardner, "Warner Bros. Wins Blockbuster Victory in Legal Battle for Superman" *Hollywood Reporter* (10 January 2013), online: The Hollywood Reporter [www.hollywoodreporter.com/thr-esq/warner-bros-wins-blockbuster-victory-410871](http://www.hollywoodreporter.com/thr-esq/warner-bros-wins-blockbuster-victory-410871).
- 62 Jay Goldberg, "King Kirby and the Amazin' Terminatin' Copyrights: Who Will Prevail!?" (Summer 2010) 2:1 American University Intellectual Property Brief 10, online: Digital Commons <http://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1011&context=ipbrief>; see also John Molinaro, "Who Owns Captain America? Contested Authorship, Work-For-Hire, and Termination of Rights under the Copyright Act of 1976" (2004) 21:2 Ga St U L Rev 565.
- 63 Mike Fleming Jr, "Fox Insiders: No Galactus Talks with Marvel" *Deadline* (6 August 2012), online: Deadline.com [www.deadline.com/2012/08/fox-insiders-no-galactus-talks-with-marvel](http://www.deadline.com/2012/08/fox-insiders-no-galactus-talks-with-marvel)



money),” writes one poster, “is because of DC’s work shepherding him over the past 70 years.” Another fan writes “Superman didn’t become the major property he is today because of [Siegel and Shuster]. He became this property because DC used and marketed him in this way.”<sup>64</sup>

## I. TRANSPROPERTIED PERSONALITIES

Where publicity rights come into conflict with other forms of IP, celebrities can invoke the *Lanham Act* and claim that their economic rights have been affected by the offending work.

In 1993, under the California right of publicity,<sup>65</sup> game show hostess Vanna White sued Samsung Electronics America on the grounds that a Samsung ad depicting a blond wigged robot standing at a *Wheel of Fortune* wheel constituted an appropriation of her likeness. When White won the case in 1994, it became possible for celebrities to assert property rights in the attributes that constitute their personae.<sup>66</sup>

Another *Lanham Act* case, involving musicians Edgar and Johnny Winter, who appeared in a comic book as mutated and depraved worm-creatures called the Autumn Brothers, was decided in favour of the comic book because the work was deemed suitably transformative such that the brothers’ right of publicity was not challenged by the portrayal. “[T]he California Supreme Court held that the comic book’s use of the Winter Brothers’ image was protected by the First Amendment guarantee of freedom of expression. To arrive at its holding, the court utilized, for only the second time, a test that it developed in 2001 — a copyright based ‘fair use’ test for the right of publicity.”<sup>67</sup>

Common law and state laws around publicity rights have shifted from personal to proprietary rights. In addition, publicity rights have been treated as descendible rights that can be protected after the death of a celebrity. These changes in IP laws as they affect creative works have, in effect, created a loose net of IP protection that forms the enclosure that legal scholars

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64 Avi Santo, “The Lone Ranger and the Law: Legal Battles over Corporate Authorship and Intellectual Property Management, 1939–1942” (2012) 29:3 *Critical Studies in Media Communication* 185 at 199–200 [endnote omitted].

65 *California Civil Code*, § 3344.

66 See John R Braatz, “*White v Samsung Electronics America: The Ninth Circuit Turns a New Letter in California Right of Publicity Law*” (1994) 15 *Pace L Rev* 161 at 221.

67 Gil Peles, “The Right of Publicity Gone Wild” (2004) 11:2 *UCLA Ent L Rev* 301 at 310 [footnotes omitted].

have described on the information and cultural commons. These protections have also changed the way that cultural goods are characterized in the marketplace. Indeed, a specialized form of communicative action has developed with the express purpose of guaranteeing (or at least encouraging) property claims in the intangible economy. This form of communication is branding.

## J. BRANDING: THE LANGUAGE OF TRANSPROPERTIZATION

The value added to cultural entities is encased, enclosed, and enforced in the concept of the “brand.” As culture increasingly became the battleground of business competition, the frenzied obsolescence of fashion was introduced into all manner of cultural endeavours, providing “a means to accelerate the pace of consumption not only in clothing, ornament, and decoration but also across a wide swathe of life-styles and recreational activities (leisure and sporting habits, pop music styles, video and children’s games, and the like).”<sup>68</sup> Starting in the 1960s with advertising’s realization that marketing the experience was as important as, if not more important than, advertising the specific and unique qualities of particular products, the slow process of reifying IP began.<sup>69</sup> If the culture industry worked largely through the commodity, argue Lash and Lury, the global culture industry works through brands.<sup>70</sup>

Some writers consider the brand as “the good name of a product, an organization or a place; ideally, linked to its identity.”<sup>71</sup> From this perspective, a brand is a “promise of value.”<sup>72</sup> Others see branding as a creative tool with which to create emotional links between audience/consumers and companies/products. Marc Gobé calls this emotional branding.<sup>73</sup> More central to this discussion is the recognition that brand stories are constructions

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68 Thomas Frank, *The Conquest of Cool: Business Culture, Counterculture and the Rise of Hip Consumerism* (Chicago: University of Chicago Press, 1997) at 25 [footnote omitted].

69 Jim McGuigan, *Cool Capitalism* (London: Pluto, 2009).

70 Scott Lash & Celia Lury, *Global Culture Industry: The Mediation of Things* (London: Polity, 2007) at 25.

71 Robert Govers & Frank Go, *Place Branding. Glocal, Virtual and Physical Identities, Constructed, Imagined and Experienced* (London: Palgrave MacMillan, 2009) at 12.

72 *Ibid.*

73 Marc Gobé, *Emotional Branding: The New Paradigm for Connecting Brands to People* (New York: Allworth Press, 2001) at 8–15.

that appeal to a variety of senses and whose intent is, like Pavlovian psychology or social engineering, to influence our behaviour. As marketing guru Scott Bedbury puts it, “[t]he concept of the brand — the Platonic idea, if you will — creates a response in its audience without the audience’s seeing the product or directly experiencing the service.”<sup>74</sup>

Yet, as Rifkin writes, “[m]arketing is the means by which the whole of the cultural commons is mined for valuable potential cultural meanings that can be transformed by the arts into commodifiable experiences, purchasable in the economy.”<sup>75</sup> Further, he observes, “the culture, like nature, can be mined to exhaustion.”<sup>76</sup>

The roles and nature of branding have changed over the past generation as branding evolves into a new kind of commercial speech, not geared to describing goods in the marketplace nor the reputation of a supplier of goods, services, or lifestyles, but as a mark of property and as the very process through which forms of expression and culture are deemed property. Branding is the activity for establishing and maintaining a reputation in the marketplace, thereby asserting one’s property rights in image, attributes, name, etc. One of the tests that US courts use to decide whether a particular person’s publicity rights are descendible is whether that person asserted her publicity rights as property during her lifetime.

Companies have emerged in the past twenty years whose specific purpose is to propertize celebrities, using the language of branding and the conflated assumptions shared by copyright, trademark, and publicity rights cases that “image” is property. These companies claim that resources like classic films and Hollywood icons deserve “our attention and respect.”<sup>77</sup> While companies are willing to pay extraordinary sums for the rights to commercially exploit celebrities such as Elvis or Muhammad Ali,<sup>78</sup> others exploit the knowledge and contacts of their heirs in order to control the new publicity rights as property and to brand those celebrities as products.<sup>79</sup>

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74 Scott Bedbury & Stephen Fenichell, *A New Brand World: 8 Principles for Achieving Brand Leadership in the 21st Century* (New York: Viking, 2002) at 12–13.

75 Rifkin, above note 24 at 171.

76 *Ibid* at 247.

77 MODA Entertainment, “About,” online: <http://modaentertainment.com/about.html>.

78 Richard Verrier, “Elvis Will Live On — At Least Digitally” *Los Angeles Times* (7 June 2012) online: *Los Angeles Times* <http://articles.latimes.com/2012/jun/07/business/la-fi-ct-virtual-elvis-20120607>.

79 For example, Stephen Humphrey Bogart sued MODA claiming that the company exploited his knowledge of Hollywood and his contacts over a three-year period. “Bogart and

## K. STOKER AND HOLT: RE-ESTABLISHING THE FAMILY BUSINESS

Returning to our point of origin, how can we look at an event like the publication of Stoker and Holt's novel as an example of convergence era, transpropriated media? Recall the conditions described earlier that characterize the new IP environment: works-for-hire, the proprietization of culture using branding, and overlapping IP protection. How do these appear in the Stoker story?

Bram Stoker died before his work became popular. His widow successfully sued the makers of *Nosferatu*, but, failing to see all copies of the film destroyed and having her control of the property rejected by Universal Studios as they prepared a sequel to *Dracula*, she gave up her battles to assert control over the work in the United States by the mid-1930s. The German film, produced in 1922 by Prana Films, tried to avoid the copyright suit by changing character names (Count Dracula becomes Count Orlock) and plot elements (the death of Orlock by exposure to daylight) to distance the film from Stoker's novel. A British court ordered all copies of the film destroyed, although a print survived and surfaced in the United States. The lawsuit bankrupted Prana Films.<sup>80</sup>

*Dracula* entered the public domain in the United States in 1899 due to an error in the registering of the work. It entered the public domain in the UK and other countries bound by the *Berne Convention* in 1962.<sup>81</sup> Dacre Stoker and Ian Holt wrote the *Un-dead* sequel in 2009 based on a 125-page manuscript appearing in Stoker's papers. Stoker the younger also prepared a book with scholar E Miller, editing a "lost" notebook by the elder Stoker.<sup>82</sup> While not working for hire, the collaborations characteristic of Dacre Stoker's endeavours suggest a corporatized method of cultural production.

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Bacall's Son Sues Bosses" *Contact Music* (28 January 2009) online: [Contact Music www.contactmusic.com/news/bogart-and-bacalls-son-sues-bosses\\_1093112](http://ContactMusic.com/contactmusic.com/news/bogart-and-bacalls-son-sues-bosses_1093112).

80 Jonathan Bailey, "Dracula vs. Nosferatu: A True Copyright Horror Story" *Plagiarism Today* (17 October 2011), online: [Plagiarism Today www.plagiarismtoday.com/2011/10/17/dracula-vs-nosferatu-a-true-copyright-horror-story](http://PlagiarismToday.com/plagiarismtoday.com/2011/10/17/dracula-vs-nosferatu-a-true-copyright-horror-story).

81 See *Lugosi v Universal Pictures*, 603 P 2d 425 (Cal Sup Ct 1979) at n 4; see also Kathryn M Foley, "Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide" (2009) 41:3 Conn L Rev 921, for a recent discussion about the difficulties in protecting fictional characters using copyright claims.

82 Elizabeth Miller & Dacre Stoker, eds, *The Lost Journal of Bram Stoker: The Dublin Years* (London: Biteback Publishers, 2012).

Regarding the propertization of culture, Stoker claims to give the original novel the “respect” it deserves. He has “rescued” the orphaned novel from the public domain and has started to mine his ancestor’s cultural pool for gold. Indeed, Stoker offers the kind of respect that custodial ownership affords. He uses the web and licensing firms to manage the estate of the writer, to manage the brand, and to create a chill on future work based on the writer’s characters.<sup>83</sup> In 2009, in the months leading up to the publication of *Dracula the Un-dead*, promotion and licensing were handled by MODA Entertainment.<sup>84</sup> Bram Stoker LLC is based in the United States and represents the direct descendants of the author in the United Kingdom. The company has consolidated the international rights and trademarks of the Bram Stoker Estate. Dacre Stoker manages the company for rights in the US and South America, while Stoker’s grandson, Robin MacCaw, manages them for the UK, Europe, and the Far East. Bram Stoker Estate LLC treats “all things Stoker” as a family business, freely applying US common law publicity rights to establish Bram Stoker as a brand.<sup>85</sup>

Through these activities the Stoker family business directs its activities to each of the forms of IP we have described. The performance of the work in Toronto echoes a live reading staged by Bram Stoker to demonstrate his copyright over the original *Dracula*. Dacre Stoker continues to publish, to make live appearances as the custodian of the estate, and to work in other media, including documentary film. Assuming the validity of descendible publicity rights, the Stokers operate on behalf of the financial interests of a celebrity who died a hundred years ago.

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83 The Stoker estate has several websites active, including: *Dracula meets Stoker*, online: [www.draculameetsstoker.com](http://www.draculameetsstoker.com); Stoker & Holt, above note 2; Bram Stoker: Official Website for the Bram Stoker Estate, online: [www.bramstokerestate.com](http://www.bramstokerestate.com); a Facebook page, online: [www.facebook.com/BramStokerEstate](http://www.facebook.com/BramStokerEstate); and a Tumblr page, online: [www.tumblr.com/tagged/bram-stoker-estate](http://www.tumblr.com/tagged/bram-stoker-estate).

84 MODA Entertainment handled the book launch, the public reading in Toronto, a screening of the 1931 film starring Bela Lugosi, and a *Dracula the Un-dead* credit card. As of 2012, licensing of Stoker merchandise is handled by Cribbs Consulting, a New York City firm who, according to *Forbes* magazine, specialize in managing dead celebrities; see Jake Paine, “Managing the Dead Celebrities Corporations Love” *Forbes* (25 October 2011), online: [Forbes www.forbes.com/sites/dorothy pomerantz/2011/10/25/managing-the-dead-celebrities-corporations-love](http://Forbes.com/sites/dorothy pomerantz/2011/10/25/managing-the-dead-celebrities-corporations-love).

85 In the afterword to *Dracula the Un-dead*, co-author Ian Holt promotes the re-establishment of *Dracula* and Bram Stoker as Stoker-controlled brands by stating, “if you don’t see the bat-logo, it’s not *official* Bram Stoker *Dracula* merchandise”: Stoker & Holt, above note 2 at 423 [emphasis added].

## L. CONCLUSION

Understanding changes in IP law as part of a changing media ecology allows us to connect changing practices in the creative and intangible economy and to see the role of IP in a new light. Intellectual property law is a medium of control in the digital age. It helps set the boundaries of interaction and, to a degree, reality definition. From this, we can make two claims.

First, it is possible, and, I would argue appropriate, to talk of an ecology of IP based on the propertization of information that began in law reform and in caselaw during the 1970s. As copyright, trademark, and the right of publicity converge, it makes sense to talk about the objects of their protection as transpropertied goods. Second, the mechanism or communicative practice associated with this new ecology of information is branding, which has changed from a technique of marketing to an informal medium of control alongside these changes in law.

A final warning, dear reader. The success of claims made under the new climate of overlapping IP protection is not the pertinent issue. In fact, the results of such cases have been mixed — *White v Samsung* established property rights in personality, while the Winter brothers lost their case on the basis that freedom of expression, particularly where creative transformation has occurred, trumps both the right to publicity and the *Lanham Act*. The estates of Siegel, Shuster, Kirby, and Simon have had mixed results. The important point to remember is that the practice of branding personalities (fictional, living or dead) presupposes their status as property and, over time, cases and law reform will reflect the practice.