CASTLE ROCK ENTERTAINMENT, INC. V. CAROL PUBLISHING GROUP, INC.

By Elisa Vitanza

I. INTRODUCTION

Society benefits from the creation and dissemination of new, creative works. The Federal copyright system serves primarily to enhance the public interest through the promotion of creativity.[1] Copyright laws struggle to strike a balance between granting exclusive property rights and enhancing the public domain so that the next generation of artists can use pre-existing works to generate more creativity.[2] The Copyright Act[3] provides authors with incentives to create and share their creativity with the public through the grant of exclusive rights, including the right to prepare derivative works.[4] Derivative artists also require incentives to invest in

1. *See* U.S. CONST. art. I, § 8, cl. 8 (providing that "Congress shall have Power . . . *To Promote the Progress of Science and useful Arts*, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries") (emphasis added).

2. *See* Landes & Posner, *An Economic Analysis of Copyright*, 18 J. LEGAL STUD. 325-33, 344-46 (1989). Landes and Posner argue that copyright protection attempts to efficiently balance the benefits of creating new works with the losses from limiting access and the costs of administering copyright protection. *Id.* The economic theory of copyright is the dominant theory in the United States. However, commentators, particularly outside the United States, rely on moral or personal rights theories to justify copyright protection. *See* Mark Lemley, *The Economics of Improvement in Property Law*, 75 TEX L. REV. 989, 1031 (1997). Countries that adhere to the Berne Convention guarantee rights of attribution and integrity to its authors. *See* Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, art. 6*bis*, *reprinted in* WORLD INTELLECTUAL PROPERTY ORGANIZATION, GUIDE TO THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS (Paris Act, 1971) 177 (1978). In the United States, moral rights are a secondary consideration. *See* ROBERT P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 12 (1st ed. 1997). Congress has enacted only limited protections of attribution and integrity interests for visual artists. *See* Visual Artists Rights Act of 1990, 17 U.S.C. § 106A (1994). Moral rights equivalents also operate to a limited extent in various US copyright doctrines. *See* ROBERT GORMAN & JANE GINSBURG, COPYRIGHT FOR THE NINETIES 477-79 (4th ed. 1993).

3. 17 U.S.C. §101 et seq. (1976).

4. *See* 17 U.S.C. 106 (2) (1976). According to the Copyright Act, a derivative work is "a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art

creations that build on pre-existing works and overprotection of initial works will likely result in under-investment in derivative works.[5] This results in a detriment to the public interest.

It is natural for creative activity to build on prevalent elements of society, such as popular culture and popular television programming. Elements of popular culture become so entrenched in our everyday lives that we come to think of them as our own.[6] In fact, copyright owners of television shows send their fictional worlds and characters into our homes every week and ask us to embrace them and to make them an indispensable part of our lives.[7] Vocabularies and experiences once introduced through the mouths of fictional characters translate into integrated parts of our reality.[8] Many artists have incorporated these assimilated images and vocabularies into a variety of derivative works including fan guide books. These popular culture derivatives represent a flourishing field of creative activity and serve the copyright system's basic purpose of enhancing and expanding the public domain of creative works.

This comment examines the copyright system's current approach to derivative works based on popular culture topics through an analysis of the Second Circuit's decision in *Castle Rock Entertainment, Inc. v. Carol Publishing Group, Inc.*[9] The approach taken by the Second Circuit does not adequately address the special nature of popular culture works, including the blurred line between fact and fiction, the reduced need to pro-

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reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted." 17 U.S.C. § 101 (1976).

5. *See generally* Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPR. SOCIETY 209 (1983) (describing the copyright law's response to the modern expansion of derivative works and the uneven provision of derivative rights by the courts).

6. *See* HENRY JENKINS, TEXTUAL POACHERS TELEVISION FANS & PARTICIPATORY CULTURE 279 (1992); NEIL POSTMAN, AMUSING OURSELVES TO DEATH: PUBLIC DISCOURSE IN THE AGE OF SHOW BUSINESS 87 (1985). Postman argues that the medium of television is shaping the very nature of public discourse. "Television...has made entertainment itself the natural format for the representation of all experience." *Id. See also* BRYON REEVES & CLIFFORD NASS, THE MEDIA EQUATION: HOW PEOPLE TREAT COMPUTERS, TELEVISION AND NEW MEDIA LIKE REAL PEOPLE AND PLACES (1996) (arguing that mass media is so pervasive that the public treats what they see as real to the extent that even the media devices themselves are assigned human qualities).

7. The NBC slogan for their highest rated shows on broadcast television is "Must see TV." ABC encourages viewership with the repeated "We Love TV." CBS beckons its audience with "Welcome Home."

8. *See* JENKINS, *supra* note 5, at 50-85 (providing an explanation of how television shows and movies become real to fans, through the development of social meaning and social interaction).

9. 150 F.3d 132, (2d Cir. 1998), [hereinafter *Castle Rock II*].

vide incentives to create mass media entertainment, the social significance of permissible use of cultural vocabularies, and the extreme fan interest and creativity in this field. Continued application of the present idea-expression, substantial similarity and fair use doctrines to popular culture derivatives will prevent use of appropriated cultural material without proper consideration. Both the Courts and Congress may need to rethink their approach to popular culture works in order to best serve the public interest and promote overall creative activity.

II. BACKGROUND

After watching the *Seinfeld*[10] television series for several years, Beth Golub created and published a trivia book, the *Seinfeld Aptitude Test ("SAT").* In 643 questions and answers, the *SAT* tests the reader's knowledge of the *Seinfeld* characters' quirks and the events depicted in the show.[11] For example, the *SAT* asks what candy Kramer snacks on and then drops while observing a surgical procedure on the balcony (junior mints).[12] The *SAT's* questions are divided into five levels of difficulty[13]

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10. *Seinfeld* is a situation comedy that aired on NBC for nine years, and ended its phenomenally successful run in 1998. The series traced the daily lives of four friends, Jerry Seinfeld, Elaine Benes, George Costanza and Cosmo Kramer; these friends lived in New York, and in each episode confronted life's "daily, petty annoyances." *See* Castle Rock Entertainment v. Carol Publishing, 955 F. Supp. 260, 262 (S.D.N.Y. 1997), [hereinafter *Castle Rock I*]. The show was often described as a show about nothing. *See e.g.. 'Sein' Off,* HOLLYWOOD REPORTER, May 14, 1998, at S3. A typical episode of the show simply followed the characters around a parking garage looking for their car. *See Seinfeld: The Parking Garage* (NBC television broadcast, Oct. 30, 1991).

11. The front cover of the *SAT,* describes the book as containing "[h]undreds of spectacular questions of minute details from TV's greatest show about absolutely nothing." The back cover asks:

> Just how well do you command buzzwords, peccadilloes, petty annoyances, and triflingly complex escapades of Jerry Seinfeld, Elaine Benes, George Costanza and Kramer—the fabulously neurotic foursome that makes the offbeat hit TV series *Seinfeld* tick? If you think you know the answers—and really keep track of *Seinfeld* minutiae-challenge yourself and your friends with these 550 questions and 10 extra matching quizzes. NO, The *Seinfeld* Aptitude test can't tell you whether you're Master of your Domain, but it will certify your status as King or Queen of *Seinfeld* trivia. So twist open a Snapple, double-dip a chip, and open this book to satisfy your between-episode cravings.

See Castle Rock II, 150 F.3d at 136.

12. *See Castle Rock II,* 150 F.3d at 135 n.12.

13. "Wuss Questions", "This, That, and the Other Questions", "Tough Monkey Questions", "Atomic Wedgie Questions", and "Master of Your Domain Questions." The categories also represent references to the show. *Id.* at 135.

with material drawn from eighty-four episodes, including some direct quotations of the show's dialogue.

Castle Rock Entertainment[14] engaged in highly selective marketing for *Seinfeld*. It licensed only one book, *The Entertainment Weekly Seinfeld Companion,* and one CD-ROM containing discussions of the show. When the *SAT* was first published, NBC requested free copies of the *SAT* to distribute as a promotion. However, in February 1995, Castle Rock filed suit alleging copyright infringement and state unfair competition.[15] The district court granted Castle Rock's motion for summary judgement on the issue of copyright infringement, finding that the *SAT* appropriated original expression from *Seinfeld* and that no "fair use" defense was available. The district court also awarded damages and permanently enjoined Carol from publishing or distributing the *SAT*[16].

A. The District Court Decision

The district court first evaluated whether the defendants improperly appropriated original, creative material from the television series. Golub admitted to taking notes from the *Seinfeld* episodes and quoting dialogue from the show in her trivia book.[17] Thus, the court focused its inquiry on whether the *SAT* copied elements of *Seinfeld* that were original.[18] The court considered a previous line of cases that drew the line between unprotectable facts and protectable expression.[19] *Feist Publications, Inc. v. Rural Telephone Services, Inc.* defined "facts" as material that does not owe its origin to an act of authorship.[20] Following *Feist,* the district court rejected the defendants' contention that the *SAT* merely tests readers on the show's underlying facts and ideas. The court noted that the *SAT* does not ask "factual" questions, such as who acts in the program, but rather asks questions about "expressive" material such as what Jerry places on

14. Castle Rock Entertainment produced the show and owns the copyright for each episode of the series.

15. *See Castle Rock I,* 955 F. Supp. at 261.

16. *See Castle Rock II,* 150 F.3d at 135.

17. *See Castle Rock I,* 955 F. Supp. at 263.

18. *See id.* at 264.

19. *See* Feist Publications, Inc. v. Rural Telephone Serv., Inc., 499 U.S. 340, 347 (1991) (discussing that white page listings of names and phone numbers are unprotectable facts); Harper and Row Publishers v. Nation Enterprises, 471 U.S. 539, 549 (1985) (finding infringement where defendant published magazine article which did not merely include facts revealed by President Ford in his as yet unpublished memoirs, but which excerpted the President's expression of those facts); Worth v. Selchow & Rightor Co., 827 F.2d 569 (9th Cir. 1987) (finding no infringement where defendant incorporated facts chronicled in plaintiff's reference books into a trivia game).

20. *See Feist,* 499 U.S. at 347.

Elaine's leg during a piano recital.[21] This is material created by the show's writers. "[U]nlike facts depicted in a biography, historical text or compilation,... *Seinfeld* is fiction."[22] The district court found that the *SAT* infringed on the *Seinfeld* copyright because it uses fictional content that is protectable expression.

The district court also considered the fair use defense under section 107 of the Copyright Act, examining each of the four relevant factors.[23] The court first found that the purpose or character of the use factor favored the defendants. The *SAT* qualified as "criticism, comment, scholarship, or research."[24] The court warned against subjective judgements about quality and noted that a work should be equally eligible for fair use protection whether testing the knowledge of Castle Rock's *Seinfeld* or Shakespeare's *Hamlet*.[25] In addition, the court found that *SAT* was transformative, it added something new, and of a different character than the television program.[26]

However, the court found that the remaining three factors favored the plaintiffs. The nature of the copyrighted work—a fictional television show—was creative. In addition, the court found that the amount and substantiality of the portion used was significant. Here, the court relied on its previous finding of substantial similarity although it proceeded to evaluate

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21. *See Castle Rock II,* 150 F.3d at 139.

22. *See Castle Rock I,* 955 F. Supp. at 266.

23. *See* 17 U.S.C. § 107 (1976). The statute provides:
in determining whether the use made of a work in any particular case is fair use the factors to be considered shall include—1) the purpose or character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes, 2) the nature of the copyrighted work; 3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and 4) the effect of the use upon the potential market for or value of the copyright work.

Id.

24. *See* 17 U.S.C. §107 (1976). The statute provides:
the fair use of a copyrighted work, including such use by reproduction in copies or phonrecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.

Id.

25. *See Castle Rock I,* 955 F. Supp at 267.

26. The Supreme Court in Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994), defined transformative as whether, "the new work merely 'supersedes the objects' of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message." *Id* at 579.

the borrowed material contained in the *SAT* from both a quantitative and qualitative perspective.[27] The court found that the *SAT* borrowed a substantial portion because it appropriated essential elements and captured the essence of *Seinfeld*, "that there is humor in the mundane, seemingly trivial, aspects of every day life."[28] Although the book transformed the program by converting its elements into a trivia format, "[s]imply put, without *Seinfeld*, there can be no *SAT*."[29]

Finally, the court analyzed what it termed the most important element of the fair use analysis, the effect of the use upon the potential market for or value of the copyright work.[30] The court agreed that the book compliments *Seinfeld*, that it has not diminished interest in the show, and that it is of value to a regular viewer of *Seinfeld*. It also agreed that the book fills a market in which the creators have expressed little interest. However, the court emphasized that copyright law protects an artist's expression, which includes deciding whether to create additional materials from his or her original work. Creators of original works control derivative uses that they would in general develop or license others to develop.[31] However, parody and critical works, by their nature, are probably better developed by persons other than the copyright owner and are not protectable. As the *SAT* does not criticize the show, but pays homage to it, the show's creators could develop this complementary material. The court determined that the fourth factor and the overall analysis did not support a finding of fair use.

B. The Second Circuit Decision

The Second Circuit affirmed the district court's judgment in favor of Castle Rock, finding unlawful copying without fair use.[32] The Second Circuit began its infringement analysis by evaluating whether the *SAT* copied sufficient material to be considered substantially similar to the television program. The court applied the "de minimis" test outlined in *Ringgold v.*

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27. Quantitative analysis includes an assessment in numbers or percentages of how much of the copyrighted work has been incorporated into the derivative work. *See Harper & Row*, 471 U.S. at 564-66; Qualitative analysis assesses the value of the borrowed material to the copyrighted work. Even small amounts of material taken from the original work can be substantial, if what is appropriated constitutes the "heart" of the original work. *Id.* at 564-66.

28. *See Castle Rock I*, 955 F. Supp. at 269.

29. *Id.* at 269.

30. *See Castle Rock I*, 955 F. Supp. at 270-71.

31. *See id.* at 271 (quoting *Campbell*, 510 U.S. at 592).

32. *See Castle Rock II*, 150 F.3d at 135.

Black Entertainment Television Inc.[33] This test examines whether the amount copied was more than de minimis and whether the material copied was expression or idea. Analyzing the material borrowed from the television series as a whole, the court found that the 643 fragments taken from the series plainly crossed the quantitative threshold. In its qualitative assessment of the copied material, the Second Circuit did not expand upon the district court's analysis of the fact-expression distinction. The Second Circuit opinion reiterated the district court's application of *Feist*—unlike listings in a telephone book, each "fact" tested in the trivia book owes its origin to an act of authorship by *Seinfeld's* writers. However, the Second Circuit did acknowledge the special nature of popular culture derivatives. The court noted the blurred line between unprotected fact and protected creative expression by alluding to the real political discourse between Murphy Brown, a fictional single, working mother and then Vice President Dan Quayle.[34]

The Second Circuit also considered the fair use defense. It began its analysis with the Constitution. It found that, ultimately, judicial assessment of fair use should turn on whether copyright's goal of promoting the Progress of Science and the useful Arts "...would be better served by allowing the use than by preventing it.[35]

Contrary to the district court, the Second Circuit did not find any transformative purpose to the *SAT*. It described the book as merely repackaging *Seinfeld* to entertain *Seinfeld* viewers. Further, the appellate court rejected the district court's classification of the *SAT* as "criticism, comment, scholarship, or research." Instead, the Second Circuit applied a test requiring both a transformative and educational purpose, conflating two elements of the analysis. The court suggested that a critical analysis of the show or a research guide may have qualified as a transformative, educational pur-

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33. *See* Ringgold v. Black Entertainment Television, Inc., 126 F.3d 70, 75 (2d Cir. 1997).

34. *Murphy Brown* was a successful situation comedy in the 1980's and 1990's that followed the lives of Murphy Brown, a television newswoman, and her co-workers. The cited incident arose when the character Murphy Brown was about to become an unwed mother. In a public speech, Vice-President Quayle accused the television character Murphy Brown of corrupting the nation's morals by having a child out of wedlock. *See* David G. Savage, *Quayle Vows White House Will Fight To End Legal Abortion* L.A. TIMES, June 12, 1992, at 18. The comment sparked a media frenzy and a fictional response from the TV character to the vice president's comments about family values and his criticisms of her choice. *See* Tom Shales, *Murphy Brown's Quayle Shoot; Season Opener a Sanctimonious Letdown* THE WASH. POST, Sept. 22, 1992, at B1; *Quayle and the boomerang thing* THE BOSTON GLOBE, May 21, 1992 at 20.

35. *See Castle Rock II*, 150 F.3d at 141.

pose. However, the *SAT* did not try to expose *Seinfeld's* "nothingness" or educate the public, it "simply pose[d] trivia questions."[36] Finally, the court found the *SAT*'s creative contribution of levels of difficulty and hiding correct answers among false ones as minimal, and further evidence of a lack of transformative, educational purpose.

The Second Circuit also rejected the district court's reasoning that a finding of substantial similarity in the infringement analysis "should suffice for a determination that the third fair use factor favors the plaintiff."[37] Because a court will not reach the question of fair use until there has been a finding of substantial similarity, the third factor would always favor the original copyright owner under the district court's standard. Thus, the Second Circuit applied a more restrictive standard to the third factor's analysis.[38] The court noted that an examination of the amount and substantiality of the portion of the copyrighted work used must focus on whether "[t]he extent of ... copying is consistent with or *no more than necessary* to further 'the purpose and character of the use.'"[39] Although the court questioned the validity of classifying the *SAT* as a commentary, the court still applied this "no more than necessary" standard to the *SAT*. The Second Circuit found the *SAT*'s use of 643 show fragments excessive to expose *Seinfeld's* nothingness in a critical commentary.

Finally, the Second Circuit examined the effect of the *SAT* on the potential markets of the television series. The court focused its analysis on whether a secondary use, such as the *SAT,* "usurps or substitutes for the market of the original work." The court held that the *SAT* substituted for a derivative market the copyright owner "would in general develop or license others to develop."[40] Castle Rock could develop promotional, en-

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36. *See Castle Rock II*, 150 F.3d at 143.

37. *See id.* at 144 (quoting *Castle Rock I*, 955 F. Supp. at 269-70 (quoting *Twin Peaks*, 996 F.2d at 1377)).

38. This standard was developed in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). In *Campbell*, the Supreme Court determined that a "parody must be able to conjure up at least enough of the [the] original work to make the object of its critical wit recognizable" *Id.* at 588. The *Campbell* standard is overly restrictive as applied to derivative works as a whole. Parodies are just one special form of derivative works, which the courts have considered fair use of the pre-existing material. It is non-sensical to focus fair use analysis of all types of derivative works on the "amount" of material necessary to conjure a remembrance of it. Derivative artists build on pre-existing materials in various ways. It is the artist who chooses what is necessary to promote the new creativity activity. The court should focus its analysis on what value has been added to the work, not an arbitrary threshold.

39. *See Castle Rock II*, 150 F.3d at 144 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586-87 (1994)).

40. *See id.* at 145 (quoting *Campbell*, 510 U.S. at 592).

tertaining material on its own. Fair use does not protect works such as the *SAT.*

III. DISCUSSION

The *SAT* is just one example of many creative works derived from copyright protected popular culture subjects. Television shows and movies such as *Seinfeld, Star Trek, The X-Files,* and *Star Wars* have enjoyed wide popularity and generated tremendous fan interest.[41] These shows have elicited hundreds of creative extensions of the programs, from newsgroups discussing last week's episode, to fan fiction sites composing new plot twists and published paper-guide books. Owners of the copyrights for *Star Wars, Star Trek,* and *The X-Files* have taken advantage of this derivative works right to create movies, books, and even action figures based on their original creations. They have also engaged in selective enforcement of their copyrights, permitting, for example, many fan web sites.[42]

Castle Rock is one of three recent cases in which the court has specifically analyzed copyright infringement claims involving fan books based on popular television series. *Twin Peaks Productions Inc. v. Publications International*[43] involved the book, *Welcome to Twin Peaks,* which contained detailed plot summaries of the first eight episode of the short-run, cult television show and some commentary on the show's popularity, music and creators. *Paramount Pictures Corp. v. Carol Publishing Group*[44]

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41. A web search for "Seinfeld" yielded 708,400 hits on January 29, 1998. Similarly, a web search for "X-Files" yielded 173,625 hits, including episode guides, frequently asked questions, in-joke lists, quizzes, role playing, cartoons, comic strips and fan fiction.

42. *See* Paramount Pictures v. Carol Publishing, No. 97-CV-8500 SAS SC., 1998 WL 357337, at *1 (S.D.N.Y. 1998). (noting that Paramount Pictures, the owner of the Star Trek properties, has engaged in selective enforcement of its intellectual property rights.)

43. 996 F.2d 1366 (2d Cir. 1993).

44. 1998 WL 357337, at *1. In 1997, Ramer, a devoted Trekker, created the "The Joy of Trek: How to Enhance Your Relations with a STAR TREK Fan." Paramount filed a motion for a preliminary injunction. The court found the *Joy of Trek* substantially similar to Star Trek. The district court applied the test for substantial similarity in Knitwaves v. Lollytogs Ltd., 71 F.3d 996, 1001 (2d Cir. 1995), "whether a lay observer would recognize the alleged copy as having been appropriated from the copyrighted work." The book both directly quoted dialogue like "live long and prosper" and "make it so" and copied fictitious facts through retelling of the story. The Joy of Trek is such a book. In its fair use analysis, the court recognized that Ramer, was motivated to a large extent, by a desire to help others understand the typical Trekker. This genuine motivation to serve a broader public purpose helped balance the book's commercial nature. However, the court

involved the book, *The Joy of Trek: How to Enhance your Relations with a Star Trek Fan,* which contained commentaries on the Star Trek shows and movies, advice on how to relate to a trekker, and descriptions of major plots, personalities, alien species and technologies that appeared throughout the show's thirty-year history. In each case, the court found that the derivative book infringed the original and that no fair use defense was available.

These three cases illustrate the limitations of current derivative rights doctrines in the context of popular culture works. The structure of the current analysis stacks the deck against unauthorized popular culture derivatives—such works will almost always be substantially similar to the original because the work is designed to evoke the original's character and style. This approach does not adequately address the special nature of popular culture works, including the blurred line between fact and fiction, the reduced need to provide incentives to create television series, the social significance of permissible use of cultural vocabularies and the extreme fan interest and creativity in this field. Continued application of current idea-expression, substantial similarity and fair use doctrines to popular culture derivatives will prevent findings of non-infringing use.

A. Serving the Goals of the Copyright System

Popular culture derivatives serve the copyright system's basic purpose of enhancing and expanding the public domain of creative works. In fact, these works represent a flourishing field of creative activity.[45] This creative activity is often discounted as less valuable to the creative bank because it does not fall into traditional categories of high art.[46] The addition of original material ranges from the creativity involved in organizing and compiling detailed summaries of a television show's history to the composition of new stories involving the show's characters.[47] Popular culture subjects engage the public on a massive scale, including more people in

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Ramer's motivation and humorous retelling of the Star Trek stories did not add enough transformative value to warrant a finding of fair use.

45. *See* Rebecca Tushnet, *Legal Fictions: Copyright, Fan Fiction, and a New Common Law,* 17 LOY.L.A. ENT. L.J. 651 (1997) (providing extensive discussion of fan fiction and the functions it serves for authors and audiences, and arguing for copyright protection for non-commercial fan fiction).

46. *See* JENKINS, *supra* note 5, at 53, 18-19; *See also* Tushnet, *supra* note 45, at 666.

47. Other creative products include trivia books, role playing, crossword puzzles, character guides, cartoons, comic strips, discussion groups, discussion books, new plots and stories.

the creative process than might ever have participated.[48] If popular culture derivatives encourage creativity and wide-scale participation, what justifies the copyright system's limitation on this creativity? Copyright should respect these creative endeavors and encourage their contribution to the public domain. A finding of permissible use in an individual case should depend on a balancing of the competing policy goals of the copyright system. As a starting point, courts must restructure their analysis of popular culture works to allow for the possibility of non-infringing uses.

B. Rethinking the Infringement Analysis: Should popular culture symbols be available for public use?

Application of a traditional infringement analysis does not allow fan compendiums to qualify as creative, non-infringing uses. Developing a workable approach to popular culture derivatives involves a re-evaluation of what should constitute protectable expression and unprotected ideas.

Generally, copyright law allows for the free use of the underlying ideas of a creative work. Section 102(b) states that "[i]n no case does copyright protection for an original work of authorship extend to any idea ... regardless of the form in which it is described, explained, illustrated, or embodied in such work."[49] This provision allows others to use ideas in the creation of new works, thereby benefiting the public interest. A person cannot copyright the idea of two young lovers, from different backgrounds and fighting families, who unsuccessfully overcome adversity to be together. However, the author can obtain a copyright for his or her particular expression of that idea such as the creators of Romeo and Juliet and West Side Story.[50] Copyright law also does not extend protection to facts, which were defined by the Supreme Court in *Feist* as material that does not owe its origin to an act of authorship.[51] In the infringement analysis, the court first identifies the protectable elements of the work distinguishing unprotected ideas and facts from protectable expression. The court finds unlaw-

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48. *See* Tushnet, *supra* note 45, at 655 n.28-29 ("Unlike 'high' art, fan fiction draws on popular culture in ways that are easy for large communities to understand and enjoy. Modern technology allows fans to reach other similar minds at minimal cost.) *See* JENKINS, *supra* note 5 (discussing the scope and breadth of fan activities).

49. The Supreme Court first examined the idea-expression dichotomy in Baker v. Shelden, 101 U.S. 99 (1880). In that case, the court held that the author of a new ledger accounting system could receive copyright protection for the expression of his system in his explanatory book, but not for the ideas that the book described.

50. *See* 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §13.03[A][1][b], at 13-33 (Sept. 1998).

51. *See Feist*, 499 U.S. at 347.

ful infringement when a derivative artist has used enough *protectable material* to identify a derivative work as substantially similar to the original

The Second Circuit in *Castle Rock* ended its analysis of the idea-expression dichotomy too abruptly by asserting that the content of the *SAT* owes its origins to a writer and therefore is protected expression. The line between fact or idea and fictional expression in a popular culture work cannot be so easily drawn. At a certain point, fictional worlds become so prevalent in everyday lives that people consider them a part of reality.[52] Through the public's embrace, these works become something more than the bare expression portrayed in a broadcast of a television program.[53] Intuitively, it is easy to understand the characterization of some popular television show's as "having a life of their own" when you look to the frenzy shows like *Star Trek* and *Seinfeld* have generated.[54]

The courts have not been entirely blind to the problem posed by popular culture works in their idea-expression analyses. Even the district court in *Castle Rock* noted that "defendants have identified a rather creative and original way in which to capitalize upon the development of a 'TV culture' in our society; a culture in which the distinction between fiction and fact is of declining consequence, and in which people are as concerned with the details of the former as the latter."[55] The Second Circuit also acknowledged the melding of fact and fiction alluding to the "real" political discourse between Vice President Quayle and the fictional char-

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52. *See* JENKINS, *supra* note 5, at 18, ("Fans seemingly blur the boundaries between fact and fiction, speaking of characters as if they had an existence apart from their textual manifestations, entering into the realm of the fiction as if it were tangible place they can inhabit and explore...What may make all of this particularly damming is that fans cannot as a group be dismissed as intellectually inferior; they often are highly educated, articulate people who come from the middle classes...."). *See also id.* at 23-24, (discussing how fans become active participants in the construction and circulation of meaning and cease to simply be an audience for popular texts); *id. at* 277-87 (summarizing the nature of fandom and discussing how the nature of fandom challenges media industry's claims to hold copyrights).

53. *See id.* at 279 ("Once television characters enter into a broader circulation, intrude into our living rooms, pervade the fabric of our society, they belong to their audience and not simply to the artists who originated them.").

54. From the day Jerry Seinfeld announced the 1997-1998 television season would be the last, news about the show made lead headlines on television shows, in *People* and other news magazines, and newspapers. "Even the august *New York Times*, judged the newsworthiness of the story by placing it on top of its first page. The next day it followed up the with a long string of just-plain-folks interviews chronicling the reactions of the program's about-to-be bereaved fans and [made it] the lead editorial ... the day after that." Frank Reuven, *After Seinfeld,* THE NEW LEADER, Jan. 26, 1998, at 20.

55. *See Castle Rock I*, 955 F. Supp. at 268.

acter Murphy Brown.[56] These comments reflect an understanding that fiction and reality are not always separable. However, the copyright system continues to preserve this separation; if something is expression, it cannot be used in a popular culture derivative work.[57]

Courts have had difficulty drawing the line between idea and expression.[58] However, instead of protecting less and preserving a greater public domain, these courts have often protected more. *In Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co,*[59] the owners of the James Bond properties filed a copyright infringement suit against Honda. They sought a preliminary injunction to prevent the airing of a Honda del Sol sports car commercial that included "a fast-paced helicopter chase scene featuring a suave [British] hero and an attractive heroine, as well as a menacing and grotesque villain."[60] In their motion for summary judgement, the plaintiffs alleged that the Honda commercial infringed on the James Bond's copyright because it borrowed the *expression* of the character delineated in those films. The court held that ideas of a high-thrill chase, with an ultra cool, charming action hero who likes high-tech gadgetry expressed James Bond's unique character and warranted copyright protection.[61] While James Bond does appear to present a unique case for the protection of a selection and arrangement of common ideas, overprotection of this popular culture work may stifle further creativity.

It may be impossible for the copyright system to adopt an easily applied and appropriate standard to distinguish between idea and expression in popular culture contexts. While the material included in the *SAT*, the *Joy of Trek*, and other fan guide books for television shows clearly owes its origin to an act of authorship, at some point this material should not be protected as expression because of its widespread incorporation into social vocabularies. The public interest goals of encouraging creativity and permitting use of cultural symbols require courts to begin development of criteria to reassess protectable elements of popular culture works. The dif-

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56. *See* supra note 34.

57. Owners of original popular culture works face conflicting incentives—"[t]he owners of popular culture forms, which constitute our most widely shared culture ... are in the contradictory position of encouraging the widespread uses of Batman, Superman, and Snow White. But when those forms are used spontaneously ... the owners want to take them back." *See* Tushnet, *supra* note 45, at 686 n.7 (quoting JANE M. GAINES, CONTESTED CULTURE: THE IMAGE, THE VOICE, AND THE LAW 228 (1991)).

58. *See* Jonathan S. Katz, *Expanded Notions of Copyright Protection: Idea Protection within the Copyright Act,* 77 B.U.L REV. 873, 876 (1997).

59. 900 F. Supp. 1287 (C.D. Cal. 1995).

60. *See id.* at 1291.

61. *See id.* at 1295-97.

ficulty is identifying usable criteria. The first step to developing a workable standard is openness to the possible transformation of protected expression into unprotected idea. The next step might include a consideration of several factors, including how long a work has been available to the public, the degree of measurable popularity, or the amount of intimate incorporation of show's content into social consciousness. However, these factors are difficult to measure. How engrained in the minds of the public does a work have to be in order to be available for use? Should copyright owners automatically give up control over a work's integrity and profit because they have created a popular work? A alternative standard might provide for use of popular culture expression only as an exception to a general rule against permissive use. At some point, it is fair for someone other than the copyright owner to use this new public product for a new creative purpose. However, developing a workable standard to determine the point at which popular expression becomes a public product may continue to prevent the courts from changing their approach to popular culture derivatives.

The *SAT* provides a good illustration of expression that might be reclassified usable material. *Seinfeld* reached the heights of popular culture enthusiasm. Knowledge of Seinfeld's antics not only became regular water cooler fodder but also was appropriated by the public as its own. The creators asked the television audience to embrace the character's lives, profited widely from this embrace, but then asked the court to limit how audience members could further engage in this fictional world. The *SAT* used what was already an intimate part of the viewer's reality.

C. Rethinking the Fair Use Analysis

The Second Circuit's focus on the overall goals of the copyright system was proper. However, the standards applied by the Second Circuit does not provide a satisfactory framework to assess popular culture derivatives. Popular culture derivatives serve the copyright system's basic purpose of enhancing the public domain through the creation and exchange of creative works. In fact, these works represent a flourishing field of creative activity that involves intense interest from people who may not have otherwise participated in creative activity.[62] Fair use analysis must at least allow for the possibility of non-infringing use of fan derivatives of popular culture material.

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62. *See* Tushnet, *supra* note 45, at 655 n.28-29; JENKINS, *supra* note 5 (discussing the scope and breadth of fan activities).

1. Recognizing Transformative Value in Popular Culture Works

The courts' application of the first fair use factor unnecessarily weighs against the granting of derivative rights to artists who use works of popular culture. First, it leads to improper value judgments about what constitutes "criticism, comment, scholarship, or research." Second, it ignores the "transformative" value of derivative works.

In *Castle Rock, Twin Peaks,* and *Paramount Pictures,* the courts acknowledged that popular culture derivative works may lead to unfair subjective judgments about the purpose and character of the use. In fact, these courts caution that such works should be judged equally in an assessment of educational purpose, regardless of their subject matter. Despite this self-awareness of potential prejudice, the Second Circuit failed to find an educational purpose in its review of *Welcome to Twin Peaks* and the *SAT.*[63] It appears that the Second Circuit would have found an educational purpose if the *SAT* had challenged a reader's knowledge of the details of Shakespeare's plots, characters, and themes—but not *Seinfeld's.* The district court in *Castle Rock* correctly set aside cultural bias in finding that the *SAT* had an educational purpose. In order for popular culture derivative works to survive fair use analysis, courts must fairly evaluate a work without elitist notions of suitable subject matter.[64] However, a finding of educational purpose should not automatically weigh the first factor in the infringer's favor. The district court in *Castle Rock* correctly identified the central inquiry of the first factor as an evaluation of the "transformative" nature of the work.

Evaluation of a work's transformative value focuses the analysis on the creative content added to the pre-existing work. The more transformative a work, the more creative content contributed to the public domain. A

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63. *See* Tushnet, *supra* note 45, at 666, ("Any evaluation of productive use must also address the contempt and distaste in which fans are held, especially by the cultural elites.... Indeed, if all popular fiction had to pass judges' tests of worthiness, it is doubtful that more than a small percentage would be found creative.")

64. In Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903), Justice Holmes wrote

> It would be a dangerous undertaking for persons trained only to the law to constitute themselves as the final judges of the worth of pictorial illustrations, outside the narrowest and most obvious limits. At one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which the author spoke ... at the other end, copyright would be denied to pictures which appealed to the public less educated than the judge....

Id. at 251-52.

work is transformative when it adds something new to another work with a further purpose or different character, altering the first with new expression meaning or message.[65] Fan derivatives of popular culture works include varying degrees of creativity from the regurgitation of plots of the first eight episodes of Twin Peak as in *Welcome to Twin Peak*, to the summary of 30 years of Star Trek fictional history in the *Joy of Trek,* to the creation of new stories in web fan fiction.

If the goal of the copyright system is to encourage creative activity, then substantial improvements on previous works, even if they borrow the heart of the pre-existing work, contribute to the overall creative bank. While incentives to create popular culture derivatives do not appear to be a problem, the copyright system does not sanction this creative activity and vigorous enforcement could ultimately eliminate it. Given the importance of and prevalence of works that build on existing works, the fair use defense should be interpreted to allow more improvers to share in the value of the work.

Derivative rights doctrine should begin by focusing on what has been added to the work rather than on what has been taken.[66] Mark Lemley's "radical improver rule"[67] provides a useful framework to balance the relative contributions made by the original copyright owner and the improver. The "radical improver rule" allows copyright doctrine to focus on the value of the new work and its relative contribution.[68] The courts' current approach ends the fair use analysis when a market harm is identified without a relative balancing of harm against added value.[69] If an improver has added substantial value to a pre-existing work, that value should be re-

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65. *See Campbell,* 510 U.S. at 577.

66. *See* Mark Lemley, *The Economics of Improvement in Property Law,* 75 TEX L. REV. 989 (1997). Lemley uses Tom Stoppard's play *Rosencrantz and Guildenstern are Dead* to illustrate the value of shifting focus from what has been taken to what has been added. He notes,

> The entire play focuses on two minor characters from Shakespeare's Hamlet, telling their story (and in the process, telling portions of Hamlet from a different perspective). Hamlet is of course in the public domain ... [but] one can imagine the author of the underlying work wishing to capture the value of Stoppard's work as well, on the theory that it is after all derivative of his masterpiece. Such a copyright claim should fail, not because there is no copying (there is), but because the principal value of Stoppard's play lies not in what he has taken, but in what he has added.

See id. at 1080.

67. *See id.* at 1075-77.

68. *See id.* at 1077.

69. *See id.* at 1075.

warded and weighed favorably against market harm. This test requires careful balancing. If a derivative work adds substantial value but eviscerates a copyright owner's licensing market, then fair use should not be allowed. This rule can apply to both popular culture and non-popular culture derivatives.

Since popular culture derivatives use the "heart" of the pre-existing work, it seems fair to require the addition of a substantial level of creative content to qualify for fair use. Although the copyright owner may lose some value through unlicensed use, the overall system benefits from the addition of substantial creative content and the encouragement of a flourishing field of creative activity. In *Castle Rock*, the district court found that Golub's contribution of levels of difficulty and wrong answers possessed transformative value. The appellate court conflated the educational purpose and transformative analysis to require a transformative educational purpose, such as critical commentary on the show's nothingness. Neither approach helps define the right level of creativity to qualify for fair use. Under a "radical" improver rule, it is unclear whether Golub's creative additions to *Seinfeld* should be considered substantial, even though they do transform *Seinfeld.* While the *SAT* required substantial time and effort to bring together minutiae in a clever format, only the organization, headings, and wrong answers can be counted as new creative content. This type of creativity is probably not enough to justify a limitation on the creator's control over his or her work. A stronger argument can probably be made for a work like the *Joy of Trek*, which contains both traditional and protectable commentary as well as previously unprotectable summaries of fictional histories highlighting and synthesizing material from 30 years of television shows and movies. A stronger argument can also be made for a work of fan fiction that uses a show's characters but creates original plots and dialogue.

2. *Review of "amount and substantiality of the portion used in relation to the copyrighted work as a whole" in the fair use analysis*

If courts continue to apply the substantial similarity finding in the infringement analysis to their consideration of the third fair use factor as the district court did in *Castle Rock*, then the third factor will always weigh heavily against popular culture derivative works. The Second Circuit rejected this rule, focusing instead on whether the derivative work borrowed "more than necessary" in order to serve its suggested purpose. The Second Circuit arrived at the correct standard for derivative popular culture works.

3. *Balancing Market Effect*

The Copyright Act provides copyright owners with monopoly control over their works in order to encourage investment in creativity. However, the full power of this monopoly may not be necessary to encourage investment in the creation of mass appeal products. Television programs and movies are part of a well-functioning market.[70] More permissive fair use of popular culture subjects will not likely limit the creation of the original works, the television series themselves.[71] The success of television shows is dependent on an interested and engaged audience.[72] Derivative works both reflect and feed on audience engagement. The copyright owner may not need as much control to invest in creation. However, an incentive system would be ineffective if the author could not depend on a certain level of return on their investment. There is room to allow *some* popular culture derivative works to exist. The difficult question is how much. What ends up as fair use of a popular show may be limited to very few works because of the effect on incentives. For example, fair use may be limited to works

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70. *See* John Steele Gordon, *What Desi Wrought,* AMERICAN HERITAGE, Dec. 1, 1998, at 20. In 1998, one movie's (*Titanic*) worldwide box office was over a billion dollars. $1.7 billion dollars was paid for the syndication rights to *Seinfeld. See* Joe Schlosser, *The funny money in off-net: Seinfeld leads way as broadcasters and cable pony up and up for high profile sitcoms,* BROADCASTING AND CABLE, Feb. 23, 1998 at 18. The syndication market for network television shows has never been as lucrative. Industry sources say that the price per episode for the broadcast of *Seinfeld* in syndication will shatter financial records surpassing its first cycle price of $3-4 million per episode. There are more buyers and television stations in the market that ever before. Shows are selling at higher prices, earlier in their run to both broadcast and cable networks.

71. Networks stand to reap tremendous potential payoff for developing a successful television series from the advertising revenue and syndication rights alone. *Seinfeld* generated 200 million a year in profits for NBC. The syndication rights sold for $1.7 billion. *See Forever Seinfeld in the absurd sitcom universe created by Jerry Seinfeld (and Larry David), warm fuzzy were banished, and only laughter ruled,* PEOPLE, May 14, 1998, at 8. In addition, one successful TV series can anchor otherwise poor-performing shows to generate revenue. Seinfeld anchored the Thursday night line-up on NBC providing boosts to several shows which would not have commanded as high an advertising price or generated as much revenue. *See* Reuven, *supra* note 54, at 20. Networks will not likely stop vying for this revenue and participating in television production all together if fans are allowed limited use of facts from the show to create a derivative work, like a trivia book.

72. *See* Reuven, *supra* note 54, at 20. Seinfeld's consistent success in the Nielsen ratings (which measure a television's show share of audience), translated into heavy advertising revenue. Commercial success is dependent on fan engagement in the product. Fan interest has also saved shows from cancellation and enabled programs to have commercial success. For example, fan interest in Star Trek brought the show back on the air after NBC cancelled the series. *See* JENKINS, *supra* note 5, at 28.

that test the meaning of phrases like "yada, yada, yada"[73] which once originated in the mouth of a fictional character but now are a part of our social vocabulary. The court's inability to find a workable approach to incorporate this creativity while protecting the copyright owner's rights to derivative markets may be the biggest obstacle to finding that a fan work is fair use.

Copyright reserves all markets for the copyright owner that the copyright owner would in general develop for their work.[74] Fan derivatives are usually thought to fall into an area that the copyright owner could develop. However, a fan work is likely to have a different quality that cannot be reproduced by the original creator.[75] Courts have identified parodies and critical commentaries as fair uses that are better exploited by someone other than the copyright owner. Perhaps a fan is uniquely equipped to feed the demands of other fans in a way the copyright owner can not. One commentator writes, "Fans often see these commercial publications as hackwork lacking the affection, dedication, and rigor fans bring to similar projects. As a result, they supplement rather than displace the amateur guides."[76] Left to their own economic choices, as in the case of *Seinfeld,* the copyright owner may engage in little or no effort to develop derivative markets. Even when more substantial effort has been made, the copyright owner's development of fan materials may not be enough to satiate interest. Although fans have developed these works in spite of copyright's prohibitions, the system should formally accommodate these creative activities.

The copyright owner will no longer be able to totally control the integrity of their work if the system provides for more fair use of popular culture material. Allowing others to appropriate copyrighted material affects

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73. Yada, Yada, Yada is a versatile phrase which means to cut a long story short, which as the advantage of succinctness but the disadvantage that crucial information may be left out. *See Yada, Yada, Yada from Buck Naked to bad naked, from spongeworthy to skiksappeal, Seinfeld thrived on a love of words, words, words,* PEOPLE, May 14, 1998, at 34.

74. *See Campbell,* 510 U.S. at 592.

75. *See* JENKINS, *supra* note 5, at 69-70. ("When professional program guides appear, they lack both the accuracy and detail of the fan versions; such books typically make mistakes such as misnaming minor characters, providing vague or misleading explanations for motivations, and distorting narrative actions and their consequences.") Jenkins also argues that fans should be allowed to appropriate the works. This appropriation allows viewers to remake the works so that the material can better speak to the audience's culture interest and more fully address their desires. *Id.* at 278-79. Fan material becomes a cultural discourse through the collaboration and exchange among the fan communities.

76. *See* JENKINS, *supra* note 5 at 70.

not only the moral protections afforded to copyright owners but the economic power of their works. An unauthorized fan book could get elements of the show wrong or tarnish the show's image. Further, artists who enjoy mainstream popularity may lose control over their expressions simply because they are successful. The implication may be that if your work is poorly received, you will have perfect control; if it is popular, derivative artists will have some liberty to make fair use of it. This loss may be an inevitable risk of production and promotion of popular culture works.[77] The copyright owner's loss of control is a real concern. This concern should be balanced against whether the system would be better served by allowing the work or not. If the potential loss of integrity diminishes the original work's overall value or discourages creation of the original work, then that loss should also be measured against the creative contribution of the derivative work. If the total creative value available to the public is increased without substantial injury to the original creator, then fair use should be permitted.

Works based on popular television programs that are published and sold in the marketplace can understandably be characterized as a profit-motivated use of copyrighted material. They appear to entertain and are derived from commercially successful originals. They are sometimes sold for profit. However, fan works, even if sold for profit, can be created for non-monetary reasons.[78] For example, in *Paramount Pictures,* the district court acknowledged that Ramer, the *Joy of Trek's* author, appeared genuinely motivated by a desire to educate people about Star Trek.[79] Other fan

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77. *See* Tushnet, *supra* note 45, at 686 n.7 (quoting JANE M. GAINES, CONTESTED CULTURE: THE IMAGE, THE VOICE, AND THE LAW 228 (1991)) ("The owners of popular culture forms, which constitute our most widely shared culture...are in the contradictory position of encouraging the widespread uses of Batman, Superman, and Snow White. But when those forms are used spontaneously...the owners want to take them back."); Rochelle Dreyfuss, *We are Symbols and Inhabit Symbols, So should we be paying rent? Deconstructing the Lanham Act and rights of publicity,* 20 COLUM.-V.L.A.J.L. & ARTS 123 (1996). The law has increasingly privatized more and more of our culture's symbolic resources out of the public domain. Dreyfuss warns against the trend of the court's affirmation of private ownership of cultural symbols. *Id.* at 129. The purveyor of the image should not be able to capture the entire value of an image. The audience should also be able to benefit from a cultural symbol because the audience often provides an image the strength of its meaning. *Id.* at 140-42.

78. *See* JENKINS, *supra* note 5, at 154-56, 162-177. "Almost as striking is how writing becomes a social activity for these fans, functioning simultaneously as a form of personal expression and as a source of collective identity...." *Id.* at 154. Jenkins describes numerous ways and reasons why fans appropriate material. *Id.* at 162-77.

79. In addition, "[w]hile The Joy of Trek's publishers undoubtedly hope to realize a profit, this fact is not dispositive as many traditional educational publishers, whose prod-

derivatives like web fan fiction are typically completely non-commercial and probably motivated by a love of the show. Courts have interpreted the effect on potential markets generously, denying a finding of fair use for any impact on a market the copyright owner might develop.[80] With the current application of this factor, fair use of popular culture works can not be granted. The analysis should be changed to allow for the possibility of fair use.

The market effect factor should be decided in favor of a derivative artist if a finding of fair use best serves the goals of the copyright system. A derivative work that adds substantial creative content to the pre-existing work serves the public interest. The value of the additional creative content should be measured against the influence the market loss will have on copyright owner's willingness to invest in creation. The comparison should not simply begin and end with the identification of market effect. All market effects should not be equated with a significant decline in the initial copyright owner's investment in creative activity. Given the level of creative interest in this field and the social significance of allowing the audience to use their own cultural vocabulary, fair use analysis should permit a finding of fair use, even if it is only available in select cases.

IV. CONCLUSION

Copyright owners of television show send their fictional worlds and characters into our homes every week and ask us to embrace them, to make them an indispensable part of our lives. However, the copyright system imposes arbitrary limits on what the audience can do with these fictional worlds. Popular culture derivatives provide a flourishing field of creative activity. To serve the overall goals of the system, the copyright law should welcome this creativity. If the courts continue to apply traditional infringement and fair use analysis to popular culture derivative works, a good deal of creative expression will be shut down without appropriate consideration. Derivative artists will not have an outlet for their own expression.

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ucts are often deemed to be fair use, are profit motivated." *See Paramount Pictures,* 1998 WL 357337, at *5.

80. *See American Geophysical Union v. Texaco Inc.,* 60 F.3d 913, 930-31 (2d Cir. 1995) (reserving derivative markets for the copyright owner that are traditional, reasonable or likely to be developed).