Sherlock Holmes and the case of the public domain

Mark Litwak is a veteran entertainment attorney and producer's rep based in Beverly Hills. He is the author of six books including: "Reel Power: The Struggle for Influence and Success in the New Hollywood"; "Dealmaking in the Film and Television Industry"; "Contracts for the Film and Television Industry"; and "Risky Business: Financing and Distributing Independent Film." He is an adjunct professor at the USC Gould School of Law and is the creator of Entertainment Law Resources at www.marklitwak.com. He can be reached at law2@marklitwak.com.

In a suit filed recently in federal court in Chicago[1], a top Sherlock Holmes scholar alleged that many licensing fees paid to the Arthur Conan Doyle estate have been unnecessary, since the main characters and elements of their story derive from materials in the public domain. The suit was brought by Leslie S. Klinger,Â the editor of the 3,000-page "Annotated Sherlock Holmes" and other Sherlock Holmes-related books. It stems from his book "In the Company of Sherlock Holmes," a collection of new Sherlock Holmes stories by various authors, edited by Klinger and his co-editor Laurie King to be published by Pegasus Books.

Doyle created Sherlock Holmes, and published most of his stories from 1887 to 1927. Because some of Doyle's stories were published in periodicals as late as 1927, they may be within the protection of U.S. copyright laws. Works published before 1923 are most likely in the public domain, at least under U.S. law. For those stories published after Jan. 1, 1923, they could remain protected until 2023.

According to the lawsuit, all the Sherlock Holmes stories entered the public domain under the laws of the U.K. and Canada in 1980. However, with the passage of the U. S. Copyright Act of 1976 the author of a work that had passed into the public domain in the U.S., or his heirs, were entitled to restore the work to copyright under certain conditions. In 1981, Dame Jean Conan Doyle, the last surviving child of Sir Arthur Conan Doyle, applied for registration of the copyright to "The Case-Book of Sherlock Holmes," a collection of stories. This work is comprised of 12 stories that were first published in various periodicals between 1921 and 1927, and the collection was first published as a book in the U.S. in 1927.

The complaint asserts thatÂ the Doyle estate sent a letter to Pegasus Books threatening to prevent publication of "In the Company of Sherlock Holmes" unless it was paid a license fee. Kingler's prior publisher, Random House, had reluctantly paid $5,000 fee for an earlier Klinger collection he edited, titled "A Study in Sherlock," even though Klinger believed he was not legally required to do so. The suit asks the court to make a declaratory judgment, establishing that the basic "Sherlock Holmes story elements" are in the public domain under U.S copyright law. Klinger claims that the stories in his new collection avoided drawing on copyrighted elements introduced in any of the Holmes stories published after Jan. 1, 1923.

In a 2004 decision, a U.S District court judge Naomi Reice Buchwald determined that of Doyle's 60 Sherlock Holmes stories, nine might still be under copyright.[2] Although the character of Sherlock Holmes is in the public domain, various storylines,

SPECIAL REPORT
20 Under 40

Monday, March 4, 2013

Intellectual Property
Judge slices Apple's patent infringement award almost in half
A federal judge cut Apple Inc.'s patent infringement award nearly in half Friday, ruling that jurors had miscalculated damages by applying a theory the court had already ruled "legally impermissible."

Litigation
Lawyers vie for lead counsel role in HP-Autonomy class actions
A line of lawyers vied Friday for a leading role in the many actions filed against Hewlett-Packard Co. and its executives for the alleged botched acquisition of Autonomy that caused an $8.8 billion mark down last fall.

Environmental
Circuit says no to farmers' plea for water
Central Valley farmers hoping to force the federal government to give them more water got nowhere with a federal appellate court Friday, when it roundly rejected their bid.

Litigation
On The Move
Sheppard Mullin adds attorneys in San Francisco and Los Angeles

Bar Associations
State Bar board will debate charging lawyers to support legal services programs
The State Bar is likely this week to decide to seek legislation that would impose a surcharge on lawyer dues to bolster funding for struggling legal aid programs.

Judges and Judiciary
Report finds judicial nominee pool less diverse
An annual report indicates that the judicial nominee pool was slightly less diverse in 2012 than in the previous year.

Litigation
Judge: Lawyer can't use Cochran name

dialogue and characters that first appeared in these nine stories could be protected under U.S. copyright law. A copyright for a derivative work based on a prior work does not create copyright protection retroactively for the underlying work but can protect new material that has been added.

Works published before 1923 are most likely in the public domain, at least under U.S. law. For those stories published after Jan. 1, 1923, they could remain protected until 2023.

Sherlock Holmes continues to be an enormously popular character, even though he is 125 years old. He was recently featured in two Warner Brother films, the BBC's "Sherlock," and the television series "Elementary." The most recent Warner Brothers film, "Sherlock Holmes: A Game of Shadows," starring Robert Downey Jr., had an international box office gross of $543 million from distribution in more than 50 countries.

The case raises the issue of which elements of the Sherlock Holmes stories are in the public domain, and which may remain under the protection of copyright law. Copyright can sometimes, but not always, protect characters and plot. Recognition of copyright protection for fictional characters goes back to Judge Learned Hand, who suggested that characters might be protected, independent from the plot of a story. He wrote "It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for making them too indistinct." So, while a writer cannot secure a monopoly on hard-boiled private eyes, one could protect a finely drawn character like Sam Spade.

While plots can be protected, stock scenes cannot. The doctrine of scÃ¨nes Ã faire excludes from copyright protection scenes that flow from common unprotectable ideas. These would include "thematic concepts or scenes which necessarily follow certain similar plot situations" and ordinary literary incidents and settings which are customary for the genre. Thus, a writer cannot preclude others from using such common devices as a car chase or cattle drive in their stories.

The situation becomes even murkier when one considers that the Sherlock Holmes stories are subject to a confusing web of differing copyright laws across the globe. Copyright law is applied territorially by every country within its borders. Thus, the duration of copyright protection differs from country to country. Each country enforces its own laws, irrespective of the nationality of the author, or where the work was created or first published. The U.S. has joined several international copyright conventions to protect American works from infringement abroad. These accords essentially provide for reciprocity of treatment for authors.

For example, France protects the works of American authors in France. In return, the U.S. protects the work of French authors in the U.S. This means that the U.S. will protect a French author in the U.S. in the same manner and extent as the U.S. protects American authors. It does not mean that French authors will have the same rights that they have in France under French law. This can produce unexpected results, for example, because U.S. law focuses on economic rights while French law protects creative rights.

U.S. law recognizes the work-for-hire doctrine under which the "author" of a work can be the employer of an artist, not the artist himself. Few countries recognize this doctrine. On the other hand, some countries have doctrines that do not exist under U.S. law. France expressly recognizes the moral rights ("droit moral") of authors. U.S. copyright law only recognizes moral rights in the realm of fine art. Moral rights prevent others from changing the author's work (the right of integrity), or removing the author's name from the work (the right of paternity), even if the author has sold the work and the copyright to it.

Under French law, the rights of integrity and paternity are perpetual, inheritable, inalienable and imprescriptible. Thus, the heirs of an artist can object to the use of their ancestor's work, even if that work's copyright has expired.

In *Huston v. Turner Entertainment*[3], the late American director John Huston was determined by a French court to be the author of the American film "The Asphalt Jungle." Under U.S. law, Huston's employer was the author or owner. When TurnerÂ Entertainment, which had acquired the film, sought to distribute a colorized version of it in France, Huston'sÂ heirs initiated an action in the French Courts under

U.S. District Judge S. James Otero issued the injunction order against Randy H. McMurray.

Case involving federal pleading standards could be headed to high court
A significant split over federal pleading standards and a highly unusual amended opinion in a 9th U.S. Circuit Court of Appeals civil rights case has some lawyers predicting the litigation could make it to the U.S. Supreme Court.

Criminal
Defendant in massive tax fraud case gets home detention
One of the biggest players in a massive government tax fraud suit against members of an Hasidic sect was back in a Central District courtroom Friday to be sentenced for violating the terms of his parole by refusing to testify before a gr

Perspective
The enduring legacy of California's Premier Justice Stanley Mosk
But first a caveat: In this, my 210th column, you will be exposed to bursts of effusive praise for one of California's and the country's premier jurists, Stanley Mosk. By **Arthur Gilbert**

Intellectual Property
Sherlock Holmes and the case of the public domain
Arthur Conan Doyle published most of his Sherlock Holmes stories from 1887 to 1927. Works published before 1923 are likely in the public domain, but those published after Jan 1, 1923, could remain protected until 2023. By **Mark Litwak**

Litigation
Antitrust standing vs. patent standing
ScanDisk leaves no doubt that the standing required to bring an antitrust claim based on the fraudulent procurement of a patent, and the standing required to invalidate a patent, are two different things. By **Audrey Millemann**

Law Practice
Art imitates life: meet the 'First Lady of Law'
Mabel Walter Willebrandt was far ahead of her time working as a federal prosecutor during prohibition. By **Ira Friedman and David Friedman**

Judges and Judiciary
Cashing in our constitutional rights: a jury of our peers
A group of state judges wants to convince us to sell off one of our cherished constitutional protections for a pittance: a trial by a jury of our peers. By **Jeff Adachi**

Judicial Profile
Maureen A. Folan

the French moral rights law, seeking an injunction and damages.

The French Supreme Court ruled that the transformation of the work from a black and white film to a colorized version was a breach of Huston's moral rights, even though these rights were not recognized in the U.S. It did not matter that Huston was a U.S. citizen directing a movie for a U.S. company (MGM), which was shot on the MGM lot in Los Angeles. Moreover, the contract with Huston granted MGM all rights, and provided that American law would govern any dispute. France's highest court found for Huston's heirs on the grounds that French moral rights laws may not be violated in France regardless of the terms of a contract made elsewhere. The court held that it was against public policy to permit foreign law or foreign contracts to change the French system of moral rights. Ultimately, the French courts entered judgment againstÂ the defendants, and prohibited distribution of the colorized film in France.

So, while Sherlock Holmes is a brilliant detective, even he may find it difficult to sort out the conflicting copyright laws of different nations.

[1] *Klinger v. Conan Doyle Estate, Ltd.*, 1:13- cv-01226 (N.D. Ill., filed Feb. 14, 2013).

[2] *Pannonia Farms, Inc., v USA Cable*, 2004 U.S. Dist. LEXIS 23015.

[3] *Huston v. Turner Entertainment* (French Court de Cassation, 1991).

Mark Litwak *is a veteran entertainment attorney and producer's rep based in Beverly Hills. He is the author of six books including: "Reel Power: The Struggle for Influence and Success in the New Hollywood"; "Dealmaking in the Film and Television Industry"; "Contracts for the Film and Television Industry"; and "Risky Business: Financing and Distributing Independent Film." He is an adjunct professor at the USC Gould School of Law and is the creator of Entertainment Law Resources at www.marklitwak.com. He can be reached at law2@marklitwak.com.*

Previous **Next**

Superior Court Judge Santa Clara County (San Jose)

Corporate Counsel
Michael Reagan
General Counsel and Executive Vice President for Kahala Franchising LLC Scottsdale, Ariz.

Litigation
ABA committee seeks to lure accomplished Bay Area antitrust plaintiffs' bar
A defense attorney from Washington, D.C. and two plaintiffs' attorneys are attempting something historically difficult: enticing the powerhouse Bay Area antitrust plaintiffs bar to become active participants in the American Bar Association.