

## Unauthorised Sequels

“Catcher in the Rye” was written by American author J.D. Salinger in 1951.

The book has since become a huge critical and commercial success and is now considered to be a classic work of mid-20th century literature. The book’s main character, through whom the story is told, is one Holden Caulfield – a 16 year old newly minted private boarding school drop out who embarks on 4 days wandering around New York – a journey of self-discovery, reflections and interactions with an array of characters and New York landmarks including the Natural History Museum and Central Park.



The book is written with a fresh literary “look and feel” – with unique turns of phrase, descriptions and dialogue.

Fast forward to the present day...an American author living in Sweden named Fredrick Colting (writing under the name John David California) wrote a sequel of sorts to Salinger’s famous and celebrated novel, “Catcher in the Rye”. The sequel, called “60 Years Later: Coming Through the Rye” portrays a 76 year old Holden Caulfield (referred to as “Mr C”) – the famed protagonist of the original work – wandering the streets of New York after having escaped from a retirement home.

Salinger, who is now 90 years old and living in recluse, was reportedly outraged that the book “60 Years Later: Coming through the Rye” brazenly stole, without Salinger’s permission, Salinger’s exact same character Holden Caulfield (along with a host of other characters from that original book) and placed them in the same location New York and used similar turns of phrase, descriptions and dialogue as in the original “Catcher in the Rye”.

Indeed, Salinger was so concerned that his rights had been trampled on that he brought a law suit against Fredrick Colting and his publisher alleging claims for Copyright Infringement and common law Unfair Competition.

The case raises a host of issues including:

1. Whether or not characters in books, films or even music lyrics attract the protection of copyright law;
2. If such characters do attract copyright protection, in what circumstances will the “fair use” exceptions to infringement of copyright – such as parody or criticism and review – apply;
3. When is a work simply derivative of an original work (and therefore more likely to breach copyright) and when is a work transformative of that original work (and therefore less likely to be in breach);
4. How does all this fit into the ideas/expression dichotomy that is the cornerstone of copyright law.
5. Also, how does the overriding imperative of Freedom of Expression – especially in the context of the US Constitution – affect these issues;
6. Can an author or publisher use the misleading and deceptive conduct sections of Part V of the Trade Practices Act (and the mirror fair trading legislation in the States and Territories) or invoke the common law action of passing off to stop an unauthorised sequel.
7. Also, can an author rely on his or her moral rights in their original work to prevent an unauthorised copy;

## J.D. SALINGER v FREDRIK COLTING ET AL

But first, I want to turn to Salinger's law suit against Fredrik Colting and his publisher regarding the contested unauthorised sequel "60 Years Later: Coming Through the Rye".

### What were the basic arguments of each side.

Both sides acknowledged and agreed that (a) Salinger holds a valid copyright in the book "Catcher in the Rye" and (b) that Colting had access to that book.

So the first issue that the Judge Deborah A. Batts sought to determine was whether or not there is a substantial similarity between the two books.

Salinger's lawyer submitted that there were two prongs to the substantial similarity question because Salinger was pleading two separate claims for copyright infringement. One is of the character Holden Caulfield. The second is of the book "The Catcher in the Rye".

As to the first claim, Salinger's lawyer said it was beyond doubt that the character Mr C in "60 Years Later" is Holden Caulfield from "Catcher in the Rye". The question was whether the iconic character Holden Caulfield was protectable under copyright. It was submitted by Salinger's lawyer that Holden Caulfield was a sufficiently delineated character to be protected under copyright law. This was despite there being only a literary description of Holden Caulfield, as opposed to a graphic representation. This was also despite the character Holden Caulfield only appearing in one work.

Regarding the second claim of substantial similarity between the two books themselves, Salinger's lawyer argued that there was not merely substantial similarity by virtue of the taking of the character, but there were numerous other elements the "60 Years Later" copied including other characters, an attempt to imitate the narrative and the tone, the style and the settings (including Central Park, the cemetery and the Museum of Natural History). It was argued that the court should go beyond looking at the fragmented literal similarities and look at the total concept and feel of the two works.

Fredrik Colting's lawyer argued that the character of Holden Caulfield as published initially is not sufficiently developed and delineated to attract copyright protection. In any event, Colting's lawyer contended that even if Holden Caulfield attracted copyright protection (which he disputed) he did not believe there was the taking of sufficient amounts of Holden Caulfield to constitute copyright infringement.

As to the question of breach of copyright in "Catcher in the Rye" itself, Colting's lawyer submitted that no expression was taken from that book and used in "60 Years Later" i.e. there was no direct copying of the text and that "60 Years Later" has 80 characters in it, only really three of which are from "Catcher in the Rye". There are 25 characters in "Catcher in the Rye" that do not appear in "60 Years Later". So there was no substantial similarity between the two books themselves.

The next issue to be looked at was whether, if "60 Years Later" did substantially copy the character Holden Caulfield and the book "Catcher in the Rye, whether that use was "fair use".

Colting's lawyer asserted that "60 Years Later" was written as critical commentary on the relationship between J.D. Salinger and the character he created, namely Holden Caulfield. "60 Years Later" was an unauthorised fictional examination of the relationship between J.D Salinger and his most famous character – and that the cover of the book (both back and front) will make that clear. It's not a sequel.

Colting's lawyer contended that "60 Years Later" is commentary on the original work because the original work has become an iconic representation of a disaffected youth who has certain characteristics, "60 Years Later" is an analysis of the creation, the creator of that work (i.e. Salinger) and what happens to that character many, many years later when we see the character having lived his whole life. You start to have more understanding about what the character was and what the original book was and it changes your reading of the original work. In short "60 Years Later" is literary criticism in a fictional form.

Colting's council then raised the issue of the danger of granting an injunction in a copyright case - i.e. a prior restraint against the publication of a book before a full hearing, before a full exploration of all the issues - noting that the United States Supreme Court has expressed its concern about injunctions in copyright cases and that where there is a colourable fair use defence, that a remedy of an injunction is an extraordinary remedy. A prior restraint, it was argued, would raise very serious First Amendment issues.

In response to this, Salinger's lawyer argued that "60 Years Later" was a sequel - pure and simple - and that the only question for the court to determine was whether that sequel was transformative or substantially similar to the original book. It was contended that "transformative" means: to take an original work and to somehow imbue it with new meaning, message or purpose, to provide something more for the public.

It was submitted that the only way that Colting had transformed the Holden Caulfield character was to make him 76 years old instead of 16 and the only way that Colting had transformed "Catcher in the Rye" was by adding some characters.

Furthermore, it was submitted that "60 Years Later" did not constitute literary criticism or parody.

In essence, Salinger's lawyer asserted that this was a case about Salinger's right not to have a sequel published, not to authorise a derivative work. i.e. it was a case about Salinger's right to keep "Catcher in the Rye" and Holden Caulfield frozen in time for the full term of copyright.

## Decision of Judge Deborah Batts in the United States District Court

So they were the basic arguments used by each side with respect to Salinger's legal action in the District Court for a preliminary injunction preventing Colting and his publisher from publishing, advertising or otherwise distributing "60 Years Later" in the United States during the pendency of that suit.

Judge Deborah Batts granted Salinger the preliminary injunction essentially for the reason's that Salinger had argued for one.

In determining that there was a "substantial similarity" between the two books as well as between the character Holden Caulfield from "Catcher in the Rye" and the character Mr C from "60 Years Later" such that it was an unauthorised infringement of Salinger's copyright, the court cited *The Wind Done Gone* case (Suntrust Bank v Houghton Mifflin Company 268 F. 3d 1257, 1266 (11th Circuit, 2001) where it was found that "substantial similarity" exists where "an average lay observer would recognise the alleged copy as having been appropriated fro the copyrighted work". The court also cited the case of *Castle Rock Entertainment v Carol Publishing Group* 150 f. 3d 132, 137 (2nd Circuit, 1998) where it was found that under the "ordinary observer" test, two works are substantially similar where the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard the aesthetic appeal of the two works as the same.

The District Court then addressed Colting and his publisher's claim that their novel "60 Years Later" and its protagonist Mr C constitute fair use of Salinger's copyrighted work.

Again citing *The Wind Done Gone* case, the court noted that at the constitutional level, while the “Copyright Clause and the First Amendment [are] intuitively in conflict, [they] were drafted to work together to prevent censorship” such that “the balance between the first Amendment and copyright is preserved, in part, by the idea/expression dichotomy and the doctrine of fair use”.

In the United States, the doctrine of fair use was codified in section 107 of the 1976 Copyright Act, which called for a four-factor test:

1. the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit 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 copyrighted work.

Applying this four factor analysis to “60 Years Later” the court found as follows:

Firstly, if the purpose or character of the use – be it for criticism, or comment, or news reporting or parody – is transformative (as opposed to merely repackaging and free riding on another’s creation) then there is a strong chance that such use is fair use.

However, the court found that “60 Years Later” contained no reasonably perceived parodic character as to “Catcher in the Rye” and Holden Caulfield – mainly because “60 Years Later” simply rehashed the character attributes of Holden Caulfield – but as an old man.

The court found that the addition of Salinger as a character in “60 Years Later” is indeed novel, but commentary and criticism of Salinger in “60 Years Later” did not amount to the required critique or commentary of “catcher in the Rye” itself or the original Holden Caulfield.

In applying this first factor of the four-factor fair use test, it was not contested that “60 Years Later” was to be sold for profit so was of a commercial nature, and therefore this prong of the first factor weighed against a finding of fair use.

Secondly, looking at the nature of the copyrighted work. The court found that the novel “Catcher in the Rye” is a creative expression for public dissemination that falls within the core of the copyright’s protective purposes” – so this factor also weighed against a finding of fair use.

Thirdly, looking at the amount and substantiality of the portion used in relation to the copyrighted work as whole, the court found that the ratio of the “borrowed to the new elements” in “60 Years Later” is unnecessarily high for any fair use purpose. In addition to Holden Caulfield as the protagonist, “60 Years Later” depends upon similar and sometimes identical supporting characters, settings, tone, and plot devices to create a narrative that largely mirrors that of “Catcher in the Rye”.

Fourthly, looking at the effect of the use upon the potential market for or value of the copyrighted work. The court found that “60 Years Later” could substantially harm the market for a “Catcher” sequel – both because it could cause confusion in the market as to which was the true sequel or companion to “Catcher” or simply because of reduced novelty or press coverage. That would remain true even if, as would undoubtedly be the case, significant residual interest in a Salinger-authored sequel would still remain. So this fourth factor also weighed against a finding of fair use.

The court weighed up these four factors in the aggregate and concluded that because Salinger had established a prima facie case of copyright infringement, irreparable harm from that infringement is presumed – so the court preliminarily enjoined Colting and his publisher from manufacturing, promoting, selling, or otherwise disseminating any copy of “60 Years Later” in or to the United States.

## Appeal of decision

Lawyers for Fredrik Colting and his distributor filed an appeal on 23 July with the Second Circuit Court of Appeals arguing that the injunction barring publication of Colting’s “60 Years Later: Coming Through the Rye” is an “impermissible prior restraint and an unwarranted extension” of copyright protection.

## AMICI Curiae briefs

An Amici Curiae brief filed by a group of major library associations asserted a public interest in overturning the injunction relating to the First Amendment. The brief noted that “Prior restraints are strongly disfavoured precisely because they have the potential to cause grave damage to free speech rights”. Indeed, Colting’s book may be an infringement, the brief concedes, but “the question of whether to ban publication pending that determination demands a more careful balancing of the important interests at stake.

An Amici Curiae brief by filed by a group of major media organisations including the New York Times Company also contended that the injunction which enforced the prior restraint should not have been granted but that the case should have proceeded to full trial, noting that the First Amendment right to free expression should never be trumped by a prior restraint in cases of copyright law where the alleged infringer has a bona fide fair use defence argument.

Public watchdog group Public Citizen Amici Curiae brief agreed with this free speech argument against the injunction, but that brief went further in that it directly attacked District Court’s copyright ruling.

Public Citizen’s Amici Curiae brief essentially attacked the copyright ruling of the District Court for two main reasons.

Firstly, the District court’s conclusion that Salinger holds a copyright in the character Holden Caulfield wholly apart from the fixed expression of the novel itself – a general right to prevent others from conjuring up readers’ memories of his iconic character – not only runs afoul of the purposes and constitutional limits on copyright but is foreclosed by the Copyright Act itself.

Purely literary characters, as opposed to graphically depicted characters, like other non-tangible, concepts found within a literary work, are not independently copyrightable. This is reflected in the longstanding practice of the United States Copyright Office, which refuses to register literary characters.

Public Citizen’s Amici Curiae brief submitted that it follows that because Salinger did not – and could not – register a copyright in Holden Caulfield (as opposed to the book itself) he may not sue Colting for infringement of the character.

Furthermore, neither the Supreme Court nor the District Court has ever accorded per se copyright protection to a literary character.

Public Citizen’s brief conceded that the fact that fictional characters are not copyrightable does not mean that the Copyright Act permits the wholesale piracy of characters in copyrighted works – particularly where the expression of those characters is fixed in graphical form or in film.

But the brief emphasised that extending copyright to characters would prove unworkable because “characterisation” is a mental impression formed from a character’s appearance, thoughts, words, or actions, and is therefore inherently subjective.

The other reason why the Public Citizen brief attacked the copyright ruling of the District Court is because such ruling was incompatible with copyright’s ideas/expression dichotomy.

The brief argues that the District Court’s infringement analysis was contaminated by its failure to identify the copyrighted work at issue. The court’s erroneous conclusion that characters could be independently copyrighted led it to perform a simplistic comparison of the similarities between the “idea” of Holden Caulfield in the two books, rather than the similarities and differences between the “expression” in the works as a whole.

The Public Citizen brief contended that the only copyright at issue in this case is Salinger’s copyright in his fixed work of creative expression, “The Catcher in the Rye”. As a consequence of Salinger’s copyright, a publisher ordinarily could not reproduce literal copies or substantial portions of the novel without Salinger’s permission. Nor could a publisher bypass Salinger’s copyright by issuing the same book using slightly different language. To prevent such obvious circumvention, the copyright is infringed if the “total concept and feel, theme, characters, plot, sequence, pace and setting” of the works as a whole are substantially similar and there is no finding of fair use or another defence, citing *Castle Rock Entertainment v Carol Publishing Group*.

So unlike the fair use defence, the idea/expression distinction prevents copyright from extending to the suppression of literary imagination in the first place. Ideas (along with theories and facts) will always remain in the public domain. That ability to “build freely upon the ideas” in others’ work is essential to First Amendment protection because even the most creative or artistic actively work depends on the ability to borrow from what has gone before.

## Where the case is up to

A three-judge panel of the US Second Circuit Court of Appeals heard arguments in early September against the injunction. Despite a negative review of Colting’s book by one of the judges, Guido Calabresi, who called the effort a “dismal piece of work”, the judges’ questions suggested that the court was leaning toward giving Colting a second look in court.

## Other examples

Of course there are numerous other examples in literature where character appropriation through the writing of sequels, prequels or re-writings of literary work has occurred.

In some of these examples, copyright has already expired, for example, in her Pulitzer prize-winning novel, “March”, the Australian author Geraldine Brooks “appropriates” the father from Louisa May Alcott’s classic novel “Little Women”, and imagines his story in her new fictional setting.

Another noted example is Jean Rhys’s “Wide Saragasso Sea” an acclaimed novel that rewrites “Jane Eyre” from the perspective of Bertha, the mad woman in the attic.

Where copyright has expired on the original work, there is no legal controversy.

However, other examples where copyright still subsists in the original work, disputes have arisen.

For example, one Alice Randall wrote a book called “The Wind Done Gone, which presents a slave’s view of the fictional world of Margaret Mitchell’s “Gone With the Wind”. The unauthorised sequel is celebrated not only for its subversive critique of the Deep South during the civil war era, but also for its significance in copyright law. A Federal District court initially enjoined its publication, but the Eleventh Circuit (in *Suntrust Bank v Houghton Mifflin*) reversed the injunction by awkwardly cramming Randall’s work into the category of “parody” – even though the book wasn’t parodic and the target of the criticism was less Mitchell’s work than the nature of American slavery, literary voice and cultural construction.

## Australian Law

This all raises the question as to whether there is any basis under Australian copyright law or other laws, to allow an author of an original work of fiction to restrain such a book being re-written, for example, in a different time or place but with the same character or characters, or simply restrain a character being recycled in another work.

Where and how does the law balance the rights of the author to maintain control over their fictional characters and the rights of other writers to create new works using those characters and therefore contribute to the overall literary culture for the public to enjoy. Or if existing characters are cordoned off, will the so-called fan author be forced to devise their own characters, thereby enlarging the literary catalogue.

And this also raises the question of the need to give authors the economic incentive to create their fictional works in the first place by according those authors copyright in their works – not only enabling the author to prevent the direct verbatim copying of the text of their works, but also the right to write a sequel or prequel, and the right to adapt the work into another medium such as a film.

As discussed earlier, the issue of character appropriation also highlights the ideas/expression dichotomy. While there is no copyright in broad-brush generic characters such as star-crossed lovers or evil villains, at what point (if any) – moving along the continuum – do characters become so well defined and originally crafted that they should attract copyright protection.

It is fair to say that under Australian copyright law, “characters” do not receive separate discrete copyright protection. A literary, non-graphic character can only be a literary work in itself, or a component of a literary work.

Nevertheless, it may be argued that if a new author takes a pre-existing character’s name, described appearance, personal traits and borrows (or is that steals) from the original character development, reviewing the character’s history and even refers to earlier important plot incidents which shaped the character – it may be argued that if all of those things appear in a sequel, then the author of that sequel has taken a “substantial part” of the original work by appropriating the character pursuant to section 14 (1) (a) of the Australian Copyright Act.

As we know, when assessing whether a “substantial part” of an original work has been appropriated, courts in Australia will look at the quality or “value” of what has been taken much more so than the quantity of what has been taken.

The test that is often cited is Justice Peterson’s in *University of London Press Ltd v University Tutorial* “rough practical test” – namely, what is worth copying is prima facie worth protecting”.

But a character can never really be copied in the same way that copying text verbatim can be. A character can only be re-crafted by the appropriator, who must choose their own collection of words to regenerate the character.

A test which Australian courts would seem likely to adopt was outlined in *Zeccola v Universal City Studios* where

Justice Gray said (at first instance) that the question of substantial similarity “ultimately comes down to the subjective impression of the judge who makes the comparison” between the original work and the appropriated work.

But the possible danger of that test is that judges then become literary and artistic critics, which is probably not what judges are employed to do

## Defences to infringement

If it can be established that a literary work has been substantially reproduced (or communicated to the public) by the appropriation of a character, the next issue that arises is whether any defences are available to the infringer.

Under the Australian Copyright Act, possible defences would be:

Fair dealing for the purpose of “criticism and review” where acknowledgement of the work is given. However, this defence would be limited because most examples of character appropriation and fan fiction lack a “critical edge”. And it must be stressed that it would not be sufficient for the sequel to criticise or review some aspect of society at large as represented in the original work – section 41 makes it clear that any later work such as a sequel would need to “criticise” or “review” the former work itself (or some other work).

Another possible defence would be fair dealing for the purpose of parody or satire. But in many cases of character appropriation, there will not be an element of parody or satire. And this raises the question, which I don’t have time to explore now, into why non-parodic character appropriations should be excluded from the fair dealing exception, while parodic appropriations are included. Who is to say that such appropriations are not equally valuable to society.

## Other breaches of the law

It also needs to be pointed out that unauthorised sequels may fall foul of other areas of the law.

### Trade Practices Act

These include “misleading and deceptive conduct” under section 52 of the Trade Practices Act 1974 (Cth) and its State-based equivalent Fair Trading Acts. Also, under section 53 (d) of the Trade Practices Act, a corporation (which would be the publisher) shall not represent that it has a sponsorship, approval or affiliation it does not have.

There is also the common law action of passing off.

By writing and publishing an unauthorised sequel, the writer and the publisher are misleading and deceiving the public into thinking that the author and the publisher had express permission to do so by the original writer and the original publisher, when no such permission was given.

Even if a disclaimer is emblazoned on the cover of the unauthorised sequel, this may only serve to highlight an affiliation between the unauthorised sequel and the original book.

### Moral Rights

It could also be argued that the unauthorised sequel breaches the moral rights of the original author.

Under section 195AI (2) of the Australian Copyright Act, the author has a “right of integrity” not to have their work (or a substantial part of it) subjected to a “derogatory” treatment.

Section 195AJ defines derogatory treatment as doing anything in relation to the work that is “prejudicial to the author’s honour and reputation”.

An example may be the use of the Harry Potter character in a pornographic context.

Another example might be if Fredrik Colting’s unauthorised sequel to “Catcher in the Rye” portrayed Holden Caulfield as a drug dealer who ran a child prostitution ring. Would such a derogatory treatment of “Catcher in the Rye” prejudice Salinger’s honour and reputation? Or, looking at it another way, would such a treatment render the new work to be “transformative” such that it would not be a “substantial reproduction” of the original work?

But it is unlikely that in a more typical case of character appropriation that the author would be able to successfully argue that his or her original work has been subjected to derogatory treatment – although I don’t believe that this has been tested in an Australian court to date.

## Conclusion

Perhaps I’ll leave the last word to Holden Caulfield himself. While Holden Caulfield was trying to think of a profession that he would enjoy, he concluded that although “lawyers are alright” he would not want to be one because “even if you did go around saving guys’ lives...how would you know you weren’t being a phoney? The trouble is, you wouldn’t”.

That’s a wise observation indeed from a mere fictional character!!!

And if we imagine that Holden Caulfield – in trying to think of a profession that he would enjoy – thought about becoming a writer of unauthorised sequels – he might have concluded that although writers of unauthorised sequels “are alright”, he would not want to be one “because how would you know you weren’t be a phoney? The trouble is, you wouldn’t.”

**Shaun Miller – Partner, Marshalls & Dent Lawyers – 8 October 2009**