
In the
United States Court of Appeals
for the Seventh Circuit

LESLIE S. KLINGER,

Plaintiff-Appellee,

v.

CONAN DOYLE ESTATE LTD.,

Defendant-Appellant.

Appeal from the United States District Court
for the Northern District of Illinois, Eastern Division, No. 1:13-cv-01226,
the Honorable **Rubén Castillo**, Chief Judge, presiding.

REPLY BRIEF OF DEFENDANT-APPELLANT
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SUMMARY OF ARGUMENT

Mr. Klinger's position rests on three arguments. *First*, he claims that the case and controversy before the Court is not whether his new book may be published without a license, and is rather the public domain status of the pre-1923 works of Arthur Conan Doyle. But a decision on whether the pre-1923 stories and novels of Arthur Conan Doyle are in the public domain is unnecessary: they are. Such a decision is also an unconstitutional advisory opinion unless there is a case or controversy about how the rights in question actually affect someone. A constitutional dispute could exist if Mr. Klinger placed his book before the Court for a decision on whether it does or does not infringe Conan Doyle's copyrights in the ten original Sherlock Holmes stories that complete Holmes's and Watson's characters (the Ten Stories). But mere reference to that controversy does not satisfy Article III of the Constitution if Mr. Klinger continues to hide the book and insist the Court answer only academic questions. All the Court can do under these circumstances, and all the district court has done, is render an advisory opinion.

Second, Mr. Klinger argues that the law in this area is settled, and Conan Doyle is asking for precedent to be overturned. What Conan Doyle has presented is a new factual situation—two series characters whose author, in the Ten Stories still protected by copyright, reached back into the characters' early and middle lives and continued forming the characters. The law applicable to this is far from settled. *Silverman v. CBS, Inc.*, 870 F.2d 40 (2d Cir. 1989) addressed characters fully formed in the public domain portion of a series, with added bits of expression in copyrighted works but no facts indicating dynamic change or mid-life character

formation in the copyrighted works. Mr. Klinger relies on Professor Nimmer's treatise, which cited no relevant cases and did not consider the continuing non-linear creation of a character in copyrighted works—and even so, Nimmer's opinion on the “difficult question” was tentative, offering what “would appear to be”¹ the proper conclusion.

Third, Mr. Klinger's central proposition is that the Holmes and Watson literary characters were fully created in public domain works. But the question of what stories created the character is a fact question, and the facts on that issue are heavily controverted. Conan Doyle submitted several affidavits below showing a dozen areas in which copyrighted stories continued the formation of both Holmes's and Watson's characters in the beginning, middle, and end of their fictional lives. A. 29–32. And Mr. Klinger admitted below that the Ten Stories did not merely develop the characters in later life, but developed each character in earlier life. R. 247 (“Plaintiff [Klinger] agrees with the following statement: ‘Sir Arthur did not develop Holmes's character in a strictly chronological way as the stories progressed. All of the last ten copyrighted stories are set in various points earlier in Holmes's life...’”).

Mr. Klinger has even admitted several facts of copyrighted character formation. His own Complaint's list of “Sherlock Holmes Story Elements” purports to list public domain characteristics of Holmes and Watson. But even that list includes concededly copyrighted character traits for both men. Holmes's retirement (listed at R. 32) is from the copyrighted story “The Lion's Mane” (1926), which Mr.

¹ Melville B. Nimmer and David Nimmer, 1 *Nimmer on Copyright*, § 2.12, at 2.178.31 (2013).

Klinger admits (at R. 34) is copyrighted. As to Watson, Mr. Klinger's list includes Watson's second marriage and early career as an athlete, from three copyrighted stories. R. 33; *see* Point II below.

Even in the face of these admissions, Mr. Klinger trivializes the two men's copyrighted character development as "vague notions." App'ee Br. at 5. One cannot help noting that for Mr. Klinger, developments from pre-1923 works are important and character-forming, but in stories from 1923 and after, instead of character traits Mr. Klinger sees only "notions," "facts," and "events." *Id*; R. 252, 257.²

Mr. Klinger also argues that these genuinely disputed material facts should simply be decided in his favor, in violation of basic summary judgment law. In support of his position that the characters in fact did *not* change in copyrighted stories, Mr. Klinger brings in new factual materials for the first time in his appeal brief, including out of context quotations from Arthur Conan Doyle, apparently purporting to indicate the author's intentions. These "facts" were never presented to the district court and are nowhere in the record.

Perhaps most significant, Mr. Klinger does not show how he can or will use the Holmes and Watson characters in such a way as to avoid their copyrighted character development. Rather Mr. Klinger places his bets on his factual contention that the characters were fully formed before 1923 and additional character formation should be ignored.³

² Conan Doyle has always agreed that all public domain stories and novels can be freely republished.

³ Mr. Klinger never suggests what to do about the copyrighted character traits he lists in his own Complaint as part of the two men's characters. R. 32–33.

This suggests a curious agreement between Mr. Klinger and Conan Doyle: neither party can provide any workable way for Holmes and Watson as characters to be dismantled in new stories. Mr. Klinger's solution is to seek a holding that the characters were completely formed in public domain works and all subsequent character development was merely "vague notions." App'ee Br. at 5. Conan Doyle insists that the facts show continued character formation in the Ten Stories. Either way, each character is an integral whole.

At the root of all of Mr. Klinger's arguments is his claim that Conan Doyle has a nefarious "business model" (App'ee Br. at 5–6) of bullying publishers and motion picture producers with bogus claims of infringement. Mr. Klinger asserts that his previous publisher, the large corporation Random House, and the major motion picture and television studios with whom Conan Doyle works have been afraid to challenge Conan Doyle—even though Mr. Klinger says they would easily win—and it is up to him to stop this injustice. Mr. Klinger offers no explanation why these large corporations would be unwilling, if Conan Doyle had no rights, to handle a simple lawsuit invalidating them.

Mr. Klinger's own prior experience may be illustrative. In publishing his last book, *A Study in Sherlock*, he claimed just as insistently as he does here that the book needed no license. But in this case Mr. Klinger conceded that the first book used material from the copyrighted Ten Stories. R. 256–57. Nor does Mr. Klinger claim that the license fee of \$5,000 was unreasonable for the Random House book. In fact nothing supports Mr. Klinger's *ad hominem* suggestions. Conan Doyle's

licensing of its existing copyrights and trademarks has actually helped bring about successful high-quality entertainment series, educational programs, and books that have given rise to a surge of interest in Arthur Conan Doyle's work.

Denying a reward for the value of an author's labors, as this Court has noted, will lead to less writing, to the detriment of society at large. *Nash v. CBS, Inc.*, 899 F.2d 1537, 1541 (7th Cir. 1990); *see generally* William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. Legal Stud. 325 (1989). "The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.'" *Mazer v. Stein*, 347 U.S. 201, 219 (1954). In a case where one party wants to borrow, as here, it is tempting to look at one side of the copyright equation and conclude that allowing the borrowing will lead to more creative work. But doing so also reduces the incentive of reward for the future—the Constitutional purpose of copyright. *Id.* As this Court has pointed out, "[a]t each instant some new works are in progress, and every author is simultaneously a creator in part and a borrower in part. In these roles, the same person has different objectives. Yet only one rule can be in force." *Nash*, 899 F.2d at 1541. That rule should give full statutory protection to works of authorship covered by copyright law.

ARGUMENT

I

MR. KLINGER ON ONE HAND URGES
THE REAL CONTROVERSY IS THE THREAT
THAT HIS BOOK INFRINGES, BUT ON THE OTHER
HAND PRECLUDES ANY DETERMINATION OF THAT ISSUE

Mr. Klinger has alleged he has a book that he wants to publish, *In the Company of Sherlock*, but he is concerned that without help from the Court he will face an infringement suit from Conan Doyle. R. 13, 21–25. Mr. Klinger has urged the immediacy of this controversy on the Court, stating that he has already allowed his book to be listed in his publisher’s catalog and offered for pre-orders on Amazon—all reasons this case needs to be decided, and soon. Appellee’s Mot. for Expedited Briefing & Consideration, Doc. 6, filed Feb. 25, 2014, at 3–4.

But while Mr. Klinger holds out that controversy as bait, he refuses to risk a concrete decision on the book. Instead he switches to an abstracted list of Sherlockian story elements. It was this academic exercise that Mr. Klinger put before the district court and now presents for decision to this Court. App’ee Br. at 25 (“The case or controversy in the present case is whether the first 50 Sherlock Holmes stories and novels are in the public domain.”) (initial capitals lowered).

While the alleged facts about Mr. Klinger’s book would suggest “that there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment,” *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127 (2007), Mr. Klinger cannot make that showing with respect to his list of story elements.

The list of “story elements” is the equivalent of an allegation that Mr. Klinger would like to write a book in the future, and requests the Court’s advance guidance on how to write that book without infringing. Having retreated from the actual case or controversy over the real book, Mr. Klinger has failed to seek “specific relief through a decree of a conclusive character, as distinguished from an opinion advising what the law would be upon a hypothetical state of facts.” *Id.* Indeed, the district court’s conclusion that Mr. Klinger may use pre-1923 Story Elements and may not use post-1922 Story Elements is an advisory opinion based upon a hypothetical state of facts (mere representations that the book will contain no post-1922 material) that has not concluded anything with respect to the actual book at issue.

In *Calderon v. Ashmus*, 523 U.S. 740 (1998) the Supreme Court held that litigants may not use declaratory judgment actions to obtain piecemeal adjudication of issues short of going all the way in resolving the underlying controversy. *Id.* at 747–49. In *Calderon*, the underlying controversy was whether the respondent was entitled to federal habeas relief. *Id.* at 746. But instead of seeking that determination, “respondent carved out of that claim only the question whether, when he sought habeas relief, California would be governed by Chapter 153 or by Chapter 154 in defending the action.” *Id.* While an answer to that question would undoubtedly help the respondent in his quest, answering the question abstracted from the actual controversy would have been an unconstitutional advisory opinion. *Id.*

Mr. Klinger seeks the same thing—an opinion to guide his future preparation of a book without risking a decision on that book. In fact Mr. Klinger’s Complaint alleges that he and his co-editor “are currently preparing” a book and alleges what it “will” include. R. 21. If this Court affirms the judgment as currently postured, Mr. Klinger would undoubtedly use this Court’s decision to bless his book as a non-infringing work. That is the whole point of this action. But the Court would have never seen the book, and the question whether it infringes could not possibly be resolved.

A declaratory judgment plaintiff concerned about infringement—while he need not risk infringement by publishing the questionable work and waiting to be sued—must take more than mere initial steps toward creating the potentially infringing work. *Vantage Trailers, Inc. v. Beall Corp.*, 567 F.3d 745, 751 (5th Cir. 2009) (affirming dismissal for lack of subject matter jurisdiction because the declaratory judgment plaintiff “failed to meet its burden to show that its design was substantially fixed as to the potentially infringing elements”); *Benitec Australia, Ltd. v. Nucleonics, Inc.*, 495 F.3d 1340, 1346 (Fed. Cir. 2007) (“The fact that Nucleonics may file a [new drug application] in a few years does not provide the immediacy and reality required for a declaratory judgment.”); *Geisha, LLC v. Tuccillo*, 525 F. Supp. 2d 1002, 1018 (N.D. Ill. 2007) (finding no jurisdiction because the “allegedly infringing future activity lacks sufficient immediacy and reality”).

Mr. Klinger claims the only way to solve the supposed threat against his publisher (and presumably book distributors and retailers) is with this action. It is

not. Mr. Klinger could quite easily have submitted his book in a declaratory judgment action for decision about whether it infringes, and could have done so before offering it to a publisher so that no publishers, distributors, or booksellers were exposed to liability for copyright infringement.

In fact, each and every one of the copyright cases Mr. Klinger cites to support his position involved a court dealing with a concrete dispute and examining the allegedly infringing work. *See Warner Bros. Entm't, Inc. v. X One X Movie Prods.*, 644 F.3d 584, 594–95, 602–04 (8th Cir. 2011) (indicating that the public domain material was in the record and analyzing the actual use of the public domain and copyrighted material); *Gaiman v. McFarlane*, 360 F.3d 644, 650–54 (7th Cir. 2004) (analyzing facts in the record in detail with respect to works at issue to determine whether plaintiff was the co-owner of the copyright in comic-book characters); *Silverman*, 870 F.2d at 43–44 (outlining facts about Silverman's Broadway musical script and affirming the district court's finding that Silverman was liable for copyright infringement based upon his use of material from post-1948 radio scripts); *Pannonia Farms, Inc. v. USA Cable*, 2004 WL 1276842 (S.D.N.Y. June 8, 2004) (although decided on plaintiff's lack of copyright ownership and standing, the alleged infringing television movie had already been broadcast and was available to the court); *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1563–64, Exs. 1–8 (S.D. Cal. 1996) (comparing the actual alleged infringing work about the O.J. Simpson trial to Dr. Seuss's original work). Mr. Klinger does not point to, nor has research revealed, any case in which a court invoked its

jurisdiction under the Declaratory Judgment Act to determine what abstract creative material was or was not in the public domain. The precedent Mr. Klinger seeks to establish would be the equivalent of placing upon this Court the burden of reviewing a verbal description of color combinations, stroke patterns, and compositional elements to determine whether, if created, such a work would infringe a Georgia O’Keeffe painting.

MedImmune, relied upon by Mr. Klinger, is not to the contrary. *MedImmune* involved a dispute between two parties to an existing contract, and in that context the Court held that in order to satisfy the “case or controversy” requirement:

All we need determine is whether petitioner has alleged a contractual dispute. It has done so.

....

MedImmune is seeking to define its rights and obligations under its contract with Genentech—precisely the type of action the Declaratory Judgment Act contemplates.

MedImmune, 549 U.S. at 125. *MedImmune* merely holds that parties in a contractual relationship need not breach that contract in order to create a case or controversy. It offers no support to Mr. Klinger in seeking to have abstract copyright issues decided without risking decision on the real controversy of whether his book infringes. If the Court should decide that no case or controversy exists under Article III of the United States Constitution, no further issues need be addressed.

II

MR. KLINGER MISTAKES THE PRESENTATION
OF A NEW FACTUAL SCENARIO AS A REQUEST FOR NEW LAW

Mr. Klinger states repeatedly in his brief that Conan Doyle is asking for new law and for special consideration, and gives the impression that the law on this subject is settled. *See, e.g.*, App'ee Br. at 10–11. But even Professor Nimmer's proposed answer is phrased tentatively (“would appear to be”⁴) and cites no relevant cases. *See* Brief of Defendant-Appellant Conan Doyle Estate Ltd., filed March 19, 2014, at 37–39.

More importantly, Professor Nimmer concedes that Judge Newman's separate opinion in *Burroughs*—on which *Silverman* is based—was probably wrong. *See Burroughs v. Metro Goldwyn Mayer, Inc.*, 683 F.2d 610 (2d Cir. 1982). Judge Newman dissented from the *Burroughs* majority and would have held that Tarzan was created entirely in the first novel, with the result that Tarzan character rights could be terminated by terminating the transfer of only the first novel. In discussing Judge Newman's view on this point, Professor Nimmer writes,

The majority is arguably correct on this issue, to the extent that the grant of rights in the 5 omitted works impliedly granted rights in all of the characters contained therein, even if the copyrights pertaining to such characters spring from earlier works—if a grant was not effectively terminated, then the rights licensed under such grant remain, even though such rights stem from more than one copyright.

³ *Nimmer* § 11.06[B] n.69.

⁴ Melville B. Nimmer and David Nimmer, 1 *Nimmer on Copyright*, § 2.12, at 2.178.31 (2013).

Silverman v. CBS, Inc. involved continuing *Amos 'n' Andy* episodes after the original creators assigned their rights to CBS, and is the only other case in this area. In *Silverman* it was workable to segment and slice off bits of character—because Amos and Andy in continuing episodes may have been given added bits of expression, but no facts in the case suggested that the characters were fundamentally formed or changed in copyrighted episodes. Conan Doyle asks for the law of summary judgment to be applied to the facts of the characters created by Arthur Conan Doyle. Those facts are that copyrighted stories continued to dynamically form and change Holmes and Watson, and these copyrighted stories reached back into Holmes's and Watson's early and middle life to create that change. A. 28. Accordingly the characters as a factual matter were not complete—at any point in their fictional lives—before the Ten Stories. Mr. Klinger admitted that the Ten Stories reach back into both character's fictional lives:

Plaintiff [Klinger] agrees with the following statement:
“Sir Arthur did not develop Holmes's character in a strictly chronological way as the stories progressed. All of the last ten copyrighted stories are set in various points earlier in Holmes's life”

R. 247. Mr. Klinger went on to reiterate his position that the characters were fully delineated in public domain works and the Ten Stories did not change the characters. *Id.* But many disputed facts and even some undisputed facts are to the contrary. As for undisputed facts, Mr. Klinger's own Complaint uses concededly copyrighted character traits in describing Sherlock Holmes's and Dr. Watson's characters, as the district court held. For Holmes, Mr. Klinger lists his retirement

habits and character that are created in the copyrighted story “The Lion’s Mane” (1926). R. 32. For Watson, Mr. Klinger lists Watson’s second wife and his athletic background as a young man—created in the copyrighted stories “The Illustrious Client” (1924), “The Blanched Soldier” (1926), and “The Sussex Vampire” (1924). R. 33. *See also* Appellant Conan Doyle’s Brief in Chief, at 12.⁵

As for disputed facts, Sherlock Holmes changed in copyrighted stories in his outlook on the world, he changed from a cold person to someone with emotion and warmth, his skills changed, his relationship with Watson changed and continued changing, Holmes went from the city to the country—even his feelings about dogs changed dramatically. A. 29–32. Mr. Klinger’s admission that the Ten Stories apply to Holmes’s and Watson’s earlier fictional lives establishes that these dynamic developments were not tacked onto the end of the character’s lives, but apply to the characters in the middle of their fictional lives. R. 247.

Silverman’s expectation of breaking off bits of character, as though Holmes and Watson were made of Lego pieces, is unrealistic and unworkable as applied to Sherlock Holmes or Dr. Watson—or other characters who fundamentally change and develop within an author’s original series.⁶

⁵ Mr. Klinger also did not controvert the fact that “when a literary character is created by an author in a series of chapters, stories, or books, that character is a single creation.” R. 255–56. Mr. Klinger denied that this constituted a fact for purposes of summary judgment, but did not factually controvert the statement. *Id.*

⁶ While every series character’s creation is a factual matter, a great many series characters have been created—suggesting the importance of a rule flexible enough to address the facts of various copyrightable characters. Merle L. Jacob & Hope Apple, *To Be Continued: An Annotated Guide to Sequels* (2d ed. 2000) lists 1762 fictional series, many created under the 1909 Act. Among them are three series by William Faulkner (nos. 483–85), C.S. Forester’s Horatio Hornblower series (no. 515), Günter Grass’s Danzig trilogy (no. 622), John

If Mr. Klinger says he can use the characters without touching that copyrighted character development, he should show the Court how, before there is a sweeping declaration that as long as one avoids a few “notions” in the Ten Stories, the Holmes and Watson characters are free for uncompensated use.

Mr. Klinger raises the specter of a supposed new “two-tier” system of special copyright protection for characters that are round rather than flat. But Conan Doyle simply asks that, as in any character case, the district court address the fact question *In what stories was a particular character created?* While flat and round are two general answers to that fact question, corresponding to creation in one story or several—the answer to the question in what works a character was created can only be answered with the facts. *See, e.g., Filmvideo Releasing Corp. v. Hastings*, 509 F. Supp. 60, 62 (S.D.N.Y.) (finding as a fact that the literary character Hopalong Cassidy was created over a series of novels and short stories published in 26 books between 1907 and 1935), *modified on other grounds*, 668 F.2d 91 (2d Cir. 1981); *New Line Cinema Corp. v. Bertelsman Music Group*, 693 F. Supp. 1517, 1521 n.5 (S.D.N.Y. 1988) (finding copyrighted character developed over series of four motion pictures); 2 *Patry on Copyright* § 3:164 (2014) (stating that stories in which a literary character is created is a question of fact).

Mr. Klinger’s brief offers no answer to the series of cases in which courts have already found that copyrightable literary characters were created over years in an

LeCarre’s George Smiley novels (no. 909), O.E. Rolvaag’s trilogy of Norwegian immigrants (no. 1341), Jean-Paul Sartre’s *The Roads to Freedom* series (no. 1392), J.R.R. Tolkien’s Middle-Earth series (no.1575), John Updike’s Bech and Rabbit series (1598–99), and hundreds of others in every genre. These series are not mentioned as having any bearing on the facts of this case, merely as illustrating the significance of the legal issues.

entire series of works. *See* Appellant Conan Doyle's Brief in Chief, at 21–24 (discussing cases holding that the characters James Bond, Hopalong Cassidy, Freddy Kreuger, Rocky Balboa, and the Muppets were all created over time in a series of works). Mr. Klinger would like to flatten the facts of such creation for his own convenience, with a legal rule that at the particular point he has chosen in the Sherlock Holmes Canon, character formation stopped.

Under the 1909 Act the issue of complex series character duration is certainly not easy. Mr. Klinger, however, focuses much of his argument on the different question of when character copyright protection begins: the point when a character is sufficiently delineated. But answering this question does not answer when creation of the character was completed—and consequently when copyright protection for the complete character ends. For example, suppose an artist creates a public mural that takes two years to complete. After the first week of work on the mural the artist has sketched the outlines and clearly has created a copyrightable work: the low bar of originality is met and a copyright exists. Two years later the artist completes the mural. There is no question it is the same work, but it is also different; much new material has been seamlessly integrated into the single work. A copyright running from the work as it existed after the first week would give the artist too short a copyright term, failing to protect the substantial copyrightable expression she developed between week one and completion two years later. It may even be that the expression in that two-year period of completion is what makes the mural a great work of art. The question presented in this case is not when a

character copyright springs into being, but when Sherlock Holmes was completed, and when his copyright expires.

The 1976 Copyright Act solved the series character duration problem in a way that respects the realities of character creation. By making the death of the author the determining date for copyright protection, “all of a particular author’s works, including successive revisions of them, would fall into the public domain at the same time, thus avoiding the present problems of determining a multitude of publication dates and of distinguishing ‘old’ and ‘new’ matter in later editions.” H.R. Rep. No. 1476, 94th Cong., 2d Sess. 134 (1976).

While the death of the author rule cannot apply here, this Court could use a similar policy in interpreting the 1909 Act’s duration provision—by holding that series characters under the 1909 Act lose copyright protection 95 years after publication of the original story in which the character was completed. Such an interpretation would respect the differences between the two statutes but would also promote uniformity in their animating policies. It would at the same time respect the creative realities of the works the law was designed to protect, by not throwing characters into the public domain while stories in which the original author was still forming the characters remain protected.

III

MR. KLINGER ARGUES THAT DISPUTED
FACTS AS TO WHETHER HOLMES AND WATSON
WERE FULLY CREATED IN PRE-1923 STORIES
SHOULD BE DECIDED ON SUMMARY JUDGMENT

Mr. Klinger argues at some length that the disputed facts about whether the Holmes and Watson characters were fully created in pre-1923 stories or also in copyrighted stories should be decided in his favor. App'ee Br. at 4 (“All of the items of expression by which the author delineated these characters [Holmes and Watson] first appeared in novels and stories that were published in the United States at various times prior to January 1, 1923.”); R. 247 (asserting in the district court that “the characters of Sherlock Holmes and Dr. Watson were fully delineated in the four novels and 46 stories that were published prior to 1923, and the Ten Stories do not change or ‘complete’ those characters.”).

In his appellate brief Mr. Klinger attempts for the first time to support this argument factually. These “facts” include quotations without context from Arthur Conan Doyle⁷ (App'ee Br. at 2) and a quotation from a law student's note opining on Holmes's character. App'ee Br. at 16.

But this material is not in the record and was never presented to the district court, in violation of this Court's rules. “No fact shall be stated in this part of the

⁷ Quotations from the author himself appear impressive but are of uncertain probative value. In the words of a fellow Englishman of Arthur Conan Doyle's generation, “the worst person to construe [a statute] is the person who [was] responsible for its drafting. He is very much disposed to confuse what he intended to do with the effect of the language which in fact has been employed.” *Hilder v. Dexter*, [1902] A.C. 474, 477 (H.L.) (Earl of Halsbury).

brief unless it is supported by a reference to the page or pages of the record or the appendix where that fact appears.” United States Court of Appeals for the Seventh Circuit Rule 28(c). Conan Doyle cannot explain the context of these statements without offering additional materials not in the record.

The substantive law of summary judgment also forbids consideration of such materials. “It is axiomatic that issues and arguments which were not raised before the district court cannot be raised for the first time on appeal.” *Republic Tobacco Co. v. North Atlantic Trading Co.*, 381 F.3d 717, 728 (7th Cir. 2004) (holding the “law of summary judgment does not permit a [party] to delay pointing out claimed flaws in the [other party’s] prima facie case until an appeal is underway.”) (quoting *Resolution Trust Corp. v. Juergens*, 965 F.2d 149, 153 (7th Cir. 1992)) (internal quotation marks omitted).

More importantly, factual disputes cannot be decided on summary judgment. *McGraw-Edison Co. v. Walt Disney Prods.*, 787 F.2d 1163, 1173–74 (7th Cir. 1986) (reversing grant of summary judgment because of fact disputes, and holding “the district court should not have decided the disputed issues in the case on a motion for summary judgment”). Here Conan Doyle provided three affidavits detailing a dozen ways in which Holmes and Watson’s characters were formed in the copyrighted Ten Stories. A. 29–32. These facts directly and genuinely dispute Mr. Klinger’s assertion that the characters were completed in public domain works. Mr. Klinger makes no argument that a rational jury could not believe this testimony, or that the

testimony could not be relied upon to conclude that the Holmes and Watson characters were changed and completed in copyrighted stories.

Instead Mr. Klinger demeans the character development in the Ten Stories, calling it “a few vague notions,” (App’ee Br. at 5) and mentioning only three of the arguably lesser areas of character formation. *Id.* Mr. Klinger then attempts to bring in new facts on appeal as described above.

Mr. Klinger also argues that the factual dispute does not matter. But it matters very much. If it is true that the Holmes and Watson characters were partly formed in copyrighted stories, then even on Mr. Klinger’s own theory of mere incremental protection, *parts of the characters of Holmes and Watson are protected by copyright.* And if some parts of the characters are copyrighted, Mr. Klinger is thrown onto the problem of how to separate protected aspects of the two men’s characters from the characters themselves. Mr. Klinger offers no solution to that problem.

The only solution he advanced in the district court Mr. Klinger has since retracted: that post-1923 character traits were not copyrightable on the ground they were “events” and not attributes. R. 252. This argument suggests the Canon is based on historical events, which are not copyrightable. But the argument does not work because the Canon is fiction, and wholly original. On appeal Mr. Klinger writes two footnotes to the effect that he never made this argument and the district court’s ruling on it was the result of a “mismarking of the exhibits.” App’ee Br. at 7

n.2; 10 n.4. Mr. Klinger did, however, expressly argue this position to the district court. R. 252, 257, 260–61.

Having abandoned that position—presumably conceding that the Ten Stories do contribute to Holmes’s and Watson’s copyrightable character formation—there is still no answer to the problem of how to separate protected aspects of the characters from unprotected aspects in any new story.

The problem is admittedly quite thorny. And the lack of a good answer to it suggests a strange agreement between Conan Doyle and Mr. Klinger: both agree that it is impossible to pull Holmes’s and Watson’s characters apart. At least neither party can say how. Mr. Klinger’s solution is that the Ten Stories add nothing to the characters. That position is difficult to sustain when his own Complaint included copyrighted items from the Ten Stories among both men’s character traits, and Conan Doyle submitted extensive facts that a rational jury could believe showing that important and indivisible aspects of the two men’s characters were formed in copyrighted works. Mr. Klinger’s solution of ignoring the copyrighted character development is forbidden by summary judgment law. *McGraw-Edison Co.*, 787 F.2d at 1173–74 (holding disputed facts cannot be decided on a motion for summary judgment).

Conan Doyle’s solution is to ask this Court to rule that copyrighted Holmes and Watson character formation cannot be separated from the characters themselves as used in any new story. At the very least, on Mr. Klinger’s motion for summary judgment it is his burden to should show *how* he can dismantle the

characters in a way that avoids copyrighted character formation. Stated in another way, it was his burden to show how his book in fact avoids copyrighted character formation.

IV

EVEN UNDER THE INCREMENTAL EXPRESSION STANDARD, THE COURT SHOULD REVERSE AND REMAND TO ADDRESS THE FACTS OF CHARACTER FORMATION IN THE PROTECTED TEN STORIES

Incremental character development in a long series is powerful protection. *Silverman* held, in Professor Nimmer's summary, "that CBS could continue to protect the audiovisual representations of its TV characters 'Amos 'n' Andy,' notwithstanding that the literary work creating those characters had fallen into the public domain." 1 *Nimmer*, at 2-178.32 n.23.4. In fact, CBS won damages for copyright infringement against plaintiff Stephen Silverman because his new Broadway musical infringed CBS's development of the Amos and Andy characters in copyrighted TV episodes. *Silverman*, 870 F.2d at 50.

Mr. Klinger's brief makes a similar point about the strength of sixteen films' incremental development of the James Bond character beyond the character as developed in Ian Fleming's novels. App'ee Br. at 18 n.6. In *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co.*, the court enjoined Honda's new commercial for likely infringing the incremental expression in those sixteen films—even if using the original novels' character would not have infringed. 900 F. Supp. 1287, 1296 (C.D. Cal. 1995).

Similarly, *Warner Bros. Entm't, Inc. v. X One X Movie Prods.*, 644 F.3d 584 (8th Cir. 2011) held that public domain photographs of characters from the movies did not inject the entirety of the film characters into the public domain, because the public domain works did not anticipate “the full range of distinctive speech, movement, demeanor, and other personality traits that combine to establish a copyrightable character.” *Id.* at 598. The same is true here. The range of Holmes’s distinctive demeanor, personality, relationship with Watson, attitude toward science and technology, outlook on life, and retirement was not revealed in pre-1923 stories, and under *Silverman*, *Metro-Goldwyn-Mayer*, and *X One X*, that range of character development remains protected by copyright. If it is appropriate for Mr. Klinger to be given judicial guidance before submitting his book for decision, as the district court purported to do, the decision should be reversed and remanded to identify protected and unprotected materials with enough specificity to be meaningful in the preparation of a new book, including guidance on the extensive copyrighted Holmes and Watson character development Conan Doyle has identified.

CONCLUSION

For all the foregoing reasons, Appellant Conan Doyle respectfully requests reversal of the district court decision on the grounds that no justiciable case exists within the meaning of Article III of the Constitution, and an order that the action be dismissed. In the alternative, Conan Doyle requests reversal of that part of the district court's decision granting partial summary judgment in favor of Mr. Klinger.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that the foregoing Reply Brief of Defendant-Appellant complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B) because it contains 5,980 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii).

The undersigned further certifies that this brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word Version 2007 in 12 point Century Schoolbook font.

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CERTIFICATE OF SERVICE

I hereby certify that on April 16, 2014, the Reply Brief of Defendant-Appellant was filed with the Clerk of the Court for the United States Court of Appeals for the Seventh Circuit by using the appellate CM/ECF system.

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