Westlaw Today Q&A: IP expert Randall K. McCarthy on Mickey Mouse's 2024 entry into the public domain

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The year 2023 is a monumental one for copyright law practitioners, as it marks the last year that Disney retains total copyright ownership of its star character Mickey Mouse. That transition, however, is not as simple as many perceive.

Westlaw Today asked intellectual property attorney Randall K. (Randy) McCarthy from the firm Hall Estill to clarify the relevant laws and provide some background on the issues surrounding the animated rodent with the high-pitched voice and optimistic outlook.

Westlaw Today: First off, most people know Mickey Mouse's first appearance was in the animated short "Steamboat Willie." That film debuted in 1928. Was there a time when Disney could have lost its copyright ownership of the film before 2024?

Randall McCarthy: Yes, theoretically at least, Disney could have lost its copyright ownership of the short many years ago had the company failed to file a copyright renewal or had Congress not enacted changes to the copyright laws in the interim.

"Steamboat Willie" was published while the 1909 Copyright Act was in force. The 1909 act provided an initial copyright term of 28 years, and this term could be extended for another 28 years if a renewal application was timely filed (which apparently occurred in this case). Thus, under the 1909 act, the copyright to "Steamboat Willie" would have run through the end of the 56th year after publication (e.g., Dec. 31, 1984), and the short would have entered public domain Jan. 1, 1985.

Congress subsequently enacted the 1976 Copyright Act, which extended the copyright term to 75 years for all copyrights of this type (e.g., corporately owned or "works made for hire") that were still in force on Jan. 1, 1978.

The 1998 Copyright Extension Act increased this term from 75 years to 95 years. Assuming Congress does not further amend the copyright statutes during this year, the copyright to "Steamboat Willie" will run

through Dec. 31, 2023, and will enter public domain Jan. 1, 2024.

2. **Does the expiration of the 95-year term of protection mean content creators are free to use all images of Mickey Mouse in 2024?**

No, the expiration of the 95 year term of protection for Steamboat Willie does not allow content creators to use all images of Mickey Mouse or other characters appearing in the short (such as Minnie Mouse, Black Pete, Clarabelle Cow, etc.). Only those elements in the Steamboat Willie cartoon itself will pass into the public domain. With regard to Mickey Mouse, this earliest version is quite a bit different from the current or classic version: the character in the short has a rat-like nose, solid black pupils, a tail, wears different clothing, and is somewhat mischievous and cruel to others.
Any and all subsequent developments and changes to Mickey Mouse and the characters are still protected by copyright, including voices (the short only includes music and sound effects), relationships, changes in demeanor and clothing, and other developments. Of course, as time goes on, later developed Mickey Mouse cartoons and other works from Disney (such as Snow White, which was released in 1937) will successively pass into the public domain in an incremental fashion.

This does raise an interesting point regarding collections or anthologies of characters that span a period of time where some of the earlier works have entered the public domain and other later works are still protected by copyright. Judge Posner in the Seventh Circuit Court of Appeals dealt with this particular issue in Klinger v. Conan Doyle Estate (755 F.3d 496 (7th Cir. 2014)) with regard to the original series of stories regarding Sherlock Holmes. Of the 60 short stories and novels written by Sir Arthur Conan Doyle beginning in 1877, the first 50 books were pre-1923 and had entered the public domain; the last 10 books were published between 1923 and 1927 and were still covered by copyright. Judge Posner determined that only those elements in the first 50 books (such as Holmes' and Dr. Watson's demeanors, habits, backgrounds, proclivities, etc.) could be used by others, while other elements in the latter 10 books (such as Holmes subsequent fondness for dogs, or Dr. Watson's second marriage) were still protected. This same analysis applies to Steamboat Willie and other copyrighted works from Disney.

3. **You caution that the news of Mickey entering the public domain "feels like a trap." How so?**

It will likely turn out that the entering of Steamboat Willie into the public domain will be more symbolic than revolutionary. While the short can be displayed and modified (colorized for example), or derivative works made that incorporate elements from the short along with other new and original elements, Disney has a history of protecting its intellectual property assets vigorously, so anyone desiring to utilize Steamboat Willie should consider consulting an intellectual property attorney first if there are any questions as to whether the work will run afoul of other areas, including trademark law.

4. **How does trademark law play a part?**

Even though Steamboat Willie (the cartoon) will enter public domain with regard to copyright law, Disney still holds strong trademark rights in the characters relating to this work, Indeed, Mickey Mouse can be considered to be the flagship trademark for the entire company.

Trademark rights protect the source of goods from a likelihood of confusion on the part of consumers. Disney has already established trademark rights to Mickey Mouse (including this earlier version of the character) in clothing, cosmetics, cake decorations, bedding, toys, games, stickers, calendars, jewelry, bags, housewares, and many other areas. Any use of the otherwise available elements from Steamboat Willie that can be viewed as coming from or otherwise related to Disney Enterprises, Inc. or its affiliates would

likely run afoul of the trademark laws.

5. What are some other works that are set to enter copyright law's public domain soon?

The Steamboat Willie cartoon was revolutionary for its time and was the first cartoon to really put Disney on the map. There was a great deal of creativity in the 1920's and 1930's, so watch for works from this era to enter public domain. Notable works that will enter the public domain in the coming years include Superman, Batman, Snow White, several early Looney Tunes characters, the song "As Time Goes By," etc.

6. How about some notable works that have recently become available for public use? (Winnie the Pooh?)

Because of the 1998 Copyright Extension Act, no works entered the public domain from 1998 to 2018. Since 2019 though, several notable works have entered the public domain including, as you noted, Winnie the Pooh by A.A. Milne, which was originally published in 1926. However, it should be noted that A.A. Milne actually wrote four (4) books in this series, so the later three (3) books are still covered by copyright (including the character "Tigger" who debuted in 1928). Complicating this issue is the fact that Disney purchased the rights to these works and published its own animated adaptations of the Winnie-the-Pooh characters in the early 1960s, so these versions and characters are still protected by copyright and trademark as before.

Other works that have recently entered public domain since 2019 include The Jazz Singer (the first live action movie with sound and dialog), the novel The Sun Also Rises by Ernest Hemmingway, the final books on Sherlock Holmes by Arthur Conan Doyle, and various compositions and recordings by Louis Armstrong.

One important point that we have not yet discussed but should be pointed out: the 1998 Copyright Extension Act provides the shorter of two ways of measuring copyright. The standard way which we have been discussing is 95 years from publication for certain types of works owned by others (including corporate owned works, works made for hire, and certain anonymous type works). The other way is the life of the author of the work plus 70 years after their death. Hence, one should be careful in determining whether a work has entered the public domain, since a number of factors apart from date of publication may come into play.

7. How does public opinion factor into the intellectual property controversy? (Could Disney possibly be afraid of enforcing its IP rights?)

Yes, public opinion can factor into the calculus as to whether Disney, or any other copyright holder, enters into litigation or other enforcement strategies against alleged infringers. The U.S. Constitution recognizes the value to society in establishing copyright laws and patent laws to "promote the progress of science [knowledge] and the useful arts [technology]" for "limited times." Whether Congress may have gone too far in protecting these types of works is a different question, but it is fundamentally a good thing for a property owner to legally assert its valid rights in intellectual property.

Generally, large corporations such as Disney appear to value their public reputation even over and above their intellectual property rights. There are well documented instances in the past where Disney legal staff pursued claims against various small entities for seemingly minor copyright-style infringements, and the company received negative publicity as a result. Disney also appeared to have suffered some blowback from its lobbying efforts to pass the 1998 Copyright Extension Act, to the extent that this legislation is also often referred to as the "Mickey Mouse Protection Act." These factors may influence the strategy taken by

the company once Steamboat Willie enters the public domain, but it can be expected that Disney will (rightfully) take reasonable steps to enforce its intellectual property rights. There is simply too much revenue at stake and too many stakeholders (e.g., employees, shareholders, etc.) who depend on the continued viability of the company to do otherwise. Where the lines are drawn will be interesting to see in the coming months and years.

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