

NOT A SPIKE LEE JOINT? ISSUES IN THE AUTHORSHIP OF MOTION PICTURES UNDER U.S. COPYRIGHT LAW

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Motion pictures are generally highly collaborative works, containing many different creative contributions. In the United States motion picture industry, most of those contributions are created as works made for hire for an employer or commissioning party, simplifying potential questions as to rights and obligations among the contributors under copyright law. Occasionally, contributions are created without documentation and outside of a potential work made for hire relationship, giving rise to issues as to ownership of copyright. In one recent case, involving the motion picture Malcolm X, such a situation arose. The court in that case addressed those issues by creating special requirements for motion picture joint works.

This Article reviews fundamental copyright law concepts of authorship both as to individual author works and as to works having multiple authors. It reviews existing law concerning the role of creative control and fixation in relation to authorship determinations and concludes that an individual who contributes or who actually controls the creation of minimally creative expression is an author under U.S. copyright law. Copyright law addressing various types of multiple author works, such as derivative works and collective works, may apply to certain contributions to a motion picture, but Congress and commentators have assumed that a motion picture is primarily a joint work among its primary creative contributors. Professor Dougherty criticizes recent judicially created limitations on joint work determination and suggests that courts or the legislature should reconsider the consequences of such a determination in the context of highly collaborative, multiauthor works such as motion pictures.

Next, this Article considers various contributors of creative material to a motion picture, including producers, screenwriters, cinematographers, editors, performers, production designers and other designers, composers, and directors, applying copyright concepts to those contributions. Many of these participants in the creation of a motion picture contribute works of authorship. The Article addresses certain special problems in motion picture authorship, including the relationship between the screenplay and the motion picture, and the question of whether performers are

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authors under U.S. copyright law. Professor Dougherty concludes that, although the relationship between a motion picture and its screenplay will often be uncertain, the motion picture will most likely be considered a derivative work of the screenplay. Additionally, certain components of an actor's performance should be considered copyrightable works of authorship. He also concludes that, under the judicially developed joint work rules, most contributors of authorship to a motion picture will not qualify as coauthors.

The Article reviews motion picture authorship under international law and under the laws of some countries outside the United States. International law establishes a default rule under which there is a presumptive waiver of certain exploitation rights by many creative contributors.

Finally, the Article considers what should be the default rule governing the rights and obligations among the contributors to a motion picture in the absence of work-for-hire or other contractual arrangements. Professor Dougherty argues that generally in those situations, courts should apply a liability rule rather than a property rule; that is, they should grant economic compensation but not injunctive relief. An appropriately structured joint work rule might be the most appropriate liability rule, but, in view of the restrictive conditions that courts have placed on joint work determination, an implied license will in many cases be the most likely and most appropriate liability rule.

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INTRODUCTION

Last time I checked, I owned those films.

—Ted Turner, addressing objections to the colorization of classic films.¹

A motion picture is a type of audiovisual work defined by the 1976 Copyright Act.² A motion picture is also one of the most collaborative types of works created by authors—the product of the efforts of numerous contributors, many of whom provide copyrightable material. In the U.S. film industry, most of those contributions customarily qualify as “work made for hire,” with the hiring party, usually the producer/financier, deemed both the author and the initial owner of the copyright in the contributions.³

Yet problems do arise. A typical problem might involve a failure to comply with a formal requirement for a particular type of work. For example, a consultant contributes copyrightable material to a film, but a work-for-hire contract is not signed. Or the parties may think they have work-for-hire arrangements, but the arrangements fail because an individual does not qualify as an employee or provides copyrightable material outside the scope of his employment.

Even in the ordinary course of events, in which the contributions to a motion picture are work made for hire, what exactly is encompassed within the copyright? An employer is the author and owner of copyright only in the copyrightable contributions of its employees. What are those contributions with respect to a motion picture? There are several important issues that have not been resolved by the Copyright Act or by the courts, or discussed in legal scholarship in connection with authorship of motion pictures.

Individuals create various contributions to a motion picture with the intent that their contributions be merged into inseparable or interdependent parts of a unitary whole. This highly collaborative work becomes a motion picture. To the extent that those individual contributions fail to qualify as works made for hire, the resulting “unitary whole” might constitute a work of coauthorship—a “joint work” under the Copyright Act.⁴ But recent judicially created requirements for joint works suggest that it is nearly impossible for contributors to a motion picture to qualify as coauthors. Perhaps judges are uncomfortable with the consequences of a determination that a work is joint,

1. Michael Sissine Wantuck Honan, *Artists, Newly Militant, Fight for Their Rights*, N.Y. TIMES, Mar. 3, 1988, at 29 (quoting Ted Turner).

2. 17 U.S.C. § 101 (1994 & Supp. V 1999).

3. *Id.* § 201(b) (1994).

4. *Id.* § 201(a) (1994).

but rather than revisit those consequences in view of the needs of the motion picture business, they create rules that preclude finding works to be joint. Thus, the Ninth Circuit, in a recent case involving contributions to *Malcolm X*,⁵ a film by director Spike Lee, missed an opportunity to elaborate appropriate rules for a film as a work of collaborative authorship, and created uncertainty instead.⁶

A motion picture is usually based upon and adapted from a screenplay, which is often derived from another underlying work, such as a novel or a short story. A motion picture is a “derivative work”⁷ of some preexisting literary material, but its legal relationship to the screenplay, the most important preexisting literary material, is surprisingly uncertain.

U.S. copyright law does not expressly address the role of the performers in the authorship of a motion picture. May performers be authors of a film? If so, under what circumstances? And what is the relation between their contributions, other contributions, and the motion picture as a whole?

This Article analyzes the various types of authorship and works that make up a motion picture under U.S. law, and suggests approaches to sorting out the legal relationships among the contributors and the producer/financier, both in the usual, customary case and in situations in which the customary practices have failed to achieve a simple work made for hire.

Part I discusses authorship under U.S. copyright law generally. It argues that an author is a person who originates minimally creative expression, regardless of whether or not that person actually fixes that expression in a tangible medium. Then it reviews the concept of work made for hire, in which an economic relationship leads an employer or commissioning party to be deemed the “author,” though the creative expression actually originates with another person. Next, it discusses aspects of authorship where multiple parties are involved, starting with the question of what is the proper understanding of the role of fixation and control in authorship determinations, followed by a review of types of works with multiple authors.

Part II applies the concepts developed in Part I to the creation of a motion picture and discusses the authorship contributions made by some of the most important participants in the production of motion pictures. It also addresses some fundamental issues in authorship of motion pictures under U.S. law, including whether a screenwriter is a coauthor of a motion picture or simply an author of an underlying literary work, and whether an actor is an author. In view of the generally minimal qualifications for authorship under

5. *MALCOLM X* (40 Acres and a Mule Filmworks 1992). Spike Lee’s films include an unusual “possessory” credit: “A Spike Lee Joint,” hence the title of this Article.

6. See *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000).

7. 17 U.S.C. § 101.

copyright law, many individuals rendering services in the creation of a film could qualify as contributors of authorship. Work-for-hire arrangements, the customary practice in the U.S. motion picture industry, avoid potential complexity under U.S. law.

Part III discusses what happens when a producer fails to satisfy the requirements for work made for hire as to a particular contribution created for use as part of a motion picture. Some form of "liability rule" should be applied to balance the interests of the non-work-for-hire contributor, the other film contributors, the financier, and the public. Current jurisprudence suggests that the implied license is the most likely and most appropriately applied liability rule.⁸

I. AUTHORSHIP UNDER COPYRIGHT LAW

A. Background

Much recent legal scholarship discusses the concept of "authorship" and its historical and sociocultural roots.⁹ The concept of an author as an innovative originator of creative material is of relatively recent origin, reflecting a romantic view of the nature of authorship as a form of individual creative genius. Several scholars criticize the romantic concept for its failure to recognize either the collaborative nature of much authorship¹⁰ or the fact that much authorship is not novel, but rather restates and reassembles prior expression by other authors.¹¹ Modern motion pictures generally are among the most collaborative of works and often involve recycling of preexisting ideas and stories.

8. Although the focus of this Article is on motion pictures, similar analysis would apply to other types of highly collaborative works of authorship. The growth of the Internet as a medium for collaborative authorship suggests that issues discussed in this Article may arise in contexts other than traditional motion pictures in the future. See Margaret Chon, *New Wine Bursting from Old Bottles: Collaborative Internet Art, Joint Works, and Entrepreneurship*, 75 OR. L. REV. 257 (1996) (stating that print-based copyright principles may not work well in addressing authorship in networked computer environments). It is hoped that the analysis in this Article will prove beneficial to those confronted with issues of authorship and ownership of copyright not only in motion pictures, but also in other similar works.

9. See MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* (1993); Peter Jaszi, *Toward a Theory of Copyright: The Metamorphosis of "Authorship,"* 1991 DUKE L.J. 455; Mark A. Lemley, *Romantic Authorship and the Rhetoric of Property*, 75 TEX. L. REV. 873, 873 n.28 (1997) (book review) (citing useful articles).

10. See JACK STILLINGER, *MULTIPLE AUTHORSHIP AND THE MYTH OF SOLITARY GENIUS* (1991); Peter Jaszi, *On the Author Effect: Contemporary Copyright and Collective Creativity*, 10 CARDOZO ARTS & ENT. L.J. 293, 302 (1992); Martha Woodmansee, *On the Author Effect: Recovering Collectivity*, 10 CARDOZO ARTS & ENT. L.J. 279 (1992) (discussing historical examples of collective authorship).

11. See Jessica Litman, *Copyright as Myth*, 53 U. PITT. L. REV. 235 (1991); Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965 (1990) [hereinafter Litman, *The Public Domain*].

Thus, the romantic notion of a single author of an original work seems particularly ill-suited to most motion pictures. The difficulty of fitting a highly collaborative work such as a motion picture into the various copyright authorship molds reveals the dependence of copyright's notions of authorship on romantic notions of individual creativity.

A legal determination of authorship has important real-world consequences. The author of a work is the first owner of copyright in the work.¹² As the owner of copyright, she has the legal right to control most copying, alteration, distribution, public performance, and public display of the work, and thus realizes much of the economic value of the work.¹³ If the work is not considered made for hire, the author or certain statutory heirs have the right to terminate grants of copyright after a period of time, permitting the renegotiation of grants in order to realize more of the value of the work.¹⁴ The author also has more personal rights, or "moral rights," in some cases, independent of economic rights.¹⁵ The right to control dispositions of the work through property rules, that is, through injunctive relief,¹⁶ can also be used to further personal interests. For example, an author may attempt to enjoin a use of a work that may be personally offensive, even though a user would be willing to pay for such a use.

What law is applicable to determine who are the authors and owners of a work generally depends on what law was in effect at the time of creation and fixation of the work.¹⁷ The Constitution both gives Congress power to grant copyright protection to authors, and limits that power. This part briefly

12. 17 U.S.C. § 201(a) (1994).

13. See 17 U.S.C. § 106 (1994 & Supp. V 1999).

14. See 17 U.S.C. §§ 203, 304(c)–(d) (1994 & Supp. V 1999). Section 203 permits termination of certain grants during a five-year period commencing thirty-five years after the grant. Section 304 permits termination of certain grants during a similar period commencing at the end of what was previously the term of copyright, effectively giving authors and certain heirs the ability to acquire the benefit of extended copyright terms.

15. 17 U.S.C. § 106A (1994). This section, which provides certain moral rights under copyright law for certain kinds of works, is supplemented by state law theories that protect similar interests. See *id.* Note that works made for hire do not receive moral rights protection under § 106A, and some cases have reflected a greater aversion to according equivalent state law rights to the human creator where his work is characterized as a work made for hire. See *id.* In this way, among others, a determination as to type of authorship has a very significant impact on the rights in a work. See *id.*

16. Numerous references will be made to the property rule/liability rule dichotomy, which was highlighted by Professors Guido Calabresi and A. Douglas Melamed in their famous article, Guido Calabresi & A. Douglas Melamed, *Property Rules, Liability Rules, and Inalienability: One View of the Cathedral*, 85 HARV. L. REV. 1089, 1092 (1972). The ability to control a work's use by means of injunctive relief is characteristic of a property rule. See Robert Merges, *Of Property Rules, Coase, and Intellectual Property*, 94 COLUM. L. REV. 2655 (1994). Injunctive relief has been described as "the classic instance of a property rule." *Id.* at 2655.

17. See 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 5.03[B][2][c], at 5-48 (2000).

reviews the constitutional requirements, and then discusses the requirements for copyrightable subject matter generally under the 1909 Copyright Act¹⁸ and the 1976 Copyright Act. Although the 1976 Act made several substantial changes in the law as it concerns multiparty works such as works made for hire and joint works, it leaves the law unchanged as to the nature of authorship generally.

B. Authorship Under U.S. Law Generally

1. Constitutional Copyright Clause—Writings of Authors

The Copyright Clause empowers Congress to enact copyright legislation "To promote the Progress of Science . . . by securing . . . to Authors . . . the exclusive Right to their . . . Writings"¹⁹ Thus, Congress may only provide copyright protection for "writings" of "authors."²⁰ Authorship, as a constitutional matter, requires originality and some minimal degree of human²¹ intellectual labor or creativity.²² "Originality" means that the work has not been copied from another; in other words, the work "owes its origin" to the contributor²³ or is the "independent creation" of the contributor.²⁴

18. 17 U.S.C. § 1 (1909) (current version at 17 U.S.C. § 101 (1994 & Supp. V 1999)).

19. U.S. CONST. art. I, § 8, cl. 8.

20. See 1 NIMMER & NIMMER, *supra* note 17, § 1.09, at 1-66.41 (regarding the ability to enact copyright-type protection under the Commerce Clause power).

21. See *Urantia Found. v. Maaherra*, 114 F.3d 955, 958 (9th Cir. 1997); *Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd.*, 96 Civ. 4126, 2000 U.S. Dist. LEXIS 10394, at *29 (S.D.N.Y. July 21, 2000). Both of these cases involved works that purportedly embodied the words of spiritual beings, as communicated through humans. In both cases, the courts found sufficient human expression incorporated in the ultimate work so that the works involved could be protected by copyright.

22. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345-46 (1991); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884); *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

23. *Burrow-Giles*, 111 U.S. at 58; 1 NIMMER & NIMMER, *supra* note 17, § 1.06, at 1-66.20. Whether creativity is viewed as an aspect of originality or as a separate requirement is probably of little significance. See *id.*

24. 1 NIMMER & NIMMER, *supra* note 17, §§ 1.06, 1.08[C][1], at 1-66.20, .31. The requirement of some creativity has been inferred from both the Constitutional terms "author" and "writing." *Id.* § 1.08[C], at 1-66.30 n.26. An early English case is the source of one definition of authorship, under which it involves "originating, making, producing, as the inventive or master mind, the thing which is to be protected." *Nottage v. Jackson*, 11 Q.B.D. 627, 635 (1883). The concept of "mastermind" found its way into U.S. jurisprudence in *Burrow-Giles*; some problems with that concept will be discussed below. Several other early definitions are discussed in Walter J. Derenberg, *The Meaning of "Writings" in the Copyright Clause of the Constitution*, in 1 STUDIES ON COPYRIGHT 43, 64 (The Copyright Society of the U.S.A. ed., 1963), including "all who exercise creative, intellectual, or aesthetic labor in the production of a concrete, tangible form." *Id.* (quoting *Hoague-Sprague Corp. v. Frank C. Meyer Co.*, 31 F.2d 583, 584 (E.D.N.Y. 1929)).

Courts interpret “writings,” as used in the Copyright Clause broadly, to mean a tangible, physical embodiment of authorship.²⁵ The term “writings” has not been limited to works expressed in words.²⁶ Courts have not often addressed whether a particular type of work qualifies as a constitutional writing.²⁷ Interestingly, it is with regard to photographs and motion pictures that courts have addressed claims that works based on new technology could not be the subject of copyright because they are not writings, and, in rejecting these claims, courts have confirmed the liberal scope of the term.²⁸ Thus, the U.S. Supreme Court has found that photographs²⁹ and motion pictures³⁰ qualify as constitutional “writings.”

2. 1909 Act—Writings of Authors

The 1909 Copyright Act covered “all the writings of an author.”³¹ This was the first time that a U.S. Copyright Act contained such a catch-all phrase, rather than list specific types of copyrightable works.³² Courts interpreted this statutory phrase broadly, but not without limitations. For example, it was held not to include sound recordings, titles, and dress designs.³³ Neither the term “writings” nor “authors” was defined in the statute. The use of the term “writings” implies what is now called “fixation.” That is, embodiment in a physical medium.

In addition to the general provision, the 1909 Act also specified certain “classes” of works for registration of copyright.³⁴ Although it did not expressly cover motion pictures when passed in 1908, the categories “motion picture photoplays” and “motion pictures other than photoplays” were added in the Act of 1912,³⁵ reflecting one of the last express expansions of copyright subject matter until the overall revision that resulted in the 1976 Act.³⁶ Even prior to that, however, motion pictures were recognized as copyrightable

25. See *Goldstein v. California*, 412 U.S. 546, 561 (1973); 1 NIMMER & NIMMER, *supra* note 17, § 1.08[A], at 1-66.27.

26. The first U.S. copyright statute, drafted by some of the same legislators who wrote the Constitution, granted copyright to maps, charts, and prints. See Derenberg, *supra* note 24, at 50.

27. See *id.* at 61.

28. See *id.* at 63.

29. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

30. See *Kalem Co. v. Harper Bros.*, 222 U.S. 55, 61–62 (1911).

31. 17 U.S.C. § 4 (1909) (current version at 17 U.S.C. § 102 (1994)).

32. See Derenberg, *supra* note 24, at 52.

33. See *id.* at 79–86 (discussing cases).

34. 17 U.S.C. § 5 (1909) (current version at 17 U.S.C. § 102 (1994)).

35. Copyright Act, 37 Stat. 488 (1912) (codified as amended at 17 U.S.C. § 5) (current version at 17 U.S.C. § 102 (1994)).

36. See Derenberg, *supra* note 24, at 54. In 1972, after Walter Derenberg wrote his study, sound recordings were added as an additional category of protectable subject matter.

subject matter, as "photographs."³⁷ There is no definition of "motion pictures" in the 1909 Act.³⁸

The 1909 Act uses the same words used in the Constitution.³⁹ This created the potential for confusion between material that falls outside the statutory subject matter and that which would fall outside the scope of constitutional power granted to Congress. A study prepared for the Copyright Office as part of the revision of the 1909 Act recommended that different language be used in a new copyright statute.⁴⁰

3. 1976 Act—Original Works of Authorship

Under the 1976 Act, copyright exists in "original works of authorship fixed in any tangible medium of expression."⁴¹ Most of the key terms in that definition—"original," "works," and "authorship"—are still not defined in the revised statute. The legislative history states that the phrase "original works of authorship" was "purposely left undefined" and "is intended to incorporate without change the standard of originality established by the courts under [the 1909 Act]."⁴² Only the phrase "standard of originality" is mentioned, and the House Report discusses "works of authorship" only in the context of the need to use a different phrase from the 1909 Act's reference to "all the writings of an author."⁴³ This was done "to avoid exhausting the constitutional power of Congress to legislate in this field, and to eliminate the uncertainties arising from the latter phrase."⁴⁴ Presumably Congress intended "original works of authorship" to mean the same thing as the statutory (but not constitutional) "writings of an author," while recognizing that the types of material protected would continue to expand to new types of works.⁴⁵

37. *Edison v. Lubin*, 122 F. 240, 242 (3d Cir. 1903); *Am. Mutoscope & Biograph Co. v. Edison Mfg. Co.*, 137 F. 262, 267 (C.C.D.N.J. 1905).

38. See 17 U.S.C. § 5 (1909) (current version at 17 U.S.C. § 102 (1994)).

39. Compare 17 U.S.C. § 5 (1909) (current version at 17 U.S.C. § 102 (1994)) ("The works for which copyright may be secured under this title shall include all the writings of an author."), with U.S. CONST. art. I, § 8, cl. 8 ("The Congress shall have Power . . . To promote the Progress of Science . . . by securing . . . to Authors . . . the exclusive Right to their . . . Writings . . .").

40. See Derenberg, *supra* note 24, at 86.

41. 17 U.S.C. § 102(a) (1994).

42. H.R. REP. NO. 94-1476, at 51 (1976).

43. *Id.*

44. *Id.*

45. The House Report states that,

Authors are continually finding new ways of expressing themselves, but it is impossible to foresee the forms that these new expressive methods will take. The bill does not intend either to freeze the scope of copyrightable technology or to allow unlimited expansion into areas completely outside the present congressional intent.

Id.

Under the 1976 Act, works of authorship include “motion pictures and other audiovisual works.”⁴⁶ Section 101 defines “audiovisual works” as “works that consist of a series of related images which are intrinsically intended to be shown by the use of machines, or devices . . . together with accompanying sounds, if any . . .”⁴⁷ Section 101 further defines “motion pictures” as “audiovisual works consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any.”⁴⁸ Obviously, there is some surplusage in these definitions, and they do little to explain what exactly would constitute the works of authorship that comprise a motion picture. Therefore, one must consider the general characteristics of authorship as developed by the courts prior to the 1976 Act in order to assess who are the authors of a motion picture within the meaning of the Act. Those cases show that one who originates (that is, does not merely copy) minimally creative expression is an author of that expression.

a. Originality—Source v. Copying

As discussed above, “originality” means that the material originates from the purported author—that it is not copied.⁴⁹ Originality does not mean that a work is novel or unique. To that extent, the legal concept of authorship seems to be different from a romantic view of authorship. Moreover, not much of an original contribution is required for a court to find copyrightable authorship. Unlike literary critics, courts are not in the business of assessing the creative value of a particular work.⁵⁰

In a case challenging the copyrightability of a photograph of Oscar Wilde, the Supreme Court explained its concept of authorship and originality.⁵¹ The Court found that authorship is present in a photograph, at least in a carefully arranged photograph such as the portrait at issue in that case.⁵² Although the subject matter of a photograph is not original, in that it exists in the world more or less independent of the photographer, the creative choices made in

46. 17 U.S.C. § 102(a)(6).

47. 17 U.S.C. § 101 (1994 & Supp. V 1999).

48. *Id.*

49. There is a great deal of recent legal scholarship challenging the concept of originality and the related so-called romantic view of authorship. See, e.g., Lemley, *supra* note 9. It is argued that few, if any, works are really original, that all works are basically a recycling or reordering of prior material, and that a concern for originality is a relatively new concept that may serve a variety of political or economic goals. See Jaszi, *supra* note 11. There are also persuasive critiques of that line of thinking. See Lemley, *supra* note 10.

50. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

51. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60–61 (1884).

52. See *id.* at 60.

creating the photograph, either in the arrangement of the subject matter or in the choice of vantage point, lens, lighting, and so on, may be original.⁵³

Expression dictated by external circumstances should not be considered authorship, because it is not original. To the extent elements of a particular expression are required by external constraints, they do not owe their origin to the expressor.⁵⁴

Thus, sports plays would be distinguishable from other, more creative, unscripted movement works because much of the movement in a sports play is dictated by the requirements of the game. A runner swings his bat because he is required to try to hit the ball. He runs to first base because the rules require him to do so. This concept precludes copyright infringement claims against players engaging in similar plays, as does the idea/expression dichotomy.

An additional argument against copyrightability of sports plays, as distinguished from other unscripted performances, is that sports plays are functional works, created primarily for functional purposes—to score points and prevent the opponent from scoring points—rather than for aesthetic purposes.⁵⁵ Performances by dancers, pantomimes, and actors would generally not be as dictated by external constraints or functionality as are sports plays. Copyright in such creative works, however, would not extend to functional movements, movements dictated by external factors, or to the ideas expressed in the works.

b. Creativity—A Modicum Will Do

Only modest “creativity,” or intellectual labor, is required to show authorship.⁵⁶ In a case finding that a realistic pictorial illustration of a circus act was copyrightable, the Supreme Court stated that even a “very modest

53. They may also be copied. See *Gross v. Seligman*, 212 F. 930, 931 (2d Cir. 1914) (holding that a photographer infringed copyright in his own earlier photo when he embodied the same expressive details such as pose, light, and shade, in photographing the same model).

54. Computer software copyright infringement cases support this—in an abstraction-filtration-comparison analysis of copyright infringement, some courts have said they would “filter out” elements dictated by external constraints, along with other non-copyrightable elements, such as *scènes à faire*, ideas, and systems. See *Computer Assocs. Int’l v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992). This concept might also help resolve the issue of copyrightability of sports events per se, or, as Professor Paul Goldstein more generally describes the issue, “whether copyright can attach to fixed but unscripted postures and movement . . .” 1 PAUL GOLDSTEIN, COPYRIGHT § 2.12.1, at 2:143 (2d ed. Supp. 1998).

55. “Functional works . . . are designed to accomplish specific tasks and their value turns primarily on their utility in accomplishing those tasks.” 1 GOLDSTEIN, *supra* note 54, § 2.15 at 2:174.

56. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

grade of art" is sufficient because "[p]ersonality always contains something unique."⁵⁷

In that same opinion, Justice Oliver Wendell Holmes articulated an important concept in copyright law that has become known as "aesthetic nondiscrimination," meaning "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."⁵⁸ Shortly after that case was decided, a federal court had no difficulty following this approach and finding that Thomas Edison's short, one-camera film of the launch of a yacht reflected adequate creativity.⁵⁹ Recently, the Supreme Court affirmed both historical cases, stating that some creativity is required and yet that the amount required is small—a "modicum."⁶⁰

c. Fixation—Authorship v. Copyrightability

In order to qualify for copyright protection, works must be "fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."⁶¹ This requirement is fairly noncontroversial as to motion pictures, as embodiment of expression in film will satisfy it. Several related issues, however, bear further discussion.

First, it must be noted that although fixation may be required for federal copyright protection, it is not required for "authorship."⁶² This is supported by at least two arguments based on the language of the Copyright Act. First, if fixation were a prerequisite for authorship, then the statute would not need to say that copyright exists in "original works of authorship fixed in any tangible medium of expression,"⁶³ because the reference to fixation would be unnecessary. Second, the statutory definition of fixation contemplates a work being fixed by someone other than the author, "under the authority of the author."⁶⁴ Further evidencing this distinction is the fact that states may protect works of authorship that are not fixed in a tangible medium of expression.⁶⁵

57. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903).

58. *Id.*

59. *See Edison v. Lubin*, 122 F. 240, 242 (3d Cir. 1903).

60. *Feist*, 499 U.S. at 346.

61. 17 U.S.C. § 102(a) (1994).

62. *See* 1 NIMMER & NIMMER, *supra* note 17, § 1.06[A], at 1-66.21.

63. 17 U.S.C. § 120(a) (1994).

64. 17 U.S.C. § 101 (1994 & Supp. V 1999) (providing definition of "fixed"); *see also* Russ VerSteeg, *Defining "Author" for Purposes of Copyright*, 45 AM. U. L. REV. 1323 (1996).

65. *See* CAL. CIV. CODE § 980(a)(1) (Deering 1990) (protecting works of authorship not fixed in any tangible medium of expression); *see also* 1 NIMMER & NIMMER, *supra* note 17, § 2.02,

Additional issues in connection with fixation arise when more than one person is involved in creating and fixing expression. These issues will be discussed below.

C. Economic Authorship—Work Made for Hire

Although generally the individual whose original, minimally creative expression is embodied in a copy is the “author” of a work, U.S. law recognizes another basis for authorship—an economic basis.⁶⁶ In the case of a work made for hire,⁶⁷ it is the employer (or commissioning party, in the case of certain types of independent contractor works) who is considered the author and first owner of copyright.⁶⁸ Of course, this claim of authorship is independent of any, and requires no, creative expression on the part of the person or entity deemed to be the author. Because only original works of authorship are entitled to copyright, the originality and minimal creativity are provided by the employee or independent contractor.⁶⁹ This is important in the analysis of motion picture authorship because in the United States most contributions to a motion picture are created as works made for hire.⁷⁰

What is a work made for hire? The 1909 Copyright Act stated “the word ‘author’ shall include an employer in the case of works made for hire,”⁷¹ without further defining those terms. As interpreted by courts, the concept of “employer” covered works created by ordinary employees in the course of their duties, and expanded in the 1960s to a hiring party that had

at 2-21 to -27 (noting that states have power to provide protection for unfixed works of authorship and discussing related issues).

66. See ROBERT A. GORMAN & JANE C. GINSBURG, *COPYRIGHT: CASES AND MATERIALS* 278 (5th ed. 1999) (discussing this economic concept of authorship and whether treating an employer or a commissioning party as an author is consistent with the Copyright Clause). This concept of economic authorship separates the U.S. copyright system from other countries’ “author’s right” systems.

67. See 17 U.S.C. § 101 (1994 & Supp. V 1999) (providing definition of work made for hire).

68. See 17 U.S.C. § 201(b) (1994).

69. One might question the constitutionality of designating as author someone other than the actual creator of the work, as the Constitution empowers Congress to secure copyright protection to “authors.” It has been suggested that the work-for-hire concept is supportable as an implied transfer of rights to the employer, because the employer and employee can agree that the employee will own the copyright. See 1 NIMMER & NIMMER, *supra* note 17, § 1.06[C], at 1-66.23 to .24.

70. See John M. Kernochan, *Ownership and Control of Intellectual Property Rights in Audiovisual Works: Contracts and Practice—Report to the ALAI Congress, Paris, September 20, 1995*, 20 COLUM.-VLA J.L. & ARTS 359, 362 (1996); TECHNOLOGICAL ALTERATIONS TO MOTION PICTURES AND OTHER AUDIOVISUAL WORKS: IMPLICATIONS FOR CREATORS, COPYRIGHT OWNERS AND CONSUMERS, REPORT OF THE REGISTER OF COPYRIGHTS (1989), *reprinted in* 10 LOY. ENT. L.J. 1, 23-24 (1990) [hereinafter TECHNOLOGICAL ALTERATIONS].

71. 17 U.S.C. § 26 (1909) (current version at 17 U.S.C. § 102 (1994)).

the right to control or supervise the work.⁷² In addition, a line of cases in the 1960s under the 1909 Copyright Act held that, in the case of commissioned works, copyright vested initially in the commissioning party as a work made for hire.⁷³

Ownership of copyright became controversial in the statutory copyright law revision process.⁷⁴ Ultimately, Congress struck a “carefully balanced compromise”⁷⁵ in the 1976 Copyright Act. Under that “compromise,” there are two sets of circumstances under which a work created on or after January 1, 1978 is considered made for hire: (1) works created by an employee within the scope of employment; and (2) subject to certain formalities and restrictions, certain categories of commissioned works.⁷⁶

1. Employee Works

The 1976 Copyright Act specifies that “a work prepared by an employee within the scope of his or her employment”⁷⁷ is the first type of work made for hire. The term “employee” is not defined in the Act, however. For several years after the effective date of the Act, different circuit courts developed conflicting interpretations.⁷⁸

The Supreme Court eventually resolved the question in *Community for Creative Non-Violence v. Reid*.⁷⁹ The case dealt with copyright ownership of a sculpture created by a sculptor at the request of a nonprofit organization. The Court held that an employee for purposes of copyright law is one who qualifies as an agent under a multifactor test for agency at common law. While control is an important factor, it is insufficient to characterize one as an employer under the Copyright Act.

An employer and employee can modify the default rule as to first ownership of copyright by contract,⁸⁰ but if the factual analysis leads to a conclusion that the rules of agency are satisfied, the parties cannot avoid by contract the statute’s characterization of the employer as the author.⁸¹

72. See 1 NIMMER & NIMMER, *supra* note 17, § 5.03[B][1][a], at 5-14.1.

73. See 1 NIMMER & NIMMER, *supra* note 17, § 5.03[B][2][c], at 5-42 to -43.

74. See Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857, 888–93 (1987) (discussing development of the 1976 Copyright Act ownership provisions).

75. H.R. REP. NO. 94-1476, at 121 (1976).

76. See *id.*

77. 17 U.S.C. § 101 (1994 & Supp. V 1999).

78. See *infra* text accompanying notes 121–122.

79. 490 U.S. 730 (1989).

80. See 17 U.S.C. § 201(b) (1994).

81. See 1 NIMMER & NIMMER, *supra* note 17, § 5.03[D] at 5-53 (2001).

2. Independent Contractors

Similarly, if a work is created by an independent contractor, the commissioning party may be deemed the author under certain circumstances. First, the work must be "specially ordered or commissioned."⁸² This has been interpreted to require that the work be created at the "instance and expense" of the commissioning party.⁸³ Second, the work must fall into one of the nine⁸⁴ categories of works specified in the Copyright Act.⁸⁵ One of those categories is "part of a motion picture or other audiovisual work."⁸⁶ Third, there must be a written instrument signed by both parties, in which they expressly agree that the work is to be considered a work made for hire.⁸⁷

D. The Problem of Multiple Participants

As discussed above, U.S. copyright law accords copyright protection to non-copied, minimally creative expression of the human intellect. The person who generates such expression (or, under certain circumstances, her employer or commissioner) is the author.

How does U.S. law allocate rights when a copyrightable work reflects the efforts of more than one individual? First, this part addresses two general questions: (1) who is the author when one individual generates intellectual expression and another is responsible for the fixation of that expression in a tangible medium, and (2) what is the proper role of control in authorship determinations?

Second, this part discusses the various possible relationships between copyright owners and works when works incorporate multiple expressive

82. 17 U.S.C. § 101 (defining "work made for hire").

83. *Playboy Enters., Inc. v. Dumas*, 960 F. Supp. 710, 713 (S.D.N.Y. 1997).

84. As passed, the 1976 Act provided only nine categories that, when specially ordered or commissioned, could constitute works made for hire: contributions to collective works, part of a motion picture or other audiovisual work, a translation, a supplementary work, a compilation, an instructional text, a test, answer material for a test, or an atlas. See 17 U.S.C. § 101. In 1999, the record industry was successful in adding "sound recordings" to the list. That addition was not widely known, became controversial, and was recently deleted from the statute. See *Work Made for Hire and Copyright Corrections Act of 2000*, Pub. L. No. 106-379, 114 Stat. 1444 (2000).

85. 17 U.S.C. § 101.

86. *Id.*

87. See *id.* There is currently a split in the circuit courts as to whether that writing must be signed prior to the creation of the work, or whether there must only be agreement that the work is made for hire before creation, while the writing may be signed afterwards. The Second Circuit has held that the writing may be signed after creation. See *Playboy Enters., Inc. v. Dumas*, 53 F.3d 549, 559 (2d Cir. 1995), *cert. denied*, 116 U.S. 567 (1995). The Seventh Circuit has held that the writing must precede creation. See *Schiller & Schmidt, Inc. v. Norausco*, 969 F.2d 410, 412 (7th Cir. 1992).

contributions from different individuals. Under U.S. copyright law the resulting works may be considered either derivative works, compilations, collective works, joint works, or some combination thereof. Alternately, a collection of multiple contributions may sometimes remain just that—a group of separate works that happen to be exploited together.

1. Fixation and Control

Certain kinds of works involving the efforts of multiple parties, such as some photographs and motion pictures, present courts with a potential problem: The individual whose intellectual labor is reflected in the work may not be the same person who operates the camera and physically fixes the intellectual conception in a tangible medium of expression. The Supreme Court, in *Community for Creative Non-Violence v. Reid*, created potential confusion between the role of “authorship” and “fixation” in authorship determinations when it said that, “As a general rule, the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.”⁸⁸ This phrase is potentially misleading. It confuses fixation with authorship,⁸⁹ and suggests that to be considered an author, one must fix one’s expression. Certainly, the person who “translates an idea” into expression creates that expression and is the “author.”

Several cases decided after that decision, however, have drawn a distinction between the person who conceives the expression that comprises authorship and the person who physically fixes that expression, finding, correctly, that one who simply “transpose[s] by mechanical or rote transcription into tangible form” the expression of another is not the author.⁹⁰ This part discusses the relationship between the creator of a work and the

88. CCNV, 490 U.S. at 737.

89. See VerSteeg, *supra* note 64. Professor Russ VerSteeg characterizes the CCNV statement quoted above as the “majority rule,” but criticizes it. *Id.* VerSteeg also notes the distinction drawn in the text above: “[F]ixation cannot be the key to becoming an author. . . . Copyright protection may, and indeed actually does, hinge on fixation, but the status of ‘author’ does not.” *Id.* at 1339. I agree with much of VerSteeg’s argument. However, I disagree with one of his central contentions: that in order to qualify as an author, one must communicate expression to another. It seems clear that one can originate creative expression without communicating it to any other person. Thus, it is the act of originating creative expression that constitutes authorship. As a practical matter, though, one will not be able to prove authorship without communicating one’s work to another, or at least memorializing it in a way that it may be communicated. Moreover, if one’s work is never communicated, then it can never be infringed. Finally, contributions to a motion picture are either fixed or communicated by some other means, so this issue remains of primarily theoretical interest.

90. *Andrien v. S. Ocean County Chamber of Commerce*, 927 F.2d 132, 135 (3d Cir. 1991).

"fixator"⁹¹ of the work with regard to authorship, and the significance under copyright law of one party's control over another in connection with the creation of a work.

a. Fixation-Authors v. Scriveners

When one individual generates intellectual expression and another fixes that expression (the fixator merely embodying the expression in a rote, mechanical fashion), then the fixator is not an author, and the person generating the expression is the author. In contrast, when the fixator elaborates the idea and creates the expression, it is the fixator who is the author of the resulting work. When both parties generate creative expression, that is, when the fixation process is not merely rote or mechanical, then both parties are authors.

In *Andrien v. Southern Ocean County Chamber of Commerce*,⁹² the plaintiff was a real estate agent who, unhappy with existing maps of his community, created a new community map.⁹³ When the defendant distributed the new map, James Andrien sued.⁹⁴ The defendants argued that Andrien was not the author of the map, and the district court agreed, granting summary judgment to the defendants.⁹⁵ Andrien had collected existing maps and conducted a survey of distances between various points.⁹⁶ He then hired a printing company, which assigned an employee named Carolyn Haines to do the "art work."⁹⁷ Haines photographed the maps, typed labels for streets, prepared a paste-up working map, and reduced it to a useful size, which was printed.⁹⁸ Believing that Haines was the person who "translated [Andrien's] idea into a fixed, tangible expression," the lower court found that Andrien was not the author of the map.⁹⁹

91. In this Article, the term "fixator" refers to the person who actually embodies a work in a tangible medium of expression. In many cases, the creator and the fixator of a work will be the same individual. For example, I am typing this Article on a computer. Thus, I am both originating its expression and also fixing it. In other cases, however, multiple individuals may be involved in both the creation and fixation processes. For example, if I were dictating this Article to my assistant, who typed as I spoke, I would be creating the expression, but my assistant would be the fixator. The question of which of those individuals are authors in a copyright sense is discussed below.

92. 927 F.2d 132 (3d Cir. 1991).

93. See *id.* at 133.

94. See *id.*

95. See *id.*

96. See *id.*

97. *Id.*

98. See *id.*

99. *Id.* at 134.

On appeal, the Third Circuit reversed and found that Andrien was the author of the map.¹⁰⁰ Analogizing to a novelist who is clearly an author although he does not run the printing press, the court focused on the Supreme Court's statement in *CCNV* that the author is the person who "translates an idea into an expression" that is embodied in a copy.¹⁰¹ The author might embody the work in a copy herself, or might authorize another to do so.¹⁰² If that embodiment is "rote or mechanical transcription that does not require intellectual modification or highly technical enhancement," then the person doing the embodying is not the author, but merely an amanuensis.¹⁰³ Finding that Andrien had "expressly directed the copy's preparation in specific detail," the court found that he, not Haines, was the author.¹⁰⁴

Two cases cited in *Andrien* found that the party who actually fixed the work was the author, when the process of embodying concepts into a fixed medium of expression was not rote or mechanical.¹⁰⁵ In *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*,¹⁰⁶ the defendant operated a dental laboratory and worked with a computer software development company to create a custom program for the business operations of the lab.¹⁰⁷ In a later copyright dispute over a similar program, Rand Jaslow, a principal of the defendant, argued that he was a coauthor of the original program along with Elaine Whelan, the programmer.¹⁰⁸ Jaslow had "originated the concept" and described in detail the operations of the lab that were to be automated by the program, but the court found that it was Whelan and her staff who "designed the system" using their own "expertise and creativeness."¹⁰⁹ The court found that Jaslow had only provided "general assistance and contributions," which did not qualify him as an author.¹¹⁰

100. See *id.* at 133.

101. See *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989).

102. The language of the 1976 Copyright Act defines "fixed" in terms that support this interpretation: "A work is 'fixed' . . . when its embodiment . . . by or under the authority of the author, is sufficiently permanent or stable . . ." 17 U.S.C. § 101 (1994 & Supp. V 1999) (emphasis added); see *Andrien*, 927 F.2d at 134; VerSteeg, *supra* note 64, at 1342.

103. *Andrien*, 927 F.2d at 135.

104. *Id.*; see also *Lakedreams v. Taylor*, 932 F.2d 1103 (5th Cir. 1991). In *Lakedreams*, the court found that the plaintiff provided specific written designs and text for a humorous "family tree" t-shirt. *Id.* at 1108. Changes from the original design were directed by the plaintiff, and the defendant silkscreen company had only "transposed their expression from paper to cloth . . ." *Id.* Thus, the plaintiff, and not the silkscreen company, was the author. See *id.*

105. See *Geshwind v. Garrick*, 734 F. Supp. 644 (S.D.N.Y. 1990); *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 609 F. Supp. 1307 (E.D. Pa. 1985).

106. 609 F. Supp. 1307 (E.D. Pa. 1985).

107. See *id.* at 1309.

108. See *id.* at 1318.

109. *Id.*

110. *Id.*

The *Whelan* court analogized the situation to that of a homeowner explaining the functions he desires in a building to an architect: "The architectural drawings are not co-authored by the owner, no matter how detailed the ideas and limitations expressed by the owner."¹¹¹

Similarly, in *Geshwind v. Garrick*,¹¹² David Geshwind was a producer of computer animation who worked with Don Leich, an employee of a company that Geshwind had engaged to prepare a fifteen-second computer-animated film. The parties disagreed as to how closely Geshwind had worked with Leich, but the court concluded that Geshwind had only reviewed Leich's ongoing work product and suggested some general changes, not all of which were implemented, and that Leich was the creator of the film.¹¹³ Citing *Whelan*, the court analogized Geshwind's acts to those of a person commissioning a portrait who can make suggestions for changes, but is not the creator of the portrait.¹¹⁴ Note that Geshwind and his client for whom the animation was produced had the right to approve the elements for the animated film, but that this right did not make them authors.¹¹⁵

Unlike *Andrien*, both the cases cited in *Andrien* present examples in which the process of fixation was not "rote or mechanical" and required "intellectual modification or highly technical enhancement."¹¹⁶ The fixator in those cases utilized substantial expertise as a computer programmer in order to realize and express the ideas of the producer. Thus, the fixator was found to be the author.

b. The Proper Role of Control

When one individual directs and controls the expression of another, the general copyright principles discussed above suggest that the person who

111. *Id.* at 1319. To the extent that this statement suggests that the homeowner has no rights under copyright, it seems erroneous. If the owner furnishes just abstract ideas (for instance, a four-bedroom home with a back balcony), the owner would not be an author. To the extent she furnishes concrete expression, then she clearly is the author of the drawings furnished. It is possible, however, that the court should have viewed the ultimate architectural plans as a derivative work of the homeowner's drawings, in which case it was correct that the plans were not a joint work by the owner and the architect. Incorrect understanding of the proper characterization of a work as joint or derivative can lead to incorrect outcomes.

112. 734 F. Supp. 644 (S.D.N.Y. 1990).

113. *See id.* at 651.

114. *See Ballas v. Tedesco*, 41 F. Supp. 2d 531 (D.N.J. 1999) (holding that plaintiff ballroom dancers, who developed the idea of a CD for the competitive dance music audience focusing on music from the film *Titanic*, suggested the number and general type of songs it should contain, but were not otherwise involved in producing the recording, were not coauthors of the recording).

115. *See Geshwind*, 734 F. Supp. at 646. It should also be noted that Geshwind's client furnished "storyboards," rough sketches of scenes and describing camera angles, to the company that created the animated film, but that apparently did not make them authors of the film. *Id.* at 649.

116. *Andrien v. S. Ocean Country Chamber of Commerce*, 927 F.2d 132, 135 (3d Cir. 1991).

directs or controls the origination of expression is the author of that expression. Simply having the right to accept or reject expression originated by another, although a relevant factor in determining economic authorship, does not otherwise constitute authorship.

Thus, when there are several participants in the creation of a work, some of whom contribute ideas, some of whom contribute material detailed enough to be considered expression, and some of whom fix the material in physical form, authorship should be accorded to those who originate the expression that is ultimately embodied in the work. This may include individuals who exercise a high degree of actual control over the expression, even if they do not physically fix it in a tangible medium.

The relevance of control over the creation of a work in determining authorship has a complex background, often arising in claims asserting a work-for-hire arrangement. The 1909 Act recognized that an "employer" was the author of work in the case of a "work made for hire," but did not define those terms.¹¹⁷ As Congress prepared the major revision of copyright law that became the 1976 Act, courts were greatly expanding the scope of the work-for-hire concept, particularly its coverage of works created by independent contractors.¹¹⁸

The scope of work made for hire was a major issue in the copyright law revision process.¹¹⁹ The 1976 Act retained the principle that the employer is the author in the case of a work made for hire and also added a limited provision that certain categories of "specially ordered or commissioned works" could be deemed works made for hire, but only if the parties so agree in writing.¹²⁰ Confusion remained in the courts, however, regarding the scope

117. 17 U.S.C. § 26 (1909) (current version at 17 U.S.C. § 101 (1994 & Supp. V 1999)).

118. Earlier cases, particularly in the Second Circuit, had found that there was a presumption in the case of commissioned photographs that the commissioning party, and not the actual person who created and fixed the work, would own the copyright. See *Easter Seal Soc'y for Crippled Children & Adults, Inc. v. Playboy Enters.*, 815 F.2d 323, 325 (5th Cir. 1987) (discussing background of the commissioning contract as originally distinct from, and later subsumed by, the work-for-hire doctrine in the Second Circuit). This presumed "assignment rule" was later extended to "a more 'radical' presumption that the commissioning party was the surrogate author under the 'works made for hire' language of [1909 Act] § 26." *Id.* at 326. Eventually, a line of cases in the Second Circuit, see *Picture Music, Inc. v. Bourne, Inc.*, 457 F.2d 1213 (2d Cir. 1972); *Brattleboro Publ'g Co. v. Winmill Publ'g Corp.*, 369 F.2d 565 (2d Cir. 1966), and in the Fifth Circuit, see *Murray v. Gelderman*, 566 F.2d 1307 (5th Cir. 1978), held that when a work was created by an independent contractor at the "instance and expense" of the commissioning party, the work was a work made for hire and the commissioning party was presumed to be the author and first owner of copyright. Some courts also emphasized the right to direct and supervise the manner in which the work was created. See *Donaldson Publ'g Co. v. Bregman, Vocco & Conn, Inc.*, 375 F.2d 639, 643 (2d Cir. 1967). Note that these cases focused on the right to supervise and control the creation of the work, and did not require actual supervision and control.

119. See H.R. REP. NO. 94-1476, at 121 (1976); Litman, *supra* note 74, at 889-90.

120. 17 U.S.C. § 101.

of those provisions, and particularly concerning the meaning of the statutory term "employee."

A split in the circuits led to four interpretations:¹²¹ (1) one is an employee whenever another has the right to control the product; (2) one is an employee "when the hiring party has actually wielded control with respect to the creation of a particular work";¹²² (3) whether one is an employee is determined by application of the common law rules of agency; and (4) only a formal, salaried employee is an employee under the statute.

The Supreme Court ultimately resolved the conflict in *Community for Creative Non-Violence v. Reid*, holding that the third interpretation is correct.¹²³ Under that approach, the commissioning party's right to control is a relevant, but not determinative, factor.¹²⁴ The Court rejected the "right to control" test because it would ignore the statutory dichotomy between works created by an employee and commissioned works.¹²⁵ Because most commissioning parties have the "right to specify the characteristics of the product desired," many commissioned works would be considered works made for hire without the need to comply with the writing requirement and regardless of whether or not the work fell into the limited list of commissioned work-for-hire categories.¹²⁶

Although the Court acknowledged that the "actual control" test was slightly less inconsistent with the statutory structure, it rejected that test because the statute creates a clear dichotomy between employee-created and commissioned works, and because "there is no statutory support for an additional dichotomy between commissioned works that are actually controlled and supervised by the hiring party and those that are not."¹²⁷ This seems to correctly analyze the role of control with respect to a determination of whether or not a work is made for hire,¹²⁸ but it ignores a more fundamental concept, suggested by the analysis of the status of the fixator discussed above: If a person actually controls the expression embodied in a work, that person is the *author* of the work, not as a work made for hire, but as the originator and creator of the copyrightable expression.¹²⁹

121. See *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 738–39 (1989).

122. *Id.* at 739.

123. See *id.* at 741.

124. See *id.*

125. *Id.*

126. *Id.*

127. *Id.* at 742.

128. See *Easter Seal Soc'y for Crippled Children & Adults, Inc. v. Playboy Enters.*, 815 F.2d 323, 333–34 (5th Cir. 1987).

129. Thus, in *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir. 1984), the principal Second Circuit case elaborating the "actual control" test for works for hire, an employee of the commissioning party provided sketches for the sculptures at issue, worked very closely with the artisans who actually implemented the expression, and actively supervised and directed the creation of

A recent case illustrates the importance of actual control of expression in authorship determinations. In *Lindsay v. The Wrecked & Abandoned Vessel R.M.S. Titanic*,¹³⁰ the plaintiff, who closely supervised the filming of a motion picture but was not the cinematographer who actually photographed (and therefore fixed) the scenes, was found to be the author. Alexander Lindsay created storyboards for a film documenting the underwater wreck of the Titanic, identified specific camera angles and shooting sequences, designed and constructed underwater lighting towers, and directed the underwater filming from a ship on the surface.¹³¹

the statues. See *id.* at 549. The court did not base its decision on the conclusion that he (and therefore his employer) was the author of the work for that reason, but stated that, "While he did not physically wield the sketching pen and sculpting tools, he stood over the artists and artisans at critical stages of the process, telling them exactly what to do. He was, in a very real sense, the artistic creator." *Id.* at 553.

Unfortunately, the actual control test was mutated into a "right to control" test by the Seventh Circuit, purporting to follow *Aldon* in a case finding that a party who commissioned a computer program was its author, although there seems to have been little evidence that the commissioning party controlled the expression. See *Evans Newton, Inc. v. Chi. Sys. Software*, 793 F.2d 889 (7th Cir. 1986).

A Fourth Circuit case following *Aldon* did a better job. See *Brunswick Beacon, Inc. v. Schock-Hopchas Publ'g Co.*, 810 F.2d 410 (4th Cir. 1987). In that case, the court determined that a newspaper ad created by the newspaper staff at the request of an advertiser was not a work made for hire by the advertiser, because there was no evidence that the advertiser had actually supervised or directed the creation of the ads, although it most likely had the right to do so. See *id.* at 413.

Marci A. Hamilton, although criticizing the *Aldon* approach to works made for hire, noted that the court could have found for *Aldon* on various other bases, including that *Aldon*'s employee may have been either a joint author or even the sole author: "[O]ne might argue that Ginsberg/*Aldon* were sole authors of the piece in the same way a poet is author of a poem that she dictates to a stenographer." Marci A. Hamilton, *Commissioned Works as Works Made for Hire Under the 1976 Copyright Act: Misinterpretation and Injustice*, 135 U. PA. L. REV. 1281, 1303 n.118 (1987). These alternative arguments for the *Aldon* outcome were noted with approval by then-Circuit Judge Ruth Bader Ginsburg in the D.C. Circuit's decision in *CCNV*, 846 F.2d 1485, 1491 n.8, *aff'd*, 490 U.S. 730 (1989).

In the Fifth Circuit's *Easter Seal* decision (which was cited with approval by the U.S. Supreme Court in *CCNV*), Judge Thomas Gee rejected the *Aldon* approach to work for hire, but explained it as an appealing way to prevent a conceded infringer from avoiding liability by arguing that the plaintiff is not the copyright owner. See *Easter Seal*, 815 F.2d at 333. Judge Gee also noted the alternative significance of actual control: "What the [*Aldon*] court did not appear to bear in mind is that any buyer satisfying a seriously enforced 'actual control' test will ordinarily be a coauthor of the work, entitled to bring and win an action for infringement against a third party." *Id.*

Under the analysis endorsed in this Article, the commissioning party who actually supervises the expression of a work will be the sole author if the fixator simply implements or mechanically transposes the instructions of the commissioner, but will be a coauthor with the fixator if the fixator also contributes some original intellectual material.

130. No. 97 Civ. 9248, 1999 WL 816163 (S.D.N.Y. Oct. 13, 1999).

131. *Id.* at *2.

The defendant argued that Lindsay had no copyright because he had not personally dived to the ship and photographed the wreck. The court said that,

All else being equal, where a plaintiff alleges that he exercised such a high degree of control over a film operation—including the type and amount of lighting used, the specific camera angles to be employed, and other detail-intensive artistic elements of a film—such that the final product duplicates his conceptions and visions of what the film should look like, the plaintiff may be said to be an “author” within the meaning of the Copyright Act.¹³²

Obviously, these cases are difficult for the courts, and the outcomes depend on whose expression is ultimately embodied in the work when it is fixed. The *right* to control does not make one an author, because having the mere right to control does not mean that the controller is the originator of authorial expression. The right to control is an economic concept that is relevant to a determination of the existence of an agency relationship, but irrelevant as a determinant of authorship *per se*.

On the other hand, actual control over the creation of particular expression is fundamental to authorship. For example, the fact that Lindsay had the right to control the photographer does not seem to be what persuaded the court; rather, what persuaded the court was that the film “duplicates his conceptions and visions.”¹³³ In other words, the film reflected Lindsay’s *expression* of the idea of filming the Titanic.¹³⁴ That Lindsay “exercised virtually total control over the content of the film” showed a lack of intent to share authorship of a joint work, but if that control had not been combined with specific instructions as to camera angles and what should be filmed, that is, if it had not been *exercised* to assure that what was filmed reflected Lindsay’s cinematic expression, then it is unlikely that Lindsay would have been found to be the author of the film.¹³⁵

Although the *Aldon* approach—defining work made for hire on the basis of actual control alone—has been clearly rejected by the Supreme Court in *CCNV*, actual control over the expression comprising a work as a basis for claiming authorship was not rejected, and has been correctly recognized in cases like *Andrien* and *Lindsay*.¹³⁶ When it is more likely that the controlling party only contributed ideas or information and that the actual expression of the work was provided by the fixator, such as in *Whelan* and

132. *Id.* at *5.

133. *Id.*

134. *See id.*

135. *Id.*

136. *See id.*

Geshwind, the courts find that such a fixator is the author of the work for copyright purposes.

2. Derivative Works

Many works are not completely original, but are built upon prior works, incorporating and transforming preexisting work and adding something new. The 1976 Copyright Act recognizes that copyright can extend to such “derivative works,”¹³⁷ but copyright in the derivative work only extends to material contributed by its author, and not to the preexisting material.¹³⁸ To some extent, most motion pictures are derivative works of some preexisting work. Courts have struggled with several questions concerning derivative works.

a. Originality and Creativity in Derivative Works

How much additional original material must be contributed in order to create a copyrightable derivative work? Generally, courts have required very little. Some courts have held that a new work must only reflect “more than a ‘merely trivial’ variation”¹³⁹ or a “distinguishable variation”¹⁴⁰ from the prior art. Others have suggested that a “substantial variation” is required.¹⁴¹

b. The Relationship Between Owners of Derivative Works and Owners of Preexisting Works

What is the relationship between owners of the derivative work and of the underlying work? The right to prepare derivative works is one of the exclusive rights of the copyright owner of the underlying work.¹⁴² Thus, use of preexisting material without a grant of rights is an infringement, and indeed,

137. 17 U.S.C. § 103(a) (1994).

138. See 17 U.S.C. § 103(b).

139. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951).

140. *Id.* at 102.

141. *Gracen v. Bradford Exch.*, 698 F.2d 300 (7th Cir. 1983); *L. Batlin & Son v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976). There is currently a split in the circuit courts as to whether changes to a work must be original at all in order to constitute an infringement of the right to prepare derivative works, or whether a mere mechanical transformation is sufficient. Compare *Lee v. A.R.T.*, 125 F.3d 580 (7th Cir. 1997) (requiring originality), with *Mirage Editions v. Albuquerque A.R.T. Co.*, 856 F.2d 1341 (9th Cir. 1988) (requiring no originality).

142. See 17 U.S.C. § 106(2) (1994).

copyright is denied to portions of a derivative work that use preexisting material unlawfully.¹⁴³

Is a lawfully created derivative work completely independent of the work upon which it is based, or does later exploitation of the derivative necessarily implicate exploitation rights in the preexisting work? The language of both the 1909 Act and the 1976 Act is somewhat ambiguous on this issue. There was also disagreement among the courts about this ambiguity until a Supreme Court decision arising in the context of a motion picture.¹⁴⁴

There is a policy-based argument for derivative work independence. The fundamental purpose of copyright protection in the United States is to benefit the public by encouraging the creation of original works of authorship. The public is more likely to have access to a given derivative work if the owner of that work, once she has secured the right to use the preexisting material to create the derivative work, does not have to maintain exploitation rights with respect to the preexisting material. Thus, arguably, derivative work independence is consistent with copyright's purpose because it facilitates public access to a derivative work.¹⁴⁵

One court followed this approach in finding that a film based on a preexisting story could continue to be exploited after the derivative work owner's rights in the story lapsed.¹⁴⁶ However, in *Stewart v. Abend*,¹⁴⁷ the Supreme Court rejected that approach and determined that, after a similar lapse of rights, the exploitation of a derivative work film infringed the copyright in the preexisting story.¹⁴⁸ Thus, the derivative work author must have a license

143. See 17 U.S.C. § 103(a) (1994). Another case extended this concept, perhaps beyond its appropriate boundaries. See *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431 (C.D. Cal. Apr. 25, 1989). In that case the plaintiff had written an unauthorized sequel to three earlier *Rocky* films. See *id.* at *1; see also *ROCKY* (Chartoff-Winkler Productions 1976); *ROCKY II* (Chartoff-Winkler Productions 1979); *ROCKY III* (MGM-United Artists 1982). When he sued the producers of *Rocky IV* for copyright infringement, the court granted summary judgment for the defendants, and suggested that Timothy Anderson could own no copyright in his screenplay because he had unlawfully used characters and other material from the earlier films. See *id.* at *6. It seems appropriate that Anderson would own no copyright in portions of his screenplay that simply embodied material he did not own, but less justifiable to deny him copyright in any original material he might have created. See *id.* at *10-*11; see also Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 TEX. L. REV. 989, 1074-77 (1997) (criticizing the *Anderson* rule and recommending a rule more like patent law's "blocking patents" approach).

144. See *Stewart v. Abend*, 495 U.S. 207 (1990).

145. On the other hand, one might argue that derivative work independence might decrease the incentive of a copyright owner to license the creation of derivative works in the first instance, thus reducing the public's access to such works.

146. See *Rohauer v. Killiam Shows, Inc.*, 551 F.2d 484 (2d Cir. 1977).

147. 495 U.S. 207 (1990).

148. The Ninth Circuit, in the decision affirmed in *Stewart*, indicated that the district court should award damages and profits rather than injunctive relief, thus accommodating the public interest in access to such works. See *Abend v. MCA, Inc.*, 863 F.2d 1465, 1480 (9th Cir. 1988),

to prepare the derivative work, plus a further grant of rights to reproduce, distribute, exhibit, or perform the derivative work.¹⁴⁹

3. Compilations and Collective Works

Another type of work protected by copyright that utilizes preexisting material is a "compilation."¹⁵⁰ The 1976 Act defines a compilation as "a work formed by the collection and assembling of preexisting materials . . . that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."¹⁵¹ The underlying material in a compilation need not be separately copyrightable works. If the compilation does utilize separately copyrightable works, it is classified as a "collective work" under the 1976 Act.¹⁵² A collective work is much like a derivative work. The basic difference between the two types of work is that in creating a derivative work the underlying work is recast, transformed, or adapted.¹⁵³

a. Originality and Creativity in Compilations

The 1976 Act is clear in requiring originality as a prerequisite for copyright in compilations.¹⁵⁴ Specifically, for a compilation to receive copyright protection apart from its copyrightable components, there must be originality in the selection, coordination, or arrangement of the components, and the compilation copyright extends only to those aspects of the work, not to the preexisting material.¹⁵⁵

Until recently, courts had accorded copyright protection to informational directories, even absent such originality, based on the industrious labor and skill—the "sweat of the brow"—required to compile the information. The Supreme Court eliminated that anomaly in *Feist Publications, Inc. v. Rural Telephone Service Co.*¹⁵⁶ *Feist* not only clarified that an original selection,

aff'd sub nom. Stewart v. Abend, 495 U.S. 207 (1990). See generally Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147 (1998).

149. In the case of a statutory termination of a grant, the 1976 Act permits the continued exploitation of a derivative work prepared under authority of the grant prior to termination, but not the preparation of new derivative works, reflecting both the public interest in access and the interest of the derivative work owner in protecting its investment in production of such works. See 17 U.S.C. §§ 203, 304(c)(6)(A), 304(d)(1) (1994 & Supp. V 1999).

150. *Id.* § 103(a) (1994).

151. *Id.* § 101 (1994 & Supp. V 1999).

152. *Id.*

153. See H.R. REP. NO. 94-1476, at 57 (1976); 1 NIMMER & NIMMER, *supra* note 17, § 3.02, at 3-5.

154. See 17 U.S.C. § 101.

155. See 17 U.S.C. § 103(b).

156. 499 U.S. 340 (1991).

coordination, or arrangement of components is necessary for copyrightability, but also that the Constitution requires such originality, which includes both independent creation and "some minimal degree of creativity."¹⁵⁷ Although the required creativity is low, a telephone book's "white pages," listing names, addresses, and phone numbers in the traditional alphabetical order was not sufficiently creative and, therefore, was held not subject to copyright protection.¹⁵⁸ *Feist* also expressly rejected "sweat of the brow" as a basis for copyright authorship.¹⁵⁹

b. The Relationship Between Owners of Collective Work and Owners of Preexisting Works

Generally, the copyright in a collective work is separate from that in the individual contributions, which vests in the author of the contribution.¹⁶⁰ Thus, the rights of the collective work's author are usually a matter of contract. In this regard, collective works are much like derivative works in terms of the respective rights of the underlying work owner and of the secondary work owner. Section 201(c) of the 1976 Act, however, provides a statutory presumption in the absence of an express agreement that the collective work owner has "the privilege of reproducing and distributing the contribution as part of that particular collective work, any revisions of that collective work, and any later collective work in the same series."¹⁶¹ The collective work owner is not presumed to have the right to utilize the contributions individually apart from the original collective work, nor to have rights other than reproduction and distribution rights, such as public display or public performance rights.¹⁶²

4. Joint Works

The last type of work involving contributions by more than one author is a "joint work." The term was not used or defined in the 1909 Act, but was developed in judicial decisions,¹⁶³ which held that the key is a "preconcerted

157. *Id.* at 345.

158. *See id.* at 361-64.

159. *Id.* at 352-54.

160. *See* 17 U.S.C. § 201(c) (1994).

161. *Id.*

162. *N.Y. Times Co. v. Tasini*, 531 U.S. 978 (2000).

163. *See* George D. Cary, *Joint Ownership of Copyrights*, in 1 STUDIES ON COPYRIGHT, *supra* note 24, at 689.

common design.”¹⁶⁴ A joint work is defined in the 1976 Copyright Act as “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”¹⁶⁵ The House Report elaborates:

[A] work is “joint” if the authors collaborated with each other, or if each of the authors prepared his or her contribution with the knowledge and intention that it would be merged with the contributions of other authors as “inseparable or interdependent parts of a unitary whole.” The touchstone here is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit, although the parts themselves may be either “inseparable” (as in the case of a novel or painting) or “interdependent” (as in the case of a motion picture, opera, or the words and music of a song).¹⁶⁶

Distinguishing a collective work from a joint work, the House Report states that a joint work entails “elements of merger and unity,”¹⁶⁷ as opposed

164. 1 NIMMER & NIMMER, *supra* note 17, § 6.02, at 6-6. Generally, these cases required a “preconcerted common design.” The earliest cases involved authors who actively collaborated together in creating a unitary work. But later cases found works to be joint, even when the coauthors worked in separate places and at separate times, and even when each coauthor did not know the actual identity of the person who would ultimately make the other contributions to the final joint work, so long as at the time one author made his contribution, he intended that it would “constitute a part of a total work to which another shall make (or already has made) a contribution.” *Id.* § 6.03, at 6-7 (describing holding of *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266 (2d Cir. 1944), *modified*, 140 F.2d 268 (2d Cir. 1944)).

One case, however, extended the joint work doctrine far beyond that, to encompass at its extremes a work created by the addition of material by an assignee of the author, when the author of a musical composition had no intent to create a contribution to a joint work at the time he wrote his music. See *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 221 F.2d 569 (2d Cir. 1955), *modified on reh'g*, 223 F.2d 252 (2d Cir. 1955) (the *12th St. Rag Case*). A later Second Circuit case questioned the validity of the *12th St. Rag Case* doctrine, but, based its rejection of a claim of joint authorship in a song on a further requirement that a contributor must make a “substantial and significant” contribution in order to qualify as a joint work author, at least when the contribution is made to an already-existing work. *Picture Music, Inc. v. Bourne*, 314 F. Supp. 640, 647 (S.D.N.Y. 1970), *aff'd on other grounds*, 457 F.2d 1213 (2d Cir. 1972); see also 1 NIMMER & NIMMER, *supra* note 17, § 6.03, at 6-9 to -10. In its revision of the copyright law, the 1976 Act’s language and its legislative history indicated an intent to follow much of that precedent, but rejected the *12th St. Rag Case* doctrine, thus narrowing the cases in which joint work would be found. See HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 90 (Comm. Print 1961); see also 1 GOLDSTEIN, *supra* note 54, § 4.2.1, at 4:10.

165. 17 U.S.C. § 101 (1994 & Supp. V 1999). Courts should apply the rules in effect when a work was created in determining whether a work was made for hire or joint. See 1 GOLDSTEIN, *supra* note 54, § 4.1, at 4:4 n.14. They have done that as to works made for hire, but less consistently as to joint works. See *id.*

166. H.R. REP. NO. 94-1476, at 120 (1976).

167. *Id.*

to a collective work in which the "key elements" are "assemblage or gathering of 'separate and independent works . . . into a collective whole.'"¹⁶⁸

a. Consequences of Characterizing a Work as "Joint"

Characterizing a work as "joint" rather than "collective" or "derivative" has significant legal consequences. First, in a collective work or a derivative work, the copyright in the preexisting contributions is separate from that in the whole. In a joint work, the components are merged and treated as a single work. Second, the components of a collective or a derivative work have separate, independent terms of protection measured from the death of their respective authors. The term of protection for all components of a joint work will be measured from the death of the last surviving author. Third, unless the parties otherwise agree, the collective work or derivative work owner has no right to exploit the separate contributions, nor do the owners of the contributions have the right to exploit the collective or derivative whole. By contrast, "[t]he authors of a joint work are coowners of copyright in the work."¹⁶⁹ Thus, co-owners of a joint work are treated as tenants in common: Each owner has an independent right to use or to nonexclusively license the entire work, subject to a duty to account to her co-owners.¹⁷⁰ A coauthor could even exploit or license the other coauthor's separate contribution (assuming the contributions are "interdependent" rather than "inseparable").¹⁷¹ Finally, unless the parties otherwise agree, each coauthor holds an equal share in the whole, regardless of the significance of that coauthor's contribution relative to the whole.¹⁷²

Perhaps most significantly, if an author's work is prepared with the intent that it will be merged into a unitary whole (and the other judge-made requirements for joint authorship are satisfied), it would appear that the author

168. *Id.*

169. 17 U.S.C. § 201(a) (1994).

170. See H.R. REP. NO. 94-1476, at 121 (1976).

171. Professor Nancy Spyke argues that this is unfair and often surprising to the other coauthor, at least when the joint work is of the "interdependent" type. She argues that these co-ownership principles should only apply where the joint work is of the "inseparable" type, but acknowledges that legislative change would probably be required. See Nancy Perkins Spyke, *The Joint Work Dilemma: The Separately Copyrightable Contribution Requirement and Co-Ownership Principle*, 11 U. MIAMI ENT. & SPORTS L. REV. 31 (1993). Ironically, the judge-made rule requiring independently copyrightable contributions for all joint works would mean that most, if not all, joint works would be of the "interdependent" types, as it is very difficult to prove independently copyrightable contributions to a work when the contributions are inseparable. As a consequence, under Spyke's argument, joint works should be treated as collective works, rather than being treated akin to tenancies-in-common. See *id.*

172. See 1 NIMMER & NIMMER, *supra* note 17, § 6.08, at 6-28.

does not have ownership of his contribution as a work separate from the joint work. Moreover, initial ownership of the whole (including separable contributions by other authors) vests in all the coauthors.¹⁷³ If that is correct, then the author has no power under the copyright law to terminate the coauthors' rights in his contribution.¹⁷⁴ If, on the other hand, the work is not prepared as a contribution to a joint work, but is treated as an independent work that is subsequently transformed into a derivative work or compiled with other works into a collective work pursuant to a grant from the author, that grant is subject to termination under the Copyright Act.¹⁷⁵

There is surprisingly little authority that a contribution to a joint work has no separate copyright, perhaps because the lack of a separate copyright is assumed by courts and attorneys. It is implied by the use of the terms "merged" and "unitary whole" in the statutory definition.¹⁷⁶ In his thorough study of joint ownership commissioned by the Copyright Office as part of the revision process which led to the 1976 Act, George Cary discussed what appears to be the earliest U.S. case addressing joint authorship:¹⁷⁷ "One who contributes to such a joint production does not retain any separate ownership in his contribution, but it merges into the whole."¹⁷⁸

There is also little authority for the contrary proposition, that a work retains its separate status after it is combined with other contributions into a unitary whole. Cary mentioned another early case, addressing the copyright status of a comic opera, that reached that conclusion¹⁷⁹ perhaps because the copyright in the music had been separately registered.¹⁸⁰ As to motion pictures, the Copyright Office's practice seems consistent with this approach. The *Compendium II of Copyright Office Practices* states that: "Generally, motion pictures by their nature are derivative works. For registration purposes, the motion picture is considered derivative *only* when it incorporates previously registered, published, or public domain material."¹⁸¹

173. See 17 U.S.C. § 201(a).

174. Transfers and licenses of copyright other than by will, for works other than works for hire may be terminated within certain time frames, subject to various limitations and formalities. See 17 U.S.C. §§ 203, 304(c)–(d) (1994 & Supp. V 1999). This power of termination is an important way for authors and certain heirs to derive more economic benefit from their works. See *id.*

175. See 17 U.S.C. §§ 203, 304(c)–(d).

176. 17 U.S.C. § 101 (1994 & Supp. V 1999).

177. See *Maurel v. Smith*, 220 F. 195 (S.D.N.Y. 1915), *aff'd.*, 271 F. 211 (2d Cir. 1921).

178. Cary, *supra* note 163, at 695.

179. See *Herbert v. Fields*, 152 N.Y. Supp. 487 (Sup. Ct. Spec. Term 1915).

180. See Cary, *supra* note 163, at 695.

181. COPYRIGHT OFFICE, COMPENDIUM II OF COPYRIGHT OFFICE PRACTICES § 480.04, at 400–26 (1984) [hereinafter COMPENDIUM] (emphasis added). Note that this provision states that the characterization is "for registration purposes." Hence, it would not necessarily apply to determinations of authorship and ownership, although timely copyright registrations are "prima facie evidence of the validity of the copyright and the facts stated in the certificate." 17 U.S.C.

The Nimmer treatise argues that, when dealing with a joint work comprised of separately identifiable contributions, the rationale for joint authorship rules is to reflect "an implied (if not express) agreement that the product of the several contributions will be jointly regarded as an indivisible whole."¹⁸² This is consistent with the statutory definition, which also focuses on the contributors' intent to "merge" their contributions into a "unitary whole."¹⁸³ By contrast, separate publication or prior registration might demonstrate intent to maintain a work's separate status, and not to lose that status by virtue of its incorporation into a later work. Thus, the intent of the contributors remains the focus of analysis as to the appropriate characterization of a work as either a contribution to a unitary work or as a separate, preexisting work.

It seems reasonable to conclude that if a work is correctly characterized as a contribution to a joint work (which requires, among other things, an intent to merge the contribution into a unitary whole), then it has no separate copyright, but rather is merged into a unitary whole that comprises the joint work. On the other hand, when there is objective evidence of intent to preserve a separate copyright in a contribution, that contribution retains its character as a separate copyrightable work, and a work resulting from the incorporation of that prior work with other material should be viewed as a derivative work, a collective work, or as simply a noncopyrightable collection of separate components.

b. Additional Judge-Made Requirements for Joint Works

Perhaps because of the significant consequences described above, courts impose additional requirements in order for a work to be characterized as joint. Although not yet adopted in all circuits, many courts require, in addition to the express statutory requirements of multiple authors and an intent to merge contributions into a unitary whole, that each putative author's contribution

§ 410(c) (1994). The registration certificate for a screenplay (or any other work) would not normally indicate that it was to be the basis for a later derivative work (such as a film) or a contribution to a joint work, so the certificate would not be *prima facie* evidence of one or the other possibility. In the motion picture context, the screenplay is sometimes, but not always, registered before the motion picture. Such a prior registration would be more common when the screenplay is written "on spec," meaning written independently and not as a work made for hire for a production company. Under the Copyright Office's approach, then, a motion picture is a derivative work of its screenplay when the copyright in the screenplay has been separately registered prior to registration of the motion picture. Otherwise, the screenplay would be either a contribution to a joint work or simply a separate work that, combined with other authorship, comprises part of a motion picture.

182. 1 NIMMER & NIMMER, *supra* note 17, § 6.01, at 6-4.1.

183. 17 U.S.C. § 101 (1994 & Supp. V 1999).

be separately copyrightable, and that the authors intend to share authorship credit. A recent Ninth Circuit decision added a third requirement that, at least in the context of a motion picture, a coauthor “superintend[s] the work by exercising control.”¹⁸⁴ The first two of these requirements will be discussed in this part. Discussion of this third requirement will be deferred to the later discussion addressing authorship of motion pictures more specifically.

(1) Separately Copyrightable Contributions

Several circuits have adopted the rule that, in order for a work to be considered joint, each author’s contribution must be separately copyrightable. There is some support for this in the language of the statute, which requires contributions by two or more “authors.”¹⁸⁵ Thus, it seems clear that each contributor must at least be an “author” in order for the resulting work to be “joint.”¹⁸⁶

184. *Aalmuhammed v. Lee*, 202 F.3d 1227, 1234 (9th Cir. 2000).

185. See 1 GOLDSTEIN, *supra* note 54, § 4.2.1.2, at 4:13.

186. In seeking to limit joint authorship claims, courts may not adequately consider the authorship involved in compilations. In *Childress v. Taylor*, 945 F.2d 500 (2d Cir. 1991), the defendant, an actress who had played the part of “Moms” Mabley in a prior production, did substantial research regarding Mabley’s life, and convinced the plaintiff to write a play about it. See *id.* at 502. Although Alice Childress’s play was presented in two theatres, the two were unable to conclude formal documentation specifying their respective rights in the play. See *id.* at 503. Clarice Taylor hired another playwright to write another play based on Mabley’s life, and Childress sued for copyright infringement. See *id.* at 504. Taylor defended in part by arguing that she had been a joint author of the Childress play. See *id.* Taylor provided the idea for the play, recorded interviews with relatives of Mabley, suggested particular scenes, provided information regarding characters, and wrote jokes and at least one line of dialogue. See *id.* at 502. She worked very closely with Childress as she wrote the play, even continuing to do research as the writing progressed. She had not, however, been physically present with Childress as she wrote the play.

The district court granted summary judgment for Childress, rejecting Taylor’s coauthorship claim primarily on the basis that her contributions were not copyrightable or were not substantial and significant enough to support a claim of joint authorship. See *id.* at 504. It is clear enough that copyright does not extend to ideas, facts, or research per se. See, e.g., *Com. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989). Hence, the district court in *Childress* may have been correct in denying Taylor authorship status on the basis of having submitted the idea of the play to Childress. Other contributions by Taylor, however, seem to come closer to authorship, particularly when it is recognized that fixation is correctly analyzed as a separate requirement for copyrightability, but not for authorship. See *Childress*, 945 F.2d at 509. For example, the selection, ordering and arrangement of facts can be copyrightable as a compilation, if original and minimally creative. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358 (1991). The specific way in which facts are expressed can also be copyrightable.

Taylor may not have been responsible for the way the facts were expressed in the play; but it appears at least arguable that she was substantially involved in the selection of the facts, and possibly in their ordering and arrangement. See *Childress*, 945 F.2d at 502. The district court opinion does not discuss this possible basis for Taylor’s coauthorship claim. The opinion notes that facts and research are not copyrightable, and then focuses on the idea that what is protectable is expression. See *id.* at 504. It seems possible at least that Taylor’s contribution might have been

Melville and David Nimmer argue in their treatise that to be a joint author, a contributor need only contribute more than a *de minimis* contribution, such as a mere word or a line of text.¹⁸⁷ The treatise also argues that the concept of *de minimis* in this context may be different from the usual standard for copyrightability, in that a contributor of only ideas, which are then further elaborated and fixed by another, should be considered a coauthor of the resulting work. It notes, however, that the concept has been “soundly rejected” in architectural works cases, and that, while still an open question in some courts, it is not the prevailing view.¹⁸⁸

On the other hand, Paul Goldstein argues in his treatise that a work is not “joint,” and that a contributor does not acquire the co-ownership that follows from that characterization, unless she contributes original expression.¹⁸⁹ Goldstein argues that the concept follows not only from the statutory requirement of two or more “authors,” but also from the fact that material not protectable by copyright is in the public domain, and may be used by anyone.

found to be sufficient to constitute a compilation, or that there was a material issue of fact on that issue, on appeal. When one collaborator contributes to an original selection, ordering, or arrangement of material, what he has contributed is authorship, even if it is not fixed. Moreover, such authorship would be separately copyrightable material, if that contribution was fixed during the process of elaboration by the other author. *See id.* If Taylor did contribute to the original selection of material, it was fixed with her authority by Childress. The court of appeals did not reach this issue, however, as it found that the play could not be a joint work because Childress did not have the intent to share authorship with Taylor. *See id.* at 509.

187. 1 NIMMER & NIMMER, *supra* note 17, § 6.07, at 6-23.

188. *Id.* The insistence on separately copyrightable contributions can be traced to cases in which architects incorporated their clients' ideas into plans, and has been followed in textile design and even in some computer program cases. *See* 1 GOLDSTEIN, *supra* note 54, § 4.2.1, at 4:14. However, it seems less apt in cases of more creative collaboration, although ironically it has been in just such cases that many courts have implemented the rule. *Cf.* Thomson v. Larson, 147 F.3d 195 (2d Cir. 1998); Erickson v. Trinity Theatre, Inc., 13 F.3d 1061 (7th Cir. 1994); Childress, 945 F.2d at 500.

Part of the problem may be courts' fear of extending copyright to ideas. Melville and David Nimmer argue that coauthorship status should extend to mere contributors of ideas, because “copyright's goal of fostering creativity is best served, particularly in the motion picture context, by rewarding all parties who labor together to unite idea with form, and that copyright protection should extend both to the contributor of the skeletal ideas and the contributor who fleshes out the project.” 1 NIMMER & NIMMER, *supra* note 17, § 6.07, at 6-24. Although the denial of copyright protection to ideas is an important fundamental concept in copyright, the Nimmers' argument is consistent with one rationale they offer for recognizing joint works—that the joint work characterization reflects a legal default rule implementing the likely intent of the parties. A person who takes someone else's idea and adds expression and who would not have created the expression but for the idea might be presumed to have agreed to share the result with the idea-submitter. The understandable, and at least theoretically correct, denial of copyright to ideas supports the judicial rejection of joint work claims by a contributor of only ideas. However, to the extent a collaborator contributes not just ideas but also expression of those ideas, she should be considered a coauthor of the resulting work, even if she did not personally fix her contribution in a tangible medium of expression. *See id.* § 6.07, at 6-25.

189. *See* 1 GOLDSTEIN, *supra* note 54, § 4.2.1, at 4:13.

The majority of courts that have considered the issue have followed Goldstein's analysis, but some seem to have gone even further in requiring that not only must expression be contributed, but also that the contributions must be separately copyrightable, that is, fixed in a tangible medium expression.¹⁹⁰

(2) Intent to Share "Authorship"

The statutory definition of joint works clearly requires appropriate intent on the part of each contributor at the time of creation.¹⁹¹ The intent expressly required by the statute is that each contribution will be merged into a unitary whole. Concerned that requiring only the intent to merge would make many contributors coauthors who are not customarily considered to have the resulting ownership interest, Judge Jon O. Newman rejected a claim of coauthorship in *Childress v. Taylor*,¹⁹² requiring that putative coauthors also have the intent to regard themselves as joint authors.¹⁹³ When there is no contract, Judge Newman suggested that a "useful test" is whether all the participants receive billing credit, showing "how the parties implicitly regarded their undertaking."¹⁹⁴ However, Judge Newman limited the importance of this inquiry to situations "where one person . . . is indisputably the dominant author of the work and the only issue is whether that person is the sole author or she and another . . . are joint authors."¹⁹⁵ He admitted that "[t]his concern requires

190. See *Erickson*, 13 F.3d at 1070–71. To the extent that courts have also required that a coauthor's contributions be fixed in order to qualify, they go beyond the statutory requirements. As discussed above, the requirement of authorship is that a contribution be original, that is, that it originate with the author, be more than just an idea, and embody some minimal degree of intellectual, creative labor. See 1 GOLDSTEIN, *supra* note 54, § 4.2.1, at 4:13. As discussed above, fixation is a separate requirement of copyrightability under the federal statute; it is not a requirement of authorship per se. See *supra* Part I.B.3.c. Because fixation is not required for authorship, it should not be required for coauthorship. Goldstein recognized this in his treatise: "Further, it is not necessary to the creation of a joint work that each collaborator actually fix the work in a tangible medium of expression." 1 GOLDSTEIN, *supra* note 54, § 4.2.1.2, at 4:15. Failure to consider fixation as a separate requirement for copyrightability rather than as part of authorship has led to confusion and perhaps erroneous results. This seems to be especially problematic where the contributions of the putative coauthors are "inseparable." See *Spyke*, *supra* note 171, at 45–46. In that event, it is difficult for a potential author, particularly a secondary contributor who does not actually fix the work, to qualify.

191. See 17 U.S.C. § 101 (1994 & Supp. V 1999) (stating that joint work is "a work prepared . . . with the intention . . ."). It is also supported in the legislative history: "The touchstone here is the intention, at the time the writing is done . . ." H.R. REP. NO. 94-1476, at 120 (1976).

192. 945 F.2d 500 (2d Cir. 1991).

193. See *Id.* at 507–08.

194. *Id.*

195. *Id.*

less exacting consideration in the context of traditional forms of collaboration, such as between the creators of the words and music of a song.”¹⁹⁶

There is no support for this requirement in the language of the statute, and although it has been criticized by some scholars¹⁹⁷ it has been widely followed.¹⁹⁸ Motion pictures, however, are a traditional form of collaboration, so a court might choose to distinguish a coauthorship claim in the context of a motion picture and to de-emphasize the intent to share authorship of a joint work requirement.¹⁹⁹

In another theatrical collaboration case in which the secondary author contributed copyrightable material, thus satisfying that prong of the judicially created requirements, lack of intent to share authorship credit was determinative. The plaintiff in *Thomson v. Larson*,²⁰⁰ a dramaturg²⁰¹ and a New York

196. *Id.*

197. In his article, *Who Owns the Movies?*, Seth Gorman argues that the *Childress* intent requirement distorts the delicate balance between authors and publisher/studios that was made in the 1976 Act. See Seth F. Gorman, *Who Owns the Movies? Joint Authorship Under the Copyright Act of 1976 After Childress v. Taylor and Thomson v. Larson*, 7 UCLA ENT. L. REV. 1 (1999). He argues that the 1909 Act was much less favorable to authors, that the 1976 Act reflects a new balance more favorable to artists, and that the enhanced intent requirement imposed in *Childress* upsets that balance. See *id.* at 24. He also argues that one important purpose of the new Act was to increase consistency and certainty of ownership, and that the *Childress* intent requirement reduces that certainty. See *id.* at 30. Goldstein expresses a similar critique of the enhanced intent rule and suggests that an alternate way for courts to protect against the problem of an overreaching contributor is to find an implied license based on the nature of the relationship. See 1 GOLDSTEIN, *supra* note 54, § 4.2.1, at 4:12.

198. See 1 NIMMER & NIMMER, *supra* note 17, § 6.07, at 6-26.

199. On the one hand, motion pictures might be characterized as having dominant author(s), often the director or producer (as a work-for-hire employer). On the other hand, a motion picture is a “traditional form of collaboration.” H.R. REP. NO. 94-1476, at 120 (1976). As to “traditional collaborators,” intent to share authorship credit is less significant—an egomaniacal director should not be able to deny joint authorship status to traditional collaborators by claiming that he did not intend to share authorship. Should courts more closely assess intent in order to reject potential spurious claims by nontraditional secondary contributors? This does not seem either appropriate or necessary for courts to achieve appropriate results. It is inappropriate by analogy to the “aesthetic nondiscrimination concept,” under which it is inappropriate for courts to distinguish which works are sufficiently creative to merit copyright protection. Similarly, courts do not seem well situated to decide which contributors are “traditional collaborators” and which are not, particularly in the context of highly collaborative works such as motion pictures. The distinction does not seem necessary because the burden to prove that an individual contributed authorial expression to a work would generally be on the contributor. If that burden cannot be met, the contributor is not a coauthor. Moreover, even when it is met, in most instances courts could find an implied license to protect the respective interests of the contributors.

200. 147 F.3d 195 (2d Cir. 1998).

201. Dramaturgs customarily assist playwrights and directors in developing and producing theatrical works, sometimes even contributing dramatic elements and even specific expression. *Thomson*, 147 F.3d at 197 n.5. They do not generally share authorship credit or receive high pay or author royalties. In this case, Lynn Thomson’s involvement in the writing of the play *Rent* seems to have become more substantial over time.

University professor, alleged that she had helped develop the plot and theme, created character elements, and written dialogue and song lyrics for the musical at issue. The play, *Rent*, became an extremely successful Broadway production, and Lynn Thomson sought from Jonathan Larson's heirs a credit and a percentage of the author's royalties. Negotiations broke down, and Thomson sued for a declaratory judgment that she was a coauthor, and for an accounting. She did not assert a claim of copyright infringement. After a bench trial, Judge Lewis A. Kaplan rejected the claim of joint authorship and dismissed the other claims. In analyzing the joint authorship claim, however, he determined that Thomson had contributed more than a *de minimis* amount of copyrightable material.²⁰² The outcome turned on whether Larson had the necessary intent to share authorship.

The *Thomson* court explored in more detail the nature of the required intent, finding that the proper inquiry is not as to the subjective state of mind of the parties, but rather addresses objective, "factual indicia of ownership and authorship,"²⁰³ including the right to decide what changes are made in the work, billing and credit, the form of agreements entered into with third parties, and other testimony as to actions by Larson that demonstrated a lack of intent to consider Thomson a coauthor. Evidence showed that Larson jealously guarded his decision-making authority as to what was included in *Rent*, that, although he gave Thomson more substantial credit than is usually the case for a dramaturg, he always reserved authorship credit to himself; that he was always identified as the sole author in contracts with third parties; and that other behavior evidenced that he understood the concept of coauthorship but rejected any suggestion that he share authorship of *Rent*. The court concluded that Larson never intended to share authorship with Thomson, and affirmed the lower court's decision that *Rent* was not a joint work.

Aside from its detailed examination of objective elements that might evidence intent to share authorship, *Thomson* demonstrates that a finding that a work is not a joint work under the judicially enhanced requirements is a potential double-edged sword, in that the plaintiff unsuccessfully claiming joint authorship may thereafter assert an infringement claim against her collaborator. On appeal, Thomson argued that, if *Rent* was not a joint work,

202. As seems typical in these collaboration cases, see, for example, *Childress, Erickson v. Trinity Theatre*, only one collaborator, here Jonathan Larson, actually did the physical writing, and neither Thomson nor Larson kept ongoing notes as to Thomson's specific contributions. Unfortunately, Larson died of an aortic aneurysm hours after the dress rehearsal for the off-Broadway production. Unlike *Childress*, however, Thomson and Larson were physically in the same room as the writing was done, and there was an earlier version of the play with which to compare the revised version upon which Thomson collaborated. Thus, there was stronger evidence in this case that Thomson had contributed copyrightable material.

203. *Thomson*, 147 F.3d at 201.

then she retained ownership of copyright in her own contributions, which the lower court had found were indeed separately copyrightable. Larson, on the other hand, argued that if Thomson failed in her joint work claim, Thomson should also have no copyright interest in her own contributions, or, alternatively, that she licensed the contributions to Larson. The court of appeals avoided addressing this issue, because Thomson had not included a claim for copyright infringement in her complaint.²⁰⁴

A few days after the appellate court's judgment, Thomson filed a complaint for copyright infringement seeking injunctive and other relief against Larson's heirs, the producers of the show, and other defendants who were exploiting rights in it. Reportedly, the parties quickly settled that claim, paying Thomson an amount equivalent to what she had sought in her first complaint.

Hence, in the absence of a work-for-hire arrangement or some other express or implied transfer of rights, under which a contributor provides copyrightable material but is found not to be a coauthor due to lack of intent, the author who incorporates that material in her work is potentially a copyright infringer. If it is difficult to remove the material, the author is at risk that the entire work may be enjoined.²⁰⁵

Factors such as who initiated the collaboration and the timing of the collaboration can also be important in a coauthorship dispute. In *Childress*, the secondary contributor suggested the writing of a play, but the dominant author thereafter wrote the play with only limited involvement of the secondary contributor. In *Thomson*, the dominant author had written an earlier version of the play and recruited the secondary contributor's assistance in revising the play.

In another case, *Maurizio v. Goldsmith*,²⁰⁶ the dominant author recruited a secondary author's help in the early stages of writing a book, and found

204. See *id.*

205. It is more likely that the contributions will be separable when a secondary author has contributed independently copyrightable material, in which event the primary author will have the option to remove the offending contributions. Thomson appears to have contributed both separable material (for example, song lyrics) and material that would be difficult to separate (for example character, plot, and dialogue elements). Moreover, *Rent* had not been successful in its early versions, prior to Thomson's contribution. For both of those reasons, presumably it would have been difficult or undesirable to eliminate Thomson's contributions, so a favorable settlement to Thomson was the only remaining option.

206. 84 F. Supp. 2d 455 (S.D.N.Y. 2000). In *Maurizio*, the defendant wrote a novel entitled *The First Wives Club*, which became a successful motion picture. In the early stages of working on the novel, Olivia Goldsmith, then an aspiring novelist, recruited her new friend Cynthia Maurizio to help her write the book by working together on an outline, allegedly promising that Maurizio could make "a lot of money" and that she would introduce Maurizio to her agent "as a co-writer of the novel and the outline of the novel." *Id.* at 458. They collaborated on the outline and Maurizio also wrote two draft chapters for the book. When Maurizio attempted to negotiate a more

herself at risk of a successful copyright claim by the secondary author when she utilized some of the secondary author's contributions in the book, because the court found issues of fact as to the necessary intent. The *Maurizio* court distinguished *Childress* because there was evidence that Olivia Goldsmith had intended to share authorship with Cynthia Maurizio. Before Goldsmith had proceeded far in the writing process, she had requested Maurizio to work with her on the outline and chapters. That created at least an issue of material fact as to intent. Summary judgment for the defendant was denied on the infringement claim.²⁰⁷ This case suggests that a person who solicits another's contribution prior to the creation of work will find it more difficult to succeed in arguing that she did not have the intent to share authorship, even if there is other objective behavior indicating that she lacked the intent.²⁰⁸

What do the courts mean by the intent to share authorship? They do not mean that the parties "intended the legal consequences which flowed from [their] prior acts,"²⁰⁹ but "some distinguishing characteristic of the relationship must be understood in order for it to be the subject of their intent."²¹⁰ One might conclude that the distinguishing characteristic is that they must intend that their contributions will be parts of a unitary whole, as required

formal arrangement whereby she would receive coauthorship credit and 25 percent of the profits, the relationship deteriorated. Goldsmith proceeded to write the novel herself with another collaborator, and motion picture rights were optioned to Paramount Pictures. Maurizio then filed a state court action against Goldsmith for breach of contract and other claims. Summary judgment was awarded Goldsmith on the basis that the Copyright Act preempted the claim. Five years after she learned that Goldsmith had written and sold the book, Maurizio filed a copyright claim in federal court. The court found that the coauthorship claim was barred under the Copyright Act's statute of limitations, but in addressing Goldsmith's motion for summary judgment as to the non-time barred copyright infringement claim, the court considered the joint authorship claim.

207. The court found that the copyrightable contribution requirement was satisfied because Maurizio produced language "as a tangible form of expression," not just uncopyrightable ideas. Goldsmith argued that the material was not independently created by Maurizio, but the court found the question of originality was also a question of fact. Maurizio also asserted Lanham Act, 15 U.S.C. §§ 1051–1096, 1111–1129 (1994 & Supp. V 1999), and state unfair competition claims for the failure to credit her as a coauthor. The court denied summary judgment on those claims, because, although the actual copyright coauthorship claim was barred, the evidence as to coauthorship could still support a false credit claim. See *Maurizio*, 84 F. Supp. 2d at 468. The court also found that Maurizio's misappropriation of idea claim was not preempted by copyright law. See *id.*

208. Most of the facts that influenced the *Thomson* court also existed here—Goldsmith only credited herself as author on the book, entered into contracts in solely her name, and controlled what ultimately was included in the book. The court distinguished *Thomson* on the basis that

Goldsmith's request that Maurizio coauthor [the book] with her, made before much of Maurizio's work on the outline and draft chapters . . . constitutes stronger evidence of intent than the statement attributed to Larson in *Thomson* [that he would always acknowledge her contribution and would never say that he wrote what Thomson wrote].

Maurizio, 84 F. Supp. 2d at 466.

209. *Childress v. Taylor*, 945 F.2d 500, 508 (2d Cir. 1991) (quoting from appellants' brief).

210. *Id.*

by the express statutory language, but that is apparently not what the *Childress* court meant.²¹¹ Unfortunately, the *Childress* court did not provide a more positive rule for inquiry, but stated that a “useful test will be whether, in the absence of contractual agreements concerning listed authorship, each participant intended that all would be identified as co-authors.”²¹² The *Thomson* court confirmed that the inquiry “is not strictly subjective,”²¹³ and looked to “billing and credit, decision making, and the right to enter into contracts.”²¹⁴ The latter two inquiries seem to have more to do with ownership and economic control than with authorship.

The billing inquiry, while perhaps relevant to show intent of the dominant author in the case of a work with a simple “by” credit, is less helpful in evidencing the contributors’ intent for works such as motion pictures. The “film by” credit sometimes accorded the director of a motion picture is highly controversial and reflects economic power and marketing clout as much as authorial contribution.²¹⁵ Numerous others who clearly contribute authorship to a film do not share a “film by” credit, but are accorded other forms of credit on a film for their particular contributions. Those other specific credits might be deemed insufficient under cases like *Thomson*, in which crediting the plaintiff as “dramaturg” was not adequate to show an intent to share authorship of the play. But credit for a particular important contribution to a motion picture seems clearly to show intent of the various participants in the making of the film to regard themselves as coauthors of a unitary work prepared by multiple authors. *Thomson* should be distinguished and according credit for a contributor’s particular contributions to a motion picture should be considered evidence of intent to share authorship of the whole.

5. Distinguishing Joint Works from Derivative and Collective Works.

The legal rights and obligations between the author of a derivative or collective work and the author of its component preexisting works are significantly different from the legal rights and obligations between coauthors of a joint work. Yet distinguishing between these types of works can be difficult for courts.

211. The court stated that “an inquiry so limited would extend joint authors status to many persons who are not likely to have been within the contemplation of Congress.” *Id.* at 507.

212. *Id.* at 508. The court noted that such an inquiry will not always be helpful, for example, in the case of a “ghost writer.” *Id.*

213. *Thomson v. Larson*, 147 F.3d 195, 201 (2d Cir. 1998).

214. *Id.*

215. But see the “film by” credit for *ALL I WANNA DO* (Alliance Comm’ns Corp. 1998): “A film by all the people who worked on it.” This film was written and directed by Sarah Kernochan, daughter of noted author’s rights advocate and professor, John Kernochan.

The legal distinction turns on the intention of the authors at the time of creation. Under the statutory language, if at the time of creation the authors intend to merge their contributions into either inseparable or interdependent parts of a unitary whole, then the resulting work is joint. Otherwise, the resulting work will be derivative (if the preexisting works are transformed) or collective (if the preexisting works are not transformed, but only selected, coordinated, or arranged in an original way). Alternately, if there is no intent to merge, no transformation, and no original selection, coordination, or arrangement, the authors own separate copyrights in their contributions.

Nimmer and Nimmer note in their treatise that “this intention standard is not air-tight,”²¹⁶ as the author of a work may have both the intent that her work will be merged with the work of others into a unitary work and that it will be separately exploited.²¹⁷ Thus, if A and B create joint work X, and B later uses the entire work, or either party’s contribution, in another work Y, is the later work a derivative work of X or another joint work, with both A and B as coauthors? In *Weissman v. Freeman*,²¹⁸ the court concluded that Y was a derivative work and that A could not claim to be a coauthor of that work. A similar conclusion was reached in *Ashton-Tate v. Ross*²¹⁹ in the Ninth Circuit. However, as Nimmer points out, if B creates Y with the intent that his contribution (the new material in Y) will be merged with the co-owned material from X, then Y would be a joint work of A and B, rather than a derivative work authored only by B.²²⁰

Nimmer and Nimmer suggest that what should be determinative to resolve this problem is the authors’ “primary intent,” but acknowledge that in close cases, it may be hard to prove which was the primary and which was a subsidiary intent. In such a case “the distinction between joint and derivative and collective works remains obscure.”²²¹

E. Summary

An author of a work (or of a contribution to a multiple-author work) is a person who originates minimally creative expression. Although unnecessary

216. 1 NIMMER & NIMMER, *supra* note 17, § 6.05, at 6-14.

217. Nimmer uses the motion picture screenplay and underlying literary property as an example of this problem. See *id.* This issue will be discussed more specifically as to motion pictures. See *infra* Part II.

218. 868 F.2d 1313 (2d Cir. 1989).

219. 916 F.2d 516 (9th Cir. 1990).

220. See 1 NIMMER & NIMMER, *supra* note 17, § 6.05, at 6-13. Of course, this assumes that the other requirements for a finding of joint authorship, which may include separately copyrightable contributions and intent to share authorship, are satisfied. See *id.*

221. *Id.* § 6.05, at 6-14.

for authorship, the work will not be protected by federal copyright unless that expression is also fixed in a tangible medium by or under the authority of the author.

It may help to clarify analysis of authorship of a work to break the process of creation and fixation of a work down into several components. Initially, there may be an individual who generates the idea for the work, whom we will call the "initiator." Next, there is the individual who generates the creative expression of the idea, whom we will call the "creator."²²² Then there is the individual who actually embodies the expression in a tangible medium, whom we will call the "fixator." These roles may be performed by the same person, or may be different persons. Ordinarily the author of a work will be the creator, unless the resulting work is made for hire, in which event, the employer or commissioner of the creator is the author for copyright purposes. As always, the author is the first owner of the copyright.²²³

If there are multiple contributors, one creator may be considered the dominant creator, or the creator who contributes most of the expression or who controls what expression is ultimately included in the work.

If separate individuals create the expression and fix the work, the fixator is not a creator/author, unless she also contributes additional original, minimally creative expression. That would not be the case to the extent that expression generated during the process of fixation is rote or mechanical,²²⁴ or is actually controlled by the nonfixator.²²⁵ If the fixator contributes original, minimally creative expression, the resulting work will be a work of joint authorship if both parties have the necessary intent at the time of creation of their respective contributions and satisfy the other formal requirements for a joint work. If either party lacks that intent—for example if the dominant creator did not intend that his work would be merged with expressive contributions by a fixator—then the result would either be (1) two separate works

222. It has been argued that most authors do not actually create original material, but rather restate preexisting material, and that maintaining a vigorous public domain permits authors to avoid the otherwise difficult or impossible task of proving that their expression is original. See Litman, *The Public Domain*, *supra* note 11, at 966–68. In virtually all copyright infringement cases, however, the plaintiff copyright owner will not have to prove originality. The burden of proving nonoriginality will shift to the defendant, because the plaintiff's copyright registration constitutes *prima facie* evidence of the validity of the copyright. In any event, the use of the term "creator" is not intended to suggest that any particular work is indeed creative or novel, but simply to distinguish the expressive elaboration of the conception from the intellectual conception and the physical embodiment of that conception. See *supra* Part I.B.3.

223. See 17 U.S.C. § 201(a) (1994).

224. See, e.g., *Andrien v. S. Ocean Country Chamber of Commerce*, 927 F.2d 132, 135 (3d Cir. 1991).

225. See, e.g., *Lindsay v. The Wrecked & Abandoned Vessel R.M.S. Titanic*, No. 97 Civ. 9248, 1999 WL 816163, at *5 (S.D.N.Y. Oct. 13, 1999).

(the first creator's contribution and the fixator's contribution), (2) a preexisting work and a derivative work, to the extent that one author transforms the other's contributions in an original, minimally creative way, or (3) a compilation including separate works, to the extent that one author selects, coordinates, or arranges her contributions with the first author's contributions in an original, minimally creative way and the contributions are not transformed. Of course, if (2) or (3) applies, there would also be at least two works (the first author's work, plus either a derivative work or a compilation work).

To the extent that any creator under this analysis is an employee working within the scope of his employment (as determined by the common law rules of agency), or creates his contribution at the instance and expense of a commissioning party pursuant to a written agreement signed by both parties (assuming the work falls into the permitted categories, including contributions to a motion picture), the employer/commissioner would be deemed the author of that creator's contribution and would step into the shoes of that creator as a joint author or author of a separate work, derivative work, or collective work, as the case may be. This would be the case, even though the employer/commissioning party is neither a creator nor a fixator.

II. THE NATURE OF A MOTION PICTURE WORK AND MOTION PICTURE AUTHORSHIP

A. Overview

In the earliest days of film, there was either a single filmmaker, or a stage manager and a camera operator, filming either simple images of real events or, sometimes, more imaginative special effects. The films were novelties, but hardly works of genius.²²⁶ Film companies were owned by inventors and manufacturers, such as Thomas Edison, and film was viewed more as another form of manufacturing by artisans than as an art form.²²⁷

226. As Marjut Salokannel has observed, *Early cinema* was primarily concerned with the production of animated pictures with no specific cinematic form of representation . . . Unlike traditional arts, which were seen as a result of human creative effort, the creation of genius, the cinema was seen merely as an extension of photographic expression, as a way of reproducing reality with the aid of a machine. It was not until some 10–15 years after the invention of this new medium that it began to claim its place within the field of arts.

MARJUT SALOKANNEL, OWNERSHIP OF RIGHTS IN AUDIOVISUAL PRODUCTIONS: A COMPARATIVE STUDY 11 (1997).

227. See *id.* at 11–12. Salokannel mentions early filmmaker, George Méliès as an example: Méliès did not regard himself as the author of a film but rather as a manufacturer, an artisan of cinema. He made the film in the proper sense of the word: he was the author and screenwriter, director, choreographer, set decorator, dress and make-up designer, as well as

Gradually, as the public tired of the mere novelty of seeing moving pictures, filmmakers developed the motion picture as a vehicle of story telling²²⁸ and utilized more sophisticated production techniques such as editing²²⁹ and camera motion.²³⁰ As that occurred, specialization and division of labor became necessary, partly because the exhibition industry needed a large supply of films to satisfy its audiences. First, the cameraman emerged, then the director, and finally the screenwriter.²³¹ At the same time, film developed as an art form of its own, rather than just a photographic documentary of real events or the optical recording of a stage play. Some directors began to be recognized as creative artists, and in the 1950s a group of French film critics associated with the *Cahiers du Cinema* focused attention on the director as the *auteur* of a film, which was said to reflect the personality, the "genius," of the director.²³²

the actor. He took care of the technical side of production from creating the special effects to using the cameras and other machines. He also assured the commercial exploitation of the film by being the producer and distributor of all his films. Other filmmakers of the period were involved to a similar degree.

Id. at 12 n.11. Note that Méliès was one of the first filmmakers to use film to tell a story and to use imaginative special effects, yet a noted film historian says of him:

Méliès . . . was not a true *cinéaste*. He was a dedicated showman; he regarded the camera as an invaluable prop which improved beyond measure many of his stage effects. With films he could reach a far wider audience. Although he employed new effects, such as a form of dissolve, Méliès's camera recorded the customary theatrical mid-long-shot—from the front seat of the stalls.

KEVIN BROWNLOW, *THE PARADE'S GONE BY* . . . 9 (1968).

228. "[I]t was the emergence of the story film, in 1904–1906, that drew people to the nickelodeons." Eileen Bowser, *The Transformation of Cinema: 1907–1915*, in 2 *HISTORY OF THE AMERICAN CINEMA* 53 (Charles Harpole ed., 1990).

229. "The development of new ways to connect shots, or editing, was probably the most important change in film form to take place during the 1907–1909 period." *Id.* at 57.

230. *See id.* at 249–52.

231. *See* SALOKANNEL, *supra* note 226, at 12–13.

232. *See id.* at 15. European film critics had viewed certain primarily European films as works of genius or romantic authorship before the *auteur* movement. The *Cahiers du Cinema* critics broadened the recognition of such directors to include American commercial film makers, searching for and finding "genius" and the expression of personality in Hollywood films that had previously not been viewed as "art" by the European critical establishment. Thus, "auteurism" reflected a rebirth of the concept of romantic authorship at a time when criticism in other fields was moving away from that conception. *See* JOHN CAUGHIE, *THEORIES OF AUTHORSHIP: A READER* 10–11 (John Caughie ed., 1981).

The very subjective approach to film criticism reflected in auteurism, with its focus on the personality of the director, was later succeeded by other critical approaches, such as "auteurism-structuralism," which adapted ideas from Claude Levi-Strauss's structuralist approach to linguistic anthropology and focused attention away from the personality of the director, to meanings found in the film itself as a myth or language. In the 1970s the semiotics approach, with its focus on the film as a "text," the meaning of which is constructed as much by the viewer as by the filmmaker, found its way into film criticism. *See generally id.* The concept of the author for purposes of film

Whether or not film critics regard film as a director's art, from a legal point of view, filmmaking is usually highly collaborative, and in most cases there are numerous individuals who contribute authorship to a film.²³³ Neither the 1909 Copyright Act nor the 1976 Act specifically address the question; which of the many individuals who work on a film are authors for copyright purposes? Thus, the analysis set forth in the previous part of this Article should be applied, and the contributions made by the many participants in the creation of a film considered, in an attempt to determine who the authors are. As a general proposition, ignoring for a moment the concept of work made for hire, the authors of a film are the creators—the individuals who contribute original, minimally creative expression to the film.

In most cases these issues of authorship are avoided because in the United States, contributors to a film prepare their work as a work made for hire for the producer.²³⁴ Yet there can be instances in which work-for-hire arrangements are not made or somehow fail.²³⁵ In that event, it may be necessary for attorneys and courts to analyze whether a participant in the filmmaking process has prepared authorial material. An analytical approach to authorship may also be helpful in determining what is covered by the copyright in a motion picture that is created as a work made for hire, because the employer is only an author to the extent its employees contributed copyrightable material. Thus, it is important for courts and attorneys to understand authorship concepts.

Of course, each film is different, with different degrees of authorship and collaboration.²³⁶ At the simplest level, it is conceivable that some films

criticism and artistic or sociocultural analysis is not necessarily relevant for purposes of a legal definition of authorship. Ultimately, legal analysis and aesthetic criticism serve different purposes.

233. See TECHNOLOGICAL ALTERATIONS, *supra* note 70, at 30–31; Kernochan, *supra* note 70, at 360.

234. See Kernochan, *supra* note 70, at 361; see also H.R. REP. NO. 94-1476, at 121 (1976).

235. The practice of the major U.S. motion picture studios varies as to requiring signed agreements from all participants in the making of a film. All of the majors require agreements granting rights in literary material to be signed. They also generally require signed documentation for screenwriters before officially permitting services to commence. As to producers, directors, and actors, while they desire to have signed documentation, they are not always successful in obtaining it. Some studios have made it their official policy not to permit an individual to work until formal documentation is signed, while others do not currently enforce such a policy. Although signed agreements are generally preferable, particularly in order to have a single, integrated document specifying the rights and obligations of the parties, there may be strategic reasons on either party's side to leave certain issues "open." Moreover, given the large number of individuals participating in the creation of a film, even when it is a company's policy to prohibit work until documentation is signed, mistakes can be made, or individuals may purport to engage the services of contributors or may utilize material in creating a film without the knowledge of the studio legal department and without formal documentation.

236. The degree of collaboration may be the result of many factors. Some film critics view it as the result of strength of personality. "[P]rovided he has any talent, it is the director, rather than

reflect no authorship and therefore have no author. For example, consider a video surveillance camera at a convenience store or a bank. Is the resulting tape a work of authorship? There is no active authorship in the making of the tape, no collaboration. However, is there adequate originality in the photographic elements: selection of the camera, the choice of subject matter, the angle of the photo, the lighting, and the determination of the time at which the photo is taken? Courts have held that documentary news videos²³⁷ and amateur photography of newsworthy events²³⁸ are sufficiently original on that basis.²³⁹ The surveillance camera hypothetical is much closer to the margin of insufficient originality.²⁴⁰ There is arguably choice of subject matter in a general sense and choice of the camera and of the angle of the photo, but probably not any choice as to the lighting and the time of the photo. Even the angle of the photo and the choice of camera may be dictated by external or functional requirements, rather than by aesthetic preferences. Hence, copyrightability of such a film is debatable, but it would seem that there is precedent for copyrightability of virtually any other type of motion picture.

An individual can be the sole author of a film. For example, when a person makes a home video using his own videocamera the aesthetic choices

anyone else, who determines what finally appears on the screen." Ian Cameron, *Films, Directors and Critics*, MOVIE, Sept. 1962, reprinted in CAUGHIE, *supra* note 232, at 53. But Ian Cameron states later in the same article:

There are, however, quite a few films whose authors are not their directors Given a weak director the effective author of a film can be its photographer (Lucien Ballard, *Al Capone*), composer (Jerome Moross, *The Big Country*), producer (Arthur Freed, *Light in the Piazza*) or star (John Wayne, *The Comancheros*). None of those films was more than moderately good. Occasionally, though, something really remarkable can come from an efficient director with magnificent collaborators.

Id. at 54-55.

237. See, e.g., *L.A. News Serv. v. Tullo*, 973 F.2d 791, 794 (9th Cir. 1992) (regarding videotapes of newsworthy events).

238. See, e.g., *Time, Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 143 (S.D.N.Y. 1968) (regarding film of John F. Kennedy assassination).

239. Courts recognize that creative authorial choices result in copyrightable works of authorship, even in the context of documentary and news footage:

Whether or not every photograph or raw videotape is original and therefore copyrightable, it is clear from the record in this case that the preparation of the two videotapes at issue required the intellectual and creative input entitled to copyright protection. . . . [T]he initial decisions about the newsworthiness of the events and how best to tell the stories succinctly and effectively; the selections of camera lenses, angles and exposures; the choices of the heights and directions from which to tape and what portions of the events to film and for how long. The camera operator described herself as "an artist. I use a paintbrush. I use the camera to tell a story."

Tullo, 973 F.2d at 794.

240. But see *Hyde Park Residence Ltd. v. Yelland*, 3 W.L.R. 215 (C.A. 2000) (U.K.) (holding that the copyright in still photographs taken from security camera videotape was infringed by reproduction in newspaper).

are solely his, and there are no other collaborators (except possibly the performers). In most cases, and certainly in virtually all commercially exploited motion pictures, however, there are at least several, and often large numbers of, collaborators.²⁴¹ The touchstone in those cases is: Who is responsible for generating the original, minimally creative expression embodied in the motion picture?

Photography was one of the technological developments that forced courts to address what exactly it is about a work that is copyrightable authorship. A motion picture comprises more potentially copyrightable material than its photographic images, but, because early courts determined that motion pictures were copyrightable as photographs, the copyrightability of photography is a starting point for our analysis of motion picture authorship.

B. Early Photograph and Motion Picture Cases

Although the result of photography is a visual image, similar to paintings and other types of works that are considered the writings of authors, the process of taking a photograph differs from the usual artistic creation. Some early cases characterized photography as actually being made by the sun, but still the result of human authorship.²⁴² Clearly, there is fixation in a photograph, but is it original and creative? If so, what is it about a photo that constitutes authorship? Logically, it follows that whoever contributes that to the photo is its author.

It will be useful to an analysis of motion picture authorship to consider the reasoning of the Court in finding that a photograph is protectable as a writing of an author. In *Burrow-Giles Lithographic Co. v. Sarony*,²⁴³ Napoleon Sarony, the plaintiff, was a photographer who had taken a portrait of Oscar Wilde. The defendant reproduced that photograph by a process of chromolithography, and, when sued by Sarony, defended on two bases: first, that the notice of copyright was defective, and second, that the legislation according copyright to photographs was unconstitutional because a photograph is a mechanical process and not a writing of an author.²⁴⁴ The case was appealed

241. See ALEXANDRA BROUWER & THOMAS LEE WRIGHT, *WORKING IN HOLLYWOOD* 19 (1990) (quoting Kathleen Kennedy regarding Steven Spielberg, "When Steven directs, he is completely open to ideas from anybody. You never know when the best boy's going to walk up and say, 'Have you ever thought of . . . ?' . . . All it takes is one little suggestion sometimes to make a shot extraordinary.").

242. See *Nottage v. Jackson*, 11 Q.B.D. 627 (1883).

243. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 53 (1884).

244. The lower court had doubts about the question, but held the law constitutional by presuming constitutionality. See *Sarony v. Burrow-Giles Lithographic Co.*, 17 F. 591, 592 (S.D.N.Y. 1883).

to the Supreme Court, which had "no doubt" that photographs could fall within the constitutional power to protect writings of authors, "so far as they are representatives of original intellectual conceptions of the author."²⁴⁵

The Court relied on certain findings of fact to conclude that the photo qualified as "an original work of art, the product of plaintiff's intellectual invention, of which plaintiff is the author."²⁴⁶ The plaintiff photographer made the picture

entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit.²⁴⁷

It was the artistic decisions about the subject of the photo that constitute "original mental conception" or "intellectual invention" and, therefore, authorship.

Because the case was one of first impression, the Court looked to English law. In *Nottage v. Johnson*,²⁴⁸ a contemporaneous English decision addressing the question of who is an author of a photograph, the plaintiffs owned a photography company. Employees of the company decided to photograph an Australian cricket team and sent a photographer employee to do so. The defendant copied the resulting photo without permission and, when sued for copyright infringement, asserted a defense that the photo had not been properly registered because the owners of the company had registered the photo in their names as *authors* of the photo, which, if false, would invalidate the copyright.²⁴⁹ The court was required to consider who is the author of a photograph, or, more precisely, whether the owners of the company were authors without any further involvement in the taking of the photo.

Avoiding the harder question of deciding who in fact was the author, the *Nottage* court concluded that the proprietors could not be authors because they did nothing in the production of the photograph other than pay for the equipment and personnel.²⁵⁰ Lord Justice Cotton said that "author[ship] involves

245. *Burrow-Giles*, 111 U.S. at 58.

246. *Id.* at 60.

247. *Id.* at 54–55.

248. *Nottage v. Jackson*, 11 Q.B.D. 627, 627.

249. *Id.* at 630.

250. In reaching that conclusion, each judge expressed his ideas as to who is an author, and some of those statements were quoted with approval by the Court in *Burrow-Giles*. Brett, M.R., said that the author is "the person who has superintended the arrangement, who has actually formed the

originating, making, producing, as the inventive or master mind, the thing which is to be protected.”²⁵¹ It is important for our later discussion to note that the plaintiffs’ provision of funds or equipment, or their general right to control the acts of their employees, was not sufficient to make them authors. Although Cotton recognized that the author may not necessarily be the one who effectuates the physical photograph, that “a good deal may be done by the hand of those who work under [the author’s] direction,”²⁵² the plaintiffs’ right to control their employees is not what he meant by “master mind.”²⁵³ This is clear, as the plaintiff had the right to control its employees but was not found to be the author of the photograph.

The *Burrow-Giles* Court, following *Nottage*, focused primarily on the photographer’s role in arranging the subject matter of the photograph. Later cases have considered other choices both as to the subject matter and the way in which the photo is taken, such as the choice of camera, film, lens, location, time at which the picture will be taken, and location of the camera.²⁵⁴

Courts cite *Bleistein v. Donaldson Lithographing Co.*,²⁵⁵ which involved chromolithographs rather than photographs, for the proposition that an element of the artist’s personality is found in almost any photograph.²⁵⁶ The Nimmer treatise describes this as the prevailing view, that is, that almost²⁵⁷ any photograph “may claim the necessary originality to support a copyright merely by virtue of the photographers’ personal choice of subject matter, angle of photograph, lighting and determination of the precise time when the photograph is to be taken.”²⁵⁸

A series of cases continued to apply reasoning from *Burrow-Giles* to find that motion pictures were copyrightable as photographs. In *Edison v. Lubin*,²⁵⁹

picture by putting the persons in position, and arranging the place where the people are to be—the man who is the effective cause of that.” *Id.* at 632. Lord Justice Bowen opined that the author is “the man who really represents or creates, or gives effect to the idea or fancy, or imagination . . . who . . . is most nearly the effective cause of the representation when completed.” *Id.* at 637.

251. *Id.* at 635.

252. *Id.* at 634.

253. Lord Justice Cotton stated that the proprietor of the photographic company “did not give the direction or make the suggestion [to take the photograph]; but, even that, in my opinion, would not do.” *Id.* at 635.

254. See, e.g., *Time, Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 143 (S.D.N.Y. 1968) (regarding the Zapruder photos of the Kennedy assassination).

255. 188 U.S. 239 (1903).

256. See, e.g., *L.A. News Serv. v. Tullo*, 973 F.2d 791, 793 (9th Cir. 1992); *Time, Inc.*, 293 F. Supp. at 141.

257. Nimmer would find insufficient originality in a “slavishly copied” photograph of another photo or of printed material, or in a photograph of the same subject matter as a prior photo, which copies all the protectable elements of the prior photo. 1 NIMMER & NIMMER, *supra* note 17, § 2.08[E][2], at 2-131 to -132.

258. *Id.* § 2.08[E][2], at 2-130.

259. 122 F. 240 (3d Cir. 1903).

Thomas Edison's "operator" filmed the launch of Kaiser Wilhelm's yacht with a single camera. Part of the resulting film was reproduced and sold to exhibitors. Edison sued. The lower court found the film not copyrightable, arguing that each separate image had to be separately registered and affixed with notice. But the appellate court reversed, finding the film a single photograph. It further stated that the film "embodies artistic conception and expression. To obtain it requires a study of lights, shadows, general surroundings, and a vantage point adapted to securing the entire effect."²⁶⁰

Not long thereafter, in *American Mutoscope & Biograph Co. v. Edison Manufacturing Co.*,²⁶¹ a film made by cutting together a set of shots made at different times was found to be copyrightable as a photograph, following *Burrow-Giles* and *Lubin*.²⁶² In its complaint, the plaintiff emphasized the skill used in preparation of the cameras, the rehearsal of the actors, the manipulation of the camera and film, and the cutting and editing of the film. The court agreed that the film was copyrightable, because it expressed the "ideas and conceptions" of the author.²⁶³

Finally, in *Harper & Bros. v. Kalem Co.*,²⁶⁴ the court found that an unauthorized film based on the story *Ben Hur* was not only a copyrightable photograph,²⁶⁵ but also an infringing dramatization of the story. The court focused on the film's arrangement of a "series of events," and the "display of feeling or earnestness on the part of the actors."²⁶⁶

C. Motion Picture as Joint Work—*Aalmuhammed's* "Mastermind" Requirement and an Opportunity Missed

The joint work cases discussed above in which courts developed additional requirements for joint authorship all arose in the context of the live theatre industry. Perhaps the judicial requirements for a joint work determination discussed above are particularly appropriate in the context of the theatre, in which the playwright has customarily retained substantial autonomy and power relative to other contributors to a production of her play. Unlike a motion picture screenwriter, a playwright usually retains sole

260. *Id.* at 242.

261. 137 F. 262 (C.C.D.N.J. 1905).

262. *See id.* at 265-66.

263. *Id.* at 266.

264. 169 F. 61 (2d Cir. 1909), *aff'd sub nom.* *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911).

265. *See Harper & Bros.*, 169 F. at 63.

266. *Id.* at 64 (citing *Daly v. Webster*, 56 F. 483 (2d Cir. 1893)).

copyright ownership of her play.²⁶⁷ The producer typically receives a limited license to present certain productions of the play for a limited period of time, but does not control subsidiary uses of the play.²⁶⁸ Potential copyrightable contributions to the text of the play by others who work on a production, such as changes that might be made by a producer, director, or actor, if permitted by the playwright, are customarily transferred to the playwright by contract.²⁶⁹ In this context, it is understandable why courts would find that dominant playwrights do not intend to share authorship in their plays by virtue of incorporating other relatively minor contributions, and that judges would develop the intent-to-share authorship requirement as a way to protect playwrights and their reasonable expectations in the theatre industry.

Expectations of screenwriters and other motion picture authors may be quite different, however, which suggests that a different set of rules for coauthorship should be applied. In *Aalmuhammed v. Lee*,²⁷⁰ a recent case arising in the context of a motion picture, the Ninth Circuit had an opportunity to establish appropriate joint work rules for the motion picture industry. For example, the court could have created intent-to-share authorship credit rules for works with large numbers of individuals contributing copyrightable material and receiving specific credit for their contributions but not for the work as a whole. The court could also have considered whether coauthors should receive an equal share of the profits from exploiting a joint work, regardless of the size and importance of their contribution.

But instead of taking the opportunity to structure better joint work rules for the type of collaborative work represented by a large, commercial motion picture, the Ninth Circuit used the *Childress*, *Erickson*, and *Thomson* rules to exclude a contributor of copyrightable material from coauthorship, and added additional requirements, including that to qualify as a coauthor of a motion picture a contributor must supervise and control the creation of the motion picture. This rule makes it unlikely that most contributors to a motion picture could ever be deemed to be coauthors. Moreover, in the process of doing so, the court has denied many of the fundamental concepts of copyright authorship discussed in Part I above, at least in the context of determining whether one is an author of a joint work, and created a rule that will make it difficult to determine who is an author of a motion picture in the absence of work-for-hire arrangements. The court thus violated what

267. See DONALD C. FARBER, PRODUCING THEATRE: A COMPREHENSIVE LEGAL AND BUSINESS GUIDE 11 (1981).

268. See *id.* at 50–51.

269. See *id.* at 49.

270. 202 F.3d 1227 (9th Cir. 2000).

has been described as Congress's "paramount goal" in creating the 1976 Copyright Act, namely, "enhancing predictability and certainty of copyright ownership."²⁷¹

The plaintiff, Jefri Aalmuhammed, was an expert in Islam and knowledgeable about the life of Malcolm X, having prepared a documentary film on the important African American figure's life.²⁷² Spike Lee and his production company arranged with Warner Bros. to produce and direct a film based on the book, *The Autobiography of Malcolm X*.²⁷³ The film's star, Denzel Washington, initially engaged Aalmuhammed to help him prepare for the role.²⁷⁴ Ultimately, Aalmuhammed's involvement in the picture became extensive.²⁷⁵ There was evidence he suggested script revisions that were included in the film, directed Washington and other actors in several scenes, created at least two entire scenes with new characters, translated material from Arabic for subtitles, provided voice-overs in his own voice, and edited parts of the film.²⁷⁶ As will be discussed in more detail below, many of those contributions would normally qualify as copyrightable contributions. Contrary to typical industry practice,²⁷⁷ Aalmuhammed had no written contract with Warner, Lee, or Lee's companies.²⁷⁸ He received monetary compensation for his contributions, but not what he thought he was entitled to.²⁷⁹ He requested credit as a cowriter, but that request was rejected and he was accorded credit as an "Islamic Technical Consultant" in the end titles of the film.²⁸⁰ After the film was released, he filed a copyright registration for the film, claiming to be a cocreator, cowriter, and codirector, and filed a complaint seeking a declaratory judgment that he was a coauthor of the film and seeking an accounting.

Of chief concern to this Article is the court's disposition of Aalmuhammed's claim that he was a coauthor of the film as a joint

271. *Effects Assocs. v. Cohen*, 908 F.2d 555, 557 (9th Cir. 1990); see *Cmty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 749 (1989).

272. *Aalmuhammed*, 202 F.3d at 1229.

273. *MALCOLM X, THE AUTOBIOGRAPHY OF MALCOLM X* (1965).

274. See *Aalmuhammed*, 202 F.3d at 1229.

275. See *id.*

276. See *id.* at 1230.

277. The major motion picture studios practices vary as to requiring fully negotiated, signed formal written contracts before proceeding with deals. In this author's experience, even studios that do not require such signed contracts with respect to some creative participants, such as actors, directors, and producers, require signed contracts for rights owners and screenwriters. Perhaps Aalmuhammed's arrangement was not formally documented because he did not fall into one of those categories at the inception of his relationship with the production company.

278. See *Aalmuhammed*, 202 F.3d at 1230.

279. See *id.* Aalmuhammed was paid \$25,000 by Spike Lee, and received a check for a further \$100,000 from Denzel Washington, which he did not cash. See *id.*

280. *Id.*

work. The court, in an opinion by Judge Andrew Kleinfeld, confirmed that an independently copyrightable contribution is required for a joint work in the Ninth Circuit, but found that there was at least a genuine issue of material fact as to Aalmuhammed's having made such a contribution.²⁸¹ But in affirming a summary judgment for the defendants on the coauthorship claim, the court went further, stating that making a "valuable and copyrightable contribution" is not enough to constitute authorship when it comes to joint works such as motion pictures.²⁸²

In what may be an extreme expression of the romantic authorship concept, the court considered who is the author of a motion picture in the absence of a contract, and suggested that it is "the originator or the person who causes something to come into being," which the court said might be the producer, the editor, the director, the screenwriter, a star, the cinematographer, or in the case of an animated film, the animators and the music composers.²⁸³ The court blatantly rejected the requirement of only minimal creativity, which is based on over a hundred years of copyright jurisprudence and was recently affirmed by the Supreme Court in *Feist*, stating that such a

measure of a "work" would be too broad and indeterminate to be useful if applied to determine who are "authors" of a movie. So many people might qualify as an "author" if the question were limited to whether they made a substantial creative contribution that that test would not distinguish one from another A creative contribution does not suffice to establish authorship of the movie.²⁸⁴

Judge Kleinfeld's statement implies that there can only be one author, although he provides no explanation for why copyright law must "distinguish one [author] from another" when individuals collaborate on a work. The Copyright Act implicitly recognizes that one may not be able to distinguish one author from another in the definition of "joint work."²⁸⁵ Under that definition, a joint work can contain either "interdependent" or "inseparable" contributions.²⁸⁶ If contributions are inseparable, it is not possible to distinguish one contribution from another, and, hence, to distinguish one author from another.

281. See *id.* at 1231–32.

282. *Id.* at 1232.

283. *Id.*

284. *Id.* at 1233.

285. 17 U.S.C. § 101 (1994 & Supp. V. 1999).

286. *Id.*

As authority for this remarkable denial of fundamental copyright concepts, Judge Kleinfeld cited *Burrow-Giles*, *Childress*, *Erickson*, and *Thomson*.²⁸⁷ Applying the *Childress* line of cases, Judge Kleinfeld expanded *Thomson*'s finding, holding that control is required for one to be considered a coauthor of a joint work.²⁸⁸ According to Judge Kleinfeld, a coauthor must "super-intend[] the work by exercising control."²⁸⁹ He stated that "the audience appeal of [a joint] work turns on both contributions and 'the share of each [author] in its success cannot be appraised.' Control in many cases will be the most important factor."²⁹⁰

Citing *Burrow-Giles*, the court stated that the author is "the person to whom the work owes its origin and who superintended the whole work, the master mind."²⁹¹ Implicitly rejecting the fact that various contributions to a film owe their origin to numerous contributors, the court stated that its approach "would generally limit authorship to someone at the top of the screen credits, sometimes the producer, sometimes the director, possibly the star, or the screenwriter—someone who has artistic control."²⁹² Judge Kleinfeld's rationale for this apparent finding that there is only one author of a film, notwithstanding the contribution of important creative expression by numerous participants, is that in *Burrow-Giles* "the Court held that the photographer was the author."²⁹³

Judge Kleinfeld's interpretation of precedent is questionable. The issue in *Burrow-Giles* was not whether Oscar Wilde or some other participant in the creation of the photograph was an author or a coauthor, but whether the photograph was a copyrightable work of authorship such that an unauthorized reproduction would constitute copyright infringement. The *Burrow-Giles* Court did not hold that any other participants in the creation of the photograph were *not* authors, but only that photography could qualify as a "writing" of an "author" under the Constitution. As discussed above, the "mastermind" language from *Nottage*, cited in *Burrow-Giles*,²⁹⁴ did not mean that someone who owned the company was an author—in fact *Nottage* stands for the contrary proposition, that the individuals who actually cre-

287. See *Aalmuhammed*, 202 F.3d at 1232–35.

288. See *id.* at 1234.

289. *Id.* (citation omitted).

290. *Id.* (quoting *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944)).

291. *Id.* at 1233 (citation omitted).

292. *Id.*

293. *Id.*

294. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 61 (1883) (quoting *Nottage v. Jackson*, 11 Q.B.D. 627, 635 (1883)).

ated the photograph were the authors. Under *Burrow-Giles*, Aalmuhammed, as the originator of his contributions to the film, is clearly an author.

In addition, there is no statutory support for Judge Kleinfeld's additional requirements for coauthorship of a film. As discussed in this Article, many years of judicial precedent require that to qualify as an author, one's contribution must only be original and include some minimal human creative expression. Control can be relevant to distinguish mere fixation from original expression, and may be a factor in determining whether or not the creator is an employee, but control is otherwise irrelevant to authorship. Control, in the sense of a right to accept or reject a contribution and use it in a work, is not authorship. Yet because the financing company, Warner Bros., and the director, Spike Lee, had the right to accept Aalmuhammed's contributions or not, the court found that Aalmuhammed "lacked control over the work," which, according to this approach shows a lack of coauthorship.²⁹⁵

By emphasizing control, Judge Kleinfeld attempts to unravel years of legislative work in crafting the 1976 Copyright Act, and the careful balance between the interests of creative authors and employers that the Act embodies.²⁹⁶ As a result, Judge Kleinfeld's approach creates complete uncertainty as to authorship and ownership of copyright, contrary to one of the important purposes of the 1976 Act: that of enhancing predictability and certainty. He recognized this when he stated,

The factors articulated in this decision . . . cannot be reduced to a rigid formula, because the creative relationships to which they apply vary too much. Different people do creative work together in different ways, and even among the same people working together the relationship may change over time as the work proceeds.²⁹⁷

It appears that under this approach there is no way to know who controls the film until after the fact. Even then, what constitutes control over a work in the context of a motion picture is uncertain. In most cases, the financier has "final cut" rights, which might be "control" under Judge Kleinfeld's approach. But what if the financier accepts the director's cut of the film? Does the financier still have control, making it the author? Or what if the director has final cut rights for some media and territories, as is sometimes the case for more powerful directors, and the financier has final cut rights for other media and territories? Is the director a coauthor for some

295. *Aalmuhammed*, 202 F.3d at 1235.

296. See *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 748–49 (1989) (rejecting the right to control and actual control tests for work made for hire as disturbing the careful balance reflected in the statute and stating that control tests would impede Congress's goal of enhancing predictability and certainty).

297. *Aalmuhammed*, 202 F.3d at 1235.

purposes but not for others? There is no basis for this kind of division of authorship under the Copyright Act.

Assuming that motion picture authors, like all other authors, must not only control the production but must also contribute original creative expression, Judge Kleinfeld's approach creates the possibility for a motion picture to have no author. This result occurs if the person with control does not also contribute the required creative expression. By making the determinative factor in a joint work analysis the right to control, the court limits joint works to those in which it can be proven that individuals share a veto power over what is included in the work and also contribute separately copyrightable material. This effectively means that commercial motion pictures can rarely be held to be joint works.

Judge Kleinfeld's other requirements are also problematic. It is not clear how a court is to apply the requirement that audience appeal "turn on both contributions" (that is, the contributions of both coauthors), or determine whether the relative importance of the contributions "cannot be appraised."²⁹⁸ How is a court to determine what is responsible for the audience appeal of a work? If there were a way to measure the relative value of each person's contributions, does that mean that work is no longer a joint work? The Copyright Act itself does not support such an inference.²⁹⁹ The only support cited for this point in Judge Kleinfeld's opinion is *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*,³⁰⁰ in which the Second Circuit determined that a song was a joint work of the lyricist and composer even though the lyricist wrote the words before he knew who the composer of the music would be. In that opinion, Judge Learned Hand found joint authorship because the parties intended their otherwise separable contributions to be exploited as part of a unitary work.³⁰¹ It seems of little use in determining whether collaborative works incorporating numerous contributions by many participants (such as most motion pictures) are joint works by referring to vague notions of audience appeal and to each contribution's respective share in the success of a work.³⁰²

298. *Id.* at 1234.

299. See 17 U.S.C. § 101 (1994 & Supp. V 1999).

300. 140 F.2d 266 (2d Cir. 1944).

301. See *id.*

302. Finally, the whole schema proposed by Judge Andrew Kleinfeld apparently becomes irrelevant when the parties simply enter into "a contract saying that the parties intend to be or not to be co-authors," because the whole factual inquiry he proposes is only necessary in the absence of a contract. *Aalmuhammed*, 202 F.3d at 1235. Presumably, the right to control would no longer be relevant if the contract specified an intention to be coauthors. If control represents the most important indicia of coauthorship, then should it be so easily rendered insignificant?

Judge Kleinfeld's laudable goal was to encourage authors' consultation with others during the creative process and to limit the risk of claims by overreaching contributors.³⁰³ His approach may encourage authors to consult, but it will arguably discourage other people from consulting with them. It does not solve the problem of overreaching contributors, because it may be considered infringement for the author to use any minimally creative expressive material a contributor provides. Also, it may not really benefit production companies because the tests of control and of audience appeal are inherently unpredictable and uncertain.

The Ninth Circuit in this decision held that the term "author" means something very different in the context of joint works than it does in general.³⁰⁴ Under this holding, motion pictures will almost never qualify as joint works and contributors to motion pictures will virtually never qualify as joint authors. The Copyright Act does not provide a basis for that approach, and the legislative history indicates that Congress thought that motion pictures would typically be considered joint works, in those rare instances when they were not works made for hire.³⁰⁵

It would have been more helpful to production companies and possibly fairer to contributors for the court to find that material such as that created by Aalmuhammed is indeed a contribution to a joint work. The court could then elaborate rules as to the consequence of that determination that make sense, particularly in the motion picture industry. The rules that a coauthor has a nonexclusive right to exploit the work and is entitled to a pro rata share of proceeds from the work are not expressed in the Copyright Act. Instead, they arose in the context of songwriting, in which there are usually only two or a few collaborators contributing relatively equal amounts of material. Those rules should be reconsidered in the motion picture context.³⁰⁶

303. See *id.*

304. See *id.* at 1232.

305. In discussing joint works in contrast with collective works, the House Report states:

The touchstone here is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit, although the parts themselves may be . . . "interdependent" (as in the case of a motion picture) It is true that a motion picture would normally be a joint rather than a collective work with respect to those authors who actually work on the film, although their usual status as employees for hire would keep the question of co-ownership from coming up.

H.R. REP. NO. 94-1476, at 120 (1976).

306. In view of the numerous collaborators and the unequal, difficult-to-assess values of contributions, a court could find that nonexclusive exploitation of a film by a minor contributor is not permissible, as it would have the potential to destroy the market value of the entire work, and that each contributor is entitled to a payment that reflects the importance of her contribution relative to the motion picture as a whole.

D. Authors and Authorship in Contributions to Motion Pictures

Although under *Aalmuhammed*, creators of motion pictures would rarely be considered coauthors of a joint work, they will be authors of their respective contributions.³⁰⁷ This part will consider some of the important contributors of authorship to films, focusing on the nature of their respective contributions. It will also discuss some important potential issues in motion picture authorship, including the relationship between a screenplay and the motion picture based on it, and the question of whether actors may be considered authors under U.S. law.

1. Production Executives and Producers

Four individuals have been described as the “helmsmen” of a film—the ones who “cause a film to happen”: the head of production, the producer, the director, and the screenwriter.³⁰⁸ Making a film happen may be an important determinant of ownership, but it is not conclusive proof of authorship. Rather, the appropriate inquiry as to authorship is: Did those individuals create original, minimally creative expression? The head of production and the producer have multiple roles, many of which do not involve generating creative expression.

The head of production, or production executive, is “the captain of the studio production process.”³⁰⁹ The production executives for a studio/financier are involved in selecting and acquiring projects for development;³¹⁰ selecting

307. See *Aalmuhammed*, 202 F.3d at 1232.

308. BROUWER & WRIGHT, *supra* note 241, at 1.

309. *Id.* at 3. In many cases, there are numerous production executives employed by the studio. Generally one will be primarily responsible for each project developed and produced by the studio. See *id.* at 3. The title “head of production” connotes the person in charge of those production executives, who, although ultimately responsible for the studio's entire slate of pictures, may have varying degrees of involvement in any particular film. See *id.*

310. Motion picture production can be broken down into four periods: development, pre-production, production, and marketing/distribution. During development, scripts are written and revised. When the script is written, it is budgeted, locations are scouted and a schedule of photography is prepared. Often, in addition to screenwriters, a producer and director are engaged pursuant to development deals to provide services in connection with the writing, scheduling, and budgeting. Once a picture has been approved for production, or “greenlit,” it enters the pre-production period, during which additional creative elements and crews are engaged, and preparations are made to commence photography. The production period refers to the period of principal photography of the film. Once photography has been completed, the postproduction period commences, during which the film is completed, which involves editing, preparing the music, sometimes shooting additional scenes or retakes, re-recording sound elements (“looping” and “dubbing”), completion of special effects and so on. Generally, there will be preview screenings of the film prior to its final completion, in order to gauge audience reaction. Meanwhile, the marketing and distribution plans are made, and finally the film will receive its initial general theatri-

and meeting with writers; reviewing and commenting on drafts of the screenplay; selecting producers, directors, actors, and other talent and crew; with other studio personnel and the filmmakers on the development, preproduction, production, and postproduction of the film; and developing marketing and distribution plans.³¹¹ During production, the production executive typically views dailies,³¹² and may give input to the director as to which of several takes of a scene should be selected for use in the film. He also gives input on other creative matters. The production executive is the studio's representative on the production team, responsible (together with others on the team) for overseeing the business aspects of the production and, to varying degrees, the creative aspects. To the extent that the production executive contributes original, minimally creative expression that is incorporated into the film, he is an author. Of course, since this work is typically done in the scope of his employment by the studio, the studio will be deemed the author and the copyright owner of the production executive's contributions.

The term "producer" and its variants (for example, "executive producer," or "associate producer") encompasses individuals involved in a film in a variety of different capacities.³¹³ Unlike most of the other categories that will be discussed below, there is no collective bargaining agreement governing who can receive producer credits and what is within their job description. It is not unusual for a given film to give producer-type credits to many individuals. A producer-type credit may be accorded to one who provided or secured financing or a distribution deal, or who came up with the idea or acquired rights in a literary property. Or it may be accorded to the line producer, who manages with the assistant director the day-to-day details in the production of the film. Sometimes the credit is given to a manager or to a friend of a star or the director, or to someone who helped attract them to the project.³¹⁴ On the other hand, some producers, sometimes referred to informally as "creative producers," are involved in the

cal release to the public, followed by distribution to ancillary markets, such as pay-per-view television exhibition, pay cable television, home video, and various free television exhibitions. Of course, these are not all completely distinct activities; for example, marketing ideas may be developed during the development period and rough assemblies of film are made during production.

311. See BROUWER & WRIGHT, *supra* note 241, at 3. Once a producer and director are involved in a project, most of those activities are done in conjunction with them.

312. "Dailies" are prints of the most recently photographed film footage, typically reviewed on a daily basis.

313. See BROUWER & WRIGHT, *supra* note 241, at 16.

314. The somewhat derogatory term "baggage producer" is sometimes used to describe a person who is required by talent to be accorded credit (and to receive a fee) as a condition of the talent's commitment to do the film.

creative development of the script and in other creative activities, such as selecting cast and editing the final version of the film.

A producer is one of the creators of a film, to the extent that he originates minimally creative expression that is incorporated into the film.³¹⁵ Although many of the activities described above do not reflect creative expression and should not be considered authorship, when a producer contributes dialogue or scenario, selects takes to incorporate into the film, or supervises editing of the film, he is contributing expression. Thus, he should be considered an author of the film.³¹⁶

2. Screenwriters

A screenplay is the written work that forms the basis of a motion picture. It usually contains dialogue (the words to be spoken by the actors on or off camera) and scenario (description of the characters, scenes, camera angles and moves, and editing instructions such as "pan in" or "cut to").³¹⁷ The earliest motion pictures did not use screenplays, but were based on a

315. See Kernochan, *supra* note 70, at 360–61.

316. If the work was done as a work made for hire, the employer would be considered the author. A student commentator has argued for a distinction between "studio producers" and "independent producers," and that the former should not be considered authors while the latter should be. See Stuart Kauffman, Note, *Motion Pictures, Moral Rights, and the Incentive Theory of Copyright: The Independent Film Producer as "Author,"* 17 CARDOZO ARTS & ENT. L.J. 749 (1999). The note also argues that the independent producer should be considered the sole author of a film and should solely own moral rights in the film because Congress's rejection of express moral rights legislation for films was the result of its fear of problems that could arise if moral rights were accorded to all the numerous authors of a film. See *id.* at 781–82.

Aside from the fact that the line between the two types of producers is not at all distinct, the author's argument seems to turn on either distinctions that are irrelevant to copyright authorship, or on a general prediction that producers of films that are "independently" financed will be more creatively involved with their films than producers of films that are financed by the studios. See *id.* The author's generalizations regarding the creative contributions and motivations of studio producers versus those of independent producers are questionable, to say the least, and, in any event, qualification as a creator/author is the result of the actual contributions of a particular producer or production executive, not of expectations and unsupported generalizations. See *id.*

317. "The word 'scenario'—replaced today by the term 'screenplay'—did not mean shooting script. It was the sequence of scenes, the story told in visual terms, originally devised to explain as clearly as possible what its author had in mind. From this scenario was written the continuity, or 'shooting script,' as it is known today." BROWNLOW, *supra* note 227, at 270–72. The Berne Convention, in its section dealing with authors of cinematographic works, distinguishes authors of "scenarios" and of "dialogues," which suggests that the "scenario" is not the same as the screenplay, but rather is the descriptive material other than dialogue in the screenplay. The Berne Convention for the Protection of Literary and Artistic Works, opened for signature July 24, 1971, art. 14 *bis*, 25 U.S.T. 1341 [hereinafter Berne Convention].

rough story idea and improvisation.³¹⁸ As films became longer and more complex, a written scenario became desirable.³¹⁹

a. The Screenplay as a Joint Work

In most cases, many writers³²⁰ and others³²¹ are involved in creating what eventually becomes the final screenplay of a motion picture. The *Writers Guild of America-Alliance of Motion Picture & Television Producers Theatrical and Television Basic Agreement* (WGA Agreement) governs who receives public credit for authorship of a screenplay that is under WGA jurisdiction.³²² The Copyright Act, however, requires that any person who contributes original, minimally creative expression to the screenplay is an author of that material, and possibly a coauthor of the screenplay as a

318. See BROWNLOW, *supra* note 227, at 270.

319. Silent comedies did not use scripts, but were worked out by numerous writers in conference, much like some television today. See *id.* Only dramatic films had scenarios. See *id.* Of course, silent film scenarios did not require dialogue, except for occasional bits for use in title cards. See *id.* For interesting descriptions of how Harold Lloyd and his collaborators created their comic films, in particular *The Freshman*, see *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1 (9th Cir. 1933).

320. The *Writers Guild of America-Alliance of Motion Picture & Television Producers Theatrical and Television Basic Agreement* (WGA Agreement) contemplates writers working as a bona fide team of not more than two writers. See WRITERS GUILD OF AMERICA-ALLIANCE OF MOTION PICTURE & TELEVISION PRODUCERS THEATRICAL AND TELEVISION BASIC AGREEMENT, art. 13.A.9 (1995) [hereinafter WGA AGREEMENT]. Since the early days of film, screenplays have been repeatedly rewritten by additional writers and others. See BROWNLOW, *supra* note 227, at 273. The WGA Agreement requires that a writer receive notice when another writer is assigned to write a project, and that a newly assigned writer is to receive notice of the names of all previous writers on the project. See WGA AGREEMENT, *supra*, art. 18.

321. The WGA Agreement contemplates contributions by persons other than the writer. See WGA AGREEMENT, *supra* note 320, art. 1.B.1 (defining "writer" for purposes of the collective bargaining agreement, indicating that certain types of changes to a script by employees other than the writer do not make such employees writers under the agreement, and indicating that certain types of changes may be subject to the agreement under some circumstances).

322. Credit for films covered by the WGA Agreement is determined by the writers, subject to general restrictions in the WGA Agreement, or, in the event of a disagreement among the writers or between the producer and the writers, by WGA arbitration. See *id.* Theatrical sched. A, Theatrical Credits. Interestingly, no matter how many writers or others work on a screenplay, under the WGA Agreement credit provisions for theatrical films, no more than three writers (or two teams of two writers), that is, those who are "chiefly responsible for the completed work," are permitted to receive screenplay credit. *Id.* Theatrical sched. A, para. 4. If other writers are entitled to credit for the "story" embodied in the screenplay, no more than two writers are permitted to receive the "story by" credit. *Id.* Hence, the WGA Agreement permits no more than six writers to be credited for a screenplay. The creators of a screenplay for copyright purposes may include more writers than are actually accorded credit on screen and in advertising for the film. See *id.* Of course, because most writing for U.S. feature films is done as a work made for hire, the employer is the copyright author, but is not prohibited from contractually agreeing to credit other individual creators. See *id.*

whole. It is often the case that this person's contribution is a work made for hire, making the employer the author.

The WGA credit procedures and the prevalence of work-for-hire arrangements simplify what would otherwise be a very complex determination. Writers who intend to merge their contributions into a unitary whole screenplay, who contribute separately copyrightable contributions, and who have the intent to share authorship would be considered joint authors of the screenplay, and the screenplay would be considered a joint work. Writers who do not meet those requirements would own their respective contributions individually.

b. The Film Based on the Screenplay—Derivative Work or Joint Work?

The relationship between the screenplay and the film based on it is a fundamental one, yet it is troublesome in terms of copyright. The issue has not been presented to a court as to whether a film based on a screenplay is a derivative work of the screenplay or is a joint work of which the screenplay is but one coauthor's (or group of coauthors') contribution. As discussed in Part I above, there are several important consequences of each possible characterization.

If the film is held to be a derivative work, it cannot be exploited without acquiring appropriate rights in the preexisting work. If those rights have been acquired by a grant, and if the script is not a work made for hire, the grant is subject to termination under the 1976 Act. After such a termination, the existing derivative work may continue to be exploited, but new derivative works may not be created without a further grant.³²³ If the screenplay was copyrighted prior to 1978 and the screenwriter dies during the initial term of copyright, the producer/grantee's rights will lapse at the end of the first term.³²⁴

If the film is a joint work, a coauthor can not terminate a grant of rights to the other coauthors, as the coauthors' rights are not the consequence of a grant, but arise by operation of law. Neither would the death of one coauthor during the first term of copyright of a pre-1978 screenplay terminate the rights of the other coauthors. Also, if the film is a joint work of the screenwriter and others, the screenwriter would have the right to

323. See 17 U.S.C. §§ 203, 304(c) (1994 & Supp. V 1999); see also Michael Davis, *The Screenwriter's Indestructible Right to Terminate Her Assignment of Copyright: Once a Story Is "Pitched," a Studio Can Never Obtain All Copyrights in the Story*, 18 CARDOZO ARTS & ENT. L.J. 93, 104-05 (2000).

324. See *Stewart v. Abend*, 495 U.S. 207, 219-21 (1990) (finding that a film based on a short story infringes copyright if exploited during the story's renewal term).

exploit or license the film or its other joint work components, subject only to a duty to account to the other coauthors, and would be entitled to a proportionate share of proceeds from exploitation of the film or of its joint work components, subject to any contrary agreement.

(1) The Screenplay as a Contribution to a Motion Picture Joint Work

The legislative history of the 1976 Act suggests that a film is a joint work, not a derivative work of its screenplay. The House Report states that:

The definition of "joint works" has prompted some concern lest it be construed as converting the authors of previously written works, such as plays, novels, and music, into co-authors of a motion picture in which their work is incorporated. *It is true that a motion picture would normally be a joint rather than a collective work with respect to those authors who actually work on the film, although their usual status as employees for hire would keep the question of co-ownership from coming up.* On the other hand, although a novelist, playwright, or songwriter may write a work with the hope or expectation that it will be used in a motion picture, this is clearly a case of separate or independent authorship rather than one where *the basic intention behind the writing of the work was for motion picture use.* In this case, the motion picture is a derivative work within the definition of that term³²⁵

This suggests that Congress believed the screenplay, like other cinematic contributions but unlike other preexisting literary material, is part of a joint work. Unlike a novel, play, or song from which the film is a derivative work, the screenplay is written with a basic intention of motion picture use, and the screenwriter often actually works on the film.

The Nimmer treatise also distinguishes the screenplay from other preexisting works:

[A] motion picture is a joint work consisting of a number of contributions by different "authors." The screenplay (*i.e.*, the script containing the precise dialogue and action) becomes a part of such joint work when it is recast into the audiovisual form of the resulting motion picture. However, a novel or stage play upon which a motion picture may be based is not a part of the motion picture joint work, but is rather a pre-existing work, in relation to which the motion picture is a derivative work.³²⁶

325. H.R. REP. NO. 94-1476, at 120 (1976) (emphasis added).

326. 1 NIMMER & NIMMER, *supra* note 17, § 6.05, at 6-13 to -14 (footnotes omitted). The foregoing was cited with approval in *Easter Seal Soc'y for Crippled Children & Adults, Inc. v. Playboy Enters.*, 815 F.2d 323, 337 (5th Cir. 1987). In the footnote to the Nimmers' statement

To the Nimmers, whether particular literary material will be considered a separate work or a contribution to a joint work should turn on the primary intent of the writer.³²⁷ For a screenwriter, this primary intent is to write a screenplay for motion picture purposes.³²⁸ Thus, under this approach, the screenplay would be a contribution to a joint work.

(2) The Screenplay as Preexisting Material for a Derivative Work

The 1976 Act's definition of "derivative work" might suggest that a motion picture is a derivative work of its screenplay:

A "derivative work" is a work based upon one or more preexisting works, such as a . . . motion picture version, sound recording . . . or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."³²⁹

But the statutory language and legislative history are not determinative. The reference in the statute to a "motion picture version" as a type of derivative work could refer to the underlying literary material other than the script (for example, a novel or short story) that the film is based on. Customary usage supports that interpretation. One customarily would refer to the motion picture as a version of a novel on which it is based, but would not customarily refer to a motion picture as a version of its screenplay.

The relation of a motion picture to its script might be analogous to that between a musical composition and a sound recording of a performance of that composition. In both cases, the underlying material is written with the intent to be performed and to have that performance recorded. A sound recording is very likely a derivative work of the composition, rather than a

that a motion picture is a joint work, they state: "The contributing 'authors' include, in addition to the writer of the screenplay, the director, the photographer, the actors and, arguably, other contributors such as the set and costume designers, etc." 1 NIMMER & NIMMER, *supra* note 17, § 6.05, at 6-14 n.8. Thus, the screenplay is said to be a contribution to a joint work film. That footnote was also cited in *Easter Seal*. See *id.* The Nimmers' proposition that the listed contributors and others would be coauthors is consistent with the position taken in this Article, but does not address the impact of the *Childress* line of cases and of *Aalmuhammed*.

327. See 1 NIMMER & NIMMER, *supra* note 17, § 6.05, at 6-14.

328. See *id.* This appears to be the prevailing view internationally as well.

In the legal literature, the prevailing opinion is that the dividing line between authors of underlying works and audiovisual authors should be determined by asking whether the contribution has been created with a view toward a planned cinematic work, to be used in the film production. This would mean that the screenwriters as well as the writers of the expose and treatment would be considered as actual audiovisual authors.

SALOKANNEL, *supra* note 226, at 99.

329. 17 U.S.C. § 101 (1994 & Supp. V 1999).

joint work of the songwriter and the sound recording authors.³³⁰ It would be highly impracticable, and not likely the intent of the recording artists, if the songwriter were considered the coauthor of each sound recording. This analogy suggests that a film should be considered a derivative work of its screenplay.

On the other hand, there are differences between a song and a screenplay that suggest that the screenplay is more like a contribution to a joint work than the basis for a derivative work. Songs are usually not written with the intent that they will be used to make a particular sound recording.³³¹ A song, if successful, may be recorded by many different artists in numerous sound recordings, whereas a screenplay would not ordinarily be used to make multiple films in simultaneous release. Indeed, although some films are remakes of prior screenplays, most screenplays are not made into multiple film versions at all. Songs also have substantial uses other than to make recordings, such as for live performance, which is not the case for screenplays. Thus, a song would not usually be created solely with the intention to merge it into a single, unitary sound recording.³³² By contrast, a screenplay is typically created with the intention to merge it with other cinematic contributions into a single, unitary film.

One reported case held that a television program was a derivative work of the screenplay, which was protected as a separate work owned by the screenwriters. In *Gilliam v. American Broadcasting Cos.*,³³³ the comedy troupe known as Monty Python had written screenplays for a television series pursuant to a contract with the British Broadcasting Corporation (BBC).³³⁴ As it was a British agreement, the screenplays were not characterized as works made for hire, and the writers retained all rights to the script, subject to the limited rights granted to the BBC.³³⁵ The agreement required the BBC to consult with the writers before making any changes to the script, except for minor alterations to avoid legal problems.³³⁶ The BBC produced the programs, and licensed ABC to exhibit them on U.S. commercial television.³³⁷ Because U.S. commercial television, unlike the

330. See *id.*

331. Under the Copyright Act, once a person has released an authorized recording of a song in the United States, anyone else may secure a compulsory license to create and distribute her own recorded version of the song. See 17 U.S.C. § 115 (1994).

332. Once one version of a song has been released on records in the United States, the song is subject to a compulsory mechanical license, pursuant to which anyone may obtain the right to create his own recorded version of the song. See *id.*

333. 538 F.2d 14 (2d Cir. 1976).

334. See *id.* at 17.

335. See *id.*

336. See *id.*

337. See *id.*

BBC, inserts commercials into its shows, ABC substantially edited the shows.³³⁸ The members of Monty Python sued under several theories, including copyright infringement and violation of the Lanham Act,³³⁹ and ultimately received a preliminary injunction that prevented ABC from further exhibiting the edited programs.³⁴⁰

The Second Circuit decision characterized the programs as derivative works, "a dramatization of the script."³⁴¹ "Since the copyright in the underlying script survives intact despite the incorporation of that work into a derivative work, one who uses the script, even with the permission of the proprietor of the derivative work, may infringe the underlying copyright."³⁴² By exceeding the rights granted to their grantor, ABC infringed the copyright in the screenplays.³⁴³ ABC's argument was that Monty Python's script and the BBC program recording are symbiotic elements of a single production in which "each contributor possesses an undivided ownership of all copyrightable elements . . . and BBC could thus have licensed use of the script, including editing"³⁴⁴ The court rejected that theory, finding that Monty Python's retention in the contract of all rights not granted, including the right to license the scripts for production by others, "suggest[s] that the parties did not consider themselves joint authors of a single work."³⁴⁵ The court noted that there was precedent that the joint work doctrine should not be applied "where the contract which leads to collaboration between authors indicates that one will retain a superior interest."³⁴⁶ Although the court noted that the issue should be further considered at trial, it was not enough to preclude a preliminary injunction.³⁴⁷

338. See *id.* at 18.

339. 15 U.S.C. §§ 1051-1096, 1111-1129 (1994 & Supp. V 1999).

340. See *Gilliam*, 538 F.2d at 26.

341. *Id.* at 19.

342. *Id.* at 20.

343. See *id.*

344. *Id.* at 22.

345. *Id.*

346. *Id.* It is not at all clear what the court meant by that statement. It cited one case, in which a screenwriter retained ownership of common law copyright in his screenplay until a certain payment was made. See *id.* (citing *Szekely v. Eagle Lion Films, Inc.*, 242 F.2d 266 (2d Cir. 1957)). The payment was not made and the screenplay was rewritten by another screenwriter and eventually produced as a motion picture. The first screenwriter sued for infringement, and was granted damages and an injunction. See *Szekely*, 242 F.2d at 267. On appeal, the defendant argued that the rewritten screenplay was a joint work between the first and second screenwriters. The court rejected that argument, because when the first screenplay was written it was not contemplated to be a joint work with other screenwriters. See *Szekely*, 242 F.2d at 268. This would seem to support the proposition that, when an author retains the copyright in his work, an infringing revision of the work will not be considered a joint work. It offers little support for the much broader statement in *Gilliam*.

347. See *Gilliam*, 538 F.2d at 22.

Thus, *Gilliam* provides judicial support for characterizing the screenplay-film relationship as that between a preexisting work and a derivative work, rather than as that between a contribution and a joint work.³⁴⁸ It suggests two rationales: (1) that the screenplay “survives intact” after incorporation into the film; and (2) that one party (in that case, the screenwriters) retained a “superior interest.”³⁴⁹ The first rationale is not persuasive because the 1976 Act contemplates that some joint works will consist of interdependent, not inseparable, contributions.³⁵⁰ In any joint work consisting of such contributions, the components survive intact. Hence, that material survives intact cannot preclude its being considered a contribution to a joint work.

The second rationale may be of limited application in the U.S. film industry, because contracts assigning rights in a screenplay typically grant the entire copyright to the producer, and do not reserve the kind of control and other rights that apparently were reserved in the British contract in *Gilliam*.³⁵¹ But U.S. contracts might be characterized as granting the other author—the producer—a “superior interest.” This is because the producer often has the right to alter the script in any way and to make any uses of the script that she desires, subject to any applicable WGA Agreement.³⁵² If courts were to interpret *Gilliam* to say that there is no joint authorship whenever the contractual rights of the parties are not comparable, then perhaps they would conclude that a screenplay acquired under a typical U.S. film industry rights acquisition or work-for-hire contract is not a contribution to a joint work, but rather the underlying work for a derivative work.³⁵³

Supporting the conclusion that a screenplay is preexisting material for a derivative work and not a contribution to a joint work film is the fact that many screenplays are never made into films. If no film of the screenplay is

348. See *id.* at 20–22.

349. *Id.*

350. See 17 U.S.C. § 101 (1994 & Supp. V 1999).

351. See *Gilliam*, 538 F.2d at 17.

352. See PAUL A. BAUMGARTEN ET AL., PRODUCING, FINANCING AND DISTRIBUTING FILM 42 (1995) (describing screenwriter agreements that contain waivers of moral rights); MARK LITWAK, DEALMAKING IN THE FILM & TELEVISION INDUSTRY 107–08 (1994) (describing a screenwriter employment agreement form’s waiver of moral rights provision). This rationale is supported by the fact that agreements for the acquisition of motion picture rights in independent literary properties, such as books, also contain waivers of moral rights. See, e.g., *id.* at 81 (describing an option and literary purchase agreement form’s waiver of moral rights provision). A motion picture would be a derivative work of a preexisting book upon which it is based. See H.R. REP. NO. 94-1476, at 120 (1976).

353. Because waivers of moral rights are common in the agreements with other contributors to a motion picture, this argument also suggests that those are not contributions to a joint work either. This is inconsistent with the legislative history of the 1976 Act. See H.R. REP. NO. 94-1476, at 120 (1976).

ever produced, then the screenplay cannot be characterized as a contribution to a joint work with no separate copyrightable existence. Would the screenplay be a separate work unless and until it is merged with other contributions? On the other end of the spectrum, some screenplays are remade several times. Under the joint work analysis, the screenwriter would be a joint author of each of those remakes as well as of the first film. Carried to its extreme, each of the coauthors of each of those versions might be coauthors of all of them, which starts to be untenable. The underlying work/derivative work analysis is far simpler.³⁵⁴

Alternatively, a screenplay may be treated as a separate work if it is registered for copyright before the registration of the motion picture based upon it. The *Compendium II of Copyright Office Practices* suggests that a motion picture is a derivative work of its screenplay, at least for registration purposes, if the screenplay has been previously registered for copyright, published, or is in the public domain.³⁵⁵ A screenplay might well be registered for copyright before the film is made or registered, particularly if it is not written as a work made for hire for the producer. Thus, for purposes of copyright registration, any film based on such a screenplay would be considered a derivative work.

(3) Screenplays Will Not Satisfy the Judicially Enhanced Joint Work Requirements

The discussion above assumes that a film would otherwise qualify as a joint work vis-à-vis the screenplay under copyright law. If the judicially enhanced requirements for a joint work are not be satisfied, however, then the screenplay would not qualify as a contribution to a joint work.

The screenwriter would almost always satisfy the statutory and some of the judge-made requirements for joint authorship. He writes the screenplay with the intent that it will be merged with other contributions into interdependent parts of a unitary whole, as required by the statute. Ordinarily, the screenplay is separately copyrightable material, as required by some courts.

The screenwriter and most other authors probably consider the screenwriter to be an important author. It is not clear, however, who is intended to share authorship of the film. The screenwriter is ordinarily accorded

354. The U.S. Copyright Office practice is to treat motion pictures as derivative works only if they are based on material that is previously published or registered for copyright. See *supra* note 181 and accompanying text.

355. See COMPENDIUM, *supra* note 181, § 480.04, at 400–26.

either a “written by” or a “screenplay by” credit on film.³⁵⁶ The numerous others providing authorship contributions to a film also receive credits as to their particular contributions. Does such credit for one important part of the film demonstrate intent to share authorship of the film, or just indicate the source of the particular individual’s contribution?

Perhaps the closest credit to pure film authorship would be the possessory or possessive “___ production” and “film by ___” credits that are accorded on many films. The possessory production credit, for example, “An Amblin Production,” is usually reserved to the producer’s production company. Of course, if the production company has engaged all the creative authors on a work-for-hire basis, that company is the author of the film under U.S. law. The “film by” credit is usually given to the director of the film. This credit is extremely controversial, as the WGA feels that it misdescribes the film authorship.

The 1995 WGA *Agreement* includes a “Preamble Regarding So-Called ‘Possessive’ Credits,” which describes “the Writers Guild’s strong, continuing, long-standing opposition and objections to the use of so-called ‘Possessive Credit(s),’” described as credits “which attribute, impute and/or which could be reasonably construed to credit a person with the authorship of a film.”³⁵⁷ It goes on to state various objections that the Writers Guild has made to possessory credits.

When used to refer to a person who is not the sole author of the screenplay, . . . [t]he granting of a possessive credit to a person who has not both written and directed a given motion picture inaccurately imputes sole or preminent authorship The widespread use of the credit denigrates the creative contributions of others.³⁵⁸

The parties were not able to finally resolve this dispute in the negotiations leading up to the 1995 WGA *Agreement*, so that agreement included an “interim agreement”³⁵⁹ that provided for tripartite negotiations among the producers, the WGA, and the Directors Guild of America (DGA), and included other measures to address the concern. That interim agreement expired on May 1, 2001, with the expiration of the 1998 WGA *Agreement*. The WGA has indicated that this issue will be an important

356. The former is used when the credited writer has written both the story and the screenplay. See WGA AGREEMENT, *supra* note 320, Theatrical sched. A, Theatrical Credits, para. 3. The latter is used when the credited writer has written the final script, but there is a separate story or source material. See *id.* at paras. 1, 2.

357. WGA AGREEMENT, *supra* note 320, at xi.

358. *Id.* at xii.

359. *Id.*

one in negotiating a successor collective bargaining agreement.³⁶⁰ Thus, it would seem that screenwriters view themselves as actual authors of the resulting film, not just as authors of a work on which the film is based. They are also striving for industry recognition of that status.

It remains an open question whether a screenwriter's recognition as the writer of the film constitutes intent to share authorship of the film with the other putative coauthor(s), as required for joint works by some courts. The prevalence of work-for-hire arrangements in the motion picture industry suggests that the producers (and presumably the individual creators who agree to work-for-hire arrangements) view the producer as the sole author of the movie. It is unclear whether that is the type of intent to share authorship contemplated by the *Childress* court.³⁶¹ It also remains to be seen whether that alone should be enough to disqualify all other contributors to a film from consideration as joint authors of the film.³⁶²

Even if the producer and the screenwriter do intend to share authorship, the Ninth Circuit's coauthorship requirement of control, as stated in *Aalmuhammed*, would mean that almost no screenwriters could be coauthors of a film.³⁶³ The screenwriter's lack of control is almost legendary (at least when the screenwriter is not also the director or the producer). To the extent courts follow *Aalmuhammed*, lack of control means that the screen-

360. As this Article goes to print, the WGA and the AMPTP have reached agreement on a new three-year collective bargaining agreement. In negotiations, the DGA and the producers offered the WGA some limitations on the "film by" credit, but the WGA declined, and the parties have agreed to continue discussions on the issue. See Peter Bart, *Case of the Credit Crisis: No Clues, No Closure*, DAILY VARIETY, July 30, 2001, at 18.

361. See *Childress v. Taylor*, 945 F.2d 500, 504 (2d Cir. 1991).

362. Each of the others who contribute authorship to a film, as will be discussed below, receive credit for their contributions, but not for the film as a whole. None of them satisfies the intent-to-share authorship requirement, and therefore, it is arguable that a film is not a joint work at all. Aside from the general critiques of that enhanced intent requirement and the fact that the cases in which it has developed did not deal with films or with other traditional forms of collaborative work, such a conclusion is not consistent with the legislative history of the 1976 Act or with some commentary. See H.R. REP. NO. 94-1476, at 120 (1976); 1 NIMMER & NIMMER, *supra* note 17, § 6.05, at 6-13.

In addition, it is inconsistent with the custom and practice regarding other types of works that are clearly intended to be, and have historically been, considered joint, such as songs written by a composer and a lyricist. Some such songs are simply credited to the authors jointly. For example, John Lennon and Paul McCartney shared a simple authorship credit even though some of their songs included music by one and lyrics by the other. See THE BEATLES, THE BEATLES ANTHOLOGY 94-98 (2000). Many songs, however, give separate credit for the music and lyrics. To characterize those songs as collective works rather than joint works because the separate credits show that the authors did not intend to share authorship credit for the song would be an extreme departure from practice, both in the industry and in the courts. Hence, to the extent that courts continue to require an intent to share authorship, a credit for separable or interdependent contributions rather than for the whole work should be considered evidence of such intent.

363. See *Aalmuhammed v. Lee*, 202 F.3d 1227, 1234 (9th Cir. 2000).

writer is not a coauthor of the film.³⁶⁴ If the screenwriter is not legally deemed a coauthor, then the film would most likely be viewed as a derivative work of the screenplay.

(4) Copyright Policy Arguments

If questions of intent to share authorship and absence of control were resolved in favor of a finding that the screenwriter was a coauthor of the film, is there a superceding copyright policy goal suggesting which would be the preferable analysis? The basic purpose of copyright law, at least in the United States, is to benefit the public by encouraging authors to create and publishers to disseminate original works of authorship through a system of property rights and the rewards that follow such rights. Screenplays are more likely to be created if the relationship between the screenplay and the film is that between a preexisting work and a derivative work. But films based on the screenplays are more likely to be created and distributed if the relationship between them is that of tenants in common. Hence, copyright policy arguments on this issue are inconclusive.

If a screenplay is considered a separate work from which the motion picture is derived and is not a work made for hire, the screenplay author has the power unilaterally to terminate transfers of rights in the screenplay. Or if the screenplay is considered a separate work, was copyrighted prior to 1978, and the author dies during the first term of copyright, any rights granted will lapse at the end of the first term. In either event, the possibility of reacquiring rights with the accompanying ability to sell them again is intended to encourage the production of works by authors. But that possibility might interfere with the production and distribution of films based on such works, because it could cause the producer to lose the right to create films based on the screenplay,³⁶⁵ or, in the event of a reversion of renewal rights, to continue to distribute existing films based on the screenplay.³⁶⁶ The impact of a termination is limited by the Copyright Act's provision that existing derivative works can continue to be exploited after a termination.³⁶⁷ Interference is likely, however, when there is a loss of renewal rights in a pre-1978

364. See *id.* at 1235.

365. See 17 U.S.C. §§ 203, 304(c), 304(d) (1994 & Supp. V 1999).

366. See *Abend v. MCA, Inc.*, 863 F.2d 1465 (9th Cir. 1988), *aff'd sub nom. Stewart v. Abend*, 495 U.S. 207 (1990).

367. See 17 U.S.C. §§ 203(b)(1), 304(c)(6)(A), 304(d)(1). Although the relation between screenplay and motion picture generally seems unresolved, a motion picture is to be considered a derivative work of the screenplay for purposes of the derivative works exception to a statutory termination. See H.R. REP. NO. 94-1476, at 127 (1976); see also 3 NIMMER & NIMMER, *supra* note 17, § 11.02[C][1], at 11-21.

screenplay: In that event new films could not be created nor could the existing film continue to be exploited without a further grant of rights by the author's heir.

One might argue that the author's (or his heirs') reacquisition of rights upon the end of the first term of copyright furthers the goal of production of films, because the author/heirs would be more likely to then license the creation of new motion picture versions of a screenplay when they reacquire those rights than would the copyright owner of the original motion picture. This is because the owner of the original motion picture might not want the competition with its existing film.

However, motion pictures are not usually created for exploitation in only the United States, because they require worldwide revenues to recoup their investment. Because only rights under U.S. copyright law would be reacquired in the event of a termination or reversion of the renewal term, the motion picture rights would be divided between the author/heirs (in the United States) and the original grantee (in the rest of the world). If the producer of the original picture (or its assignee) were motivated to prevent the production of a competing sequel or remake, it would effectively be able to do so by refusing to grant rights as to the world outside the United States. Thus, it is possible that treating a film as a derivative work of the screenplay, with the resulting possibility of a split of rights, might encourage the creation of screenplays, but it would not further the goal of production of films.

If the screenplay is treated not as a separate work but rather as a contribution to a joint work, there would be no reversion or termination of rights as between coauthors of a joint work. This might discourage creation of screenplays, but could encourage the production of motion pictures by extending and simplifying the producer's rights. On the other hand, having to share authorship of films with other creative participants who were not engaged under work-for-hire arrangements may be undesirable to producers because of the potential loss of exclusive control over the film. Hence, there is no clear public policy rationale favoring either characterization of a film as a joint work with the screenwriter or as a derivative work of the screenplay.

(5) Conclusion

Although the above arguments do not clearly support either possibility, characterization of the screenplay as a preexisting work from which the motion picture is a derivative work seems more likely. This would certainly be true in most cases if courts follow *Aalmuhammed*, but also seems likely if courts reject the control test enunciated in that case.

3. Cinematographers

Cinematography is one of the key, inseparable components of film authorship.³⁶⁸ Cinematography is clearly copyrightable authorship.³⁶⁹ The cinematographic contributions to film authorship are inseparable parts of the unitary whole. As such, the originators of those contributions would seem to be joint authors of the film. Under the enhanced intent requirements and the *Aalmuhammed* control test,³⁷⁰ however, there is some doubt whether even a cinematographer would qualify as a coauthor, or whether his cinematography contributions would be viewed as separate—albeit inseparable—works. Analyzing these contributions requires consideration of which elements constitute copyrightable authorship in the photography comprising a motion picture, and then determining who are the originators of those elements.

In the silent film era, one photographer handled tasks that are now handled by a whole crew of technicians; he sometimes even oversaw the laboratory's development of the film.³⁷¹ Now, the photography is handled by a crew, including a director of photography, a camera operator, a first assistant photographer, and a second assistant photographer.³⁷² The director of photography is in charge of that crew.³⁷³ "The term 'Director of

368. Some of the earliest films, which had no script, actors, or editing, were copyrighted as photographs; these may be the purest example of cinematography. See *Edison v. Lubin*, 122 F. 240 (3d Cir. 1903) (holding that a short film of Kaiser Frederick Wilhelm's yacht launch, *Meteor*, photographed by Thomas Edison and his camera operator was copyrightable as a photograph); Charles Musser, *The Emergence of Cinema: The American Screen to 1907*, in 1 HISTORY OF THE AMERICAN CINEMA, *supra* note 228 (discussing early motion picture productions).

369. The House Report accompanying the 1976 Copyright Act states:

When a football game is being covered by four television cameras, with a director guiding the activities of the four cameramen and choosing which of their electronic images are sent to the public and in which order, there is little doubt that what the cameramen and the director are doing constitutes "authorship."

H.R. REP. NO. 94-1476, at 52 (1976).

370. See *supra* Part II.C.

371. See BROWNLOW, *supra* note 227, at 212.

372. See AGREEMENT BETWEEN PRODUCER & INT'L ALLIANCE OF THEATRICAL STAGE EMPLOYEES & MOVING PICTURE TECHNICIANS, ARTISTS & ALLIED CRAFTS OF THE U.S. & CAN. & INT'L PHOTOGRAPHERS OF THE MOTION PICTURE & TELEVISION INDUS., LOCAL #600, §VIII, ¶ 95 [hereinafter PHOTOGRAPHERS AGREEMENT]. In films subject to the *Photographers Agreement* the director of photography is not permitted to actually operate the camera; this job is reserved to the camera operator. See *id.* ¶ 96.1. The first assistant photographer is responsible for maintaining the proper lens focus, handling filters and other optical effects and lenses, and assisting the camera operator. See *id.* ¶ 98; BROWNLOW, *supra* note 227, at 212. The second assistant photographer loads the film magazines, assists the first assistant, and handles reports and other administrative work. See PHOTOGRAPHERS AGREEMENT, *supra*, ¶ 95; BROWNLOW, *supra* note 227, at 212.

373. See PHOTOGRAPHERS AGREEMENT, *supra* note 372.

Photography' . . . mean[s] a photographer . . . who is in active charge of photographing a motion picture, including supervision of the technical crew, process photography, underwater photography, aerial photography, process plates, inserts and special effects photography."³⁷⁴

Authorship in cinematography draws from determinations of authorship contributions to a photograph. These include posing the subject and evoking the desired expression; selecting and arranging the costumes, props, and other accessories; arranging light and shade;³⁷⁵ selecting the type of camera and lenses; selecting the time and position of the camera for taking the photograph;³⁷⁶ selecting the camera angles and exposures; and deciding what events to photograph and the duration of the filming.³⁷⁷ As with many aspects of film authorship, many people may participate in making those authorial choices. However, arranging light and shade, selecting the camera and lenses, and determining camera position, angles, and exposures are decisions particularly within the domain of the director of photography, the camera operator, and possibly the first assistant cameraman, together in some cases with the film director. Whoever actually makes those decisions is the author of the cinematographic work.

Thus, in the absence of a work-for-hire arrangement, the cinematography should be considered a contribution of inseparable material to a unitary whole motion picture, and the cinematographer should be considered a coauthor of the film. The cinematographer, however, is usually credited merely as such and not as a coauthor of the film as a whole. Moreover, the cinematographer will usually not be in control of the film as a whole.³⁷⁸ Hence, under the judicially enhanced joint work rules, the cinematographer would not be considered a coauthor of a joint work, and the cinematography would be a distinct work, albeit a work that is inseparable from the other elements of the film.

4. Editors

Film editing is another aspect of the motion picture that involves inseparable contributions to the audiovisual work. Editing involves the cut-

374. PHOTOGRAPHERS AGREEMENT, *supra* note 372, ¶ 95.

375. The preceding elements were said to constitute photographic authorship in *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

376. See *Time, Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 143 (S.D.N.Y. 1968).

377. See *L.A. News Serv. v. Tullo*, 973 F.2d 791, 794 (9th Cir. 1992).

378. The *Aalmuhammed* decision stated that the "chief cinematographer" may be regarded as the author of the film "[w]here the visual aspect of the movie is especially important." *Aalmuhammed v. Lee*, 202 F.3d 1227, 1232 (9th Cir. 2000). How it is to be determined that the visual aspect is "especially important" or who is to make that determination is not specified.

ting and assembling of various shots or parts of a film into a unitary whole. Many have credited D. W. Griffith's *The Birth of a Nation*³⁷⁹ as the first film to exemplify "the extraordinary power of editing."³⁸⁰ In earlier times, the director simply told a film "cutter" which scenes to assemble, but "[a]s filmic storytelling became more imaginative, so the cutter's job became more complex, more responsible. The role of the editor was created."³⁸¹

The editor normally works under the supervision of the director and the producer, selecting and arranging the separate shots into the composite film and synchronizing soundtrack and visual elements.³⁸² After principal photography of a motion picture is completed, the film editor creates the "editor's assembly," a rough cut of the film, and delivers it to the director.³⁸³ Usually, the assembly is done according to the directions of the director, but the editor's creative autonomy may vary.³⁸⁴

In a sense, a film is a collective work incorporating multiple, separately copyrightable segments of cinematography that are selected, coordinated,

379. THE BIRTH OF A NATION (David W. Griffith Corp. 1915).

380. BROWNLOW, *supra* note 227, at 281. The simplest home videos may consist of a single shot with no editing. Use of editing techniques to define the temporality and spatiality of a film dates back to some of the earliest films. See Musser, *supra* note 368, at 5-6; *Am. Mutoscope & Biograph Co. v. Edison Mfg. Co.*, 137 F. 262 (C.C.D.N.J. 1905) (involving an early film that incorporated multiple scenes, cut and edited together).

381. BROWNLOW, *supra* note 227, at 280.

382. The editor's duties have been described as follows:

The Film Editor selects and assembles the film to create a story progression in accordance with the director's vision. He works closely with the director, viewing dailies with him to determine the selection of images, and with his assistant editor in the actual organization, physical handling, and cutting of the positive workprint. He also supervises the synchronization of voice and sound tracks with the picture and provides guide tracks for the sound effects editors to enable them to prepare for dubbing sessions. Additional duties include designing, preparing, and approving orders for opticals, titles, stock footage when necessary, and viewing the composite answer prints for quality control. He or she also coordinates the work of the sound and music editors and the negative cutter . . .

BROUWER & WRIGHT, *supra* note 241, at 360. "Z-1 Feature Editor' shall be deemed to mean a person actually engaged in the editing and/or cutting of positive prints of feature motion pictures. He edits and cuts the positive prints of pictures into proper sequence and story form." AGREEMENT BETWEEN PRODUCER-I.A.T.S.E. & M.P.T.A.A.C. MOTION PICTURE EDITORS GUILD (MAJORS), LOCAL #776, art. VIII, at 95 (Aug 1, 1996) [hereinafter PRODUCERS AGREEMENT].

383. *Id.* art. VII, at 64.

384. "If the Director does not give such directions, the Editor may proceed with the assemblage of the sequences without them." ALLIANCE OF MOTION PICTURE & TELEVISION PRODUCERS AND DIRECTORS GUILD OF AMERICA, INC. BASIC AGREEMENT OF 1993, § 7-505(a). Freeman Davies, who with his wife Carmel is often Walter Hill's editor, said: "Walter gives me a lot to work with. There's always great footage. He pretty much lets me do what I want with the initial assemblage. He trusts me enough to give me a lot of control in the rough cut." BROUWER & WRIGHT, *supra* note 241, at 364.

and arranged in an original manner.³⁸⁵ That selection, coordination, and arrangement constitutes what is called film editing. Films also include sound elements and musical elements, the selection, coordination, and arrangement of which is handled by sound editors and music editors, respectively.³⁸⁶

To the extent that the producer or director makes the original and creative decisions as to that selection, coordination, or arrangement, he is the author of that collective work. To the extent that he relies on the editors to make those decisions, the editors are authors. Editing is always an inseparable contribution to a unitary whole film. Yet, as with the other contributions, the editor might not qualify as a coauthor under the judicially enhanced joint work rules, because he is typically credited for editing and not for authoring the film as a whole, and because he will rarely have control over the film as a whole.

5. Performers

There is little case law or statutory authority as to the position of performers as authors of an audiovisual work under U.S. law. Many international territories do not consider performers authors, but instead protect them against the unauthorized fixation or distribution of recordings of their performances by a "neighboring right" or "related right," also known as the "performers right." This is a lesser status than that of an author, and is more akin to a translator's rights.³⁸⁷

Some early cases in the United States demonstrated a reluctance to grant copyright or other property in the movements, voice, or postures of actors; instead, these aspects of performances were characterized as mere

385. "Compilation authorship in a motion picture is generally combined with editing authorship." COMPENDIUM, *supra* note 181, § 480.04, at 400-27.

386. See PRODUCERS AGREEMENT, *supra* note 382, art. VIII, at 99 (sound editor) & 100 (music editor).

387. See RICHARD ARNOLD, PERFORMERS' RIGHTS (2d ed. 1997). The term "neighboring rights" or "*droits voisins*" covers rights of performers, producers of sound recordings, and broadcasters. 3 NIMMER & NIMMER, *supra* note 17, § 8 E.01[A], at 8E-4. Such rights are recognized by the 1961 Rome Convention, to which the United States is not a party. See *id.* The term "related rights" is sometimes used to cover those rights, plus the rights of film producers and rights in literary first editions and typographical arrangements. *Id.* § 8E.01[A], at 8E-5. With its historical roots in the problem of whether intellectual property rights should be recognized in photographs, this additional realm of legal protection is accorded to these types of matter that are not thought of as embodying the "high authorship" of more traditional artistic media. *Id.* The United States has finally recognized neighboring rights for musical performers as a result of its obligations as a signatory to the AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS, Apr. 15, 1994, 33 I.L.M. 87 (1994) portion of the World Trade Organization Agreement. See 17 U.S.C. § 1101 (1994); see also 3 NIMMER & NIMMER, *supra* note 17, § 8E.01[B], at 8E-5.

"stage business," rather than as original, creative literary expression.³⁸⁸ But a closer review of some of the earliest cases shows that they rejected claims for imitation of a performance not because the original elements of a performance could not be protected by copyright, but because the plaintiff did not own the elements of the performance imitated by the defendant.

In *Bloom & Hamlin v. Nixon*,³⁸⁹ a popular mimic imitated "the peculiar actions, gestures, and tones" of another well-known performer in her performance of the latter's signature song.³⁹⁰ The court refused to enjoin the performance, finding that the plaintiffs, a songwriter and the employer of the stage director, could not have a copyright in those elements of the well-known performer's rendition of the song.³⁹¹

Similarly, in *Savage v. Hoffman*,³⁹² the defendant performed a burlesque "imitating the postures" of the performers in a popular production of the opera *The Merry Widow*.³⁹³ The court refused to grant an injunction, stating that "the complainant has no literary property in the manner in which [the stars] dance or posture. [The stars], if any one, have the right to complain."³⁹⁴ Seemingly recognizing the possibility of originality on the part of the performers, the court continued, "The manner and method of every dancer and actor is individual"³⁹⁵

Not long after those cases, however, the Second Circuit cited them in rejecting copyright in performance elements, in *Chappell & Co. v. Fields*:³⁹⁶ "While the voice, motions, and postures of actors and mere stage business may be imitated because they have no literary quality and cannot be copyrighted [citing *Bloom* and *Savage*], a scene like the one under consideration has literary quality, and may be protected by copyright."³⁹⁷

Later, the Ninth Circuit cited *Fields* for the same proposition, stating: "It is true that the mere motions, voice and postures of actors and mere stage business is not subject of copyright protection, but the sequence in question has literary quality in that it contains a story and is dramatic composition."³⁹⁸

388. *Chappell & Co. v. Fields*, 210 F. 864, 865 (2d Cir. 1914).

389. 125 F. 977 (E.D. Pa. 1903).

390. *Id.* at 978.

391. "What is being represented are the peculiar actions, gestures, and tones of Miss Faust; and these were not copyrighted by the complainant Bloom, and could not be, since they were the subsequent device of other minds." *Id.*

392. 159 F. 584 (S.D.N.Y. 1908).

393. *Id.* at 585.

394. *Id.*

395. *Id.*

396. 210 F. 864 (2d Cir. 1914).

397. *Fields*, 210 F. at 865; see also *Universal Pictures, Co., v. Harold Lloyd Corp.*, 162 F.2d 354, 363 (9th Cir. 1947); *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1, 22 (9th Cir. 1933).

398. *Universal Pictures*, 162 F.2d at 363.

It should be noted that the outcomes of these cases did not turn on the lack of copyrightability in an actor's performance.

A contemporaneous case, *Waring v. WDAS Broadcasting Station, Inc.*,³⁹⁹ carefully examined what the performer may add to material performed and found that there was a property right in the artistic performances of an orchestra:

It may be said that the ordinary musician does nothing more than render articulate the silent composition of the author. But it must be clear that [highly accomplished] actors . . . or [highly accomplished] vocal and instrumental artists . . . by their interpretations definitely added something to the work of authors and composers which not only gained for themselves enduring fame but enabled them to enjoy financial rewards from the public in recognition of their unique genius . . . [P]roperty rights in intellectual or artistic productions . . . may be acquired by one who perfects the original work or substantially adds to it in some manner The translation of a novel, or its dramatization, vests a distinct property right which is entitled to the same protection as is extended to the original. . . . [I]t is the performer who must consummate the work by transforming it into sound. If, in so doing, he contributes by his interpretation something of novel intellectual or artistic value, he has undoubtedly participated in the creation of a product in which he is entitled to a right of property, which in no way overlaps or duplicates that of the author in the musical composition [S]uch a property right inheres in the case of those artists who elevate interpretations to the realm of independent works of art.⁴⁰⁰

If a musical performance, which is generally a rendition of a preexisting musical composition, constitutes authorship, it is a logical inference that a dramatic performance—a rendition of a screenplay—would also be a work of authorship, which is copyrightable if fixed in a tangible form such as a motion picture. Additionally, although novelty is not required, performance contributions, to be copyrightable, must be original and sufficiently concrete to be considered expression rather than merely abstract ideas.⁴⁰¹

Musical performers' neighboring rights were formally recognized in the United States in 1994, when a provision was added to the 1976 Act prohibiting the unauthorized fixation of musical performances. In addition to such neighboring rights recognition, the legislative history of the 1976 Act indicates that musical performers may also be authors of a sound recording:

The copyrightable elements in a sound recording will usually, though not always, involve "authorship" both on the part of the performers

399. 194 A. 631 (Pa. 1937).

400. *Id.* at 634–35.

401. See 1 NIMMER & NIMMER, *supra* note 17, § 2.13, at 2-178.3; see also 1 GOLDSTEIN, *supra* note 54, § 2.10, at 2:114 to :115.

whose performance is captured and on the part of the record producer responsible for setting up the recording session, capturing and electronically processing the sounds, and compiling and editing them to make the final sound recording. There may, however, be cases where the record producer's contribution is so minimal that the performance is the only copyrightable element in the work⁴⁰²

Because works of choreography and pantomime are potentially works of authorship under current copyright law,⁴⁰³ there is an implication that an actor's performance can be a work of authorship, because acting involves movement, posture, and gesture, which are analogous to copyrightable pantomime or choreography. Under the copyright law prior to 1978, choreography was not expressly recognized as copyrightable, but cases had found copyrightability if the movement was sufficiently "dramatic."⁴⁰⁴ Drama was inferred if the movement told a story, portrayed a character, depicted an emotion, or otherwise conveyed a dramatic concept or idea.⁴⁰⁵ The requirement that movement be dramatic or literary under pre-1978 law in order to qualify for copyright may explain the early decisions' rejection of copyright for performances. Although much acting might qualify as dramatic, at least in the broader sense of depicting emotion, that may no longer be necessary under current law. The 1976 Act provided for the first time that pantomime and choreography fall within the subject matter of copyright.⁴⁰⁶ Neither term is defined in the Act,⁴⁰⁷ but the legislative history indicates congressional intent to extend protection to "all forms of choreography,"⁴⁰⁸ and commentators have argued persuasively that the Act extends protection to nondramatic choreography and pantomime.⁴⁰⁹ Of course, the movement must be original, expressive, and at least minimally creative,⁴¹⁰ and must be fixed in a tangible medium of expression, in order to be protectable under federal law.

402. H.R. REP. NO. 94-1476, at 56 (1976).

403. See 17 U.S.C. § 102(a)(4) (1994).

404. 1 NIMMER & NIMMER, *supra* note 17, § 2.07[B], at 2-69; see 1 GOLDSTEIN, *supra* note 54, § 2.10, at 2:115.

405. See Borge Varmer, *Copyright in Choreographic Works*, reprinted in 1 STUDIES ON COPYRIGHT, *supra* note 24, at 105-06.

406. See 17 U.S.C. § 102(4).

407. The legislative history states that those terms "have fairly settled meanings." H.R. REP. NO. 94-1476, at 53 (1976).

408. *Id.* at 52.

409. See 1 NIMMER & NIMMER, *supra* note 17, § 2.07[B], at 2-69; see also 1 GOLDSTEIN, *supra* note 54, § 2.10, at 2:116 to :117.

410. Nimmer and Nimmer argue that the legislative history's statement that copyright would not be extended to "social dance steps and simple routines," H.R. REP. NO. 94-1476, at 54 (1976), may suggest a heightened creativity requirement. See 1 NIMMER & NIMMER, *supra* note 17, § 2.07[C], at 2-70.

The *Copyright Office Compendium* defines pantomime as "the art of imitating or acting out situations, characters, or some other events with gestures and body movement," which "need not tell a story."⁴¹¹ A mere "style" of movement would be an unprotectable idea, and there must be "a significant amount of copyrightable matter in the form of specific gestures"⁴¹² The *Compendium* defines choreography as "the composition and arrangement of dance movements and patterns[;] . . . static and kinetic successions of bodily movement in certain rhythmic and spatial relationships," which, like pantomime, "need not tell a story."⁴¹³ To the extent that what an actor adds to a motion picture is original, expressive movement, posture, and gesture, it should be considered copyrightable subject matter, by analogy to pantomime and choreography.

There is virtually no case law addressing the copyrightability of either pantomime or dance, or the protectability of an actor's work as such.⁴¹⁴ However, a recent California appellate decision found that the performance of an actor in a film was copyrightable as a dramatic work.⁴¹⁵

Thus, it seems likely that an actor's original movements, postures, gestures, and other physical expression may constitute authorship. As the *Waring* case recognized, only that which is added by the performer would qualify for copyright authorship. A performer's work would not be considered original, and thus would not be copyrightable, to the extent that the actor's material is described in the screenplay, is originated by the director, is dictated by necessity, consists of standard, stock movements, or is copied from other performances. An actor's general style would be unprotectable, since it is merely an idea. For similar policy reasons, the Nimmers' suggestion that a higher degree of creativity might be required as to dance steps should be applied to an actor's performance.⁴¹⁶

If an actor's original performance⁴¹⁷ constitutes authorship of a copyrightable work, actors potentially have a stronger degree of protection under

411. COMPENDIUM, *supra* note 181, § 460.01, at 400–21.

412. *Id.* § 461, at 400–21.

413. *Id.* § 450.01.

414. *But see* Horgan v. MacMillan, Inc., 789 F.2d 157 (2d Cir. 1986) (holding that choreographic work may be infringed by series of still photographs).

415. *See* Fleet v. CBS, Inc., 50 Cal. App. 4th 1911, 1919–20 (1996). *Fleet* involved a claim by actors against the distributor of the motion picture alleging violation of their right of publicity in their likeness, a state claim. *See id.* at 1915. The court found the claim preempted by federal copyright law, in part because the performance, once embodied in a motion picture with their consent, was copyrightable. *See id.* at 1919–20.

416. *See supra* note 410.

417. The above discussion has focused on the performance aspect of an actor's contribution to a motion picture. Actors are also notorious for changing dialogue. To the extent that an actor changes or creates new dialogue that is more than *de minimis*, the actor is also an author of literary

U.S. law than they do under the law of countries that have long recognized the performer's right, because copyright is a more extensive bundle of rights than the performer's right. For example, the performer's right typically provides rights in the actual recording of a performance, not a right to stop imitative performances.⁴¹⁸ Although the requirements of originality and creativity, as well as other defenses against infringement,⁴¹⁹ should limit claims against imitative performances, the rights of the actor as an author under copyright would include the right to copy, or to prepare derivative works of, the protectable expressive elements of the performance.⁴²⁰

In one way, however, the rights of a performer as an author are more limited than under typical performers' rights. The performer's right typically includes the right to make a fixation of an unfixed performance.⁴²¹ Other than the relatively new right recognized with respect to musical performances under 17 U.S.C. § 1101, U.S. copyright law only applies to performances that have already been fixed in a tangible medium of expression,⁴²² and would not operate to provide a right against an unauthorized first fixation.⁴²³

material. The WGA Agreement would preclude the actor's being recognized as a screenwriter for such rewriting of dialogue. To the extent that the dialogue is rewritten by the actor as part of her performance, it would appear to be a contribution to the audiovisual work, rather than a preexisting literary work from which the motion picture is a derivative work.

418. See ARNOLD, *supra* note 387, at 93. United States law is similar with respect to rights in sound recordings, which may not be duplicated or distributed publicly, but it is not an infringement of copyright to imitate. See 17 U.S.C. § 114 (1994).

419. For example, *de minimis* uses do not infringe. A *de minimis* use is too minimal to be considered infringing. Moreover, the requirement that a taking be substantial to be infringing, along with the fair use and parody defenses, also limit infringement claims.

420. Although U.S. copyright law has explicitly recognized moral rights only as to works of visual art, the definition of which would not include audiovisual performances, the performer's right of integrity, one of the most important of the moral rights, would be protected by the right to prevent unauthorized derivative works. See *Gilliam v. ABC*, 538 F.2d 14 (2d Cir. 1976). The other most important moral right, that of attribution, is somewhat less protected under U.S. law. False or misleading credits are actionable under state and federal unfair competition law. See *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981) (crediting another instead of plaintiff actor for a performance constituted "reverse palming off"). The *Alliance of Motion Picture & Television and Screen Actors Guild (SAG) Codified Basic Agreement* gives further protection. Producers are required to give at least one "card" of screen credits indicating the performer and the role played, but leaves the number of credits on that card to the producer's discretion, except that at least fifty performers must receive credit (or all performers, if there are less than fifty in the film). See *id.* art. 25. It is likely that any actor with a significant part in a film will be covered by the minimum requirement, and, as a practical matter, all actors (perhaps other than some nonspeaking "extras") receive credit in SAG feature films.

421. See STEPHEN M. STEWART, *INTERNATIONAL COPYRIGHT AND NEIGHBORING RIGHTS* § 7.23 (1989).

422. See 17 U.S.C. § 1101 (1994).

423. State or common law copyright might provide protection against unauthorized first fixation. See CAL. CIV. CODE § 980 (West 1982) (providing protection for works of authorship not fixed in a tangible medium of expression).

The extent to which audiovisual performances are protected under existing U.S. law is likely to become more important in the future, as the World Intellectual Property Organization (WIPO) is considering requiring recognition of such rights as it negotiates a new international treaty.⁴²⁴

Hence, many performers could be considered the authors of the original expressive aspects of their performances in a motion picture. Although the film producer would ordinarily engage actors under work-for-hire agreements, and thus the producer would be considered the author of actors' contributions under U.S. copyright law, in the absence of a work-for-hire relationship, performers who qualify as authors might be viewed as coauthors of a joint work. Under the judicially enhanced joint work requirements, however, an actor might not satisfy the intent-to-share authorship requirement and almost always will fail to satisfy the control test.⁴²⁵ Hence, as with the cinematographers, editors, and others, the actors' performances would be conceptually separate works of authorship, physically inseparable from other cinematic contributions.

6. Production Designers and Other Designers

"Art direction, or production design, determines the look of a picture almost as forcefully as the lighting."⁴²⁶ Production design involves many different activities:

The Production Designer supervises the search for locations, designs the sets, oversees the drawing up of blueprints and the building and dressing

424. See http://www.wipo.org/news/en/index.html?wipo_content_frame=/news/en/conferences.html (last visited Sept. 23, 2001) (reporting on Diplomatic Conference on the Protection of Audiovisual Performances). In December 2000, progress was made on most provisions of such a treaty, but delegates were unable to agree on an article concerning transfer of rights. Further meetings are to take place in September 2001.

425. The *Aalmuhammed* decision suggested that a star might be the person with creative control. See *Aalmuhammed v. Lee*, 202 F.3d 1227, 1232 (9th Cir. 2000).

426. BROWNLOW, *supra* note 227, at 238. William Everson, a noted film historian, says that planned art direction in cinema did not occur until at least 1915, and even then was rare. See WILLIAM K. EVERSON, *AMERICAN SILENT FILM* 299 (1998). Prior to that, the function was handled by the director and the cameraman. See *id.* He also points out that the functions of production designer might be performed by an assortment of individuals and varied from picture to picture. See *id.* at 303. Everson feels that the art direction has been inappropriately underrated by critics and the public, and that it "often has far more influence on the style of the finished film than the work of the director." *Id.* at 304. For an extremely interesting discussion of the role of art direction and production design, see *id.* at 299-316.

of sets, and coordinates the various departments that contribute to the artistic design of the film and the execution of those designs—namely construction, set design and decoration, props, costumes, hair, and makeup.⁴²⁷

Many, but not necessarily all, of those activities result in copyrightable material. For example, creating original sketches and designs for sets and backgrounds constitutes authorship. The sets and backgrounds themselves would be copyrightable copies or derivative works of those designs. To the extent that sets and props have an intrinsic utilitarian function, they may implicate the copyright problems associated with “useful articles.”⁴²⁸ Although close questions could result from a particular item, to the extent there are pictorial, graphic, or sculptural elements that are separable from the utilitarian aspects of the article, those elements are copyrightable.⁴²⁹ Moreover, if the utilitarian function is “merely to portray the appearance of the article,” then it is not considered a useful article at all, and would be fully protectable as a pictorial, graphic, or sculptural work.⁴³⁰

In addition, the original, minimally creative selection, ordering, or arrangement of items, even if not themselves separately copyrightable, can result in a copyrightable compilation.⁴³¹ The art director’s function may involve such compilation, and other, less obviously artistic crew who perform

427. BROUWER & WRIGHT, *supra* note 241, at 179. Everson distinguishes the art director from the production designer: “Although the production designer had the same skills and performed many of the same functions as the art director, he operated on a higher plateau and usually only for much more important films. . . . In many ways, the production designer was a director before the fact.” EVERSON, *supra* note 426, at 304. The collective bargaining agreement covering art directors gives what sounds like a more limited description of her job: “an employee who directs the preparation of and/or prepares sketches and designs of motion picture sets and/or backgrounds and generally supervises the execution of such designs and the decorating of sets and/or backgrounds.” AGREEMENT BETWEEN PRODUCER-I.A.T.S.E. & M.P.T.A.A.C. MOTION PICTURE & TELEVISION ART DIRECTORS, LOCAL # 876, art. VIII, at 95(b) (Aug. 1, 1996) [hereinafter PRODUCERS AGREEMENT II]. But it goes on to state that “It is not the intent of the Producer to abridge or reduce or extend any of the historical duties, work practices and traditional function of Art Directors and/or Production Designers” *Id.* art. VIII, at 95(f). Generally, the person performing those functions is to receive credit as “Art Director,” but credit in the form “Production Designer” is permitted with the Guild’s written approval. *Id.* art. VII, at 84. In practice, production designer credit is routinely sought and permitted.

428. 17 U.S.C. § 101 (1994 & Supp. V 1999). See generally Shira Perlmutter, *Conceptual Separability and Copyright in the Design of Useful Articles*, 37 J. COPYRIGHT SOC’Y U.S.A. 339 (1990).

429. See 17 U.S.C. § 101.

430. *Id.*

431. See 17 U.S.C. §§ 101, 103.

such compilation activities, such as the set decorator,⁴³² lead man,⁴³³ and property master,⁴³⁴ may also make such authorial contributions.

The costume designer often creates sketches of the clothing to be worn by the actors.⁴³⁵ The sketches themselves are clearly protectable pictorial works, but the resulting clothing may not be subject to copyright, or only minimally so, because of the useful article doctrine.⁴³⁶ Moreover, ownership of the sketches may not include the right to prevent the construction of the costumes depicted, because of the functional works doctrine of *Baker v. Selden*.⁴³⁷

Even makeup design, if original and minimally creative, can constitute copyrightable material.⁴³⁸

7. Music: Composers, Songwriters, and Performers

It seems inarguable that film music is a copyrightable element of a motion picture. Like the screenplay, music is capable of existing separately from the film, and is clearly copyrightable.⁴³⁹

432. A description of the set decorator's responsibilities reads:

The Set Decorator works closely with the production designer to achieve the visual look of the film. To do this he or she decorates with furniture, drapes, textures, carpeting, personalized memorabilia, paintings, and so on. The Set Decorator supervises the set dressing crew, consisting of a lead man and swing gang

BROUWER & WRIGHT, *supra* note 241, at 194.

433. "The Lead Man assists the set decorator in . . . arranging for the . . . positioning of all items of set dressing He supervises the swing gang or set dressing crew, who physically dress . . . the set" *Id.* at 208-09.

434. "The Property Master is responsible for . . . selecting, positioning, and maintaining all props. Props are items that are carried or handled by the actors The Property Master, unlike the set decorator, physically positions the props on the set or on the actor." *Id.* at 199.

435. See Tino Balio, *Grand Design: Hollywood as a Modern Business Enterprise, 1930-1939*, in 5 HISTORY OF THE AMERICAN CINEMA, *supra* note 228, at 92-94 (discussing the importance of the studio costume designers in creating the "look" of motion pictures during that period). "Costumes, like sets, served a narrative function: they helped define character, social status, and historical period." *Id.* at 92.

436. But see Rebeca Sanchez-Roig, Note, *Putting the Show Together and Taking It on the Road: Copyright, the Appropriate Protection for Theatrical Scenic and Costume Designs*, 40 SYRACUSE L. REV. 1089 (1989) (arguing that theatrical scenic and costume designs should not be considered useful articles and should be copyrightable).

437. 101 U.S. 99 (1879).

438. See *Carell v. Shubert Org., Inc.*, 104 F. Supp. 2d 236 (S.D.N.Y. 2000) (assuming that makeup designs for successful Broadway production of *Cats* were copyrightable).

439. This assumes that the music satisfies the basic requirements for a copyrightable work, namely, originality and minimal creativity. The relationship between a music soundtrack and the film as a whole is nebulous. See H.R. REP. NO. 94-1476, at 56 (1976). A thorough consideration of the potential legal issues arising from that relationship is beyond the scope of this Article. See generally E.F. Brylawski, *Motion Picture Soundtrack Music: A Gap or Gaff in Copyright Protection?*, 40 J. COPYRIGHT SOC'Y U.S.A. 333 (1993) (discussing some of those issues).

There are at least two separate types of works involved in film music: musical composition,⁴⁴⁰ and a recording of a specific performance of the composition.⁴⁴¹ Much of the musical composition of a film consists of what is known as the “score” or “underscore,” which is the background music supporting the visual images in the film.⁴⁴² It is increasingly common for a film soundtrack also to include recordings of songs, which may either be preexisting or composed specifically for use in the film. The score and any original songs are typically recorded for use in the film. Existing recordings of preexisting songs are usually used, but in some cases new recordings are made specifically for the film.

Preexisting songs and recordings that are licensed for use in a film are unarguably separate works from the film, and need not be further addressed here, as their copyright status is unquestioned. The score, the recording of the score, original songs, and recordings of either original songs or preexisting songs are usually prepared under contracts, which, like other contracts in the U.S. motion picture industry, generally provide that the music and recordings are works made for hire for the producer. Outside a work-for-hire arrangement, the author of the score music and any original songs is the person who originates the copyrightable expression. This is likely to be the composer, but in films, the composition and songwriting is often a collaboration between the composer and the director, producer, and others involved in production of the film.⁴⁴³ As is true of non-motion picture sound recordings, the author of the recordings of the score and of any songs made for the film will typically be the performers and the recording producers.⁴⁴⁴

440. The 1976 Copyright Act expressly includes “musical works, including any accompanying words” among the categories of works of authorship. 17 U.S.C. § 102(a)(2) (1994).

441. One might describe the recording as a sound recording, which is also expressly included among the categories of works of authorship under the 1976 Act. See 17 U.S.C. § 102(a)(7). The recordings of film music are “works that result from the fixation of a series of musical, spoken, or other sounds.” 17 U.S.C. § 101 (1994 & Supp. V 1999). However, “sounds accompanying a motion picture” are, by definition, not sound recordings. See *id.* (defining sound recordings). Rather, the sounds accompanying a motion picture are, by definition, part of the motion picture. See *id.* (defining motion pictures). Still, the concepts and jurisprudence that have developed as to sound recordings would seem to apply to recordings of music made for use in a film, for example, as to authorship of the recording. See *Maljack Prods., Inc. v. UAV Corp.*, 964 F. Supp. 1416, 1428 (C.D. Cal. 1997) (holding that motion picture soundtracks are analogous to sound recordings and that a remixed motion picture soundtrack was a copyrightable derivative work).

442. See DONALD S. PASSMAN, *ALL YOU NEED TO KNOW ABOUT THE MUSIC BUSINESS* 379 (2d ed. 1994).

443. See FRED KARLIN & RAYBURN WRIGHT, *ON THE TRACK: A GUIDE TO CONTEMPORARY FILM SCORING* 15–26 (1990) (discussing the interplay of the composer with the director, producers, editors, and music supervisors).

444. See H.R. REP. NO. 94-1476, at 56 (1976). It seems likely that the conductor, if there is one, might also be a coauthor, as a result of his input into and control of certain aspects of the performance.

Because the music and recordings are capable of existing independently from the rest of a film, questions arise similar to those discussed above with respect to the screenplay. In the absence of work-for-hire arrangements, should the authors of the music and recordings be considered contributors of separate works to a compilation, owners of a preexisting work from which the motion picture is a derivative work, or coauthors of the film itself, whose contributions are interdependent with the other material in the film? In most cases, the music is not composed or recorded until the film is nearly complete, although some directors like to involve the composer at earlier stages of production.⁴⁴⁵ Hence, it would be unusual for the film to be considered a derivative work of the music.⁴⁴⁶

On the other hand, some music recordings may satisfy the requirements for a joint work.⁴⁴⁷ The authors intend to merge contributions into interdependent parts of a unitary whole, and the music and recordings will generally be separately copyrightable elements.

The more difficult determination would be whether the parties regarded themselves as joint authors. The composer is not credited as an author of the film itself, and usually only receives credit for the music. As discussed above, it is unclear whether credit for a particular contribution is sufficient to show an intent to share coauthorship. Indeed, in a dispute arising in connection with Disney's animated film *Fantasia*,⁴⁴⁸ the plaintiff, executor of the estate of the film's music conductor, Leopold Stokowski, asserted that Stokowski was a joint author of the film.⁴⁴⁹ There was evidence that Stokowski "actively collaborated with Disney in selecting the musical works to be performed in the movie, and in visualizing the animation to accompany the music."⁴⁵⁰ The court rejected the joint authorship argument, however, primarily because it

445. See KARLIN & WRIGHT, *supra* note 443, at 32. Songs are sometimes written at an earlier stage, and for some scenes it may be necessary to write and record music in order to shoot for playback—that is, film a sequence to the music track. See *id.* at 31. Still, the screenplay, and to some extent the film, preexists the music.

446. In the case of animated films, soundtrack is typically recorded before the creation of the animation, that is, the visual images are created to synchronize with the soundtrack. Unless the characters are portrayed as singing a song, however, it would not be necessary to pre-record the songs. In any event, a screenplay and probably some rough visual elements, would very likely predate the music, so it is unlikely that the film as a whole would be a derivative work of the music. But see *Woods v. Bourne Co.*, 60 F.3d 978 (2d Cir. 1995) (finding that for purposes of the derivative works exception to termination of transfers, an audiovisual work is a derivative work of musical compositions included in its soundtrack).

447. See Brylawski, *supra* note 439 (discussing some of those issues). E.F. Brylawski did not consider the additional *Childress* requirements for a joint work even though his article was published after the *Childress* decision. See *id.*

448. *FANTASIA* (Walt Disney Productions 1941).

449. See *Muller v. Walt Disney Prods.*, 871 F. Supp. 678 (S.D.N.Y. 1994).

450. *Id.* at 684.

was persuaded that Stokowski created his contributions as a work made for hire. It also noted that Stokowski had never asserted any ownership rights or claimed to be a coauthor of the film in the thirty-seven years between release of the film and his death, and that copyright had been registered and renewed in Disney's name.⁴⁵¹

Thus, it remains unclear whether an author of film music could successfully claim to be a joint author of film. As argued above, crediting a contributor for his contribution should be adequate evidence of intent to share authorship, and therefore, the film music author should be considered a coauthor of the film. But because film music authors will rarely, if ever have control over the creation of the motion picture, they will not qualify as coauthors under *Aalmuhammed*.

8. Directors

Most laypeople today would indicate that the director is the author of a film. It is often said that films are a "director's medium," but this has not always been the case.⁴⁵² In the earliest history of the medium, films were created by one person, a filmmaker, who handled all stages in the creation and distribution of a film, including writing, directing, editing, producing, and distributing.⁴⁵³ As the process of filmmaking was industrialized, division of labor arose. For a short time, the cameraman occupied a central role. But soon it became desirable for a single person to control the work of all the participants in filmmaking: "In order for the cinematographic work to attain an artistically coherent form, it was necessary that the whole work process was under the control of one person. This was the task of the director."⁴⁵⁴ After a few years, however, "the producer took over the complete control of the film making process,"⁴⁵⁵ at least in the United

451. See *id.* at 685. In a related case, a court rejected a claim by the Philadelphia Orchestra Association that it was a joint author of the film, though the orchestra received equal billing with Disney, because the orchestra's performance was a work made for hire. See *Phil. Orchestra Ass'n v. Walt Disney Co.*, 821 F. Supp. 341, 347 (E.D. Pa. 1993).

452. The relative power of producers, directors, and writers is very different in television, in which the writers and producers have typically much more power vis-à-vis the director than they do in motion picture production. Thus, television is often described as a "writer's medium." Josef Adalina, *Leveling the Field—In Writers' Medium Directors Seek Parity*, VARIETY, June 14, 2001, at A4.

453. See SALOKANNEL, *supra* note 226, at 12.

454. *Id.*; see also BROWNLOW, *supra* note 227, at 67–68 (discussing the importance of the director in the silent film era, prior to 1925, when Irving Thalberg reinstituted the supervisor system, putting production executives back in a primary position).

455. SALOKANNEL, *supra* note 226, at 13. "Greater executive control over production came mainly at the expense of directors who were relegated basically to staging the action." Balio, *supra* note 435, at 107.

States.⁴⁵⁶ Although a few directors from that period might be recognized as film authors, the concept of the director as the *auteur* of his film is often attributed to young film critics who wrote for the French publication, *Cahiers du Cinema*, during the 1950s.⁴⁵⁷ Film critic Andrew Sarris popularized the *auteur* theory in the United States.⁴⁵⁸ Auteurism as an approach to film criticism may have been superseded by other critical approaches,⁴⁵⁹ but today studio production executives focus more on business matters and the director's importance has correspondingly increased.⁴⁶⁰ A director's creative control over his films may vary, depending on the power and creative involvement of the producer and other participants on a particular film, but the director of the film is certainly potentially one of its most important authors.⁴⁶¹

In addition to collaboration and control over the various elements that comprise film authorship, the director can be the person with a vision of the entire work, who effectively selects, coordinates, and arranges all of the elements into a coherent whole:⁴⁶² "The parts, however entertaining individually, must cohere meaningfully. This meaningful coherence is more likely when the director dominates the proceedings with skill and purpose . . . The

456. "How often has this directorial domination been permitted in Hollywood? By the most exalted European standards, not nearly enough. Studio domination in the thirties and forties was the rule rather than the exception, and few directors had the right of final cut." ANDREW SARRIS, *THE AMERICAN CINEMA: DIRECTORS AND DIRECTIONS, 1929-1968*, at 30 (1968).

457. See François Truffaut, *Une Certaine Tendance du Cinema Français*, *CAHIERS DU CINEMA*, Jan. 1954, at 9.

458. See CAUGHIE, *supra* note 232, at 9-15 (discussing auteurism and its place in the history of film criticism).

459. See *id.*; see also Marvin D'Lugo, *Authorship and the Concept of National Cinema in Spain*, 10 *CARDOZO ARTS & ENT. L.J.* 591, 591-97 (1992) (discussing auteurism, other critical theories, and the politics of Spanish cinematic authorship).

460. See Karen L. Gulick, *Creative Control, Attribution, and the Need for Disclosure: A Study of Incentives in the Motion Picture Industry*, 27 *CONN. L. REV.* 53, 68-69 (1994).

461. The concept of the director as the sole author of a film has been criticized. For example, Jack Stillinger discusses the example of *Citizen Kane*, directed by Orson Welles, which has been a "central focus of the auteur movement." JACK STILLINGER, *MULTIPLE AUTHORSHIP AND THE MYTH OF SOLITARY GENIUS* 179 (1991); see also *CITIZEN KANE* (RKO Radio Pictures 1941). Stillinger refers to a carefully researched study proving that *Citizen Kane* was not solely the work of Welles, but "owes its eminence, and perhaps even its existence, to the combined efforts of several extraordinarily talented individuals," including screenwriter Herman J. Mankiewicz and other uncredited writers, the art director, the cinematographer, the actors, and "the professionals responsible for various postproduction operations," including the sound and music editing, the composition and orchestration of the music, and the film editing. STILLINGER, *supra*, at 179-80. He concludes that film production is "too complicated, require[s] too many separate specialized abilities, and [is] hedged on every side with competing interests and influences" to be considered the work of any single author. *Id.* at 181.

462. See *Apple Barrel Prods. v. Beard*, 730 F.2d 384, 387-88 (5th Cir. 1984) (holding that a country music show comprised of uncopyrightable elements may still be copyrightable as a compilation).

strong director imposes his own personality on a film; the weak director allows the personalities of others to run rampant.”⁴⁶³ Of course, a producer can also play that role with respect to a film, either by himself or in collaboration with the director. To the extent that the director (or producer) selects, coordinates, or arranges elements in an original, minimally creative way, he is the author of the resulting compilation.

A person is not an author under U.S. law simply because he is called the director or is credited as the director on screen. The fundamental question under U.S. law is: Who originated a particular expression? Merely having the right to accept or reject another author’s original expression does not constitute authorship, nor does mere time and effort, or “sweat of the brow.”⁴⁶⁴ Although the collective bargaining agreements suggest distinct roles for the director and for the other authors, the actual working relationships vary, and may be collaborative. Still, in the case of most commercial motion pictures, it is likely that the director’s contributions will be some of the most important copy-rightable elements of the film.⁴⁶⁵

9. Film Authorship Under International and Comparative Law⁴⁶⁶

The director is viewed as an important author of films under international law and under the laws of other countries. Countries have approached the question of film authorship and ownership in several ways. Common law countries such as the United Kingdom (prior to the implementation of the

463. SARRIS, *supra* note 456, at 30–31.

464. *L.A. News Serv. v. Tullo*, 973 F.2d 791, 794 (9th Cir. 1992) (holding that a news videotape was original work of authorship as a result of creative decisions as to how to “tell the story,” selections of camera lenses, angles, and exposures, choices of heights and directions from which to film, and portions and durations of events to film, not because of “mere time and effort”).

465. Directors and their representatives sometimes claim that the director should be vested with control over alterations to a film. See, e.g., *TECHNOLOGICAL ALTERATIONS*, *supra* note 70, at 30. Such claims suggest that the director is ultimately the most important author of a film, its *auteur*. That suggestion seems ironic because if the director (who is not also the cinematographer, editor, designer, and performer) can claim authorship primarily through his control over the authorial expression of those other authors, that is, through his supervisory role, then similar claims to authorship by control can also be made by some producers. But often, directors object to the film producer’s control over changes to a film. On what basis do some directors claim primacy over other film authors? Perhaps it is on the basis that other creators “place their trust in the director” or because other creators (excluding the screenwriter) “do not compose the yarn.” *Id.* (quoting George Lucas and Steven Spielberg, respectively). Although there is anecdotal support for some producers’ sacrifice of art to commerce, it is not clear that other authors do not place their trust in the producer, and it would seem that the screenwriter is primarily responsible for composing the yarn.

466. An exhaustive comparative analysis is beyond the scope of this Article, but an overview and a few examples will suffice.

European Community directive discussed below)⁴⁶⁷ have a film copyright system, under which all exploitation rights in the film typically are owned by one person, the producer, subject to his contractual rights with authors of preexisting works used in the film.⁴⁶⁸ This approach simplifies the exploitation of rights, but is viewed by author's rights advocates as prejudicial to the interests of other creators.⁴⁶⁹

On the other end of the spectrum are *droit d'auteur* systems, typical of civil law regimes, under which various contributors of intellectual creativity to the film are viewed as coauthors, from whom the producer must obtain grants of rights in order to exploit the film. This approach can be potentially more protective of the interests of individual creators, but can complicate the assimilation of rights necessary to exploit the film and to protect the interests of financiers.⁴⁷⁰

Some countries, such as Italy, designate specific persons who are coauthors of a film. Others, such as France, have statutes specifying a list of presumptive coauthors.⁴⁷¹ In countries such as Germany, there is no specific list, and any contributor of personal, original intellectual material is potentially a coauthor.⁴⁷² Where there is a list of presumptive coauthors, the director is included. Recognizing the potential difficulties in obtaining grants from numerous coauthors, some *droit d'auteur* countries, such as Italy, provide for an automatic "legal assignment" of exploitation rights by the coauthors to the producer,⁴⁷³ and other countries, such as

467. See Lionel Bently & William R. Cornish, *United Kingdom*, in *INTERNATIONAL COPYRIGHT LAW AND PRACTICE* §§ 1[3][b], 2[2][b], 4[1][a][ii] (Paul Edward Geller & Melville B. Nimmer eds., 1999).

468. See SAM RICKETSON, *THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886-1986*, at 573 (1987); *TECHNOLOGICAL ALTERATIONS*, *supra* note 70, at 27.

469. See Kernochan, *supra* note 70, at 363.

470. See Gerald Dworkin, *Authorship of Films and the European Commission Proposals for Harmonising the Term of Copyright*, 5 *EUR. INTELL. PROP. REV.* 151, 153 (1993).

471. See André Lucas & Robert Plaisant, *France*, in *INTERNATIONAL COPYRIGHT LAW AND PRACTICE*, *supra* note 467, § 4[1][a][ii]; *TECHNOLOGICAL ALTERATIONS*, *supra* note 70, at 28.

472. See Adolph Dietz, *Germany*, in *INTERNATIONAL COPYRIGHT LAW AND PRACTICE*, *supra* note 467, § 4[1][a]; *TECHNOLOGICAL ALTERATIONS*, *supra* note 70, at 29; Kernochan, *supra* note 70, at 361. Actually, under German law, only contributors of material that is not exploitable separate from the film as a whole are considered coauthors. Contributors of material that is separable, such as the screenwriter and score composer, are not considered coauthors. See Dietz, *supra*. However, the term of copyright is measured from the death of the last surviving of a list of designated authors, including the principal director, the screenwriter, the dialogue writer, and the composer of the soundtrack music. See *id.*

473. Mario Fabiani, *Italy*, in *INTERNATIONAL COPYRIGHT LAW AND PRACTICE*, *supra* note 467, § 4[1][a][2]. Under Italian law, a film is considered a joint work whose coauthors are the director, the author of the subject, the screenwriter and the soundtrack composer. The rights of

France⁴⁷⁴ and Germany,⁴⁷⁵ provide for a presumption of such assignment subject to contrary arrangements.⁴⁷⁶

These variations in treatment of films led to difficulty in exploitation, and studies were conducted to amend the Berne Convention to address and harmonize the issue of film ownership. The amendment was passed as part of the 1967 Stockholm Revision of the Convention, adding a new Article 14 *bis*, which attempted to deal with those difficulties. That article states that ownership of copyright in films is to be determined under the law of the country where protection is sought.⁴⁷⁷ It further provides that in countries that recognize authors of contributions as owners of copyright in a film, there is a presumption in the absence of an agreement to the contrary that authors who have undertaken to contribute to a film may not object to reproduction, distribution, public performance, or to certain other exploitation rights in the film.⁴⁷⁸ That presumption is known as the "presumption of legitimation."⁴⁷⁹ Either the country in which the filmmaker is headquartered or the country in which protection is sought can require that, in order for the presumption to take effect, there must be a written agreement between the filmmaker and the creative contributor.⁴⁸⁰ In addition, unless a country's legislation provides to the contrary, the presumption does not apply to authors of scenarios, dialogue, or musical works created for the film, or to the principal director.⁴⁸¹ Hence, unless otherwise legislatively provided, it does not apply to many of the main authors contributing to a film. As a result of these various limitations and exceptions, the objective of simplifying international exploitation of films was not achieved and these provisions

economic utilization for purposes of cinematographic exploitation are automatically deemed vested in the producer who undertakes and organizes production. See *id.*

474. See Lucas & Plaisant, *supra* note 471, at § 4[3][c][iii][A]. Apparently, some cases have held that there must be a written contract in order for the presumption to apply. See *id.* Also, there is no such presumption regarding the musical composer. See *id.*

475. See Dietz, *supra* note 472, at § 4[3][b]. This presumption applies not only to those deemed coauthors, but also to authors of separable contributions. See *id.* Note that there is no such presumption as to exploitation rights in media not known at the time the author agreed to contribute to the film. See *id.* The presumptively granted rights are apparently somewhat more narrow as to preexisting works. See *id.* There is also a similar presumption as to certain performers' rights, once they agree to participate in the production of a film. See *id.* § 9[1][a]. The producer who undertakes and organizes the filming herself has certain "neighboring" or "related" rights with respect to the film. *Id.* § 9[1][c].

476. See RICKETSON, *supra* note 468, at 573; TECHNOLOGICAL ALTERATIONS, *supra* note 70, at 27.

477. See Berne Convention, *supra* note 317, art. 14 *bis* (2)(a).

478. See Berne Convention, *supra* note 317, art. 14 *bis* (2)(b).

479. RICKETSON, *supra* note 468, at 580.

480. See Berne Convention, *supra* note 317, art. 14 *bis* (2)(c); see also RICKETSON, *supra* note 468, at 584–85.

481. See Berne Convention, *supra* note 317, art. 14 *bis* (3).

have been described as "the most obscure and least useful in the whole Convention."⁴⁸²

In 1993, the Council of Ministers of the European Community (E.C.) adopted a directive dealing with harmonization of the term of protection for copyrights and some related rights.⁴⁸³ That directive stipulates that the principal director of a cinematographic work is to be regarded as its author, or as one of its authors, although member states are permitted to designate other coauthors.⁴⁸⁴ As a result of that directive, all E.C. Member States' were required to recognize the principal director as an author of a film as of July 1, 1995, subject to some transitional provisions.⁴⁸⁵ The U.K., for example, has modified its copyright law to implement the directive, so that as to films made on or after July 1, 1994, the director is a coauthor with the producer.⁴⁸⁶

Australia is a "film copyright" country where the owner of a film is the "maker," that is, the producer who arranges the production of the first negative or tape.⁴⁸⁷ Neither the director nor the other participants in the creation of a film are considered authors of the film, and they have no interest in the film copyright unless they are also the "maker."⁴⁸⁸ The government, however, is currently conducting a study as to a proposal for a "director's copyright" in films.⁴⁸⁹

482. RICKETSON, *supra* note 468, at 582.

483. Council Directive 93/98/EEC, O.J. No. L290, Oct. 29, 1993. See generally Pascal Kamina, *Authorship of Films and Implementation of the Term Directive: The Dramatic Tale of Two Copyrights*, [1994], 16 EUR. INTELL. PROP. REV. 319 (1994). Because the term of protection for works under many countries' laws is measured from the death of the author, the fact that there are a variety of sets of authors of films under various regimes led to complexity and uncertainty over the basic question of when does the copyright in a film expire. Hence, the need for a harmonization directive.

484. Council Directive, *supra* note 483, art. 2(1). The term of protection is required to extend until seventy years after the death of the last survivor of the following list, regardless of whether they are designated coauthors under a particular member country's law: the principal director, the author of the screenplay, the author of the dialogue, and the composer of music specifically created for use in the film. See *id.* art. 2(2). This is the aspect of the directive that harmonizes the term for a film's copyright.

485. Term Directive, art. 13(1). See generally Herman Cohen Jehoram & Ben Smulders, *The Law of the European Community and Copyright*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 467, at § 4[2][e].

486. See Bently & Cornish, *supra* note 467, at §§ 1[3][b], 2[2][b].

487. Brad Sherman & James Lahore, *Australia*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE, *supra* note 467, at § 4[1][B][2][b].

488. *Id.*

489. *Director's Copyright*, 104 COPYRIGHT WORLD 4 (2000); see also *Proposal for a Directors' Copyright in Films: Non-Exclusive Checklist of Possible Issues*, at <http://www.dcita.gov.au/cgi-bin/graphics.pl?path=5282> (last visited Sept. 28, 2001).

III. MOTION PICTURE OWNERSHIP: WORK MADE FOR HIRE AND CONSEQUENCES OF FAILURE TO QUALIFY AS A WORK MADE FOR HIRE

A. General Practice: Motion Pictures as Works Made for Hire

In the United States, most film authorship contributions will be made by employees within the scope of their employment, or pursuant to work-for-hire agreements. In the latter case, the parties may comply with the statutory requirements for a commissioned work made for hire, primarily a signed writing confirming the parties' intent that the proceeds of the services will be considered work made for hire. Production company attorneys are generally vigilant to ensure such agreements are signed, but occasionally mistakes are made or contributors may be unanticipated or overlooked.

Many of the creative contributors to a film discussed above would satisfy the requirements under CCNV to qualify as employees of the production company. Hence, works created within the scope of their employment would be considered works made for hire, even in the absence of a written agreement.

There may be issues as to the scope of employment when someone contributes material that is used in the film, but that contribution is outside the scope of the person's usual duties.⁴⁹⁰ For example, if an actor changes his lines of dialogue or a best boy grip, whose job entails handling camera equipment, suggests a scene for a film, should that be considered outside the scope of their employment? In determining whether work is within the scope of employment, courts consider whether it is (1) the kind of work the creator was employed to do; (2) rendered during work hours, at the workplace; and (3) intended to serve the employer.⁴⁹¹ The actor, in changing his dialogue, would satisfy all requirements, as performing dialogue is the kind of work actors are hired to do, and it is often accepted practice for actors to modify dialogue. On the other hand, the best boy's suggestion would seem to satisfy (2) and (3), but not necessarily (1). The best boy grip is not employed to create scenes in a film. What if the best boy's employment agreement states that any contributions he makes, including those outside of his usual duties, are works made for hire? Parties cannot simply agree that works not within the scope of employment are works made for hire with the employer deemed the

490. See BROUWER & WRIGHT, *supra* note 241, at 19 (quoting Kathleen Kennedy's statement regarding a best boy, whose job would ordinarily involve nonauthorial activity such as caring for equipment, ordering supplies, and hiring additional staff, making a creative suggestion that becomes an extraordinary shot).

491. See 1 NIMMER & NIMMER, *supra* note 17, § 5.03[B][1][b][i], at 5-33.

author.⁴⁹² Thus, if the producer is to own such contributions, the agreement with those contributors must also contain an assignment or license of rights.

Parties can agree that a commissioned work that otherwise satisfies the statutory requirements is a work made for hire. Would an agreement that the creative contributions of the best boy constitute works made for hire qualify the contributions as commissioned works made for hire? The suggestion would be for use as part of a motion picture, and, because most crew sign at least a short deal memorandum before working, the requirement of a writing signed by both parties would be satisfied. But in order to qualify, the creative contributions would have to be "specially ordered or commissioned," that is, rendered at the employer's "instance and expense."⁴⁹³ It seems unlikely that gratuitous creative suggestions would satisfy that requirement. The agreement might be found to imply a transfer of rights, but clearly the safest practice for the production company would be a clear, express, written assignment of rights. Because best boys do not customarily provide such creative contributions, it is possible their employment agreement would not include such a provision, although many motion picture work-for-hire agreements contain "alternative assignment" language, under which rights in any material not deemed work for hire are assigned to the producer.

Similar problems will arise when a person is asked to be a consultant of some kind and proper work-for-hire documentation is not obtained.⁴⁹⁴ A consultant may not qualify as an employee under the CCNV requirements. Because contributions by a consultant would likely constitute specially ordered or commissioned material intended for use as part of a motion picture, they could qualify as a commissioned work made for hire, if there is a signed agreement so stating. If there is no signed, written agreement indicating that the parties intended the results and proceeds of the consulting services to be a work made for hire, then questions may arise as to the ownership of rights in the contribution or as to the ownership of the film into which those contributions are incorporated. *Aalmuhammad* was just such a case.

B. The Nature of a Film Work when Not a Work for Hire

Putting aside the usual work-for-hire system, what type of multiple-creator work is a motion picture? It would seem to be a perfect candidate to be characterized as a joint work, at least as to those authors who create their contributions intending their exclusive or primary use in the film. There are

492. See *id.* at 5-34.

493. *Playboy Enters., Inc. v. Dumas*, 960 F. Supp. 710, 710 (S.D.N.Y. 1997).

494. See, e.g., *Aalmuhammad*, 202 F.3d 1227 (regarding consultant on film with no written contract); *supra* Part II.C.

multiple authors, who intend to merge their contributions into inseparable⁴⁹⁵ or interdependent⁴⁹⁶ parts of a unitary whole, as required under the express language of the 1976 Copyright Act.⁴⁹⁷ The legislative history⁴⁹⁸ and some major copyright commentators⁴⁹⁹ have assumed that a motion picture is a joint work. One purpose of joint work rules is “to provide a starting point for the allocation of rights and liabilities between co-authors of collaborative works.”⁵⁰⁰ Such presumptive rules can be valuable because collaborators often fail to work out express arrangements among themselves.⁵⁰¹

In elaborating additional rules for finding a work to be joint, courts have focused on preventing unreasonable claims of coauthorship by relatively minor contributors. It is true that, given current assumptions about the consequences of a joint work determination, deciding that a work is jointly authored with a minor contributor or a contributor of mere ideas could defy the reasonable expectations of a dominant author in some cases. But by creating the additional intent rules and the requirement that a joint author have control over creation of the work, courts effectively eliminate the possibility of a set of default liability rules for highly collaborative works for which such rules could be most useful. Courts should instead follow the statutory requirements for joint authorship, and restructure the rules as to the *consequences* of joint work status to reflect the reasonable expectations of the parties in highly collaborative works with numerous authors contributing extremely variable contributions (both quantitatively and qualitatively). Nothing in the Copyright Act requires a particular rule as to those consequences, and the case law has developed primarily in the context of industries very different from motion pictures. This is an avenue worth exploring by courts, since most motion pictures will not qualify as joint works under the rules currently applied by the courts, at least in the Second and Ninth Circuits.

Whether or not a motion picture is a joint work, it is also often a derivative work of preexisting literary material not written with the primary purpose of incorporation into a unitary film work, such as a novel or a magazine article. A film also includes compilation authorship. Some of that compilation authorship comprises contributions to the joint work. For example, film and

495. For example, the cinematography, editing, actor performances, and production design are virtually inseparable from the film as a whole.

496. The musical compositions and recordings, for example, are separable from the other contributions, but are interdependent.

497. 17 U.S.C. § 101 (1994 & Supp. V 1999) (defining joint works).

498. See H.R. REP. NO. 94-1476, at 120 (1976).

499. See 1 NIMMER & NIMMER, *supra* note 17, § 6.05, at 6-13 to -14 (2000); 1 GOLDSTEIN, *supra* note 54, § 4.2.1, at 4:8 to :9 n.18 (citing the House Report provision *supra* note 498).

500. 1 GOLDSTEIN, *supra* note 54, § 4.2, at 4:6.

501. See *id.*

sound effect editing contributions are themselves compilations (selection, coordination, and arrangement of materials) that are created with the intent to be merged into the unitary whole film. In addition, to the extent that the film incorporates selection, coordination, or arrangement of materials that were *not* prepared with the intent to merge into a unitary whole (preexisting art works or musical recordings, for example), the film is a collective work in relation to that material.⁵⁰² Thus, the nature of a film's copyright is potentially quite complex.

When a copyrightable contribution is not a work made for hire, the rights in the works may be fragmented—the contributor owns a copyright in material that is to be incorporated in a motion picture otherwise owned by the producer. By recognizing authorship of the contribution, society has decided that the creator—the author—should receive the entitlement. But the question remains: How should the law treat the respective rights and interests of the effected parties? Legal entitlement literature categorizes entitlements as either property rules or liability rules.

One possibility, and perhaps the one that seems the most obvious, would be that the contributor owns her material, and if the producer uses it, he is subject to a copyright infringement suit with the full panoply of copyright remedies, including, most importantly, injunctive relief—in other words a property rule.⁵⁰³ It is a basic premise of the economic analysis of copyright law that recognizing a property right in the author encourages production of works of authorship for the benefit of society by permitting the author to appropriate the value of her creations, which would otherwise have the character of public goods (an incentive function).⁵⁰⁴ Another basic premise is that copyright has the potential to maximize social welfare by permitting private transactions to determine the most valued uses for the work (an allocative efficiency function).⁵⁰⁵ It can be argued that both of those functions are achieved by

502. In addition to the liability rules discussed below, there may be an additional liability rule available to the film production company when dealing with a contribution to the film as a collective work. Under 17 U.S.C. § 201(c) (1994), when an express transfer is lacking, the collective work copyright owner is presumed to have certain rights vis-à-vis the owner of copyright in the contribution. Although this section was developed primarily for non-motion picture works such as newspapers and other periodicals and anthologies, it is not expressly limited to such works. The existence of this provision also illustrates Congress's concern for clarifying rights in complex multiauthor works, and its presumption in favor of a liability rule approach.

503. I call this a property rule because it gives the copyright owner an effective right to veto a transfer to a potential user, that is, to invoke the power of the state to prevent a use from occurring. A property rule "lets each of the parties say how much the entitlement is worth to him, and gives the seller a veto if the buyer does not offer enough." Calabresi & Melamed, *supra* note 16, at 1092.

504. See ROBERT COOTER & THOMAS ULEN, *LAW & ECONOMICS* 126 (3d ed. 2000).

505. See Neil Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 308–11 (1996) (discussing and distinguishing these two rationales for copyright, labeling the latter a "neoclassicist" approach).

according to the author a property right in her work, which permits her to exact a payment for the use of the work by granting her the right to prohibit use.⁵⁰⁶ Because she can exclude others from use, potential users will bargain with her and she can sell to the highest valued use, therefore receiving compensation for her efforts and achieving maximum allocative efficiency.⁵⁰⁷ A property rule permits the owner of the entitlement to decide the value of the entitlement through market interactions, with minimal involvement by the state.⁵⁰⁸ A fundamental requirement for this approach to work, however, is that there is a market, with multiple buyers and multiple sellers. In cases of bilateral monopoly, that is, one buyer and one seller, there can be bargaining problems that will preclude consensual exchanges.⁵⁰⁹

It has been argued that, under some types of circumstances, a liability rule would be preferable to a property rule. Under a liability rule, the rights holder does not have the right to veto—that is, enjoin—the use, but the user must “pay an objectively determined value for it.”⁵¹⁰ Guido Calabresi and A. Douglas Melamed argue that liability rules can be preferable to property rules on efficiency grounds (based on market failures arising from hold-outs and free-riders), or when market valuations are unavailable or more expensive than collective valuations.⁵¹¹ They also note that a liability rule can further distributional goals by reflecting collective rather than private evaluations.⁵¹² Moreover, Ian Ayres and Eric Talley have argued that, contrary to some accepted wisdom in law and economics, liability rules can encourage consensual transactions more than property rules, particularly in cases in which

506. See *id.* at 319–21 (noting that neoclassicists favor an absolute right to exclude, except in cases of “endemic and insuperable” market failure).

507. Professor Robert Merges has also argued that using property rules rather than liability rules encourages the development of private institutions that create privately negotiated arrangements approximating liability rules. See Robert P. Merges, *Contracting into Liability Rules: Intellectual Property Rights and Collective Rights Organizations*, 84 CAL. L. REV. 1293 (1996). Professor Neil Netanel criticizes this “new institutional economic theory” approach for valuing market efficiency over public policy. Netanel, *supra* note 505, at 312. In addition, Merges’s theory seems best suited to situations in which there are numerous rights holders and users engaging in numerous similar transactions, such as the licensing of public performance rights in musical compositions (one of the main examples of this dynamic discussed in his article), in which there are arguably strong incentives to collective activity and few reasons to refuse to issue licenses. Such a context is very different from the one we consider here, which is most likely to involve two parties in a unique transaction. See Merges, *supra*.

508. See Calabresi & Melamed, *supra* note 16, at 1092.

509. See JEFFREY L. HARRISON, *LAW AND ECONOMICS IN A NUTSHELL* 64–65 (1995); Richard Epstein, *A Clear View of the Cathedral: The Dominance of Property Rules*, 106 YALE L.J. 2091 (1997); see also Stewart E. Sterk, *Neighbors in American Land Law*, 87 COLUM. L. REV. 55, 69–74 (discussing problems in bilateral monopoly situations in real property disputes).

510. Calabresi & Melamed, *supra* note 16, at 1092.

511. See *id.* at 1106–10.

512. See *id.* at 1110.

the parties have private information that can be used for strategic behavior and, therefore, create potential market failure.⁵¹³ Liability rules are thought to be more efficient and fairer than property rules in cases of bilateral monopoly.

In general, copyright law reflects a strong property rule approach. Although there are various monetary remedies available to a successful copyright infringement plaintiff, injunctive relief is permitted by statute and routinely awarded by judges.⁵¹⁴

There are various kinds of liability rules available in U.S. copyright law under certain circumstances. Some copyright liability rules are legislative liability rules, often called compulsory licenses. There are several types of uses of copyrights that are subject to compulsory licenses.⁵¹⁵ In some cases, courts apply a judicial liability rule. When a court grants damages in lieu of injunctive relief, it is implementing a judicially structured liability rule.⁵¹⁶ Characterizing a work as a "joint work" can result in a mixed legislative/judicial liability rule. As between the coauthors, characterizing a work as joint creates a liability rule—neither coauthor can stop the other from using or licensing the work, but each coauthor is entitled to a share of the proceeds. I call that a mixed legislative/judicial liability rule because it is the result of judicial interpretation and enhancement of a legislative definition of joint authorship. In appropriate cases, a court might also find an implied license—yet another type of liability rule.

As between a property rule and a liability rule, which makes the most sense in the context of a single contribution to a motion picture? A liability rule seems to be the best approach based on the economic considerations raised above. Let's assume that the production company owns all the contributions to a film except for one work, say the design of an important set that was created by an independent contractor and filmed without the company first having obtained the necessary signed commissioned-work-for-hire agreement. This is clearly a situation of bilateral monopoly. There is one seller, the creator of the set, and one buyer, the producer of the film for which the set

513. See Ian Ayres & Eric Talley, *Solomonic Bargaining: Dividing a Legal Entitlement to Facilitate Coasean Trade*, 104 YALE L.J. 1027, 1035 (1995).

514. See 17 U.S.C. §§ 502, 504.

515. See *id.* § 111(d) (1994) (providing compulsory licenses for cable retransmission of programming); *id.* § 114(d) (providing compulsory licenses for certain digital transmissions of sound recordings); *id.* § 115 (compulsory license for the manufacture and distribution of phonorecords of musical compositions); *id.* § 118 (providing compulsory licenses for the display or performance of certain types of works by noncommercial public broadcasting entities); *id.* § 119 (providing compulsory licenses for certain satellite retransmissions).

516. See Merges, *supra* note 507, at 1315–17 (discussing transaction costs of judicially administered liability rules).

was built and filmed. In that situation, a liability rule may more appropriately balance the interests of the parties and the public.⁵¹⁷

Moreover, it is difficult for the parties to accurately assess the respective value of the set and the film.⁵¹⁸ First, each film is a new product, and it is extremely difficult to predict the commercial success of the film with any certainty. Second, it is impossible to determine what importance that particular set would have in achieving that success. On the one hand, it may be an important aspect of a central scene in the film. On the other hand, it is unlikely that a significant number of people would pay to see the film in order to see that one set, and numerous other factors, including the stars, the screenplay, the music, and the marketing and distribution clout of the producer/distributor will probably be more important in the ultimate success of the film. Furthermore, it may be difficult to assess the value of the set to the designer, and there is some basis to believe that, if the designer identifies the set as property belonging to the designer, she will tend to give it a much higher evaluation.⁵¹⁹ Irrationality factors such as pride or anger may also arise, perhaps exacerbated by the potential disagreement over valuation.

The bilateral quality of the situation, coupled with valuation uncertainty and the possibility of irrational behavior, is likely to lead to bargaining breakdown. If injunctive relief is available to the set designer, and the set is integral to the film, bargaining breakdown could lead to failure to release the film, which could lead to a substantial loss to society. If the creator of a contribution is entitled to enjoin the distribution of a motion picture, then not only does the infringer lose (which may be normatively appropriate), but the public also loses access to the work, including to those elements of the

517. It has been observed that most legal systems:

[A]ssume[] the dominance of property rules over liability rules, except under those circumstances where some serious holdout problem is created because circumstances limit each side to a single trading partner. In these cases of necessity, the holdout problem could prove enormous, so that the strong protection of a property rule is relaxed. One person may be allowed to take the property of another upon payment of compensation, but only in a constrained institutional setting that limits the cases in which that right can be exercised and supervises the payment of compensation for it . . . [L]iability rules are limited to those circumstances in which property rules work badly, namely, cases where the holdout power implicit in a property rule becomes so large that useful transactions may be blocked by a wide range of strategic behaviors. These holdout situations arise when the resource currently commanded by A is needed by B, such that each can deal only with the other for the useful exchange to take place.

Epstein, *supra* note 509, at 2092–94.

518. See Lemley, *supra* note 143, at 1053, 1055–56.

519. This phenomenon is known as the “endowment effect.” See Ayres & Talley, *supra* note 513, at 1101 (citing research confirming the endowment effect).

motion picture that are not infringing.⁵²⁰ Not only is that potentially harmful to the public, it may be unfair to all the other authors of the film who did not infringe in creating their contributions. Thus, in this sort of situation, a liability rule better achieves copyright's purposes of increasing public access to works and creating incentives to create (at least as to the other creators).

From an economic efficiency point of view, these additional costs of an injunction—the loss of public access and the disincentive to other creators—may be considered externalities because they are not borne by the immediate parties. Because these costs potentially affect a large number of people, they are public externalities.⁵²¹ Such externalities further evidence potential market failure in this context. A liability rule would eliminate these costs.

One might object to a liability rule because at first glance this is a somewhat different context from those in which scholars usually identify an advantage for liability rules. Normally, the existence of two parties, difficulty in evaluation, and low transaction costs would favor a property rule, while numerous parties, strategic bargaining, and high transaction costs favor a liability rule.⁵²² It is true that there would only be two parties negotiating in our hypothetical, but when there is only one potential seller and only one buyer, there is a bilateral monopoly—which favors a liability rule. While some transaction costs, such as the cost of identifying the parties, might be low in this bilateral situation, others, including the likelihood of strategic bargaining, would be high.

520. See *Abend v. MCA, Inc.*, 863 F.2d 1465, 1478–79 (9th Cir. 1988), *aff'd sub nom. Stewart v. Abend*, 495 U.S. 207 (1990). In *Abend*, the Ninth Circuit found that the continuing exploitation of the film *Rear Window* after the lapse of rights to use the preexisting short story, was an infringement of copyright. But the court suggested that an injunction would be an inappropriate remedy, because the success of the film was the result of “collaborative efforts of many . . . individuals” other than the short story author, and it would be a “great injustice for the owners of the film” to enjoin further exploitation, which would also “cause public injury by denying the public the opportunity to view a classic film for many years to come.” *Id.* at 1479; see also *REAR WINDOW* (Paramount Studios 1954). The Supreme Court expressly did not decide the propriety of the potential remedies. See Roberta Rosenthal Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 65 n.75 (1994) (discussing *Abend* and citing other copyright cases in which courts consider the public interest in determining appropriate remedies). But see *Woods v. Universal City Studios, Inc.*, 920 F. Supp. 62 (S.D.N.Y. 1996) (enjoining a film of which a small portion incorporated material infringing plaintiff's artwork and rejecting public interest arguments).

521. See COOTER & ULEN, *supra* note 504, at 151.

522. See Merges, *supra* note 16, at 2664. In another article, Professor Merges argues that a property rule, injunctive relief in this case, would lead to the development of consensual collective rights administration institutions. See Merges, *supra* note 507. That seems inapplicable here, because this type of transaction is not the high volume, repetitive transaction that normally would encourage growth of such institutions.

Perhaps the main argument against a liability rule in this circumstance is the risk of undercompensating the creator.⁵²³ Indeed, that is a risk and it has both efficiency implications and fairness implications. Large motion picture companies are not noted for their generosity to relatively minor participants in the filmmaking process. (For that matter, neither are small, impecunious producers.) A court, in fashioning an appropriate liability rule, should endeavor to adequately compensate the author.⁵²⁴ By permitting testimony and other evidence proffered by the parties, including expert testimony as to the value of the contribution, a judicial process might be more likely to determine a fair price than the parties would have been able to do in this context. Moreover, by refusing to enjoin the larger work, the interests of all the parties and the public are most likely to be properly balanced.

What are the implications of copyright policy on this discussion? That may depend on which aspect of copyright policy one emphasizes. The fundamental policy of copyright law in the United States is to benefit society by giving private incentives to encourage the production of creative works. The two component parts of that policy statement—public benefit and private incentives—are sometimes in conflict. Generally, a property rule maximizes the incentives to the author to produce, thus encouraging production of such works, benefiting society.

Limiting authors to liability rules might impair that incentive, by either undercompensating the author or by eliminating the author's ability to control the work. Ordinarily, that reduction in authorial incentive might be viewed as preventing the creation of works, and, therefore, harming society. However, in the specific fact pattern contemplated here, applying a property rule may prevent the dissemination of the work and harm society, thus disserving the ultimate purpose of copyright. Moreover, particularly if an author's work is entwined with other works, one hold-out author might be able to prevent dissemination of others' works, further harming both society and the other authors.

Finally, the impairment to the authors' incentives seem relatively minor, so long as authors receive appropriate compensation as contemplated by an effective liability rule. Essentially, the analysis may break down into a determination of whether the benefit to society outweighs the author's loss of control (the ability to enjoin one particular use). Reasonable minds could differ as to the appropriate balance.

523. See Merges, *supra* note 507, at 2666 (noting this risk, particularly when it is difficult for courts to evaluate the damages).

524. See Roger Blair & Thomas Cotter, *An Economic Analysis of Damages Rules in Intellectual Property Law*, 39 WM. & MARY L. REV. 1585 (1998) (suggesting optimal damages rules, at least in theory, for copyright infringement cases).

C. Which Liability Rule?

What kind of liability rule makes the most sense? There would be four possibilities: a compulsory license, a joint work determination, a damages determination in lieu of injunctive relief, or an implied license. Under current jurisprudence, an implied license is the most likely liability rule to be applied in the context of a dispute about a contribution to a motion picture.

There is currently no compulsory license for use of materials in a motion picture,⁵²⁵ and courts are generally willing to grant injunctive relief in cases of copyright infringement, rather than limiting the plaintiff to a damages award. As was discussed above, current judicially enhanced joint work requirements will prevent most contributors to a motion picture from being considered coauthors of a joint work.

One possible solution to some of the problems with characterizing a film as a joint work might be for courts to reconsider the consequences of such a characterization in the context of a work created by numerous authors whose contributions may not be of equal importance to the work, such as a motion picture.⁵²⁶ In that case, perhaps a court should find that each contributor is not entitled to a pro rata share based on the number of contributors, but should qualitatively evaluate the proportionate value of the relevant contribution.⁵²⁷ In addition, when there are numerous contributors to a work, perhaps the rule that each contributor has the nonexclusive right to separately exploit or license the whole should be modified.⁵²⁸ But unless and until courts revise the joint work rules to better fit this type of work, an implied license is the most likely form of liability rule to be implemented by a court in this context.

525. But see 17 U.S.C. § 118 (1994) (providing for compulsory license for certain uses of certain works by public broadcasting entities).

526. See *supra* Part III.B.

527. See Note, *Fixing Fixation: A Copyright with Teeth for Improvisational Performers*, 97 COLUM. L. REV. 1363, 1403–04 (1997) (making a similar suggestion as to multiperformer improvisations).

528. Many European jurisdictions require the consent of all joint authors in order to license or exploit joint works. Following that rule as to films would again create a property-like rule that could encourage holdout problems and preclude exhibition of the film. Perhaps recognizing that possibility, some jurisdictions have presumptions of transfer of economic rights by film authors to the producer, thus creating a liability rule. Under U.S. jurisprudence, co-owners would not be able to exploit the work in a way that would destroy its value. Arguably, permitting the designer to license the entire film could destroy the value of the film, because most licensees will require exclusive rights of some kind. Hence, it might be argued that, even under existing joint work rules, a contributor of a minor part of the whole should not have the right to issue licenses in the whole work, effectively giving the producer exclusive rights in our hypothetical example.

D. Implied Licenses⁵²⁹

Transfers of copyright after January 1, 1978, other than those by operation of law, are required by the 1976 Act to be in writing, signed by the party transferring rights or by an authorized agent.⁵³⁰ The term "transfer" is defined in the 1976 Act to cover any "conveyance, alienation or hypothecation," excluding a nonexclusive license. Nonexclusive licenses of copyright can be oral or can be implied by conduct of the parties.⁵³¹

1. Availability of Implied Licenses

Courts will look at the totality of the parties' conduct to find an implied license.⁵³² Such a license has often been found when the parties initially intended a work-for-hire arrangement, but failed to comply with the required formalities.⁵³³ In the Ninth Circuit, *Effects Associates v. Cohen*⁵³⁴ is illustrative. In that case, Larry Cohen, a horror film producer, engaged Effects Associates to prepare some special effects shots for a film entitled *The Stuff*. The parties agreed to a deal orally, but never signed a formal agreement, and nothing was said about copyright ownership. When Cohen was unhappy with some of the effects, he failed to pay the full contract amount, but included the effects footage in his film anyway. Effects Associates sued for copyright infringement. Cohen argued that no signed agreement should be required,

529. The subject of implied licenses in copyright cases has recently been thoroughly explored in Scott Burnham, *The Interstices of Copyright Law and Contract Law: Finding the Terms of an Implied Nonexclusive License in a Failed Work for Hire Agreement*, 46 J. COPYRIGHT SOC'Y U.S.A. 333 (1999). Scott Burnham considers much of the case law and concludes that in cases of a failed attempt to transfer exclusive rights, defective work-for-hire arrangements, or mutual mistakes between parties as to their respective legal rights, "copyright ownership belongs to the hired party and the hiring party has an implied license to use the work." *Id.* at 367. In view of Burnham's thorough treatment of the general subject, this Article will only summarize some important aspects of the issue, and attention is directed to his article for more detailed discussion. See also Mark Janis, *A Tale of the Apocryphal Axe: Repair, Reconstruction, and the Implied License in Intellectual Property Law*, 58 MD. L. REV. 423 (1999) (arguing for the application of implied license analysis to certain patent disputes and surveying property and contract law analogues to the implied license).

530. See 17 U.S.C. § 204(a) (1994).

531. See 3 NIMMER & NIMMER, *supra* note 17, § 10.03[A][7], at 10-42.

532. See Janis, *supra* note 529, at 502 ("[T]here is ample support for the proposition that implied license scope in general is determined by considering the reasonable expectations of the parties in view of all the circumstances, including the parties' conduct.").

533. The Nimmer treatise appears to criticize such cases as raising "serious questions under contract law, as the enterprise would plainly contravene the mutual intent of the parties." 3 NIMMER & NIMMER, *supra* note 17, § 10.03[A][7], at 10-43. Still, cases in several circuits have permitted such an outcome, even where the likely intent of the parties was to grant exclusive, not nonexclusive, rights.

534. 908 F.2d 555 (9th Cir. 1990).

because the custom in the motion picture industry is not to require written agreements, but Judge Alex Kozinski declined the invitation to modify the express provisions of the Copyright Act to reflect that custom.

However, Judge Kozinski found that there was no copyright infringement because Effects Associates had granted Cohen an implied, nonexclusive license to include the footage in the film and had granted the distributor the right to distribute the film including the footage.⁵³⁵ The conduct that evidenced the implied license was that: (1) the footage was created at the producer's request, (2) Effects Associates delivered the footage to the producer, and (3) Effects Associates intended that the footage would be incorporated into the film, copied, and distributed.⁵³⁶ Correspondence from Effects Associates as to the deal, deposition testimony by the company president, and Effects Associates' copyright registration for the footage stating that it was to be used in the film indicated its intent.⁵³⁷ The fact that Cohen paid \$56,000 for the footage also evidenced the license, because, if a license had not been granted, the footage would be "of minimal value."⁵³⁸ Of course, such an implied license must be nonexclusive, because the Copyright Act requires that exclusive licenses be written. Courts in other circuits have also found implied nonexclusive licenses in copyright cases.⁵³⁹

The fact that the full contract amount had not been paid did not defeat the license. Judge Kozinski rejected the argument that payment was a condition precedent to the license, stating that "[c]onditions precedent are disfavored and will not be read into a contract unless required by plain, unambiguous language."⁵⁴⁰

When there is evidence that the creator's intent was not to allow a work delivered to another to be used by the recipient, some courts have found that there is no implied license. In *Johnson v. Jones*,⁵⁴¹ for example, Jones hired Johnson, an architect, to design her dream house. Johnson proffered two draft contracts to Jones that clearly indicated he was to retain ownership of

535. See *id.* at 559.

536. See *id.* at 558.

537. See *id.* at 558 n.6.

538. See *id.* at 559 (quoting *Oddo v. Ries*, 743 F.2d 630 (9th Cir. 1984)).

539. See, e.g., *Korman v. HBC Fla., Inc.*, 182 F.3d 1291 (11th Cir. 1999); *Lulirama Ltd., Inc. v. Axxess Broad. Servs., Inc.*, 128 F.3d 872 (5th Cir. 1997); *I.A.E. Inc. v. Shaver*, 74 F.3d 768 (7th Cir. 1996); *MacLean Assocs., Inc. v. Wm. M. Mercer-Meidinger-Hansen, Inc.*, 952 F.2d 769 (3d Cir. 1991); *Gracen v. Bradford Exch.*, 698 F.2d 300 (7th Cir. 1983).

540. *Cohen*, 908 F.2d at 559 n.7. In a later case involving a music synchronization license, the Ninth Circuit noted that when there is a right to rescind a license for material breach and that right is exercised, further exploitation would constitute infringement. See *Fosson v. Palace (Waterland), Ltd.*, 78 F.3d 1448, 1455 (9th Cir. 1996) (citing *Rano v. Sipa Press, Inc.*, 987 F.2d 580 (9th Cir. 1993)).

541. 149 F.3d 494 (6th Cir. 1998).

his drawings, and that they would not be used for completion of the project by another without a further agreement. Jones never signed those contracts, but encouraged Johnson to keep working on the plans. Later, Jones's attorney prepared another draft contract, which provided that Jones would have the right to utilize the plans for any purpose, but Johnson did not sign that contract. Eventually, Johnson was fired because the parties failed to agree on the terms, and Jones hired another architect to complete the project. When Johnson eventually visited the construction site and saw the plans, he sued for copyright infringement and other claims. Although recognizing that non-exclusive licenses may be implied from conduct, the court distinguished *Effects Associates* and other precedents cited by the defendants and found that there was no evidence Johnson intended for the plans to be used by Jones and another architect to complete the project. The earlier draft contracts submitted by Johnson in fact evidenced a contrary intent, and "[w]ithout intent, there can be no implied license."⁵⁴²

Thus, although nonexclusive licenses can be readily implied in appropriate circumstances, if, looking at all the circumstances, there is evidence it was not the creator's intent that a work delivered to a producer should be used by the producer, no implied license will be found. Courts consider objective indicia of intent, not the parties' alleged subjective state of mind.⁵⁴³ The difficult cases will be those in which there is no evidence of intent or the lack of intent, other than the facts that the work was prepared at the request of a party, delivered to that party, and that a payment was made. It would seem that under those circumstances, at least in the motion picture context, a license should be implied absent some objective evidence that an affirmative

542. *Id.* at 502. A Fourth Circuit case illustrates the same approach. See *Saxelbye Architects Inc. v. First Citizens Bank & Trust Co.*, 129 F.3d 117 (4th Cir. 1997) (unpublished opinion, text available at 1997 U.S. App. LEXIS 30320). There, an architectural company delivered plans for a building project to the defendant as part of a multiphase proposal under which plans would be submitted for approval and construction would then be supervised by Saxelbye. See *id.* at *2-*3. Shortly after delivery of the plans, the defendant terminated the arrangement and proceeded to complete the project with a different architectural company. Within a few days after the termination, Saxelbye wrote a letter indicating that it considered the plans its property and that no one else had permission to use them. Thereafter, Saxelbye sued for copyright infringement and for breach of contract. See *id.* at 4. The district court dismissed the copyright claim finding that there was an implied nonexclusive license to use them. The Fourth Circuit reversed, rejecting the implied license argument because Saxelbye had a contract contemplating its completion of the entire project and alleged that the drawings were submitted for approval and comments, not as an "end-product for use by" the defendant. See *id.* at 12. Stating that "[t]he implied license exception to the requirement of a writing is a limited one," the court cited the district court decision in *Johnson v. Jones* for the proposition that "all of the circumstances surrounding the negotiations made between the parties must be considered to determine if and to what extent an implied license was granted." *Id.* at *12-*13 (citing *Johnson v. Jones*, 885 F. Supp. 1008, 1014 (E.D. Mich. 1995)).

543. See *Shaver*, 74 F.3d at 776-77.

intent to the contrary has been communicated to the recipient prior to preparation of the work, delivery, and payment. First, those facts alone would seem to objectively evidence a license, absent contrary behavior. Second, to hold otherwise would seem unfair to the recipient, particularly if it has proceeded in reliance on a reasonable expectation that the work will be prepared and delivered for use in a film.⁵⁴⁴

Scott Burnham has criticized converting the three factual conditions that the *Effects Associates* court found evidenced an implied license into a three-pronged test for determining whether there is such a license in other cases.⁵⁴⁵ Those factual conditions were: (1) the hiring party requested creation of the work, (2) the hired party delivered it to the hiring party, (3) the hired party intended that the hiring party copy and distribute the work.⁵⁴⁶ The first factor is generally present in these cases.⁵⁴⁷ Delivery does not itself convey any rights, and failure to deliver might indicate a breach of contract as much as the lack of a license.⁵⁴⁸ As to the hired party's intent, if it is expressed, there is no need to discuss implied licenses.⁵⁴⁹ If it is not expressed, it should not be considered relevant.⁵⁵⁰ Objective facts and circumstances should be examined, rather than *ex post* statements of subjective intent.⁵⁵¹ Moreover, a license may not have involved the right to copy and distribute a work, but rather may have authorized the exercise of other rights under copyright.⁵⁵²

Having critiqued the mechanical application of the *Effects Associates* factors, Burnham suggests that the appropriate test is a "use" test: Do "the circumstances indicate that the hiring party intended to use the work?"⁵⁵³ He would find that test satisfied either when the hired party has expressly stated that he intends to use the work at the time of contracting, or when the work is commissioned for use and value is given.⁵⁵⁴ In either case, there would

544. In *Fosson*, the district court found that promissory estoppel served as a substitute for consideration when the plaintiff failed to object to the use of his song by the defendant pursuant to a draft synchronization license until after the song was used. On appeal, the court found it unnecessary to reach that issue, as it found that the express license was enforceable. See *Fosson*, 78 F.3d at 1452 n.4; see also Janis, *supra* note 529, at 503-04 (noting that, in the patent field, some courts apply an equitable estoppel approach and others a legal estoppel approach).

545. See Burnham, *supra* note 529, at 359-62.

546. See *Effects Assocs. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990).

547. See Burnham, *supra* note 529, at 360.

548. See *id.*

549. See *id.*

550. See *id.*

551. See *id.*

552. See *id.*

553. *Id.*

554. See *id.* at 362. Burnham includes a third factor, that "the hired party has granted the hiring party no exclusive copyright interest." *Id.* That does not seem to be relevant to a finding of a

be a license, and the remaining issue would generally be as to its scope. Burnham notes that the use test is supported by several architectural work cases, some of which found there was no implied license to use architectural plans.⁵⁵⁵

A more recent case has suggested that if there is disagreement as to the nature of the intended use, there is no meeting of the minds and, hence, no license. In *SHL Imaging, Inc. v. Artisan House, Inc.*,⁵⁵⁶ the court found that the defendant did not have an implied license to use the plaintiff's photographs of the defendant's picture frames in a catalog. The photographs had been prepared for use by salesmen as slides. The court said that "[a]n implied license can only exist where an author creates a copyrighted work with knowledge and intent that the work would be used by another for a specific purpose [N]o court has found an implied license where the nature of the use is contested."⁵⁵⁷ Focusing on the requirement that there be a meeting of the minds, the court said that implied licenses "cannot arise out of the unilateral expectations of one party."⁵⁵⁸

Although this case might seem to reject a use test as articulated by Professor Burnham, requiring a complete meeting of the minds as to the scope of an implied license seems too high a burden to place on the defendant, because in most implied license cases there will be terms upon which the parties have not agreed, but which are fairly implied. Arguably, implied licenses should not be defeated by the unilateral, unexpressed intent of one party, when the other party had a conflicting, reasonably foreseeable expectation of owning rights. *SHL Imaging* might be better understood as simply a case in which the defendant exceeded the scope of an express license and failed to prove the existence of an implied license, because there was an express license to reproduce and use the photos as slides for sales purposes. The defendant argued unsuccessfully that there was also an implied license to use the photos in a catalog, apparently merely on the basis of an allegation that the plaintiff "suspected" the defendants might do so.⁵⁵⁹ The existence of an express license might reasonably give rise to an inference that other uses outside the scope of the express license are not impliedly granted. Thus, *SHL Imaging* should be viewed as a case about the scope of use, and not as a general rejection of the use test. Alternately, it could be viewed as an

nonexclusive implied license. If an exclusive interest has been effectively granted, there will have been a writing, and the issue of implied license will not arise. Thus, it would seem that the use test is satisfied by the first two findings without a third.

555. See *id.* at 362–63.

556. 117 F. Supp. 2d 301 (S.D.N.Y. 2000).

557. *Id.* at 317.

558. *Id.* (quoting *Design Options, Inc. v. Belle Pointe, Inc.*, 940 F. Supp. 86, 92 (S.D.N.Y. 1996)).

559. *Id.*

example of the appropriate focus on intent when there is an express agreement, without denying the role of the parties' reasonable expectations in the absence of an express agreement.

Another alternative might be to recognize that some implied licenses should be viewed as contracts implied in law. The court construes the rights of the parties in order to avoid unjust enrichment and not as a substitute for words of agreement. Intent of the parties is generally irrelevant in connection with an agreement implied in law. Cases finding implied licenses of copyrights have suggested that the license is implied in fact rather than in law. That is, they focus on inferring an agreement from the conduct of the parties rather than creating a legal obligation to avoid unjust enrichment. Arguably, though, a party would be unjustly enriched by receiving payment for the creation of a contribution to a motion picture while prohibiting its use. Thus, a court could find a license implied in law even absent other conduct implying the existence of an actual agreement between the parties.⁵⁶⁰

Mark Janis makes an argument in the patent context that seems consistent with the cases and addresses some of the concerns discussed above. He points out that courts are reluctant to rely on the supposed intent of the intellectual property owner in some patent cases, because there is an incentive for the property owner to develop so-called intent after the fact, and to raise that intent at trial, as if it had been obvious to the parties when they transacted.⁵⁶¹ Of course, such a strategy would be equally tempting to a copyright owner. Janis argues that a better approach to implied licenses might be derived by reference to real property law, under which intent is important when there is an express agreement between the parties requiring interpretation, but the "reasonable expectations" of the parties, inferred from all the circumstances, should determine the parameters of an implied agreement.⁵⁶²

Finally, an implied license approach is consistent with our obligations under the "presumption of legitimation" of Berne Convention Article 14 *bis*, which indicates that many contributors of authorship to films⁵⁶³ should not

560. Mark Janis points out that in the patent field, some courts apply an "equitable estoppel" approach in finding an implied license, but others apply a "legal estoppel" approach. The former focuses on reasonable reliance by the defendant and the latter a grant of a license and an attempt to derogate the license by the plaintiff. Janis notes that the Federal Circuit has said that these are not different kinds of license, but different types of conduct that result in the same thing—an implied license—and that courts need not pursue "an endless quest to characterize the inherent nature of the implied license." Janis, *supra* note 529, at 504.

561. See *id.* at 508.

562. *Id.* at 512 (citing the tentative draft of the RESTATEMENT (THIRD) OF PROP.: SERVITUDES).

563. As discussed above, the presumption of legitimation requirement does not apply to screenwriters, film composers, or the principal director, unless legislation provides to the contrary. See Berne Convention, art. 14 *bis* (3). Member countries are required to notify the director general

have the right to object to most exploitation of the film, absent contrary agreement between the parties.⁵⁶⁴

Thus, in many instances when authorship material has been provided for use in a film, courts can implement a liability rule by means of an implied license. Such a license should be broad in scope absent a showing by the author that the reasonably foreseeable uses of the material were limited, and the license should not be revocable if there was any consideration.⁵⁶⁵ Because a licensee acting within the scope of its license is not an infringer of copyright, no copyright damages would be obtainable, nor could the court award attorneys' fees or costs to the plaintiff.⁵⁶⁶

CONCLUSION AND SUMMARY OF RECOMMENDATIONS

This Article has reviewed the requirements for copyright authorship under U.S. law, and applied those concepts to motion pictures. Although the issues addressed here will not come up often because most contributors of authorship to most motion pictures make their contributions as works made for hire, there are occasions when issues will arise. There is very little discussion in the case law or in legal scholarship about these issues. As a starting point, this Article has shown that anyone contributing original, minimally creative material to a film contributes work of authorship and, absent work-for-hire arrangements, is an author of that material.

This Article has suggested that there is uncertainty as to whether a screenplay would be considered a contribution to a joint work or a separate work from which the motion picture is a derivative work, and has concluded that under current joint work jurisprudence, it is unlikely to be considered a contribution to a joint work. It has suggested that original creative performance elements may be considered authorship and that actors can be authors, absent a work-for-hire status.

Finally, it has argued that, when material is created for use in a film in the absence of work-for-hire arrangements, courts should either modify the

of the World Intellectual Property Organization if their law does not apply the presumption to principal directors. *See id.*

564. Failure to comply with our obligations under Article 14 *bis* would also violate Article 9 of the *Agreement on Trade-Related Aspects of Intellectual Property Rights*. *See* AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS, Apr. 15, 1994, art. 9, 33 I.L.M. 81.

565. It would seem that the production company's incurring expense in reasonable reliance on the existence of an implied license should be considered an alternative to consideration.

566. If the plaintiff asserts a copyright infringement claim and loses, a court may award attorney's fees and costs to the successful defendant. *See Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994). Therefore, the plaintiff author might be better off asserting a claim other than copyright infringement, for example, breach of contract or *quantum meruit*, when it is likely that an implied license would be found.

consequences of a joint work determination, or, absent contractual arrangements to the contrary, continue to find broad, irrevocable, implied licenses to use the material in the exploitation of the film.

It is hoped that this Article will lead to a more vigorous discussion of these and other issues relating to the appropriate treatment of motion picture authorship, and the authorship of other highly collaborative works under U.S. copyright law in the future.