

THE FATE OF JOINT AUTHORSHIP AFTER COMMUNITY FOR CREATIVE NON-VIOLENCE V. REID*

I. INTRODUCTION

Courts have traditionally considered a party who commissioned the creation of a work to be the exclusive copyright owner of that work. Only the commissioning party had the right to reproduce, distribute, or prepare derivative works based upon the commissioned work¹ for the lifetime of the copyright.² The hired party, on the other hand, received no prospective benefit.³ Stated simply, because the commissioning party had enough money to support an artist's efforts, she⁴ received the copyright and consequently all monetary profits resulting from the work for the duration of the copyright.

For more than a decade, the circuit courts have disagreed in their interpretations of the term "work made for hire"⁵ found in

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¹ According to the 1976 Copyright Act:

[T]he owner of copyright . . . has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending

17 U.S.C. § 106 (1988). "[I]n the case of literary, musical, dramatic, and choreographic works, pantomimes," and audiovisual works, the copyright owner also has the exclusive rights of performance and display. *Id.*

² The lifetime of a copyright is the life of the author plus 50 years, or, in the case of a work made for hire, 75 years "from the year of its first publication, or a term of one hundred years from the year of its creation, whichever expires first." *Id.* § 302(a), (c).

³ Arguably, by contracting for and receiving a set payment for her services, the hired artist forfeits any subsequent benefit. However, since the ultimate economic value of most art pieces by undiscovered artists is not realized until time has passed and the artist's reputation has become established, this payment is rarely just compensation.

⁴ In this Note the female and male pronouns are used interchangeably, without any intended significance, except in the context of the factual background of specific cases.

⁵ A "work made for hire" is—

- (1) a work prepared by an employee within the scope of his or her employment; or
- (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

the Copyright Act of 1976 ("1976 Act").⁶ In June 1989, the Supreme Court heard *Community for Creative Non-Violence v. Reid*⁷ to resolve this conflict. The Court in *Reid* adopted the narrowest interpretation: A work is only a work for hire if (1) the artist, according to common law agency principles, is an employee of the commissioning party; or (2) the parties agree in writing that a work for hire is being created and the work falls into one of the enumerated categories of section 101(2) of the work-for-hire definition.⁸

By restricting the application of the work-for-hire doctrine, the Court made it more difficult for a commissioning party to claim *exclusive ownership* of a copyright and thereby granted the artist greater protection. The *Reid* decision, however, left open on remand the question of how a commissioning party can claim *co-ownership* of a copyright as a joint author of the work.⁹ The present test for joint authorship turns on the intention of the parties at the time of creation of the work. Because courts must infer the intention of the parties on a case-by-case basis, this test often does not provide predictable results. Additional inconsistencies arise because courts and copyright commentators differ on whether a contribution to a work must be copyrightable to make the contributor a joint author of the work.¹⁰

Senator Thad Cochran (R.-Miss.) introduced a bill aimed at

17 U.S.C. § 101 (1988).

For differing interpretations of the work-for-hire doctrine, see *Easter Seal Soc'y v. Playboy Enters.*, 815 F.2d 323 (5th Cir. 1987), *cert. denied*, 485 U.S. 981 (1988) (a work is a work for hire if and only if the artist is an "employee" within the meaning of agency law or the parties agree to such in writing and the work falls into one of the categories enumerated in 17 U.S.C. § 101(2)); *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.), *cert. denied*, 469 U.S. 982 (1984) (a work for hire is created when an independent contractor is sufficiently supervised and directed by the hiring or commissioning party).

The expressions "work made for hire" and "work for hire" have been used interchangeably in recent articles and case decisions. This Note uses the shorter term "work for hire," inserting hyphens into the adjectival form.

⁶ 17 U.S.C. §§ 101-914 (1988).

⁷ 109 S. Ct. 2166 (1989), *aff'g* 846 F.2d 1485 (D.C. Cir. 1988).

⁸ *Id.* at 2174-78. The Court applied the holding from *Easter Seal Soc'y*, 815 F.2d 323.

⁹ The fact that this case recently was settled with each party retaining a joint copyright interest, has done nothing to answer the question. Without a definitive statement on joint authorship from the Supreme Court or an amendment to the 1976 Act's definition of joint work, the ambiguity will remain.

For details of the settlement, see *Group for Homeless Settles Copyright Fight Over Sculpture*, N.Y. Times, Dec. 26, 1990, at A32.

¹⁰ See *infra* notes 50-104 and accompanying text.

resolving these issues in favor of artists.¹¹ During an address to the Senate, Senator Cochran drew attention to the fact that:

[r]ecent cases, most notably [*Reid*], aptly illustrate that the determination that a commissioned work is not a work for hire leaves open the difficult issue whether the commissioning party and the creator are joint authors of the work under the current definition of "joint work." Without additional legislative clarification, litigation over the joint work question as it arises in the commissioned work setting will be long and protracted.¹²

Senator Cochran recommends that the 1976 Act be amended to add the requirements of a copyrightable input¹³ and a written stipulation that the parties intended to create a work of joint authorship before a party can be considered a joint author.¹⁴

This Note addresses the joint authorship issue raised in *Reid* and analyzes Senator Cochran's proposed bill. Part II examines the statutory definition of, and the requirements for, joint authorship. It further discusses the facts and reasoning of *Reid*, and explains how this decision highlights the issue of what constitutes joint authorship. Part III focuses on the disagreement as to whether copyrightability is an implicit requirement for joint authorship. Part IV discusses the practical problems encountered in a joint authorship situation and illustrates why courts should find joint authorship only when it is truly warranted. Part V examines the bill proposed by Senator Cochran which would amend the 1976 Act to include an input requirement of a copyrightable element by each author and a written stipulation of the intent of the parties. Finally, this Note suggests that the proposed amendment would make more changes than are necessary. By requiring that a person contribute a copyrightable input to be deemed a joint author of a work, the amendment would resolve the current ambiguity in the statute and reduce

¹¹ [S]ection 101 of title 17, United States Code, is amended—

(2) in the definition of "joint work", by striking out "their contributions" and inserting in lieu thereof "their original contributions"; and

(3) by adding before the period at the end of the definition of "joint work" the following: ", provided that, in the case of each specially ordered or commissioned work, no such work shall be considered a joint work unless the parties have expressly agreed in a written instrument, signed by them before the commencement of the work, that the work shall be considered a joint work".

S. 1253, 101st Cong., 1st Sess., 135 CONG. REC. 7341 (1989) [hereinafter *The Artists' Bill of Rights*].

¹² *Id.* at 7343. See also *infra* note 48.

¹³ For the standard of copyrightability, see *infra* note 82.

¹⁴ *The Artists' Bill of Rights*, *supra* note 11, at 7341.

potential inconsistency and unfairness in the courts. However, by requiring a written stipulation as to the intention of the parties, the proposed amendment would provide more protection to artists than is required to equalize the bargaining process.

II. JOINT AUTHORSHIP AND *COMMUNITY FOR CREATIVE NON-VIOLENCE V. REID*

A joint work is defined 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."¹⁵ A work is considered "joint" if the parties collaborate with one another, or if they each prepare their contribution with the knowledge and intention that all contributions will be merged.¹⁶ Moreover, no provision requires that respective contributions of authors be quantitatively or qualitatively equal.

Congress clearly stated that the intention of the parties, at the time the work was created, should be examined to determine joint ownership.¹⁷ An example of someone who is not a joint author is a novelist who writes a work "with the hope or expectation" that the piece will be adapted into a film.¹⁸ Congress stated that "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."¹⁹

Since a copyright initially vests in the author or authors of a work,²⁰ a copyright will vest in all of the authors in the case of a joint work, making them co-owners.²¹ The legislative history of the 1976 Act expressly stated that the court-made law under the Copyright Act of 1909 ("1909 Act")²² concerning rights and duties of joint owners should stand.²³ Therefore, the relationship

¹⁵ 17 U.S.C. § 101 (1988).

¹⁶ See H.R. REP. NO. 1476, 94th Cong., 2d Sess. 120, *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5736 [hereinafter H.R. REP.]; S. REP. NO. 473, 94th Cong., 2d Sess. 103 [hereinafter S. REP.]. Support in Congress was so great that both houses issued virtually identical reports.

¹⁷ H.R. REP., *supra* note 16, at 5736; S. REP., *supra* note 16, at 103.

¹⁸ H.R. REP., *supra* note 16, at 5736; S. REP., *supra* note 16, at 104.

¹⁹ H.R. REP., *supra* note 16, at 5736; S. REP., *supra* note 16, at 104. In other words, a novelist cannot claim joint authorship if her novel is later turned into a movie. An author must have more than hope that her work will be used to create a film, she needs to have knowledge of this fact.

²⁰ For a listing of those rights which vest in a copyright owner, see *supra* note 1. The exception to this rule is the special circumstance of the work-for-hire doctrine. See 17 U.S.C. § 101 (1988).

²¹ See 17 U.S.C. § 201(a).

²² Pub. L. No. 60-349, 60 Stat. 1075, *repealed by* Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified at 17 U.S.C. §§ 101-914 (1982)).

²³ See H.R. REP., *supra* note 16, at 5736; S. REP., *supra* note 16, at 104.

between co-owners of a copyright, as established under the 1909 Act, continues to be treated like a tenancy in common.²⁴ Joint authors share equally in the ownership of the work;²⁵ each owns an undivided interest in the whole work in proportion to the number of authors and not in relation to importance or quantity of their respective contributions.²⁶ Such an undivided interest in the whole gives each joint owner a right to exploit the joint work or grant a nonexclusive right²⁷ to a third party without obtaining consent from his fellow owners.²⁸

The only responsibility that a joint owner has to the other joint owners is a duty to account for profits realized from the work, a point illustrated in *Oddo v. Ries*.²⁹ Oddo and Ries became partners³⁰ in the creation of a book on how to restore Ford pick-up trucks. Oddo was writing a manuscript by reworking his previously published magazine articles and adding new material.³¹ Unsatisfied with Oddo's progress, Ries hired a writer to finish Oddo's manuscript and then published it as a book.³² In an infringement action brought by Oddo, the district court found "that the Oddo/Ries partnership own[ed] the copyrights in the book and the manuscript" and that "[a]s a partner, Ries [was] a co-owner of the partnership's assets, including the copyrights."³³ Thus, Ries had the right to publish the manuscript. Based upon this finding, the court of appeals held that Ries could not be lia-

²⁴ See H.R. REP., *supra* note 11, at 5736; S. REP., *supra* note 16, at 104. The principles of a tenancy in common were applied to co-owners of a copyright as early as 1921 in *Silverman v. Sunrise Pictures Corp.*, 273 F. 909 (2d Cir. 1921). The court stated that "[a]ssuming tenancy or ownership in common . . . there is no reason why other and well-known incidents of such title should not control the interpretation of a statute creating common ownership." *Id.* at 914. Cf. H. See, *Copyright Ownership of Joint Works and Terminations of Transfers*, 30 U. KAN. L. REV. 517 (1982) (discussing the possibility of contracting for joint tenancy and the issues involved).

²⁵ 1 M. NIMMER, NIMMER ON COPYRIGHT § 6.08, at 6-20 (1990) [hereinafter NIMMER].

²⁶ See *id.* See also *Pye v. Mitchell*, 574 F.2d 476, 480 (9th Cir. 1978) (Although copyright was secured in the names of only two of the authors, there was abundant evidence to support finding of a third co-author. Therefore, since the work was "a product of joint authorship, each co-author automatically [became] a holder of an undivided interest in the whole."); The Artists' Bill of Rights, *supra* note 11, at 7343.

²⁷ One who has a nonexclusive right has the privilege to exploit a work, but has no authority to prevent others from exploiting such work.

²⁸ 1 NIMMER, *supra* note 25, § 6.10, at 6-22.

²⁹ 743 F.2d 630 (9th Cir. 1984).

³⁰ The court analogized the rights of partners to the rights of joint authors. "We have not found any cases dealing with the rights of partners in copyrights held by their partnership, but we see no reason why partners should be excluded from the general rules governing copyright co-ownership." *Id.* at 633.

³¹ *Id.* at 632.

³² "The book that Ries eventually published contained substantial quantities of Oddo's manuscript but also contained material added by the new writer." *Id.*

³³ *Id.*

ble for infringement on his own copyright.³⁴ However, the court stated that “[a] co-owner of a copyright must account to other co-owners for any profits he earn[ed] from licensing or use of the copyright.”³⁵

Although it might appear that the joint work definition of the 1976 Act is unambiguous, a question arises as to whether a copyrightable contribution is required before one can be considered a joint author.³⁶ Although the 1976 Act remains silent on this issue, a majority of the courts have read an implicit requirement of a copyrightable input into the joint authorship situation.³⁷ Some courts and commentators, however, do not agree. Recently, with the decision in *Community for Creative Non-Violence v. Reid*, this inconsistency was forced into the forefront.

In *Reid*, the Community for Creative Non-Violence, a non-profit unincorporated association, entered into a verbal agreement with Reid, a sculptor, to create a statue of a modern Nativity scene dramatizing the plight of the homeless.³⁸ The sculptor donated his services, but the association paid the sculptor’s expenses.³⁹ During their relationship there was never any discussion regarding copyright ownership in the finished piece.⁴⁰ Subsequently, each party claimed a right to an exclusive copyright: Reid as the author and the Community for Creative Non-Violence as the commissioning party under the work-for-hire doctrine.⁴¹

The Supreme Court stated that common law agency principles, traditionally, are used to determine whether a commissioned party is an employee⁴² for work-for-hire pur-

³⁴ *Id.* at 632-33.

³⁵ *Id.* at 633. The court further explained that this duty to account does not stem from copyright law. “Rather, it comes from ‘equitable doctrines relating to unjust enrichment and general principles of law governing the rights of co-owners.’” *Id.* (quoting *Harrington v. Mure*, 186 F. Supp. 655, 657-58 (S.D.N.Y. 1960)).

³⁶ “‘Contributions’ [in the definition of joint work in § 101 of the 1976 Act] is not defined, and how much of a contribution is necessary to qualify a collaborator as a joint author is extremely uncertain.” Gerber, *Joint Authorship Requirements Questioned by Courts, Experts*, Nat’l L.J., Apr. 30, 1990, at 24, col. 1 [hereinafter *Joint Authorship Requirements*].

³⁷ The Artists’ Bill of Rights, *supra* note 11, at 7343. See also *infra* notes 51-81 and accompanying text.

³⁸ *Community for Creative Non-Violence v. Reid*, 109 S. Ct. 2166, 2169 (1989). The title of the work was to be “Third World America.” *Id.*

³⁹ *Id.*

⁴⁰ “The parties did not sign a written agreement. Neither party mentioned copyright.” *Id.* “Reid and [the Community for Creative Non-Violence] members did not discuss copyright ownership on any of [their] visits.” *Id.* at 2169-70.

⁴¹ Both Reid and Snyder, acting in his capacity as trustee for the Community for Creative Non-Violence, filed certificates of copyright registration. *Id.* at 2170.

⁴² *Id.* at 2179 n.31. For a list of relevant factors to be considered, see generally RESTATEMENT (SECOND) OF AGENCY § 220(2) (1958).

poses.⁴³ In this case, the Court found Reid to be an independent contractor, not an employee of the association. Furthermore, since the work did not fit into any of the enumerated categories of section 101(2) of the work-for-hire definition,⁴⁴ the work did not constitute a work for hire. As a result, the Court held that the Community for Creative Non-Violence did not wholly own the copyright.⁴⁵ The Court, however, left for remand the issue of whether the Community for Creative Non-Violence and Reid were joint authors, each owning a nonexclusive copyright in the whole.⁴⁶

By stating that agency law principles determine who is an employee in a work-for-hire situation, the Court invalidated the broader test previously applied.⁴⁷ Such a narrowing of the work-for-hire doctrine will make it difficult for commissioning parties to retain an exclusive copyright in a commissioned work. Consequently, many commissioning parties will now try to obtain joint author status to avoid losing their investments.⁴⁸ Although the

⁴³ The Supreme Court made clear that the two means by which a work for hire can be created are mutually exclusive. Accordingly, to determine within which subsection of the work-for-hire definition a work falls, a court must first apply principles of general common law of agency to decide whether the work was prepared by an employee or an independent contractor. See *Reid*, 109 S. Ct. at 2174. Once that determination is made, the Court applies either § 101(1) or (2). If the work was prepared by an employee, § 101(1) applies and the work is automatically labeled a work for hire. If, however, the Court finds that the work was prepared by an independent contractor, § 101(2) applies. In this situation, the work is a work for hire only if the work falls within one of the enumerated categories of § 101(2) and there is a written, signed statement stipulating that the work is a work for hire. For the work-for-hire provision, see *supra* note 5.

⁴⁴ See *supra* note 5.

⁴⁵ *Reid*, 109 S. Ct. at 2179-80.

⁴⁶ *Id.* at 2180. For a discussion of the ramifications of joint authorship, see *supra* notes 20-29 and accompanying text.

⁴⁷ The previous test, which defined an employee as a person who is "sufficiently supervised or directed," was articulated and applied in *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.), *cert. denied*, 469 U.S. 982 (1984). The *Reid* Court described this test as the "actual control" test. *Reid*, 109 S. Ct. at 2173.

⁴⁸ See *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1497 n.17 (D.C. Cir. 1988), *aff'd*, 109 S. Ct. 2166 (1989) ("With the substantial cutback of the work for hire doctrine under the 1976 Act, more cases of this genre can be expected to appear under the joint authorship rubric."); O'Meara, "Works Made for Hire" Under the Copyright Act of 1976—Two Interpretations, 15 CREIGHTON L. REV. 523, 539 (1982) ("If the radical view is followed, [as it was by the Supreme Court in *Reid*,] co-ownership will become a central issue in many disputes."); Goldberg and Bernstein, *The Battle Over Joint Ownership*, 202 N.Y.L.J. 3, col. 1 (Nov. 17, 1989) [hereinafter *The Battle Over Joint Ownership*] ("If a hiring party does not qualify as an employer-for-hire under [*Reid*], it will often argue, alternatively, that its contributions to the work entitle it to joint authorship status.').

Furthermore, the question of whether collaborators are joint authors has confronted courts recently because of the "enormous multiplication in the numbers of people who participate in creatively fashioning a final entertainment product. . . . Absent 'work made for hire' status, the concept of 'joint authorship' is critical in untangling ownership rights in these complex collaborative works." *Joint Authorship Requirements*, *supra* note 36, at 24, col. 1. For the practical ramifications of being deemed a joint author of a copyright, see *supra* notes 20-29 and accompanying text.

Reid Court may have resolved conflicts relating to the work-for-hire doctrine, the opinion simply shifted this confusion to the question of joint authorship by remanding the case to the district court without guidance on that issue.⁴⁹

III. REQUIREMENT OF COPYRIGHTABILITY IN JOINT AUTHORSHIP SITUATIONS

There is disagreement, unresolved by the Court in *Reid*, as to what one must contribute to be considered a joint author of a work. This conflict centers on the question of whether each author must contribute a copyrightable element. Although Congress has never mentioned the requirement of a copyrightable input in the context of joint authorship, and Nimmer explicitly rejects the requirement,⁵⁰ “[m]ost courts have correctly recognized that the contribution of ideas alone, or of other uncopyrightable involvement . . . is not sufficient to make the resulting work a ‘joint work.’ ”⁵¹

A. *A Majority of Courts Imply a Requirement of Copyrightable Input*

There are many cases where courts have implied a requirement of copyrightable input from the language of the 1976 Act. In *Meltzer v. Zoller*,⁵² the Meltzers had a house built for themselves. The construction plans for the house included work by an architect, designs of the stock plans (a product of the architectural firm), and sketches drawn by the Meltzers.⁵³ A little over a

⁴⁹ “Neither [the Community for Creative Non-Violence] nor *Reid* sought review of the Court of Appeals’ remand order. We therefore have no occasion to pass judgment on applicability of the [1976] Act’s joint authorship provisions to this case.” *Reid*, 109 S. Ct. at 2180 n.32.

The only guidance given the district court by the Court of Appeals was the statement that this case “might qualify as a textbook example of a jointly-authored work in which the joint authors co-own the copyright.” *Reid*, 846 F.2d at 1497 (suggesting that this factual situation is similar to *Strauss v. The Hearst Corp.*, 8 U.S.P.Q.2d (BNA) 1832 (S.D.N.Y. 1988), in which the Southern District of New York found joint authorship). Furthermore, the court stated, “[w]e do not instruct the final decision, however, so that *Reid* may have a full and fair opportunity to rebut [the Community for Creative Non-Violence’s] joint ownership claim and to pursue a question *Reid* has raised regarding the identity of potential joint authors.” *Reid*, 846 F.2d at 1497. For a discussion of *Strauss*, see *infra* notes 87-102 and accompanying text.

⁵⁰ 1 NIMMER, *supra* note 25, § 6.07, at 6-18.2.

⁵¹ The Artists’ Bill of Rights, *supra* note 11, at 7343. This requirement of a copyrightable input is found in a copyright treatise as well as in case law. See 1 P. GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE § 4.2.1.2, at 379 (1989). “A collaborative contribution will not produce a joint work, and a contributor will not obtain a coownership interest, unless the contribution represents original expression that could stand on its own as the subject matter of copyright.” *Id.*

⁵² 520 F. Supp. 847 (D.N.J. 1981).

⁵³ *Id.* at 850.

year later, the Zollers wished to build a house similar to the Meltzers' and hired the same architectural firm to design it. Subsequently, the Meltzers copyrighted the plans and brought suit for copyright infringement against the Zollers.⁵⁴

The court concluded that the Meltzers "[did] not have the authorship interest in the plans requisite for copyright protection and consequently," they did not have a cause of action.⁵⁵ The Meltzers did not own a valid copyright in the plans because they failed to prepare or create the work.⁵⁶ "The ideas and sketches contributed by plaintiff [did] not sufficiently constitute fixed expressions⁵⁷ of ideas; therefore, plaintiff [was] not the 'creator' of the plans for his house for copyright purposes."⁵⁸ Furthermore, the failure to "create" the work as defined by the 1976 Act prohibited the plaintiffs from asserting any copyright interest as an author or even as a joint author of the plans.⁵⁹ In other words, the *Meltzer* court held that a client who only contributes ideas, which are not sufficiently fixed and therefore not copyrightable, cannot be an author or a joint author with an architect.⁶⁰

⁵⁴ *Id.* at 852.

⁵⁵ *Id.* at 853. The court looked at both the work-for-hire and joint authorship provisions for protection. *Id.* at 853-57.

⁵⁶ *Id.* at 857. "[P]ursuant to 17 U.S.C. § 101, a 'work' is 'created' when 'it is fixed in a copy . . . for the first time.'" *Id.*

⁵⁷ "A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." 17 U.S.C. § 101 (1988) (author's footnote added).

⁵⁸ *Meltzer*, 520 F. Supp. at 857. "Without authorship, the *sine que non* [sic] of copyright, plaintiff has no cause of action." *Id.*

⁵⁹ *See id.*

⁶⁰ *See also* *Aitken v. Empire Constr. Co.*, 542 F. Supp. 252 (D. Neb. 1982). In *Aitken*, another architecture case, Belmont Construction Company ("Belmont") hired Aitken to design an apartment complex. "Belmont contributed ideas, directed certain changes be made, and exercised approval power at the completion of each stage of development of the plans." *Id.* at 259. After Belmont copied Aitken's drawings and used them in its construction of another apartment complex, Aitken sued Belmont for copyright infringement. *Id.* at 255.

Belmont argued that it was the sole owner of the copyright under the work-for-hire doctrine and, in the alternative, that it was a co-owner because Belmont was a joint author of the plans. *Id.* at 256. After dismissing Belmont's work-for-hire claim, *id.* at 256-58, the court stated that Belmont's involvement was expected and that this extent of client involvement did not ordinarily render a client an author. *Id.* at 259. "The only design idea which may be said to have originated in Belmont was the design by which the balconies were to be attached to the exterior walls of the apartment complex. However, even as to this design idea, it was the plaintiff's employees who prepared the actual design drawing incorporating the idea into the . . . architectural plans." *Id.* The *Aitken* court found that "Belmont directed . . . certain architectural features be incorporated into the architectural plans, but [it was the architect who] controlled *how* those ideas were [to be] incorporated" into a tangible expression. *Id.* (emphasis added). "Even assuming that Belmont's contribution of this idea to the plans in question was a contribution of authorship, Belmont's overall contribution to the plans cannot be said to be

Another case which illustrated the copyrightable input requirement for joint works was *Weissmann v. Freeman*.⁶¹ In *Weissmann*, the question was "whether a medical paper derived from the parties' prior jointly authored works is itself a joint work."⁶² Beginning in 1979, the parties jointly authored several articles on iminodiacetic acid (IDA) which were published under the names of Freeman and Weissmann.⁶³ In 1985, Weissmann authored a syllabus derived from the earlier jointly written articles with some portions taken verbatim from the prior works and with other new elements added.⁶⁴ This syllabus was published with Weissmann named as the sole author.⁶⁵ Freeman later tried to use this syllabus naming himself as the author. Weissmann requested that he not circulate this syllabus and sued for copyright infringement.⁶⁶

The Second Circuit declared that a joint author in a derivative work must "contribute" to the derivative work itself.⁶⁷ While Freeman provided original work for the first set of articles, his failure to add new copyrightable expression to the derivative work meant that he could not be considered a joint author.⁶⁸

In the case at hand, because Dr. Freeman conceded that he had not participated in drafting the new matter included in [the syllabus], it follow[ed] as a logical corollary, therefore, that he acquired no interest in or right to use [the syllabus] beyond those rights which he had as co-author in the prior joint material incorporated into [the syllabus].⁶⁹

Thus, the *Weissmann* court, like the *Meltzer* court, held copyrightable input to be a prerequisite to joint authorship.

more than de minimus in nature." *Id.* Thus, without contributing authorship, Belmont could not be considered either an author or a joint author.

⁶¹ 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

⁶² *Id.* at 1315.

⁶³ Some other scientists were also credited with authorship, but they were not party to this lawsuit. *Id.*

⁶⁴ *Id.* at 1316.

⁶⁵ *Id.* Theoretically, Freeman could not have prevented Weissmann from using the previously published sections because joint authors each have unrestricted rights to use their copyrighted joint works. *See supra* text accompanying notes 27-28.

⁶⁶ *Weissmann*, 868 F.2d at 1316.

⁶⁷ "Because [17 U.S.C.] § 103(b) extends *independent* protection to derivative works, an intent to contribute or an actual contribution to previous works does not serve as proof of ownership in the derivative work." *Id.* at 1318 (emphasis added).

⁶⁸ *See id.* In addition, Weissmann failed to show the necessary intent "that the new material be included as part of a joint work with her previous collaborator. This finding was based in part on plaintiff's publication of the updated version in her own name, without seeking any comments from defendant, in contrast to her practice with respect to previous papers in which she collaborated with defendant." *The Battle Over Joint Ownership*, *supra* note 48, at 7, col. 1.

⁶⁹ *Weissmann*, 868 F.2d at 1318.

Even more recently, in *Olan Mills, Inc. v. Eckerd Drugs*,⁷⁰ a photographer sued Eckerd Drugs ("Eckerd") which, through its self-service counter, made duplications or enlargements of the plaintiff's copyrighted photographs for the subjects of the portraits. The question in this case was whether one who sat for a portrait was a joint owner of the copyright in such portrait, and was therefore allowed to reproduce the work without permission.⁷¹ The photographer claimed "that the photographer or photographic studio [was] the sole author and owner of the copyright in portrait photographs and that Eckerd willfully infringed the copyright" by duplicating the pictures without the photographer's consent.⁷²

Eckerd contended that its actions could not constitute infringement because they were authorized by the subjects of the portraits, who were joint authors and thus co-owners of the copyright.⁷³ The court rejected the proposition that someone can simply enter a studio and thereby acquire a property right in a professional portrait.⁷⁴ The court recognized that such intangible and consequently uncopyrightable involvement cannot make one a co-creator of a photograph.

The question of what constitutes joint authorship, and consequently whether there is a requirement of a copyrightable input, has also arisen in computer software cases. Recently, in *S.O.S., Inc. v. Payday, Inc.*,⁷⁵ S.O.S. licensed software to Payday to use in its business of providing payroll and financial services to the entertainment industry.⁷⁶ A Payday employee, Goodman, informed S.O.S. of the tasks the software should perform and how it should sort data. S.O.S. customized the software to meet Payday's needs.⁷⁷

Upon being sued for making illegal copies of the program, Payday claimed that through Goodman the company was a joint author of the program and was thus "entitled to modify, reproduce, or distribute copies of the work."⁷⁸ The court pointed out that "[Goodman] did none of the coding and [did] not understand any computer language."⁷⁹ Furthermore, the court reasoned that:

[a] person who merely describes to an author what the com-

⁷⁰ Copyright L. Dec. (CCH) ¶ 26,420, at 22,630 (N.D. Tex. Apr. 20, 1989).

⁷¹ See *id.* at 22,631.

⁷² *Id.*

⁷³ *Id.*

⁷⁴ *Id.* at 22,632.

⁷⁵ 886 F.2d 1081 (9th Cir. 1989).

⁷⁶ See *id.* at 1083.

⁷⁷ *Id.*

⁷⁸ *Id.* at 1086. See 17 U.S.C. §§ 106(1)-(3), 201(a) (1988).

⁷⁹ *S.O.S.*, 886 F.2d at 1086.

missioned work should do or look like is not a joint author for purposes of the Copyright Act. 17 U.S.C. § 101 defines a "joint work" as a "work prepared by two or more *authors*." To be an author, one must supply more than mere direction or ideas: one must "translate[] an idea into a fixed, tangible expression entitled to copyright protection."⁸⁰

The court stated that the contributor of an idea is no more an author of a program than one who supplies the disk on which that program is stored—neither party being able to claim authorship of the program. Here, again, the Ninth Circuit reiterated the test that most courts have been following: To be a joint author, one must be an "author"; one must contribute something that is tangible and copyrightable.⁸¹

B. *A Court and Commentator Refuse to Imply a Requirement of Copyrightable Input*

Despite the abundance of case law, the 1976 Act and legislative history are silent as to whether each person's contribution to a joint work must meet a standard of copyrightability.⁸² Although Nimmer writes that each contribution by a joint author

⁸⁰ *Id.* at 1087 (emphasis in original) (quoting *Reid*, 109 S. Ct. at 2171). "It is of particular interest to note that the Ninth Circuit relied on the Supreme Court's formulation of the authorship requirement in [*Reid*]. Although made in the context of consideration of the work-for-hire issue, the Supreme Court's definition of authorship casts doubt on the validity of the position in the *Nimmer* treatise that a joint author need not contribute separately copyrightable material." *The Battle Over Joint Ownership*, *supra* note 48, at 7, col. 3. For Nimmer's interpretation of the joint authorship provision, see *infra* notes 83-85 and accompanying text.

⁸¹ See also *Ashton-Tate Corp. v. Ross*, 728 F. Supp. 597 (N.D. Cal. 1989). In *Ashton-Tate*, the defendant gave the programmer, Wigginton, "a list of user commands he felt the program should contain." *Id.* at 600. Based on this contribution, Ross claimed that the user interface portion of the program was a joint work. The court rejected this contention by going as far as stating that "[i]n order for an author to obtain an interest in a 'joint work,' federal copyright law requires that the contribution made by that author to the 'joint work' is, by itself, protectable under the Federal Copyright Act." *Id.* at 601 (citing *Whelan Assocs. v. Jaslow Dental Laboratory, Inc.*, 609 F. Supp. 1307 (E.D. Pa. 1985) (Descriptions by an owner of a dental laboratory to a software designer concerning the operations of his laboratory and information he wanted to be able to obtain from the program, was not enough to make him coauthor of the software system.), *aff'd on other grounds*, 797 F.2d 1222 (3rd Cir.), *cert. denied*, 479 U.S. 1031 (1987); *Aitken v. Empire Constr. Co.*, 542 F. Supp. 252 (D. Neb. 1982)). For a discussion of *Aitken*, see *supra* note 60.

⁸² The standard for copyrightability is that a work is original and is a fixed, tangible expression. "Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . ." 17 U.S.C. § 102(a) (1988). "In no case does copyright protection for an original work of authorship extend to any idea . . ." *Id.* § 102(b). Only the fixed representation of an idea is copyrightable because any idea can be expressed in infinite ways. If any one person could copyright an idea and thereby stop all subsequent expression of it, such a copyright would create an overly broad monopoly which would have the effect of stifling creativity rather than promoting it. Consequently, one who simply gives another an idea is not an author because nothing

must be more than *de minimis*,⁸³ he states that for joint authorship "the standard of *de minimis* is not necessarily the same as the standard for copyrightability."⁸⁴ Unfortunately, Nimmer gives no reason why a standard of copyrightability should not be applied to contributions by joint authors. He does, however, give an example: "if authors A and B work in collaboration, but A's contribution is limited to plot ideas which standing alone would not be copyrightable, and B weaves the ideas into a completed literary expression, it *would seem* that A and B are joint authors of the resulting work."⁸⁵ Nimmer does not cite any case law to support this proposition.

Although many courts have required that a joint author make a copyrightable contribution to a work,⁸⁶ the Southern District of New York in *Strauss v. The Hearst Corp.*⁸⁷ followed what seems to be the Nimmer approach. This court found a joint work without each "joint author" contributing a copyrightable input. This decision has "suggested that the involvement of a commissioning party in the project, through supervising the work of the creator, is alone sufficient to confer joint authorship status upon him."⁸⁸

Strauss was a photographer hired by *Popular Mechanics* magazine to photograph fishing rods and fishing gear for an upcoming article.⁸⁹ The magazine's graphics director drew sketches, assembled the equipment for the photographic shoot, and retained the right of approval.⁹⁰ Moreover, the magazine retouched the photographs before printing the article.⁹¹

After the magazine reused the photograph as a promotional insert, Strauss "argue[d] that he own[ed] the copyright to the

copyrightable is contributed, but one who creates a tangible representation of the idea is the author.

⁸³ "That is, more than a word or a line must be added by one who claims to be a joint author." 1 NIMMER, *supra* note 25, § 6.07, at 6-18.2.

⁸⁴ *Id.*

⁸⁵ *Id.* (emphasis added). It is unclear whether Nimmer is only singling out literary expression as an area where copyrightable contribution is not required to become a joint author. Also, Nimmer's use of the language "would seem" leaves one questioning whether he has convinced himself of this proposition.

⁸⁶ See *supra* notes 51-81 and accompanying text.

⁸⁷ 8 U.S.P.Q.2d (BNA) 1832 (S.D.N.Y. 1988).

⁸⁸ The Artists' Bill of Rights, *supra* note 11, at 7343. See *Easter Seal Soc'y v. Playboy Enters.*, 815 F.2d 323, 334 (5th Cir. 1987), *cert. denied*, 485 U.S. 981 (1988) (dictum) ("[A]ny plaintiff who actually controls an independent contractor will be a co-author of the work . . .").

⁸⁹ *Strauss*, 8 U.S.P.Q.2d at 1833.

⁹⁰ The magazine sent the photographs back to Strauss to be reshot when the pictures were not acceptable. *Id.*

⁹¹ *Id.* at 1834.

photograph . . . , that he granted [the magazine] only a limited license to use the photograph . . . , and that [the magazine's] subsequent republication of the photograph in the promotional [sic] infringed his copyright."⁹² The court stated that it was "hard to imagine" facts that could more clearly demonstrate that Strauss and *Popular Mechanics* "intended . . . 'their contributions be . . . a unitary whole.'"⁹³ The court reasoned that:

[n]either party denie[d] that both intended from the start for Strauss's photograph to be incorporated into the April 1985 article. It [was] apparent from Strauss's deposition that he knew captions and other copy would be superimposed upon the photograph when the article was put in its final form. To that end he was careful to leave space in the composition of the photograph that would accommodate such future additions.⁹⁴

In addition to finding that Strauss and *Popular Mechanics* intended to create a joint work,⁹⁵ the court also gave weight to the input of the magazine's graphic editor in designing the layout for this article, supervising some of the shoots, and having the photographs retouched by artists and technicians hired by *Popular Mechanics*. Based on these findings, the court came to the "inescapable" conclusion that the contributions made by both parties constituted a joint work.⁹⁶

The court, however, failed to question whether its characterization of the relationship between the magazine and the photographer made sense in light of industry practices.⁹⁷ By leaving adequate space on the photograph for captions, Strauss was not making a

⁹² *Id.* at 1834-35 (citations omitted).

⁹³ *Id.* at 1837.

⁹⁴ *Id.* (footnote omitted).

⁹⁵ *See id.* *But see* *Grosset & Dunlap, Inc. v. Gulf & Western Corp.*, 534 F. Supp. 606 (S.D.N.Y. 1982), in which the court stated that the intent to place pieces together did not equal an intent to create a joint work and therefore to share a joint copyright. *Id.* at 609. Edward Stratemeyer, the creator of the books featuring the Bobbsey Twins, the Hardy Boys, Nancy Drew, and Tom Swift, granted the plaintiff the exclusive right to publish some of his stories. In a later lawsuit, the plaintiff claimed that he was a joint copyright owner of these stories by virtue of the illustrations he provided in the books. The court found that the text and the illustrations were not "inseparable or interdependent parts of a unitary whole." *Id.* (quoting 17 U.S.C. § 101 (1988)). "[T]he parties' intention was that the illustrations be included to enhance the attractiveness, for marketing purposes . . ." *Id.* The court found that Stratemeyer and his heirs never intended "that its stories be 'subsumed into [a] joint effort'" and therefore, they lacked the necessary intent. *Id.* (quoting *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429, 430 (S.D.N.Y. 1974)).

⁹⁶ *See Strauss*, 8 U.S.P.Q.2d at 1837-38.

⁹⁷ *See Aitken v. Empire Constr. Co.*, 542 F. Supp. 252 (D. Neb. 1982) (the court considered the amount of contribution expected from a client, in a client-architect relationship, to determine whether the client was a joint author). For a discussion of *Aitken*, see *supra* note 60.

statement that he intended to make an inseparable joint work.⁹⁸ Rather, his statement was that he wished to be paid for services rendered. Freelance artists are at the mercy of those who hire them; their work must conform to the hiring parties' specifications. Strauss participated in the manner *Popular Mechanics* requested because this was the only way for him to receive payment for his services.

The *Strauss* decision differs from the cases previously discussed where the courts explicitly stated that an employer cannot gain a copyright merely by giving directions regarding the form of the artist's final product.⁹⁹ The court in *Strauss* did not discuss whether the respective contributions made by the two parties were copyrightable. This decision held that one can become a joint author of a work simply by having the intent to do so, without actually doing anything worthy of copyright—a party can be considered an author without having actually “authored” anything.

If the copyrightable input test¹⁰⁰ had been applied in this situation, the case would have been decided differently. *Popular Mechanics* magazine only gave guidance and direction to the photographer. The sketches prepared by *Popular Mechanics* to guide Strauss in his work and its power of approval were not contributions tangibly reflected in the final product and therefore were not copyrightable.¹⁰¹ Strauss was the one who fixed the graphics director's ideas in a tangible expression by taking the photographs. The photographs themselves were tangible, original expressions that could be copyrighted.¹⁰² Therefore, the court should have concluded that Strauss was the author of the photographs and *Popular Mechanics* was simply a hiring party.

The inconsistency between *Strauss* and the cases which required

⁹⁸ Strauss denied that he intended to create a joint copyright. The court answered that “[e]ven though Strauss may not have intended the legal consequences that attach[ed] to his actions, he [did] not deny that he still had the requisite intent to participate in the creation of pages 86 and 87 in the manner described.” *Strauss*, 8 U.S.P.Q.2d at 1837 n.5.

⁹⁹ See *supra* notes 52-60 and 75-81 and accompanying text.

¹⁰⁰ See *supra* notes 51-81 and accompanying text.

¹⁰¹ Of course it can be argued that retouching the photographs was a copyrightable input. Unfortunately, the problem with the *Strauss* decision is that the court failed to even reach this argument. If the court had discussed this point and concluded that the retouching of the photographs was a tangible expression worthy of a copyright, and because of this fact made the magazine a joint author, there would be no inconsistency between this case and other joint authorship cases. The court, however, failed altogether to acknowledge the existence of a copyrightable input requirement in the joint authorship definition.

¹⁰² Photographs fall within the definition of subject matter which can be copyrighted. See 17 U.S.C. § 102(a) (1988).

a copyrightable input¹⁰³ illustrates that courts have different notions as to what kinds of input should be rewarded. Fortunately, no court has followed the *Strauss* decision. However, similar unjust decisions could occur if the 1976 Act's definition of a joint work is not amended to expressly include the copyrightable input requirement recognized by the majority of courts.¹⁰⁴

IV. PROBLEMS ENCOUNTERED IN JOINT AUTHORSHIP SITUATIONS

Now that it will be harder for commissioning parties to achieve copyright ownership under the work-for-hire doctrine in the wake of *Reid*, they may seek to have courts declare them joint authors along with the artists.¹⁰⁵ The drafters of the 1976 Act understood that there can be more than one author of a work and tried to establish a system which would reward all the contributing members equally.¹⁰⁶ Although in terms of economic efficiency establishment of an artist and his commissioning party as joint authors may be desirable,¹⁰⁷ serious negative ramifications may also result. Courts should consider the problems encountered in a joint authorship situation to avoid conferring joint authorship status too frequently.

A. *Loss of Incentive for Artists*

Copyright law is designed to ensure that the owner of a copyright "has the exclusive rights to do and to authorize" the reproduction, distribution, performance and display of the work as well as to prepare derivative works.¹⁰⁸ One of the main purposes of copyright law is to give artists incentive by rewarding their creative work.¹⁰⁹ If a commissioning party is made a joint

¹⁰³ See *supra* notes 51-81 and accompanying text.

¹⁰⁴ For a discussion of a proposed amendment to the joint work definition, see *infra* notes 142-59 and accompanying text.

¹⁰⁵ See *supra* note 48 and accompanying text.

¹⁰⁶ "[T]he source of copyright ownership is the author of the work, and . . . in the case of a 'joint work,' the coauthors of the work are likewise coowners of the copyright." H.R. REP., *supra* note 16, at 5736; S. REP., *supra* note 16, at 103. See Note, *Joint Authorship of Commissioned Works*, 89 COLUM. L. REV. 867, 879 (1989) (authored by Julie Katzman) [hereinafter *Joint Authorship*].

¹⁰⁷ In the situation of a commissioning party and a hired party, "[j]oint authorship . . . enables the better exploiter[, often the commissioning party with the funds,] to benefit society [by disseminating the work] without eviscerating the legislative policy of entitling creators of commissioned works." *Joint Authorship*, *supra* note 106, at 878. *Contra* Case-note, *The Work Made for Hire Doctrine: Incentive and Concern*, 62 TEMP. L. REV. 377, 401 (1989) (authored by Thomas F. Doyle) (discussing situation of joint owners and suggesting that "[s]uch a fractionalization of copyright interests would defeat the policy concerns of the 1976 Act.").

¹⁰⁸ 17 U.S.C. § 106(1)-(5) (1988).

¹⁰⁹ Brief *Amici Curiae* of the American Society of Magazine Photographers and the

author with an artist, the artist becomes only one of two parties with exclusive rights in the work. Each joint author has the right to license the work without permission of the other joint author.¹¹⁰ The licensing joint author must always account for the profits, but the disapproving author has no veto power to block the transfer. The same is true for a termination of a transfer of an agreement, because a "majority approval of the termination by the authors, or the persons entitled to exercise their rights, may terminate the transfer or license."¹¹¹

"[I]n order to survive, freelancers must retain all remaining rights to ensure their own ability to benefit financially from future uses of their work."¹¹² If joint authorship is found more frequently than is warranted, artists will lose the considerable advantages of an exclusive copyright.¹¹³ This could negate the incentive to create that copyright law has tried to establish.¹¹⁴

Copyright Justice Coalition in support of the respondent at 7-8, *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485 (D.C. Cir. 1988) (No. 87-7051) [hereinafter ASMP and CJC Brief]. Copyright protection is derived from the clause of the Constitution which grants Congress the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8. See *The Battle Over Joint Ownership*, *supra* note 48, at 7, col. 1.

¹¹⁰ 1 NIMMER, *supra* note 25, § 6.10, at 6-22. For simplicity, this Note speaks of the situation with only two authors, but this can occur with any number of authors.

¹¹¹ Comment, *Joint Ownership of Computer Software Copyright: A Solution of the Work For Hire Dilemma*, 137 U. PA. L. REV. 1251, 1273 (1989) (authored by Stacy L. Jarett) [hereinafter *Joint Ownership*]. See 17 U.S.C. § 203(a)(1) (1988). For the purpose of this Note, one of two authors is considered a majority.

¹¹² ASMP and CJC Brief, *supra* note 109, at 3. Most artists in a commissioning situation, photographers for example, are:

generally not accorded employment benefits. They are not paid a regular salary . . . and must purchase their own cameras and laboratory equipment. They are responsible for all of the overhead expenses associated with running a business, [and] must pay the costs of their own health and liability insurance Given these responsibilities and limited resources, the entrepreneurial risks assumed by [American Society of Magazine Photographers] members when they accept a commissioned project are far greater than those of the publisher or advertising agency in undertaking that project.

Id. at 1.

Moreover, the inability to retain all copyright rights threatens freelancers' very ability to earn a living. They rely heavily for basic living expenses on the income-producing potential of their works through reuse fees, creation and distribution of derivative works, and royalty payments from licensing arrangements. Retention of copyright rights and the potential income such rights may generate over many years is the only reliable source of sustained income that many freelancers have.

Id. at 3. Therefore, artists should not be forced to relinquish a nonexclusive interest in a copyright.

¹¹³ Since joint authorship is likened to a tenancy in common, all authors receive a nonexclusive interest in the whole with no survival interest.

¹¹⁴ Brief of the Copyright Justice Coalition as *Amicus Curiae* in support of the respondent at 16, *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485 (D.C. Cir. 1988) (No. 87-7051) ("[T]he central purposes of the copyright laws . . . are to encourage

Thus, misapplication of joint authorship runs contrary to the incentive goals of copyright law.

An overexpansive definition of joint authorship would interfere with other aspects of copyright law. Due to the tremendous impact of joint authorship on a person's exclusive rights to her works, the decision to find joint authorship should be well-reasoned and documented. Only one who is actually a joint author should be allowed to dilute the exclusive rights of another author. "The Constitution, after all, speaks of 'Authors and Inventors,' not purveyors."¹¹⁵

B. *Inconsistencies Within the 1976 Act*

The fact that there is currently no explicit statutory copyrightable input requirement for one to be deemed a joint author creates inconsistencies in the judicial application of the joint work provision and within the larger framework of copyright law itself. In the absence of such a clear statutory requirement, courts and commentators have been split as to whether there is a copyrightable input requirement in joint authorship situations.¹¹⁶ Thus, there is no consistent precedent to guide future artists and commissioning parties.

Furthermore, the absence of a copyrightability requirement for contributions of joint authors creates an inconsistency within the overall framework of copyright law. While there is a requirement of copyrightability in the legislative history of the derivative work and compilation definitions, no such requirement is clearly stated in relation to joint works.¹¹⁷ This interpretation of the joint work provision, which results in disparate treatment of authors of different types of works, particularly disadvantages artists of commissioned works and should therefore be explicitly justified.

Like joint works, compilations and derivative works are the product of more than one individual. In the case of derivative works, however, both the original author and the author of the derivative work must make an original contribution to gain copyright ownership. The 1976 Act explains that "[t]he copyright in

creative activity for the benefit of the public and to ensure fair compensation to creators for their contributions.").

¹¹⁵ ASMP and CJC Brief, *supra* note 109, at 8.

¹¹⁶ See *supra* notes 50-104 and accompanying text.

¹¹⁷ Although many courts apply a standard of copyrightability to joint authorship situations, the 1976 Act and legislative history remain silent on the issue.

a compilation¹¹⁸ or derivative work¹¹⁹ extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work."¹²⁰ Although the statute does not state whether the selection of material or the added material has to meet any standard of originality, the House and Senate Reports state that when "[r]ead together, [sections 102 and 103 of the 1976 Act] make plain that the criteria of copyrightable subject matter stated in section 102 appl[ies] with full force to works that are entirely original and to those containing preexisting material."¹²¹ Therefore, to obtain copyright protection for a compilation or a derivative work, the manner of transformation or arrangement of the prior work or the material added to the preexisting work must be a copyrightable contribution.¹²²

Numerous courts have considered what sort of originality is necessary for compilations and derivative works to merit copyright protection. For example, in *Roth Greeting Cards v. United Card Co.*,¹²³ although the wording used in the cards under consideration was in the public domain, the arrangement of the words in conjunction with the art was found to be original and entitled to copyright protection as a compilation.¹²⁴ Similarly, the court in *Eckes v. Card Prices Update*¹²⁵ held that although the prices of baseball cards were facts which could not be copyrighted, the appellant's original selection and arrangement of the information merited protection as a compilation.¹²⁶

In *L. Batlin & Son v. Snyder*,¹²⁷ the defendant created a plastic

¹¹⁸ "A 'compilation' is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term 'compilation' includes collective works." 17 U.S.C. § 101 (1988) (author's footnote added).

¹¹⁹ "A 'derivative work' is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted." *Id.* (author's footnote added).

¹²⁰ *Id.* § 103(b).

¹²¹ H.R. REP., *supra* note 16, at 5670; S. REP., *supra* note 16, at 57.

¹²² Nimmer compiled a list of contributions which courts have held to be too minimal to warrant a copyright and ones which have constituted sufficient contributions. See 1 NIMMER, *supra* note 25, § 3.03, at 3-10 to -13. Nimmer summarized his list by stating that "the applicable standard in determining the necessary quantum of originality is that of a 'distinguishable variation['] that is more than 'merely trivial.'" *Id.* at 3-12 (quoting *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 102-03 (2d Cir. 1951)).

¹²³ 429 F.2d 1106 (9th Cir. 1970).

¹²⁴ "We conclude that each of Roth's cards, considered as a whole, represents a tangible expression of an idea and that such expression was, in totality, created by Roth." *Id.* at 1110.

¹²⁵ 736 F.2d 859 (2d Cir. 1984).

¹²⁶ *Id.* at 862-63.

¹²⁷ 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976).

reproduction of a cast iron "Uncle Sam" bank that was in the public domain. The court found that "there were no elements of difference that amounted to significant alteration or that had any purpose other than the functional one of making a more suitable (and probably less expensive) figure in the plastic medium."¹²⁸ Where the only changes made were for practical reasons, the court rejected the contention that the additions were original and therefore denied the work copyright protection as a derivative work. More recently, in *Gracen v. Bradford Exchange*,¹²⁹ a painting based upon still photographs from a motion picture was held not to be copyrightable because "a derivative work must be substantially different from the underlying work to be copyrightable."¹³⁰

The courts are not the only forum in which an originality standard for compilations and derivative works is being applied. The Compendium of Copyright Office Practices ("Compendium")¹³¹ instructs that "[a] compilation is registrable if its organization, arrangement, or selection as a whole constitute an *original* work of authorship."¹³² Officers at the Copyright Office are therefore instructed not to register any claim of compilation authorship where the compilation does not appear to constitute an original work of authorship.¹³³

For derivative works, the Compendium requires that a copyright application "should [contain a statement] describ[ing] the material added to [the preexisting work] in which copyright is claimed."¹³⁴ This statement should describe the material being registered and how it satisfies certain criteria, one being that "[t]he material must contain sufficient *original* authorship to be copyrightable."¹³⁵ Furthermore, a circular distributed by the Copyright Office specifies that "[t]o be copyrightable, a derivative work must be different enough from the original to be regarded as a 'new work' or must contain a substantial amount of new material. . . . *The new material must be original and copyrightable in*

¹²⁸ *Id.* at 489.

¹²⁹ 698 F.2d 300 (7th Cir. 1983).

¹³⁰ *Id.* at 305.

¹³¹ Compendium of Copyright Office Practices, Copyright Office (1984 & rev. Feb. 1988). The Compendium is designed to reflect Copyright Office practices under the 1976 Act. "[It] is a manual intended primarily for the use of the staff of the Copyright Office as a general guide to its examining and related practices." *Id.* at preface.

¹³² *Id.* § 625.02, at 600-141 (emphasis added).

¹³³ *See id.* § 625.03, at 600-142.

¹³⁴ *Id.* § 626.04, at 600-151.

¹³⁵ *Id.* § 626.04(2), at 600-151 (emphasis added).

itself.”¹³⁶

The legislature and judiciary have required copyrightable input in cases concerning derivative works and compilations. The same standard should be applied throughout copyright law, specifically to joint works, so as to avoid inconsistencies and inequities. To give artists incentive to create, copyright law must provide consistent protection upon which the artists can rely.

C. *Duty of Accountability*

Another problem encountered by artists in the joint authorship situation is the duty of accountability. This duty may seem straightforward at first,¹³⁷ but there are scenarios in which an accounting can become complicated. One example of this problem is when only part of an original joint work is used separately for another purpose.

[I]f two composers collaborate on a song, one composing the music and the other writing the lyrics, the two create an interdependent joint work. If, however, in the future, the composer of the music licenses a filmmaker to use only the music in the film's soundtrack, the question arises whether the author of the lyrics is entitled to receive half of the royalties earned under such an agreement.¹³⁸

In *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*,¹³⁹ the court discussed in dictum the relationship between separate musical and lyrical contributions to a song intended to be a joint work. The court observed that “[t]he popularity of a song turns upon both the words and the music; the share of each in its success cannot be appraised; they interpenetrate each other as much as the notes of the melody, or separate words of the ‘lyric.’”¹⁴⁰ “Therefore, the music in a song may be desirable as a movie soundtrack because of the popularity of the original song as a whole. The author of the lyrics to the song should be as entitled as the composer to receive an accounting of profits from the music.”¹⁴¹

Since most joint efforts are intended to be joint works and will probably be used that way, the issue of accountability may not occur

¹³⁶ Circular 14, Copyright Registration for Derivative Works, Copyright Office at 2 (Aug. 1988) (emphasis added).

¹³⁷ For a general discussion of a joint author's duty of accountability, see *supra* notes 29-35 and accompanying text.

¹³⁸ *Joint Ownership*, *supra* note 111, at 1271-72.

¹³⁹ 140 F.2d 266 (2d Cir. 1944).

¹⁴⁰ *Id.* at 267.

¹⁴¹ *Joint Ownership*, *supra* note 111, at 1272.

often. Courts and legislators, however, still need to address this problem. The *Marks* case suggested a solution; unfortunately, this was only dictum and has not been endorsed by other courts. Therefore, the intricacies of accounting between joint authors has not been clearly determined.

V. PROPOSED AMENDMENT TO THE 1976 ACT

In the 1976 Act, Congress attempted to address two problems facing the artist of a commissioned work: first, their inferior bargaining position in relation to the party commissioning the work, which resulted from the expansive definition given to the work-for-hire doctrine by courts interpreting the 1909 Act; and second, the particular disadvantages of the freelancer's situation.¹⁴² Despite Congress' attempt to correct these problems, interpretations of the joint work provision such as Nimmer's,¹⁴³ if carried to their logical conclusion, could cause joint authorship to result almost every time an artist is commissioned and thus undermine the goals of the 1976 Act.¹⁴⁴ A commissioning party and the commissioned artist will usually intend to combine their contributions, as most artists want to create a work which will be to the commissioning party's liking. Therefore, the requirements of joint authorship must be defined more narrowly in order to prevent every demanding commissioner from obtaining a joint

¹⁴² See *Joint Authorship*, *supra* note 106, at 875-76.

¹⁴³ For Nimmer's interpretation of the joint work provision, see *supra* notes 83-85 and accompanying text.

¹⁴⁴ Other overly broad interpretations of joint authorship have also been argued. See *Joint Authorship*, *supra* note 106, at 884. One author suggested carrying over to joint authorship the rejected work-for-hire test, applied in *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.), *cert. denied*, 469 U.S. 982 (1984), in which a contractor who sufficiently supervised and directed a hired party was found to be the author of the work in a work-for-hire situation.

In making the determination whether a commissioning party made a more than de minimis contribution to the commissioned work, courts will be faced with the unsettled question [of] whether certain types of contributions typical of commissioning parties may give rise to joint authorship. . . . [T]his question is best resolved by recognizing that actual *control and supervision* over the work of an independent contractor is a contribution sufficient to establish a commissioning party as a joint author of the completed work.

Joint Authorship, *supra* note 106, at 884 (emphasis added). In effect, the "supervision and control" standard would harm the hired artist who interacts closely with the commissioning party by risking forfeiture of part of her rights. Now that the Supreme Court has explicitly rejected this "actual control" standard in the work-for-hire cases, *Community for Creative Non-Violence v. Reid*, 109 S. Ct. 2169, 2174 (1989), there is no reason for the courts to embrace this standard for joint authorship. "Nothing in the legislative history reveals any intent to adopt [the] . . . 'supervision and control' test to transmogrify a freelance creator into an 'employee[.]'" ASMP and CJC Brief, *supra* note 109, at 6, or taken further, to change a creator into a joint author.

copyright.¹⁴⁵

Since 1982, Senator Cochran has urged the legislature to enact a law¹⁴⁶ to "ensure that one who actually creates a work of art be considered its author and able to claim the benefits of copyright protection in that work."¹⁴⁷ Senator Cochran introduced his newest measure on June 22, 1989.¹⁴⁸ This bill does not propose a radical change, but rather seeks to clarify the statutory language.¹⁴⁹ "[I]t is a corrective measure designed to restore a more appropriate balance to [the relationship between the rights of the creators and the publishers]."¹⁵⁰

A close reading of the Court's decision in *Reid* suggests the

¹⁴⁵ "Unless the copyrightability standard is scrupulously applied, the danger exists that any commissioned work created with the involvement of the commissioning party (and which is not the subject of a valid work for hire agreement under subsection (2)) will not be owned by the creator as Congress intended, but rather by the creator and the investor jointly, simply by virtue of the latter's involvement in the project." ASMP and CJC Brief, *supra* note 109, at 30 n.17 (citing *Strauss v. The Hearst Corp.*, 8 U.S.P.Q.2d (BNA) 1832 (S.D.N.Y. 1988) as an example of how a commissioning party could receive more rights than Congress intended). For a discussion of *Strauss*, see *supra* notes 87-102 and accompanying text.

¹⁴⁶ In 1982, Senator Cochran first introduced S. 2044 to change the work-for-hire provision of the 1976 Act. S. 2044, 97th Cong., 2d Sess., 128 CONG. REC. 649 (1982). If enacted, this bill would have eliminated three categories from the work-for-hire definition: "(1) a contribution to a collective work, which encompasses magazine articles and anthologized short stories, (2) a part of a motion picture or other audiovisual work, and (3) an instructional text." *Id.* This bill, although sent to the Judiciary Committee, was never acted upon.

In 1983, Senator Cochran introduced S. 2138, 98th Cong., 1st Sess., 129 CONG. REC. 34,442 (1983). This bill, besides eliminating the above stated categories, would have exempted "supplementary work" from the work-for-hire provision. This bill went a step further, allowing parties the freedom to contract away any rights agreed upon, so long as each right was enumerated in the contract with the consideration to be paid. Moreover, S. 2138 would also have added a provision to allow any creator to bring an unjust enrichment action against a commissioning party if the consideration paid "[was] strikingly disproportionate to the profits received." *Id.* at 34,443. This bill never came out of the Judiciary Committee.

In 1986, Senator Cochran introduced S. 2330, 99th Cong., 2d Sess., 132 CONG. REC. S4493 (daily ed. Apr. 17, 1986). This was the first time that the Senator addressed the issue of how courts define joint works. "In order to close another potential loophole in the work-for-hire laws, the bill clarifies the definition of joint work by requiring that, for a specially ordered or commissioned work to be considered a joint work, the parties must expressly so agree in a written instrument prior to commencement of the work." *Id.* at S4494. As with the Senator's other proposed bills amending the 1976 Act, this too was never acted upon.

¹⁴⁷ The Artists' Bill of Rights, *supra* note 11, at 7341.

¹⁴⁸ *Id.* Hearings took place on this bill, but it was never reported by the Judiciary Committee. Senator Cochran will resubmit a similar bill next year.

¹⁴⁹ *Id.* at 7342.

¹⁵⁰ Statement of Senator Thad Cochran before the Subcommittee on Patents, Copyrights and Trademarks, Sept. 20, 1989, dealing with S. 1253, the Artists' Bill of Rights, at 3 (unpublished transcript of speech). Senator Cochran emphasized that "[w]ork made for hire strikes at the heart of the relationship between creators and publishers, and it has been abused and now disrupts that relationship to the detriment of the public. The creative artists of America are being robbed of their incentive to work and their rewards for working. We are all poorer because of it." *Id.* at 4.

need for further clarification of the legislative language. Senator Cochran's bill serves as a response.¹⁵¹ This bill proposes two changes to the joint work definition in the 1976 Act: (1) to be a joint author, one must contribute a copyrightable input; and (2) an author's intention to create a joint work must be set forth in writing before commencement of a project.¹⁵² The first requirement merely codifies the majority of current case law, but the second requirement is not uniformly supported and is essentially unnecessary.

The first change proposed by Senator Cochran, requiring a would-be joint author to add copyrightable input,¹⁵³ would "make explicit what most courts have recognized [a]s implicit in the current definition—that any joint author must make an original (i.e. copyrightable) contribution of authorship to the joint work."¹⁵⁴ Senator Cochran explains that "these clarifications will provide a more predictable working environment for creators of artistic works as well as for those who purchase, commission and disseminate those works."¹⁵⁵ This amendment would also make joint authorship consistent with other related areas of copyright law, such as compilations and derivative works.¹⁵⁶

Senator Cochran's second change calls for a modification of the 1976 Act which would require a written and signed agreement before commencement of a project, manifesting the intention of the parties to create a joint work.¹⁵⁷ The Senator believes that this requirement serves the dual purpose of preventing claims of joint authorship after the commencement or completion of a project by a commissioning party who failed to comply with the work-for-hire provision, and stopping courts from expanding conditions under which joint authorship may be found in order to circumvent the more restrictive work-for-hire definition.¹⁵⁸

As the joint authorship definition now stands, courts are directed to surmise the intention of the parties at the time work began. A written agreement would remove the possibility of er-

¹⁵¹ Goldberg, *Work for Hire Resolved?*, 202 N.Y.L.J. 4, col. 5 (July 21, 1989).

¹⁵² The Artists' Bill of Rights, *supra* note 11, at 7341. The other main purpose of this bill is to make four changes in the work-for-hire provision of the 1976 Act. *Id.* Discussion of these changes, however, is beyond the scope of this article.

¹⁵³ *Id.* at 7343.

¹⁵⁴ *Id.* at 7342.

¹⁵⁵ *Id.* at 7341.

¹⁵⁶ For a discussion of the requirement of copyrightable input for compilations and derivative works, see *supra* notes 117-36 and accompanying text.

¹⁵⁷ The Artists' Bill of Rights, *supra* note 11, at 7344.

¹⁵⁸ *Id.*

ror, thereby preserving the parties' true intentions in an area wrought with emotion and uneven bargaining power. Furthermore, requiring such written agreements could also make the courts' task much easier and subsequent court decisions more consistent and reliable.

It may not require great effort to draw a written agreement regarding copyright ownership in advance of creation, however, one might argue that requiring such an agreement is still too burdensome because it is unnecessary. Once a statutory copyrightable input requirement is in place, artists should not need any further protection from commissioning parties. Senator Cochran is concerned that, unless legislative action is taken, courts may start treating joint authorship as if it is just another name for the work-for-hire doctrine, but in this instance he failed to make the differentiation himself. A written agreement is vital to establish the existence of a work for hire, because there is no copyrightable input requirement and, therefore, no objective proof of intent after the work is created unless there is such an agreement. Such a written agreement, however, should not be required as long as the party seeking interest in a joint copyright has contributed a copyrightable input.¹⁵⁹ Once one party allows another party's copyrightable input to be incorporated into a work, a court should presume that the parties intended to create a joint work. Furthermore, once a second party's copyrightable input has been incorporated into a work, that party has earned the right to be a joint author of that work.

VI. CONCLUSION

"[R]ecognition of commissioning parties as joint authors rewards their special contributions without wholly divesting primary authors."¹⁶⁰ This is true, but such recognition is not always appropriate. Commissioning parties can be joint authors, but they should earn such rights by actually helping to create the tangible work. The federal copyright system is designed to establish an incentive for authors to create. Authors, however, must be aware of such an incentive and be able to rely on it so that they can produce the desired result—to create original works.

Congress should enact a bill such as the Artists' Bill of

¹⁵⁹ "Even the Register of Copyrights believes that a written agreement before commencement of a joint work is impractical." Hartnick, *Works for Hire: The Reid Case and What to do About it*, 62 N.Y. ST. B.J. 39, 42 (1990).

¹⁶⁰ *Joint Authorship*, *supra* note 106, at 877.

Rights proposed by Senator Cochran. This bill, by codifying the requirement of a copyrightable input, will effectively correct the current lack of clarity in determining joint authorship and halt the potential for inconsistency in court decisions. Although the requirement of a written stipulation is not overly burdensome, once a copyrightable input is a requirement for a joint author, it is simply unnecessary.

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