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Joint Works Under United States Copyright Law: Judicial Legislation Through Statutory Misinterpretation

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JOINT WORKS UNDER UNITED STATES COPYRIGHT LAW: JUDICIAL LEGISLATION THROUGH STATUTORY MISINTERPRETATION

MICHAEL LANDAU¹

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I. INTRODUCTION

Among the most hotly litigated issues in copyright law are those related to ownership. When a lone author, artist, composer, or programmer, with his or her own funds, creates a work, the issue of initial ownership is an easy one. The creator is the statutory “author,” and its creator owns the work. However, when more than one person or entity is involved in the creative process, the ownership issues become a bit murky, due to uncertainty with regard to interpretation of the relevant statutes in the Copyright Act of 1976.² The litigated ownership issue of the 1980s was “works made for hire.”³ After an intercircuit split in which four different standards were being applied by the appellate courts,⁴ in 1989, in *Community for Creative Non-*

² See Rosemary J. Coombe, *Fear, Hope and Longing for the Future of Authorship and a Revitalized Public Domain in Global Regimes of Intellectual Property*, 52 DEPAUL L. REV. 1171–72 (2003) (explaining that the concept of authorship may be too narrow).

³ The “works made for hire” doctrine dealt with the questions of who owns copyrights in a work that is created by an independent commissioned contractor, and, for purposes of the statute, what is an “employee.”

⁴ These standards were: the right to supervise and control standard (*Peregrine v. Lauren*, 601 F. Supp. 828 (D. Colo. 1985)); the actual supervision and control standard (*Evans Newton, Inc. v. Chicago Sys. Software*, 793 F.2d 889 (7th Cir. 1986), *cert. denied*, 479 U.S. 949 (1986); *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir. 1984), *cert. denied*, 469 U.S. 982 (1984)); the Restatement of Agency § 220 standard (*Easter Seal Soc’y for Crippled Children and Adults, Inc. v. Playboy Enter.*, 815 F.2d 323 (5th Cir. 1987), *cert. denied*, 485 U.S. 981 (1988);

Violence v. James Earl Reid,⁵ the United States Supreme Court finally resolved the issue, applying the Fifth and D.C. Circuits' "Restatement of Agency § 220" standard.⁶ As a result of the *Reid* case, many parties who thought that they were the "authors" and owners of works were left without any copyright interests whatsoever.⁷

In order to attempt to have an authorship interest in the work, parties with undefined or questionable rights to the works have brought actions under the "joint works" doctrine. Consequently, the new "hot" ownership issue in copyright law is "what is a joint work?" Courts and commentators are presently in disagreement over the

Cnty. for Creative Non-Violence v. Reid (C.C.N.V.), 846 F.2d 1485 (D.C. Cir. 1988), *aff'd*, 490 U.S. 730 (1989)); and the formal salaried employee standard (*Dumas v. Gommerman*, 865 F.2d 1093 (9th Cir. 1989)). The formal salaried employee standard followed by the Ninth Circuit was the standard advocated by the Copyright Office in the Supreme Court litigation.

⁵ 490 U.S. 730 (1989).

⁶ For a discussion of the "works made for hire" doctrine and its shortcomings, *see generally*, Michael B. Landau, *Works Made for Hire after Community for Creative Non-Violence v. James Earl Reid: The Need for Statutory Reform and the Importance of Contract*, 9 CARDOZO ARTS & ENT. L.J. 107 (1990).

⁷ *See* 17 U.S.C. § 106 (2012) (Subject to sections 107 through 120, the owner of a copyright under this title has the exclusive rights:

- (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
- (4) In the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly
- (5) In the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly
- (6) In the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.).

requirements for joint authorship. The recent trend among the courts, first articulated by the Second Circuit in *Childress v. Taylor*,⁸ is to apply a two-prong test for determining whether a work is a “joint work”: (1) each of the contributions of the respective collaborators must be independently copyrightable, and (2) there must be intent, at the time of creation, that the parties be joint authors.

Both prongs of the standard are at odds with the express language of the statute and the legislative intent of the United States Congress. As a result, numerous co-authors are being denied the benefits of their labors or creations by judges who have misconstrued the “joint works” doctrine. In addition, there is more uncertainty regarding the status of collaborative works than ever before, because of the undue emphasis and reliance by the courts on prong two, the “intent” prong. If the court stops the analysis at a determination of lack of intent and does not deal with the contributions of the collaborators, the rights of both parties are unclear, and the possibility that neither party may employ the entire work lurks as a distinct possibility.⁹ In addition, the fact that different courts have different interpretations will lead to forum shopping and uncertainty. The “joint works” doctrine must be clarified and uniformly applied in all jurisdictions.

II. JOINT WORKS CASES PRIOR TO THE 1976 ACT

The law of joint authorship, prior to the enactment of the 1976 Act, was derived from common law principles. The doctrine was primarily formulated by the federal courts in New York, with Judge Learned Hand being largely responsible. The first major “joint

⁸ 945 F.2d 500, 504–06 (2d Cir. 1991).

⁹ See Benjamin E. Jaffe, *Rebutting the Equality Principle: Adapting the Co-Tenancy Law Model to Enhance the Remedies Available to Joint Copyright Owners*, 32 CARDOZO L. REV. 1549, 1550–52 (2011) (arguing that a real property co-tenancy model of ownership of joint works would eliminate the limited remedies provided by the accounting remedy’s “on-off switch” by placing too much weight on the determination of joint authorship and equal co-ownership instead of recognizing the inevitable unequal contributions to a work).

authorship” case was *Maurel v. Smith*,¹⁰ a case before the Southern District of New York in 1915. In *Maurel*, the plaintiff wrote the story for a comic opera and made an agreement with the defendant to write the libretto. The plaintiff contended that the parties agreed to be joint authors. The defendant, without plaintiff’s knowledge or consent, finished the libretto and contracted with another party to publish and copyright the entire opera.

Judge Learned Hand held that the parties had, indeed, agreed to be joint authors.¹¹ Because there was a dearth of United States law on the subject, Judge Hand relied upon English law to reach his decision. Judge Hand cited *Levy v. Rutley*¹² for the proposition that joint authorship exists when parties contribute labor to work under a common and preconcerted design.¹³ Judge Hand found such “joint labor” and common design in the facts of the case.¹⁴ The plot and libretto met the criteria.¹⁵

Later, in *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*,¹⁶ the doctrine was further developed. In *Marks*, the plaintiff was a lyricist and sold words to a music publisher.¹⁷ The publisher, without plaintiff’s knowledge or consent, hired a composer to write accompanying music.¹⁸ The combination of words and music was then copyrighted as a single song.¹⁹ Judge Hand, this time sitting on the Second Circuit, found the combination of words and music to be a

¹⁰ 220 F. 195 (S.D.N.Y. 1915).

¹¹ *Id.* at 197–98.

¹² L.R. 6 C.P. 523 (1871).

¹³ *See Maurel*, 220 F. at 199–200.

¹⁴ *Id.*

¹⁵ *See id.*

¹⁶ 140 F.2d 266 (2d Cir. 1944).

¹⁷ *Id.* at 266.

¹⁸ *Id.*

¹⁹ *Id.* at 266–67.

“joint work.”²⁰ He stated that it was not relevant to the determination that the words and the music were not written at the same time or that the two “authors” did not work together, if the authors meant for their respective works to be combined in a single finished product.²¹ Because the lyricist gave the words to the publisher with the intent that they be put to music, it was held that, from the start, each contributor intended the work to be performed as a whole.²² Under *Marks*, therefore, it was not necessary for the authors of a “joint work” to have worked together or even, for that matter, to have been acquainted with each other for the work to legally be classified as a “joint work.”²³

The doctrine was broadened in *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co. (“Shapiro I”)*,²⁴ yet another decision to which Judge Hand contributed. In *Shapiro I*, commonly called the “Melancholy Baby Case,” a composer named Ernie Burnett wrote the music and his wife wrote the lyrics to a song they called “Melancholy.”²⁵ The song was sold to a publisher.²⁶ The publisher was unhappy with the lyrics and, with the consent of the composer, Burnett, hired a lyricist named Norton to create new lyrics to go along with Burnett’s melody.²⁷ The new version of the song, consisting of Norton’s lyrics and Burnett’s music, was retitled “Melancholy Baby” and became wildly famous.²⁸ Later, when a copyright dispute arose over ownership of the copyrights in the new song, the Second Circuit held that Burnett and Norton were the joint owners of the song.²⁹

²⁰ *Id.* at 267.

²¹ *Id.*

²² *Marks*, 140 F.2d at 267.

²³ *See id.*

²⁴ 161 F.2d 406 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947).

²⁵ *Id.* at 407.

²⁶ *Id.* at 408.

²⁷ *Id.*

²⁸ *Id.* at 407–08.

²⁹ *Id.* at 410.

Burnett's wife did not have an ownership interest based upon her first version of the lyrics.³⁰

In some ways, the case is similar to *Marks*. Under Second Circuit law at the time, all that was necessary for the work to be considered a "joint work" was that each author have knowledge that his or her work would be used in combination with another's as part of a larger unitary whole. The *Shapiro I* case expands *Marks*, in that it holds:

[I]f author A intended from the beginning to work with author B, but later author C's work is substituted for that of author B's work, then A and C will be considered joint authors of the work that they created. It was not necessary that A and C originally collaborated because A had the intent to put his music with someone's lyrics, and C wrote his lyrics intending to combine it with A's music. It does not matter that A originally wanted to combine his music with B's lyrics, since he still wanted to create a unitary work. A, therefore, had the necessary intent for a preconcerted, common design. A was in collaboration with C, not because he consented to the addition of C's lyrics, but because he had the prior intent to combine his work with that of another.³¹

The doctrine was again further liberalized in *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co. ("Shapiro II")*,³² commonly known as the "12th Street Rag" case — a completely different case involving the same parties. In *Shapiro II*, a composer wrote piano music, with no intention whatsoever of having it joined with lyrics.³³ The piece, as

³⁰ See *Shapiro I*, 161 F.2d at 410.

³¹ Scott C. Brophy, *Joint Authorship Under the Copyright Law*, 16 HASTINGS COMM. & ENT. L.J. 451, 457 (1994) (hereinafter "Brophy").

³² 221 F.2d 569 (2d Cir. 1955).

³³ *Id.* at 570.

written, was intended for solo piano.³⁴ As was common, the composer assigned his copyrights to his publisher.³⁵ The publisher, against the composer's wishes, hired a lyricist to write words to go along with the melody.³⁶ The Second Circuit held that this, too, was a "joint work."³⁷

The *Shapiro II* decision stretched the "joint works" doctrine as far as it could go. A combined work could be considered to be a "joint work" even if one of the creators of a component part *did not have any intent to merge* his or her part into a larger unitary whole. In addition, it allowed the assignee of the composition to have the necessary intent, as opposed to the author himself or herself. *Shapiro II*, in essence, eliminated any requirement of collaboration on the part of the parties involved.

Following *Shapiro II*, another music case arose in the Southern District of New York. In *Picture Music Inc. v. Bourne, Inc.*,³⁸ an employee for Walt Disney Productions wrote the words and music to a song that was to be used in the Disney cartoon, *The Three Little Pigs*.³⁹ After hearing the song, two writers working for the publishing company, Irving Berlin, Inc., made some changes to the song to make it more fitting for sale as a "popular song."⁴⁰ Disney subsequently assigned the rights to the song to the Berlin Company.⁴¹ During the last year of the first term of copyright, when it was time to file for renewal, the assignee of one of the writers at Berlin who had modified the song claimed a "joint authorship" interest.⁴²

³⁴ *Id.*

³⁵ *See id.*

³⁶ *Id.*

³⁷ *Id.* at 570–71.

³⁸ 314 F. Supp. 640 (S.D.N.Y. 1970), *aff'd*, 457 F.2d 1213 (2d Cir. 1972), *cert. denied*, 409 U.S. 997 (1972).

³⁹ *Id.* at 642.

⁴⁰ *Id.*

⁴¹ *Id.* at 643.

⁴² *Id.*

The court criticized the “12th Street Rag” case’s elimination of the collaboration requirement but avoided trying to get around precedent by simply claiming that, under the facts of the case, a holding of “joint authorship” was not warranted because the writers at Berlin had not made a substantial enough contribution to the song to be given an authorship interest.⁴³ The court in *Picture Music*, therefore, despite criticism of *Shapiro II*, might have been compelled to apply it, had there been a substantial contribution to the song by a party other than the original author.⁴⁴ It is interesting to note that the concept of “substantial contribution” was also the center of another music case involving the *Bourne* publishing company in the 1990s, *Woods v. Bourne, Inc.*⁴⁵ In that case, involving the termination rights exception under section 304(a) of the Copyright Act of 1976, the court held that the additions of harmony and accompaniment to the “lead sheet” (lyrics and melody) of a song were not “sufficiently original” to qualify for separate copyright protection as a “derivative work.”⁴⁶

III. JOINT WORKS UNDER THE 1976 ACT

A. Section 101 and the Legislative History

The 1976 Copyright Act, which took effect on January 1, 1978, was a huge reworking of many principles of copyright law.⁴⁷

⁴³ See *id.* at 647.

⁴⁴ See generally *Shapiro II*, 221 F.2d at 570.

⁴⁵ See *Woods v. Bourne, Inc.*, 841 F. Supp. 118 (S.D.N.Y. 1994), *aff’d in relevant part*, 60 F.3d 978 (2d Cir. 1995).

⁴⁶ *Id.* at 122–23.

⁴⁷ See generally Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857 (1987) (summarizing changes made in the 1976 Copyright Act, Litman calls the act comprehensive and starkly different from its 1909 predecessor and the result of more than 10 years of legislative history; further positing judicial interpretation of language contained within the act may lack historical context because new legal regimes in employment law were created during the bill’s journey through Congress into law).

Judicially created doctrines such as “fair use” and “joint works” were codified in the new Act. The statutory definition of “joint work” is contained in section 101:⁴⁸

A “joint work” is 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.⁴⁹

The statute is relatively unambiguous. The only requirement, according to the express language, is that the collaborators manifest an intent to merge the work. According to the legislative history, the requisite intent will be found “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.’”⁵⁰ In order for the work to be classified as a “joint work,” the desire to make the contributions part of a single end

⁴⁸ 17 U.S.C. § 101 (2012).

⁴⁹ *Id.*; *Childress*, 945 F.2d at 505 (citing H.R. REP. NO. 1476, at 120 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5736) (“Parts of a unitary whole are ‘inseparable’ when they have little or no independent meaning standing alone. That would often be true of a work of written text, such as the play that is the subject of the pending litigation. By contrast, parts of a unitary whole are ‘interdependent’ when they have some meaning standing alone but achieve their primary significance because of their combined effect, as in the case of words and music of a song. Indeed, a novel and a song are among the examples offered by the legislative committee reports of the 1976 Copyright Act to illustrate the difference between ‘inseparable’ and ‘interdependent’ parts.”).

⁵⁰ See Stacy L. Jarret, *Joint Ownership of Computer Software Copyright: A Solution to the Work for Hire Dilemma*, 137 U. PA. L. REV. 1251, 1269 (1989) (quoting H.R. Rep. No. 1476, at 120) (hereinafter “Jarret”); see also Nancy Perkins Spyke, *The Joint Work Dilemma: The Separately Copyrightable Contribution and Co-Ownership Principles*, 40 J. COPYRIGHT SOC’Y U.S.A. 463, 466-67 (1993) (hereinafter “Spyke”); see generally Shari Eileen Fine, *The Fate of Joint Authorship After Community for Creative Non-Violence v. Reid*, 9 CARDOZO ARTS & ENT. L.J. 151 (1990).

product must be evidenced at the time of creation.⁵¹ As commentators have noted, “the legislature considered a joint work to exist where each party has the intention, at the time the writing is done, that his or her part be absorbed or combined into an integrated unit.”⁵²

Furthermore, the legislative history behind the Copyright Act makes it clear that Congress intended to reject the “12th Street Rag” doctrine. Where there is a significant temporal difference between the creation of the different parts of a work and no intention to combine these parts into a final “unitary whole,” the work will probably not be considered to be a joint work. For example, according to the House Report: “[A]lthough 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 was behind the writing of the work for motion picture use.”⁵³

In addition, the Register of Copyrights’ 1961 Report—when Congress was already in the process of beginning to revise the Act—stated that the copyright register would not go as far as the “12th Street Rag” decision, but would follow the rules as developed in the previous case law.⁵⁴ Thus, it is clear that the case law, as established by Judge Hand in the Second Circuit, with the exception of the later “12th Street Rag” case, has been codified by the 1976 Copyright Act. It should also be noted that the statute does not say anything regarding the amount of work contributed by each author. Therefore, there is no requirement that each author contribute the same amount of work to the end product. The traditional view is that each respective

⁵¹ See Jarret, *supra* note 50 at 1269–70.

⁵² See William J. Dockery, *The Importance of a Written Agreement When Collaborators Created a Copyrighted Work in the Performing Arts*, 28 ENT. & SPORTS L. 8, 9 (2010–2011) (citing H.R. REP. NO. 1476, at 120 ; S. REP. NO. 473, at 103 (1976)).

⁵³ H.R. REP. NO. 1476, at 120.

⁵⁴ REGISTER OF COPYRIGHTS, 87TH CONG., REPORT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 90 (Comm. Print. 1961).

contribution be at least something more than a *de minimis* contribution.⁵⁵

A determination that the work is a “joint work” means that the authors are tenants-in-common.⁵⁶ Each party may exploit the work as he or she desires, subject to a duty to account to the other joint author(s).⁵⁷ An exception is that a joint author may not assign the work or grant an exclusive license to the work without permission of the other authors.⁵⁸ In addition, each party, as a matter of law, will own a *pro rata* share of the final work.⁵⁹ On the other hand, if the work is determined not to be a joint work, then a court should decide the respective rights of the parties—something that has been avoided in many of the recent cases.

B. Disagreement Among the Commentators

The primary reference books on Copyright, authored respectively by Paul Goldstein,⁶⁰ William Patry,⁶¹ and David

⁵⁵ Spyke, *supra* note 50, at 466 (citing *Words & Data, Inc. v. GTE Comm’ns Serv., Inc.*, 765 F. Supp. 570, 575 (W.O. Mo. 1991)); see *Greene v. Ablon*, slip op., 2012 WL 4104792 at *11 (D. Mass. Sept. 17, 2012) (Even the parsimonious allegation of a fifteen page book contribution was “well above the ‘more than a word or a line’ guideline for determining whether a contribution is *de minimis*.”). This is also the position taken by Professor Nimmer in his treatise. See also MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 6-07 (2012); but see 1 PAUL GOLDSTEIN, *COPYRIGHT: PRINCIPLES, LAW & PRACTICE* § 4.2.1.2, at 379 (1989) (Goldstein takes a different view, that of independent copyrightability). The competing reference works are discussed *infra* Section 3(B).

⁵⁶ See *C.C.N.V.*, 846 F.2d at 1498 (“Joint authors co-owning copyright in a work ‘are deemed to be tenants in common,’ with ‘each having an independent right to use or license the copyright, subject only to a duty to account to the other co-owner for any profits earned thereby.’”).

⁵⁷ See *Oddo v. Ries*, 743 F.2d 630, 633 (9th Cir. 1984).

⁵⁸ See *id.*

⁵⁹ See *id.*

⁶⁰ See PAUL GOLDSTEIN, *COPYRIGHT* (2d ed. 2000) [hereinafter GOLDSTEIN].

⁶¹ See WILLIAM F. PATRY, *PATRY ON COPYRIGHT* (2012).

Nimmer,⁶² take different approaches to the “independently copyrightable” requirement. Professor Goldstein states that “a collaborative contribution will not produce a joint work, and a contributor will not obtain a co-authorship interest, unless the contribution represents original expression that could stand on its own as the subject matter of copyright.”⁶³ According to Goldstein, the use of the word “author” in section 101⁶⁴ and 302(b)⁶⁵ “implies that the contributor of each must be a copyrightable ‘work of authorship’ within the terms of section 102(a).”⁶⁶ Goldstein justifies this position

⁶² See MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT (2012) [hereinafter Nimmer].

⁶³ GOLDSTEIN, *supra* note 60, § 4.2.1.2, at 4:16. *But see* H.R. REP. NO. 1476, at 120 (“[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’”).

⁶⁴ 17 U.S.C. § 101 (2010).

⁶⁵ 17 U.S.C. § 302(b) (2012).

⁶⁶ GOLDSTEIN, *supra* note 60, § 4.2.1.2, at 4:17. *See* 17 U.S.C. § 102(a) (2012) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in a tangible medium of expression. . . .”); Mary LaFrance, *Authorship, Dominance, and the Captive Collaborator: Preserving the Rights of Joint Authors*, 50 EMORY L.J. 193, 197 (2001) (“[U]nder the Goldstein test, a person can be a joint author only if he or she contributed at least some element of copyrightable creative expression to the putative joint work. In other words, a collaborator who contributes only ideas or facts cannot use another collaborator’s particularized expression of that material to provide the ‘work of authorship’ necessary to bestow authorship status.”); *see also* Jaffe, *supra* note 9, at 1561 n.82 (citing Goldstein, *supra* note 60, § 4.2.1.2) (“While the courts following the Goldstein view require a claimant seeking joint authorship to show that each putative co-author made an independently copyrightable contribution to the work, there is no requirement that the claimant show these independently copyrightable contributions were equal.” Thus, “the problem with the current accounting remedy exists regardless of which school the courts adopt because joint authors inevitably make unequal contributions, whether or not they are separately copyrightable.”); *see generally* 17 U.S.C. § 102(b) (2012) (providing that copyright does not attach to facts, ideas, systems, and methods).

by arguing that any material that does not meet “the Copyright Act’s copyrightability standard falls within the public domain, which any author is entitled to use without having to share proceeds from the work’s exploitation.”⁶⁷ Therefore, under the Goldstein standard, an author who contributes the idea for a work cannot be a joint author because ideas are not copyrightable.⁶⁸ William Patry also expounds the “independent copyrightability” standard in his book:⁶⁹

In order to be a “joint” author, one must be an “author.” To be an author, one must independently create and contribute at least some minimal amount of expression. The requirement that each joint author contribute expression has important policy and constitutional implications. From a policy perspective, the requirement ensures that the scope of the joint authorship doctrine is not expanded to include editors, research assistants, actors in plays, and movie consultants. Instead, reward for such contribution is left to contract.⁷⁰

In contrast, Professor Nimmer takes the view that each author need not make a copyrightable contribution.⁷¹ Nimmer points out that neither the Copyright Act of 1976 nor legislative history of the Act provides support for the proposition that an author must make a

⁶⁷ Norbert F. Kugele, *How Much Does It Take?: Copyrightability as a Minimum Standard for Determining Joint Authorship*, 1991 U. ILL. L. REV. 809, 820 (1991) (citing GOLDSTEIN, *supra* note 60, § 4.2.1.2, at 4:17) [hereinafter Kugele]; *see also* Brophy, *supra* note 31, at 465.

⁶⁸ For several cases supporting Goldstein’s view, *see* *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231 (9th Cir. 2000) (discussed *infra*), *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 521 (9th Cir. 1990); *S.O.S. Inc. v. Payday, Inc.*, 886 F.2d 1081, 1087 (9th Cir. 1989).

⁶⁹ *See* WILLIAM F. PATRY, PATRY ON COPYRIGHT § 5-14 (2012).

⁷⁰ *Id.*

⁷¹ Nimmer, *supra* note 62 § 6.02

copyrightable contribution.⁷² He points to the definition of “joint work” in section 101 of the 1976 Act, which contains no separate requirement that each putative collaborator contribute something that can stand alone as being independently copyrightable.⁷³ “Congress made ‘intention’ the touchstone of joint authorship status while saying nothing of a copyrightable contribution requirement.”⁷⁴

Nimmer does, however, have a standard for each collaborator. Each author’s contribution must merely be more than *de minimis*.⁷⁵ “More than *de minimis*” means more than a few simple words or phrases.⁷⁶ According to Nimmer, contributing ideas, which in themselves may not be independently copyrightable, may make one a “joint author” if the party contributing the idea had the proper intent to collaborate the intent to merge the contribution into a part of a unitary whole.⁷⁷ Therefore, if one author suggests plot ideas and the other author creates the written story, the parties are joint authors.⁷⁸ The contribution must be one that is creative; a party who contributes financing so that the project may get under way is not a “joint author.”⁷⁹

⁷² *Id.*

⁷³ *Id.*

⁷⁴ See Brophy, *supra* note 31, at 464.

⁷⁵ See NIMMER, *supra* note 62, § 6.07; see also Kugele, *supra* note 67, at 824–25; Brophy, *supra* note 31, at 464–66; Russ Versteeg, *Defining “Author” for Purposes of Copyright*, 45 AM. U. L. REV. 1323, 1333–34 (1996).

⁷⁶ See *id.*

⁷⁷ See NIMMER, *supra* note 62, § 6.07.

⁷⁸ See Brophy, *supra* note 31, at 464–65 (citing NIMMER, *supra* note 62, § 6.07).

⁷⁹ *Id.* See Jaffe, *supra* note 9, at 1558–60 (citing NIMMER, *supra* note 62 at § 6.07) (noting that the prevailing equality standard of co-authorship is “especially troublesome in these situations because in cases where parties have not contracted their rights, it allows a co-author to obtain a fifty percent interest in the work even though his actual contribution may have been negligible,” which then “increases the disparity between an author’s contribution and his economic rewards. . .”).

IV. ILLUSTRATIVE CASES UNDER THE 1976 ACT

The courts are in disagreement over construing the statute. The majority of courts agree with the standards set forth in *Childress v. Taylor*,⁸⁰ that (1) each party's contribution must be independently copyrightable and (2) the parties must have had the intent to be joint owners at the time that the work was created.⁸¹ The *Childress* case and cases that follow are fact intensive, and are discussed in this section.

A. *Childress v. Taylor*

In *Childress*, Clarice Taylor, an actress, developed a character based upon the comedienne Jackie “Moms” Mabley for an off-Broadway performance about the Apollo Theatre in Harlem.⁸² In order to prepare for her role, Taylor conducted extensive historic research about Mabley, including “interviewing her friends and family, collecting her jokes, and reviewing library resources.”⁸³

The court in *Childress* explained the additional facts of the case as follows:

In 1985, Taylor contacted the plaintiff, playwright Alice Childress about writing a play based on “Moms” Mabley. Childress had written many plays, for one of which she won an “Obie” award. Taylor had known Childress since the 1940s when they were both associated with the American Negro Theatre in Harlem and had previously acted in a number of Childress’s plays.

When Taylor first mentioned the “Moms” Mabley project to Childress in 1985, Childress stated

⁸⁰ 945 F.2d 500 (2d Cir. 1991).

⁸¹ *See id.*

⁸² *Id.* at 502.

⁸³ *Id.*

she was not interested in writing the script because she was too occupied with other works. However, when Taylor approached Childress again in 1986, Childress agreed, though she was reluctant due to the time constraints involved. Taylor had interested the Green Plays Theatre in producing the as yet unwritten play, but the theatre had only one slot left on its summer 1986 schedule, and in order to use that slot, the play had to be written in six weeks.

Taylor turned over all of her research material to Childress, and later did further research at Childress's request. It is undisputed that Childress wrote the play, entitled "Moms: A Praise Play for a Black Comedienne." However, Taylor, in addition to providing the research material, which according to her involved a process of sifting through facts and selecting pivotal and key elements to include in a play on "Moms" Mabley's life, also discussed with Childress the inclusion of certain general scenes and characters in the play. Additionally, Childress and Taylor spoke on a regular basis about the progress of the play.

Taylor identify[d] the following as her major contributions to the play: (1) she learned through interviews that "Moms" Mabley called all of her piano players "Luther," so Taylor suggested that the play include such a character; (2) Taylor and Childress together interviewed Carey Jordan, "Moms" Mabley's housekeeper, and upon leaving the interview they came to the conclusion that she would be a good character for the play, but Taylor could not recall whether she or Childress suggested it; (3) Taylor informed Childress that "Moms" Mabley made a weekly trip to Harlem to do ethnic food shopping; (4) Taylor suggested a street scene in Harlem with speakers because she recalled having seen or listened to such a scene many times; (5) the idea of using a minstrel scene came out of Taylor's

research; (6) the idea of a card game scene also came out of Taylor's research, although Taylor could not recall who specifically suggested the scene; (7) some of the jokes used in the play came from Taylor's research; and (8) the characteristics of "Moms" Mabley's personality portrayed in the play emerged from Taylor's research. Essentially, Taylor contributed facts and details about "Moms" Mabley's life and discussed some of them with Childress. However, Childress was responsible for the actual structure of the play and the dialogue.

Childress completed the script within the six-week time frame. Childress filed for and received a copyright for the play in her name. Taylor produced the play at the Green Plays Theatre in Lexington, New York, during the 1986 summer season and played the title role. After the play's run at the Green Plays Theatre, Taylor planned a second production of the play at the Hudson Guild Theatre in New York City.⁸⁴

"At the time Childress agreed to the project, she did not have any firm arrangements with Taylor, although Taylor had paid her \$2,500 before the play was produced."⁸⁵ Both Taylor's and Childress' agents sent letters back and forth with different arrangements with respect to copyright ownership.⁸⁶ Taylor's agent claimed that during their telephone conversation the parties had agreed to the following with respect to ownership: "The finished play shall be equally owned and be the property of both Clarice Taylor and Alice Childress."⁸⁷ Childress's representative responded by saying: "It [wa]s to be understood that pending the proper warranty clauses to be included in the contract Miss Childress is claiming originality for her words only

⁸⁴ *Id.*

⁸⁵ *Id.* at 503.

⁸⁶ *Childress*, 945 F.2d at 503.

⁸⁷ *Id.*

in said script.”⁸⁸ Therefore, there was no clear understanding between the two with respect to ownership or division of rights.

In 1987, the relationship between the two parties deteriorated.⁸⁹ Taylor hired another playwright to work on a “Moms” Mabley script.⁹⁰ Taylor gave the new playwright, Caldwell, a copy of the original script from which to work.⁹¹ A new, revised play was produced, with no mention of Childress in any of the credits.⁹² Childress sued Taylor for copyright infringement, claiming that the copyright to her play had been infringed by the creation and performance of the new work.⁹³ Taylor defended on the grounds that the work was a “joint work” and that, as a joint author, she was free to exploit the play.⁹⁴ In addition, joint authors may not sue each other for copyright infringement.⁹⁵ The district court ruled in favor of the playwright, Childress.⁹⁶

In determining whether Taylor had infringed, the Second Circuit Court of Appeals discussed the standards for whether a work is a “joint work.”⁹⁷ Ultimately, the court came up with two requirements: (1) that each of the parties contribute an independently

⁸⁸ *Id.* (having back-and-forth letters regarding ownership, the two parties defeated the case for mutual intent to be joint owners).

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Childress*, 945 F.2d at 503.

⁹³ *Id.* at 504.

⁹⁴ *Id.*

⁹⁵ See *Cambridge Literary Props., Ltd. V. W. Goebel Porzellanfabrik G.m.b.H & Co. KG.*, 510 F.3d 77, 98 (1st Cir. 2007) (noting that although the Copyright Act “sets forth express remedies available to copyright owners against infringers,” the Act “deliberately omits any comparable express or implied remedy for a co-owner seeking [relief] from a joint copyright owner who has profited from use of the copyright.”).

⁹⁶ *Childress*, 945 F.2d at 504.

⁹⁷ *Id.* at 504–08.

copyrightable contribution and (2) that the parties intended to be joint authors when they were working on their respective contributions.⁹⁸ I address each of these in turn.

1. Independent Copyrightable Contribution

The court noted that the issue was difficult and that the courts⁹⁹ and commentators¹⁰⁰ were split on the issue but that the Register of Copyrights strongly supported this independently copyrightable contribution view, “arguing that it is required by the statutory standard of ‘authorship’ and perhaps by the Constitution.”¹⁰¹ The court then proceeded with its own analysis:

The issue, apparently open in this Circuit, is troublesome. If the focus is solely on the objective of copyright law to encourage the production of creative works, it is difficult to see why the contributions of all joint authors need be copyrightable. An individual creates a copyrightable work by combining a non-

⁹⁸ *See id.*

⁹⁹ The Third Circuit left it as an open issue. *See Andrien v. S. Ocean City Chamber of Commerce*, 927 F.2d 132 (3d Cir. 1991). Other courts have required a copyrightable contribution. *See, e.g., M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1492–93 (11th Cir. 1990); *Ashton-Tate*, 728 F. Supp. at 601; *S.O.S. Inc. v. Payday, Inc.*, 886 F.2d 1081, 1087 (9th Cir. 1989); *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 609 F. Supp. 1307, 1318–19 (E.D. Pa. 1985), *aff’d without consideration of this point*, 797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987); *Kenbrooke Fabrics Inc. v. Material Things*, 223 U.S.P.Q. 1039, 1044–45 (S.D.N.Y. 1984); *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Constr. Co.*, 542 F. Supp. 252, 259 (D. Neb. 1982); *Meltzer v. Zoller*, 520 F. Supp. 847, 857 (D.N.J. 1981).

¹⁰⁰ *Childress v. Taylor*, 945 F.2d 500, 506 (2d Cir. 1991) (citing *NIMMER*, *supra* note 62); Goldstein, *supra* note 60; WILLIAM F. PATRY, *LATMAN’S THE COPYRIGHT LAW* 116 (6th ed. 1986)).

¹⁰¹ *Id.* at 506 (citing *Moral Rights in Our Copyright Laws: Hearings on S. 1198 and S. 1253 Before the Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary*, 101st Cong. 210-11 (1989) (statement of Ralph Oman)).

copyrightable idea with a copyrightable form of expression; the resulting work is no less a valuable result of the creative process simply because the idea and the expression came from two different individuals. Indeed, it is not unimaginable that there exists a skilled writer who might never have produced a significant work until some other person supplied the idea. The textual argument from the statute is not convincing. *The Act surely does not say that each contribution to a joint work must be copyrightable, and the specification that there be “authors” does not necessarily require a copyrightable contribution.* “Author” is not defined in the Act and appears to be used only in its ordinary sense of an originator. The “author” of an uncopyrightable idea is nonetheless its author even though, for entirely valid reasons, the law properly denies him a copyright on the result of his creativity. And the Register’s tentative constitutional argument seems questionable. It has not been supposed that the statutory grant of “authorship” status to the employer of a work made for hire exceeds the Constitution, though the employer has shown skill only in selecting employees, not in creating protectable expression.¹⁰²

Despite the fact that the court found no support in the language of the statute itself and questioned the constitutional requirement argument, the court, nonetheless found it to be more “with the spirit of copyright” to require that each contribution be able to stand alone as copyrightable.¹⁰³

The insistence on copyrightable contributions by all putative joint authors might serve to prevent some

¹⁰² *Id.* (emphasis added).

¹⁰³ *Id.* at 507.

spurious claims by those who might otherwise try to share the fruits of the efforts of a sole author of a copyrightable work, even though a claim of having contributed copyrightable material could be asserted by those so inclined. More important, the prevailing view strikes an appropriate balance in the domains of both copyright and contract law. In the absence of contract, the copyright remains with the one or more persons who created copyrightable material. Contract law enables a person to hire another to create a copyrightable work, and the copyright law will recognize the employer as “author.” Similarly, the person with non-copyrightable material who proposes to join forces with a skilled writer to produce a copyrightable work is free to make a contract to disclose his or her material in return for assignment of part ownership of the resulting copyright. And, as with all contract matters, the parties may minimize subsequent disputes by formalizing their agreement in a written contract. (“[W]ork made for hire” definition of “specially ordered” or “commissioned” work includes requirement of written agreement). It seems more consistent with the *spirit of copyright law* to oblige all joint authors to make copyrightable contributions, leaving those with non-copyrightable contributions to protect their rights through contract.¹⁰⁴

Although the court held that a “copyrightable contribution” was the standard, the court did not evaluate whether Taylor’s contribution met the standard.¹⁰⁵ Instead the court decided the case solely on the “intent” issue.¹⁰⁶

¹⁰⁴ *Id.* (emphasis added) (citations omitted).

¹⁰⁵ *See generally id.*

¹⁰⁶ *Childress*, 945 F.2d at 508. For further discussion regarding “intent,” *see infra* Section 2.

The court is exercising judicial legislation, plain and simple. As the Supreme Court stated in *Stewart v. Abend*¹⁰⁷: “[I]t is not our role to alter the delicate balance Congress has labored to achieve.”¹⁰⁸ Congress easily could have added the requirement of “originality” to the “joint works” definition in section 101,¹⁰⁹ as it did in the definitions of “derivative works” and “collective works,” as well as in section 102(a).¹¹⁰ The fact that Congress did not accept the proposed amendments to section 101, including the requirement of a copyrightable contribution, is further evidence that Congress did not intend to demand that each joint owner's contribution meet the “originality” standard. It should be noted that Congress was not inactive in the copyright field in the late 1980s.¹¹¹ Since that time Congress has been amending the Copyright Act extensively in many area, sometimes with lightning speed.¹¹²

In addition, the court shows that it does not understand how the creative process works.¹¹³ Authors, composers, playwrights, and other creative artists do not usually have lawyers on retainer.¹¹⁴ When they

¹⁰⁷ 495 U.S. 207 (1990).

¹⁰⁸ *Id.* at 230.

¹⁰⁹ *See* 17 U.S.C. § 101.

¹¹⁰ *See* 17 U.S.C. § 102(a) (“Copyright subsists . . . in *original works of authorship*. . . .”) (emphasis added).

¹¹¹ U.S. COPYRIGHT OFFICE, CIRCULAR 92, COPYRIGHT LAW OF THE U.S. AND RELATED LAWS CONTAINED IN TITLE 17 OF THE U.S. CODE (Dec. 2011), *available at* <http://www.copyright.gov/title17/circ92.pdf>.

¹¹² Congress made nearly fifty amendments to Copyright Law between 1984 and 2010. For a complete review of the changes, *see id.* at v–xii.

¹¹³ *See e.g.,* Price v. Fox Entm’t Group, Inc., 473 F. Supp. 2d 446, 458 (S.D.N.Y. 2007) (holding moot the issue of co-ownership of two people who established a production company, registered it as a general partnership, but failed to delineate their ownership interests in movies they created through the production company because the Copyright co-author equitable tolling doctrine requires due diligence).

¹¹⁴ *See* Telephone Interview with Meredith Ragains, Executive Director of Georgia Lawyers for the Arts (Jan. 23, 2014) (noting that a very small percentage of artists retain attorneys to represent them in legal matters).

begin a collaborative project, they attempt to work together to create an aesthetically good work, they do not call legal counsel first.¹¹⁵ Copyright ownership and use issues are the furthest things from most of their minds at the time of creation especially complicated with works related to the performing arts.¹¹⁶

2. Intent to Be Joint Authors

The court engaged in similar judicial legislation when it interpreted the “intent” prong:

The wording of the statutory definition appears to make relevant only the state of mind regarding the unitary nature of the finished work—an intention “that their contributions be merged into inseparable or interdependent parts of a unitary whole.” However, an inquiry so limited would extend joint author status to many persons who are not likely to have been within the contemplation of Congress. For example, a writer frequently works with an editor who makes numerous useful revisions to the first draft, some of which will consist of additions of copyrightable expression. Both intend their contributions to be merged into inseparable parts of a unitary whole, yet very few editors and even fewer writers would expect the editor to be accorded

¹¹⁵ Imagine the old Andy Hardy movies with Judy Garland and Mickey Rooney. Can you imagine one of them saying, “Let’s write a play. Hold on, I need to call my lawyer before we get started.”? I guess in those films, Andy Hardy, the character portrayed by Mickey Rooney, could have asked his dad for help. After all, the character of his father was a judge in the films.

¹¹⁶ See *Tang v. Putruss*, 521 F. Supp. 2d 600, 607 (E.D. Mich. 2007) (“The contract between the parties, which is essentially just an invoice, does not indicate who is to have authorship over the photo images.”); Dockery, *supra* note 52, at 8 (“Copyright ownership relating to musical works and stage plays can be more prone to challenges than written works and photography, simply because a number of people are usually involved in the creation of these types of works.”).

the status of joint author, enjoying an undivided half interest in the copyright in the published work. Similarly, research assistants may on occasion contribute to an author some protectable expression or merely a sufficiently original selection of factual material as would be entitled to a copyright, yet not be entitled to be regarded as a joint author of the work in which the contributed material appears. What distinguishes the writer-editor relationship and the writer-researcher relationship from the true joint-author relationship is the lack of intent of both participants in the venture to regard themselves as joint authors.

Focusing on whether the putative joint authors regarded themselves as joint authors is especially important in circumstances, such as the instant case, where one person (Childress) is indisputably the dominant author of the work and the only issue is whether that person is the sole author or she and another (Taylor) are joint authors.¹¹⁷

Despite the fact that the court acknowledges that there is no intent provision in the statute itself, the court attempted to fill in perceived blanks in the statutory language by interpreting “intent” to mean, not intent to *merge* the contributions, but intent to *jointly own*.¹¹⁸

There are clear problems with the “intent to be joint owners” standards. As discussed earlier, most creative parties do not sit down and negotiate ownership rights when they begin a project.¹¹⁹ If there is

¹¹⁷ *Childress*, 945 F.2d at 507–08.

¹¹⁸ See *Ulloa v. Universal Music and Video Distrib. Corp.*, 303 F. Supp. 2d. 409, 411–12, 417–18 (S.D.N.Y. 2004) (citing *Childress*, 945 F.2d at 509) (finding no shared intent to be joint authors when an accidental contributor dropped in on Shawn Carter's recording session, but contribution of vocal countermelody to a song's instrumental phase allowed copyright infringement claim to survive motion to dismiss); Dockery, *supra* note 52, at 10–13.

¹¹⁹ See *supra* Section 2.

no tangible evidence of an intention to jointly own the work, all that it takes to defeat “joint authorship” is a disagreement at some time regarding the rights. If one party were to say, “I did most of the work; I should own it,” halfway through the project, the intent prong would not be met.

The court is also being overly general in dismissing the editor and researcher situations. The facts of the case and the quantitative and qualitative nature and substantiality of the contributions must be considered. While not meaning to demean editors, whose contributions are certainly valuable, edits and stylistic contributions could be handled by either counting their contributions as legally *de minimis* or by invoking the “works made for hire” doctrine. In the cases of staff editors who work for publishing houses or magazines, the publisher owns their work.¹²⁰ In the case of the author-researcher relationship, the contribution may be sufficient on the part of the researcher to warrant “joint authorship” status,¹²¹ or the relationship may be such as to also be a “work made for hire.”¹²² The situation must be fact specific. For example, in *Seshadri v. Kasraian*,¹²³ a professor's graduate student was held to be a “joint author” of a journal article with the university professor.¹²⁴ Under the facts of the case, the

¹²⁰ 17 U.S.C. § 201 (b) (2012) (“the employer or other person for whom the work was prepared is considered the author for purposes of this title . . .”).

¹²¹ See Rochelle Cooper Dreyfuss, *Collaborative Research: Conflicts on Authorship, Ownership, and Accountability*, 53 VAND. L. REV. 1161, 1166 (2000) (advocating for “[r]ethinking the intellectual property system in light of the increasing prevalence of collaborative production . . .”). See also, Alan L. Durham, *The Random Muse: Authorship and Indeterminacy*, 44 WM. & MARY L. REV. 569 (2002) (discussing concept of authorship and property rights). But see Mark A. Lemley, *Rights of Attribution and Integrity in Online Communications*, 1995 J. ONLINE L. art. 2, ¶ 11, available at http://caselaw.lp.findlaw.com/data/law_reviews/031j_online_law/lemley.html (noting the importance of peer recognition for some authors who do not receive financial compensation and stating that “for other authors, particularly those in the academic community, attribution may be more important than the right of commercial control”).

¹²² *Childress*, 945 F.2d at 507 n.2.

¹²³ 130 F.3d 798 (7th Cir. 1997).

¹²⁴ *Id.* at 804.

professor acknowledged that the student authored the first draft of two sections that occupied almost five pages of a thirteen page article, as well as of a number of complicated graphs.¹²⁵ The court found the contribution was significant.¹²⁶

There is another problem with concentrating on the “intent” prong, as the Second Circuit did in *Childress*: because the test has two required elements, failure to meet one of them ends the inquiry of joint authority. The court did not sufficiently address whether Taylor did, indeed, contribute copyrightable material.¹²⁷ If she had, what becomes of it? Could Taylor sue *Childress* for unauthorized use of copyrightable patrons contained in the work? After all, there is sufficient precedent holding that characters, if sufficiently developed may, be protected.¹²⁸ Were some of the added characters protected? In addition, did Taylor contribute “expression” that transcended “ideas” to the plot? Did Taylor’s behavior contributions give to *Childress* a “nonexclusive” license to use the work? There are still many open questions.¹²⁹

B. *Erickson v. Trinity Theatre*

Childress was followed by a case in the Seventh Circuit, *Erickson v. Trinity Theatre, Inc.*,¹³⁰ also involving a playwright and

¹²⁵ *Id.* at 803.

¹²⁶ *Id.* at 804–05. It is interesting to note that the court did not concentrate on the intent prong. The professor, in that case, clearly did not intend to be a “joint author” with his graduate student.

¹²⁷ See generally *Childress*, 945 F.2d 500.

¹²⁸ See *Gaiman v. MacFarlane*, 360 F.3d 644, 660 (7th Cir. 2004). See generally *Detective Comics, Inc. v. Bruns Publ’ns*, 111 F.2d 432 (2d Cir. 1940); *Anderson v. Stallone*, 11 U.S.P.Q.2d (BNA) 1161 (C.D.Cal. 1989). But see *Nichols v. Universal Pictures*, 45 F.2d 119 (2d Cir. 1930).

¹²⁹ These issues will be more fully discussed, along with *Thomson v. Larson*, the case involving the musical *Rent*, later in this article. See *infra* Section 2(C).

¹³⁰ 13 F.3d 1061 (7th Cir. 1994).

several actors.¹³¹ Karen Erickson, a playwright, “was one of the founders of” and wrote several plays to be produced at Trinity Theatre.¹³² Between 1981 and 1991, she served in several capacities at the Theatre, including “playwright, artistic director, actress, play director, business manager, and member of the board of directors.”¹³³ During rehearsals of the plays in question, the actors frequently made suggestions that were incorporated into the plays.¹³⁴

In 1987, Trinity produced the plays and “began paying Ms. Erickson royalties for [the] performances,” crediting her as the playwright.¹³⁵ In 1988, “Ms. Erickson entered into a two-year license agreement with Trinity,” also listing her as “playwright” and agreeing to pay royalties for the two-year term of the agreement.¹³⁶ “Trinity discontinued making royalty payments on November 15, 1990.”¹³⁷ Erickson registered the works in her name and sued the Theatre for copyright infringement.¹³⁸ The Theatre alleged that it did not infringe because it was a “joint author” along with Erickson, on the basis of the contributions made by the actors—employees of the theatre.¹³⁹

The court held that in order to be “joint authors,” the two-pronged test articulated in *Childress v. Taylor* must be met.¹⁴⁰ The court held that the actors were not “joint authors” of the plays and affirmed the district court’s injunction on performances of the plays or

¹³¹ *Id.* at 1063–64.

¹³² *Id.* at 1063.

¹³³ *Id.*

¹³⁴ *Id.* at 1064.

¹³⁵ *Id.*

¹³⁶ *Erickson*, 13 F.3d at 1064.

¹³⁷ *Id.*

¹³⁸ *Id.* at 1064–65

¹³⁹ *Id.* at 1063–64. It is interesting that Trinity Theatre did not claim that it was the statutory author of the plays under the “works made for hire” doctrine. Erickson regularly worked for the theater for ten years in a number of capacities. It is possible that, under the *Reid* factors, she would have been classified as an “employee.”

¹⁴⁰ *See id.* at 1071.

displays of videotapes of the plays.¹⁴¹ It was clear from the facts of the case that the playwright and the actors did not share the “intent” to be joint authors.¹⁴² Regarding the copyrightability of the contributions issue, the court followed the lead articulated by Professor Paul Goldstein that the individual contributions of collaborators must themselves be independently copyrightable and followed by the Second Circuit:

We agree with the *Childress* court’s observation that the copyrightability test “strikes an appropriate balance in the domains of both copyright and contract law.” Section 201(b) of the Act allows any person to contract with another to create a work and endow the employer with authorship status under the Act. A contributor of uncopyrightable ideas may also protect her rights to compensation under the Act by contract. Section 201(d) of the Act provides in part that any of the exclusive ownership rights comprised in a copyright may be transferred from the person who satisfied the requirements for obtaining the copyright to one who contracts for such rights. Thus, anyone who contributes to the creation of a work, either as patron, employer, or contributor of ideas, has the opportunity to share in the profits produced by the work through an appropriate contractual arrangement In order for the plays to be joint works under the Act, Trinity also must show that actors’ contributions to Ms. Erickson’s work could have been independently copyrighted. Trinity cannot establish this requirement for any of the above works. The actors, on the whole, could not identify specific contributions that they had made to Ms. Erickson’s works. Even when Michael Osborne was able to do so,

¹⁴¹ See *id.* at 1072–73.

¹⁴² See *Erickson*, 13 F.3d at 1072–73.

the contributions that he identified were not independently copyrightable. Ideas, refinements, and suggestions, standing alone, are not the subjects of copyrights. Consequently, Trinity cannot establish the two necessary elements of the copyrightability test and its claims must fail. Trinity cannot establish joint authorship to the plays at issue.¹⁴³

The court was a bit disingenuous by saying that “refinements and suggestions, standing alone, are not the subject matter of copyright.” What if the “refinements and suggestions” involved changes in dialogue? Adding dialogue or editing could be copyrightable contributions. A better way of approaching the “copyrightability” issue is to look at either a “more than *de minimis* contribution” or a genuine contribution” alluded to in some of the House Reports that accompanied proposed amendments to the statute.¹⁴⁴ While “more than *de minimis*” and “genuine contribution” are, admittedly, a bit ambiguous and would still require judicial interpretation, those standards are more intellectually honest than an outright rejection of copyrightability for the contributions of actors made to improve upon a written script.

¹⁴³ *Id.* at 1071–73 (citations omitted). Supporting the need for intent, the court references a citation from *Childress*. *See id.* at n.10 (citing 945 F.2d at 509) (“Childress was asked to write a play about ‘Moms’ Mabley and did so. To facilitate her writing task, she accepted the assistance that Taylor provided, which consisted largely of furnishing the results of research concerning the life of ‘Moms’ Mabley. As the actress expected to portray the leading role, Taylor also made some incidental suggestions, contributing ideas about the presentation of the play’s subject and possibly some minor bits of expression. But there is no evidence that these aspects of Taylor’s role ever evolved into more than the helpful advice that might come from the cast, the directors, or the producers of any play. A playwright does not so easily acquire a co-author.”).

¹⁴⁴ *See* H.R. REP. NO. 92-487, at 5 (1971); *see also* H.R. REP. NO. 94-1476, at 120 (1976).

C. *Thomson v. Larson*

In 1998, the Second Circuit was presented with another “joint works” case—this time a high-profile one involving the hit Broadway musical *Rent*.¹⁴⁵ In *Thomson v. Larson*,¹⁴⁶ the issue before the court was whether a dramaturg who was brought in to make changes to the play prior to the Broadway opening was a “joint author.”¹⁴⁷ The facts of the case are as follows:

Rent, the Pulitzer Prize and Tony Award-winning Broadway modern musical based on Puccini's opera *La Boheme*, began in 1989 as the joint project of Billy Aronson and composer Jonathan Larson. Aronson and Larson collaborated on the work until their amicable separation in 1991. At that time, Larson obtained Aronson's permission to develop the play on his own. By written agreement, Larson promised that the title would always be “RENT a rock opera by Jonathan Larson. Original concept and additional lyrics by Billy Aronson.” In return, Aronson agreed that he would “not . . . be considered [an] active collaborator or co-author of *Rent*.”

In the summer of 1992, Larson's *Rent* script was favorably received by James Nicola, artistic director of the New York Theatre Workshop (“NYTW”), a non-

¹⁴⁵ *Thomson v. Larson*, 147 F.3d 195 (2d Cir. 1998).

¹⁴⁶ *Id.*

¹⁴⁷ *Id.* One issue for the court to consider was whether \$2,000 is fair compensation for dramatalogical services for a Broadway-bound musical. *Id.* For a thorough discussion of *Thomson*, see Alvin Deutsch, *La Boheme—Revisited: Thomson v. Larson—An Unhurried View*, 45 J. COPYRIGHT SOC'Y U.S.A. 652 (1998). See also Faye Buckalew, *Joint Authorship in the Second Circuit: A Critique of the Law in the Second Circuit Following Childress v. Taylor and as Exemplified in Thompson v. Larson*, 64 BROOK. L. REV. 545 (1998).

profit theater company in the East Village Larson continued to develop and revise the “workshop version” of his *Rent* script. In the spring of 1993, Nicola urged Larson to allow the NYTW to hire a playwright or a bookwriter to help revamp the storyline and narrative structure of the play. But Larson “absolutely, vehemently and totally rejected [Nicola’s] suggestion of hiring a bookwriter” and “was insistent on making *Rent* entirely his own project.” Larson received a grant in the spring of 1994 to pay for a workshop production of *Rent*, which was presented to the public in the fall of 1994 in a series of ten staged performances produced by the NYTW and directed by Michael Greif. “[T]he professional consensus concerning the show, after the studio production, was that it was, at a minimum, very promising and that it needed a great deal of work.” Artistic Director Nicola once again suggested to Larson that he consider working with a bookwriter, which Larson “adamantly and steadfastly refused, consistently emphasizing his intention to be the only author of *RENT*.”

In May 1995, in preparation for *Rent*’s off-Broadway opening, scheduled for early 1996, Larson agreed to the NYTW’s hiring of Lynn Thomson, a professor of advanced playwriting at New York University, as a dramaturg¹⁴⁸ to assist him in clarifying the storyline of the musical. Thomson signed a contract with the NYTW, in which she agreed to provide her services with the workshop production from May 1, 1995, through the press opening, scheduled for early February of 1996. The agreement stated that

¹⁴⁸ “Dramaturgs provide a range of services to playwrights and directors in connection with the production and development of theater pieces. According to Thomson’s testimony, the role of the dramaturg ‘can include any number of the elements that go into the crafting of a play,’ such as ‘actual plot elements, dramatic structure, character details, themes, and even specific language.’” *Id.* at n.5.

Thomson's "responsibilities shall include, but not be limited to: Providing dramaturgical assistance and research to the playwright and director." In exchange, the NYTW agreed to pay "a fee" of \$2000, "[i]n full consideration of the services to be rendered" and to provide for billing credit for Thomson as "Dramaturg." The Thomson/NYTW agreement was silent as to any copyright interests or any issue of ownership with respect to the final work.¹⁴⁹

In the summer and fall of 1995, Thomson and Larson worked extremely intensively together on the show. For the most part, the two worked on the script alone in Larson's apartment. Thomson testified that revisions to the text of *Rent* didn't begin until early August 1995. Larson himself entered all changes directly onto his computer, where he kept the script, and Thomson made no contemporaneous notes of her specific contributions of language or other structural or thematic suggestions. Thomson alludes to the "October Version" of *Rent* as the culmination of her collaborative efforts with Larson. That new version was characterized by experts as "a radical transformation of the show."

A "sing-through" of the "October Version" of *Rent* took place in early November 1995. On November 3, 1995, Larson signed a contract with the NYTW for ongoing revisions to *Rent*. This agreement

¹⁴⁹ It should be noted that the Agreement was with the NYTW, and not with Larson himself. See *id.* at 197. Conceivably, then, claims should have been against NYTW. See Deutsch, *supra* note 187, at 658. There also could have been a "works made for hire claim" made by NYTW with respect to Thomson's work. It should be noted that the only way that "work made for hire" could have been claimed would have been under section 101(1) by applying the *Reid* factors. Section 101(2) could not have been used, for there was no writing stating that the work was a "work made for hire." Moreover, plays are not in the enumerated categories in section 101(2). See 17 U.S.C. § 101.

identified Larson as the “Author” of *Rent* and made no reference to Thomson. The contract incorporated by reference an earlier draft author's agreement that set forth the terms that would apply if the NYTW opted to produce *Rent*. The earlier draft author's agreement gave Larson approval rights over all changes in text, provided that any changes in text would become his property, and assured him of billing as “sole author.”¹⁵⁰

The final dress rehearsal was held on January 24, 1996. Just hours after it ended, Larson died suddenly of an aortic aneurysm. Over the next few weeks, Nicola, Greif, Thomson, and musical director Tim Weil worked together to fine-tune the script. The play opened off-Broadway on February 13, 1996, to rave reviews. On February 23, 1996, *Rent's* move to Broadway was announced. Since its opening on Broadway on April 29, 1996, the show has been “an astounding critical, artistic, and commercial success.” . . . Thomson approached . . . the surviving members of Jonathan Larson's family, to request a percentage of the royalties derived from the play. In a letter to the Larson family, dated April 8, 1996, Thomson stated that she believed Larson, had he lived, would have offered her a “small percentage of his royalties to acknowledge the contribution I made.” In reply, the Larson heirs offered Thomson a gift of 1% of the author's royalties.¹⁵¹

When negotiations between Thomson and the heirs disintegrated, Thomson brought suit, claiming that she was a

¹⁵⁰ On November 30, 1995, Larson signed an option deal with the Broadway producers. This contract defined the royalty payments and other entitlements that would flow to Larson as the “Author.” *Thomson*, 147 F.3d at n.6.

¹⁵¹ *Id.* at 197–98.

“co-author” of *Rent*.¹⁵² She also alleged in the alternative that she never transferred any of her rights.¹⁵³

The district court trial was a bench trial in front of Judge Kaplan.¹⁵⁴ After hearing the testimony of two dozen witnesses, as well as reviewing thousands of pages of documentary evidence, Judge Kaplan issued his decision from the bench, holding that Thomson was not a “joint author” and dismissing the complaint.¹⁵⁵ Thomson appealed, arguing again that she was a “joint author.”¹⁵⁶ In the alternative, she asked for a determination of whether the district court's holding that she was not a joint author meant that she was the holder of all exclusive rights to her contributions.¹⁵⁷

On appeal, the Second Circuit addressed the *Childress* factors in turn.¹⁵⁸ With respect to the independently copyrightable contribution requirement, the court agreed with the district court in that Thomson had made “at least some *non-de minimis* copyrightable contribution.”¹⁵⁹ After deciding that there was a sufficient copyrightable contribution to satisfy the first prong of the *Childress* test, the court went on to the intent prong.¹⁶⁰

¹⁵² *Id.* at 198.

¹⁵³ *Id.* Under section 204 of the Copyright Act of 1976, all “transfers” must be in writing. See 17 U.S.C. § 204 (2012). See also, 17 U.S.C. § 101 (defining “transfer” to include assignments and exclusive licenses, but expressly excluding nonexclusive licenses).

¹⁵⁴ *Id.* at 199.

¹⁵⁵ *Id.*

¹⁵⁶ *Thomson*, 147 F.3d at 199.

¹⁵⁷ *Id.*

¹⁵⁸ *Id.* at 200–05.

¹⁵⁹ *Id.* at 200–01 n.14 In the district court opinion delivered from the bench, “Judge Kaplan stated that ‘there are lines in *Rent* that originated verbatim with Ms. Thomson. I don't think that they amount to 9%, and certainly not zero. There is probably enough there that it is not *de minimis*.’” *Id.*

¹⁶⁰ *Id.* at 200–01.

The court viewed the *Childress* intent prong as requiring the putative collaborators to, “‘entertain in their minds the concept of joint authorship.’ This requirement of mutual intent recognizes that, since co-authors are afforded equal rights in the co-authored work, the ‘equal sharing of rights should be reserved for relationships in which all participants fully intent to be joint authors.’”¹⁶¹ As the court did in *Childress*, the Second Circuit ignored the express statutory language and stated “[i]t is not enough that they intend to merge their contributions into one unitary work.”¹⁶² The court then proceeded to look to “factual indicia” to determine whether the primary author, Larson, had any intent to share authorship with anyone else.¹⁶³ Factors that the court considered as evidence of Larson's intent not to be a joint author were: (1) decision-making authority; (2) billing; (3) written agreements with third parties; and (4) additional evidence.¹⁶⁴

With respect to decision-making authority, evidence showed that Larson wanted all creative control and had expressly negotiated for final authority over any changes.¹⁶⁵ In addition, Larson's agreement with NYTW stated that any changes to the script would become Larson's property.¹⁶⁶ With respect to billing, the court first stated the proposition that “a writer's attribution of the work to herself alone is ‘persuasive proof . . . that she intended this particular piece to represent her own individual authorship’ and is ‘*prima facie* proof that [the] work was not intended to be joint’”¹⁶⁷ The court noted that every copy of a script brought to the court's attention said, “*Rent*, by Jonathan Larson.”¹⁶⁸ In addition, both the Off-Broadway and the

¹⁶¹ *Id.* at 201 (citing *Childress*, 945 F.2d at 509).

¹⁶² *Thomson*, 147 F.3d at 200 (citing *Cabrera v. Teatro Del Sesenta, Inc.*, 914 F. Supp. 743, 764 (D.P.R. 1995) (following the *Childress* standard)).

¹⁶³ *Id.*

¹⁶⁴ *Id.* at 200–05.

¹⁶⁵ *Id.* at 202.

¹⁶⁶ *Id.* at 203.

¹⁶⁷ *Id.* (quotations omitted) (citing *Weissmann v. Freeman*, 868 F.2d 1313, 1320 (2d Cir. 1989)).

¹⁶⁸ *Thomson*, 147 F.3d at 204.

Broadway copies of playbill identified the play as being “by Jonathan Larson,” while Thomson was listed as “Dramaturg.”¹⁶⁹ The court affirmed the district court’s conclusion that Larson was the sole author.¹⁷⁰ With respect to written agreements with third parties, the court found that all agreements with NYTW stated that Larson was to be listed as the “sole author.”¹⁷¹ This, too, was found to be evidence that Larson did not have any intent to share authorship with anyone else.¹⁷² With respect to additional evidence, the court, relying on Larson’s earlier discussions and negotiations with Aaronson, found that Larson completely understood the concept of “joint authorship.”¹⁷³ His agreements with Aaronson expressly stated that Aaronson would “not . . . be considered an active collaborator or co-author of *Rent*.”¹⁷⁴ Based upon all of the evidence, the mutual intent to be “joint authors” was not found and Thomson was not found to be a joint author.¹⁷⁵

Regarding Thomson’s claim of having the exclusive rights in and to her contributions, based upon the court’s finding that she had made a copyrightable contribution, the court was able to skirt the issue.¹⁷⁶ Although the court acknowledged that “[u]nder section 106, she would have the right to enjoin any use of her contributions in any stage production, book, cast album, or motion picture,” the court held because Thomson brought up the issue for the first time on appeal and did not address it at the district court level, the issues were “not properly before us, [and] we express no opinion on them.”¹⁷⁷

¹⁶⁹ *Id.* at 204–05.

¹⁷⁰ *Id.* at 204.

¹⁷¹ *Id.* at 204.

¹⁷² *Id.*

¹⁷³ *Id.* at 204–05.

¹⁷⁴ *Thomson*, 147 F.3d at 205.

¹⁷⁵ *Id.* at 206–07.

¹⁷⁶ *See id.*

¹⁷⁷ *Id.* at 206.

D. Aalmuhammed v. Lee

Another co-authorship claim centered on the award winning movie *Malcolm X* directed by Spike Lee and starring Denzel Washington.¹⁷⁸ In *Aalmuhammed v. Lee*, the court had to decide, “Who, in the absence of contract, can be considered an author of a movie?”¹⁷⁹ The case is interesting because it is decided on the grounds of “authorship,” despite the fact that Aalmuhammed clearly made a “copyrightable contribution” to the movie.¹⁸⁰ In doing so, it moves away from the *Childress v. Taylor* standard.¹⁸¹

After Lee co-wrote the screenplay and Washington signed on as its star, Washington asked Jefri Aalmuhammed to assist him in his preparation due to Aalmuhammed’s extensive knowledge of Malcolm X and Islam.¹⁸² “Aalmuhammed, a devout Muslim, . . . [had] previously written, directed, and produced a lesser known documentary film about Malcolm X. Aalmuhammed joined Washington on the movie set” to review religious and historical authenticity of the scenes.¹⁸³ Using his expertise, Aalmuhammed revised parts of the script, assisted with Arabic translations in Egypt, voiced some voice-overs, translated Arabic into English for subtitles, “and edited parts of the movie during post production.”¹⁸⁴ Some of his revisions were included in the released version of the film while others were not.¹⁸⁵ Significantly, “he wrote [two] scenes relating to Malcolm X’s Hajj pilgrimage that were enacted in the movie.”¹⁸⁶ Aalmuhammed

¹⁷⁸ *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000).

¹⁷⁹ *Id.* at 1232.

¹⁸⁰ *See id.* at 1235–36.

¹⁸¹ *See id.*

¹⁸² *Id.* at 1229–31 (“Coaching of actors, to be copyrightable, must be turned into an expression in a form subject to copyright.”).

¹⁸³ *Id.* at 1229–30.

¹⁸⁴ *Aalmuhammed*, 202 F.3d at 1230.

¹⁸⁵ *Id.*

¹⁸⁶ *Id.* at 1231.

cashed a \$25,000 check from Lee, but kept a \$100,000 check from Washington.¹⁸⁷ Although Aalmuhammed was turned down for a writing credit, the film listed him as “Islamic Technical Consultant” in its November 1992 release.¹⁸⁸ In November 1995, he applied for a copyright in the film as “co-creator, co-writer, and co-director of the movie”.¹⁸⁹ “The Copyright Office issued him a “Certificate of Registration,” but advised him . . . that his claims conflict with previous registrations of the film.”¹⁹⁰ Later that month, Aalmuhammed sued for a declaratory judgment of co-ownership in the movie and an accounting of profits, along with other claims.¹⁹¹

In attempting to justify the authorship standard of *Burrow-Giles*¹⁹² with the originality standard of copyrightability of *Feist Publications*,¹⁹³ *Burrow-Giles* proved more useful.¹⁹⁴ The court began by analyzing the theories of author as the originator, Chaucer’s first cause “Author of Nature,” and “auteur” theory suggesting the director able to impose his artistic judgments on the film as author.¹⁹⁵ “[Authoring] involves originating, making, producing, as the inventive or master mind, the thing which is to be protected. . . .”¹⁹⁶ The author

¹⁸⁷ *Id.* at 1230. By taking the time to write checks for \$25,000 and \$100,000 respectively, Spike Lee and Denzel Washington could have also taken the time to write agreements providing the rights and responsibilities of Aalmuhammed. It also would have ended the case.

¹⁸⁸ *Id.* at 1231.

¹⁸⁹ *Id.* at 1230.

¹⁹⁰ *Aalmuhammed*, 202 F.3d at 1230 (internal quotations omitted).

¹⁹¹ *Id.* Although the ninth circuit held that joint authorship was not present, it remanded for further proceedings of Aalmuhammed’s *quantum meruit* and unjust enrichment claims. *Id.* at 1237.

¹⁹² 111 U.S. 53, 61 (1884).

¹⁹³ 499 U.S. 340 (1991).

¹⁹⁴ *Aalmuhammed*, 202 F.3d at 1233–34.

¹⁹⁵ *Id.* at 1232.

¹⁹⁶ *Id.* at 1233 (citing *Burrow-Giles*, 111 U.S. at 61).

“really represents, creates, or gives effect to the idea, fancy, or imagination. . .” when considering the nature of authorship.¹⁹⁷ After considering the “copyrightable contribution,” which gives joint authorship status to one who creates “some minimal level of creativity” or “originality” standard sufficient to create a copyrightable “work,” the court held that that standard would be unmanageable in the film context.¹⁹⁸ Because so many people on a film set make substantial creative contributions, no one working on the set could be distinguished from another.¹⁹⁹

Everyone from the producer and director to casting director, costumer, hairstylist, and “best boy” gets listed in the movie credits because all of their creative contributions really do matter. It is striking in *Malcolm X* how much the person who controlled the hue of the lighting contributed, yet no one would use the word “author” to denote that individual’s relationship to the movie. A creative contribution does not suffice to establish authorship of the movie.²⁰⁰

The court used the reasoning in its opinion to reach a practical result “consistent” with the Second and Seventh Circuits, although those decisions were not based “on the word ‘authors’ in the statute.”²⁰¹ Those circuits “have likewise concluded that contribution of independently copyrightable material to a work intended to be an inseparable whole will not suffice to establish authorship of a joint work.”²⁰²

¹⁹⁷ *Id.* (internal quotation omitted).

¹⁹⁸ *Id.* at 1233, 1236 (citing *Feist*, 449 U.S. at 345).

¹⁹⁹ *Id.* at 1233.

²⁰⁰ *Aalmuhammed*, 202 F.3d at 1233.

²⁰¹ *Id.* at 1233–34.

²⁰² *Id.* at 1233.

In combining the “author” theory of *Burrows-Giles* and the “thoughtful opinion” theory in *Thomson*, the court enumerated three factors as criteria for joint authorship in the absence of contract²⁰³ First, and most important, the “author superintends the work by exercising control.”²⁰⁴ This “inventive or master mind” will “create[] or give[] effect to the idea” through “actually form[ing] the picture by putting the persons in position, and arranging the place where the people are to be.”²⁰⁵ A master mind is “the man who is the effective cause of that” creation.²⁰⁶ Second, “putative coauthors make objective manifestations of a shared intent to be coauthors. . . .”²⁰⁷ Third, “the audience appeal of the work turns on both contributions and ‘the share of each in its success cannot be appraised.’”²⁰⁸

Because the court found the “master mind’s” control of paramount importance, *Aalmuhammed*, even in making substantial contributions to the film, including two full scenes, was not one of its authors.²⁰⁹ The independently copyrightable contribution requirement gave way to constitutional authorship under the copyright clause: “We hold that authorship is required under the statutory definition of a joint work, and that authorship is not the same thing as making a valuable

²⁰³ See *id.* at 1234 (citing 111 U.S. at 61; *Thomson*, 147 F.3d. at 195).

²⁰⁴ *Aalmuhammed*, 202 F.3d at 1234 (internal quotations omitted).

²⁰⁵ *Id.* at 1233–34.

²⁰⁶ *Id.* at 1234.

²⁰⁷ *Id.*

²⁰⁸ *Id.* (quoting *Edward B. Marks Music Corp. v. Jerry Vogel Music Co., Inc.*, 140 F.2d 266, 267 (2d Cir. 1944), *modified by*, 140 F.2d 268 (1944)). The *Aalmuhammed* court did not explicitly apply the third factor in determining authorship in this case. See *id.* Presumably, this factor refers to the inseparability when merging parts into a “unitary whole.” See 17 U.S.C. § 101 (defining a joint work as being “prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole”).

²⁰⁹ *Aalmuhammed*, 202 F.3d at 1235–36.

and copyrightable contribution.”²¹⁰ Because Warner Brothers and Spike Lee controlled the making of the film, “Aalmuhammed did not at any time have superintendence of the work.”²¹¹ Instead, the court likened him to Larson’s dramaturg, making “extremely helpful recommendations,” which Spike Lee could freely refuse.²¹² Although Aalmuhammed showed he made valuable contributions to the movie, those contributions were subject to a supervisor’s discretion and did not amount to enough for co-authorship of a joint work.²¹³ Moreover, no one involved made any objective manifestations of intent to be co-authors.²¹⁴ The court feared that “progress would be retarded rather than promoted, if an author could not consult with others and adopt their useful suggestions without sacrificing sole ownership of the work.”²¹⁵

In sum, although Aalmuhammed presented evidence suggesting an independently copyrightable contribution which those involved intended to be merged into interdependent parts of the movie as a unitary whole, he was not one of the film’s “authors.” While the master mind theory might prove more useful in the film-making context because of the plethora of the court’s feared “claim-jumping” contributors, it is at odds with the copyrightable contribution requirement added by the Second and Seventh Circuits.

²¹⁰ *Id.* at 1232.

²¹¹ *Id.* at 1235.

²¹² *Id.*

²¹³ *See id.* at 1236.

²¹⁴ *Id.* at 1235. Even Spike Lee would not be considered a co-author and co-owner with Warner Brothers because he had signed a work for hire agreement. *See id.* The court noted this fact to illustrate the illogical presumption that Warner Brothers, “while not wanting to permit Lee to own the copyright, intended to share ownership with individuals like Aalmuhammed who work under Lee’s control. . . .” *Id.*

²¹⁵ *See Aalmuhammed*, 202 F.3d at 1235–36 ((stating that if creative contribution alone sufficed to establish authorship “[c]laimjumping[sic] by research assistants, editors, and former spouses, lovers and friends . . . [would] endanger authors who talked with people about what they were doing”).

E. *Janky v. Lake County Convention and Visitors Bureau*

In a case in which a writer who contributed only 10%, and was not the mastermind, as in *Aalmuhammed v. Lee*, the Seventh Circuit reversed a summary judgment finding of sole authorship by granting joint work status in a doo-wop ditty.²¹⁶ Cheryl Janky and Henry Farag were two “members of ‘Stormy Weather,’ an Indiana-based group revitalizing the nation’s a cappella doo-wop sound.”²¹⁷ The Lake County Convention and Visitor’s Bureau attempted to attract visitors to the “pristine beachfront along the Indiana Dunes National Lakeshore” by “commission[ing] a tune singing the county’s praises.”²¹⁸ After hearing about the Bureau’s interest in a song to represent Lake County, Farag suggested the band give it a try.²¹⁹ “Janky took the initiative,” “writing the music and lyrics for a tune she called ‘Wonders of Indiana.’”²²⁰ When the song was complete in May 1999, she registered the copyright as a work of sole authorship.²²¹ However, when she showed it to Farag, he recommended focusing the lyrics more on Lake County in particular, “includ[ing] references to the area as ‘Chicago’s neighboring south shore’ and to its ethnic diversity.”²²² Although Janky stated that Farag’s recommendations “accounted for [only] ten percent of the lyrical content,” she filed a new copyright registration in December 1999 listing Farag as co-author of the “joint work”, and “filed a document with the American

²¹⁶ *Janky v. Lake County Convention and Visitors Bureau*, 576 F.3d 356, 363–64 (7th Cir. 2009), *cert denied*, 555 U.S. 1137 (2010).

²¹⁷ *Id.* at 359 & n.2.

²¹⁸ *Id.* at 358.

²¹⁹ *Id.* at 359.

²²⁰ *Id.*

²²¹ *Id.*

²²² *Janky*, 576 F.3d at 359–60.

Society of Composers, Authors and Publishers (ASCAP) stating that Farag held a [ten] percent ‘ownership share.’”²²³

Janky, Farag, and the rest of Stormy Weather recorded a demo of the song and produced a music video to present to the Bureau.²²⁴ The Bureau, satisfied with the great marketing tool, used the video and song in exchange for the group’s costs of production.²²⁵ They debuted the song December 1, 1999, with a live performance at the Bureau.²²⁶ The Bureau also purchased 1,500 copies of the album on which the song ultimately appeared to resell at the visitor’s center.²²⁷

Yet, a mere three years later, Janky changed her mind.²²⁸ “On July 15, 2003, [she] filed yet another copyright registration form, ostensibly to correct the ‘mistake’ she had made” in placing Farag’s name on the registration form.²²⁹ Instead of crediting him as a joint author, she listed Farag on the registration “as an indication of [her] gratitude ... and to demonstrate that [she] appreciated every little bit of support.”²³⁰ At some point, she also informed “the Bureau that she was the exclusive owner.”²³¹ Farag, however, contended his lyrical changes were not *de minimis*, but “significant” and corresponded with further revisions to the melody.²³² Because “the Bureau did not stop

²²³ *Id.* at 360.

²²⁴ *Id.*

²²⁵ *Janky*, 576 F.3d at 360 (Stormy Weather “decided the publicity generated from the Bureau’s use of the material would be payment enough,” so “Farag issued a nonexclusive license to” the Bureau).

²²⁶ *Id.*

²²⁷ *Id.*

²²⁸ *Id.*

²²⁹ *Id.*

²³⁰ *Id.* at 360.

²³¹ *Janky*, 576 F.3d at 360.

²³² *Id.*

using the tune,” Janky filed a lawsuit against it for copyright infringement in October 2003.²³³

At trial in the Northern District of Indiana, Janky contended she composed the song and never gave the Bureau permission to use it.²³⁴ The Bureau countered that she was only a co-author; Farag, as the other songwriter, had the authority to license its use.²³⁵ However, the court held that Farag’s contribution did not rise to the level of a contribution that could, on its own, be subject to copyright protection.²³⁶ The court found there was not a genuine issue of material fact to reach the intent element as “contemporaneous input by more than one party alone does not satisfy the intent requirement.”²³⁷ After the district court granted Janky partial summary judgment on sole authorship, a jury awarded her \$100,000.²³⁸

On appeal, the Seventh Circuit evaluated whether Janky was truly the only author.²³⁹ Because “‘joint authors hold undivided interests in [the] work, despite any differences in each other’s contribution’ . . . each author may use or license the joint work.”²⁴⁰ First, Judge Evans evaluated whether Farag and Janky intended to create a joint work by intending to be joint authors at the time of creation.²⁴¹ The court cited *Erickson* when explaining that “the intent

²³³ *Id.* The complaint alleged that as the sole author of the work to the exclusion of Farag, the exclusive license granted by him to the Bureau was without effect, and the use was therefore illegal. *Id.* at 360–61.

²³⁴ *Id.*

²³⁵ *Id.* at 358.

²³⁶ *See id.* at 361.

²³⁷ *Janky v. Farag*, 2006 WL 842391, at *7–10, No 3:05-CV-217PRC, (N.D. Ind. Mar. 29, 2006), *rev’d*, 576 F.3d 356 (7th Cir. 2009), *cert denied*, 559 U.S. 992 (2010).

²³⁸ *Janky*, 576 F.3d at 358.

²³⁹ *Id.* at 361.

²⁴⁰ *Id.* (citing *Erickson*, 13 F.3d at 1068).

²⁴¹ *Id.* at 362.

prong does *not* have to do with the collaborators' intent to recognize each other as co-authors for purposes of copyright law; the focus is on the parties' intent to work together in the creation of a single product, not on the legal consequences of that collaboration."²⁴²

Here, unlike *Erickson*, Farag instead was entitled to summary judgment because the song was a product of them both.²⁴³ Judge Evans went so far as to note that "Farag wielded considerable control over what the song finally looked like; one could even say he demanded the changes."²⁴⁴ But stronger still, Janky named Farag as co-author on the copyright registration and deemed the song a "joint work."²⁴⁵ Although the court characterizes her recanting as a "post hoc rationalization" of her actions, like in *Erickson*, "crediting another person as a co-author is strong evidence of intent to create a joint work."²⁴⁶ Her affidavits contesting this intent were "at odds with the significant contributions made by Farag" and her voluntary decision to list him on the registration form.²⁴⁷

²⁴² *Id.* at 362 (emphasis added). See Dockery, *supra* note 52, at 9 (stating this "appears to refute the notion that the collaborators share a mutual intent to be coauthors of the song. Under this view of intent, for example, anytime two musicians make a recording, the intent element is met simply by the act of playing together and recording their combined performance").

²⁴³ *Janky*, 576 F.3d at 362.

²⁴⁴ *Id.* But see *id.* at 364–65 (Ripple, J., dissenting) (noting that the issue of Farag's intent and control is far from clear on the record and thus the issue should not be resolved on summary judgment for either party. Indeed, Farag's affirmative defenses stating that Janky did not own the copyrights at issue undermines the Bureau's claim that Farag intended to create a joint work with her).

²⁴⁵ *Id.*; Dockery, *supra* note 52 (interpreting the court's evaluation of the intent element and stating: "The notion that collaborators share a joint intent that their parts be merged led to the court's finding that the intent element of authorship should be found in the subjective belief of the collaborators. The court recognized that how the putative authors regarded themselves in relation to the work was a key factor in ascertaining whether the intent element of Section 101 is satisfied.").

²⁴⁶ *Janky*, 576 F.3d at 362.

²⁴⁷ *Id.* (The court quotes *Childress* in noting that billing credit, although not decisive "helpfully serves to focus the factfinder's attention on how the parties implicitly regarded their undertaking"); see also *Corwin v. Quinonez*, 858 F. Supp. 2d 903,

Second, the court examined Farag's contributions to test whether they were independently copyrightable.²⁴⁸ Judge Evans noted the *Gaiman* exception applies only if the nature of the creative process requires that none of the constituent parts could pass the test of copyrightability alone.²⁴⁹ Moreover, *Erickson* requires a greater contribution by each author than demanded by Nimmer's *de minimis* test.²⁵⁰ Here, *Gaiman*'s exception did not apply because Janky's work was copyrightable before Farag supplied his contributions.²⁵¹ Once again, the situation "differ[ed] considerably from *Erikson*" because Farag's contributions were "concrete expressions and thus pass the test of copyrightability where mere ideas fail."²⁵² Before Farag became involved, "the song [only] celebrated the charm of Indiana."²⁵³ Because Farag shifted the focus to Lake County, even his ten percent changes to the lyrics were significant enough to impact "not only ... the final sound, but also ... its commercial viability."²⁵⁴ The Bureau had no reason to embrace the song without Farag's input and refocus.²⁵⁵ The court recognized it was a "close case" and the need to limit the contributions of every collaborative contributor or else "copyright would explode."²⁵⁶ However, "the very purpose of

n.11 (N.D. Ohio 2012) (distinguishing *Janky*, which involved a "clear concession of joint authorship," by filing the copyright registration listing the co-author as joint author and the work as a joint work).

²⁴⁸ *Janky*, 576 F.3d at 363.

²⁴⁹ *Id.* at 362 n.4 (noting that the *Gaiman* exception applied to the specific particular creative process in making a comic book involving a writer, penciler, inker, and colorist); see also *Gaiman v. McFarlane*, 360 F.3d 644, 658–59 (7th Cir. 2004).

²⁵⁰ *Janky*, 576 F.3d at 362.

²⁵¹ *Id.* at 362 n.4.

²⁵² *Id.* at 363 (citing *Gaiman*, 360 F.3d at 658).

²⁵³ *Id.*

²⁵⁴ *Id.*

²⁵⁵ See *Janky*, 576 F.3d at 363.

²⁵⁶ *Id.* (quoting *Gaiman*, 360 F.3d at 658).

copyright law is to promote the progress of the arts and sciences...a purposes that is defeated if important contributions are denied copyright protection.”²⁵⁷ Because “copyrightability is always an issue of law,” the Seventh Circuit thus reversed and granted summary judgment in favor of the Bureau.²⁵⁸

Although the majority emphasized its continued rejection and scorn of Professor Nimmer’s “de minimis” test, as the dissent notes, the record before it leaves scant reason to find for summary judgment in favor of either party.²⁵⁹ Farag’s ten percent contribution seems to be the only concrete evidence of a copyrightable contribution.²⁶⁰ The intent prong is primarily met because of Janky’s snafu in registering the song as a joint work co-authored by both.²⁶¹ The majority doesn’t mention Farag’s intent, other than his wielding “considerable control over what the song finally looked like” and positing that he must have “demanded the changes.”²⁶² However, his intent seems more aligned with that of an editor’s revisions to ensure content has the greatest “commercial viability.” Although the majority notes that Farag contributed “concrete expressions” that pass the test of copyrightability, the ten percent lyrical contributions, due to their “significan[ce],” were both quantitatively and qualitatively more than de minimis.²⁶³ It is a wonder the Seventh Circuit is stretching so hard to reject Nimmer’s suggestion based on precedence when its opinions seem to be at least subconsciously embracing it.

²⁵⁷ *Id.* (citing U.S. CONST. art. I, §8, cl. 8).

²⁵⁸ *Id.* at 363–64 (citing *Gaiman*, 360 F.3d at 568).

²⁵⁹ *Id.* at 365 (Ripple, J., dissenting).

²⁶⁰ *See id.* at 360.

²⁶¹ Dockery, *supra* note 52 at 9 (stating that the *Janky* court “seemed to cast off an investigation into whether the putative authors shared a subjective mutual intent to create a joint work and merely focused on the circumstances surrounding the creation of the song . . . instead of analyzing the legal consequences of collaboration, the focus is on the collaborators’ intent to work together to create a single product”).

²⁶² *See Janky*, 576 F.3d at 362.

²⁶³ *See id.* at 363.

F. *Gaiman v. McFarlane*

Judge Posner followed the statutory rule, instead of the “copyrightable contribution” in *Gaiman v. McFarlane*.²⁶⁴ He deviated from *Aalmuhammed* when, instead of disregarding a co-creator’s independent contribution, which satisfies the copyright originality standard as in *Aalmuhammed*, he acknowledged that in merging parts into an inseparable whole, the two parts cannot always be torn apart into independent units that can satisfy the copyrightability tests on their own.²⁶⁵

The parties of the case “are both celebrated figures in the world of comic books.”²⁶⁶ While Neil Gaiman solely writes scripts, Todd McFarlane writes, illustrates, and publishes comic books.²⁶⁷ In 1992, McFarlane formed his own publishing house and began publishing a series entitled *Spawn*.²⁶⁸ The title character, Al Simmons, is a “Hellspawn”: an officer in the army of the damned preparing to someday launch an attack against Heaven.²⁶⁹ After his death, Simmons entered a Faustian pact with the devil to return to the living to see his widow and avenge his murder.²⁷⁰ After early issues of the series were criticized for bad writing, McFarlane invited four writers, including Gaiman, to contribute an issue of *Spawn*.²⁷¹ Although their only contract was oral, Gaiman wrote the script for *Spawn* issue No. 9

²⁶⁴ See generally *Gaiman*, 360 F.3d at 644.

²⁶⁵ See *id.* at 658–59.

²⁶⁶ *Id.* at 649.

²⁶⁷ *Id.*

²⁶⁸ *Id.*

²⁶⁹ *Id.*

²⁷⁰ *Gaiman*, 360 F.3d at 649.

²⁷¹ *Id.*

in exchange for McFarlane's assurance to treat him "better than the big guys" did.²⁷²

Gaiman introduced three new characters in his script for *Spawn* No. 9: Medieval Spawn,²⁷³ Angela,²⁷⁴ and Count Nicholas Cogliostro.²⁷⁵ "Gaiman described, named, and wrote the dialogue for them, but McFarlane drew them."²⁷⁶ "Olden Days Spawn," as Gaiman referred to the character, rides up on a huge horse wearing the mask and Spawn suit "reminiscent of a suit of armour" of the Middle Ages.²⁷⁷ Although he attempts to help a damsel in apparent distress with credibly medieval colloquialisms, he is quickly dispatched by Angela, the "warrior angel and villain."²⁷⁸ McFarlane told Gaiman he wanted a "wisened [sic] sage" character to inform and assimilate Spawn.²⁷⁹ Gaiman created an "old man" character to educate spawn about the extent of the super powers.²⁸⁰ Spawn would first meet Colgiostro as a homeless "drunken bum," but later realize he is "some kind of mysterious stranger who knows things."²⁸¹ Gaiman described him as "a really old bum, a skinny, blading old man, with a grubby

²⁷² *Id.* Gaiman had previously worked for D.C. Comics and Marvel Comics under work for hire agreements, which established ownership of copyrights in the employer and did not entitle Gaiman to royalty payments from derivative works such as action figures. *Id.* at 649–50 & 656.

²⁷³ Gaiman referred to this character "Olden Days Spawn," a 13th century version of the current-day Al Simmons. *Id.* at 657 & 661. McFarlane named him "Medieval Spawn" in later issues to which Gaiman did not contribute. *Id.* at 661.

²⁷⁴ *Id.* at 650–51. McFarlane conceded joint ownership in Angela presumably because Gaiman was asked and wrote three additional issues as a "mini-series" to develop the character. *Id.*

²⁷⁵ *Id.* at 650.

²⁷⁶ *Gaiman*, 360 F.3d at 650.

²⁷⁷ *Id.* at 657.

²⁷⁸ *Id.*

²⁷⁹ *Id.* at 657–58.

²⁸⁰ *Id.* at 658.

²⁸¹ *Id.*

grayish-yellow beard, like a skinny santa clause” whom “calls himself Count Nicholas Cagliostro.”²⁸² McFarlane, dissatisfied with the description, “which made Cogliostro sound like a wino,” drew him “as an old man with a long grey beard who faintly resembles Moses.”²⁸³

Spawn No. 9 was a huge success and sold more than a million copies.²⁸⁴ McFarlane paid Gaiman \$100,000 for his work on No. 9,²⁸⁵ \$3,300 for his contribution to No. 26 to form a bridge to the *Angela* mini-series, and more than \$30,000 for the *Angela* series.²⁸⁶ In 1995, after McFarlane created a toy company to manufacture action figures of the *Spawn* characters including Medieval *Spawn*, he sent Gaiman a check for \$20,000, which the court assumes to be royalties from the toy sales.²⁸⁷ Later, McFarlane licensed the publication of paperback books reprinting the series.²⁸⁸ The books carry a copyright notice similar to his previous comics, except the addition that “all related characters” were copyrighted by McFarlane.²⁸⁹

²⁸² *Gaiman*, 360 F.3d at 658.

²⁸³ *Id.* at 657–58.

²⁸⁴ *Id.* at 651.

²⁸⁵ *Id.* Gaiman testified that he would have expected to receive an equivalent amount from DC Comics “had he written the script of *Spawn* No. 9 for that company as a work made for hire.” *Id.* Although McFarlane did not argue that telling Gaiman that he would treat him “better than the big guys” might create a work for hire relationship, the court held that no such relationship existed because there was no written agreement and Gaiman was not an employee of McFarlane. *Id.* at 650.

²⁸⁶ *Id.* at 651. The *Angela* series was published in 1994. *Id.*

²⁸⁷ *Id.* Judge Posner refers to these derivative works as “statuettes.” *See id.* Because toy companies, children, and adults tend to refer to character toys as “action figures,” so will this author.

²⁸⁸ *Gaiman*, 360 F.3d at 651.

²⁸⁹ *Id.* McFarlane defended Gaiman’s co-ownership claim on the ground that the statute of limitations had expired through copyright notice on publication and copyright registration. *Id.* at 652. The court found that Gaiman appropriately filed suit within one month prior to the 3-year deadline, based on a final letter from McFarlane after negotiations dissolved. *Id.* at 655. The operative statement “all rights to Medieval *Spawn* and Cogliostro shall continue to be owned by Todd

McFarlane first requested protection of a written contract in 1996, after learning that McFarlane might sell his enterprise.²⁹⁰ Through desultory negotiations, the parties reached a tentative agreement that McFarlane would pay royalties on the action figures, “but Gaiman would exchange his rights in Medieval Spawn and Cogliostro for McFarlane’s rights in another comic book character, Miracleman.”²⁹¹ Thus, in ‘1997 and 1998, McFarlane sent Gaiman royalty checks totaling about \$16,000 . . . , with royalty reports that referred to Gaiman as “co-creator” of Medieval Spawn, Angela, and Cogliostro.”²⁹² In 1999, McFarlane sent a letter officially rescinding all previous offers while offering a take it or leave it deal.²⁹³ Later, Gaiman filed suit seeking “a declaration that he *is* a co-owner” of the three characters and an accounting of profits.²⁹⁴ A jury returned a verdict for Gaiman.²⁹⁵ At the time of trial, *Spawn* was up to issue No. 120 with a progeny of derivative works, many of which “include[d] all three characters to which Gaiman contributed.”²⁹⁶

On appeal, Judge Posner questioned whether Gaiman’s contribution to the comic book characters in quest gave him a copyright interest in them.²⁹⁷ McFarlane argued that Medieval Spawn and Cogliostro were not copyrightable either because Gaiman contributed merely unexpressed ideas, or because they are

McFarlane Productions” effected an unambiguous renunciation of Gaiman’s ownership rights thus starting the limitations clock. *Id.* at 652 (emphasis added).

²⁹⁰ *Id.* at 651.

²⁹¹ *Id.*

²⁹² *Id.*

²⁹³ *Id.* at 652.

²⁹⁴ *Gaiman*, 360 F.3d at 652.

²⁹⁵ *Id.* at 648.

²⁹⁶ *Id.* at 652 (noting that the derivative works included “posters, trading cards, clothing,” action figures, “an animated series on HBO, video games, and a motion picture”).

²⁹⁷ *Id.* at 652.

commonplace stock characters.²⁹⁸ In recognizing the rules that people who contribute merely non-expressive elements to a work are not copyright owners and some of the original expression by a co-author must be independently copyrightable, Judge Posner decided Gaiman's contributions were more than just editorial suggestions, saying:

But where two or more people set out to create a character jointly in such mixed media as comic books and motion pictures and succeed in creating a copyrightable character, it would be paradoxical if though the result of their joint labors had more than enough originality and creativity to be copyrightable, no one could claim copyright. That would be peeling the onion until it disappeared.²⁹⁹

Posner distinguished his decision from anomalous precedent because those decisions “weren’t thinking of the case in which [a contribution] *couldn’t* stand alone because of the nature of the particular creative process that had produced it.”³⁰⁰ Before the court was a different creative process involving the joint work of four artists: the writer, the penciler, the inker, and the colorist “with each contributing too little to have by his contribution alone carried the stock character over the line into copyright land.”³⁰¹ “The finished

²⁹⁸ *Id.* at 657. Recognizing that McFarlane’s arguments regarding the characters’ copyrightability were inconsistent, Posner considered the argument for the expiration of the statute of limitations. *Id.* at 652–57. McFarlane claimed that the “all related characters” copyright notice established his ownership of the characters. *See id.* at 654. Alternately, he McFarlane argued that if the characters were copyrightable, they only became so through his further work published after *Spawn* No. 9 was published. *Id.* at 567.

²⁹⁹ *Id.* at 658–59.

³⁰⁰ *Gaiman*, 360 F.3d at 659 (emphasis in original).

³⁰¹ *Id.* Judge Posner later suggests that the Gaiman might have an independently copyrightable contribution in Count Cogliostro through his description and dialogue even though the graphic expression of a comic book more finely defines him. *Id.* at 660. Otherwise, the writer is presumed to contribute “merely a stock character.”

product is copyrightable, yet one can imagine cases in which none of the separate contributions of the four collaborating artists would be.”³⁰²

Gaiman and McFarlane were entitled to ownership of the copyright in Count Nicholas Cogliostro because the character was a joint work with equal contributions from them both.³⁰³ Although a “drunken old bum” is a stock character, Cogliostro had finer delineation due to his specific name, dialogue, and appearance.³⁰⁴ “Cogliostro’s age, obviously phony title (“Count”), what he knows and says, his name, and his faintly Mosaic facial features combine to create a distinctive character. No more is required for a character copyright.”³⁰⁵ “Although Gaiman’s verbal description of Cogliostro may have been of a stock character,” not copyrightable in itself, “once he was drawn and named and given speech he became sufficiently distinctive to be copyrightable.”³⁰⁶ Conversely, without Gaiman’s contribution of expressive content, Cogliostro “wouldn’t have been a character at all, but merely a drawing.”³⁰⁷

Yet, Medieval Spawn seemed a “closer case” than Cogliostro.³⁰⁸ As yet unnamed in *Spawn* No. 9, he is only

which only acquires copyrightable distinctiveness through the work of the other artists. *Id.* at 659.

³⁰² *Id.* at 659. The four artists include the writer (Gaiman), “the penciler who creates the art work (McFarlane), the inker (also McFarlane, in the case of *Spawn* No. 9, but it would often be a different person from the penciler) who makes a black and white plate of the art work, and the colorist who colors it.” *Id.*

³⁰³ *Id.* at 661.

³⁰⁴ *Id.* at 660.

³⁰⁵ *Id.* To suggest otherwise would call into question the character copyrights in *Batman* (DC Comics Inc v. Reel Fantasy, Inc., 696 F.2d 24, 25, 28 (2d Cir. 1982)), *Mickey Mouse* (Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 753–55 (9th Cir. 1978)), *Superman* (Detective Comics v. Bruns Pubs, 111 F.2d 432, 433–34 (2d Cir. 1940)), and *Betty Boop* (Fleisher Studios, Inc. v. Ralph A. Freundlich, Inc., 73 F.2d 276, 278 (2d Cir. 1934)).

³⁰⁶ *Gaiman*, 360 F.3d at 661.

³⁰⁷ *Id.*

³⁰⁸ *See id.*

distinguished from other Hellspawn through his costume, manner of speech, and medieval background.³⁰⁹ Judge Posner found those elements amounting to enough expressive content for copyrightability because “Spawn itself ... is not a stock character ...”³¹⁰ Rather, Medieval Spawn was sufficiently distinct from Spawn to be a derivative work of his present day equivalent.³¹¹

Posner impliedly adopts Nimmer’s suggestion—and the statutory language—of truly collaborative authorship.³¹² Although Gaiman’s contribution went beyond plot and stock character ideas into distinctive descriptions and dialogue, without McFarlane’s artwork, the comic book would not exist.³¹³ While both dialogue with a character description and artwork seem to be independently copyrightable, Judge Posner instead decided that their contributions could not be separated as the rule required.³¹⁴

V. PROBLEMS WITH THE CASES: THE COURTS ARE MISCONSTRUING THE STATUTE

A. *There Is No “Intent” to Be Joint Owners Requirement*

The modern interpretation of the statute by the courts, especially the Second Circuit, is, as stated before, contrary to the

³⁰⁹ *Id.* (stating that the lack of a name in his introductory issue was not critical because the Lone Ranger “doesn’t have a proper name either”).

³¹⁰ *Id.*

³¹¹ *Id.* at 661–62.

³¹² *Gaiman*, 360 F.3d at 659. The court noted that Nimmer suggests that “if authors A and B work in collaboration but A’s contribution is limited to plot ideas that 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.” *Id.* (quoting 1 NIMMER ON COPYRIGHT § 6.07 (2010)).

³¹³ *See id.*

³¹⁴ *See id.*

statutory language, as well as contrary to congressional intent. It is important to look again to the Supreme Court's decision in *Reid*.³¹⁵ After determining that the work was not a "work made for hire" and that the Community for Creative Non-Violence did not have a full statutory "authorship" interest in the work, the Supreme Court affirmed the Court of Appeals for the District of Columbia Circuit's order to remand the case for a determination of whether it was a "joint work."³¹⁶ If the proper standard were "intent to be joint owners," as later articulated in *Childress*, *Erickson*, and *Larson*, the Supreme Court would not have remanded the case. In *Reid*, the dispute was an "all-or nothing" ownership dispute.³¹⁷ The parties litigated bitterly for years all the way to the Supreme Court over the issue of absolute ownership.³¹⁸ The facts of *Reid* clearly demonstrate an intent not to be joint owners.³¹⁹ The Supreme Court remanded the issue for a determination of joint authorship under the statute.³²⁰ The issue to be settled on remand was whether the parties had the intent to merge their respective contributions into a "unitary whole."³²¹

Even so, in creative dramatic and musical productions, courts seem to punt on determining the subjective intent of the authors when there is at least one dominant creator in the relationship. Instead, if one party has most of the artistic control and another can be deemed a mere collaborator on a portion of the work, then the only intent that matters is that which is held in the mind of the dominant creator.³²²

³¹⁵ See *Reid*, 490 U.S. at 730.

³¹⁶ *Id.* at 753.

³¹⁷ See generally *id.* at 738.

³¹⁸ See *id.* at 733–38.

³¹⁹ See *id.* at 733–37.

³²⁰ *Id.* at 753.

³²¹ *Reid*, 490 U.S. at 753.

³²² See Dockery, *supra* note 52, at 9 ("Courts sometimes tend to sidestep the hard work of ascertaining mutual subjective intent where there is a dominant person directive creative activity.").

B. There Is No Authority for Requiring That Each Contribution Be Independently Copyrightable

In 1987, and again in 1989, there were attempts to amend the “joint work” provision in Section 101 of the Copyright Act.³²³ Senator Cochran introduced legislation to include the requirement of “independent copyrightability” for each author's contribution.³²⁴ The bill never passed, and the statute does not embody, and has never embodied, the proposed changes.³²⁵ If a bill was introduced to add that standard and the standard never made it into the law, Congress, through the language of the statute, is telling us that “independent copyrightability” is not the standard. The general understanding among most of the courts and Congress was that there had to be “a genuine contribution” to the total work. Although there may still be some ambiguity and litigation over what constitutes a “genuine contribution,” that standard addresses *de minimis* contributions, such as modifications and changes made by an editor, actors' ad libs that end up in the final script, and so on.

Many believe that the “independent copyrightability” standard adopted by the courts derives from Justice O'Connor's conclusory holding in *Feist v. Rural Publications*³²⁶ that “[o]riginality is a constitutional requirement.” The source of Congress' power to enact copyright laws is Article I, § 8, cl.8, of the Constitution, which authorizes Congress “to secure for limited Times to Authors . . . the exclusive Right to their respective Writings.”³²⁷ Justice O'Connor essentially equated “author” in Article I, section 8, clause 8 of the

³²³ See S.1223, 100th Cong., 1st Sess. (1987); S.1253, 101st Cong., 1st Sess. (1989).

³²⁴ *Id.*

³²⁵ *Id.*

³²⁶ 499 U.S. 340 (1991).

³²⁷ *Id.* at 346. It should be noted that the capitalizations of the nouns “Times,” “Authors,” and “Writings” appear as they did in the original. At the time of the drafting of the Constitution, nouns were often capitalized, as they are today in modern German.

United States Constitution (the Copyright and Patent Clause) with “one who creates original material.”³²⁸ This decision was not based upon any thorough analysis of the framers' intent, for there is none.³²⁹ The Copyright and Patent Clause was adopted without debate.³³⁰ As Professor Hamilton stated in her work, *Historical and Philosophical Underpinnings of the Copyright Clause*:

The [Constitutional] Convention record yields little. The Copyright Clause was introduced, never debated, never amended. It seems to be fait *accompli* that sparked no concerns from a group that wrangled for months over powers of the federal government.³³¹

Justice O'Connor's conclusion that something be “original” is a constitution requirement results from her blindly following two very old Supreme Court cases, *Burrow-Giles Lithographic Company v. Sarony*³³² and *The Trade-Mark Cases*.³³³ By decreeing that “originality” was a constitutional requirement, the Court held that works protected under “the sweat of the brow” doctrine that rewarded industrious labor in a Lockean sense were not available for protection.³³⁴ Professor Jane Ginsburg of Columbia Law School set

³²⁸ *Id.* at 346–47.

³²⁹ *See generally Feist*, 499 U.S. 340.

³³⁰ *See* Marci A. Hamilton, *Historical and Philosophical Underpinnings of the Copyright Clause*, 5 Occasional Papers In Intellectual Property From Benjamin Caldozo School of Law 1, 9 (1999).

³³¹ *See id.*

³³² 111 U.S. 53 (1884).

³³³ 100 U.S. 82 (1879). *See also Feist*, 499 U.S. at 346 (finding that “originality” is a constitutional requirement).

³³⁴ *See Feist*, 499 U.S. at 359–60.

forth the case that works created through labor should be protected.³³⁵ Such works would not be protected under *Feist*.³³⁶

There is evidence that “author” is not constitutionally required. First, if one examines the Copyright Act of 1976, one finds much language to the contrary.³³⁷ Section 102(a), the provision that sets forth the standards for copyrightable subject matter, uses the words “[c]opyright subsists in accordance with this title, in *original works of authorship*”³³⁸ Section 101 includes “original works of

³³⁵ See Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection Works of Information*, 90 COLUM. L. REV. 1865 (1990) (arguing for protection of “sweat works” in a piece written before *Feist*).

³³⁶ See generally *Feist*, 499 U.S. 349.

³³⁷ See 17 U.S.C. § 102.

³³⁸ See *id.* That section of the statute states:

Sec. 102. Subject Matter of Copyright: In General

(a) Copyright protection subsists, in accordance with this title, in original works of authorship 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. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

authorship” in the definitions of both derivative works and collective works.³³⁹ The contention that “originality equals author” is further belied when one looks to the “works made for hire” doctrine. The employer or the commissioning party, if the other requirements of Section 101(2) are met, is the statutory “author.”³⁴⁰ The contribution of the “author” in these cases is a paycheck! How can a paycheck be “copyrightable contribution”?

Congress deliberately chose to modify the language in the 1909 Act, to state “all the writings of an author,” because of the ambiguity.³⁴¹ Moreover, the inclusion of “original works of authorship” in several portions of the statute and the absence of this phrase in the “joint work” sections can lead one to believe that there is no copyrightable contribution. As Senator Cochran’s proposed amendments to include the requirement of “copyrightable contribution” illustrates, Congress did not think that there was an originality requirement at the time.³⁴² When drafting the 1976 Act, Congress could easily have stated “original contributions of authors” instead of “contributions” of authors.³⁴³ “Author” in Article I, Section 8, Clause 8 is neutral.³⁴⁴

It has been argued that because the words “Authors,” “Writings,” and “limited Monopoly” are used in the same clause, there is protection for all of the writings of authors.³⁴⁵ If there is protection for an author, and if originality is the requirement for copyright, then

³³⁹ See 17 U.S.C. § 101.

³⁴⁰ See *id.*

³⁴¹ H.R. REP. NO. 94-1476, at 51 (1976).

³⁴² S.1223, 100th Cong. (1987); S.1253, 101st Cong. (1989).

³⁴³ See Copyright Act of 1909, Pub. L. No. 60-349, ch. 320, 35 Stat. 1075, 1081, superseded by 17 U.S.C. §§ 101-914 (1982).

³⁴⁴ For a discussion of the definition of “author,” see generally Russ Versteeg, *Defining “Author” for Purposes of Copyright*, 45 AM. U. L. REV. 1323 (1996).

³⁴⁵ Randall P. Bezanson & Joseph M. Miller, *Scholarship and Fair Use*, 33 COLUM. J.L. & ARTS 409, 425 (2010).

an “author” is one who creates something original. Indeed, this argument could have been supported under a reading of the provisions of the 1909 Act, which protected all “the writings of an author.”³⁴⁶

When Congress was drafting the Copyright Act of 1976, it realized that the provision in the 1909 Act regarding “authors” was ambiguous.³⁴⁷ In order to eliminate this ambiguity, the language in the 1976 Act provided for “...*original* works of authorship fixed in any tangible medium of expression”³⁴⁸ If “author” means “original,” as advocated by some, then why add the word “original”? Would there not be the same meaning had the statute been drafted “works of authorship fixed in a tangible medium of expression”?

Words are the tools of the lawyer’s and legislator’s craft. They are chosen with deliberation, not capriciously. The word “original” in Section 102(a) of the Act implies that there can be two types of works of authors: (a) original works of authorship and (b) nonoriginal works of authorship. The only type of work that is protectable under the copyright laws are works of type (a)—“original works of authorship.”³⁴⁹ Nonoriginal works that are the end products of an author’s endeavors are not protectable. Congress, under its constitutional authority, made facts, ideas, methods, and systems of operation unprotectable under copyright law in Section 102(b).³⁵⁰

This difference is more than just a semantic difference. Anyone who writes something—or, for that matter, creates something—is an author. Casebooks and reporters are replete with opinions in which something that has been created is deemed not original and, therefore, not protectable. Is the person who writes an unprotectable idea an author? Is the person who compiles an unprotectable compilation not an author?

³⁴⁶ See Copyright Act of 1909, Pub. L. No. 60-349, ch. 320, 35 Stat. 1075, 1081, *superseded by* 17 U.S.C. §§ 101-914 (1982).

³⁴⁷ H.R. REP. NO. 94-1476, at 51 (1976).

³⁴⁸ See 17 U.S.C. § 102 (emphasis added).

³⁴⁹ *Id.*

³⁵⁰ See *id.* § 102(b).

The standard under the 1976 Act is the same as under the 1909 Act.³⁵¹ This standard is that of originality. Therefore, when Congress in the House Report stated that the originality requirement would not change, Congress was talking about the standard, not the definition of author.³⁵² The unambiguous language of Section 102(a), changed from the ambiguous language of the 1909 Act, leads one to the conclusion that not all works of authors are original.

If not all works are not original, then the language in Section 101 defining a joint work does not carry with it any originality requirement on the part of the respective contributions of collaborators. Just as Congress added the word “original” to Section 102(a) of the Act, so, too, could Congress have added the word “original” to Section 101's definition of a “joint work.” Congress easily could have written the statute as follows: “A ‘joint work’ is the original contributions of authors . . . etc.”

When reading a section of a statute, one must not read it in a vacuum. Sections of statutes must be read in the context of other sections of the same statute. When reading Sections 102(a) and 101 together, one reaches the unmistakable conclusion that the work of an author and an original work of authorship are not the same thing. An original work of authorship is one of the potential categories of works of authorship. In order to qualify for copyright protection, the work must be an *original* work of authorship under Section 102(a).

C. The Court Has Failed to Address the Rights of Collaborators Who Make Copyrightable Contributions in the Absence of Intent

In most of the cases, the courts have based their holdings on a lack of “mutual intent to the joint authors.” In doing so, the courts left open the issue of the respective rights of the parties in the event that each collaborator has made a copyrightable contribution. This creates

³⁵¹ Compare Copyright Act of 1909, Pub. L. No. 60-349, ch. 320, 35 Stat. 1075, 1081, *superseded by* 17 U.S.C. §§ 101-914 (1982), *with* 17 U.S.C. §§ 101-914 (2012).

³⁵² H.R. REP. NO. 94-1476, at 51 (1976).

a potential nightmare, whereby each party may enjoin the other party from using any of the copyrightable material contributed by the other. It also fosters additional litigation in order to determine exactly what the copyrightable contributions are. While ideas may not be protected, expression may.³⁵³ Courts would have to decide what is an idea and what is expression. In addition, courts would have to determine whether characters are “sufficiently developed” to receive protection or not.

In future joint-work cases, the issue of “implied nonexclusive licenses” should be addressed. An “implied nonexclusive license arises when (1) a person (the licensee) requests the creation of a work, (2) the creator (the licensor) makes the particular work and delivers it to the licensee who requested it, and (3) the licensor intends that the licensee-requestor copy and distribute his work.”³⁵⁴ The implied license doctrine gets around the writing requirement of Section 204. It also prevents the problem of parties who have specifically made contributions on commission for a particular purpose totally preventing the party who paid for the work from using any of it. For example, had Thomson attempted to enjoin all use of her contributions to *Rent*, the Larson heirs could have brought up the “implied license” doctrine.

³⁵³ See David A. Gerber, *Joint Authorship Requirements Questioned by Courts, Experts*, NAT'L L.J., Apr. 30, 1990, at 24 (“Although a contribution may not contain protected expression, it nonetheless may constitute an important (sometimes disproportionately important) contribution to the final product. A creator whose efforts may be extensive should not be excluded from sharing these rewards, nor should the co-creator be over-rewarded by being deemed the sole owner of the work.”).

³⁵⁴ *Lulirama, Ltd., Inc. v. Axxess Broad. Servs., Inc.*, 128 F.3d 872, 879 (5th Cir. 1997); see also *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 776 (7th Cir. 1996); *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 558-59 (9th Cir. 1990).

D. *Patent Law Does Not Require Each Inventor to Make A Fully Patentable Contribution*

It is also instructive to take a brief look at the sister area of intellectual property, patents, for guidance. The authority to regulate patents is also granted in Section 8, Clause 8, of Article I of the U.S. Constitution: “[Congress shall have the power] [t]o promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Writings and Discoveries.”³⁵⁵ The requirements for “joint inventorship” in patent law are, however, totally different, from those of “joint authorship” in copyright law.³⁵⁶ There is no requirement that the contribution of each joint inventor be independently patentable (i.e., “useful,” “novel,” and “non-obvious”) by itself.³⁵⁷ This is especially interesting given Justice O’Connor’s unequivocal holding that “originality is a constitutional requirement” for all authors in *Feist*.³⁵⁸ By the same logic, shouldn’t “patentability” be a constitutional requirement for all “inventors”?

The requirements for “inventorship” are (1) conception of the subject matter of the invention and (2) corroboration of the invention with others.³⁵⁹ Conception has been defined as “formation in the mind

³⁵⁵ U.S. CONST. art. I, § 8, cl. 8.

³⁵⁶ Gregory N. Mandel, *Left-Brain Versus Right-Brain: Competing Conceptions of Creativity in Intellectual Property Law*, 44 U.C. DAVIS L. REV. 283, 310–11 (2010).

³⁵⁷ *Id.*

³⁵⁸ *See Feist*, 499 U.S. at 346.

³⁵⁹ *See Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1460–61 (Fed. Cir. 1998); *see also* Dale L. Carlson & James R. Barney, *The Division of Rights Among Joint Inventors: Public Policy Concerns After Ethicon v. U.S. Surgical*, 39 IDEA 251 (1999); Anthony J. Luppino, *Fixing a Hole: Eliminating Ownership Uncertainties to Facilitate University-Generated Innovation*, 78 UMKC L. REV. 367, 398–403 (2009–10); *see generally* Tigran Guledjian, *Teaching the Federal Circuit New Tricks: Updating the Law of Joint Inventorship in Patents*, 32 LOY. L.A. L. REV. 1273 (1991).

of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.”³⁶⁰

Determining whether an alleged inventor participated in conceiving the subject matter or, phrased another way, made a “conceptual contribution” is important in determining who is a “joint inventor.” For parties to be legally deemed to be “joint inventors,” it is not necessary that they: (1) physically work together at the same time; (2) make the same type or amount of the contribution; or (3) make a contribution to the subject matter of each claim of the entire patent.³⁶¹

The standards for “joint inventorship” are much closer to those of the statutory language in copyright than to the new standards articulated in *Childress*. In fact, the consequence of deliberately omitting one who made a “conceptual contribution” to the invention because one of the inventors or the “dominant inventor” had the intent to own it herself is invalidity of the entire patent.³⁶² All inventors must be named in the patent application, regardless of size of the contribution of the respective joint inventor.

VI. CONCLUSION

The limits of copyright law should be set by Congress. If a court does not think that the statute, as written, will bring about the right result, it is not for the court to engage in judicial legislation by determining what is “more in the spirit of copyright.” As the Supreme Court said in *Deepsouth Packing Co. v. Laitram Corp.*:³⁶³ “The

³⁶⁰ *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986) (quoting 1 ROBINSON ON PATENTS § 376 (1890)).

³⁶¹ See *Ethicon*, 135 F.3d. at 1460 & 1471; see also Guledjian, *supra* note 359, at nn.74–90 and accompanying text.

³⁶² See 35 U.S.C. §§ 116 & 256.

³⁶³ 406 U.S. 518 (1972). In *Deepsouth*, the Supreme Court held that supplying a device in parts — a condition that was not in “operable assembly” — did not amount

direction of Art. I is that Congress shall have the power to promote the progress of science and the useful arts. When, as here, the Constitution is permissive, the sign of how far Congress has chosen to go can come only from Congress.”³⁶⁴ Courts should adhere to this admonition. As the statute now stands, there is no requirement for copyrightable contribution or for mutual intent to be joint authors. While application of the statute, as written, might bring about some undesired results, such as giving an authorship interest to one with whom one of the collaborators did not wish to share, it is not up to a court to rewrite the law in the “spirit” of what it thinks the law should be. If the law stands as is, courts should apply the “implied license” doctrine.

It should be remembered that the “works made for hire”³⁶⁵ case, *Reid*, was a very statutory case.³⁶⁶ In fact, the Justices took their time and effort to adhere to the statute, specifically noting that in the 1976 Act, Congress had created two different subsections, one for works created by employees and one for works created by commission of special order.³⁶⁷ Several courts were still employing old law in their cases, and they were admonished by the Supreme Court for not following the new statutory language that distinguished between the categories of works. Yet, only one year later, the Second Circuit ignored the statutory language of the “joint works” doctrine and developed its own standard that unfortunately has been followed by too many courts.

Admittedly courts have not been too happy with the statutory language, and that has led the courts to define their own standards. But it is up to Congress to change a statute, not the courts. If courts send the message to Congress that a law, as it stands, does not provide adequate results, Congress will reevaluate it and, if necessary, amend

to infringement. *Id.* at 528. The Court sent the message that it is up to Congress to establish the boundaries of the law. *See id.*

³⁶⁴ *Id.* at 530.

³⁶⁵ 17 U.S.C. §§ 101(1) & 101(2).

³⁶⁶ *See Reid*, 490 U.S. 730.

³⁶⁷ *See id.* at 738.

the statute, as it has done in the past, such as in response to *Deepsouth*³⁶⁸ or, in 1997, in response to *La Cienega Music v. ZZ Top*.³⁶⁹

If Congress feels that it is proper to add a “copyrightable contribution” standard, then Congress should amend the statute accordingly. As discussed earlier, legislation to do so had been introduced in the past and did not pass. If Congress feels that “intent” should be changed from “intent to merge the contributions into interdependent or inseparable parts of a unitary whole” to “mutual intent to be joint owners,” then Congress should amend the statute. However, if Congress is going to amend the statute to provide for “mutual intent to be joint authors,” Congress should add a writing requirement. As the cases illustrate, the lack of a writing between the parties often is found by the courts to be evidence of a lack of intent. That may or may not be true. If the parties had the intent at the time that the project started but had a falling out later, it is easy for one of them to say, “I never had the intention to share ownership or authorship.”

The following language should be added to the relevant portion of section 101: “provided that the parties sign a written instrument stating that the work shall be a ‘joint work.’” Although it does not reflect the “real world” practice, other sections of the Copyright Act have “written instrument” requirements.³⁷⁰ The parties would quickly learn that a writing is necessary. This proposal would create a clear standard and, if followed, would establish the intent of the parties.

³⁶⁸ *Deepsouth Packing Co.*, 406 U.S. at 530 (“When, as here, the Constitution is permissive, the sign of how far Congress has chosen to go can come only from Congress.”).

³⁶⁹ *La Cienega Music Co. v. ZZ Top*, 53 F.3d 950 (9th Cir. 1995), *cert. denied*, 516 U.S. 927 (1996). Congress reacted to Supreme Court inactivity, and passed 17 U.S.C. § 303(b), which provides: “The distribution before January 1, 1978, of a phonorecord shall not for any purpose constitute a publication of any musical work, dramatic work, or literary work embodied therein.”

³⁷⁰ *See, e.g.*, 17 U.S.C. §§ 101(2) & 204.

In general, creative parties do not sign agreements when they begin work. As stated previously, in general, creatives do not have lawyers on retainer. There are, however, incentives for collaborators to agree in advance. Joint authors, regardless of their quantitative contribution, are considered to be pro rata owners without a modification by agreement.³⁷¹ If the parties put it in writing, then one who contributes 80% of the material can negotiate with the other party to receive 80% of the royalties. In addition, without an agreement, each party is free to commercialize the work as he or she wishes—with the exception of assigning it away or granting an exclusive license—subject to an accounting and payment of the proper share of royalties. If one party desires only to license to PBS and the other wants to license to *The Jerry Springer Show*, there is nothing that can be done about without an agreement setting forth the respective uses and limitations. The law should move toward certainty. Judicial legislation—shaping the law into what a court thinks it should be—is not the way to do it.

³⁷¹ *Oddo v. Ries*, 743 F.2d 630, 632–33 (9th Cir. 1984).