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THE JOINT WORK DILEMMA: THE SEPARATELY COPYRIGHTABLE CONTRIBUTION REQUIREMENT AND CO-OWNERSHIP PRINCIPLE

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I celebrate myself;
And what I assume you shall assume;
For every atom belonging to me, as good belongs to you.¹

I. INTRODUCTION

Section 101 of the Copyright Act of 1976 defines a joint work as a work that is "prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole."² The Copyright Act does not define interdependent; however, Webster's Unabridged Dictionary provides this definition: "mutually dependent."³ Dependency requires influence or control by something else, or a reliance on something else for support or aid.⁴ One respected commentator states that joint work contributions are "interdependent" when they are assembled into a collective whole, rather than being recast

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1. WALT WHITMAN, *Song of Myself*, WALT WHITMAN SELECTED POEMS 15 (1992).

2. 17 U.S.C. § 101 (1988).

3. WEBSTER'S NEW UNIVERSAL UNABRIDGED DICTIONARY 956 (2d ed. 1983).

4. *Id.* at 488.

and incorporated into the whole.⁵

Joint works composed of interdependent parts may include a song with lyrics, a novel with illustrations, a computer program comprised of different components, or a mixed media artistic installation such as a sculpture with sound.⁶ In each instance, one component of the work is influenced or controlled by the other, and the relationship between the components of the works fits comfortably within the Webster definition. Furthermore, in these examples, the individual contributions are assembled into the final product, rather than being recast. While joint works may also be created when authors contribute inseparable components to the whole, this Article is primarily concerned with the peculiar problems of joint works comprised of interdependent parts.

In any one of the examples above, the work is considered a joint work if more than one author contributes to the work, and if the authors intend that the interdependent parts become a unified finished product. In such a case, absent an agreement to the contrary, the authors of the joint work are co-owners of the copyright in the work, each one enjoying an undivided ownership interest in the entire work. Each co-owner may freely utilize the work, subject only to a duty to account to the other co-owner. Arguably, one co-owner could also appropriate any portion of the work, even if that portion of the work was created by the other co-owner.⁷ As suggested by the Walt Whitman verse reproduced at the beginning of this article, joint authors create individually, yet share every atom of ownership with all co-authors.

Increasingly, courts have required each contribution to a joint work to be separately copyrightable. This trend is at odds with the definition of a joint work, which requires merger and unity, and also leads to a recognition that discrete individual efforts often

5. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 6.04 (1993).

6. Throughout this article, the mixed media art installation will be used as one example of a joint work. An article about a Miami art festival featuring precisely these types of collaborative efforts inspired this article. See Elisa Turner, *Sights, Sounds Harmonize in Three Collaborations*, THE MIAMI HERALD, Aug. 9, 1992, at 31.

7. See *infra* text accompanying note 134. The verb "appropriate" is used throughout this article to refer to situations where one co-author makes use of a portion of a joint work, as opposed to granting a license to the work. The co-author may freely grant a non-exclusive license to the joint work without the authorization of another co-author. *Noble v. D. Van Nostrand Co.*, 164 A.2d 834, 839 (N.J. Super. Ct. Ch. Div. 1960). However, one co-author cannot transfer the interest of another co-author without consent. 17 U.S.C. § 204(a) (1988); *Crosney v. Edward Small Products*, 52 F. Supp. 559 (S.D.N.Y. 1942); NIMMER § 6.11. Since the Copyright Act defines a "transfer of copyright ownership" to include an exclusive license, a co-author may freely grant only non-exclusive licenses to a joint work without the authorization of other co-authors. See 17 U.S.C. § 101 (1988).

combine to create a joint work. In light of this increased emphasis on each author's contribution, the co-ownership principles become harder to rationalize. This Article proposes that the "separately copyrightable" test not be used to determine the existence of a joint work, but instead to determine whether a joint work is interdependent. It further proposes a different form of ownership for collaborative efforts comprised of interdependent parts.

The existing joint work co-ownership provisions could lead to results not anticipated by the authors of component parts. A sculptor who creates a work in conjunction with a composer will discover that the composer may grant a non-exclusive license to the sculpture alone, subject only to the duty to account. The novelist who writes a book illustrated by a photographer will discover that the photographer may use the novel's story to create a different book with other photographs. Authors of interdependent works may fully intend to create a joint work, but may not anticipate the interest in the author's contribution to the joint work conferred upon the co-author. Case law reinforces the principle that later derivative works created or licensed by one author that incorporate any part of the joint work may not be the subject of an infringement action by the other author. The only remedy is an action for an accounting, which differs significantly from an infringement action.

More equitable ownership principles can be found by looking to European practice and by looking within the Copyright Act itself. The prevailing European definition of joint work does not encompass creations where authors contribute interdependent parts; only if authors' works are inseparable will many foreign jurisdictions perceive the authors as co-owners. This view recognizes the interest of individual authors in the components of collaborative works comprised of interdependent parts, and allocates ownership rights in a more sensible fashion. Another, perhaps preferable, approach would be to treat the joint efforts of authors in these cases as collective works, which would allow the authors to separately own the copyrights to the individual components of the work and limit the later use of the combined work. The use of collective work ownership principles has some appeal, but is not supported by existing copyright provisions, their legislative history, or case law.

Either the European rule or the collective work approach presents a more favorable positioning of the authors in the event a joint work is later appropriated. These approaches also better serve the purposes of copyright. However, neither view is currently

tenable in the United States. Based on the current law, the most prudent course of action is for joint authors to take preventative measures by contracting to restrict one another's use of the joint work and its components. In the following pages, the statutory provisions governing joint works, relevant case law, the extent of the joint work contribution and co-ownership dilemma, and the available remedies will all be explored.

II. BACKGROUND: STATUTORY PROVISIONS AND LEGISLATIVE HISTORY

The copyright protection afforded joint works is set forth in a number of provisions of the Copyright Act of 1976. To begin, joint works will qualify for copyright protection if they are original works that are fixed in a tangible medium of expression. Pictorial, graphic, and sculptural works are expressly recognized as being copyrightable.⁸ Therefore, joint works can be found in a number of mediums: popular songs, symphonies, books, and even mixed media artistic works, as in the case where a painter, sculptor, and composer collaborate on a single installation.⁹

The statutory definition of joint works points out that the authors must intend their contributions, whether they are inseparable or interdependent, to be part of a unitary whole.¹⁰ There is no requirement that each author of a joint work contribute the same amount to the work; rather, the traditional view has been that each author's contribution, whether qualitative or quantitative, must be at least something more than *de minimis*.¹¹ Increasingly, however, the courts dealing with this issue have required each author's contribution to a joint work to be separately copyrightable.¹² One commentator has argued against the "separately copyrightable" requirement, claiming it has been adopted for "evidentiary convenience, and that it contradicts the core concept of joint works as

8. 17 U.S.C. § 102 (1988).

9. The canvases created jointly by Andy Warhol and Jean Michel Basquiat in 1984 and 1985 are examples of joint works. See BOB COLACELLO, *HOLY TERROR: ANDY WARHOL CLOSE UP* 474 (1st ed. 1990).

10. Nimmer defines an author as "a creator in any medium to which the term writings may be applied," NIMMER § 1.06[B]. The term includes artists, composers, and photographers, as well as writers. *Id.*

11. See, e.g., *Words & Data, Inc. v. GTE Communications Serv., Inc.*, 765 F. Supp. 570, 575 (W.D. Mo. 1991) (relying on NIMMER § 6.07 (1990)).

12. *Childress v. Taylor*, 945 F.2d 500, 506-07 (2d Cir. 1991); *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 525 (9th Cir. 1990); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1493 (11th Cir. 1990); *Meltzer v. Zoller*, 520 F. Supp. 847, 857 (D.N.J. 1981).

being a unitary whole.”¹³ In any event, it appears that the separately copyrightable test will be easily met in most joint works composed of interdependent parts, as opposed to inseparable joint works.¹⁴ It is this separate nature of the contributions to a joint work composed of interdependent parts that raises questions regarding the extent of each author’s ownership.

Assuming the requisite intent exists, a joint work can result where a painter creates an enormous mural that is accompanied with sound, even if the sound is made up of, and played from, a relatively short sequence of audio tape. Likewise, a joint work will exist if an author writes a book of several hundred pages and an illustrator contributes a mere handful of illustrations.

Crucial to the creation of a joint work are the elements of merger and unity, regardless of whether the contributions are interdependent or inseparable.¹⁵ However, it is not necessary that an author know, at the time of the creation of her work, exactly how or when that work will be merged with that of another author. In *Edward B. Marks Music Corp. v. Jerry Vogel Music Corp.*,¹⁶ a lyricist wrote the words to a song and sold them to a music publisher who later hired a composer to write music for the lyrics. The composer and lyricist had not worked together on the song and, in fact, never met until years after the song was finished. However, the lyricist wrote the lyrics with the intent that they would be merged with music; likewise, the composer knew that he was writing music for lyrics.¹⁷ Based on these facts, the court found that the song was a joint work: “[I]t makes no difference whether the authors work in concert, or even whether they know each other; it is enough that they mean their contributions to be complementary in the sense that they are to be embodied in a single work to be performed as such.”¹⁸ This principle appears to remain viable even under the

13. Edward Valachovic, *The Contribution Requirement to a Joint Work Under the Copyright Act*, 12 LOY. L.A. ENT. L.J. 199, 214 (1992). A thorough analysis of this line of cases is not contemplated here. The author acknowledges the trend and proposes to illustrate that, in addition to contradicting the merger concept of joint works, the separately copyrightable test is incongruous with joint work co-ownership principles.

14. For example, in the song and lyrics example, the music and words would each be separately copyrightable. When contributions are inseparable, the separately copyrightable determination would arguably involve more of an inquiry.

15. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 103, 120, reprinted in 1976 U.S.C.C.A.N. 5659, 5736.

16. 140 F.2d 266 (2d Cir. 1944).

17. *Marks*, 140 F.2d at 266.

18. *Id.* at 267.

1976 Act.¹⁹ Therefore, if a sculptor creates a work intending that it will be combined with a work in another medium, such as sound, and if, at a later time, the sound is created by a composer who intends his sound to accompany the work, a joint work will result. The lapse between the co-authors' intentions under this rationale underscores how very separate the components of joint works can be, despite the fact that they may ultimately be merged.

Contrasted with joint works are compilations, which the Copyright Act defines as works "formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."²⁰ Compilations include collective works, ones "in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole."²¹ Examples of collective works include periodicals and encyclopedias.²² In a collective work, "the key elements are assemblage or gathering of 'separate and independent works . . . into a collective whole.'"²³ Compilations have been found to exist where existing street maps have been assembled into a composite,²⁴ where a directory of public relations firms was assembled,²⁵ and even where the sound recording of a hockey game was edited to be used in a miniature hockey game.²⁶ Compilations can exist where non-copyrightable material is assembled into a work which becomes copyrightable; collective works, however, contain a number of independent works that are copyrightable in and of themselves.²⁷ Thus, all collective works are compilations, but not all compilations are collective works.

19. NIMMER § 6.03.

20. 17 U.S.C. § 101 (1988).

21. *Id.*

22. *Id.*

23. HOUSE REPORT, *supra* note 16, at 120. The legislative history emphasizes the difference between joint works, "where the separate elements merge into a unified whole, and a 'collective work,' where they remain unintegrated and disparate."

24. *Adrien v. Southern Ocean County Chamber of Commerce*, 927 F.2d 132, 134 (3d Cir. 1991).

25. *J.R. O'Dwyer Co., Inc. v. Media Mktg. Int'l, Inc.*, 755 F. Supp. 599, 605 (S.D.N.Y. 1991).

26. *Innovative Concepts in Entertainment, Inc. v. Entertainment Enter. Ltd.*, 576 F. Supp. 457 (D.C.N.Y. 1983).

27. See HOUSE REPORT, *supra* note 16, at 120: "Unlike the contents of other types of 'compilations,' each of the contributions incorporated in a 'collective work' must itself constitute a 'separate and independent' work, therefore ruling out compilations of information or other uncopyrightable material and works published with editorial revisions or annotations"; see also *Southern Bell Tel. and Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801 (11th Cir. 1985).

Based on these definitions, if two authors create individual works fixed in a tangible medium of expression,²⁸ and if those works are assembled or coordinated and presented together, the result is either a joint work or a collective work. To illustrate the difference between joint and collective works, consider the following examples. A composer and an artist decide to work together to create a mixed media installation at a local museum. The resulting interdependent parts of the piece (the sound and the sculpture) form a joint work. In contrast, consider the sculptor inspired by the pre-existing music of a composer, who then decides the music would compliment a sculpture that she has previously created. If the sculptor assembles the two preexisting works for display, a collective work arguably results.²⁹

But what if the sculptor is inspired by the music and creates a sculpture to be merged with the music for ultimate display? In such a case, a joint work cannot exist, assuming that the composer, at the time the music was created, did not intend the music to be merged into a unitary whole. Likewise, to label the work as a collective work is inappropriate, since this scenario reflects more than the assembly of two or more preexisting works. What exists in this instance is a derivative work, as it is a transformation or adaptation of a preexisting work.³⁰

The proper labeling of these types of works is crucial, since different copyright protection exists in these three instances. In the first example, the artist and sculptor are co-owners of the copyright of the joint work.³¹ This co-ownership means that each author acquires an individual ownership in the entire work, "including all of the contributions contained therein."³² In the collective work example, the composer and artist retain the distinct copyrights in their individual contributions to the collective work, and, in the absence of any agreement to the contrary, the sculptor who assembled the work also acquires the copyright to the collec-

28. 17 U.S.C. § 192 (1988).

29. This appears to be so despite legislative history indicating that where there are a few separate elements brought together, it is unlikely that a collective work exists. House REPORT, *supra* note 15, at 120.

30. 17 U.S.C. § 101 (1988) defines a derivative work as "a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work'."

31. 17 U.S.C. § 201(a) (1988).

32. *Words & Data*, 765 F. Supp. at 574 (quoting NIMMER).

tive work, which carries the privileges of reproducing and revising the contributions as part of the collective work.³³ Finally, where the sculptor uses the composer's sounds in creating a derivative work, the sculptor owns the copyright to the derivative work, and that right extends only to the material contributed by the sculptor; the sculptor enjoys no rights in the preexisting music. The composer's copyright in the sound remains independent of the sculptor's rights.³⁴

Therefore, works that incorporate separate contributions may be protected in different ways, depending on whether they qualify as joint, collective, or derivative works. In the first instance, the authors are co-owners of the copyright. If the final work is a collective work, the individual authors retain copyright protection in their own works, and the person who assembles or coordinates the contributions acquires the privilege of presenting the contributions in the collection. In the case of a derivative work, the author of the preexisting material retains her copyright, and the author who later uses that material in the final work acquires copyright in the derivative work, limited to her contribution.

The owners of copyright in the above examples enjoy a number of rights, including the right to reproduce the work, to prepare derivative works, and to perform and display the work publicly.³⁵ Anyone who violates these rights may be subject to an infringement action.³⁶ Returning to our examples, the authors of the joint work each have an independent right to determine if the mixed media piece will be reproduced.³⁷ In the collective work example, the sculptor can present the combined work at a later time, and even revise the combined work, but cannot license the rights to the music.³⁸ Similarly, in the case of the derivative work, the sculptor can allow his sculpture to be photographed and reproduced for a postcard, but cannot authorize the public performance of the com-

33. 17 U.S.C. § 201(c) (1988).

34. 17 U.S.C. § 103(b) (1988). Importantly, 17 U.S.C. § 106 gives the owner of copyright the exclusive right to prepare derivative works. Therefore, in this hypothetical situation, the composer would have to authorize the use of the music.

35. 17 U.S.C. § 106 (1988).

36. 17 U.S.C. § 501 (1988). Before initiating an infringement action, the copyright owner must register the copyright. 17 U.S.C. § 411(a) (1988); *see, e.g., M.G.B. Homes*, 903 F.2d at 1488.

37. 17 U.S.C. § 109(b) (1988) allows the owner of a copy of a work, or one authorized by the owner, to display the copy publicly. This provision would generally allow a museum to display those joint works without facing infringement liability.

38. 17 U.S.C. § 103(b) (1988). The copyright in a collective work "does not imply any exclusive right in the preexisting material."

poser's music beyond the music's role in the derivative work.³⁹

The ramifications of these varying copyright interests can be surprising in the case of a joint work. Since the authors of the joint work each own an undivided right in the whole work, any author may use any portion of the joint work, or grant a non-exclusive license to the work, subject only to a duty to account for the profits to the other authors.⁴⁰ Therefore, the composer who is the co-author of the mixed media piece in the above example could grant a non-exclusive license for the reproduction rights to the sculpture without the permission of the sculptor, and would only have to provide an accounting to the sculptor. The sculptor could not sue the composer for infringement because it is impossible to infringe one's own copyright.⁴¹ Similarly, the sculptor could use the composer's music in conjunction with another of her sculptures, subject only to the duty to account to the composer. This result could surprise either or both of the artists, despite their intent to merge their interdependent works into a unified whole.

The result is, however, different in the case of a collective or derivative work. In the collective work example mentioned above, the sculptor (the author of the collective work) risks an infringement suit if she authorizes the use of the works of the painter that were used in the collection; likewise, the sculptor who creates a derivative work using the composer's music cannot license the rights to the music without facing infringement liability. The latter two results appear more logical than those arising in the case of a joint work, since the rights of the authors of the previously existing works are fully protected. Whether joint works composed of interdependent parts should be treated differently than collective or derivative works is the question this paper addresses. This Article proposes that the differing treatment is not warranted, and actually fails to serve the purposes of copyright.

III. THE EXISTENCE OF JOINT WORKS

Joint work issues have frequently arisen over the years and new trends continue to unfold. What follows is a discussion of cases dealing with joint work issues, largely focusing on those cases

39. Section 103 only provides a limited copyright to the author of the derivative work. The composer alone has the authority to authorize the public performance of the music. 17 U.S.C. § 103 (1988).

40. See *Strauss v. The Hearst Corp.*, 8 U.S.P.Q.2d 1832, 1837 (S.D.N.Y. 1988); *Ash-ton-Tate*, 916 F.2d at 522.

41. See *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429, 430 (S.D.N.Y. 1974).

involving joint works made up of interdependent contributions. The discussion will first analyze case law where joint works were found to exist, and will then discuss cases reaching the opposite conclusion.

A. Joint Works Composed of Interdependent Parts Found to Exist

A common example of a joint work is a song with lyrics. It is easy to picture the Gershwin brothers or Rogers and Hammerstein laboring together to create their songs, and there is little problem perceiving these works as interdependent parts intended to be merged into a unified whole. Numerous cases illustrate this principle, and in doing so they reiterate that the co-authors each own an undivided interest in the copyright.⁴² One court eloquently described the requisite creative process by noting that the co-author lyricist and composer of a song "both plan an undivided whole; in that case unless they stipulate otherwise in advance, their separate interest will be as inextricably involved, as are the threads out of which they have woven the seamless fabric of the work."⁴³

Joint works are found in other media as well. In *Donna v. Dodd, Mead & Co.*,⁴⁴ a book containing photographs was found to be a joint work. In this case, an author, Donna, and a photographer co-authored a children's book; the author provided the text, and the photographer provided illustrative photographs. Later, the photographer and his wife co-authored three books, using substantially the same format as the original work. Donna sued for infringement. She did not dispute the principle that if she was considered a joint author, she could not sue for infringement, since a copyright owner cannot infringe her own copyright.⁴⁵ However, she claimed that the original book was a composite work rather than a joint work,⁴⁶ and that she and the photographer possessed separate copyrights for their contributions. The basis of this argument was Donna's claim that the photographer did not have Donna's text in.

42. See, e.g., *Pye v. Mitchell*, 574 F.2d 476, 480 (9th Cir. 1978), where the court found that three co-authors created and wrote the words and music to a song, and as such each held an undivided one-third interest in the work.

43. *Marks*, 140 F.2d at 267.

44. 374 F. Supp. 429 (S.D.N.Y. 1974).

45. *Donna*, 374 F. Supp. at 430.

46. "Composite works" were defined in the Copyright Act of 1909 as works to which a number of authors contributed distinguishable parts. *Shapiro, Bernstein & Co. v. Bryan*, 123 F.2d 697, 699 (2d Cir. 1941). As such, they were similar to the current Act's collective works.

mind when he took the photographs.⁴⁷ However, the *Donna* court noted that the “preconcerted design” standard had been eroded.⁴⁸ The court in *Marks* had held that joint works will result even from authors who are strangers and who work at different times, as long as the authors at the time of creation intend their work to form part of an integrated whole.⁴⁹ Applying the *Marks* rule, the court found a joint work in *Donna*’s case, since it appeared that the photographer may have intended his photographs to be joined with text from another source at the time they were taken.⁵⁰

As an alternative rationale, the *Donna* court stated that a joint work would exist even if the photographer had no such intention when the photographs were taken. This view was based on the “12th Street Rag doctrine”, enunciated in *Shapiro v. Bernstein*, which stated that even if an author has no intent to merge a work with another at the time of creation, a joint work will nevertheless be created if that author later forms and carries out the necessary intent.⁵¹ However, under the Copyright Act of 1976, the 12th Street Rag doctrine is no longer viable.⁵² Therefore, for works created on or after January 1, 1978, the effective date of the current Act, there must be an intent to form a joint work at the time each contribution is created.⁵³ The demise of the 12th Street Rag doctrine leads to the conclusion that works incorporating a previously existing work, created without the intent that it become part of a joint work, will be deemed either collective or derivative works.⁵⁴ If the situation in the *Donna* case arose under the current Act, it would be necessary to demonstrate that the photographer, at the time he took his pictures, intended to merge his work with some text to be written in the future. Only then could the resulting book be considered a joint work.⁵⁵

47. *Donna*, 374 F. Supp. at 430.

48. *Id.* (citing *Marks*, 140 F.2d at 267).

49. *Marks*, 140 F.2d at 267. Before *Marks*, co-authors had to share a common design before the elements of the work were produced.

50. *Donna*, 374 F. Supp. at 430.

51. *Id.* (citing *Shapiro*, 161 F.2d at 409). This view is commonly referred to as the “12th Street Rag” doctrine, after the name of the song at issue in *Shapiro*.

52. NIMMER § 6.03 (relying on the Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law; 1965 Revision Bill, 89th Congress, 1st Session, Copyright Law Revision Part 6 (House Committee Print 1965)). The Supplementary Report, at page 65, expressly overrides the broadened intent concept of the 12th Street Rag Doctrine.

53. The House Report emphasizes that “the touchstone here is the intention at the time the writing is done.” HOUSE REPORT at 120.

54. See NIMMER § 6.06[B].

55. Books can also be joint works where the efforts of multiple authors are insepara-

The computer age has also spawned joint works composed of interdependent parts. In *Ashton-Tate Corp. v. Ross*, two men collaborated in the development of a computer spreadsheet program.⁵⁶ Ross alleged that the two decided that he, Ross, would write the computational component of the program (the "engine"), and the other, Wigginton, would write the user interface component.⁵⁷ There was no formal written contract between the two, and they each worked on their portions of the program, meeting on at least two occasions to discuss concepts for it.⁵⁸ At one of these meetings, Ross apparently provided Wigginton with a handwritten list of potential commands that could be incorporated into the user interface.⁵⁹ After working for six months, the two men developed a prototype program, but they had a dispute as to how it should be marketed. As a result, Wigginton approached Ashton-Tate, a leading publisher of software, hoping it would publish and market the program. Wigginton later discovered that Ross was not interested in having Ashton-Tate market the program.⁶⁰ Wigginton then went to work for Ashton-Tate, taking the user interface portion of the program with him.⁶¹ Ashton-Tate subsequently marketed a spreadsheet program which incorporated this interface with another engine in the final program.⁶²

Prior to completion of the Ashton-Tate program, Ross developed a user interface component, combined it with his engine, and produced his own spreadsheet program. He planned to use his own company, Bravo, to market his program.⁶³ Ross also met with Ashton-Tate and discussed his spreadsheet program, and at that meeting both parties signed nondisclosure statements. Ross claims that representatives of Ashton-Tate assured him that the nondisclosure statements covered information relating to Ross' program.⁶⁴ When Ashton-Tate later completed its spreadsheet program, Ross and Bravo demanded that they be compensated for Ross' contribution.

ble. For example, in the early 1960's, Alex Haley, the author of *Roots*, collaborated with Malcom X on the civil rights activist's autobiography. The book was published in 1964 and its manuscript was registered as jointly owned by Haley and Malcom X. *Malcom X Widow Sues for Proceeds from Manuscript*, PALM BEACH POST, Nov. 22, 1992, at 2A.

56. 916 F.2d 516, 517 (9th Cir. 1990).

57. *Id.*

58. *Id.*

59. *Id.*

60. *Id.*

61. *Id.*

62. *Id.* at 518.

63. *Id.*

64. *Id.*

Ashton-Tate then filed an action for declaratory relief.⁶⁵

The district court granted Ashton-Tate's motion for summary judgment on all issues, holding that Ross' suggested user commands were not enough of a contribution to Wigginton's interface to constitute a joint work.⁶⁶ The most interesting issue raised on appeal was Ross' claim that the prototype program created by him and Wigginton was a joint work, and that he was a joint author of the entire prototype, including the user interface.

The court held that a joint work requires that each author contribute an independently copyrightable contribution.⁶⁷ Because Ross only contributed a handwritten list of suggested user commands to Wigginton's interface component, the court found that Ross was not a co-author of the interface component and that the interface was therefore not a joint work.⁶⁸ The court conceded to the possibility that the Wigginton/Ross prototype program was a joint work, and that the two men may have obtained an undivided interest in the entire work.⁶⁹

The computer program prototype in *Ashton-Tate* falls squarely within the parameters of the joint work definition. Both Ross and Wigginton intended to create interdependent works that would be combined into a unified whole — the spreadsheet program. In this case there was no issue surrounding the timing of the authors' intent or the certainty of one author as to how or when his work would be merged with the other's. Nor was there an issue as to the amount each author contributed to the prototype because the court inferred that each component was separately copyrightable.⁷⁰ Assuming the possibility, as the *Ashton-Tate* court conceded, that the program prototype was a joint work, both Ross and Wigginton owned undivided interests in the whole work.

In another case, *Strauss v. The Hearst Corp.*, the publisher of *Popular Mechanics* magazine commissioned a commercial photographer to take photographs to be used in conjunction with an article. The court held the article to be a joint work.⁷¹ At the time of the "shoot," the photographer, Strauss, knew that his photograph

65. *Id.*

66. *Ashton-Tate Corp. v. Ross*, 728 F. Supp. 597, 602 (N.D. Cal. 1989).

67. *Ashton-Tate*, 916 F.2d at 521. The court acknowledged that this issue is not yet settled. For example, Nimmer claims that a joint work exists even where an author makes a lesser contribution. NIMMER § 6.07.

68. *Ashton-Tate*, 916 F.2d at 521-22.

69. *Id.* at 522. As discussed below, the court did not need to decide the issue, since Ross and Bravo misframed their relief.

70. *Id.*

71. 8 U.S.P.Q.2d 1832, 1833 (S.D.N.Y. 1988).

would be used for the first two pages of an article. As such, he knew that captions and copy would be superimposed on the picture when the article was finalized. One of the magazine's graphics editors who designed the layout of the article closely supervised Strauss.⁷² The magazine later used a modified copy of the article pages, including the photograph, in an advertising insert, and Strauss sued for infringement.⁷³ The court first ruled against the magazine's claim that its later use of the photograph was protected by the fair use doctrine.⁷⁴ However, the court found that the incorporation of the photograph in the first two pages of the article created or resulted in a joint work. In reaching this determination, the court noted that "it is hard to imagine a set of facts that is any clearer on that point. Neither party denies that both intended from the start for Strauss' photograph to be incorporated into the . . . article."⁷⁵ Because a joint work existed, Strauss could not sue for infringement; at best, he could sue for his pro rata share of the profits generated by the defendant's use of the joint work.⁷⁶

Similar to the components of the computer program prototype in *Ashton-Tate*, the title page with photography in *Strauss* was a joint work composed of interdependent parts. The magazine and Strauss were therefore co-owners of the copyright, each with an undivided interest in the whole.⁷⁷ Despite Strauss' objections, the unauthorized use of his photograph by the magazine could not lead to infringement liability.⁷⁸

In another case, *Words & Data, Inc. v. GTE Communications Services, Inc.*, the suggestions from a customer that became an integral part of a telemarketing form led a court to determine that

72. *Strauss*, 8 U.S.P.Q.2d at 1833.

73. *Id.* at 1834-35.

74. *Id.* at 1836.

75. *Id.* at 1837.

76. *Id.* at 1838.

77. Another case finding a joint work composed of inseparable components is *Weinstein v. University of Illinois*, 811 F.2d 1091 (7th Cir. 1987), where two assistant professors and a director of continuing education at a pharmaceutical college created a joint work by collaborating on a research article.

78. It has been suggested that because commissioning parties such as The Hearst Corporation are now limited in relying on a claim of sole copyright ownership based on the work for hire doctrine (See *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989)), they will now assert co-ownership based on the joint work doctrine. Kent R. Middleton, *The Inadvertent Joint Author: The Need to Establish Joint Authorship in Commissioned Work by Contract*, 8 U. MIAMI ENT. & SPORTS L. REV. 141, 144 (1991). However, the emergence of the separately copyrightable standard may make it more difficult for commissioning parties to substantiate a joint work claim.

the form was a joint work.⁷⁹ Sprint Communications Company collaborated with Words & Data to create a system that would allow Sprint to gather and track telemarketing information. The tracking form resulted in a combination of Words & Data's bar coding with Sprint's format and text. The court held that the encoding form was a joint work.⁸⁰

In one of its arguments, the plaintiff, Words & Data, argued that because Sprint never claimed to be a joint owner during the parties' collaboration there was no intent to establish the existence of a joint work.⁸¹ The court rejected that argument, however, by noting that a joint author's ownership arises automatically; no express claim of authorship is required.⁸² The court additionally relied on legislative history which states that collaboration alone will establish intent:

[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."⁸³

The court found that both parties collaborated on the telemarketing forms, and additionally found that at the time of the collaboration, Words & Data intended for its contributions to be integrated with those of Sprint.⁸⁴ Based on its reliance on the legislative history, the court appeared to view that the collaboration alone was sufficient to establish intent. The additional discussion of Words & Data's intent is curious since the legislative history requires that, as an alternative to collaboration, intent can be established if each party can show a preconcerted design. The facts showed no such intent on Sprint's part.

The *Words & Data* construction of intent embraces legal and factual intent. Although this liberal interpretation finds support in the legislative history, it has not been adopted by other courts.⁸⁵

B. Joint Works Found Not to Exist

Many of the cases which refuse to find joint works involve col-

79. 765 F. Supp. 570 (W.D. Mo. 1991).

80. *Words & Data*, 765 F. Supp. at 579.

81. *Id.* at 574-75.

82. *Id.* at 575.

83. *Id.* (quoting HOUSE REPORT at 120).

84. *Id.* at 575.

85. See, e.g., *Childress*, 945 F.2d at 507-08.

laborative efforts of the inseparable rather than interdependent genre. These cases are valuable for the additional light they shed on the elements of intent and level of contribution. In *Childress v. Taylor*,⁸⁶ an actress approached a playwright with the idea of writing a play about Jackie "Moms" Mabley. When the playwright, Alice Childress, agreed, the actress, Clarice Taylor, turned over all the research she had accumulated to Childress. In addition, Taylor conducted further research for the play at Childress' request.⁸⁷ The two spoke about the play on a regular basis, and Taylor suggested certain scenes and characters for the play.⁸⁸ The court found that Taylor "[e]ssentially . . . contributed facts and details about 'Moms' Mabley's life and discussed some of them with Childress." Childress, however, wrote all the dialogue and created the play's structure.⁸⁹ After the play was initially produced, the two women were unable to formalize their relationship; Taylor had the play rewritten by another playwright, and the new version was subsequently performed.⁹⁰ Childress sued Taylor and others for copyright infringement, and Taylor responded by claiming to be a co-author of a joint work. Had the court agreed, Taylor, as a co-owner of the copyright, would have been free to adapt the work with another playwright.

The claim that the play was a joint work failed. The court looked to the statutory definition of a joint work and reasoned that the "definition concerns the *creation* of the work by the joint authors, not the circumstances. . . ."⁹¹ Furthermore, the court noted that the legislative history requires a focus on two factors: the act of collaboration and the parties' intent.⁹² The court acknowledged the unsettled issue regarding the requisite level of contribution to a joint work, and determined that each contribution must be separately copyrightable.⁹³ In situations where a party makes a less than copyrightable contribution, protection can be afforded only by contract.⁹⁴ Therefore, the court's determination as to the exis-

86. 945 F.2d 500 (2d Cir. 1991).

87. *Childress*, 945 F.2d at 502.

88. *Id.*

89. *Id.*

90. *Id.* at 503.

91. *Id.* at 505 (emphasis in original).

92. *Id.* at 505.

93. *Id.* at 507. The court admitted that the issue was not an easy one to resolve, because the Copyright Act does not require each contribution to be copyrightable. Further, since "author" is not defined in the Act, there is no textual support requiring that co-authors of a joint work create copyrightable contributions.

94. *Id.*

tence of a joint work hinged on two elements: intent and the amount of contribution by each author.

Ultimately, the *Childress* court did not have to determine whether Taylor's contributions were copyrightable, because it agreed with the district court that the parties did not share the requisite intent.⁹⁵ Specifically, the district court determined that the parties had to "entertain in their minds the concept of joint authorship, whether or not they understood precisely the legal consequences of that relationship."⁹⁶ The court suggested two factors that could be helpful in making this determination: 1) whether, in the absence of a written contract, each party intended that all parties would be identified as co-authors; and 2) how the parties regarded themselves in relation to the work.⁹⁷ The result is that all contributors must fully intend to be joint authors.

Notably, the court found too broad the view that intent requires merely a finding that the parties intend their work to be part of a unified whole.⁹⁸ In the court's opinion, such a test could result in a finding of intent in unlikely situations.⁹⁹ The court found no evidence that Childress intended to enter into a joint authorship, or that she contemplated the play's authorship to be credited to both herself and Taylor. Rather, the court determined that Taylor merely offered advice as the actress who would play the title role, and that Taylor's intent to be a joint author was never shared by Childress. An important consideration to the court's decision was that after the play was written, Childress was unwilling to enter into any contractual arrangement that recognized a co-ownership of the rights to the play. Even though the proper focus was on the intent at the time of the writing, the court acknowledged that evidence of later conduct could be probative of a prior state of mind.¹⁰⁰

The narrow view of intent expressed by *Childress* contrasts sharply with the view embraced in *Words & Data*, which holds that collaboration alone may establish intent. This article does not attempt to either harmonize these views or resolve the issue, but rather exposes joint work intent as yet another area ripe for

95. *Id.* at 509.

96. *Id.* at 508.

97. *Id.*

98. *Id.* at 507.

99. *Id.* The court used the examples of a writer/editor relationship and a writer/researcher relationship, where the contributors typically intend their work to be merged but do not regard themselves as co-authors.

100. *Id.* at 509.

debate.

Courts have also disallowed joint works based on findings that the putative co-author failed to create a portion of the work. In *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*,¹⁰¹ M.G.B. filed an infringement action against Ameron, claiming that Ameron had constructed a home using the floor plan for one of M.G.B.'s model homes. M.G.B. claimed ownership of the copyright because of its relationship with the drafting company that produced the final floor plans for the model home. After the court rejected the idea that the plans were a product of an employee and therefore not a work for hire,¹⁰² it addressed the possibility that M.G.B. co-authored the plans, which, if true, would have rendered the plans a joint work.¹⁰³ To support its claim, M.G.B. argued that it provided a thumbnail sketch of the floor plan to the drafting company, "reviewed the drawings in progress, made suggestions and corrections, and had final approval authority over the work. . . ."¹⁰⁴ The court found that M.G.B. did what was expected of most clients in architectural settings, and that such a level of involvement would not make M.G.B. an author.¹⁰⁵ The court determined that M.G.B.'s contribution amounted to ideas, and was not copyrightable because M.G.B. had not "created" anything.¹⁰⁶

One court, in finding that a joint work was not created, stated that the determination must be made by considering both the quantity and quality of an alleged co-author's contribution.¹⁰⁷ In

101. 903 F.2d 1486 (11th Cir. 1990).

102. A work made for hire includes "a work prepared by an employee within the scope of his or her employment" 17 U.S.C. § 101 (1988). In the event a work for hire exists, the employer is considered the author and owns the copyright, unless the parties expressly agree otherwise in writing. 17 U.S.C. § 201(b) (1988). Whether a work is prepared within the scope of employment is determined by applying agency principles. See *CCNV*, 109 S.Ct. at 2174-76.

103. *M.G.B. Homes*, 903 F.2d at 1492.

104. *Id.*

105. *Id.* at 1493.

106. *Id.* In a footnote, the court stated that a work is not created until it is fixed in a copy for the first time. *Id.* note 16. Other cases have similarly rejected the contention that a joint work exists where a putative author has made mere suggestions regarding the content of the work. See, e.g., *Whelan Assoc. Inc. v. Jaslow Dental Lab., Inc.*, 609 F. Supp. 1307 (D.C. Pa. 1985), *aff'd*, 797 F.2d 1222 (3d Cir. 1986) (court rejected dental laboratory's claim that it was a joint author of a business software program because an officer and shareholder of the laboratory "did little more than explain the operations of the dental laboratory business and define the information he wanted to be able to obtain from the computer"); *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081 (9th Cir. 1989) (computer software company customer's suggestions, ideas, and limitations were insufficient to render him a joint author of a software program).

107. *Eckert v. Hurley Chicago Co., Inc.*, 638 F. Supp. 699 (N.D. Ill. 1986).

Eckert v. Hurley Chicago Co., the court noted that those cases that disallow joint work status when one party merely makes suggestions appear to focus not only on the quality of the contribution, but on the quantity as well. *Eckert* reasoned that "quality" is considered when courts find suggestions to be insufficient to constitute a joint work contribution. On the other hand, "quantity" is considered when courts find that the parties did not intend the suggestions to be merged into the final work.¹⁰⁸ The "quality" analysis appears to focus on the type of material that is contributed to the work, while the "quantity" analysis appears to focus on how much of the contribution is embodied in the final product.¹⁰⁹ As *Childress*, *Ashton-Tate*, and *M.G.B.* illustrate, the Second, Ninth, and Eleventh Circuits reflect a trend requiring a co-author's contribution to be independently copyrightable in order to be part of a joint work. In those jurisdictions, *Eckert's* "quality/quantity" analysis would arguably be unnecessary, because regardless of quality or quantity, if multiple contributions to a work are separately copyrightable, those courts will likely find that a joint work has been created, assuming the intent exists.

Unlike those cases that fail to find the requisite involvement and intent to create a joint work, the court in *Words & Data*¹¹⁰ held that the input of a customer was sufficient to make it a co-author of the completed work. As discussed above, Sprint and Words & Data created a system involving a series of bar-coded forms. Using the form in conjunction with a scanner and modem, Sprint representatives would transmit prospective customer information to Words & Data, which would then format the forms.¹¹¹ The deposition testimony of Words & Data's president undisputedly established that Sprint contributed all of the text for the forms, and that it also made suggestions as to the form headings and format.¹¹² When Sprint later sought to have another company handle the formatting of data, Words & Data sued for copyright infringement.¹¹³

The court distinguished cases such as *M.G.B.* by saying that client contributions to architectural firms are typically transformed

108. *Eckert*, 638 F. Supp. at 704.

109. *Eckert's* discussion of intent in conjunction with its "quantity" analysis is somewhat confusing. The intent of the parties to create a joint work is a separate requirement that must be addressed to determine if a joint work exists.

110. *Words & Data*, 765 F. Supp. at 579.

111. *Id.* at 572.

112. *Id.* at 577-78.

113. *Id.* at 572.

into highly refined plans, unlike Sprint's case, where its contributions remained intact on the final form. Moreover, it also distinguished other cases¹¹⁴ involving alleged co-authorship of technical coding systems by noting that the claim in *Words & Data* involved the infringement of the entire form, not merely the bar codes. The court found that both parties collaborated on the form, intending to integrate their contributions to create the final form.¹¹⁵ Furthermore, the court held that Sprint's contributions, including all of the form text and much of its format, were more than *de minimis*, rendering the form a joint work.¹¹⁶

The form in *Words & Data* was a joint work composed of the interdependent form text and bar coding. In reaching its joint work determination, the court indicated that if an alleged author's contribution is merely in raw form, and is taken and refined into a more sophisticated component of the final work by another author, it is less likely that the court will consider it a joint work. In its consideration of the final form a putative author's contribution takes in the joint work, the *Words & Data* court clearly focused on an author's level of contribution. The court found Sprint's contribution to be more than *de minimis*, and thus did not require each author's contribution to be separately copyrightable.¹¹⁷

IV. A PROPOSED USE FOR THE "SEPARATELY COPYRIGHTABLE" TEST

The foregoing case law exposes the current analysis that courts must undertake to determine whether parties have co-authored a joint work. First, at the time of creation, authors must intend to merge their work with another work in order to form a unified whole. Cases such as *Ashton-Tate*, *Words & Data*, and *Childress* underscore this requirement, although there is no consensus as to what constitutes intent. Secondly, assuming the intent exists, a growing number of jurisdictions require the contribution of each author to be copyrightable. The irony of this emerging contribution requirement is that it forces courts to search for a signifi-

114. These cases included *Whelan*, 609 F. Supp. at 1307, and *S.O.S.*, 886 F.2d at 1081. See *supra* note 107.

115. *Words & Data*, 765 F. Supp. at 575.

116. *Id.* at 575-79.

117. Many cases hold that forms in and of themselves are not copyrightable. See, e.g., *M.M. Business Forms Corp. v. Uarco, Inc.*, 472 F.2d 1137 (6th Cir. 1973); *Donald v. Uarco Business Forms, Inc.*, 344 F. Supp. 338 (W.D. Ark. 1972), *aff'd*, 478 F.2d 764 (8th Cir. 1973). But see *Continental Casualty Co., v. Beardsley*, 151 F. Supp. 28 (S.D.N.Y. 1957), *modified on other grounds*, 253 F.2d 702 (2d Cir. 1958), *cert. denied*, 358 U.S. 816 (1958).

cant measure of independence in components of collaborative works that, by statute, must be merged into a unified whole. It is also ironic that the enhanced contribution requirement requires individual and separable components in joint works, yet these separable components are co-owned by all the authors.

This is not to say that courts should not consider the copyrightable nature of one author's contribution in a joint work analysis, but that they should not use this as a bright line test for all joint works or to ease evidentiary determinations.¹¹⁸ The separately copyrightable threshold is more valuable as a tool to determine when joint works are based on interdependent, rather than inseparable, contributions.

The courts should retain a "more than *de minimis*" contribution requirement in determining whether a creation is a joint work, and should only find a joint work to exist when the co-authors meet this standard, assuming they possess the requisite intent. This lower contribution threshold has some support in case law and is embraced by a major commentator on copyright law.¹¹⁹ The more than *de minimis* standard fosters creative activity to a greater extent than does the separately copyrightable standard, because under the *de minimis* test, authors will create joint works more easily. It appears that the relaxed contribution standard would most notably result in the creation of more joint works composed of inseparable components.¹²⁰ As such, the *de minimis* approach furthers one of the often-enunciated purposes of copyright,¹²¹ and allows the joint work concept to retain vitality.

The separately copyrightable standard, in contrast, significantly restricts the existence of joint works, particularly those of the inseparable nature. It is more difficult, after all, to find separately copyrightable components in alleged joint works where the efforts are inseparable. Because the more stringent contribution standard would limit shared copyright protection, such a view would likely restrict artistic expression.

Assuming a more than *de minimis* contribution requirement for joint works is the better-reasoned choice, courts could then

118. See *supra* text accompanying note 13.

119. *Words & Data*, 765 F. Supp. at 575; Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Construction Co., 542 F. Supp. 252, 259 (D. Neb. 1982); NIMMER § 6.07.

120. For example, two authors might work so intimately on a project that it could become difficult to demonstrate the separate contributions in the final work. Under the more than *de minimis* approach, a joint work could still exist; under the separately copyrightable test, there would be no such result.

121. See *Stewart v. Abend*, 110 S. Ct. 1750, 1764 (1990).

look to any contribution that exceeds that standard as a factor in determining intent. The more substantial a contribution an author makes to a joint work, the more difficult it becomes for another author to claim that he did not intend to create a joint work. For example, in *Childress*, if Taylor had actually written a scene or two that was incorporated into the final play, *Childress* would have had more difficulty arguing that the final product was hers alone. Similarly, the court in *Words & Data* could have relied on Sprint's level of contribution to further bolster its determination that intent existed.

At a given point, the components of a joint work will be separately copyrightable. Once this occurs, courts should determine whether or not the joint work is made up of interdependent components. This approach would recognize that joint works composed of interdependent contributions are notably distinguishable from those composed of inseparable contributions, because the former involve individual efforts that can stand alone, despite the fact that they are merged with other authors' efforts.

Using the separately copyrightable test in this manner sets the stage for a renewed consideration of co-ownership principles for joint works. Simply put, should the copyright to joint works of both the inseparable and interdependent genre be co-owned by all the authors? In the author's view, courts should not apply co-ownership principles to joint works comprised of separately copyrightable contributions.¹²² As commentators have suggested, co-ownership can lead to unanticipated results. The following discussion highlights cases dealing with the later appropriation of joint works.

V. LATER APPROPRIATION OF JOINT WORKS COMPOSED OF INTERDEPENDENT PARTS

If collaborators produce a joint work, all of the co-authors own an undivided interest in the whole work. Each owner has the right to "modify, reproduce, or distribute copies of the work."¹²³ Nimmer points out that joint ownership means that each co-owner may, without the consent of the other owners, "exploit the work

122. Complex issues could arise where more than two authors engage in a collaborative effort where some co-authors create separately copyrightable contributions, and others contribute a lesser (but more than *de minimis*) effort. In such a case, a joint work should be found and all collaborators should be viewed as co-authors. However, the extent of each author's copyright ownership could conceivably differ.

123. *S.O.S.*, 886 F.2d at 1086; *Pye*, 574 F.2d at 480.

himself, or grant a non-exclusive license to third parties.”¹²⁴ In so doing, a co-author cannot sue the authorizing co-author for infringement, because he cannot infringe his own copyright. “The immunity of a joint owner from suit extends to the situation where one co-owner makes unauthorized use of the contribution of the other.”¹²⁵ While infringement is not possible, the co-owner who appropriates the work must account to the other co-owners for a rateable share of the profits realized from the use of the work.¹²⁶

These rules relating to the later use of a joint work are logical when the joint work is one that is made up of inseparable components. An illustrative case is *Weissmann v. Freeman*,¹²⁷ in which two physicians, Drs. Weissmann and Freeman, created a scholarly syllabus based on years of collaborative research and writing. Dr. Weissmann thereafter significantly modified the first syllabus to create her own work. It was not necessary that she obtain Dr. Freeman’s permission before setting out to modify the joint work, because her status as a co-owner allowed her to make these revisions on her own. Here, the underlying joint work was composed of the inseparable contributions of both doctors. As such, it would have been extremely difficult, if not impossible, to determine which author’s portion of the joint work was being utilized in the later work. Furthermore, due to the inseparable nature of the contributions, Dr. Weissmann was using every bit as much of her own work as of Dr. Freeman’s when she appropriated the underlying work. There should be no need to seek permission in such a case, and in fact, Dr. Freeman did not question Dr. Weissmann’s authority to revise the original syllabus.

Thus, the nature of a joint work comprised of inseparable parts warrants a co-owner’s unauthorized appropriation of that joint work. If the revised work is sufficiently original, it is a derivative work owned by the author who made the modifications. In *Weissmann*, the court identified the revised syllabus as a derivative work because Dr. Weissmann’s revisions were significant enough to satisfy the “modest requirements” of the Copyright Act.¹²⁸ A derivative work can consist of “editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship. . .,”¹²⁹ and the court held

124. NIMMER § 6.10.

125. *Strauss*, 8 U.S.P.Q.2d at 1837.

126. *Id.*; see also *Oddo v. Ries*, 743 F.2d 630 (9th Cir. 1984); NIMMER § 6.12.

127. 868 F.2d 1313 (2d Cir. 1989).

128. *Weissmann*, 868 F.2d at 1322-23.

129. *Id.* at 1321.

that Dr. Weissmann's additions to the syllabus satisfied this standard. Furthermore, since Dr. Weissmann alone created the derivative work, she was the sole owner of the revised syllabus.¹³⁰ The court noted that Dr. Freeman's intent to create the underlying joint work was not relevant in determining whether he was a joint owner of the derivative work, and specifically stated that it was error for the trial court to rule that the joint authorship of an underlying work automatically makes the authors co-owners of a derivative work.¹³¹ Dr. Weissmann's ownership of the revised syllabus meant that she held rights to that material which she contributed to the derivative work. Her copyright was independent of the copyright in the underlying joint work.¹³²

Less logical results may occur when an author appropriates a portion of a joint work comprised of interdependent parts. Because of copyright's co-ownership principles, "one joint author . . . obtains the right to use or license that portion of the joint work which was the sole creation of the other joint author."¹³³

The court in *Ashton-Tate* stated that the prototype spreadsheet program that had been created by the merger of Wigginton's user interface and Ross' engine could be considered a joint work.¹³⁴ The court noted, relying on *Weissmann*, that even if Ross was a co-owner of the prototype, he would not have been a joint owner of the final Ashton-Tate program because it was a derivative work.¹³⁵ The prototype program was a joint work based on separate but interdependent parts, but would still endow both authors with undivided interests in the whole prototype program. Therefore, each author could adapt or grant a non-exclusive license to any portion of the work without the consent of the other, subject only to a duty to account for profits. Applying this principle to *Ashton-Tate*, Wigginton was within his rights as a co-owner of the spreadsheet program prototype to bring it to Ashton-Tate for further development. The court recognized that if Wigginton had owned the finalized program, he would have had a duty to account to Ross.¹³⁶ The

130. *Id.* at 1318-20. The court specifically looked to the fact that unlike the articles in the underlying joint syllabus, the revised syllabus carried only Dr. Weissmann's name as author. See also *Childress*, 945 F.2d at 508.

131. *Weissmann*, 868 F.2d at 1319.

132. 17 U.S.C. § 103(b) (1988).

133. NIMMER § 6.06[A].

134. *Ashton-Tate*, 916 F.2d at 522.

135. *Id.*

136. *Id.* However, because Wigginton had sold his services and the use of his interface to Ashton-Tate, Ross at most would be entitled to only share in Wigginton's proceeds for the use of the interface.

resulting program would then be a derivative work, to which Ashton-Tate would own the copyright; the co-owned copyright in the underlying interface, however, would remain intact.

That result could seem illogical to someone in Wigginton's position, because any proceeds which would result from the marketing of the finalized program would come from its utilization of his, not Ross', contribution. As *Childress* states, however, joint works can exist without the authors realizing the legal consequences.¹³⁷ Moreover, Wigginton might never have created his interface but for the joint work project. Despite these arguments, the results of the co-ownership in this instance do not seem as fair as they do in a case such as *Weissmann*, where the joint work is based on inseparable components.

Even more unsettling is the prospect that a co-owner may utilize the portion of the joint work which she did not create, and merely have to account to the other owner. Traditional concepts of joint ownership support this result.¹³⁸ For example, in *Words & Data*, the telemarketing form incorporating Words & Data's bar code was a joint work composed of interdependent parts.¹³⁹ When Sprint sought to use the form, including the bar code, with another encoding company, it was sued for infringement because it allegedly prepared a derivative work, displayed the work publicly, and submitted the forms to other encoding companies.¹⁴⁰ Because the form was a joint work, however, the court found that an infringement action could not stand.¹⁴¹ While the court did not elaborate on this point, its holding meant that Sprint was free to use and modify the form, including the bar code, without the authorization of Words & Data. While Sprint would remain liable for a ratable share of profits derived from a new form, the result would arguably seem unfair to Words & Data, which may have preferred the form not to be used with another encoder.

Similarly, *Popular Mechanics'* later unauthorized use of Strauss' photograph illustrates the inequitable application of co-ownership principles.¹⁴² Strauss may never have wanted his photograph to become part of an advertising campaign, or he might have objected to how it was incorporated into the magazine's insert. Nevertheless, he had no say in any such later use because of his

137. *Childress*, 945 F.2d at 508.

138. See NIMMER § 6.06[A].

139. *Words & Data*, 765 F. Supp. at 578-79.

140. *Id.* at 571.

141. *Id.*

142. *Strauss*, 8 U.S.P.Q.2d at 1834.

status as a co-owner of the copyright.

An analogous result occurred in the case of *Oddo v. Ries*.¹⁴³ Oddo had authored a number of magazine articles relating to the restoration of Ford pickup trucks. He and Ries entered into a partnership where Ries would supply the capital and supervise Oddo's authorship and editing of a book on the same subject.¹⁴⁴ Oddo subsequently prepared a manuscript, largely based on the earlier magazine articles. Ries became dissatisfied with Oddo's progress and later hired another writer to complete the manuscript.¹⁴⁵ The book was eventually published, containing substantial quantities of Oddo's manuscript with additions by the new author.¹⁴⁶ Because Ries was Oddo's partner, he was a co-owner of the partnership assets, including the manuscript. He therefore had the right to use the manuscript by having another author complete the work, but had to account to Oddo for profits.¹⁴⁷ Importantly, this case was not based on the fact that the manuscript was a work made for hire, but was instead based on co-ownership principles.¹⁴⁸

Oddo's co-ownership did not arise by virtue of two authors contributing interdependent parts to a joint work; rather, the co-ownership existed because of a state law's view of a partnership agreement. Nevertheless, the partnership co-ownership is analogous to the copyright co-ownership, in that it illustrates that a co-owner who did nothing to create part of a work may thereafter use it subject only to a duty to account.

Artists and authors in these situations may be surprised to see that their work may have a life beyond the immediate project, and that new life may be dictated by someone other than themselves. Their ignorance of the legal consequences of co-ownership will not shield them from potential adverse results.

VI. CO-OWNERSHIP ILLUSTRATIONS, POLICY, AND EXPECTATIONS

Suppose two composers decide to collaborate on a symphony. Suppose further that, as they work, they work together in such a way that their individual creative efforts are inseparable. As long as each contribution passes the more than *de minimis* threshold,

143. 743 F.2d 630 (9th Cir. 1984).

144. *Oddo*, 743 F.2d at 632.

145. *Id.*

146. *Id.*

147. *Id.* at 633.

148. While the court found no infringement of the manuscript, it did find that Ries infringed Oddo's copyright in the magazine articles. *Id.* at 634.

the result will be a joint work. If thereafter one of the composers decides to rework the symphony into a chamber piece such as a string quartet, that could be accomplished without the permission of the other composer. Moreover, the string quartet would be a derivative work. The quartet composer would have to account to the other composer for the profits garnered by using the symphony as the underlying work for the derivative piece.

Returning to the example of the mixed media installation, assume the sculptor and composer agree they will each create an interdependent work. The result here will also be a joint work, but distinguishable from the above example because each contribution is separately copyrightable. Nevertheless, the sculptor and composer will co-own the copyright to the entire joint work, and may use any portion of the joint work subject to a duty to account to the other. Therefore, the sculptor could use the music in conjunction with another sculptural work without the composer's approval. The new work would be a derivative work to which the sculptor would hold the copyright. Likewise, without the sculptor's approval, the composer could compose another sequence of music to be used with the same sculpture. Again, the new mixed media piece would be a derivative work owned by the composer.

This Article proposes that the symphony/string quartet example is more equitable than the mixed media example for two reasons. First, because the symphony would be comprised of truly inseparable creative efforts; a requirement of requesting the permission of the other co-author before using the work would amount to a requirement of asking yourself permission to use your own work. Such a requirement would needlessly frustrate one purpose of the Copyright Act, which is to foster creative endeavors.¹⁴⁹ But in the mixed media example, even though a collaborative intent exists, it is inescapable that the creative efforts are separate even though they are merged into a unified whole. Allowing one co-author to use a component of this type of joint work without the permission of the author of that component may foster creative endeavors, but does so at the expense of the component's author. In fact, the later use of the component by a non-author co-owner frustrates a competing goal of the Copyright Act: to allow an artist control over her own work for the duration of its copyright.¹⁵⁰

The United States Supreme Court recently stated that the goals of disseminating creative works to the public and artistic

149. *Stewart*, 110 S. Ct. at 1764.

150. *Id.*

control must be balanced.¹⁵¹ Assuming the co-author of a joint work has created a copyrightable contribution that is merged with another to form the joint work, the subsequent use and modification of that contribution by another co-author, without permission, seems to frustrate the original author's control rights. In effect, the current status of the law appears to punish those authors who choose to collaborate on a joint work, because it strips them of the control they might otherwise have had if they had completed the work alone and independently copyrighted it. Furthermore, the argument that those artists will still be able to enjoy the profits from the later use of their work by way of the accounting requirement may not provide the relief desired by the author. And, as will be shown below, the remedy of an accounting may afford only limited relief.

VII. INFRINGEMENT AND ACCOUNTING ACTIONS

If a cause of action for infringement exists, remedies such as damages and injunctive relief are available. Section 501 of the Copyright Act provides the right to bring an action if one has violated any of the exclusive rights of the copyright owner.¹⁵² The Act affords flexible relief to a plaintiff in an infringement action. A court may grant temporary and permanent injunctions against the infringer,¹⁵³ impound, destroy, or otherwise dispose of the infringing articles,¹⁵⁴ and award either actual damages (and any additional profits of the infringer) or statutory damages.¹⁵⁵ Statutory damages may range from \$500 to as much as \$100,000,¹⁵⁶ depending on the nature of the infringement.

Courts will consider statutory damages where, not uncommonly, profits or damages are difficult to prove.¹⁵⁷ For example, difficulty may exist in calculating actual damages where the in-

151. *Id.*

152. 17 U.S.C. § 501 (1988).

153. 17 U.S.C. § 502 (1988).

154. 17 U.S.C. § 503 (1988).

155. 17 U.S.C. § 504(c) (1988).

156. *Id.* The court may determine the amount of liability in a sum not less than \$500 or more than \$20,000 for all infringements involved in the action with respect to any one work. *Id.* Furthermore, if the infringement was willfully committed, the court has the discretion to increase the statutory damages to no more than \$100,000. *Id.*

157. *United Features Syndicate, Inc. v. Spree, Inc.*, 600 F. Supp. 1242, 1245 (E.D. Mich. 1984) *appeal dismissed*, 779 F.2d 53 (6th Cir. 1985); *Lauratex Textile Corp. v. Allton Knitting Mills Inc.*, 519 F. Supp. 730, 732 (S.D.N.Y. 1981); *Lottie Joplin Thomas Trust v. Crown Publishers, Inc.*, 592 F.2d 651, 657 (2d Cir. 1978).

fringer fails to provide the necessary documentation,¹⁵⁸ or where the plaintiff fails to accurately quantify damages.¹⁵⁹ In any event, the trial court has a great deal of discretion in determining damages, especially statutory damages.¹⁶⁰

These flexible remedial provisions, however, are not available to the author of a joint work whose contribution is appropriated by a fellow author. That damaged party must sue for an accounting. While this Article does not attempt to present a thorough review of the scope of an accounting action, a brief discussion is illustrative of its limitations.¹⁶¹

Both statutory and equitable accountings are viable causes of action,¹⁶² but in the context of a co-owner who objects to the appropriation of his contribution to a joint work, an equitable accounting appears to be the proper action. In an analogous context, an equitable accounting was permitted where a plaintiff claimed a share of profits based on a number of contractual provisions.¹⁶³ Equitable accountings are also available where the issues are complex.¹⁶⁴ A suit brought by an aggrieved co-owner of the copyright in a joint work would probably fit into this equitable setting, because the co-ownership arising from the relationship between the authors is similar to a contractual relationship. It is also likely that a determination of the ratable share of profits due to the plaintiff author would involve complicated computations.

Assuming an equitable action is proper, the plaintiff would first be required to demonstrate a right to the accounting.¹⁶⁵ Other cases describe this burden as requiring the plaintiff to "allege and prove that there is something due him or her."¹⁶⁶ Because statutory damages are often resorted to in infringement actions, as precise damage calculations are difficult to assess, plaintiffs seeking an accounting may have difficulty meeting this burden. In *Strauss*, for example, the court openly stated that Strauss would have difficulty

158. *Cable/Home Communications Corp. v. Network Prod., Inc.*, 902 F.2d 829, 851 (11th Cir. 1990).

159. *RSO Records, Inc. v. Peri*, 596 F. Supp. 849, 860 (S.D.N.Y. 1984).

160. *Video Views, Inc. v. Studio 21, Ltd.*, 925 F.2d 1010, 1016 (7th Cir. 1991), *cert. denied*, 112 S. Ct. 181 (1991).

161. A search of accounting cases yielded none that arose from a joint work dispute.

162. *Harmon Care Centers, Inc. v. Knight*, 340 N.W.2d 872 (Neb. 1983).

163. *Zichel v. Knell*, 210 S.W.2d 59, 62 (Mo. 1948).

164. *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 478 (1962).

165. *Goldfarb Novelty Co. v. Vann*, 94 So.2d 845, 848-49 (Fla. 1957); *Wood v. Brackett*, 266 So.2d 398, 399 (Fla. 1st D.C.A. 1972); *Randolph Foods, Inc. v. McLaughlin*, 115 N.W.2d 868, 871 (Iowa 1962).

166. *Cimino v. W.A. Piel, Inc.*, 416 N.W.2d 505, 508 (Neb. 1987).

in both proving the amount due him by way of an accounting, and in proving a causal connection between the use of the joint work and the magazine's advertising profits.¹⁶⁷

In addition, while the court has the power to grant full relief,¹⁶⁸ it also has a great deal of discretion in making its determination.¹⁶⁹ Furthermore, an appeal from an accounting action is limited; the ultimate decision cannot be overturned unless it is against the manifest weight of the evidence¹⁷⁰ or if there is a facial error of law.¹⁷¹

Apparently, plaintiffs in an accounting action do not enjoy the same flexibility afforded infringement plaintiffs. This differing relief exists despite the fact that both the sole author of a copyrighted work and the individual author of a joint work who has seen her work appropriated in an offensive manner have had their control over their work compromised in much the same way.¹⁷² An author's intent to create a joint work logically warrants special copyright treatment of the joint work itself; however, extending that special treatment by imposing co-ownership principles which allow the unauthorized later use of portions of the joint work by a co-owner is not only unwarranted, but is inequitable.

VIII. SUGGESTED CO-OWNERSHIP ALTERNATIVES

Assuming that unfair treatment of authors exists in these instances, what alternatives are available to afford more equitable treatment? If courts use the separately copyrightable test to distinguish between joint works of the inseparable and interdependent sort, they should consider whether and when to apply co-ownership principles to those types of works. Simply put, if each component of a joint work is separately copyrightable, do the existing co-ownership provisions make sense? The application of tenancy-in-common principles in such a case is illogical to the extent that one

167. *Strauss*, 8 U.S.P.Q.2d at 1838. Without proof of the causal connection, the court stated that only nominal damages of \$1.00 would be in order. *Id.*

168. *Dowell v. Dowell*, 316 P.2d 850, 852 (Okla. 1957).

169. *Cimino*, 416 N.W.2d at 506.

170. *Id.*

171. *Appeal of Priestly*, 17 A. 1084, 1086 (Pa. 1889).

172. An equal protection question possibly lurks within this issue. At least one argument exists that the author of an interdependent contribution to a joint work is similarly situated to the sole author of a copyrighted work. This argument gains greater force in light of the trend that requires each author's contribution to be separately copyrightable. In spite of this similarity, the two are treated differently with respect to the remedies available to them in the event of later appropriation of their work. Even applying a rational relationship/lowest level scrutiny analysis, the differing treatment may raise a constitutional issue.

author could appropriate or authorize the use of another author's work.

One alternative would be to adopt the view of a number of European jurisdictions and refuse to treat works composed of interdependent contributions as joint works. Another possibility would be to treat these works in the same manner as collective works. In lieu of these alternatives, artists must protect themselves before entering into collaborations with other authors so they are able to control the ultimate destiny of their work.

In a number of European jurisdictions, authors must contribute inseparable works in order to consider the resulting work a joint work. In those countries, it is not enough that the works be merely interdependent.¹⁷³ Therefore, these countries would not consider the sculpture and sound mixed-media piece or a song with lyrics to be joint works. This view focuses more on the separate identity of the components of a collaborative effort than on the intent to create a unified end product. Such an approach works well, because it recognizes a distinction between different sorts of collaborative efforts that American law fails to embrace.

Even if a foreign jurisdiction recognizes a collaborative effort as a joint work, it will typically require all the joint owners to consent to license a joint work.¹⁷⁴ Thus even in those foreign jurisdictions that would view a work comprised of interdependent parts as a joint work, the consent of all authors would be required in order to validly license the work. In such a case, the joint work could be disseminated, but not without the agreement of each author. This approach reaches a fair balance between recognizing artists' desire for control over their works, and the competing interest of allowing the dissemination of creative works.

The limited European definition of joint work and its licensing restrictions avoid some of the joint work co-ownership problems currently existing under the Copyright Act. Another, and perhaps better way to address the problem would be to treat a collaborative work made up of interdependent parts as a collective work. Under the proposed use of the separately copyrightable test, the owners of any collaborative effort which is comprised of separately copyrightable components would be treated in this manner.

A collective work is a work such as an encyclopedia or anthology, where separate and independent works are assembled into a

173. NIMMER § 17.07. This view is shared by the United Kingdom, Germany, the Netherlands, and Austria. *Id.* n.2.

174. *Id.* §§ 17-10[B], 6.10[C].

collective whole.¹⁷⁵ The authors of the separate components of a collective work own the copyright to those components, and the individual who assembles those components into a whole acquires the copyright to the whole.¹⁷⁶ Applying this concept to the situation where two artists create separately copyrightable works intending them to be merged together, each artist would first own the copyright to her individual work, and both would own the copyright to the assembled piece. Co-ownership principles would apply only to the collaborative work, meaning that either artist could make use of the combined work. Under this approach, however, only the artist who created any single contribution could exercise the exclusive rights of copyright for that particular contribution. If the other author appropriated that artist's contribution, an infringement action and all of its relief would be available to the artist.

Better than the European approach, the collective work approach serves the purposes of copyright law. Such a view allows authors to control their own copyrightable works, but also recognizes them as co-owners of the collective work. This promotes the dissemination of artistic works without unnecessarily frustrating the authors' control over their works.

The obvious difficulty with the collective work approach is that under the current Act, joint works composed of interdependent parts are co-owned joint works. The European view is also inapposite to the current statutory definition of a joint work. Legislative history poses problems as well for the collective work approach, because it states that collective works are typically comprised of a significant number of contributions.¹⁷⁷ Therefore, without legislative revision, courts will view authors who have pre-concerted designs to create a unified work comprised of interdependent and separately copyrightable components as the authors and co-owners of a traditional joint work.

Artists who contemplate a collaboration where their contribution is separately copyrightable and valuable on its own must protect themselves by contracting with their co-authors. It is essential that they reserve for themselves the rights to license and use their contributions to joint works, or risk seeing their work appropriated in a manner that they may find offensive or unwise.

175. 17 U.S.C. § 101 (1988).

176. 17 U.S.C. § 201(c)(1988).

177. See *supra* text accompanying note 30.

IX. CONCLUSION

As it increases in acceptance, the separately copyrightable contribution requirement will raise questions about traditional notions of joint works. The more each contribution to a joint work is required to stand on its own, the less the concepts of merger and unity can be meaningfully addressed. A better analysis would be to continue to recognize joint works as long as each contribution meets the *de minimis* standard. Any significant amount of contribution in excess of a *de minimis* level could be used as a factor in determining whether the parties intended to create a joint work. Once the contributions are separately copyrightable, the joint work could be identified as the interdependent type.

Analyzing individual contributions to joint works in this manner crystallizes the inconsistency inherent in the existing co-ownership principles as they relate to joint works composed of interdependent parts. The possibility that one co-author can freely appropriate work that another author exclusively created is an unfortunate restriction on an artist's right to control her own work. Artists do not have the luxury of having a crystal ball to see if, how, or when, their works may be used in the future. But where artists combine their work with another's to create a traditional joint work, the current law allows the later use of their work to be placed in another's hands subject only to a duty to account. Artists currently must protect against this possibility by contracting to retain their rights to the use of their work.

More sensible and equitable alternatives exist, either by narrowing the definition of joint works to exclude those works composed of interdependent parts, or by treating joint works made up of interdependent parts as collective works. The ultimate goals should be to allow artists to retain control over their individual works and to co-own the combined work. By restructuring both the analysis of joint work contributions and the resulting scope of co-ownership, the joint work provisions of copyright will better reflect the expectations of authors.

