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THE INADVERTENT JOINT AUTHOR: THE NEED TO ESTABLISH JOINT AUTHORSHIP IN COMMISSIONED WORKS BY CONTRACT

KENT R. MIDDLETON*

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I. INTRODUCTION

Popular Mechanics commissioned Steven Strauss, a commercial photographer, to photograph several fishing rods, reels, and miscellaneous fishing gear.¹ Bryan Canniff, *Popular Mechanics'* graphics director, provided the gear and helped arrange it for the photos during two of three sessions at Strauss's studio.² After Strauss's third shooting session, the magazine was not satisfied with the photographs.³ *Popular Mechanics* then hired other professionals to retouch the final photo. The final retouched photo, credited to Strauss, was published in 1985, illustrating an article entitled "What's New In Fishing Tackle."⁴

Without Strauss's permission, *Popular Mechanics* also published a modification of the photo in a promotional insert in the magazine.⁵ Strauss filed suit claiming the second use of the photo infringed his copyrighted work. The Hearst Corporation, publisher of *Popular Mechanics*, responded that publication of the photo

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1. *Strauss v. Hearst Corp.*, 8 U.S.P.Q.2d 1832 (S.D.N.Y. 1988).

2. *Id.* at 1833.

3. *Id.* at 1833-34.

4. *Id.* at 1834.

5. *Id.*

constituted a fair use—an argument the United States District Court for the Southern District of New York rejected.⁶ The district court agreed with Hearst's second argument, however, that the publisher could republish the photo without Strauss's permission because Strauss and Hearst were joint authors of the photo.⁷ Hearst co-owned copyright in the photo and could use it without Strauss's permission, provided the publisher paid Strauss his share of the profits derived.⁸

Strauss, like other photographers, artists,⁹ film crews,¹⁰ and fabric designers¹¹ inadvertently became a joint copyright owner, learning only after completing the work that the commissioning party claimed joint authorship.¹² In some cases, the commissioning

6. *Id.* at 1836. While the court performed the four-part fair use analysis, it concluded that an analysis of the nature of the copyrighted work, the substantiality of the portion used, and the effect of the alleged infringement on the market for copyrighted work was unnecessary because the "purely commercial character" of the use placed the infringement "well outside the realm of uses conceivably protected by the fair use doctrine." *Id.*

7. *Id.* at 1836-38. A joint work is one prepared by "two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." 17 U.S.C. § 101 (1988). Each contributor to a joint work acquires an undivided ownership in the entire work. *Meltzer v. Zoller*, 520 F. Supp. 847, 857 n.23 (D.N.J. 1981). See *M. NIMMER & D. NIMMER, 1 NIMMER ON COPYRIGHT* § 6.03, at 6-6 (1989) [hereinafter 1 NIMMER]. The joint owner may not be liable to a co-owner for copyright infringement because an owner "cannot infringe his own copyright." *Weissman v. Freeman*, 684 F. Supp. 1248, 1260 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). Absent an agreement to the contrary, joint authors share equally in the ownership of the joint work, even if respective contributions are not equal. 1 NIMMER, at § 6.08.

8. *Strauss*, 8 U.S.P.Q.2d at 1838. Strauss and Hearst were treated as tenants in common:

Under the [proposed 1976 copyright revision] bill as under the present copyright law, co-owners of a copyright would be treated generally as tenants in common, with each co-owner having an independent right to use or license the use of a work, subject to a duty of accounting to the other co-owners for any profits.

H.R. REP. NO. 1476, 94th Cong., 2d Sess. 121 (1976) [hereinafter H.R. REP. NO. 1476]. The revision, the 1976 Copyright Act (1976 Act), is found at 17 U.S.C. § 101 *et seq.* (1988).

Strauss, as a joint author, was entitled to a pro rata share of the profits generated by Hearst's use of the photo in the promotion. *Strauss*, 8 U.S.P.Q.2d at 1838. However, the judge expressed "serious doubt" that Strauss could prove with sufficient certainty the amount due him: "The joint work used in the promotional insert constituted only one element of the insert which was itself probably only a small portion of the total efforts used to induce business to advertise in Popular Mechanics magazine." *Id.*

9. *Community for Creative Non-Violence v. Reid*, 652 F. Supp. 1453 (D.C. Cir. 1987), *rev'd*, 846 F.2d 1485 (D.C. Cir. 1988), *aff'd*, 490 U.S. 730 (1989) (sculptor).

10. *E.g.*, *Easter Seal Soc'y for Crippled Children and Adults of Okla. v. Playboy Enters., Inc.*, 815 F.2d 323 (5th Cir. 1987), *cert. denied*, 485 U.S. 981 (1988).

11. *E.g.*, *Mister B Textiles, Inc. v. Woodcrest Fabrics*, 523 F. Supp. 21 (S.D.N.Y. 1981).

12. In *Reid*, the district court did not consider whether the Community for Creative Non-Violence (CCNV) was a joint author of a sculpture it commissioned from sculptor

party only hired and supervised the freelancer, never contributing copyrightable expression upon which to base a claim of joint ownership.¹³ Whether an inadvertent joint author realizes greater rewards from a co-authored work than from an independently owned work is debatable. In some cases, inadvertent co-authors might realize greater rewards because freelancers' rights in joint works are not limited to their own contributions.¹⁴ However, the co-author runs the risk that the copyright co-owner will diminish the value of a joint work by exploiting it exhaustively or in inappropriate settings.¹⁵ Furthermore, a copyright law that permits freelancers to become inadvertent joint authors contravenes the purpose of copyright, which is to encourage creative activity¹⁶ in fair and predictable copyright relations.¹⁷ At the very least, unsuspecting joint authors may find it burdensome to learn they must share copyright with new co-owners because former co-owners have sold their interests.¹⁸ Richard Weisgrau, Executive Director of the American Society of Magazine Photographers, points out how inadvertent joint authors may be disadvantaged by their co-authors:

[Joint work status] deprive[s] the creator of the value of copy-

James Earl Reid, ruling instead that the sculpture was a work for hire. *Reid*, 652 F. Supp. at 1457. The D.C. Circuit reversed and remanded the case on the joint-authorship question. *Reid*, 846 F.2d at 1499, *aff'd*, 490 U.S. at 753.

13. For a discussion of supervision and copyrightability, see *infra* text accompanying notes 51-92.

14. Note, *Manifest Intent and Copyrightability: The Destiny of Joint Authorship*, 17 *FORDHAM URBAN L.J.* 257, 264-65 (1989) (authored by Therese M. Brady) [hereinafter Note, *Manifest Intent*]. *Contra* CARY, STUDY NO. 12: JOINT OWNERSHIP OF COPYRIGHTS 92-101, reprinted in 1 *STUDIES ON COPYRIGHT* 696-705 (A. Fisher, ed., mem. ed., 1963). See also *supra* note 8 (accounting between joint copyright owners often difficult).

15. See, e.g., *Easter Seal Soc'y for Crippled Children and Adults of Okla. v. Playboy Enters., Inc.*, 815 F.2d 323 (5th Cir. 1987), *cert. denied*, 485 U.S. 981 (1988) (film commissioned by charitable society sold by joint author for use in sexually-oriented program).

16. "Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries" U.S. CONST., art. I, § 8, cl. 8. Congress reaffirmed the nurturing function of copyright in the 1976 revision:

By substituting a single Federal system for the present anachronistic, uncertain, impractical, and highly complicated dual system, the [proposed 1976 copyright revision] bill would greatly improve the operation of the copyright law and would be much more effective in carrying out the basic constitutional aims of uniformity and the promotion of writing and scholarship.

H.R. REP. NO. 1476, *supra* note 8, at 129.

17. According to the Supreme Court, "Congress' paramount goal in revising the 1976 [Copyright] Act . . . [was] enhancing predictability and certainty of copyright ownership." *Reid*, 490 U.S. at 749 (citing H.R. REP. NO. 1476, *supra* note 8, at 129).

18. *Moral Rights in Our Copyright Laws: Hearings on S. 1253 Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary*, 101st Cong., 1st Sess., 77 n.39 (1989) [hereinafter *1989 Hearings*].

right rights because they are exploited instead by better-funded co-owners who usually do not bother (especially since they have no legal obligation to do so) to advise the creator of the deals that have been made, and to share the profits generated by them.¹⁹

Independent contractors should expect commissioning parties to claim joint authorship in a work more frequently. The United States Supreme Court's decision in *Community for Creative Non-Violence v. Reid*²⁰ limited the circumstances in which commissioning parties may claim sole copyright ownership in commissioned works for hire.²¹ Additionally, the increasing use of digital forms of writing and editing invites earlier participation by commissioning parties, further blurring the distinction between independently authored and joint works.²²

To establish order and fairness in copyright relations, Senator Thad Cochran introduced a bill in the 101st Congress²³ that would deny joint authorship claims to commissioning parties who do not make original copyrightable contributions to a commissioned work.²⁴ Cochran's proposal would also require that the parties to a commissioned work sign a joint-work contract before work begins.²⁵ This Article supports the requirements of the Cochran bill

19. *Id.* at 77.

20. 490 U.S. 730 (1989).

21. See *infra* notes 25, 38-50 and accompanying text. Prior to the Supreme Court's work-for-hire ruling, the United States Court of Appeals for the District of Columbia noted that more joint-works cases could be expected after the substantial cutback in the work-for-hire doctrine as a result of the 1976 Copyright Act. *Reid*, 846 F.2d at 1485, 1497 n.17.

22. For a discussion on the digitalization of writing, pictures, and other communication, see M. KATSH, *ELECTRONIC MEDIA AND THE TRANSFORMATION OF LAW* 92-94 (1989).

23. S. 1253, 101st Cong., 1st Sess., 135 CONG. REC. S7343-44 (daily ed. June 22, 1989). S. 1253 died in committee, but Senator Cochran intends to reintroduce a similar bill in the 102d Congress. Telephone interview with Linda Roach, legislative assistant to Senator Cochran (Jan. 30, 1991).

24. *Id.* S. 1253 would amend the definition of joint work in 17 U.S.C. § 101. With the proposed language italicized, the definition would read:

"A 'joint work' is a work prepared by two or more authors with the intention that their *original* contributions be merged into inseparable or interdependent parts of a unitary whole, *provided that, in the case of each specially ordered or commissioned work, no such work shall be considered a joint work unless the parties have expressly agreed in a written instrument, signed by them before commencement of the work, that the work shall be considered a joint work.*"

S. 1253, 101st Cong., 1st Sess., 135 CONG. REC. S7343-44.

25. *Id.* at S7344. S. 1253 would also exclude independent contractors working on commission from being considered "employees" under the work for hire doctrine. *Id.* S. 1253 provides that a work made for hire be a work "prepared by a *formal* salaried employee within the scope of his or her employment." *Id.* (emphasis added). Requiring that employees be "formal salaried" workers would have halted the practice emerging before *Reid* of

that protect freelancers from inadvertently becoming joint authors by requiring commissioning parties claiming joint authorship to (i) make a copyrightable contribution, and (ii) sign a joint-work agreement.

II. COPYRIGHTABLE CONTRIBUTIONS

A. *Development of Freelancers' Rights*

The copyright provision of the Constitution promotes the progress of science and the useful arts.²⁶ The copyright statute stimulates creative expression that benefits society by granting a monopoly to a copyright owner. Before the revision in 1976, copyright statutes favored publishers over individual creators. Under the copyright law of 1909,²⁷ a short story writer could sue a playwright for copyright infringement only with the cooperation of the story writer's publisher, who most likely owned the copyright.²⁸ Before the 1976 revision of the law, independent contributors to magazines, newspapers, and other collective works transferred all rights, often unknowingly, when they cashed checks from their publishers.²⁹ Thus, a primary goal of the 1976 Act was "to clarify and improve the present confused and frequently unfair legal situation with respect to rights in contributions" to collective works.³⁰

The 1976 Act aided independent creators by relaxing notice³¹

commissioning parties claiming that freelancers working on commission were employees if the commissioning party merely supervised or retained the right to supervise the free lancer. See *infra* notes 38-50 and accompanying text. In *Reid*, the United States Supreme Court did not adopt the formal employee standard, ruling instead that an independent contractor would be an employee only if he or she met the criteria of employees under agency law. *Reid*, 490 U.S. at 750-51. See *infra* notes 47-50 and accompanying text. Thus, *Reid* went a long way towards meeting the goals of Senator Cochran's work-for-hire provision by rejecting the line of cases holding that a commissioning party could claim to be the employer simply by hiring or supervising a freelancer.

26. See *supra* note 16.

27. Act of March 4, 1909, ch. 320, 35 Stat. 1075 (1909).

28. *Dam v. Kirke La Shelle Co.*, 175 Fed. 902 (2d Cir. 1910).

29. *Id.* See also *Best Medium Pub. Co. v. National Insider, Inc.*, 259 F. Supp. 433 (N.D. Ill. 1966), *aff'd*, 385 F.2d 384 (7th Cir. 1967), *cert. denied*, 390 U.S. 955 (1968), *reh'g denied*, 390 U.S. 1008 (1968).

30. H. REP. No. 1476, *supra* note 8, at 122. A collective work is a work "such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." 17 U.S.C. § 101 (1988). A primary goal related to clarifying confusion was to "ensur[e] predictability" of copyright relations through advance planning. *Reid*, 490 U.S. at 750.

31. 17 U.S.C. § 405 (Supp. 1990). See generally Middleton, *Copyright Law and the Journalist: New Powers for the Free-Lancer*, 56 JOURN. Q. 38 (1979).

and registration requirements,³² extending the duration of copyright,³³ and allowing rights in commissioned works that are not works for hire to be renegotiated after thirty-five years.³⁴ Divisibility of copyright provided greater flexibility for independent authors, allowing them to grant copyright to publishers and producers for limited uses without relinquishing all other rights, including copyright, in the underlying work.³⁵ A freelancer contributing to a magazine or other collective work retains all copyright rights, except for first publication rights, unless the parties expressly agree otherwise by contract.³⁶ Revision of the work-made-for-hire doctrine, under which an employer owns the copyright in the work of employees and some commissioned works, further strengthened freelancers' rights.³⁷

B. Works Made for Hire

Section 101(1) of the 1976 Act provides that a work made for hire may be produced in one of two ways. The work may be prepared by an employee within the scope of his or her employment,³⁸

32. 17 U.S.C. § 411 (Supp. 1990).

33. 17 U.S.C. § 302(a) (1988).

34. 17 U.S.C. § 203(a) (1988).

35. 17 U.S.C. §§ 201(d)(1), (2) (1988) provides that copyright owners' exclusive rights, or any subdivision of them, may be transferred "in whole or in part" and "owned separately." Inclusion in the 1976 Act of divisible copyright relieved freelancers from having to seek cooperation of publishers to sue for copyright infringement. *See supra* text accompanying notes 27-30.

36. 17 U.S.C. § 201(c) (1988) provides:

Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

Id.

37. *See infra* notes 38-50 and accompanying text.

38. Section 101 of the Copyright Act of 1976 defines "work made for hire" as follows:

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

17 U.S.C. § 101 (1988).

If a work for hire is created, the employer owns all rights:

In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless

or it may be specifically ordered or commissioned for use as a contribution to a collective work, provided the parties expressly agree in writing that the work is to be considered a work made for hire.³⁹ Some jurisdictions limited the definition of an "employee" acting within the "scope of his or her employment" to "formal" salaried employees.⁴⁰ Other jurisdictions, however, held that commissioned freelancers were "employees" operating within the "scope of their employment" when the commissioning party merely supervised a job⁴¹ or retained the right to supervise.⁴² These jurisdictions did not require that a freelance "employee" be salaried, enjoy fringe benefits, or meet other criteria normally associated with employment. Under such expansive interpretations of "employee" and "scope of employment," a freelancer did not necessarily know at the time work commenced whether the commissioning party would later claim the freelancer was an employee creating a work for hire.⁴³ Freelancers thus unintentionally became employees, inad-

the parties have expressly agreed otherwise in a written instrument signed by them, owns all the rights comprised in the copyright.

17 U.S.C. § 201(b) (1988).

39. *Id.*

40. *See Dumas v. Gommerman*, 865 F.2d 1093 (9th Cir. 1989) (freelance graphic artist not a formal salaried employee).

41. The Second Circuit enunciated the actual-control test in *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.), *cert. denied*, 469 U.S. 982 (1984) (statuettes considered works for hire because commissioning company exercised extensive supervision of manufacturing process).

42. Under the right-to-control test, it was not necessary that the hiring party supervise the work, only that he or she retain this right. *See, e.g., Town of Clarkstown v. Reeder*, 566 F. Supp. 137 (S.D.N.Y. 1983) (town owned copyright in handbook prepared by volunteer without supervision); *see also Epoch Producing Corp. v. Killiam Shows, Inc.*, 522 F.2d 737 (2d Cir. 1975), *cert. denied*, 424 U.S. 955 (1976).

43. In a discussion of the actual-control test, the Supreme Court wrote:

In a 'copyright marketplace,' the parties negotiate with an expectation that one of them will own the copyright in the completed work. With that expectation, the parties at the outset can settle on relevant contractual terms, such as the price for the work and the ownership of reproduction rights. To the extent that petitioners endorse an actual control test, CCNV's construction of the work for hire provisions prevents such planning. Because that test turns on whether the hiring party has closely monitored the production process, the parties would not know until late in the process, if not until the work is completed, whether a work will ultimately fall within § 101(1). Under petitioners' approach, therefore, parties would have to predict in advance whether the hiring party will sufficiently control a given work to make it the author. 'If they guess incorrectly, their reliance on "work for hire" or an assignment may give them a copyright interest that they did not bargain for.' This understanding of the work for hire provisions clearly thwarts Congress' goal of ensuring predictability through advance planning. Moreover, petitioner's interpretation 'leaves the door open for hiring parties, who have failed to get a full assignment of copyright rights from independent contractors falling outside the subdivision (2) guidelines, to unilaterally

vertently creating works for hire.

Senator Cochran's bill would limit works made for hire to those "prepared by a formal salaried employee within the scope of his or her employment."⁴⁴ Although the Cochran bill is to be reintroduced in the 102d Congress,⁴⁵ the Supreme Court's decision in *Community for Creative Non-Violence v. Reid*⁴⁶ obviates the urgency for legislatively narrowing the definition of "employee," as the Cochran bill would.

In *Reid*, the Supreme Court ruled that whether persons who create works on commission are employees should be determined by applying the common law of agency.⁴⁷ Although an "employee" is not as narrowly defined in agency law as the "formal salaried" employee proposed in the Cochran bill, agency law requires that several criteria be met. Among the factors to be considered in determining whether an independent contractor is an employee under agency law are the hiring party's right to control creation of the product, the skill required, the source of the tools, the location of the work, the duration of the relationship between the parties, the provision of employee benefits, and the tax treatment of the hired party.⁴⁸ In *Reid*, the Court found that James Earl Reid, a sculptor commissioned to produce four homeless figures, was not an employee of the non-profit Community for Creative Non-Violence (CCNV), the organization that commissioned the work. In so deciding, the Court considered that CCNV did not provide Reid with salary, regular work space, fringe benefits, or other emoluments usual to employment.⁴⁹ Under *Reid*, commissioning parties are not employers simply because they supervise or retain the right to supervise a work.

The Court remanded *Reid* for a determination of whether CCNV was a joint author with Reid. If a joint author, CCNV could

obtain work-made-for-hire rights years after the work has been completed as long as they directed or supervised the work, a standard that is hard not to meet when one is a hiring party.'

Reid, 490 U.S. at 749-50 (citations omitted). See Hamilton, *Commissioned Works as Works Made for Hire Under the 1976 Copyright Act: Misinterpretation and Injustice*, 135 U. PA. L. REV. 1281, 1304 (1987).

44. 1989 Hearings, *supra* note 18. See *supra* notes 24-25 and accompanying text.

45. See *supra* note 23.

46. 490 U.S. 730 (1989).

47. *Id.* at 751-52.

48. *Id.* Other factors include whether the hiring party has the right to assign additional projects to the hired party, the extent of the hiring party's role in hiring and paying assistants, and whether the hiring party is in business. *Id.*

49. *Id.* at 753. The Court rejected the formal definition of "employee" because Congress had not defined "employee" as a formal, salaried worker. *Id.* at 742-43 n.8.

display the sculpture and pedestal without Reid's permission, provided CCNV paid Reid a proportion of the profits earned. The appellate court had earlier suggested that *Reid* might be a "text-book" example of joint authorship, in part because CCNV conceived the idea for the sculpture and supervised Reid's work.⁵⁰

C. Supervision Not Copyrightable

The subject matter of copyright subsists "in original works of authorship fixed in any tangible medium of expression."⁵¹ A work of a sole author need embody little originality to be copyrightable.⁵² An author need only contribute something more than trivial variation.⁵³ Any expression demonstrating a modicum of intellectual effort and originality suffices for a creator to claim sole authorship of a work.⁵⁴ The Supreme Court stated that originality is "little more than a prohibition [against] actual copying."⁵⁵ An author is "he to whom anything owes its origin."⁵⁶ But ideas, procedures, processes, systems, and concepts are not original works of authorship capable of being copyrighted.⁵⁷ Neither are facts.⁵⁸

Photos, although "an example *par excellence* of a representa-

50. *Reid*, 846 F.2d at 1497. Reid's contribution, a steam grate pedestal on which Reid's sculpted figures rested, qualified him for joint authorship. *Id.* The steam grate was, arguably, an embodiment of artistic expression because it "was designed and constructed precisely 'to portray the appearance of' an actual streetside grate." *Id.* at 1496. See also 17 U.S.C. § 101 (1988). The court was therefore satisfied that the grate, which was designed to conform to the sculpted figures, was not an uncopyrightable utilitarian object. *Reid*, 846 F.2d at 1497.

CCNV's contribution of the pedestal, however, was not the primary reason for considering CCNV a joint author. The court found Reid's most prominent argument against being a sole author to be that "CCNV was the motivating factor in the procreation of [the sculpture] 'Third World America' " *Id.* at 1496-97. CCNV, the court said, "conceived the idea in starkly specific detail and directed enough of [Reid's] effort to ensure that, in the end, he had produced what [CCNV], not he, wanted . . ." *Id.*

The court of appeals, however, is misguided in its contention that a commissioning party's joint authorship in a work should be based primarily on the commissioning party's "motivating" and "directing" the independent contractor and "conceiving the ideas" for the work. Motivating, directing, and conceiving ideas are not copyrightable contributions justifying joint copyright ownership for their contributors. See *infra* text accompanying notes 51-92.

51. 17 U.S.C. § 102(a) (1988).

52. *Reid*, 846 F.2d at 1496.

53. *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976).

54. "It suffices if the author refrains from copying from prior works and contributes more than a minimal amount of creativity." H. HENN, COPYRIGHT LAW 48 (1988).

55. *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239, 250 (1903).

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

57. 17 U.S.C. § 102 (1988).

58. Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569, 1594 (1963).

tion of an objective fact," are copyrightable.⁵⁹ As Justice Holmes noted: "The least pretentious picture has more originality in it than directories and the like, which may be copyrighted."⁶⁰ Photographers' originality lies in their "arranging the subject as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression."⁶¹ Copyright ownership belongs to the photographer who "superintend[s] the arrangement."⁶² American courts have recognized the need to find sufficient originality to warrant copyright in photographs, a quest that reflects a concern for the expenditure of time and effort embodied in photographs.⁶³

The contribution of a joint author must also be an original work of authorship. A joint work is one "prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole."⁶⁴ Congress failed to define what constitutes "contributions," but courts and commentators agree that a contribution must be a work of authorship.⁶⁵ Similarly, Congress intended that contributions to joint

59. *Id.* Works of authorship have never been limited to writings that can be read from the printed page. The first copyright act included a provision that protected authors of maps, charts, and books. Act of May 31, 1790, ch. 15, 1 Stat. 124. An amendment to the copyright act in 1802 provided copyright protection to engravings, etchings, and prints. Act of April 29, 1802, ch. 36, 2 Stat. 171. Protection was extended to photographs in 1865. Act of March 3, 1865, ch. 126, 13 Stat. 540. The Copyright Act of 1976 protects pictorial, graphic, and sculptural works, as well as literary, musical, and dramatic works. 17 U.S.C. § 102 (1988). Works of authorship also include pantomime and choreography, motion pictures and other audiovisual works, and recordings. *Id.*

60. *Bleistein*, 188 U.S. at 250 (1903). Judge Hand later wrote: "[N]o photograph, however simple, can be unaffected by the personal influence of the author" *Jeweler's Circular Publishing Co. v. Keystone Publishing*, 274 Fed. 932, 934 (S.D.N.Y. 1921), *aff'd*, 281 Fed. 83 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922). Even the "least pretentious picture" contains sufficient originality to be copyrightable. *Bleistein*, 188 U.S. at 250. Even a very modest grade of art expresses the author's unique personality. *Id.* at 251. Furthermore, "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *Id.*

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

62. *Id.* at 61 (quoting *Nottage v. Jackson*, 11 Q.B.D. 627 (1883)). "It undoubtedly requires originality to determine just when to take the photograph," another court observed, "so as to bring out the proper setting for both animate and inanimate objects, with the adjunctive features of light, shade, position, etc." *Pagano v. Charles Beseler Co.*, 234 Fed. 963, 964 (S.D.N.Y. 1916).

63. Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569, 1596 (1963).

64. 17 U.S.C. § 101 (1988).

65. See, e.g., *Reid*, 846 F.2d at 1494. Nimmer wrote that a "contribution" to a joint work must be "authorship." 1 NIMMER, *supra* note 7, § 6.07, at 6-18.

works be furnished by "authors."⁶⁶ A work is "joint" if (1) the authors collaborated with each other, or (2) both authors prepared their contribution with the knowledge and intention that it would be merged with the contributions of other authors. For example, in *Strauss v. Hearst Corp.*,⁶⁷ a New York court found that Brian Canniff, the graphics editor of *Popular Mechanics*, was a joint author with Steven Strauss, the commissioned photographer, because Canniff designed the layout for the photo, supervised some of the shooting sessions, and provided props and arranged the composition.⁶⁸

Some courts have recognized joint authorship where the authors contribute only the modicum of originality required of sole authors.⁶⁹ Other courts and commentators set a higher standard of joint authorship, requiring a contributor to a joint work to make a more substantial contribution than a sole author.⁷⁰ Nimmer subscribes to the notion that ideas, which by themselves are not copyrightable,⁷¹ constitute contributions to joint authorship.⁷² Citing Nimmer, the D.C. Circuit Court in *Reid* suggested that CCNV may be a joint author with the sculptor it commissioned because the commissioning party conceived the idea and monitored the progress of the sculpture of the four homeless persons.⁷³

66. See 17 U.S.C. § 101 (1988).

67. 8 U.S.P.Q.2d 1832 (S.D.N.Y. 1988).

68. *Id.* at 1833, 1837. In *Strauss*, the court did not distinguish between the level of originality necessary to claim authorship in a joint work and the work of sole authorship.

69. See, e.g., *Reid*, 846 F.2d at 1496. See *supra* text accompanying notes 52-56.

70. See, e.g., *Picture Music, Inc. v. Bourne*, 314 F. Supp. 640, 647 (S.D.N.Y. 1970), *aff'd*, 457 F.2d 1213 (2d Cir.), *cert. denied*, 409 U.S. 997 (1972). Nimmer, following *Picture Music*, argues that "more than the minimal copyright standard of 'distinguishable variation' must be added" in joint works. 1 NIMMER, *supra* note 7, § 6.03, at 6-9-10. Nimmer also argues that supervision, which is not copyrightable by itself, might be a copyrightable contribution to a joint work.

71. See *infra* notes 76-77 and accompanying text.

72. 1 NIMMER, *supra* note 7, § 6.07, at 6-18.2.

73. *Reid*, 846 F.2d at 1497. While noting that joint authorship requires "authorship," *id.* at 1496, the court also said that the community's supervision and addition of normally noncopyrightable titles and legends might "count" towards a finding that the non-profit organization was a joint author of the commissioned sculpture. *Id.* at 1496 n.15. See also *Dumas v. Gommerman*, 865 F.2d 1093, 1105 (9th Cir. 1989) (degree of control and input exercised by buyer may be relevant to inquiry into joint authorship).

In *Reid*, however, the D.C. Circuit stated: "In no case does copyright protection for an original work of authorship extend to an idea." 846 F.2d at 1497. Whatever the court of appeals' ambivalence to basing joint authorship on contributions of ideas, a finding of joint authorship in *Reid* would not depend on supervision or other ideas of the commissioning party. In addition to supervising work on the sculpture, CCNV qualified as a joint author by contributing arguably copyrightable expression, the pedestal. *Id.*

Supervision of a work, however, like paying for a work,⁷⁴ has been ruled to be too trivial and lacking in intellectual content to constitute a copyrightable contribution to a joint work.⁷⁵ Ideas, even when embodied in the work of another, are not copyrightable.⁷⁶ Thus, home buyers who commission architects are not joint authors by virtue of "contribut[ing] ideas and ma[king] certain changes and exercis[ing] approval power" over an architect's plans.⁷⁷

Permitting commissioning parties to base joint authorship claims on supervision of freelancers is both bad law and bad policy. Hiring and supervising do not constitute authorship and thus are not copyrightable.⁷⁸ Allowing joint authorship based on supervision grafts onto joint-authorship law the discredited and detrimental supervision standard of work-for-hire cases.⁷⁹ The D.C. Circuit Court borrowed the supervision standard from the work-for-hire doctrine as a basis for remanding the joint-works claims in *Reid*.⁸⁰ The Circuit Court in *Reid*, looking to the opinion of the district court, found that the most "prominent" arguments for considering the commissioning party and the sculptor joint authors were CCNV's motivation, conception of the idea for the sculpture, and direction of the sculpture.⁸¹ The D.C. Circuit applied the lower

74. See, e.g., *Dahinden v. Byrne*, 220 U.S.P.Q. 719 (D. Or. 1982); see also 1 NIMMER, *supra* note 7, § 6.07, at 6-18.3-6-19. But see *Laskowitz v. Marie Designer, Inc.*, 119 F. Supp. 541 (S.D. Cal. 1954).

75. Expression in which a commissioning party gives directions and ideas is so unoriginal as to be "little more than one would expect" from one who has commissioned a work. *Whelan Assocs. v. Jaslow Dental Laboratory, Inc.*, 609 F. Supp. 1307, 1318 (E.D. Pa. 1985). "Such general assistance and contributions to the fund of knowledge of the author [of a business computer program] did not make [the commissioning party] a creator of any original work, nor even the co-author." *Id.* See also NIMMER, *supra* note 7, § 6.07, at 6-18.2-.3; *Eckert v. Hurley Chicago Co.*, 638 F. Supp. 699, 704 (N.D. Ill. 1986).

Nor does supervising a work "fix" expression in a tangible medium as required if it is to be copyrighted. 17 U.S.C. § 102(a) (1988). "A work is 'fixed' . . . when its embodiment in a copy or phonorecord, . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." 17 U.S.C. § 101 (1988).

76. Rosengart, *Principles of Co-Authorship in American, Comparative, and International Copyright Law*, 25 S. CALIF. L. REV. 247 (1952) ("Nor is there co-authorship where one person originates the idea and another embodies it: here the copyright is solely in the person who clothes the idea with the form.").

77. *Meltzer v. Zoller*, 520 F. Supp. 847, 857 (D.N.J. 1981) (design sketches do not sufficiently constitute fixed expressions of ideas to make home buyer a joint author of architect's plans).

78. See *supra* notes 75-77 and accompanying text.

79. See *supra* notes 38-50 and accompanying text.

80. *Reid*, 846 F.2d at 1496-97.

81. *Id.* See *supra* notes 49-50 and accompanying text.

court's analysis out of context. The district court had argued that CCNV's motivation, ideas, and direction made the organization an employer—and the sculpture a work for hire—not that CCNV's motivation, ideas, and direction made the organization and Reid joint authors, as the appellate court subsequently suggested.⁸² While supervision is still an appropriate consideration for determining the existence of an employer-employee relationship in work-for-hire cases,⁸³ the court of appeals inappropriately used non-copyrightable motivation, ideas, and direction from work-for-hire doctrine to remand joint authorship claims.

Allowing claims of joint ownership based on the commissioning party's supervision of an independent contractor discourages creativity because "[t]here is no incentive for an author to create a work which will vest co-ownership in another who has merely contributed ideas to the work."⁸⁴ If supervision entitles a commissioning party to joint ownership, an employer may claim co-authorship in nearly every case,⁸⁵ thus creating a presumption that the copyright always belongs to the commissioning party. Some involvement by the commissioning party necessarily exists in every case. Richard Weisgrau, Executive Director of the American Society of Magazine Photographers, comments:

A freelance photographer, for example, is always told what the client wants, and the client inevitably has the right to accept or reject the work. Under current law, the client can always make the argument, however specious it may be, that the parties intended to create an interdependent whole and thus that the final product of the photographer's work qualifies as a joint work. That argument should fail even under current law if the client does not contribute an original work of authorship to the project, but the lack of clear, objective criteria in the definition of joint work means that artists will frequently be forced to either litigate the issue or simply give in to the client's demands.⁸⁶

Commissioning parties' ability to base claims of joint author-

82. *Reid*, 652 F. Supp. at 1456.

83. See *supra* notes 47-50 and accompanying text.

84. Note, *Manifest Intent*, *supra* note 14, at 296. "The concept of vesting ownership in one who has merely contributed supervision and control derives its force as a carry-over from the work for hire doctrine." *Id.*

85. 1989 *Hearings*, *supra* note 18, at 65-66 (statement by Richard Weisgrau, Executive Director of the American Society of Magazine Photographers, in testimony supporting S. 1253) (The definition of joint work is so subjective that it stands as an open invitation to litigants to make a joint work argument in any case in which more than one person has some involvement, no matter how minimal, with the freelance work.).

86. *Id.*

ship on supervision of freelancers violates one of the paramount Congressional policy goals of the 1976 revision of the copyright law—to ensure predictability in copyright “through advance planning.”⁸⁷ The lack of stability in joint-work cases undermines Congress’ attempt to bolster the position of individual authors vis-a-vis more powerful commissioning parties.⁸⁸ When commissioning parties destabilized copyright relations by basing work-for-hire claims on supervision of freelancers, the Supreme Court restored the balance by ruling that freelancers are employees only if they meet the criteria of agency law.⁸⁹ Senator Cochran’s bill would help correct the imbalance in relations between joint authors by terminating a commissioner’s joint authorship claim based on supervision.⁹⁰ Cochran’s proposal expressly requires that each joint author make an original contribution to the work.⁹¹ The bill would, therefore, protect independent contractors from having to share copyright with a commissioning party who makes no copyrightable contribution to the work. As Senator Cochran noted: “The constitutional imperative [of protecting authors] may not be circumvented by describing one as a ‘joint’ author. One must still be an ‘author.’ ”⁹²

Merely requiring that a commissioning party contribute more than supervision to claim joint authorship will not, by itself, ensure that freelancers avoid becoming joint authors inadvertently. Senator Cochran’s proposed legislation would also require that commissioning parties and independent contractors indicate their intent to create joint works by signing an agreement before work begins.

III. INTENT

The Copyright Act of 1976 requires that all parties to a joint work intend their contributions be merged into inseparable or interdependent parts of a unitary whole.⁹³ Indeed, Congress asserted that the touchstone of a joint work is the intention at the time of the writing that the parts be absorbed or combined.⁹⁴ In adopting the Copyright Act, Congress rejected the *Twelfth Street Rag*⁹⁵ rul-

87. *Reid*, 490 U.S. at 750.

88. *See supra* text accompanying notes 31-37.

89. *See supra* text accompanying notes 47-49.

90. *See supra* note 24.

91. *Id.*

92. S. 1253, 101st Cong., 1st Sess., 135 CONG. REC. S7343-44 (daily ed. June 22, 1989).

93. 17 U.S.C. § 101 (1988). *See supra* note 7.

94. H. REP. NO. 1476, *supra* note 8, at 120.

95. *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 221 F.2d 569 (2d Cir.), *modified on reh'g*, 223 F.2d 252 (2d Cir. 1955).

ing in which the Second Circuit held that a second contributor to a work could be a joint author even if the first author completed his contribution without realizing that the work would be modified. Under the 1976 Act, it is not necessary that joint authors work near each other, in concert, or that contributions be equal in quantity or quality.⁹⁶ Nor is an express agreement to collaborate necessary.⁹⁷ Congress declared that 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.'"⁹⁸

The intent requirement does not depend on the state of mind of the contributor. In *Strauss v. Hearst Co.*,⁹⁹ the district court ruled that Strauss manifested an intent to create a work of joint authorship even though he never consciously planned to share authorship with Hearst.¹⁰⁰ Strauss testified that joint authorship was never discussed with *Popular Mechanics*, and that he "would never have consented to it if it had been."¹⁰¹ However, it was not necessary that Strauss intended the legal consequences of his actions.¹⁰² In other words, a freelancer could be an inadvertent joint author.

Under the 1976 law, intent to create a work of joint authorship should be manifested through collaboration and contributions to a common design rather than through the subjective state of mind of the contributor.¹⁰³ Legislative panels prior to adoption of the 1976 Act rejected a subjective intent standard in joint-authorship cases.¹⁰⁴ The genesis of the language in the 1976 Act, which follows

96. "It is not essential that the execution of the work should be equally divided; as long as the general design and structure was agreed upon, the parties may divide their parts and work separately." *Maurel v. Smith*, 271 Fed. 211, 215 (2d Cir. 1921). See also 1 NIMMER, *supra* note 7, § 6.03, at 6-6.

97. 1 NIMMER, *supra* note 7, § 6.03, at 6-7.

98. H. REP. NO. 1476, *supra* note 8, at 120.

99. 8 U.S.P.Q.2d 1832 (S.D.N.Y. 1988).

100. *Id.* at 1837.

101. *Id.* at 1837 n.5.

102. *Id.*

103. See Note, *Manifest Intent*, *supra* note 14, at 265-69. Common design as a definition of joint authorship was adopted in American law by Judge Learned Hand in *Maurel v. Smith*, 220 Fed. 195 (S.D.N.Y. 1915), *aff'd*, 271 Fed. 211 (2d Cir. 1921). In *Maurel*, Judge Hand quoted *Levy v. Rutley L.R.*, 6 C.P. 523 (1871), in which Judge Keating stated: "[T]o constitute joint authorship there must be a common design." *Id.* at 199 (quoting *Levy*, 6 C.P. at 529).

104. Note, *Manifest Intent*, *supra* note 14, at 265-69.

traditional ideas,¹⁰⁵ "confirms that the 'intent' element in the definition of joint work should be interpreted as an objective standard."¹⁰⁶ The district court in *Strauss* found sufficient objective evidence of collaboration on a common design to rule that Strauss and Hearst were joint authors, stating:

Neither party denies that both intended from the start for Strauss's photograph to be incorporated into the April 1985 article. . . . It is apparent from Strauss's deposition that he knew captions and other copy would be superimposed upon the photograph when the article was put in its final form. To that end he was careful to leave space in the composition of the photograph that would accommodate such future additions.¹⁰⁷

While Congress intended that the intent requirement in joint works not depend on a contributor's state of mind, it is unlikely that Congress, in the absence of specific language, meant to counter broader copyright goals. Yet, permitting freelancers to become inadvertent joint authors undermines the provisions of the 1976 copyright law revision directed at strengthening an independent creators' position in predictable copyright relations.¹⁰⁸ Permitting freelancers to inadvertently become joint authors also contravenes the well developed trade practices inherent to predictable copyright relations.

105. A. LATMAN, R. GORMAN & J. GINSBERG, COPYRIGHT FOR THE EIGHTIES 228 (2d ed. 1985)

106. Note, *Manifest Intent*, *supra* note 14, at 269.

107. *Strauss*, 8 U.S.P.Q.2d. at 1837. Other evidence of joint work cited by the court is the addition to the photograph of "editorial copy contributed by the magazine itself, such as captions for the fishing rods and reels as well as the initial paragraphs of the article." *Id.* at 1836-37. In setting out the facts in the case, the court also noted:

The contents of the photograph in question were strictly dictated by employees of Popular Mechanics. Sometime in December 1984 the magazine's graphics director, Bryan Canniff, sent to Strauss the fishing gear that was to be the subject of the photograph along with a sketch layout of what the photograph was to look like. Together the two men decided on the dark blue plexiglass that forms the prominent background for the photo. When the time came to make the actual photograph, Canniff was present in Strauss's studio to supervise preparations for the shoot. As part of his supervisory function, Canniff helped assemble the rods and reels and then arranged the gear on the plexiglass background as he wanted it. In arranging the equipment according to his layout, Canniff had to be careful to leave enough space to accommodate the seven captions, one illustration, title and first two paragraphs of text that were to be superimposed on the photograph in the finished article.

Id. at 1833 (citations omitted).

108. See *supra* notes 31-37 and accompanying text.

A. Trade Practices

A relationship between a commissioning party and an independent contractor operates on the intuitive understanding that the commission is for someone other than the commissioning party to create a work. A commission is an order to a second party to perform a particular task or to carry out a work.¹⁰⁹ One who commissions a work does not generally contemplate that he will perform the work himself. It is also unlikely that either a freelancer or an editor anticipates that an editor who commissions a work will become a co-author. An editor, by definition, modifies or revises the work of another.¹¹⁰ Instead of anticipating or fearing joint authorship with an editor, a freelancer such as Strauss is more likely to be wary that an editor will damage the work and thereby defile the reputation of the author whose byline or credit line will appear on the work.¹¹¹

A freelancer often makes a contribution to a collective work, in Strauss's case a magazine.¹¹² A contribution to a collective work is separate and independent and, therefore, one in which a freelancer can expect to retain copyright.¹¹³ Strauss's expectation of copyright ownership may have been reinforced by the credit line he was given,¹¹⁴ allowing him to register work in bulk, in his own name, for copyright protection.¹¹⁵ Furthermore, Strauss may have known that a publisher's copyright on a magazine or other collective work does not negate separate copyright on individual contributions.¹¹⁶ A freelancer may feel additional security that his copyright is se-

109. WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 457 (1966).

110. An editor is one "who revises, corrects, or arranges the contents and style of the literary, artistic, or musical work of others for publication or presentation." WEBSTER'S THIRD INTERNATIONAL DICTIONARY 723 (1966).

111. Editorial violations may include libel, misrepresentation, or mutilation and those rights protected under moral rights. See, e.g., N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney Supp. 1990) (interests protected). Although it apparently was not an issue in the case, Popular Mechanics sent Strauss's photo to a professional processing lab to have it enhanced by computer. A retoucher at the magazine then used an airbrush to alter the color of the background, paint in previously illegible wording on the equipment, and make other changes. *Strauss*, 8 U.S.P.Q.2d at 1834.

112. A collective work is a work "such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." 17 U.S.C. § 101 (1988).

113. *Id.* See also *supra* note 30.

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

115. Photographers, writers, and other freelancers publishing in collective works may register works for copyright in a group if they retain a credit line. 17 U.S.C. § 408(c) (Supp. 1990).

116. See *supra* note 36.

cure if he operates under no contract¹¹⁷ or under a contract, as did Strauss and Hearst,¹¹⁸ in which either party retains rights.¹¹⁹ In these circumstances, rights not enumerated may be reserved.

If Congress failed to protect independent contractors from joint-works claims by commissioning parties, it is most likely because Congress did not foresee that commissioning parties would disrupt usual trade practices by claiming joint authorship. Experts testifying at early hearings on joint works recognized that joint authorship would be an issue among creative writers and photographers working on a single project.¹²⁰ Participants in the hearings, however, did not mention joint authorship as an issue between creative talent and commissioning parties. One expert noted that writers, composers, and lyricists under contract to a publisher or producer may produce joint works; but the expert did not suggest that the publisher or producer would be a joint author.¹²¹

Whatever the limits of its vision, Congress has the opportunity to redress the emerging imbalance in copyright relations by pass-

117. See *Boggs v. Japp*, 9 U.S.P.Q.2d 1040, 1044 (E.D. Va. 1988) (no intent to create a joint work, in part, because no contract formed).

118. *Strauss*, 8 U.S.P.Q.2d at 1837 n.5. Strauss argued that the words "First Publication Right in U.S. and Foreign" typed by Hearst on the back of his check indicated that the parties did not intend to create a joint work. *Id.* The court ruled that the contract did not abrogate Hearst's claim to joint authorship. *Id.* The court found adequate evidence of intent to create a joint work, interpreting the words "First Publication Right in U.S. and Foreign" to be a possible limit to Hearst's natural rights as a joint holder, but not as a renunciation of joint authorship. *Id.* *Strauss*, therefore, stands for the proposition that "joint authors can subsequently contract away their rights, but a contract will not alter the vesting of the initial tenancy-in-common." Note, *Manifest Intent*, *supra* note 14, at 278.

119. See *Gilliam v. American Broadcasting Co.*, 538 F.2d 14, 22 (2d Cir. 1976) (Monty Python and the BBC did not create a joint work, in part because Python stipulated in a contract that it retained all rights not granted to the BBC).

120. See, e.g., COPYRIGHT LAW REVISION PART 3 (Preliminary Draft for Revised U.S. Copyright Law 410 (1964)) (discussion and comments on the draft) (testimony of Harold Orenstein). Orenstein made no suggestion that commissioning parties and those on commission might share authorship. Orenstein recommended that whether a work is joint or composite—now collective—might depend on whether there was a written agreement beforehand. *Id.* at 410-11.

121. *Id.* Orenstein also stated:

Generally, when writers start to work together they have no idea whether their work will ultimately be published or produced or whether one or the other will drop out of the collaboration in the middle of it. Sometimes it is because of disagreement over the course of the collaboration and sometimes it is because the producer or publisher (assuming that they are jointly contracted to write a work by a producer or publisher) is not satisfied with the talents of either one or the other. In addition, it frequently happens (in the music field particularly) that one writes the music and one writes the lyrics. While these may be clearly distinguishable from one another it could nevertheless still be considered a joint work.

Id.

ing Senator Cochran's bill. If the Supreme Court can remedy the imbalance in work-for-hire relations that developed after passage of the 1976 Act,¹²² Congress can restore the balance to joint-works relations.

Senator Cochran's bill would prohibit a commissioning party from claiming joint authorship in a commissioned work unless both parties agreed in writing before work began.¹²³ Operating under such a requirement, commissioning parties could not claim joint authorship without establishing the express intention of both parties. The Cochran bill provides "clearer, more explicit guidance to the public and to courts so as to discourage the indiscriminate and unjustified assertion of joint work claims by publishers and other parties that commission freelance talent."¹²⁴

B. Criticisms of the Cochran Contract Proposal

At least two criticisms have been articulated against Cochran's proposal, neither of which should halt its adoption. One criticism of the Cochran bill is that the contract requirement allows a commissioning party to claim joint authorship in works where the commissioning party has not contributed authorship.¹²⁵ The attempt to assure joint authorship status through a prior written agreement is seen as a way to confer ownership rights on a party who is not an author.¹²⁶ Indeed, the Cochran contract requirement is seen as work for hire in another guise.¹²⁷ The commentator concluded: "[T]here is still no basis for bestowing authorship on a commissioning party who has not made a copyrightable contribution other than to reward that party for funding the project."¹²⁸

122. See *supra* notes 47-50 and accompanying text.

123. See *supra* note 24.

124. 1989 Hearings, *supra* note 18, at 68.

125. Note, *Manifest Intent*, *supra* note 14, at 283. "Various applications of the joint authorship doctrine ignore the copyrightability doctrine, as though prefixing 'co-' on the word 'author' changes the components of authorship." *Id.* at 283-84 (citing S. 1253, 101st Cong., 1st Sess., 135 CONG. REC. S7343 (daily ed. June 22, 1989)). "Congress never intended to allow one who does not meet the constitutional standard of authorship to become a co-owner of all copyright rights in that work." *Id.* at 284 n.175.

126. *Id.* at 283 n.173.

127. *Id.* Specifically, the author stated:

If a work does not qualify for protection under work for hire—the exception specifically envisioned by Congress—why should it qualify under joint work? To endow ownership rights on a party who is not an author is just work for hire in another guise. In such a scenario, the author is given ownership as well, which puts him in a better position than work for hire.

Id.

128. *Id.* The author elaborated:

If a commissioning party claims joint authorship by paying for a work and signing a contract, joint authorship does become nothing more than "work for hire in another guise."¹²⁹ If merely paying for a work results in joint authorship, a commissioning party, because of superior economic power, might routinely require a freelancer to sign a joint-works contract, if not a work-for-hire agreement.¹³⁰

The above criticism of the contract requirement is misplaced because the contract provision in the Cochran proposal would not permit a commissioning party to claim joint authorship simply by commissioning a work and signing a contract. The Cochran bill also requires that both parties make copyrightable contributions to a joint work.¹³¹ Thus, the Cochran proposal would not permit the easy application of a contract requirement on which the commentator relies.

A more substantial objection to the Cochran proposal is lodged by Ralph Oman, the Register of Copyrights.¹³² Oman sug-

Taking the concept of paying for the project to its fullest, even buyers of a finished work could claim [that because] they paid for it, they own the copyright. Additionally, as coauthors, independent contractors share in both licensing rights and control over licensing rights, therein leaving commissioning parties with no control over the independent contractor's licensing choices.

Id.

129. *Id.* at 284.

130. For comments of Richard Weisgrau, Executive Director of the American Society of Magazine Photographers, see *supra* text accompanying note 19.

131. See, e.g., Note, *Manifest Intent*, *supra* note 14, at 296 n.263 (quoting Senator Cochran's statement supporting his bill).

132. Note, *Manifest Intent*, *supra* note 14, at 276 n.128. Oman states his position in the following manner:

S. 1253 also requires that for all specially ordered or commissioned works, the parties must, before commencement of the work, enter into a signed agreement stating that the work is to be one of joint authorship. . . . I am unsure how it would work in practice. Assume, for example, that the producer of an audiovisual work for elementary schools commissions a friend who is a composer to write some music for the work; the two work closely, with the producer giving detailed comments and suggestions for both the original draft and subsequent revisions of the music . . . and the composer giving suggestions for revision of the visual component of the work. . . . The only agreement is an oral one to split the profits 75% - 25%. Under *CCNV v. Reid*, it is unlikely the music would be deemed made for hire. Under the existing statute, the work would qualify as a joint work. Under S. 1253, though, the work could not be a joint work since no written agreement to that effect was entered into. The question then arises, who owns what rights? The audiovisual work here consists of 'inseparable or interdependent parts' that are useful only as part of a 'unitary whole.' The easy answer is to say each owns rights in his or her contribution, but this answer gets you no place where each contribution is only marketed as part of the unitary whole. I do not see how the work could be anything but a joint work, a result prohibited by S.1253.

gests that the Cochran contract requirement would create situations in which authors who have collaborated, but not signed joint-works contracts, could be denied the prerogatives of both the joint author and of the sole author. What if, for example, the producer of an audiovisual work commissions a composer-friend to compose music for a joint audiovisual musical production?¹³³ Under present copyright law, the final product of their collaboration would be a joint work, irrespective of whether a contract was signed.¹³⁴ Under the Cochran proposal, however, the work would not be one of joint authorship if no agreement were signed.¹³⁵ Thus, under the Cochran bill, each contributor would be unable to market the whole because neither would be a joint author. Each would also be unable to exploit her separate contribution individually because each contribution would be combined into an inseparable whole.¹³⁶

If the Cochran bill were passed, there may be unusual situations in which one commissioned a "friend," as Oman suggested,¹³⁷ to produce a unified work that was not considered joint because no contract was signed. In such an unlikely situation, exploitation of the joint work or its individual contributions might be stymied. More likely, one friend would not commission another, but would work spontaneously, as academic colleagues might on a research paper.¹³⁸ Spontaneous collaboration among friends and colleagues, where neither party commissions the other and commercial gain may not be a primary concern, would result in joint works under the Cochran proposal as such collaboration does under present law.¹³⁹ The Cochran proposal, like present copyright law, would not require a contract to certify a non-commissioned joint work.

The Register of Copyright's criticism is perhaps more applicable in the commercial context of a publisher or producer commissioning a freelance work. In this case, a commissioning party might contribute expression to a unified work that would not be considered a joint work under the Cochran bill if no contract were signed. In this situation, the Cochran bill may prevent the parties from exploiting either the whole work—because neither contributor

Id.

133. *Id.*

134. See *supra* notes 96-98 and accompanying text.

135. See *supra* note 24.

136. See Note, *Manifest Intent*, *supra* note 14, at 276 n.128, 283 n.173.

137. See *supra* note 132.

138. See, e.g., *Weissmann v. Freeman*, 684 F. Supp. 1248, 1260 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

139. See *supra* notes 7 & 24.

could claim joint authorship—or an individual contribution—because each contribution would be inseparable from the other.¹⁴⁰

To avoid the stalemate Oman describes, the Cochran bill should be interpreted to mean that ownership in a commissioned work belongs to the independent contractor unless a contract stipulates otherwise. This interpretation conforms to present copyright law governing contributions to collective works.¹⁴¹ Section 201(c) of the 1976 Act vests all rights, except first publication rights, in the author of a contribution to a collective work.¹⁴² Vesting all rights in the freelancer serves three purposes. First, it bars the commissioning party from making the independent contractor an inadvertent joint author, either through the commissioning party's supervision or expressive contributions. Second, it furthers the copyright policy goals of enhancing the powers of creative authors through predictable copyright relations.¹⁴³ Finally, it properly places the burden to contract on the commissioning party—the party usually in the stronger economic position to bear the costs of contracting and the losses of forfeited copyright ownership.¹⁴⁴

IV. CONCLUSION

Independent contractors working on commission should be protected from inadvertently becoming joint authors of commissioned works. Allowing commissioning parties to claim joint authorship in commissioned work they supervise creates unstable copyright relations that discourage the creative enterprise and undermine the stability that the copyright law is designed to foster. To discourage the gratuitous joint-authorship claims of commissioning parties, Congress should pass the Cochran bill, which would recognize joint authorship in commissioned works only if all parties contribute copyrightable expression and a joint-work contract is signed before work begins.

140. See *supra* note 24.

141. See 17 U.S.C. § 201(c) (1988).

142. *Id.*

143. See *supra* notes 16-17.

144. See Hamilton, *Commissioned Works as Works Made for Hire Under the 1976 Copyright Act: Misinterpretation and Injustice*, 135 U. PA. L. REV. 1281, 1308-1311 (1987).