

III. Authorship and Ownership

The Copyright Act does not define either “**author**” or “**authorship**”; those terms can be understood only by implication from various provisions in the statute, and by the interpretation of the meaning of those terms provided in the opinions of federal courts.

Section 201 of the Copyright Act provides for two ways in which initial copyright ownership may arise in a work:

(a) Initial Ownership.—

Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.

(b) Works Made for Hire.—

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

The relevant statutory provisions may be summarized as follows: First, ownership vests initially in a work’s author or authors. For a work with one author, initial ownership of the work’s copyright vests in that author. For a work with more than one author—defined by the statute as a “**joint work**”—ownership of the copyright vests initially in the co-authors of that work as co-owners.

Second, initial ownership in a “**work made for hire**” vests in “the employer or other person for whom the work was prepared.” The owner of a work made for hire is also considered the work’s author.

We will first discuss authorship and ownership of single-authored works. We will then examine the rules governing authorship and ownership of joint works. Finally, we will examine the Copyright Act’s “work made for hire” provisions.

A. The Definition of Authorship

As you read this decision, focus on the concept of “authorship.” The Copyright Act does not define that term or tell us how to determine whether someone is an “author,” although that determination is absolutely central to copyright law. Does the decision provide a definition of “author” or “authorship”? If so, what is it?

Alexander Lindsay v. The Wrecked and Abandoned Vessel R.M.S. Titanic

52 U.S.P.Q.2d 1609 (S.D.N.Y. 1999)

BAER, J.: ...

[1] In 1994, the plaintiff[, Alexander Lindsay], under contract with a British television company, filmed and directed the British documentary film, “Explorers of the Titanic,” a chronicle of defendant [R.M.S. Titanic, Inc.]’s third salvage expedition of the Titanic. To film this documentary, Lindsay sailed with ... the salvage expedition crew to the wreck site and remained at sea for approximately one month. The plaintiff alleges that during and

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after filming this documentary in 1994, he conceived a new film project for the Titanic wreck using high illumination lighting equipment....

[2] As part of his pre-production efforts, the plaintiff created various storyboards for the film, a series of drawings which incorporated images of the Titanic by identifying specific camera angles and shooting sequences that reflected [his] creative inspiration and force behind his concept for shooting the Subject Work. The plaintiff also alleges that he, along with members of his film team, designed the huge underwater light towers that were later used to make the film. Lindsay also personally constructed the light towers and thereafter for approximately 3–4 weeks directed, produced, and acted as the cinematographer of the Subject Work, underwater video[]taping of the Titanic wreck site, and otherwise participated in the 1996 salvage operation. He also directed the filming of the wreck site from on board the salvage vessel “Ocean Voyager” after leading daily planning sessions with the crew of the Nautilie, the submarine used to transport the film equipment and photographers to the underwater wreck site. The purpose of these sessions was to provide the photographers with detailed instructions for positioning and utilizing the light towers.

[3] The plaintiff now alleges that he was never fully compensated for his services and that, *inter alia*, the defendants are now “unlawfully profiting from the exploitation of the” film project at issue....

[4] The defendants ... move ... to dismiss Lindsay’s copyright claims, and the plaintiff cross-moves for summary judgment on his copyright ... claim[]....

[5] The defendants first argue that the plaintiff cannot have any protectable right in the illuminated footage since he did not dive to the ship and thus did not himself actually photograph the wreckage. This argument, however, does not hold water.

[6] The Copyright Act of 1976 provides that copyright ownership “vests initially in the author or authors of the work.” 17 U.S.C. § 201(a). Generally speaking, the author of a work is the person who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection. In the context of film footage and photography, it makes intuitive sense that the “author” of a work is the individual or individuals who took the pictures, i.e. the photographer. However, the concept is broader than as argued by the defendants.

[7] For over 100 years, the Supreme Court has recognized that photographs may receive copyright protection in “so far as they are representatives of original intellectual conceptions of the author.” *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884). An individual claiming to be an author for copyright purposes must show “the existence of those facts of originality, of intellectual production, of thought, and conception.” *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*, 499 U.S. 340, 346–47 (1991) (citing *Burrow-Giles*, 111 U.S. at 59–60). Taken as true, the plaintiff’s allegations meet this standard. Lindsay’s alleged storyboards and the specific directions he provided to the film crew regarding the use of the light towers and the angles from which to shoot the wreck all indicate that the final footage would indeed be the product of Lindsay’s “original intellectual conceptions.”

[8] The fact that Lindsay did not literally perform the filming, i.e. by diving to the wreck and operating the cameras, will not defeat his claims of having “authored” the illuminated footage. The plaintiff alleges that as part of his pre-production efforts, he created so-called “storyboards,” a series of drawings which incorporated images of the Titanic by identifying specific camera angles and shooting sequences. During the expedition itself, Lindsay claims to have been the director, producer and cinematographer of the underwater footage. As part of this role, Lindsay alleges that he directed daily planning sessions with the film crew to provide them with detailed instructions for positioning and utilizing the light towers. Moreover, the plaintiff actually directed the filming of the Titanic from on board the Ocean Voyager, the salvage vessel that held the crew and equipment.

Finally, Lindsay screened the footage at the end of each day to confirm that he had obtained the images he wanted.

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

NOTES

1. Can you extract from this case an understanding of the definition of the term “author”? What is it? Is the definition adequate to determine who is and who is not an “author” across a range of contexts?
2. In *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989), the Supreme Court stated that the author of a work is the person “who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.” (citing 17 U.S.C. § 102). Does this articulation of the definition of authorship align with the holding in *Lindsay*?

As you read the next decision, think again about the definition of “author” that you extracted from *Lindsay* and ask yourself (a) whether the court followed that rule, and (b) if not, why?

Cindy Lee Garcia v. Google, Inc.

786 F.3d 733 (9th Cir. 2014) (en banc)

McKEOWN, J.:

[1] In this case, a heartfelt plea for personal protection is juxtaposed with the limits of copyright law and fundamental principles of free speech. The appeal teaches a simple lesson—a weak copyright claim cannot justify censorship in the guise of authorship....

[2] In July 2011, Cindy Lee Garcia responded to a casting call for a film titled *Desert Warrior*, an action-adventure thriller set in ancient Arabia. Garcia was cast in a cameo role, for which she earned \$500. She received and reviewed a few pages of script. Acting under a professional director hired to oversee production, Garcia spoke two sentences: “Is George crazy? Our daughter is but a child?” Her role was to deliver those lines and to seem concerned.

[3] Garcia later discovered that writer-director Mark Basseley Youssef ... had a different film in mind: an anti-Islam polemic renamed *Innocence of Muslims*. The film, featuring a crude production, depicts the Prophet Mohammed as, among other things, a murderer, pedophile, and homosexual. Film producers dubbed over Garcia’s lines and replaced them with a voice asking, “Is your Mohammed a child molester?” Garcia appears on screen for only five seconds.

[4] Almost a year after the casting call, in June 2012, Youssef uploaded a 13-minute-and-51-second trailer of *Innocence of Muslims* to YouTube, the video-sharing website owned by Google, Inc., which boasts a global audience of more than one billion visitors per month. After it was translated into Arabic, the film fomented

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outrage across the Middle East, and media reports linked it to numerous violent protests. The film also has been a subject of political controversy over its purported connection to the September 11, 2012, attack on the United States Consulate in Benghazi, Libya.

[5] Shortly after the Benghazi attack, an Egyptian cleric issued a fatwa against anyone associated with *Innocence of Muslims*, calling upon the “Muslim Youth in America[] and Europe” to “kill the director, the producer[,], and the actors and everyone who helped and promoted this film.” Garcia received multiple death threats.

[6] Legal wrangling ensued. Garcia asked Google to remove the film, asserting it was hate speech and violated her state law rights to privacy and to control her likeness. Garcia also sent Google five takedown notices ..., claiming that YouTube’s broadcast of *Innocence of Muslims* infringed her copyright in her audio-visual dramatic performance. Google declined to remove the film....

[7] ... Garcia turned to federal court.... [She] alleged copyright infringement against both defendants

[8] Garcia then moved for a temporary restraining order and for an order to show cause on a preliminary injunction She sought to bar Google from hosting *Innocence of Muslims* on YouTube or any other Google-run website.

[9] ... [T]he district court denied Garcia’s motion for a preliminary injunction.... In particular, the district court found that the nature of Garcia’s copyright interest was unclear ...

[10] ... [A divided] panel majority reversed the district court and granted Garcia’s preliminary injunction. Despite characterizing Garcia’s copyright claim as “fairly debatable,” the panel majority nonetheless concluded that Garcia was likely to prevail on her copyright claim as to her individual performance in *Innocence of Muslims*....

[11] We granted rehearing en banc....

[12] A plaintiff seeking a preliminary injunction must show[, among other things,] that ... she is likely to succeed on the merits....

[13] The central question is whether the law and facts clearly favor Garcia’s claim to a copyright in her five-second acting performance as it appears in *Innocence of Muslims*. The answer is no....

[14] Under the Copyright Act, “[c]opyright protection subsists ... in original works of authorship fixed in any tangible medium of expression ... [including] motion pictures.” 17 U.S.C. § 102(a). That fixation must be done “by or under the authority of the author.” [*Id.*] § 101. Benchmarked against this statutory standard, the law does not clearly favor Garcia’s position.

[15] The statute purposefully left “works of authorship” undefined to provide for some flexibility. Nevertheless, several other provisions provide useful guidance. An audiovisual work is one that consists of “a series of related images which are intrinsically intended to be shown” by machines or other electronic equipment, plus “accompanying sounds.” 17 U.S.C. § 101. In turn, a “motion picture” is an “audiovisual work [] consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any.” *Id.* These two definitions embody the work here: *Innocence of Muslims* is an audiovisual work that is categorized as a motion picture and is derivative of the script. Garcia is the author of

none of this and makes no copyright claim to the film or to the script.⁶ Instead, Garcia claims that her five-second performance itself merits copyright protection.

[16] In the face of this statutory scheme, it comes as no surprise that during this litigation, the Copyright Office found that Garcia’s performance was not a copyrightable work when it rejected her copyright application. The Copyright Office explained that its “longstanding practices do not allow a copyright claim by an individual actor or actress in his or her performance contained within a motion picture.” Thus, “[f]or copyright registration purposes, a motion picture is a single integrated work.... Assuming Ms. Garcia’s contribution was limited to her acting performance, we cannot register her performance apart from the motion picture.”

[17] We credit this expert opinion of the Copyright Office—the office charged with administration and enforcement of the copyright laws and registration. The Copyright Office’s well-reasoned position reflects a body of experience and informed judgment to which courts and litigants may properly resort for guidance....

[18] Garcia’s theory of copyright law would result in [a] legal morass ...—splintering a movie into many different “works,” even in the absence of an independent fixation. Simply put, as Google claimed, it “make[s] Swiss cheese of copyrights.”

[19] Take, for example, films with a large cast—the proverbial “cast of thousands”—such as *Ben-Hur* or *Lord of the Rings*. The silent epic *Ben-Hur* advertised a cast of 125,000 people. In the *Lord of the Rings* trilogy, 20,000 extras tramped around Middle-Earth alongside Frodo Baggins Treating every acting performance as an independent work would not only be a logistical and financial nightmare, it would turn cast of thousands into a new mantra: copyright of thousands....

[20] Untangling the complex, difficult-to-access, and often phantom chain of title to tens, hundreds, or even thousands of standalone copyrights is a task that could tie the distribution chain in knots. And filming group scenes like a public parade, or the 1963 March on Washington, would pose a huge burden if each of the thousands of marchers could claim an independent copyright.

[21] Garcia’s copyright claim faces yet another statutory barrier: She never fixed her acting performance in a tangible medium, as required¹³

[22] For better or for worse, Youssef and his crew “fixed” Garcia’s performance in the tangible medium, whether in physical film or in digital form. However one might characterize Garcia’s performance, she played no role in fixation. On top of this, Garcia claims that she never agreed to the film’s ultimate rendition or how she was portrayed in *Innocence of Muslims*, so she can hardly argue that the film or her cameo in it was fixed “by or under [her] authority.” 17 U.S.C. § 101.

[23] In sum, the district court committed no error in its copyright analysis. Issuance of the mandatory preliminary injunction requires more than a possible or fairly debatable claim Because neither the Copyright Act nor the Copyright Office’s interpretation supports Garcia’s claim, this is a hurdle she cannot clear....

⁶ In another odd twist, one of Garcia’s primary objections rests on the words falsely attributed to her via dubbing. But she cannot claim copyright in words she neither authored nor spoke. That leaves Garcia with a legitimate and serious beef, though not one that can be vindicated under the rubric of copyright.

¹³ The Copyright Office draws a distinction between acting performances like Garcia’s, which are intended to be an inseparable part of an integrated film, and standalone works that are separately fixed and incorporated into a film. We in no way foreclose copyright protection for the latter—any “discrete work in itself that is later incorporated into a motion picture,” as the Copyright Office put it.

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[24] Privacy laws, not copyright, may offer remedies tailored to Garcia’s personal and reputational harms. On that point, we offer no substantive view....

KOZINSKI, J., dissenting:

[25] Garcia’s dramatic performance met all of the requirements for copyright protection: It was copyrightable subject matter, it was original and it was fixed at the moment it was recorded. So what happened to the copyright? At times, the majority says that Garcia’s performance was not copyrightable at all. And at other times, it seems to say that Garcia just didn’t do enough to gain a copyright in the scene. Either way, the majority is wrong and makes a total mess of copyright law, right here in the Hollywood Circuit. In its haste to take internet service providers off the hook for infringement, the court today robs performers and other creative talent of rights Congress gave them. I won’t be a party to it....

[26] Youssef handed Garcia a script. Garcia performed it. Youssef recorded Garcia’s performance on video and saved the clip. Until today, I understood that the rights in such a performance are determined according to elementary copyright principles: An “original work[] of authorship,” 17 U.S.C. § 102(a), requires only copyrightable subject matter and a “minimal degree of creativity.” *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). The work is “fixed” when it 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. And at that moment, the “author or authors of the work” instantly and automatically acquire a copyright interest in it. 17 U.S.C. § 201(a). This isn’t exactly String Theory; more like Copyright 101.

[27] Garcia’s performance met these minimal requirements; the majority doesn’t contend otherwise. The majority nevertheless holds that Garcia’s performance isn’t a “work,” apparently because it was created during the production of a later-assembled film, *Innocence of Muslims*. But if you say something is not a work, it means that it isn’t copyrightable by anyone. Under the majority’s definition of “work,” no one (not even Youssef) can claim a copyright in any part of Garcia’s performance, even though it was recorded several months before *Innocence of Muslims* was assembled. Instead, *Innocence of Muslims*—the ultimate film—is the only thing that can be a “work.” If this is what my colleagues are saying, they are casting doubt on the copyrightability of vast swaths of material created during production of a film or other composite work.

[28] The implications are daunting. If Garcia’s scene is not a work, then every take of every scene of, say, *Lord of the Rings* is not a work, and thus not protected by copyright, unless and until the clips become part of the final movie. If some dastardly crew member were to run off with a copy of the Battle of Morannon, the dastard would be free to display it for profit until it was made part of the final movie. And, of course, the take-outs, the alternative scenes, the special effects never used, all of those things would be fair game because none of these things would be “works” under the majority’s definition. And what about a draft chapter of a novel? Is there no copyright in the draft chapter unless it gets included in the published book? Or if part of the draft gets included, is there no copyright in the rest of it?

[29] This is a remarkable proposition, for which the majority provides remarkably little authority.... [A] contribution to a movie can be copyrightable (and thus can be a “work”)....

[30] The majority also seems to hold that Garcia is not entitled to copyright protection because she is not an author of the recorded scene. According to the majority, Garcia can’t be an author of her own scene because she “played no role in [her performance’s] fixation.”

[31] But a performer need not operate the recording equipment to be an author of his own performance. Without Garcia’s performance, all that existed was a script. To convert the script into a video, there needed to be both an actor physically performing it and filmmakers recording the performance. Both kinds of activities can result in copyrightable expression. Garcia’s performance had at least “some minimal degree of creativity”

apart from the script and Youssef's direction. See *Feist*, 499 U.S. at 345. One's "[p]ersonality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something which is one man's alone." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903). To dispute this is to claim that *Gone With the Wind* would be the same movie if Rhett Butler were played by Peter Lorre.

[32] I'd therefore find that Garcia acquired a copyright in her performance the moment it was fixed.... It's not our job to take away from performers rights Congress gave them. Did Jimi Hendrix acquire no copyright in the recordings of his concerts because he didn't run the recorder in addition to playing the guitar? Garcia may not be as talented as Hendrix—who is?—but she's no less entitled to the protections of the Copyright Act....

[33] [U]nder our copyright law, the creators of original, copyrightable material automatically acquire a copyright interest in the material as soon as it is fixed. There's no exception for material created during production of a film or other composite work. When modern works, such as films or plays, are produced, contributors will often create separate, copyrightable works as part of the process. Our copyright law says that the copyright interests in this material vest initially with its creators, who will then have leverage to obtain compensation by contract. The answer to the "Swiss cheese" bugbear isn't for courts to limit who can acquire copyrights in order to make life simpler for producers and internet service providers. It's for the parties to allocate their rights by contract. Google makes oodles of dollars by enabling its users to upload almost any video without pre-screening for potential copyright infringement. Google's business model assumes the risk that a user's upload infringes someone else's copyright, and that it may have to take corrective action if a copyright holder comes forward.

[34] The majority credits the doomsday claims at the expense of property rights that Congress created. Its new standard artificially shrinks authorial rights by holding that a performer must personally record his creative expression in order to retain any copyright interest in it, speculating that a contrary rule might curb filmmaking and burden the internet. But our injunction has been in place for over a year; reports of the internet's demise have been greatly exaggerated....

NOTES

1. Should Garcia be treated as an "author" under the standard set out by *Lindsay*? On what basis did the *Garcia* court hold that Garcia was not an author? For an analogous case reaching a similar result, see *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247 (2d Cir. 2015) ("Filmmaking is a collaborative process typically involving artistic contributions from large numbers of people, including—in addition to producers, directors, and screenwriters—actors, designers, cinematographers, camera operators, and a host of skilled technical contributors. If copyright subsisted separately in each of their contributions to the completed film, the copyright in the film itself, which is recognized by statute as a work of authorship, could be undermined by any number of individual claims."). For an investigation whether actors deserve to be treated as authors, see Justin Hughes, *Actors as Authors in American Copyright Law*, 51 CONN. L. REV. 1 (2019).

2. Imagine that a director hires an actor to produce a very short scene—less than one minute—that the director plans to incorporate into a 90-minute movie. The director hands over a script and some money; the actor hires a camera crew, shoots the scene described in the script, and hands the completed scene back to the director. Is the scene itself a "work"? Or is only the completed movie a "work"?

3. In *Naruto v. Slater*, 888 F.3d 418 (9th Cir. 2018), the Ninth Circuit held that the Copyright Act does not recognize claims of authorship or copyright ownership by non-humans. That case involved assertions of copyright ownership on behalf of a monkey, represented on a "next friend" basis by People for the Ethical Treatment of Animals. The monkey (which PETA dubbed "Naruto") happened upon a camera left unattended

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by a professional photographer, David Slater. While handling the camera, the monkey repeatedly tripped the shutter and captured several very striking “selfies,” including the one shown in Figure 44.



Figure 44: selfie photograph captured by “Naruto”

The Ninth Circuit noted that the Copyright Act is silent with respect to the standing of non-humans to assert claims of authorship or copyright ownership. In the face of that silence, the court refused to presume that Congress intended to provide standing to non-humans to press those claims. The U.S. Copyright Office takes the same position. In its *Compendium of U.S. Copyright Office Practices*, §§ 306, 313.2 (3d ed. 2014), the Copyright Office expressly concluded that the Copyright Act does not recognize non-humans as authors. (What about Slater? Should *he* be the author? Why or why not?)

4. Can an AI agent be considered an author if the program’s operation generates poetry, artwork, or music? If not, who is the author? See Annemarie Bridy, *Coding Creativity: Copyright and the Artificially Intelligent Author*, 2012 STAN. TECH. L. REV. 5; Jane C. Ginsburg & Luke Ali Budiardjo, *Authors and Machines*, 34 BERKELEY TECH. L.J. 343 (2019); James Grimmelman, *There’s No Such Thing as a Computer-Authored Work—And It’s a Good Thing, Too*, 39 COLUM. J.L. & ARTS 403 (2016); Pamela Samuelson, *Allocating Ownership Rights in Computer-Generated Works*, 47 U. PITT. L. REV. 1185 (1986).

These questions became more concrete in November 2018, when Dr. Stephen Thaler, an artificial intelligence researcher, applied to register an image (“A Recent Entrance to Paradise”), shown in Figure 45, produced by Creativity Machine, one of Thaler’s AI systems. The Copyright Office denied the copyright registration application because the image “lack[ed] the human authorship necessary to support a copyright claim,” and a federal district court affirmed, holding that “human creativity is the *sine qua non* at the core of copyrightability, even as that human creativity is channeled through new tools or into new media.” *Thaler v. Perlmutter*, 687 F. Supp. 3d 140 (D.D.C. 2023).



Figure 45: “A Recent Entrance to Paradise”



Figure 46: Midjourney Image (left) and final version (right) of “Théâtre D’opéra Spatial”

In 2023, the Copyright Office denied a copyright registration application for another AI-generated image, titled “Théâtre D’opéra Spatial” and shown on the right in Figure 46. An initial version of this image (the “Midjourney Image,” shown on the left in Figure 46) was generated using the Midjourney AI tool. The registration applicant, Jason Michael Allen, produced the final image by manipulating the AI output, using Photoshop to remove flaws and create new visual content. The final image, which won a prize at the Colorado State Art Fair in 2022, differed substantially from the initial version, and the final image’s human-added features would have been registrable—but Allen refused to disclaim the features due solely to the AI. Allen appealed the Office’s refusal of registration to the Copyright Office’s appellate body, the Copyright Review Board, which affirmed:

In the Board’s view, Mr. Allen’s actions as described do not make him the author of the Midjourney Image because his sole contribution to the Midjourney Image was inputting the text prompt that produced it. Although Mr. Allen describes “input[ing] numerous revisions and text prompts at least 624 times” before producing the Midjourney Image, the steps in that process were ultimately dependent on how the Midjourney system processed Mr. Allen’s prompts. According to Midjourney’s documentation, prompts “influence” what the system generates and

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are “interpret[ed]” by Midjourney and “compared to its training data.” As the [Copyright] Office has explained, “Midjourney does not interpret prompts as specific instructions to create a particular expressive result,” because “Midjourney does not understand grammar, sentence structure, or words like humans.” It is the Office’s understanding that, because Midjourney does not treat text prompts as direct instructions, users may need to attempt hundreds of iterations before landing upon an image they find satisfactory. This appears to be the case for Mr. Allen, who experimented with over 600 prompts before he “select[ed] and crop[ped] out one ‘acceptable’ panel out of four potential images ... (after hundreds were previously generated).” As the Office described in its March [2023] guidance, “when an AI technology receives solely a prompt from a human and produces complex written, visual, or musical works in response, the ‘traditional elements of authorship’ are determined and executed by the technology—not the human user.” And because the authorship in the Midjourney Image is more than de minimis, Mr. Allen must exclude it from his claim. Because Mr. Allen has refused to limit his claim to exclude its non-human authorship elements, the Office cannot register the Work as submitted.

U.S. Copyright Office, Copyright Review Board Letter of Sept. 5, 2023 (Second Request for Reconsideration for Refusal to Register Théâtre D’opéra Spatial), <https://www.copyright.gov/rulings-filings/review-board/docs/Theatre-Dopera-Spatial.pdf>.

B. Authorship and Ownership in Joint Works

Section 101 of the Copyright Act defines “joint work” as follows:

A “joint work” is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

Although the Copyright Act explicitly contemplates the existence of a category of joint works, the statute is silent with respect to the nature of the joint-authorship relationship, including the nature of joint authors’ co-ownership of the copyright in their joint work. This omission was intentional: According to the Copyright Act’s legislative history, “[t]here is ... no need for a specific statutory provision concerning the rights and duties of the coowners of a work; court-made law on this point is left undisturbed. Under the bill, as under the present law, coowners of a copyright would be treated generally as tenants in common, with each coowner having an independent right to use or license the use of a work, subject to a duty of accounting to the other coowners for any profits.” H.R. REP. NO. 1476, 94th Cong., 2d Sess. 47, at 121 (1976).

Note that the co-authors’ rights as co-owners are simply default rules and may be adjusted by the agreement of the co-authors. For example, in the absence of an agreement to the contrary, each co-author (regardless of how much “authorship” that a particular co-author contributed) will own an equal, undivided fractional interest in the entire work. But co-authors might agree that one of them is entitled to a greater or lesser share of revenues from licensing the work. Similarly, in the absence of an agreement to the contrary, each co-author has an independent right to exercise each of the copyright rights in the work, and to license others to do so. But co-authors might also agree that no one of them may use the work, or may license use of the work, without the other co-author’s (or co-authors’) agreement. We will return to the issue of licensing in Chapter X.

As you read the following cases, consider the roles that (a) status as an “author” and (b) the parties’ “intention” play in the court’s understanding of the definition of a “joint work.”

Karen Erickson v. Trinity Theatre, Inc.

13 F.3d 1061 (7th Cir. 1994)

RIPPLE, J.: ...

[1] [Karen] Erickson was one of the founders of a theatre company in Evanston, Illinois, that ultimately became known as Trinity Theatre. Between 1981 and January 1991, Ms. Erickson served Trinity in various capacities: as playwright, artistic director, actress, play director, business manager, and member of the board of directors. This suit revolves around Ms. Erickson’s role as playwright....

[2] Ms. Erickson left Trinity Theatre in January 1991.... On January 21, 1991, Ms. Erickson’s attorneys wrote Trinity a letter demanding that the theatre discontinue performing the plaintiff’s plays. Trinity refused to comply with the request.

[3] ... Ms. Erickson filed a ... complaint against Trinity Theatre, members of Trinity’s management, and individual Trinity actors ... in which she alleged copyright infringement

[4] The [court is] faced with ... establishing the appropriate test for determining whether a work has been prepared as a “joint work” within the meaning of § 101 of the Copyright Act of 1976. The parties suggested different approaches. Trinity maintained that the standard for determining a joint work is “collaboration alone”; because there was collaboration between Ms. Erickson and its members, its members jointly authored the ... plays at issue and share rights to their use and production. Ms. Erickson contended that the appropriate test for a joint work is the “copyrightable subject matter” test. Under the test suggested by Ms. Erickson, none of the plays were joint works because only she was an author; the other actors had not contributed independently copyrightable subject matter....

[5] Even if two or more persons collaborate ..., the product will be considered a “joint work” only if the collaborators can be considered “authors.” Courts have applied two tests to evaluate the contributions of authors claiming joint authorship status: Professor Nimmer’s de minimis test and Professor Goldstein’s copyrightable subject matter (“copyrightability”) test. The de minimis and copyrightability tests differ in one fundamental respect. The de minimis test requires that only the combined product of joint efforts must be copyrightable. By contrast, Professor Goldstein’s copyrightability test requires that each author’s contribution be copyrightable. We evaluate each of these tests in turn....

[6] [Nimmer’s] position has not found support in the courts. The lack of support in all likelihood stems from one of several weaknesses in Professor Nimmer’s approach. First, Professor Nimmer’s test is not consistent with one of the [Copyright] Act’s premises: ideas and concepts standing alone should not receive protection. Because the creative process necessarily involves the development of existing concepts into new forms, any restriction on the free exchange of ideas stifles creativity to some extent. Restrictions on an author’s use of existing ideas in a work, such as the threat that accepting suggestions from another party might jeopardize the author’s sole entitlement to a copyright, would hinder creativity. Second, contribution of an idea is an exceedingly ambiguous concept. Professor Nimmer provides little guidance to courts or parties regarding when a contribution rises to the level of joint authorship except to state that the contribution must be “more than a word or a line.”

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[7] For these reasons, we, as the majority of the other courts, cannot accept Professor Nimmer’s test as an adequate judicial tool to ascertain joint authorship.

[8] The copyrightable subject matter test ... formulated by Professor Paul Goldstein ... has been adopted, in some form, by a majority of courts that have considered the issue. According to Professor Goldstein, “[a] collaborative contribution will not produce a joint work, and a contributor will not obtain a co-ownership interest, unless the contribution represents original expression that could stand on its own as the subject matter of copyright.” Professor Goldstein and the courts adopting his test justify this position by noting that § 101’s and § 302(b)’s use of the word “authors” suggests that each collaborator’s contribution must be a copyrightable “work of authorship” within the meaning of § 102(a).

[9] We agree that the language of the Act supports the adoption of a copyrightability requirement. Section 101 of the Act defines a “joint work” as a “work prepared by two or more *authors*” (emphasis added). To qualify as an author, one must supply more than mere direction or ideas. An author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection....

[10] The copyrightable subject matter test does not suffer from the same infirmities as Professor Nimmer’s de minimis test. The copyrightability test advances creativity in science and art by allowing for the unhindered exchange of ideas, and protects authorship rights in a consistent and predictable manner. It excludes contributions such as ideas which are not protected under the Copyright Act. This test also enables parties to predict whether their contributions to a work will entitle them to copyright protection as a joint author. Compared to the uncertain exercise of divining whether a contribution is more than de minimis, reliance on the copyrightability of an author’s proposed contribution yields relatively certain answers. The copyrightability standard allows contributors to avoid post-contribution disputes concerning authorship, and to protect themselves by contract if it appears that they would not enjoy the benefits accorded to authors of joint works under the Act....

[11] In order for the plays to be joint works under the Act, Trinity ... must show that actors’ contributions to Ms. Erickson’s work could have been independently copyrighted. Trinity cannot establish this requirement for any of the ... works. The actors, on the whole, could not identify specific contributions that they had made to Ms. Erickson’s works. Even when [a Trinity Theatre actor] was able to do so, the contributions that he identified were not independently copyrightable. Ideas, refinements, and suggestions, standing alone, are not the subjects of copyrights....

[12] Trinity cannot establish joint authorship to the plays at issue....

Jefri Aal Muhammed v. Spike Lee

202 F.3d 1227 (9th Cir. 1999)

KLEINFELD, J.: ...

[1] In 1991, Warner Brothers contracted with Spike Lee and his production companies to make the movie *Malcolm X*, to be based on the book, *The Autobiography of Malcolm X*. Lee co-wrote the screenplay, directed, and co-produced the movie, which starred Denzel Washington as Malcolm X. Washington asked Jefri Aal Muhammed to assist him in his preparation for the starring role because Aal Muhammed knew a great deal about Malcolm X and Islam. Aal Muhammed, a devout Muslim, was particularly knowledgeable about the life of Malcolm X, having previously written, directed, and produced a documentary film about Malcolm X.

[2] Aalmuhammed joined Washington on the movie set.... Aalmuhammed presented evidence that his involvement in making the movie was very extensive. He reviewed the shooting script for Spike Lee and Denzel Washington and suggested extensive script revisions. Some of his script revisions were included in the released version of the film; others were filmed but not included in the released version. Most of the revisions Aalmuhammed made were to ensure the religious and historical accuracy and authenticity of scenes depicting Malcolm X's religious conversion and pilgrimage to Mecca.

[3] Aalmuhammed submitted evidence that he directed Denzel Washington and other actors while on the set, created at least two entire scenes with new characters, translated Arabic into English for subtitles, supplied his own voice for voice-overs, selected the proper prayers and religious practices for the characters, and edited parts of the movie during post production. Washington testified in his deposition that Aalmuhammed's contribution to the movie was "great" because he "helped to rewrite, to make more authentic." Once production ended, Aalmuhammed met with numerous Islamic organizations to persuade them that the movie was an accurate depiction of Malcolm X's life.

[4] Aalmuhammed never had a written contract with Warner Brothers, Lee, or Lee's production companies, but he expected Lee to compensate him for his work.... Aalmuhammed ultimately received a check for \$25,000 from Lee, which he cashed, and a check for \$100,000 from Washington, which he did not cash.

[5] During the summer before Malcolm X's November 1992 release, Aalmuhammed asked for a writing credit as a co-writer of the film, but was turned down. When the film was released, it credited Aalmuhammed only as an "Islamic Technical Consultant," far down the list. In November 1995, Aalmuhammed applied for a copyright with the U.S. Copyright Office, claiming he was a co-creator, co-writer, and co-director of the movie. The Copyright Office issued him a "Certificate of Registration," but advised him in a letter that his "claims conflict with previous registrations" of the film.

[6] On November 17, 1995, Aalmuhammed filed a complaint against Spike Lee, his production companies, and Warner Brothers The suit sought declaratory relief and an accounting under the Copyright Act.... The district court dismissed some of the claims under Rule 12(b)(6) and the rest on summary judgment....

[7] Aalmuhammed claimed that the movie *Malcolm X* was a "joint work" of which he was an author, thus making him a co-owner of the copyright. He sought a declaratory judgment to that effect, and an accounting for profits. He is not claiming copyright merely in what he wrote or contributed, but rather in the whole work, as a co-author of a "joint work." ...

[8] Aalmuhammed argues that he established a genuine issue of fact as to whether he was an author of a "joint work," *Malcolm X*. The Copyright Act does not define "author," but it does define "joint work":

A "joint work" is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

[9] The statutory language establishes that for a work to be a "joint work" there must be (1) a copyrightable work, (2) two or more "authors," and (3) the authors must intend their contributions be merged into inseparable or interdependent parts of a unitary whole. A "joint work" in this circuit requires each author to make an independently copyrightable contribution to the disputed work. *Malcolm X* is a copyrightable work, and it is undisputed that the movie was intended by everyone involved with it to be a unitary whole.... Aalmuhammed has ... submitted evidence that he rewrote several specific passages of dialogue that appeared in *Malcolm X*, and that he wrote scenes relating to Malcolm X's Hajj pilgrimage that were enacted in the movie. If Aalmuhammed's evidence is accepted, as it must be on summary judgment, these items would have been independently copyrightable. Aalmuhammed, therefore, has presented a genuine issue of fact as to whether he made a copyrightable contribution. All persons involved intended that Aalmuhammed's contributions would

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be merged into interdependent parts of the movie as a unitary whole. Aalmuhammed maintains that he has shown a genuine issue of fact for each element of a “joint work.”

[10] But there is another element to a “joint work.” A “joint work” includes “two or more authors.” Aalmuhammed established that he contributed substantially to the film, but not that he was one of its “authors.” We hold that authorship is required under the statutory definition of a joint work, and that authorship is not the same thing as making a valuable and copyrightable contribution. We recognize that a contributor of an expression may be deemed to be the “author” of that expression for purposes of determining whether it is independently copyrightable. The issue we deal with is a different and larger one: is the contributor an author of the joint work within the meaning of 17 U.S.C. § 101.

[11] The word “author” is taken from the traditional activity of one person sitting at a desk with a pen and writing something for publication. It is relatively easy to apply the word “author” to a novel. It is also easy to apply the word to two people who work together in a fairly traditional pen-and-ink way, like, perhaps, Gilbert and Sullivan. In the song, “I Am the Very Model of a Modern Major General,” Gilbert’s words and Sullivan’s tune are inseparable, and anyone who has heard the song knows that it owes its existence to both men, Sir William Gilbert and Sir Arthur Sullivan, as its creative originator. But as the number of contributors grows and the work itself becomes less the product of one or two individuals who create it without much help, the word is harder to apply.

[12] Who, in the absence of contract, can be considered an author of a movie? The word is traditionally used to mean the originator or the person who causes something to come into being For a movie, that might be the producer who raises the money.... The “auteur” theory suggests that it might be the director, at least if the director is able to impose his artistic judgments on the film. Traditionally, by analogy to books, the author was regarded as the person who writes the screenplay, but often a movie reflects the work of many screenwriters.... [T]he person with creative control tends to be the person in whose name the money is raised, perhaps a star, perhaps the director, perhaps the producer, with control gravitating to the star as the financial investment in scenes already shot grows. Where the visual aspect of the movie is especially important, the chief cinematographer might be regarded as the author. And for, say, a Disney animated movie like *The Jungle Book*, it might perhaps be the animators and the composers of the music.

[13] The Supreme Court dealt with the problem of defining “author” in new media in *Burrow-Giles Lithographic Co. v. Sarony*. The question there was, who is the author of a photograph: the person who sets it up and snaps the shutter, or the person who makes the lithograph from it. Oscar Wilde, the person whose picture was at issue, doubtless offered some creative advice as well. The Court decided that the photographer was the author ...: “the person who has superintended the arrangement, who has actually formed the picture by putting the persons in position, and arranging the place where the people are to be—the man who is the effective cause of that”; “author” involves originating, making, producing, as the inventive or master mind, the thing which is to be protected”; “the man who really represents, creates, or gives effect to the idea, fancy, or imagination.” The Court said that an “author,” in the sense that the Founding Fathers used the term in the Constitution, was “he to whom anything owes its origin; originator; maker; one who completes a work of science or literature.”

[14] So many people might qualify as an “author” if the question were limited to whether they made a substantial creative contribution that that test would not distinguish one from another. Everyone from the producer and director to casting director, costumer, hairstylist, and “best boy” gets listed in the movie credits because all of their creative contributions really do matter. It is striking in *Malcolm X* how much the person who controlled the hue of the lighting contributed, yet no one would use the word “author” to denote that individual’s relationship to the movie. A creative contribution does not suffice to establish authorship of the movie.

[15] *Burrow-Giles*, in defining “author,” requires more than a minimal creative or original contribution to the work.... *Burrow-Giles* defines author as the person to whom the work owes its origin and who superintended the whole work, the “master mind.” In a movie this definition, in the absence of a contract to the contrary, would generally limit authorship to someone at the top of the screen credits, sometimes the producer, sometimes the director, possibly the star, or the screenwriter—someone who has artistic control. After all, in *Burrow-Giles* the lithographer made a substantial copyrightable creative contribution, and so did the person who posed, Oscar Wilde, but the Court held that the photographer was the author.

[16] Considering *Burrow-Giles* ... and the Gilbert and Sullivan example, several factors suggest themselves as among the criteria for joint authorship, in the absence of contract. First, an author superintends the work by exercising control. This will likely be a person who has actually formed the picture by putting the persons in position, and arranging the place where the people are to be—the man who is the effective cause of that, or the inventive or master mind who creates, or gives effect to the idea. Second, putative coauthors make objective manifestations of a shared intent to be coauthors, as by denoting the authorship of *The Pirates of Penzance* as “Gilbert and Sullivan.” We say objective manifestations because, were the mutual intent to be determined by subjective intent, it could become an instrument of fraud, were one coauthor to hide from the other an intention to take sole credit for the work. Third, the audience appeal of the work turns on both contributions and the share of each in its success cannot be appraised. Control in many cases will be the most important factor.

[17] The best objective manifestation of a shared intent, of course, is a contract saying that the parties intend to be or not to be co-authors. In the absence of a contract, the inquiry must of necessity focus on the facts. The factors articulated in this decision ... cannot be reduced to a rigid formula, because the creative relationships to which they apply vary too much. Different people do creative work together in different ways, and even among the same people working together the relationship may change over time as the work proceeds.

[18] Aalmuhammed did not at any time have superintendence of the work. Warner Brothers and Spike Lee controlled it. Aalmuhammed was not the person who has actually formed the picture by putting the persons in position, and arranging the place. Spike Lee was, so far as we can tell from the record. Aalmuhammed ... could make extremely helpful recommendations, but Spike Lee was not bound to accept any of them, and the work would not benefit in the slightest unless Spike Lee chose to accept them. Aalmuhammed lacked control over the work, and absence of control is strong evidence of the absence of co-authorship.

[19] Also, neither Aalmuhammed, nor Spike Lee, nor Warner Brothers, made any objective manifestations of an intent to be coauthors. Warner Brothers required Spike Lee to sign a “work for hire” agreement, so that even Lee would not be a co-author and co-owner with Warner Brothers. It would be illogical to conclude that Warner Brothers, while not wanting to permit Lee to own the copyright, intended to share ownership with individuals like Aalmuhammed who worked under Lee’s control, especially ones who at the time had made known no claim to the role of co-author. No one, including Aalmuhammed, made any indication to anyone prior to litigation that Aalmuhammed was intended to be a co-author and co-owner.

[20] Aalmuhammed offered no evidence that he was the inventive or master mind of the movie.... What Aalmuhammed’s evidence showed, and all it showed, was that, subject to Spike Lee’s authority to accept them, he made very valuable contributions to the movie. That is not enough for co-authorship of a joint work.

[21] The Constitution establishes the social policy that our construction of the statutory term “authors” carries out. The Founding Fathers gave Congress the power to give authors copyrights in order “[t]o promote the progress of Science and useful arts.” Progress would be retarded rather than promoted, if an author could not consult with others and adopt their useful suggestions without sacrificing sole ownership of the work. Too open a definition of author would compel authors to insulate themselves and maintain ignorance of the contributions

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others might make. Spike Lee could not consult a scholarly Muslim to make a movie about a religious conversion to Islam, and the arts would be the poorer for that....

[22] Because the record before the district court established no genuine issue of fact as to Aalmuhammed's co-authorship of Malcolm X as a joint work, the district court correctly granted summary judgment dismissing his claims for declaratory judgment and an accounting resting on co-authorship....

NOTES

1. Consider the different ways in which *Erickson* and *Aalmuhammed* interpret the meaning and effect of the word "authors" in the statutory definition of joint work. Are the two courts' interpretations reconcilable?
2. *Aalmuhammed* says that an "author" is the "inventive" actor, or the "master mind," exercising creative control over the production of a work. What do those words mean? Think of famous creative duos like W.S. Gilbert and Arthur Sullivan, John Lennon and Paul McCartney, and Charles and Ray Eames. Can you identify a "master mind" in any of these duos? Does that concept fit with the reality of creative collaboration?
3. Does *Aalmuhammed's* interpretation of the meaning of "author" have roots in the statutory definition of "joint work"?
4. What sort of "intention" is necessary to create a joint work? *Aalmuhammed* suggests that what is required is an intention by each participant to enter into a co-authorship relationship. *Aalmuhammed* further provides that this intent may be demonstrated by "objective manifestations." But the text of § 101 and the legislative history suggest that the requisite intent is focused on a different point. That is, the "intention" required is not to be co-authors, but merely to "merge" the separate contributions of the putative co-authors into a "unitary whole." The legislative history makes this clear: "[A] work is 'joint' if the authors collaborated with each other, or if each of the authors prepared his or her contribution with the knowledge and intention that it would be merged with the contributions of other authors as 'inseparable or interdependent parts of a unitary whole.' The touchstone here is the intention, at the time the writing is done, that the parts be absorbed or combined into an integral unit..." H.R. REP. NO. 1476, 94th Cong., 2d Sess. 47, at 120 (1976).

A comment in the Restatement of Copyright rejects any test for joint authorship that includes a categorical requirement of an intent to be joint authors:

Two circuits have adopted an additional intent requirement, beyond the intent that each author's contributions be merged into a unitary whole. Those courts require that all putative coauthors must intend to be joint authors, in the sense that they must intend to enter into the legal relationship that governs co-authors of a joint work. For example, the Second Circuit requires that all co-authors "entertain in their minds the concept of joint authorship." Childress v. Taylor, 945 F.2d 500 (2d Cir. 1991). Accord Erickson v. Trinity Theatre, Inc., 13 F.3d 1061 (7th Cir. 1994) (requiring the plaintiff "show the parties intended to be joint authors at the time the work was created"). In explaining this requirement, the Second Circuit has stated that because "coauthors are afforded equal rights in the co-authored work, the 'equal sharing of rights should be reserved for relationships in which all participants fully intend to be joint authors.'" Thomson v. Larson, 147 F.3d 195 (2d Cir. 1998) (quoting Childress). The rule in those circuits is clear: authorship of a copyrightable contribution and intent to merge contributions is insufficient; all authors must also possess an intent to be joint authors.

Most circuits have not adopted that strict requirement for a shared intent to be joint authors. The Ninth Circuit has held that "whether the 'putative coauthors ma[de] objective manifestations of their shared intent to be coauthors" is one of at least three criteria used to determine whether the parties have created a joint work. Richlin v. Metro-Goldwyn-Mayer Pictures, Inc., 531 F.3d 962 (9th Cir. 2008) (quoting Aalmuhammed). It is not, however, the most important factor. Id.

(noting that level of control exercised by the putative co-authors “will often be the most important factor”).

Whether expressed as a categorical requirement for a work to be a joint work or as one factor in making that determination, the consideration of whether the authors intended to be coauthors is animated by a desire to not elevate a minor contributor to the status of a joint author entitled to equal co-ownership of the entire work unless there is a clear corresponding intent by the author(s) of the major contribution(s). See, e.g., *Childress* (noting that the “equal sharing of rights should be reserved for relationships in which all participants fully intend to be joint authors”). It is also animated by a desire to keep the number of authors of a complex work to a manageable number. See *Aalmuhammed*. A categorical requirement of shared intent to be co-authors, however, is not directly supported by the statute’s text or its legislative history regarding the necessary intent. This Restatement takes the position that the concern that minor contributors to a work not be elevated to the status of joint author is better addressed through an examination of whether the contributor is in fact not just the author of his or her own minor contribution to a larger work but rather is one of the co-authors of that larger work as a unitary whole.... The evidence that the Second, Seventh, and Ninth Circuits employ to demonstrate a shared intent to be co-authors can be helpful in determining whether the significance of each author’s contribution to a work qualifies the author as a co-author of that work....

Restatement of the Law, Copyright, Tentative Draft No. 2, § 22, Comment c, copyright © 2021 by The American Law Institute. Reproduced with permission, not as part of a Creative Commons license.

5. If *Aalmuhammed*’s construction of the meaning of both “authors” and “intention” is not aligned with the statute, what do you suppose led the Ninth Circuit to add its “intent to be co-authors” requirement?

6. Is a Wikipedia entry, or the entirety of Wikipedia, a joint work with all contributors as co-authors? Why or why not? For more on the granularity of authorship and micro-works, see Justin Hughes, *Size Matters (or Should) in Copyright Law*, 74 *FORDHAM L. REV.* 575 (2005); Molly Shaffer Van Houweling, *Author Autonomy and Atomism in Copyright Law*, 96 *VA. L. REV.* 549 (2010).

7. Recently there has been a string of lawsuits filed by paparazzi photographers against celebrities who have posted the pictures paparazzi took of them on their social media accounts. Do the celebrities have a possible claim of co-authorship and co-ownership of those photographs? See Jeanne C. Fromer, *The New Copyright Opportunist*, 67 *J. COPYRIGHT SOC’Y* 1 (2020).

8. As you read earlier, copyright law’s default rule grants all co-authors of joint works an equal co-ownership share. Of course, co-authors can agree to contract around this rule. But the question nonetheless arises whether equal co-ownership is the right default, especially given the possibility that co-authors might make contributions of different magnitude and value. One of the concerns motivating the default rule of equal co-ownership shares must be the cost and difficulty of determining, either ex ante or ex post, the relative importance or value of different co-authors’ contributions. Recent empirical scholarship also suggests that, at least for jointly written songs, co-ownership by equal shares actually improves the quality of creativity. See Sarah Polcz, *Loyalties vs. Royalties*, 74 *HASTINGS L.J.* 765 (2023).

C. Authorship and Ownership in Works Made for Hire

As stated above, the Copyright Act of 1976 provides that copyright ownership “vests initially in the author or authors of the work.” 17 U.S.C. § 201(a). As a general rule, the author is the party or parties who actually create the work, that is, the person or persons who translate an idea into a fixed, tangible expression entitled to copyright protection. *Id.* § 102. However, the Copyright Act establishes an exception for “works made for hire.”

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If the work is made for hire, “the employer or other person for whom the work was prepared is considered the author,” and initially owns the copyright, unless there is a written agreement to the contrary. *Id.* § 201(b).

As we shall see later in this book, a work’s status as a “work made for hire” has implications for, among other things, (a) the duration of the copyright term that applies to the work, and (b) whether the author of that work may take advantage of the Copyright Act’s termination-of-transfers provision. We’ll return to those issues in Chapter IV.

Section 101 of the Copyright Act contains a two-part definition of “work made for hire”:

A “work made for hire” is—

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. For the purpose of the foregoing sentence, a “supplementary work” is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an “instructional text” is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

NOTES

1. What role do the “work made for hire” provisions play in the overall scheme of U.S. copyright law? What are the policy arguments for and against the “work made for hire” provisions?
 2. Recall that the Constitution’s Copyright and Patent Clause empowers Congress to grant copyrights to “Authors.” Is the Copyright Act’s “work made for hire” provision constitutional?
-

1. Works of Employees Operating Within the Scope of Employment

The next two cases focus on the first part of the “work made for hire” definition—the part that classifies as works made for hire “work[s] prepared by an employee within the scope of his or her employment” As you read these cases, think about whether the guidance they provide (a) regarding who is an “employee” and (b) whether a particular work falls within the “scope of employment,” tracks your intuitions about these concepts.

Community for Creative Non-Violence v. James Earl Reid

490 U.S. 730 (1989)

MARSHALL, J.: ...

[1] Petitioners are the Community for Creative Non-Violence (CCNV), a nonprofit unincorporated association dedicated to eliminating homelessness in America, and Mitch Snyder, a member and trustee of CCNV. In the fall of 1985, CCNV decided to participate in the annual Christmastime Pageant of Peace in Washington, D.C., by sponsoring a display to dramatize the plight of the homeless. As the District Court recounted:

Snyder and fellow CCNV members conceived the idea for the nature of the display: a sculpture of a modern Nativity scene in which, in lieu of the traditional Holy Family, the two adult figures and the infant would appear as contemporary homeless people huddled on a streetside steam grate. The family was to be black (most of the homeless in Washington being black); the figures were to be life-sized, and the steam grate would be positioned atop a platform pedestal, or base, within which special-effects equipment would be enclosed to emit simulated steam through the grid to swirl about the figures. They also settled upon a title for the work—‘Third World America’—and a legend for the pedestal: ‘and still there is no room at the inn.’

[2] Snyder made inquiries to locate an artist to produce the sculpture. He was referred to respondent James Earl Reid, a Baltimore, Maryland, sculptor. In the course of two telephone calls, Reid agreed to sculpt the three human figures. CCNV agreed to make the steam grate and pedestal for the statue. Reid proposed that the work be cast in bronze, at a total cost of approximately \$100,000 and taking six to eight months to complete. Snyder rejected that proposal because CCNV did not have sufficient funds, and because the statue had to be completed by December 12 to be included in the pageant. Reid then suggested, and Snyder agreed, that the sculpture would be made of a material known as “Design Cast 62,” a synthetic substance that could meet CCNV’s monetary and time constraints, could be tinted to resemble bronze, and could withstand the elements. The parties agreed that the project would cost no more than \$15,000, not including Reid’s services, which he offered to donate. The parties did not sign a written agreement. Neither party mentioned copyright.

[3] After Reid received an advance of \$3,000, he made several sketches of figures in various poses. At Snyder’s request, Reid sent CCNV a sketch of a proposed sculpture showing the family in a crèche like setting: the mother seated, cradling a baby in her lap; the father standing behind her, bending over her shoulder to touch the baby’s foot. Reid testified that Snyder asked for the sketch to use in raising funds for the sculpture. Snyder testified that it was also for his approval. Reid sought a black family to serve as a model for the sculpture. Upon Snyder’s suggestion, Reid visited a family living at CCNV’s Washington shelter but decided that only their newly born child was a suitable model. While Reid was in Washington, Snyder took him to see homeless people living on the streets. Snyder pointed out that they tended to recline on steam grates, rather than sit or stand, in order to warm their bodies. From that time on, Reid’s sketches contained only reclining figures.

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[4] Throughout November and the first two weeks of December 1985, Reid worked exclusively on the statue, assisted at various times by a dozen different people who were paid with funds provided in installments by CCNV. On a number of occasions, CCNV members visited Reid to check on his progress and to coordinate CCNV's construction of the base. CCNV rejected Reid's proposal to use suitcases or shopping bags to hold the family's personal belongings, insisting instead on a shopping cart. Reid and CCNV members did not discuss copyright ownership on any of these visits.

[5] On December 24, 1985, 12 days after the agreed-upon date, Reid delivered the completed statue to Washington. There it was joined to the steam grate and pedestal prepared by CCNV and placed on display near the site of the pageant. Snyder paid Reid the final installment of the \$15,000. The statue remained on display for a month. In late January 1986, CCNV members returned it to Reid's studio in Baltimore for minor repairs. Several weeks later, Snyder began making plans to take the statue on a tour of several cities to raise money for the homeless. Reid objected, contending that the Design Cast 62 material was not strong enough to withstand the ambitious itinerary. He urged CCNV to cast the statue in bronze at a cost of \$35,000, or to create a master mold at a cost of \$5,000. Snyder declined to spend more of CCNV's money on the project.



Figure 47: "Third World America," by James Earl Reid

[6] In March 1986, Snyder asked Reid to return the sculpture. Reid refused. He then filed a certificate of copyright registration for "Third World America" in his name and announced plans to take the sculpture on a more modest tour than the one CCNV had proposed. Snyder, acting in his capacity as CCNV's trustee, immediately filed a competing certificate of copyright registration.

[7] Snyder and CCNV then commenced this action against Reid ... seeking return of the sculpture and a determination of copyright ownership. The District Court granted a preliminary injunction, ordering the sculpture's return. After a 2-day bench trial, the District Court declared that "Third World America" was a "work made for hire" under § 101 of the Copyright Act and that Snyder, as trustee for CCNV, was the exclusive owner of the copyright in the sculpture. The court reasoned that Reid had been an "employee" of CCNV within the meaning of § 101(1) because CCNV was the motivating force in the statue's production. Snyder and other CCNV members, the court explained, conceived the idea of a contemporary Nativity scene to contrast with the

national celebration of the season, and directed enough of Reid's effort to assure that, in the end, he had produced what they, not he, wanted.

[8] The Court of Appeals for the District of Columbia Circuit reversed and remanded, holding that Reid owned the copyright because "Third World America" was not a work for hire.... Because, under agency law, Reid was an independent contractor, the court concluded that the work was not "prepared by an employee" under § 101(1)....

[9] We granted certiorari to resolve a conflict among the Courts of Appeals over the proper construction of the "work made for hire" provisions of the Act....

[10] The Copyright Act of 1976 provides that copyright ownership "vests initially in the author or authors of the work." As a general rule, the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection. The Act carves out an important exception, however, for works made for hire. If the work is for hire, "the employer or other person for whom the work was prepared is considered the author" and owns the copyright, unless there is a written agreement to the contrary....⁴

[11] Section 101 of the 1976 Act provides that a work is for hire under two sets of circumstances:

(1) a work prepared by an employee within the scope of his or her employment; or

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

[12] Petitioners do not claim that the statue satisfies the terms of § 101(2). Quite clearly, it does not. Sculpture does not fit within any of the nine categories of "specially ordered or commissioned" works enumerated in that subsection, and no written agreement between the parties establishes "Third World America" as a work for hire.

[13] The dispositive inquiry in this case therefore is whether "Third World America" is "a work prepared by an employee within the scope of his or her employment" under § 101(1). The Act does not define these terms. In the absence of such guidance, four interpretations have emerged. The first holds that a work is prepared by an employee whenever the hiring party retains the right to control the product. Petitioners take this view. A second, and closely related, view is that a work is prepared by an employee under § 101(1) when the hiring party has actually wielded control with respect to the creation of a particular work. This approach [i]s ... adopted ... at times, by petitioners. A third view is that the term "employee" within § 101(1) carries its common-law agency law meaning. This view was endorsed ... by the Court of Appeals below. Finally, respondent and numerous amici curiae contend that the term "employee" only refers to formal, salaried employees.

[14] The starting point for our interpretation of a statute is always its language. The Act nowhere defines the terms "employee" or "scope of employment." It is, however, well established that where Congress uses terms that have accumulated settled meaning under the common law, a court must infer, unless the statute otherwise dictates, that Congress means to incorporate the established meaning of these terms. In the past, when Congress has used the term "employee" without defining it, we have concluded that Congress intended to

⁴ As of 1955, approximately 40 percent of all copyright registrations were for works for hire, according to a Copyright Office study.... The Copyright Office does not keep more recent statistics on the number of work for hire registrations.

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describe the conventional master-servant relationship as understood by common-law agency doctrine. Nothing in the text of the work for hire provisions indicates that Congress used the words “employee” and “employment” to describe anything other than the conventional relation of employer and employ[ee]. On the contrary, Congress’ intent to incorporate the agency law definition is suggested by § 101(1)’s use of the term, “scope of employment,” a widely used term of art in agency law. *See* Restatement (Second) of Agency § 228 (1958).

[15] In past cases of statutory interpretation, when we have concluded that Congress intended terms such as “employee,” “employer,” and “scope of employment” to be understood in light of agency law, we have relied on the general common law of agency ... to give meaning to these terms.... We thus agree with the Court of Appeals that the term “employee” should be understood in light of the general common law of agency.

[16] In contrast, neither test proposed by petitioners is consistent with the text of the Act. The exclusive focus of the right to control the product test on the relationship between the hiring party and the product clashes with the language of § 101(1), which focuses on the relationship between the hired and hiring parties. The right to control the product test also would distort the meaning of the ensuing subsection, § 101(2). Section 101 plainly creates two distinct ways in which a work can be deemed for hire: one for works prepared by employees, the other for those specially ordered or commissioned works which fall within one of the nine enumerated categories and are the subject of a written agreement. The right to control the product test ignores this dichotomy by transforming into a work for hire under § 101(1) any “specially ordered or commissioned” work that is subject to the supervision and control of the hiring party. Because a party who hires a “specially ordered or commissioned” work by definition has a right to specify the characteristics of the product desired, at the time the commission is accepted, and frequently until it is completed, the right to control the product test would mean that many works that could satisfy § 101(2) would already have been deemed works for hire under § 101(1)....

[17] The actual control test fares only marginally better when measured against the language and structure of § 101. Under this test, work for hire status under § 101(1) depends on a hiring party’s actual control of, rather than right to control, the product.... [T]here is no statutory support for an additional dichotomy between commissioned works that are actually controlled and supervised by the hiring party and those that are not.

[18] We therefore conclude that the language and structure of § 101 of the Act do not support either the right to control the product or the actual control approaches.⁸ The structure of § 101 indicates that a work for hire can arise through one of two mutually exclusive means, one for employees and one for independent contractors, and ordinary canons of statutory interpretation indicate that the classification of a particular hired party should be made with reference to agency law....

[19] ... [P]etitioners’ construction of the work for hire provisions would impede Congress’ paramount goal in revising the 1976 Act of enhancing predictability and certainty of copyright ownership. 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.

[20] 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,

⁸ We also reject the suggestion of respondent and amici that the § 101(1) term “employee” refers only to formal, salaried employees. While there is some support for such a definition in the legislative history, the language of § 101(1) cannot support it. The Act does not say “formal” or “salaried” employee, but simply “employee.” ...

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 ... 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....

[21] We turn, finally, to an application of § 101 to Reid's production of "Third World America." In determining whether a hired party is an employee under the general common law of agency, we consider the hiring party's right to control the manner and means by which the product is accomplished. Among the other factors relevant to this inquiry are the skill required; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired party; the extent of the hired party's discretion over when and how long to work; the method of payment; the hired party's role in hiring and paying assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hired party. See Restatement § 220(2) (setting forth a nonexhaustive list of factors relevant to determining whether a hired party is an employee). No one of these factors is determinative.

[22] Examining the circumstances of this case in light of these factors, we agree with the Court of Appeals that Reid was not an employee of CCNV but an independent contractor. True, CCNV members directed enough of Reid's work to ensure that he produced a sculpture that met their specifications. But the extent of control the hiring party exercises over the details of the product is not dispositive. Indeed, all the other circumstances weigh heavily against finding an employment relationship. Reid is a sculptor, a skilled occupation. Reid supplied his own tools. He worked in his own studio in Baltimore, making daily supervision of his activities from Washington practicably impossible. Reid was retained for less than two months, a relatively short period of time. During and after this time, CCNV had no right to assign additional projects to Reid. Apart from the deadline for completing the sculpture, Reid had absolute freedom to decide when and how long to work. CCNV paid Reid \$15,000, a sum dependent on completion of a specific job, a method by which independent contractors are often compensated. Reid had total discretion in hiring and paying assistants. Creating sculptures was hardly regular business for CCNV. Indeed, CCNV is not a business at all. Finally, CCNV did not pay payroll or Social Security taxes, provide any employee benefits, or contribute to unemployment insurance or workers' compensation funds.

[23] Because Reid was an independent contractor, whether "Third World America" is a work for hire depends on whether it satisfies the terms of § 101(2). This petitioners concede it cannot do. Thus, CCNV is not the author of "Third World America" by virtue of the work for hire provisions of the Act. However, ... CCNV nevertheless may be a joint author of the sculpture if, on remand, the District Court determines that CCNV and Reid prepared the work "with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." In that case, CCNV and Reid would be co-owners of the copyright in the work....

NOTES

1. Is the Court's textual argument—that the common law agency approach to determining status as employee or independent contractor is consistent with the Copyright Act's text, and that the other tests ("right to control the product," "actual control," and "formal or salaried employee") are not—convincing?
2. Similarly, the court rejects the "right to control the product" and "actual control" tests in part because those tests would make it difficult for the parties to predict in advance who would end up owning the copyright. Is that a convincing argument? Does the common law agency test fare better on this count?

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3. While the *CCNV* case was pending on remand, Mitch Snyder died by suicide. For a respectful appreciation of a complicated life, see <https://www.nytimes.com/1990/07/06/obituaries/mitch-snyder-46-advocate-of-homeless.html>. The case settled soon thereafter, with the parties agreeing that Reid was the author and copyright owner of “Third World America,” but that *CCNV* was the owner of the physical sculpture. The parties further agreed that *CCNV* and Reid would each have rights to produce two-dimensional copies (posters and postcards) of the work.

4. If the *CCNV* case had not settled, the district court on remand would have considered whether “Third World America” was a joint work in which Reid and *CCNV* were co-authors. How do you think this issue should have been decided?

5. For a survey of how courts have used the *CCNV* factors, and, in particular, an analysis of which of the *CCNV* factors is the most important, see Ryan Vacca, *Work Made for Hire—Analyzing the Multifactor Balancing Test*, 42 FLA. ST. L. REV. 197 (2014). Based on his analysis of a dataset of cases applying the *CCNV* factors, Vacca concludes that tax treatment, the provision of employee benefits, and payment method are the most important, followed closely by whether the hiring party has the power to assign additional projects, the skill required, and the source of the instrumentalities and tools. The other *CCNV* factors appear to be less important in driving the analysis of whether a party is an employee or independent contractor.

6. In *JustMed, Inc. v. Byce*, 600 F.3d 1118 (9th Cir. 2010), the Ninth Circuit held that the defendant was an employee despite his argument that the plaintiff did not treat him as an employee for tax purposes. Other *CCNV* factors also weighed against employment. For example, the defendant had been paid in shares of stock, which had not been reported as income by him. Nonetheless, the court reasoned that the business at issue was a technology start-up company rather than an established business, which affected its evaluation of the factors. How should the *CCNV* factors be applied to evaluate employment status for a technology start-up company or other less traditional businesses?

7. In 2005, the American Law Institute adopted the *Restatement (Third) of Agency*. The new Restatement no longer contains the list of factors relied upon in *CCNV* for determining employment status. Instead, it provides that “an employee is an agent whose principal controls or has the right to control the manner and means of the agent’s performance of work.” RESTATEMENT (THIRD) OF AGENCY §7.07(3)(a). Do you think the result in *CCNV* would come out any differently under the Restatement’s revised formulation? Do you think this new standard better comports with current types of employment?

Avtec Systems, Inc. v. Jeffrey G. Peiffer

21 F.3d 568 (4th Cir. 1994)

PHILLIPS, J.: ...

[1] Avtec Systems, Inc. markets space-related computer services and products to the federal government. Its services include computerized simulations of satellite orbital patterns. Jeffrey G. Peiffer began working part-time for Avtec while in college and became the company’s fifth full-time employee upon his graduation in 1984. During his career with Avtec, his job description included “implement[ing] computer simulation” and, specifically, simulating “satellite orbits.”

[2] In 1984, Avtec purchased a Macintosh computer at Peiffer’s suggestion. After Peiffer demonstrated the computer’s abilities to Avtec President Ronald Hirsch and other employees, it became apparent that the company’s orbital simulations would be enhanced in several respects by using a Macintosh. It is disputed whether that idea originated with Peiffer alone or in discussions with other Avtec personnel; it also is disputed

whether Avtec authorized Peiffer to begin developing a computer program for that purpose as he did in 1985. Peiffer demonstrated the Program—called “the .309 version”—to Hirsch and others at Avtec that same year, and again during his 1988 performance appraisal as evidence of his initiative on the job.

[3] At that point, Hirsch and another Avtec employee suggested several modifications to enhance the Program’s utility as a marketing tool for the company. Peiffer charged time to an Avtec account for making those enhancements. Peiffer also received a \$5,000 bonus in early 1989 for helping to land a contract by demonstrating the Program as a unique Avtec service. He performed similar demonstrations for other clients as well. Later that year, Avtec issued a written policy, of which Peiffer was aware, binding employees to duties of confidentiality and nondisclosure respecting the company’s proprietary information and trade secrets.

[4] In early 1990, another Avtec employee found some bugs in the Program. After Peiffer fixed them, that other employee presented the corrected version to a client. In 1991, Avtec labeled the Program as a trademark and advertised it as unique to Avtec. At no time before his eventual departure from Avtec did Peiffer represent to his employer or to its potential clients that he had an ownership interest in the Program.

[5] In 1992, however, when Peiffer was asked to demonstrate the Program to NASA as part of a contract bid, he used the old, uncorrected .309 version without informing anyone at Avtec or NASA of that fact. Peiffer concedes that Avtec did not win that contract in part because he showed the outdated version. Shortly thereafter, when Peiffer was again asked to demonstrate the program, he refused and said that he didn’t have a copy of it at the office.

[6] Unbeknownst to Avtec, Peiffer had met Paul F. Kisk early in 1989 and granted Kisk’s company, Kisk-Kisk, Inc. (KKI) an exclusive license to market the Program. Sales generated \$197,000 in gross revenues for KKI, of which Peiffer received approximately half.

[7] Avtec registered for a copyright in the .309 version of the Program on March 27, 1992. Six days later, Avtec commenced this action against Peiffer, Kisk, and KKI charging copyright infringement, misappropriation of trade secrets, and breach of fiduciary duty.... On April 9, Peiffer registered his copyright claim in the .309 version, which he called MacOrbit, and another copyright claim in the 2.05 version, which he called the Orbit Program and identified as derivative of the .309 version. Defendants then counterclaimed for copyright infringement.

[8] After a three-day bench trial, the court found that Peiffer owned copyright in the later version of the Program, reasoning that he had not created it within the scope of his employment as is required by 17 U.S.C. § 201(b) in order for copyright to vest in an employer. On that basis, the court denied Avtec relief on Count I and—pursuant to defendants’ counterclaim—ordered Avtec to withdraw its registration of copyright....

[9] To recover on its copyright claim, Avtec had to show that it owned a valid copyright in the Program and that defendants encroached upon one of the exclusive rights it conferred....

[10] These rights presumptively vest in the author—the one who translates an original idea into a fixed, tangible means of expression. The presumption of authorial ownership falls, however, if the work is made for hire, such as one prepared by an employee within the scope of his or her employment. Under those circumstances, copyright vests in the employer for whom the work was prepared. This exception is overridden only by a clear writing reserving authorship rights to the employee, 17 U.S.C. § 201(b), which concededly did not exist in this case.

[11] It is essentially undisputed that Peiffer was Avtec’s employee at the time of the Program’s inception. The contested issue throughout has been whether Peiffer created the Program within the scope of his employment. [*Community for Creative Non-Violence v. Reid* instructs that common-law agency principles govern resolution

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of that question. As expressed in Section 228 of the *Restatement [(Second) of Agency]*, the key principle is that a servant's conduct is within the scope of employment "only if: (a) it is of the kind he is employed to perform; (b) it occurs substantially within the authorized time and space limits; [and] (c) it is actuated, at least in part, by a purpose to serve the master."

[12] We agree with the district court that creation of the Program was "of the kind" of work Peiffer was employed to perform. When that element of the *Restatement* test is met, courts have tended not to grant employees authorship rights solely on the basis that the work was done at home on off-hours.

[13] On the other hand, copyright does not vest in the employer solely because the subject matter of the work bears upon or arises out of the employee's activities for his employer. Thus, Avtec had to show that Peiffer was at least appreciably motivated by a desire to further its corporate goals in order to satisfy the third element of the work-for-hire test.

[14] The district court found that Peiffer had not developed version 2.05 of the Program "within Avtec authorized time and space limits ... [and] was [not] motivated, at least in part, by a purpose to serve Avtec." On this basis, the court held that copyright vested in Peiffer, not in Avtec, and accordingly rendered judgment in favor of defendants on Avtec's claim and on their counterclaim....

[15] Instead of focusing upon the question whether the .309 version was created within the scope of Peiffer's employment, however, the district court made a preliminary finding that Avtec used the original version solely as "a demonstration and marketing device," while the later 2.05 version was a "stand-alone software package that could be marketed commercially," which Avtec neither could nor would have developed. Relying on this utilitarian distinction between two versions of the program, the court expressly confined its decision on the question of copyright ownership to "the current 2.05 version" of the Program. Finding dispositive the facts that Peiffer worked on the Program at home, on his own equipment and time, as a "personal hobby, and not to satisfy specific work obligations for Avtec," the court reasoned that "while Peiffer allowed earlier versions of the Orbit Program to be used by Avtec for various client demonstrations, Avtec did not ... persuade the Court that Peiffer's *development of the 2.05 version* ... was actuated by his desire to serve Avtec" and held that Avtec could not "claim complete or joint ownership of the 2.05 version."

[16] Defendants urge us to extend this express language to encompass the .309 version as well....

[17] Anticipating our *de novo* review of the legal component of the scope-of-employment issue, the parties emphasize conflicting evidence supporting their respective positions on that issue. Avtec points to evidence that it authorized Peiffer to work on the project at home during off-hours and contends that Peiffer's resulting behavior compels the inference that he intended the work, at least in part, to contribute to Avtec's successful pursuit of its business objectives. Defendants counter with the evidence relied upon by the district court that Peiffer developed the Program as a hobby and that Avtec failed to exercise significant control or supervision over the project.

[18] ... [W]e ...conclud[e] that the district court's resolution of the scope-of-employment issue was flawed by a misapprehension of the controlling legal principles. We are not in a position to resolve that heavily fact-laden issue in the first instance; among other reasons, credibility could be decisive. Though we regret the necessity, we must instead vacate those portions of the judgment respecting the claim and counterclaim for copyright infringement and remand those claims for reconsideration, in light of this opinion, of the dispositive common issue whether the original Program was created within the scope of Peiffer's employment....

NOTES

1. Again, is the common law agency test predictable in its application? Does the analysis in this case align with your intuitions regarding whether Pfeiffer undertook his work respecting either version of the software program within the scope of his employment with Avtec?

2. How should the district court rule on remand?

3. Avtec leans heavily on § 228 of the *Restatement (Second) of Agency*, which states that an employee's conduct is within the scope of employment "only if: (a) it is of the kind he is employed to perform; (b) it occurs substantially within the authorized time and space limits; [and] (c) it is actuated, at least in part, by a purpose to serve the master." Does this formulation fit with the conditions of modern employment (such as the flexible work schedules and ability to telecommute that many employees have)? Note that Avtec has arguably adjusted the Restatement's three-part test by refusing to apply the second part literally ("When th[e] first element of the Restatement test is met, courts have tended not to grant employees authorship rights solely on the basis that the work was done at home on off-hours.>").

4. As noted above, in 2005, the American Law Institute adopted the *Restatement (Third) of Agency*. In § 7.07(2), the new Restatement sets out a different test for scope of employment:

An employee acts within the scope of employment when performing work assigned by the employer or engaging in a course of conduct subject to the employer's control. An employee's act is not within the scope of employment when it occurs within an independent course of conduct not intended by the employee to serve any purpose of the employer.

Should the result in Avtec change if this revised test is applied?

5. What do you think would have happened if Avtec had come out in favor of the defendants? It is likely that even if the .309 version of the program was not created within the scope of Avtec's employment, the court would have found that Pfeiffer implicitly licensed that code to his employer, and that the license endured so long as the code was used by the employer. See, e.g., *Effects Assoc., Inc. v. Cohen*, 908 F.2d 555 (9th Cir. 1990) (holding that although special effects footage did not qualify as a work made for hire nor was ownership transferred by written agreement, the parties' course of conduct created an implied license to use the footage in the defendant's motion picture).

2. Specially Ordered or Commissioned Works

In addition to works created by employees within the scope of their employment, the Copyright Act defines a second category of works as potential works made for hire: works that are "specially ordered or commissioned." 17 U.S.C. § 101.

The Categories of Works

For a specially ordered or commissioned work to be a work made for hire, two requirements must be fulfilled. First, the work must fit within one of the specified types of works listed in the statute. Under the terms defining work made for hire in § 101, a specially ordered or commissioned work is eligible to be considered a work made for hire if it has been specially ordered or commissioned for use as: (1) a contribution to a collective work, (2) as a part of a motion picture or other audiovisual work, (3) as a translation, (4) as a supplementary work, (5) as a compilation, (6) as an instructional text, (7) as a test, (8) as answer material for a test, or (9) as an atlas.

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What distinguishes these categories from other types of specially ordered or commissioned works that are not eligible for work made for hire treatment? (Think of the sculpture in *CCNV v. Reid*, which the Supreme Court said was outside of the list of enumerated categories and thus ineligible for work made for hire treatment as a “specially ordered or commissioned work.”) Is the statutory list just an artifact of special-interest lobbying? Or does the list reflect some deeper commonality among works in the enumerated categories that makes these works especially suitable for work made for hire treatment? According to former Register of Copyrights Marybeth Peters, the categories were chosen in response to practical concerns about the consequences of permitting termination of transfers with respect to certain types of works:

[W]orks included in these categories tend to be works done by freelance authors at the instance, direction, and risk of a publisher or producer where it was argued that it would be unfair to allow such authors to terminate assignments of rights. Other exceptions (contributions to collective works, parts of motion pictures), were based on the fact that the resulting work involved numerous authors and that permitting terminations of grants of rights to such works would cause chaos.

Sound Recordings as Works Made for Hire: Hearings Before the Subcomm. on Courts and Intellectual Property of the H. Comm. on the Judiciary, 106th Cong. 257 (2000).

The Writing Requirement

Second, the parties must agree, in a written instrument signed by both of them, that “the work shall be considered a work made for hire.” 17 U.S.C. § 101.

Both requirements must be met in order for a specially ordered or commissioned work to be a work made for hire.

NOTES

1. There is a circuit split about the timing of the writing requirement. The Second Circuit has suggested that the “writing requirement of § 101(2) can be met by a writing executed after the work is created, if the writing confirms a prior agreement, either explicit or implicit, made before the creation of the work.” *Playboy Enter., Inc. v. Dumas*, 53 F.3d 549, 560 (2d Cir. 1995). That approach is contrary to the position taken by the Seventh Circuit, which has held that execution of the writing must occur before creation of the subject work, “in order to serve its purpose of identifying the (noncreator) owner unequivocally.” *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 413 (7th Cir. 1992). Which view makes more sense as a matter of copyright policy?

A comment in the Restatement of Copyright comes down on the side of the Seventh Circuit:

The Seventh Circuit’s holding that the writing must precede the creation of the work is more in accord with the author-protective role given to the writing requirement in the 1976 Act. The option of a later writing should be available only in exceptional circumstances when no unfairness to the creator of the work ensues; for example, when the later writing confirms a clear, express agreement made orally before the creation of the work or when the work is part of a series of works that the parties agreed would all be produced as works made for hire but is one work that the parties forgot to mention in their written agreement.

Parallelism with the first prong of the definition of “work made for hire” also suggests that the express written agreement must be made before the specially ordered or commissioned work is created. [A]n order for a work to constitute a work made for hire under the first prong of the statutory definition, an employee must be in the employer’s employment at the time when the work is created. Similarly, the conditions for a commissioned work to constitute a work made for

hire under the second prong should exist at the time when the work is created, and one of those conditions is a signed, written agreement among the parties.

This Restatement therefore takes the position that the written agreement in which the parties expressly agree that a specially ordered or commissioned work shall be considered a work made for hire ordinarily must be executed in advance of the work's creation, but that in exceptional circumstances a work may be specially ordered or commissioned as a work made for hire orally, provided that the express oral agreement is later confirmed in a signed writing.

Restatement of the Law, Copyright, Tentative Draft No. 2, § 24, Comment *g*, copyright © 2021 by The American Law Institute. Reproduced with permission, not as part of a Creative Commons license.

2. There has also been some disagreement about whether the written agreement must clearly identify the work as a “work made for hire.” The Second Circuit refused to recognize a work as a work made for hire where the writing consisted of a check issued by the commissioning party that bore a check legend that mentioned only “assignment” and did not explicitly identify the payment as being for creation of a work made for hire. *Playboy Enter.*, 53 F.3d at 560. In contrast, the Ninth Circuit does not require any “talismanic words.” *Warren v. Fox Family Worldwide, Inc.*, 328 F.3d 1136, 1141 (9th Cir. 2003). A comment in the Restatement of Copyright agrees that no talismanic words are required, but nonetheless notes that the agreement to treat the work as a work made for hire must be “express”:

The parties' agreement as to the work's status as made for hire must be express, even if that agreement does not use the words "work made for hire." This express agreement can be sufficiently clear, for example, if the parties provide in a written agreement that the commissioning party will be "the author" and owner of all rights of the commissioned materials. Such an agreement would make clear the parties' mutual intent to treat the work as a specially ordered or commissioned work made for hire, because only if the work is made for hire would the hiring party qualify as the work's author. By contrast, if the parties stated in their written agreement that the commissioning party would be the "owner" of the copyright in the commissioned work, that would likely not be a sufficiently express agreement to consider the work "made for hire," because it could merely reflect the parties' agreement that the person creating the commissioned work would transfer copyright ownership to the commissioning party. Written instruments that purport to effectuate "assignments," "transfers," "sales," or other transactions that focus on copyright ownership, rather than authorship, should be treated as insufficient to satisfy the statutory requirements that make a work a work "made for hire," although they may result in transfers of copyright ownership.

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3. There is a longstanding dispute regarding whether commissioned sound recordings qualify as works made for hire, at least when they were contributions to collective works—that is, they were contributions to record albums, which are collections of independent sound recordings. Several courts have expressed skepticism that sound recordings are properly treated as works made for hire under the “specially ordered or commissioned” prong of the definition, and several courts have stated specifically that sound recordings as such are not among any of the nine categories of specially ordered or commissioned works. *See, e.g., Stagers v. Real Authentic Sound*, 77 F. Supp. 2d 57 (D.D.C. 1999); *Ballas v. Tedesco*, 41 F. Supp. 2d 531 (D.N.J. 1999); *Lulirama Ltd. v. Axxess Broadcast Services, Inc.*, 128 F.3d 872 (5th Cir. 1997).

In 1999, record companies attempted to settle the controversy by pushing for amendments to the Copyright Act. That effort was initially successful, and sound recordings were added to the list of categories of works made eligible for works made for hire treatment as a specially ordered or commissioned work under 17 U.S.C. § 101(2). *See S. 1948*, 106th Cong. § 1011(d) (1999) (enacted). Congress characterized the addition as a “technical

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amendment.” However, less than one year later, and after an uproar led by musicians, sound recordings were removed from the provision. See Work Made for Hire and Copyright Corrections Act, H.R. 5107, 106th Cong., Pub. L. 106-369, 114 Stat. 1444 (2000). The 2000 deletion restored the “works made for hire” provision to the pre-1999 amendment status by repealing the 1999 amendment, and also by adding language to the Copyright Act instructing courts that they should interpret the meaning of the “work made for hire” provision as if the legislation adding and then removing sound recordings from the list had never been passed. See 146 Cong. Rec. H7244-02, H7245 (daily ed. Sept. 6, 2000) (statement of Rep. Berman).
