U.S. Copyright Law Casebook

{in development}

by Eric E. Johnson
ericejohnson.com

This part:

Story Arc 5

Ownership and Licensing

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Ownership and Licensing

A. Introduction

A.1. What now?

This swath of the casebook looks at ownership and licensing. People new to copyright may find this area of the law to be unexpectedly rich. Indeed, it is a topic area rife with surprises. Those surprises can be intriguing for the student. But in the real world of authors, rights buyers, and licensees, legal surprises can be really nasty – or, on the other side, fantastically delightful.

For lawyers, surprises are almost always trouble. Even a surprise that's wonderful for the client probably isn't great for the lawyer, because whatever it is, the lawyer would certainly rather have seen it coming. So that means ownership and licensing is an area warranting wary but intense curiosity.

Ownership and licensing is also an area that will be particularly interesting to those attracted to a transactional practice or other non-litigation practice. Strictly speaking, of course, there's really no such thing as transactional law and litigation law. All law can be relevant to a given lawsuit or transaction. Nevertheless, the material concerning copyright ownership and licensing is of particular interest and usefulness to lawyers doing transactional work, including mergers and acquisitions. Additionally, this subject matter is right in the wheelhouse for general counsels and for attorneys doing wills, trusts, and estates.

A.2. How does this fit in?

An archetypal case for copyright infringement – infringement of the reproduction right – can be broken down into four elements: (1) a valid

copyright, (2) owned by the plaintiff, (3) actually copied by the defendant, and (4) substantially appropriated. The material in this portion of the casebook is relevant to that second element – the plaintiff's ownership of the copyright.

Other material within this portion of the casebook does not, as a procedural matter, tend to come up in the prima facie case. Rather, its procedural home is with the defenses. Potential defenses are almost limitless, but big defenses in copyright are fair use, first sale, license, and copyright misuse. The material here, of course, fills out the affirmative defense of license. Those other defenses are explored as such elsewhere in this book, yet the material in this part of the book does have relevance to defenses of first sale, copyright misuse, and even fair use.

B. The Basics, the Myths, and the Statutory Law of Ownership and Licensing

B.1. The most important and fundamental aspects

B.1.a. The relationship of ownership and authorship

Ownership starts with authorship. The author of a copyrightable work is the owner of the copyright. And the author stays the owner until the author assigns it in whole or in part, or until the author dies. (Like money, you can't take copyright with you.)

The connection of authorship and ownership is clear in the U.S. Constitution's provision that gives Congress the power to create copyright law:

> "The Congress shall have Power … To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

United States Constitution, Article I, Section 8, clause 8

In 1976, Congress minded the particulars of its constitutional sanction to enact copyright law "by securing … to Authors … the exclusive Right to their … Writings" with the Copyright Act's § 201(a). That section provides that ownership of copyright "vests initially in the author or authors of the work."

And in the next sentence, the statute provides that there may be more than one author, in which case the co-authors are co-owners: "The authors of a joint work are coowners of copyright in the work."

Thus, it is crystal clear as a matter of law that authors are the initial owners of copyright. All the troubles with ownership – all the interpretive issues for courts, all the interesting bits for us to study – arise in answer to essentially two questions:

- Who counts as an author?
- What can and can't happen in terms of the author transferring ownership or granting licenses to others?

Even when getting into the details of these questions, we will see that the tie between authorship and ownership remains a persistent theme. (For instance, under some circumstances, some grants of ownership can be nullified. Who has such an extraordinary power? The answer is authors or their heirs.)

B.1.b. Co-owners, divisions of ownership, transfers of ownership

A copyright can be owned by multiple persons.

If a work has two authors, then those two authors are co-owners. Each has a separate 50% ownership stake in the whole copyright. Their ownership interest is separate in the sense that they can transfer their 50% as they like without the blessing of their co-author.

We can use vocabulary you may have learned about real property. In copyright, co-authors' form of ownership is "tenancy in common." That is to say that if one co-author dies, the 50% ownership interest goes to the author's heirs or devisees. (That is as opposed to "joint tenancy," where the death of one joint owner makes the surviving owner the 100% owner of the property.)

A copyright's ownership interest can also be divided up so that different people own different parts of the copyright. That is, one party could own 100% of one part of the copyright, and a different person could own 100% of another part of the copyright. Thus, a single author, starting out owning 100% of the copyright to their novel, could assign the movie rights to a Hollywood producer. As a formal matter, the author is assigning to the producer the exclusive right to make a derivative work in the form of a motion picture.

The division of one copyright into these distinct parts works according to the "bundle of sticks" metaphor you may be familiar with from studying real property law. A copyright is a bundle of sticks, and the owner can pull sticks out of the bundle and give different sticks to different people. And, of course, any given "stick" can have multiple owners, each of whom owns a percentage.

Obtaining ownership of the whole copyright – or a portion of it – is called a "transfer." It isn't complex, but it does have to be done right – including with a signed writing. And similar to concerns with title to real property, assignees of copyright may need to concern themselves with recordation in case there is a dispute about priority multiple parties claim to be assignees.

B.1.c. Works made for hire

If you want a copyright, but because of a lack of time or talent you can't do the creative work yourself, you can have the whole copyright assigned to you. Then it's yours. But there's also another way: the law of works made for hire.

Works-made-for-hire doctrine is of huge importance in copyright law. The doctrine is a departure from copyright's usual strong allegiance to creators as authors and therefore owners. The work-for-hire doctrine provides that, under certain circumstances, if you hire someone to create a copyrightable work for you, then you, as the hiring party, will be deemed the author of the work and therefore also the owner of the copyright.

But merely hiring someone is not nearly enough! Whether a work qualifies as a work made for hire depends on strict application of very particular rules set out by statute. And even though the statute is particular and strict, it leaves various questions unanswered that thus require caselaw for interpretation.

Rather than try to summarize work-made-for-hire doctrine here, we'll just say that it is somewhat complicated and it can diverge widely from people's expectations and be very unforgiving. Bottom line, works-made-for-hire doctrine presents a real pitfall for unwary lawyers.

B.1.d. Copyright recaptures

Moving up several notches from work-for-hire doctrine in the realm of complexity and surprise is the world of terminations of transfer under the 1976 Act and the effect today of transaction-eviscerating renewals made yesteryear, in the time of the 1909 Act.

Copyright law loves authors. So much so, in fact, that through amendments and wholesale reform, U.S. copyright law has remained committed to providing mechanisms for the recapture by authors, or their heirs, of copyright interests previously licensed or assigned to others. It's a nightmare for Hollywood studios, Nashville labels, and Manhattan publishing houses, but it's a boon for artists from Everytown U.S.A. who were late bloomers in the fame-and-acclaim department. More importantly, for lawyers, it is an area rife with opportunities and traps.

More later, but for now, appreciate this: The potential of copyright recapture is a big part of what makes works made for hire so important. If the work in question was a work made for hire, then the hiring party is deemed the author and owns the copyright at the very moment it springs into existence. That means that the hiree, despite being the creator-in-fact, cannot yank the copyright away. After all, in such a situation, the hiree isn't legally the "author," and there's no transfer to terminate.

B.1.e. License and licenses

The word "license" is subject to a lot of confusion in copyright. There will be much more to say about license and licenses later on. But here are some basics.

In the world of copyright, there are "exclusive licenses" and "nonexclusive licenses." It's tempting to say that these are "two types of licenses," but that's not very accurate. People writing about copyright law and people engaged in copyright-related business transactions use the term "nonexclusive license" to mean a "license," and they use the term "exclusive license" to mean ownership of a cleaved-off portion of the copyright – i.e., one of the sticks in the bundle. Thus, when the author of a novel grants a producer the exclusive right to make a derivative work in the form of a motion picture, it is commonly said that the producer now owns an "exclusive license" to make a film version of the novel.

As a grant of ownership of a piece of the copyright, an exclusive license must be conveyed by way of a signed writing to be valid. Also, the owner of the exclusive license – as a copyright owner – has standing to sue for infringement within the ambit of that ownership interest.

By contrast, a nonexclusive license of a copyright is a real "license" in the normal sense. It means that if the licensee is sued for copyright infringement, the licensee can repel the claim with a defense of license. A nonexclusive license is not an ownership interest in the copyright. Correspondingly, the conferring of a nonexclusive license need not be in writing to be valid. It need not even be expressed. A nonexclusive license may be implied. Also correspondingly, a nonexclusive license does not give the holder any standing to sue for copyright infringement.

When anyone says "license" without a modifier – it must be assumed they are talking about a "nonexclusive" license – i.e., a real *license*, as opposed to a subdivided ownership interest.

A good way to think about license is the following: License is to intellectual property as consent is to intentional tort law. And license is to copyright infringement as consent is to a cause of action for trespass or battery. If I tell you that you can punch me, then you have a consent defense to a claim of battery, were I to bring one. And if I tell you that you can make a copy of my copyrighted work, then you have a license defense to a claim of copyright infringement, were I to bring one.

Let's also nip this in the bud: A license is not a contract.

It does not make sense to speak of either a nonexclusive license as a contract nor an exclusive license as a contract. An exclusive license is ownership of part of a copyright. A nonexclusive license is a license – legally cognizable as an affirmative defense to infringement. Neither is a "contract," and thinking as such will only lead to confusion.

Now a license can be something exchanged in a contract. That's the same as with consent. We could have a contract where you agree to pay me $20 and I agree to consent to you parking your car on my lawn during the football game. And we could have a contract where I agree to pay you $100 and you agree to license me to stage a performance of your play this weekend. And as far as exclusive license goes, just as we could have a contract for the sale of a piece of land, we could also have a contract for the sale of the movie rights to your play. But none of that makes a license a contract.

B.2. Myths of Copyright Ownership

B.2.a. Myth: By Chattel Ownership

Ownership of a physical object in which a copyrighted work is embodied has nothing to do with the ownership of the copyright. This seems intuitive to people when it comes to mass-marketed books and photographic prints. But many people intuit that ownership of some unique, original work of art (such as an oil painting on canvas) also means that the owner has the copyright. Alternatively, they may intuit that there is at least some exclusive right to make copies. Either way, that is absolutely not true.

The same thing applies with regard to private letters or a handwritten diary. Ownership of the physical medium (sheets of paper, a bound notebook) is unconnected from ownership of the copyright. And conveying ownership of a tangible medium of expression does not convey ownership of any copyright. If you send a handwritten letter through the mail to someone, it seems quite clear that in doing so you have transferred ownership of the physical letter (the paper and the ink residue thereon) to the recipient. But there is no intellectual property interest that travels along with that physical property.

With some familiarity with copyright law and the way the whole concept works, it seems quite obvious, indeed logically necessary, that physical possession or ownership of a tangible embodiment of a copyrighted work can't include ownership of the copyright. Yet many people are stubbornly resistant to the idea that owning an original work of art does not also mean they have the copyright. Nothing in statute provides a basis for such a belief or even hints at such a notion. Yet, presumably because some people are so attracted to the idea of chattel ownership being connected to copyright ownership, that Congress nipped the whole matter in the bud in the '76 Copyright Act. Section 202 of Title 17 explains: "Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied." And to make sure the matter is put fully to rest, the section goes on: "Transfer of ownership of any material object, including the copy or phonorecord in which the work is first fixed, does not of itself convey any rights in the copyrighted work embodied in the object{.}"

By the way, you can also sell a copyright without transferring ownership of any chattel. See 17 U.S.C. § 202 ("nor, in the absence of an agreement, does transfer of ownership of a copyright or of any exclusive rights under a copyright convey property rights in any material object").

Now, all that being said about ownership, license is a different matter. The owner of a physical embodiment of a copyrighted work might be able to argue that they have an implied license that came with the sale of a tangible embodiment of the copyrighted work. That could depend on things like circumstances, indications of intent, custom, and so on.

Suppose an artist sells one of their original paintings on canvas to a museum, and then suppose the artist sues the museum for copyright infringement of the public display right when the museum puts the painting up on a gallery wall. On these facts, the museum will surely win on an implied

license defense. (One imagines fair use could also rescue the museum, though going there would inevitably muddy things.)

Note that anyone can construct arguments for implied license based on such things. Suppose the artist sold their painting to a private art collector, and years later the painting was resold to someone else, and years later it ended up sold again, this time to a museum. Even then – all privity laundered away – it would seem highly unlikely that an implied license theory could fail to be a complete defense for the museum's public display. Yet what if the museum then reproduced the painting as posters or postcards for sale in the gift shop? The museum would almost certainly lose. Without any additional facts, implied license would be too far-fetched in such a scenario.

B.2.b. Myth: By Real Property Ownership

If someone comes on your property without permission and takes photographs or shoots video, do you own the copyright, or do they?

They do. Of course.

If people could own the copyright to recordings and photography made on their property without their authorization, things would be a whole lot easier for businesses that are targeted by investigative journalists.

In another class, you may have read the case of *Food Lion v. Capital Cities /ABC,* 194 F. 3d 505 (4th Cir. 1999). It is sometimes assigned in Property, Torts, and Mass Media Law courses. The facts are that two television reporters working for ABC News used false resumes to get jobs at Food Lion supermarkets to investigate unwholesome goings-on in the meat department. The reporters surreptitiously videotaped some 45 hours of footage. Some of that footage was used in a 1992 broadcast of the news magazine program *PrimeTime Live*. Footage that was broadcast appeared to show Food Lion workers repackaging expired fish with a new date, combining beef past its expiration date with fresh beef, and putting barbeque sauce on expired chicken – to mask its odor – after which it was put on sale with the gourmet food selections.

Food Lion filed a lawsuit against ABC based on the way in which ABC acquired the footage, alleging trespass and a slew of torts. But there was no way Food Lion would have been able to maintain a claim for copyright infringement. Why not? Authors own the copyright to what they create. Not realty owners.

In case you're curious, Food Lion won – sort of. It didn't get the millions in compensatory damages it sought. Instead it got nominal damages for trespass to land totaling $2.00 – one dollar for each reporter who trespassed. And to answer another question you may have, Food Lion didn't pursue a defamation claim either. Defamatory statements have to be false to be actionable. You can draw your own conclusions about why Food Lion may have omitted to pursue defamation.

B.2.c. Myth: By Unjust Enrichment, Fraud, Deceit

Food Lion's unsuccessful lawsuit – discussed immediately above – also sought recovery for claims, beyond trespass, for fraud and for breach of the duty of loyalty. (A duty of loyalty is generally owed by employees to their employer. And, anyone would have to agree, the undercover ABC journalists who got jobs at Food Lion were certainly not being loyal to Food Lion.)

Under such circumstances – where the copyrighted footage was deceitfully obtained – even if Food Lion couldn't be the initial owner of the copyrighted footage, could they at least get a court to order the transfer of the copyright? That is, could a court order a transfer of ownership from the creators, who relied on deceit in the work's creation, to the party so deceived?

The answer is clearly no.

Such a thing might be available by means of state law. (State law has many mechanisms to move property ownership around – particularly in circumstances of fraud, deceit, or unjust enrichment.) But the United States of America, in its federal instantiation, has been jealously possessive of the copyright system it has created, and it does not want states messing with it. Not only do federal courts have exclusive jurisdiction over copyright infringement suits, but the '76 Act 's § 301, titled "Preemption with respect to other laws," powerfully excludes state law from entering into the copyright space.

Section 301(a) provides that "all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103˜ are governed exclusively by this title." The statute draws a line under the matter by stating that following the Act's effective date, "no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State." 17 U.S.C. § 301(a).

So, when all was said and done, Food Lion had a runt of a claim for trespass, but they had absolutely no claim for copyright infringement. And fairness doesn't enter into it – no matter how epically unfair Food Lion may have thought it had been treated.

While Food Lion had absolutely no claim for copyright infringement, they did have an immense sense of victimhood born of their pious suffering.

So Food Lion sued for copyright infringement anyway.

If the law is not on your side, but if you are very strongly convinced that fairness *is* on your side, then under our Anglo-American legal tradition there's a place to take that: equity. And, indeed, guided by the light of their self-righteousness, Food Lion brought a suit for declaratory judgment that they owned the copyright to the footage by way of the equitable theory of constructive trust, which is a doctrine generally available as a matter of state law.

Sued in Food Lion's heartland in the U.S. District Court for the Middle District of North Carolina, Capital Cities/ABC filed a 12(b)(6) motion to dismiss. After roundly rejecting another of Food Lion's claims, the court turned to the constructive trust theory for gaining copyright:

> "Plaintiff's alternative, constructive trust theory is similarly unavailing. As Plaintiff recognizes, the Copyright Act specifically preempts rights recognized under state law that are equivalent to the exclusive rights provided for by federal copyright law. 17 U.S.C. § 301. Here, Plaintiff seeks a declaration of copyright ownership based on state law. The Copyright Act sets out the elements of copyright ownership˜. Plaintiff's attempt to expand upon or circumvent this right by relying on state law is preempted.

Food Lion v. Capital Cities/ABC, 946 F. Supp. 420, 422 (M.D.N.C. 1996). The constructive trust theory was thus rejected by way of a 12(b)(6) dismissal. *Id.*

Wait, you might say. Let's change the facts because, admittedly, Food Lion wasn't a very sympathetic plaintiff (notwithstanding the halo Food Lion saw in the mirror). Let's say instead criminals break into your house and film a video of their vandalizing and destroying the inside of your home. The criminals then upload the video online. They make lots of money off of it. You want the copyright to their film. You *deserve* the copyright. Could you have a court order the transfer of the copyright to you?

The answer would still be no. Even if you came up with some strategy for overcoming § 301's preemption of state law, then as individual authors, the criminals would be protected by 17 U.S.C. § 201(e), which is titled "Involuntary Transfer." That section provides:

> "When an individual author's ownership of a copyright, or of any of the exclusive rights under a copyright, has not previously been transferred voluntarily by that individual author, no action by any governmental body or other official or organization purporting to seize, expropriate, transfer, or exercise rights of ownership with respect to the copyright, or any of the exclusive rights under a copyright, shall be given effect under this title, except as provided under title 11 {federal bankruptcy law}."

Whether you can get a court to order as restitution all the money the criminals have made from the video is a different matter entirely. Copyright law doesn't necessarily prohibit that. But the copyright itself will stay with the author.

B.2.d. Myth: By Paying for the Copyright, by Agreement, by Contract

If you and the love of your life hire a photographer to take photographs for your wedding, and you pay them hundreds of dollars in cash, and it's an enforceable oral contract, will you and your spouse own the copyright to the photographs? No, not on these facts. What if there was an enforceable written contract? Again, on these facts – without something more – you will not have the copyright.

What if you expressly agree with the photographer orally – witnessed by several other people – that in exchange for some specified amount of money (it doesn't matter how much), the photographer will (1) take photos of your wedding and (2) give you the photos in the form of digital files and (3) you will own the copyright to all the photos.

No, even on these facts, you will not end up owning the copyright. That's even though everyone agreed that you'd own the copyright and even though you paid for it.

There are certainly ways to structure this deal such that you will end up with the copyright. And that's covered below. But neither payment nor agreement nor binding contract will, by itself, do the job.

B.3. Copyright Act of 1976 on Ownership and Licensing

B.3.a. The role of statute

Compared to the subject of copyrightable subject matter or infringement, statutory text plays a more featured role when it comes to issues of copyright ownership and licensing. Caselaw is critically important in many respects. But when it comes to ownership, sometimes questions are answerable just from the relevant statutory text. (That's not to say the careful lawyer doesn't need to consult cases or treatises to make sure that the statutory text is all that's relevant on the matter!)

B.3.b. About the '76 Act

The current U.S. copyright statute is the Copyright Act of 1976. The '76 Act was a wholesale rewriting of the copyright statute by Congress, undertaken in 1976 with an effective date of January 1, 1978. (The '76 Act replaced the 1909 Act, but that act still has modern relevance for works dating to before 1978.)

The '76 Act has been amended many times since its original passage, but the current statute is still commonly referred to as the 1976 Act notwithstanding its later amendments. The '76 Act was encoded in Title 17 of the United States Code, and its section numbering begins at 17 U.S.C. § 101. The fact that the first section of the code under the '76 Act is § 101 helps to avoid confusion with the '09 Act, whose section numbering began with § 1.

That first section, § 101, is an important one to know because it contains definitions of terms that are used throughout the succeeding provisions. Sometimes, on a given point of law, the text in § 101 is the principal text concerned.

The '76 Act is organized into chapters, of which there are more than a dozen. The numbering of sections corresponds to chapters like the numbering of hotel rooms corresponds to floors. Chapter 1 (titled "Subject Matter and Scope of Copyright") consists of § 101 and subsequently numbered sections beginning with a 1 (§ 102, § 103, and so on). Chapter 7 ("Copyright Office") is § 701 et seq. If you're looking for § 1507, you'll find that in Chapter 15 ("Copyright Small Claims").

B.3.c. The '76 Act on ownership

For ownership, we will be most concerned with sections gathered together as Chapter 2, which is titled "Copyright Ownership and Transfer."

We will encounter the actual statutory text further below – under the heading of specific topics to which the statutory text is germane. But for a forest-for-the-trees perspective, know that there are five sections in Chapter 2. They are:

- § 201 Ownership of copyright
- § 202 Ownership of copyright as distinct from ownership of material object
- § 203 Termination of transfers and licenses granted by the author
- § 204 Execution of transfers of copyright ownership
- § 205 Recordation of transfers and other documents

In addition, definitions from § 101 will be important. As a heads-up, those will include definitions for the following terms:

- "copyright owner"
- "derivative work"
- "fixed"
- "joint work"
- "pseudonymous work"
- "transfer of copyright ownership"
- "work made for hire"

That last one, "work made for hire," is a biggie. The operative provision on the ownership of works made for hire is § 201(b). But that provision has only 53 words in it. The really important stuff about works made for hire is in the definition of "work made for hire" in § 101, which has about 350 words on the topic.

C. Ownership by Authorship

C.1. Lead-in

Ownership starts with authorship. The author of a copyrightable work is the owner of the copyright. And the author stays the owner until the author assigns it in whole or in part, or until the author dies. (Like money, you can't take copyright with you.)

The connection of authorship and ownership is clear in the U.S. Constitution's provision establishing the power of Congress to create copyright law:

> "The Congress shall have Power ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

United States Constitution, Article I, Section 8, clause 8

The 1976 Copyright Act, 17 U.S.C. § 201(a), provides that ownership of copyright "vests initially in the author or authors of the work." And in the next sentence, the statute provides that there may be more than one author, in which case the joint authors are co-owners of the copyright: "The authors of a **joint work** are coowners of copyright in the work."

Insofar as the statute says what it says, the law is clear. But troubles – i.e., interpretive questions – arise as to what it means to be an author.

The term "author" is not defined by the statute. According to *CCNV v. Reid* (U.S. 1989), the author 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."

For further elaboration on the meaning of authorship, we'll need caselaw. And caselaw does not answer questions in the abstract. For caselaw, there has to be a case, which means there has to be a claim, a plaintiff, and a defendant.

Questions of the meaning of authorship come up in two important contexts. Each context makes for a different sort of question.

In one context, you get a "whether" question: The plaintiff sues the defendant for copyright infringement, and the defendant counters that the plaintiff's claim fails because the alleged copyrighted work is not protected by

copyright at all for want of authorship. That is, the question is *whether anyone* could be the author. In other words: Is the work a "work of authorship" at all? A couple of examples of this would include a pattern of cracks appearing in desiccated mud on the plaintiff's land or a set of newly discovered facts uncovered by the plaintiff's clever archival research. No one is the author of such things as patterns emerging from nature or historical facts. (Cases engaged with such authorship questions are found elsewhere in this casebook.)

In the other context, you get a "who" question: The plaintiff and the defendant agree that the work is copyrightable, and they agree that ownership comes from authorship, but they maintain incompatible contentions concerning ownership. The question then concerns *who among rivals* actually counts as author of a given work. In other words: Who authored the work? Was it the one person, the other person, or both? These are the questions we are concerned with in this portion of the casebook.

The procedural posture giving rise to such questions can vary. One is where plaintiff sues a defendant for infringement, and the defendant counters that the defendant is a co-author, in which case the co-author was within their rights to reproduce the work, display it, distribute it, etc. Or the plaintiff might sue the defendant for infringement, and the defendant counters that the plaintiff isn't author at all (and therefore not an owner) because the defendant is the sole author. Or it might not be an infringement case at all. The plaintiff might allege co-authorship in suing the defendant for a share of the defendant's profits – an action called an "accounting." And other procedural postures can require courts to decide such questions as well.

C.2. 1976 Act's Section 201(a)

§ 201 · Ownership of copyright

(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.

{remainder of § 201 omitted}

Definitions from § 101

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.

C.3. Joint authorship and co-ownership

{The following text was created by starting with text from Greene v. Ablon, 794 F.3d 133 (1st Cir. 2015) and substantially reworking it and adding to it. Thus, this text should not be taken to represent the text of that case, but the editor/reworker is not the "author" of this entire passage in the common, non-copyright-law sense of that word.}

When are two contributors joint authors?

Under the Copyright Act, 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." 17 U.S.C. § 101.

The words "inseparable" and "interdependent" are key. Courts have held that "inseparable" contributions "have little or no independent meaning standing alone," as might frequently be the case with collaboration on a written text like a play or a novel. *Childress v. Taylor,* 945 F.2d 500, 505 (2d Cir.1991). On the other hand, "interdependent" contributions "have some meaning standing alone but achieve their primary significance because of their combined effect, as in the case of the words and music of a song." *Id.*

Intent is crucial, and so is the time when the intent is measured. For a work to be "joint," the authors must have intended at the time the writing is done that their contributions be merged into "an integrated unit." *Id.*

The authors' contributions don't need to be equal or roughly equivalent – either quantitatively or qualitatively. Rather, the requirement is only that each author's contribution be more than de minimis.

Co-authorship means co-ownership

Authors who create a joint work co-own the copyright in that work. This is required by 17 U.S.C. § 201(a), but it also follows as a conceptual and logical matter from the fact that copyright protection, in the general case, attaches to the work's actual creator.

Assuming some agreement to the contrary has not been made ahead of time, joint authors share "equal undivided interests in the whole work." *Thomson v. Larson,* 147 F.3d 195, 199 (2d Cir. 1998). Even if it is clear that one co-author has contributed more – or even much more – to the work than another co-author, the co-authors are nevertheless equal co-owners of the copyright.

The privileges and obligations of a co-owner

By having an equal, undivided interest in the whole work, each copyright co-owner "has the right to use or to license the work as he or she wishes, subject only to the obligation to account to the other joint author for any profits that are made." *Thomson v. Larson* at 199. This means that among joint authors who have not made some other legally binding arrangement, each has total discretion to grant nonexclusive licenses to whomever they choose, without the consent of another author. But, to the extent one co-owner derives profit from sales or licenses, that co-owner must provide to any other co-owner their share – e.g., 50% if there are two authors total.

C.4. Case: Thomson v. Larson (2d Cir. 1998)

Pre-reading notes

Rent is a musical that debuted off-Broadway in 1994 and on Broadway in 1996. Its story centers on young, struggling artists in New York. The musical borrowed greatly from the 1896 opera *La Bohème* by Giacomo Puccini, which set in the bohemian culture of 1840s Paris amid a tuberculosis epidemic. *Rent* is set in lower Manhattan amid the HIV/AIDS epidemic in the late 1980s / early 1990s. The rock musical was a huge critical and popular success, garnering Tony awards, the Pulitzer Prize for Drama, and sold-out shows. *Rent* author/composer Jonathon Larson died just before the show's Broadway opening.

Lynn Thomson, who assisted Larson and participated in the creation of *Rent*, filed a lawsuit seeking recognition as a joint author. The Second Circuit ruled against Thomson, deciding she could not be an author because of a lack of mutual intent as to joint authorship.

Opinion

Edited opinion by JAMES GRIMMELMANN. *Credit and licensing notes:* This edited version of the following judicial opinion, not including the text preceding the judge's words, is by James Grimmelmann, obtained from Chapter 4.B.2 of JAMES GRIMMELMANN, PATTERNS OF INFORMATION LAW: INTELLECTUAL PROPERTY DONE RIGHT (version 1.1, August 2017). I understand the correct copyright notice to be: © 2017 James Grimmelmann. The book is licensed under the Creative Commons Attribution International License 4.0 (CC-BY 4.0) license, available at https://creativecommons.org/licenses/by/4.0/. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at https://james.grimmelmann.net/ipbook/. For the material I took from Professor Grimmelmann's book, I made formatting changes, including to typography, pagination, paragraph styling, etc. Superscript right- and left-pointing descending arrows ⤷⤶ enclose footnote material that has been incorporated into above-the-line text. All italicization has been omitted from the text. – EEJ

Thomson v. Larson

U.S. Court of Appeals for the Second Circuit
147 F.3d 195 (2d Cir. 1998)

Lynn M. Thomson, Plaintiff-appellant, v. Allan S. Larson, Nanette Larson, and Julie Larson Mccollum,defendants-appellees. Before FEINBERG, CALABRESI, and BRIGHT, Circuit Judges.

CALABRESI, Circuit Judge:

Plaintiff-appellant Lynn Thomson claims that, along with principal playwright Jonathan Larson, she co-authored a "new version" of the critically acclaimed Broadway musical Rent.

Background

Rent, the Pulizer Prize and Tony Award-winning Broadway modern musical based on Puccini's opera La Bohème, began in 1989 as the joint project of Billy Aronson and composer Jonathan Larson. Aronson and Larson collaborated on the work until their amicable separation in 1991. At that time, Larson obtained Aronson's permission to develop the play on his own.

In the summer of 1992, Larson's Rent script was favorably received by James Nicola, Artistic Director of the New York Theatre Workshop ("NYTW"), a non-profit theater company in the East Village. Larson

continued to develop and revise the "workshop version" of his Rent script. In the spring of 1993, Nicola urged Larson to allow the NYTW to hire a playwright or a bookwriter to help revamp the storyline and narrative structure of the play.

In May 1995, in preparation for Rent's off-Broadway opening scheduled for early 1996, Larson agreed to the NYTW's hiring of Lynn Thomson, a professor of advanced playwrighting at New York University, as a dramaturg to assist him in clarifying the storyline of the musical. ⁻Dramaturgs provide a range of services to playwrights and directors in connection with the production and development of theater pieces. According to Thomson's testimony, the role of the dramaturg "can include any number of the elements that go into the crafting of a play," such as "actual plot elements, dramatic structure, character details, themes, and even specific language."⁻

Thomson signed a contract with the NYTW, in which she agreed to provide her services with the workshop production from May 1, 1995, through the press opening, scheduled for early February of 1996. The agreement stated that Thomson's "responsibilities shall include, but not be limited to: Providing dramaturgical assistance and research to the playwright and director." In exchange, the NYTW agreed to pay "a fee" of $2000, "[i]n full consideration of the services to be rendered" and to provide for billing credit for Thomson as "Dramaturg." The Thomson/NYTW agreement was silent as to any copyright interests or any issue of ownership with respect to the final work.

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

A "sing-through" of the "October Version" of Rent took place in early November 1995. And on November 3, 1995, Larson signed a contract with the NYTW for ongoing revisions to Rent. This agreement identified Larson as the "Author" of Rent and made no reference to Thomson. The contract incorporated by reference an earlier draft author's agreement that set forth the terms that would apply if the NYTW opted to produce Rent. The earlier draft author's agreement gave Larson approval rights over all changes in text, provided that any changes in text would become his property, and assured him billing as "sole author."

The final dress rehearsal was held on January 24, 1996. Just hours after it ended, Larson died suddenly of an aortic aneurysm. Over the next few weeks, Nicola, Greif, Thomson, and musical director Tim Weil worked together to fine-tune the script. The play opened off-Broadway on February 13, 1996, to rave reviews. On February 23, Rent's move to Broadway was announced. Since its opening on Broadway on April 29, 1996, the show has been "an astounding critical, artistic, and commercial success."

Before the Broadway opening, Thomson, in view of her contributions to Rent, sought compensation and title page dramaturgical credit from the Broadway producers. And on April 2, 1996, she signed a contract in which the producers agreed to pay her $10,000 plus a nominal $50/ week for her dramaturgical services. Around the same time, upon the producers' advice, Thomson approached Allan S. Larson, Nanette Larson, and Julie Larson McCollum ("Larson Heirs"), the surviving members of Jonathan Larson's family, to request a percentage of the royalties derived from the play. In a letter to the Larson family, dated April 8, 1996, Thomson stated that she believed Larson, had he lived, would have offered her a "small percentage of his royalties to acknowledge the contribution I made." In reply, the Larson Heirs offered Thomson a gift of 1% of the author's royalties. Negotiations between Thomson and the Larson Heirs, however, broke down.

After the parties failed to reach a settlement, Thomson brought suit against the Larson Heirs, claiming that she was a co-author of Rent and that she had never assigned, licensed, or otherwise transferred her rights. Thomson sought declaratory relief and a retroactive and on-going accounting under the Copyright Act. Specifically, she asked that the court

declare her a "co-author" of Rent and grant her 16% of the author's share of the royalties. ↵Thomson claims that she seeks 16% of the proceeds "because of her respect for Larson's role as the principal creator of the work." Thomson derives the 16% figure in the following way: she alleges that 48% of the Rent script is new in relation to the 1994 Workshop version (prior to her involvement); as co-author, she is, therefore, entitled to 50% of this part (or 24% of the total revenues); but since there are three components to Rent (book, lyrics, and music) and she did not contribute to one (music), she is entitled to 2/3, or 16% of the total revenues. Thomson also sought the right to quote freely from various versions of Rent in a book that she planned to write.↵

Thomson's Co-Authorship Claim

The Copyright Act defines a "joint work" as "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." 17 U.S.C. § 101 (1994). The touchstone of the statutory definition is the intention at the time the writing is done that the parts be absorbed or combined into an integrated unit.

Joint authorship entitles the co-authors to equal undivided interests in the whole work – in other words, each joint author has the right to use or to license the work as he or she wishes, subject only to the obligation to account to the other joint owner for any profits that are made.

In *Childress v. Taylor*, our court interpreted this section of the Act and set forth "standards for determining when a contributor to a copyrighted work is entitled to be regarded as a joint author" where the parties have failed to sign any written agreement dealing with coauthorship. While the Copyright Act states only that co-authors must intend that their contributions "be merged into ... a unitary whole," Judge Newman explained why a more stringent inquiry than the statutory language would seem to suggest is required:

> An inquiry so limited would extend joint author status to many persons who are not likely to have been within the contemplation of Congress. For example, a writer frequently works with an editor who makes numerous useful revisions to

> the first draft, some of which will consist of additions of copyrightable expression. Both intend their contributions to be merged into inseparable parts of a unitary whole, yet very few editors and even fewer writers would expect the editor to be accorded the status of joint author, enjoying an undivided half interest in the copyright in the published work.

The potential danger of allowing anyone who makes even a minimal contribution to the writing of a work to be deemed a statutory co-author – as long as the two parties intended the contributions to merge — motivated the court to set forth a two-pronged test. A co-authorship claimant bears the burden of establishing that each of the putative co-authors (1) made independently copyrightable contributions to the work; and (2) fully intended to be co-authors.

1. Independently Copyrightable Contributions

Childress held that collaboration alone is not sufficient to establish joint authorship. Rather, the contribution of each joint author must be independently copyrightable.

Without making specific findings as to any of Thomson's claims regarding lyrics or other contributions, the district court concluded that Thomson "made at least some non-de minimis copyrightable contribution," and that Thomson's contributions to the Rent libretto were "certainly not zero." Once having said that, the court decided the case on the second *Childress* prong – mutual intent of co-authorship. It hence did not reach the issue of the individual copyrightability of Thomson's varied alleged contributions (plot developments, thematic elements, character details, and structural components).

2. Intent of the Parties

Childress mandates that the parties "entertain in their minds the concept of joint authorship." This requirement of mutual intent recognizes that, since coauthors are afforded equal rights in the coauthored work, the "equal sharing of rights should be reserved for relationships in which all participants fully intend to be joint authors."

Childress and its progeny, however, do not explicitly define the nature of the necessary intent to be co-authors. The court stated that "[i]n many instances, a useful test will be whether, in the absence of contractual arrangements concerning listed authorship, each participant intended that all would be identified as co-authors." But it is also clear that the intention standard is not strictly subjective.

i. Decisionmaking Authority

An important indicator of authorship is a contributor's decisionmaking authority over what changes are made and what is included in a work. See, e.g., Erickson v. Trinity Theatre, Inc. (an actor's suggestion of text does not support a claim of co-authorship where the sole author determined whether and where such contributions were included in the work); Maruel v. Smith (claimant had a contractual right to control the contents of the opera).

The district court determined that Larson "retained and intended to retain at all times sole decision-making authority as to what went into Rent." In support of its conclusion, the court relied upon Thomson's statement that she was "flattered that [Larson] was asking [her] to contribute actual language to the text" and found that this statement demonstrated that even Thomson understood "that the question whether any contribution she might make would go into the script was within Mr. Larson's sole and complete discretion." Moreover, as the court recognized, the November agreement between Larson and the NYTW expressly stated that Larson had final approval over all changes to Rent and that all such changes would become Larson's property.

ii. Billing

In discerning how parties viewed themselves in relation to a work, Childress also deemed the way in which the parties bill or credit themselves to be significant. As the district court noted, "billing or credit is ... a window on the mind of the party who is responsible for giving the billing or the credit." And a writer's attribution of the work to herself alone is "persuasive proof ... that she intended this particular piece to represent her own individual authorship" and is "prima facie proof that [the] work was not intended to be joint." Weissmann v. Freeman Thomson claims that Larson's

decision to credit her as "dramaturg" on the final page of Rent scripts reflected some co-authorship intent. Thomson concedes that she never sought equal billing with Larson, but argues that she did not need to do so in order to be deemed a statutory co-author.

The district court found, instead, that the billing was unequivocal: Every script brought to [the court's] attention says "Rent, by Jonathan Larson." In addition, Larson "described himself in the biography he submitted for the playbill in January 1996, nine days before he died, as the author/composer, and listed Ms. Thomson on the same document as dramaturg." And while, as Ms. Thomson argues, it may indeed have been highly unusual for an author/composer to credit his dramaturg with a byline, we fail to see how Larson's decision to style her as "dramaturg" on the final page in Rent scripts reflects a co-authorship intent on the part of Larson. The district court properly concluded that "the manner in which [Larson] listed credits on the scripts strongly supports the view that he regarded himself as the sole author."

iii. Written Agreements with Third Parties

Just as the parties' written agreements with each other can constitute evidence of whether the parties considered themselves to be co-authors, so the parties' agreements with outsiders also can provide insight into co-authorship intent, albeit to a somewhat more attenuated degree.

The district court found that Larson "listed himself or treated himself as the author in the November 1995 revisions contract that he entered into with the NYTW, which in turn incorporated the earlier draft author's agreement that had not been signed." That agreement identifies Larson as Rent's "Author" and does not mention Thomson. It also incorporates the terms of a September 1995 draft agreement (termed "Author's Agreement") that states that Larson "shall receive billing as sole author." The district court commented, moreover, that

> "[t]he fact that [Larson] felt free to enter into the November 1995 contract on his own, without the consent of and without any reference to Ms. Thomson quite apart from whatever the terms of the agreements are, indicates that his intention was to be the sole author."

Conclusion

Based on all of the evidence, the district court concluded that "Mr. Larson never regarded himself as a joint author with Ms. Thomson." We believe that the district court correctly applied the Childress standards to the evidence before it and hold that its finding that Larson never intended co-authorship was not clearly erroneous.

C.5. Case: Lindsay v. R.M.S. Titanic (S.D.N.Y. 1999)

Pre-reading notes

Can someone who doesn't actually hold or operate the camera be the author of motion picture footage taken with that camera? In the film and television world, there's usually plenty of legal paperwork that's been done that prevents the occurrence of any ownership issue that would occasion a court to engage with the question. But not always. Every once in a while something big and unforeseen lies under the calm surface.

Alexander Lindsay, a documentary filmmaker, instituted this lawsuit alleging that he was the author of filmed footage where he, himself, was not holding the camera – though the actual camera work was done according to Lindsay's directions. The footage in question was filmed at the bottom of the North Atlantic Ocean at the most famous shipwreck of all time. And to vindicate his claim, Lindsay sued the Discovery Channel and, for procedural and remedial reasons we wisely will leave undisturbed, the *Titanic* – as in the actual ship that sank in 1912.

Here, at the trial court, the motion being considered is a motion to dismiss. The court holds that Lindsay's allegations are sufficient to state a claim.

Opinion

{Citations to the plaintiff's complaint omitted without notation. Curly brackets, which may be superscript, $^{\{\}}$ denote material added by the casebook editor; superscript angle brackets $^{<>}$ denote material from a footnote worked into the body text; footnotes removed without notation; the superscript hash sign $^{\#}$ denotes one or more deleted citations. Portions of cites (parallel citations, internal-quotation source citations, denial of cert citation) removed without notation. The name "Lindsay" was substituted for references to "plaintiff" or "the plaintiff" in various places without notation. Typography (use of underlining in addition to

italics and typesetting of dashes) differs. Otherwise, deletions are marked with a superscript tilde ˜.}

Lindsay v. Wrecked & Abandoned Vessel R.M.S. Titanic

U.S. District Court for the Southern District of New York
52 U.S.P.Q.2D 1609 (1999)

Alexander LINDSAY, Plaintiff, versus THE WRECKED AND ABANDONED VESSEL R.M.S. TITANIC, HER ENGINES, TACKLE, EQUIPMENT, FURNISHINGS, Located Within One Nautical Mile of a Point Located at 41 [degrees], 43'32" North Latitude and 49 [degrees], 56'49" West, and Artifacts, and Video Located at 17 Battery Place, New York, NY, in rem, and R.M.S. Titanic, Inc.; Titanic Ventures Limited Partnership, Oceanic Research and Exploration Limited; Suarez Corporation Industries, Inc.; and Discovery Communications, Inc., d.b.a. THE DISCOVERY CHANNEL, in personam, Defendants. Decided October 12, 1999. Filed October 13, 1999. 97 Civ. 9248 (HB). Reported: 52 U.S.P.Q.2D 1609; 1999 U.S. Dist. Lexis 15837; Copy. L. Rep. P27,967.

HAROLD BAER, JR., District Judge:

˜ I. BACKGROUND

The plaintiff Lindsay, a citizen of the United Kingdom and resident of the State of New York, is an independent documentary film maker engaged in the business of creating, producing, directing, and filming documentaries. {This and other representations of fact are based on the plaintiff's amended complaint.} Defendant R.M.S. Titanic, Inc. ("RMST") is a publicly traded U.S. corporation˜. Defendant George Tulloch ("Tulloch") is a shareholder, president and member of the board of directors of RMST.˜ Defendant Tulloch {and others with overlapping ownership are collectively referenced as "RMST".} Defendant Discovery Communications, Inc. ("DCI") is a Maryland corporation doing business as "The Discovery Channel", and is engaged in the business of making, financing and distributing documentary films.

In 1993, RMST was awarded exclusive status as salvor-in-possession of the Titanic wreck site and is therefore authorized to carry on salvage operations at the vessel's wreck site. As a condition of obtaining these rights, RMST allegedly agreed to maintain all the artifacts it recovered during the salvage operations for historical verification, scientific education, and public awareness.

In 1994, plaintiff Lindsay, under contract with a British television company, filmed and directed the British documentary film, "Explorers of the Titanic," a chronicle of RMST's third salvage expedition of the Titanic. To film this documentary, Lindsay sailed with RMST and the salvage expedition crew to the wreck site and remained at sea for approximately one month. Lindsay alleges that during and after filming this documentary in 1994, he conceived a new film project for the Titanic wreck using high illumination lighting equipment.

Lindsay later discussed his idea with defendant George Tulloch and, according to Lindsay, the two agreed to work together on the venture. In March 1995, Lindsay traveled to New York and developed a comprehensive business plan for the new film project entitled, "Titanic: A Memorial Tribute." Tulloch allegedly informed Lindsay that he would agree to the plan – which purported to include provisions for compensating Lindsay for his work on the project – but that Tulloch would have to obtain approval from the RMST Board of Directors. Lindsay agreed to join RMST to raise money not only for the film project, but for other aspects of the 1996 salvage operation as well.

Lindsay moved into an office at RMST in and around April 1995. Around this time, Tulloch repeatedly told Lindsay that he would obtain approval from RMST's Board of Directors for a contract for the plaintiff based upon the terms of Lindsay's film plan. The contract was to include terms of Lindsay's compensation, including sharing in the profits derived from any film, video and still photographs obtained from the 1996 salvage operation. This contract was never executed.

As part of his pre-production efforts, Lindsay 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 Planitff's [sic] creative inspiration and force behind his concept for shooting the Subject Work." Lindsay 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 Nautile, 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."

Lindsay 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.

Lindsay originally brought this action under the Court's admiralty jurisdiction to enforce his salvage claims against defendants RMS Titanic, Inc., Titanic Ventures Limited Partners, Oceanic Research and Exploration Limited (collectively as "RMST"), and Suarez Corporation.˜

RMST˜ then answered the complaint and included counterclaims for copyright infringement arising from the Lindsay's use of certain video footage taken from the wreck during the 1996 expedition. {Subsequently,} I granted Lindsay's motion to amend his complaint to add copyright infringement claims against RMST˜ and to join Discovery Communications, Inc. ("DCI") d/b/a The Discovery Channel, for copyright infringement of what appears to be the same footage at issue in the defendants' counterclaims.

The plaintiff's amended complaint now includes 13 causes of action, including those based on copyright infringement, salvage claims, and state law causes of action for fraud, breach of contract, and conversion. The defendants now move pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure to dismiss Lindsay's copyright claims, and the plaintiff cross-moves for summary judgment on his copyright and salvage claims.

III. DISCUSSION

A. Standards for Motion to Dismiss

˜"'The task of the court in ruling on a Rule 12(b)(6) motion is 'merely to assess the legal feasibility of the complaint, not to assay the weight of the evidence which might be offered in support thereof.'"# In deciding a 12(b)(6)

motion, the Court must accept as true all material facts alleged in the complaint and draw all reasonable inferences in the nonmovant's favor.˜

B. Copyright Claims

1. Pleading Requirements

To withstand a motion to dismiss, a complaint based on copyright infringement must allege: (1) which specific original works are the subject of the copyright claim; (2) that the plaintiff owns the copyrights in those works; (3) that the copyrights have been registered in accordance with the statute; and (4) "by what acts during what time" the defendant infringed the copyright. *Kelly v. L.L. Cool J.*, 145 F.R.D. 32, 35 (1992), *aff'd*, 23 F.3d 398 (2d Cir.).

Although the complaint is not a model of clarity, it meets for the most part, these standards. With regard to the first element, the complaint refers to Lindsay**'s** copyright interest in the "Subject Work," and – as the defendants point out – makes several different references to what exactly this work constitutes.[4]

> [4] Lindsay defines the "Subject Work" as: "a new film project for the Titanic wreck using high illumination lighting equipment" ; "the documentary film *Titanic: In a New Light*" ; and "the illuminated underwater video footage."

However, piecing together these various allegations, and drawing all reasonable inferences in the plaintiff's favor, it becomes clear for purposes of this motion that the "Subject Work" consists of the illuminated underwater footage that was filmed utilizing the large light towers that Lindsay helped design and construct. Regarding the second and third elements, the plaintiff alleges that he owns these works, , and that they were accepted and registered with the U.S. Register of Copyrights.

As to the fourth element – how and when the defendants infringed the copyright – the plaintiff has satisfied his burden˜. With respect to RMST, the complaint alleges that RMST "unlawfully entered into the exclusive license agreement with DCI," , "enered [sic] into contracts conveying video clips and still images . . . to various Titanic artifacts exhibitions throughout the world," and "RMST displays images from the Subject Work on its

INTERNET web site." The complaint alleges that DCI incorporated portions of the illuminated footage into three separate documentaries that aired on certain dates in 1997. ˜

2. Authorship

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.

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." *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989) (citing 17 U.S.C. § 102). 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.

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, 346-347 (1991) (citing *Burrow-Giles*, 111 U.S. at 59-60). Some elements of originality in a photograph includes "posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any variant involved." *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992). 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 lightowers 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."

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."

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.

Indeed, the instant case is analogous to *Andrien v. Southern Ocean County Chamber of Commerce*, 927 F.2d 132 (3d Cir. 1991). There, the Third Circuit recognized that "a party can be considered an author when his or her expression of an idea is transposed by mechanical or rote transcription into tangible form under the authority of the party." *Id.* at 135. The plaintiff in *Andrien* had received a copyright for a map of Long Beach Island, New Jersey which was created from a compilation of pre-existing maps and the plaintiff's personal survey of the island. To transform his concepts and the information he had gathered into the final map, the plaintiff hired a printing company to print the map in final form. The plaintiff testified that the maps were made by the printer "with me at her elbow practically" and that he spent time each day at the print shop during the weeks the map was made, directing the map's preparation in specific detail. In reversing the lower court's granting of summary judgment against the plaintiff, the court noted that the

printers had not "intellectually modified or technically enhanced the concept articulated by Andrien," nor did they "change the substance of Andrien's original expression." *Id.* at 135. *See also Lakedreams v. Taylor*, 932 F.2d 1103, 1108 (5th Cir. 1991) (noting that authors may be entitled to copyright protection even if they do not "perform with their own hands the mechanical tasks of putting the material into the form distributed to the public"). It is too early to tell whether the allegations of the plaintiff here satisfy the copyright laws, but crediting his story as I must, dismissal is unwarranted at this stage of the litigation.

The defendants' argue that *Geshwind v. Garrick*, 734 F. Supp. 644 (S.D.N.Y. 1990), *vacated in part*, 738 F. Supp. 792 (S.D.N.Y.1990), *aff'd*, 927 F.2d 594 (2d Cir. 1991), mandates dismissal. That case, however, is inapposite. The plaintiff there, a producer of computer graphics animation and special effects, had contracted to produce a 15-second animation piece. The plaintiff hired Digital, a computer graphics company to, in essence, produce the animated piece. The court in *Geshwind* found that Digital, by its employee, was the "author" within the meaning of the Copyright Act. In ruling that the plaintiff was not an "author," Judge Patterson found that the plaintiff there had made only minimal contributions to the final product and had only some, if any, of his "suggestions" incorporated into the final product. *Id.* at 650. This is in stark contrast to the case at bar where Lindsay alleges that his *contributions* – not suggestions – were anything but minimal, and he describes himself as the driving force behind the final film product at issue here.

3. Joint-Authorship

In the alternative, the defendants argue that Lindsay is, at best, a joint author of the underwater footage with RMST. This contention is based on the notion that Christian Petron, the main photographer of the film, was at least a joint-author of the footage with the plaintiff. Since Petron's participation was accomplished under the auspices of a work for hire agreement with RMST, the defendants' argument continues, any rights to authorship Petron may have received via his filming were conferred upon RMST. As a joint author with the plaintiff then, RMST cannot be liable for copyright infringement since each co-author acquires an undivided interest

in the entire work and has the right to use the work as he or she pleases. *Thomson v. Larson*, 147 F.3d 195, 199 (2d Cir. 1998); *Weissmann v. Freeman*, 868 F.2d 1313, 1318 (2d Cir.) ("An action for infringement between joint owners will not lie because an individual cannot infringe his own copyright."). Similarly, any copyright claim against DCI would fail since RMST, as a joint author, has the right to license the joint work to third parties. *Thomson*, 147 F.3d at 199.

A "joint work" under the Copyright Act is one "prepared by two or more authors with the intention that their contributions be merged into inseparable or independent parts of a unitary whole." 17 U.S.C. § 101. To prove co-authorship status, it must be shown by the individual claiming co-authorship status that each of the putative co-authors (1) fully intended to be co-authors, and (2) made independently copyrightable contributions to the work. *Thomson*, 147 F.3d at 200

Drawing all inferences in favor of Lindsay, I conclude that no such status existed in the case at bar. With regard to the intent prong of the analysis, "an important indicator of authorship is a contributor's decision making authority over what changes are made and what is included in a work." 147 F.3d at 202-3 (citing *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1071-72 (7th Cir. 1994) (actor's suggestions of text did not support a claim of co-authorship where the sole author determined whether and where such suggestions were included in the work)). In other words, where one contributor retains a so-called "veto" authority over what is included in a work, such control is a strong indicator that he or she does not intend to be co-authors with the other contributor. According to the pleadings, the plaintiff exercised virtually total control over the content of the film as "the director, producer and cinematographer" of the production. Additionally, he briefed the photographers with regards to, *inter alia*, the specific camera angles they were to employ, and Lindsay screened the film each day to make sure the proper footage was obtained. Based on these allegations, and implicit in the notion that the film crew was simply "following directions," Lindsay retained what appeared to be exclusive authority over what was included in the footage. <Along these lines, Lindsay's alleged control over the filming rendered the film crew's role to one of no more than "rote or mechanical

transcription that [did] not require intellectual modification," *Andrien*, 927 F.2d at 135, a contribution that would not be independently copyrightable. *Id.; Thomson*, 147 F.3d at 200. RMST's claims of joint-authorship would thus fail on this prong as well.>

Assuming as I must at this stage of the litigation that this is true {(that Lindsay retained what appeared to be exclusive authority over what was included in the footage)}, it can hardly be said that the plaintiff intended Petron – or any other contributor – to be a co-author. Accordingly, the claims by RMST that it – by virtue of Petron's role as a photographer under a work-for-hire agreement – was a joint-author within the meaning of the Copyright Act must fail.~

The plaintiff's~ copyright-based claims~ have survived this motion.~

SO ORDERED.