

The Importance of a Written Agreement When Collaborators Create a Copyrighted Work in the Performing Arts

BY J. WILLIAM DOCKREY

Under the U.S. Copyright Act of 1976, authors of a joint work own an undivided interest in the work from the moment of creation and fixation of the work in a tangible medium. If the work becomes popular, those involved in its creation are naturally motivated to claim an authorship interest. In the absence of a written agreement regarding ownership of the work, disputes often arise as to whether or not a person claiming to be an author, and thus an owner of the work, is in fact an “author” within the context of copyright law. The following discussion of court cases dealing with musical compositions, stage plays, and a movie illustrate the unpredictable nature of litigation involving claims of authorship and the challenges of litigating such cases.

The key to gaining an ownership interest is to be considered an “author” under the Copyright Act. In reviewing claims of authorship, courts typically consider two factors in determining whether collaborators are authors of a work. The first factor is whether all the collaborators shared the intent to create a joint work at the time of creating the work. The second factor is the nature of the subject matter contributed to the joint work. The contributed content must be independently protectable by copyright. In other words, the contribution to the work by the putative author must be something more than mere ideas, refinements, or suggestions. Determining the intent of the collaborators and the nature of the contribution often involves the painstaking process of sifting through imprecise records and conflicting testimony.

The scope of this ownership interest is irrespective of the level of contribution that each author makes to the work. Furthermore, each author can independently assert ownership rights to the work. For example, each author can license or assign the work to a third party independent of the remaining author or authors. The unfettered right to commercially exploit the work is only limited to a duty to account to the other author or authors for any profits gained by the use of the work.

In addition to sharing in monetary gain from the exploitation of the work, those involved can be motivated to claim authorship if they find themselves defendants in a copyright infringement suit. Authorship is a defense to copyright infringement because one cannot simultaneously infringe a work and be an author of the work. In an all-too-common scenario, the collaborators never had a written agreement regarding ownership of the work or, if an agreement existed, it has become lost in the intervening years since creation of the work.

CHALLENGES IN *JANKY*

In *Janky v. Lake County Convention and Visitors Bureau* and *Janky v. Farag*, the Seventh Circuit Court of Appeals found that a contribution of 10 percent of the lyrics to a song was sufficient to meet the requirements of authorship under the copyright laws.¹ Generally speaking, this amount of contribution does not seem to be sufficient to award authorship status upon the contributor. In this instance, however, the court noted additional circumstances that compelled its decision.

Copyright ownership relating to musical works and stage plays can be more prone to challenges than written works and photography, simply because a number of people usually are involved in the creation of these types of works. For example, the *Janky* cases arose as a result of a musical group seeking to present one of its songs to the Lake County Convention & Visitors Bureau (“LCCVB”) for use in promoting tourism in Indiana. After learning that the LCCVB was looking for a song that was representative of Lake County, Indiana, Stormy Weather band member Henry Farag suggested that the band create a song for submission. In response, Cheryl Janky wrote the lyrics and music to a song entitled “Wonders of Indiana” and filed a copyright registration for her composition in May 1999. Finding that Janky’s song needed modification to better address the requirements of the LCCVB, Farag offered his idea for changes to the lyrics. Janky incorporated Farag’s lyrical changes and filed a second copyright registration. In the second copyright registration, Janky credited Farag as contributing 10 percent of the lyrics. After a dispute arose over licensing rights to the song, Janky filed a third copyright registration for the song and indicated that it was a sound recording derivative of the first registration. In the third registration, Janky listed herself as the sole author.

The district court for the Northern District of Indiana held that Farag's contribution did not rise to the level of a contribution that could, on its own, be subject to copyright protection.² In other words, Farag's contribution was not independently copyrightable. The court did not reach the intent element of the authorship analysis, described above, in view of its finding that the defendant LCCVB failed to create a genuine issue of material fact as to intent. The Seventh Circuit reversed. On appeal, the Seventh Circuit court posed the question: When does a song qualify as a "joint work"? With respect to the intent element, the court stated that "the intent prong does not have to do with the collaborators' intent to recognize each other as coauthors for purposes of copyright law; the focus is on the parties' intent to work together in the creation of a single product, not on the legal consequences of that collaboration."³ This appears to refute the notion that the collaborators share a mutual intent to be coauthors of the song. Under this view of intent, for example, anytime two musicians make a recording, the intent element is met simply by the act of playing together and recording their combined performance.

In reaching its decision, the Seventh Circuit cited a precedential Second Circuit case that dealt with copyright infringement of an off-Broadway play entitled *Moms: A Praise for a Black Comedienne* and a counter-claim of coauthorship.⁴ In this case, a playwright claimed authorship because of suggestions that she made to the author regarding characters, character traits, and certain scenes for the play. In undertaking an analysis of the concept of a "joint work" within the context of copyright law, the court first considered the nature of the contribution required for a joint work. In its analysis, the Second Circuit court reviewed the case law history of authorship and the definitive work on copyright, *Nimmer on Copyright*, and concluded that the contribution of each author must be copyrightable. The court further observed that Section 101 of the Copyright Act defines "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)

In looking to the legislative history of Section 101, the legislature considered a joint work to exist where each party has the intention, at the time the writing is done, that his or her part be absorbed or combined into an integrated unit (H.R. Rep. No. 1476, 94th Cong., 2nd Sess. (1976) at 120; S. Rep. No. 473, 94th Cong., 2nd Sess. at 103). The notion that the collaborators share a joint intent that their parts be merged led to the court's finding that the intent element of authorship should be found in the subjective belief of the collaborators. The court recognized that how the putative authors regarded themselves in relation to the work was a key factor in ascertaining whether the intent element of Section 101 is satisfied. Indeed, where there is a dominant author, the decision can turn on whether the dominant author intends to share authorship.

COLLABORATION VS. MEANING OF INTENT

The *Janky* court also undertook a review of its earlier decision in *Erickson v. Trinity Theatre, Inc.*⁵ The notion of shared or mutual intent played an important role in *Erickson*, which dealt with the authorship of three plays prepared for performance by Trinity Theatre. The plays were developed over time by the playwright, Karen Erickson. Two of the plays were written prior to Trinity's preparing the plays for production. During this preparation of plays for Trinity, various actors made suggestions to the script and to some of the scenes through improvisations during rehearsals. Trinity alleged that it owned an interest in the plays through the contribution of its actors.

The court recognized the authorship issue with respect to Section 101 presented by Erickson to be a case of first impression in the Seventh Circuit.⁶ The district court followed the Second Circuit's approach and stated that to meet the intent requirement, the putative authors should entertain in their minds the concept of coauthorship. After finding that the playwright and the actors did not intend to create a joint work with respect to two of the three plays, the court reviewed the nature of the contribution made by the actors to the plays. Trinity argued that collaboration alone should be sufficient for a joint work, while Erickson argued that the contribution should rise to the level of copyrightable subject matter. The district court did not decide the level of contribution necessary for authorship and simply concluded that under either standard, Erickson was likely to prevail on the merits. Accordingly, the actor-contributors were not authors of the play. Trinity appealed the district court decision.

On appeal, the Seventh Circuit undertook review of the same legislative history as the Second Circuit in *Childress v. Taylor*. The court noted that the legislative history of Section 101 focused on collaboration rather than on the meaning of intent. The simple act of collaborating does not address cases in which the parties had some level of interaction, but dispute whether they intended to create a joint work. In refuting Trinity's "collaboration alone" argument, the court agreed with the Second Circuit's analysis in *Childress* and held that, the legislative history

notwithstanding, the statute requires that each author intend for his or her respective contributions to be merged into a unitary whole.⁷

The court then considered the standard of authorship and noted that courts have applied two tests—the *de minimis* test, as outlined by M.B. Nimmer, and the independent copyrightability test. Under the *de minimis* test, an author must make more than a *de minimis* contribution, and the combined product of the joint effort must be copyrightable.⁸ The court dismissed this standard and held that the contribution of each author must be independently copyrightable.⁹ In the court’s view, this dismissal of the *de minimis* standard eliminates contributions that are no more than ideas, procedures, or discoveries. The court further noted that requiring the contribution of an author to be independently copyrightable would increase the certainty as to authorship for purposes of Section 101.

Interestingly, although the *Janky* court cited *Erickson* in reaching its decision that Farag was a coauthor of the song “Wonders of Indiana,” the court did not precisely follow the *Erickson* analysis with respect to the intent element. In *Janky*, the court seemed to cast off an investigation into whether the putative authors shared a subjective mutual intent to create a joint work and merely focused on the circumstances surrounding the creation of the song. In fact, as noted above, the court described *Erickson* as defining the intent prong as not having to do with the collaborators’ intent to recognize each other as coauthors. According to the *Janky* court, instead of analyzing the legal consequences of the collaboration, the focus is on the collaborators’ intent to work together to create a single product.

However, it is difficult to see where the *Janky* court finds support for this position in *Erickson*. The *Erickson* court ultimately decided that there was no coauthorship of the three plays because the actors did not consider themselves to be authors, and *Erickson* did not consider the actors to be coauthors. In short, there was no shared subjective intent by the putative authors. The dissent in *Janky* argued that there was no evidence that Farag intended to be a coauthor.¹⁰ The dissent argued that the majority placed too much emphasis on the fact that Farag had asserted control over the song and that *Janky* recognized Farag in one of her copyright registrations. Decision making and billing should not be controlling factors. The dissent further questioned the independent copyrightability of Farag’s contribution to the song and qualified his 10 percent contribution to the lyrics as not rising above a mere idea, refinement, or suggestion.¹¹

The case law reviewed above shows that, with respect to determining authorship, courts sometimes tend to sidestep the hard work of ascertaining mutual subjective intent where there is a dominant person directing creative activity. The *Erickson* case is typical of a common authorship dispute situation where one person has most of the artistic control over the creation of the work, while another person collaborates on some portion of the work. In these situations, while mutual intent is considered, the analysis will usually center on the state of mind of the person having the most artistic control over the work. In *Thomson v. Larson*, for example, the Second Circuit cited *Erickson* as signaling the Seventh Circuit’s adoption of *Childress* in requiring a mutual intent, such that the parties entertain in their minds the concept of coauthorship.¹² This standard is clearly subjective, but the intent of the collaborators is a question of fact.

In analyzing the facts, courts must examine the circumstances surrounding the creation of the work. In the *Thomson* case, under a contract with the New York Theater Workshop (“NYTW”), Lynn Thomson performed research and provided services as a dramaturge during the off-Broadway production of *Rent*. The playwright, Jonathan Larson, maintained approval rights of all changes in the text of the play. Following Larson’s death and after the play opened on Broadway, Thomson signed a new contract with NYTW and she continued to provide dramaturgical services, albeit at a much increased compensation level. Later, Thomson brought suit against the Larson heirs, claiming that she was a coauthor. After considering a large amount of evidence, the district court ruled that Thomson was not a coauthor of the play.

On appeal, the *Childress* factors of intent and the level of contribution took center stage. The court must look deep enough into the facts to weed out contributions that amount to no more than useful revisions or helpful advice. It is important to guard against overreaching by those who would claim to be an author, especially in cases where there is clearly one main author that maintains control over the work. The court’s analysis of the issue focused on the intent prong of the *Childress* test.

Mutual intent requires that all the collaborators have a relationship in which they wish to fully share rights in the work. One way to find mutual intent is to determine how the collaborators regarded themselves in relation to the

work. This analysis must go beyond whether they meant to merge their contribution into a single unitary whole because this is always the result of any contemporaneous collaboration. But the analysis is not entirely limited to subjective factors; the court must examine factual indicia of ownership and authorship. Facts regarding how the collaborators regarded each other with respect to the work are relevant. Outwardly directed acts such as listing others on documents that credit authorship, making decisions regarding the composition of work, and entering into contracts with respect to the work are objective indicia of ownership. In some cases, the contributions of coauthors are not contemporaneous. Additional objective facts can be found where an author writes the lyrics to a song, but does not write the music. For example, where it is clear that the lyricist fully expects someone to provide music to go with the lyrics at some point, the composer of the music will be a coauthor of the song. Accordingly, the nature of the inquiry varies depending on the particular situation.

In *Thomson*, the court noted that, in cases where there is a dominant author, care must be taken to ensure that sole authorship is not denied simply because another person renders some form of assistance. The *Thomson* court found that, while Thomson had made substantive contributions to the play *Rent*, Larson retained control over whether and where any of the contributions would be included. Larson retained the sole and complete discretion as to the content of the play and thus did not exhibit any intent that he and Thomson mutually create a joint work.

THE ACCIDENTAL CONTRIBUTOR

Even where there is a dominant author and thus control of the creative activity is clear, the dynamic environment of the places where the action occurs sometimes leads to unintended consequences. For example, music studios and the creative activity that occurs in them are venues ripe for copyright ownership disputes. Artists sometimes visit a recording studio during a recording session and end up making a contribution to the recording. Without some type of written agreement, the court is left to sort out the details when the contributor later makes a claim to an ownership interest in the recording. Such a case arose when Demme Ulloa dropped into a recording session at a studio where Shawn Carter was making a recording.¹³ During the recording session, Ulloa contributed a vocal countermelody to an instrumental phase of the music to a song titled “Izzo.” The producers subsequently released an album including Ulloa’s addition, but refused to recognize this contribution to the song. Ulloa then brought suit claiming copyright infringement, false designation of origin, unjust enrichment, joint ownership of copyright, and an accounting of sales.

Ulloa claimed an ownership interest in both the sound recording and the musical composition. The court, however, ruled that Ulloa did not show that Carter intended to share authorship with her. In reaching its decision, the court relied on *Childress* and noted that authorship requires a shared intent to share the rights of authorship: finding none on the part of Carter or the producers, the court dismissed the joint ownership claim.¹⁴ This court’s reliance on *Childress* and its focus on the sharing of authorship rights can be contrasted with the Seventh Circuit’s statement in *Janky* that the focus is on the parties’ intent to work together and not on the legal consequences of the collaboration.

In contesting the copyright infringement claim, the defendants argued that Ulloa’s contribution was not original and was thus unprotectable by copyright. The court refused to dismiss Ulloa’s claim¹⁵ on the grounds that her countermelody was derived from the instrumental phrase. In later proceedings, the court ultimately refused to dismiss the copyright infringement claim because the defendants failed to show that Ulloa did not independently create the countermelody or that the countermelody was too common or trite to be protectable by copyright. The court also ultimately refused to dismiss the unjust enrichment claim.¹⁶

As the number of people involved in the production of a creative work increases, the difficulty in identifying authors of the work increases dramatically. The Ninth Circuit took the opportunity to consider authorship issues in a case that arose over an authorship claim to the movie *Malcolm X*.¹⁷ In deciding an appeal brought by an Islamic technical consultant upon an unfavorable district court ruling, the court considered the definition of the term “author” in the context of Section 101 of the Copyright Act set forth above. The classic definition of an “author” is one who takes pen to paper and creates a written work. This is easy to visualize, and the concept can be readily extended to situations in which only a few people actively participate in the creation of a work.

The court used the example of songs written by *Gilbert and Sullivan* in which the music and lyrics intertwine in a unified composition. Where the number of collaborators increase and the extent of their contribution to the work varies, identifying an “author” becomes much more difficult. In the *Malcolm X* case at hand, movie sets, like music studios, involve the creative contribution of a large number of people, many of whom could be characterized as contributing copyrightable expression in the production of a movie. In seeking guidance for defining an “author,” the court considered the Supreme Court’s opinion in an 1884 decision.¹⁸ According to this decision, an “author” is

the person to whom the work owes its origin and who superintended the whole work, the “mastermind.” Upon arriving at this definition, however, little insight is gained regarding the “author” of complex works with many creative contributors, such as movies, plays, large musical productions, and the like.

In reviewing the *Thomson*, *Erickson*, and *Childress* decisions, the Ninth Circuit summarized these cases as standing for the proposition that the “contribution of independently copyrightable material to a work intended to be an inseparable whole will not suffice to establish authorship of a joint work.”¹⁹ There must be a showing of a shared intent. The court found favor with the Second Circuit’s analysis of intent that focuses on objective factors, such as the outward manifestations of the person having decision making authority. In supporting that proposition, the court seems to draw upon the mastermind concept from its analysis of what it means to be an “author.” The court noted that the consideration of subjective factors in deciding authorship could lead to fraud because one coauthor could simply hide his or her actual intent from others to create a joint work. Taking the Supreme Court’s definition of “author” into consideration with the Second and Seventh Circuits’ authorship cases, the Ninth Circuit court established the following criteria for authorship in the absence of a contract:

- (1) An author exercises control over the work;
- (2) Coauthors make objective manifestation of a shared intent to be coauthors; and
- (3) The contributions of the coauthors establish the audience appeal of the work, and the share of each author’s contribution cannot be appraised.

The court noted that the first criterion—exercise of control—is the most important factor. Additionally, the Ninth Circuit noted that a written contract is the best objective evidence regarding intent to be a coauthor of a joint work.

It is interesting to analyze the *Janky* case using the criteria established by the Ninth Circuit in *Aalamuhammed*. The Seventh Circuit found that Farag exerted a certain amount of control over the song at issue in that case. The court also found that Janky made objective manifestations through a copyright registration that included Farag. Listing Farag as a joint author showed a manifest intention at the time when the work had only recently been created. Later, Janky characterized her actions as merely a show of gratitude to Farag. This characterization leads to an important lesson and rule of thumb: Do not list someone on a copyright registration application for any reason other than the person is an author of the subject work. Lastly, the court indicated that Farag’s contributions to the lyrics were significant and that they were important both to the final sound and the commercial viability of the song. This last finding, especially, captures the essence of the third Ninth Circuit factor—audience appeal. In recognizing Farag as a coauthor, the Seventh Circuit noted that this case was a “close call”²⁰—a point to be well taken.

The cases discussed in this article demonstrate the importance of establishing a written agreement among the collaborators prior to creating any kind of joint work. In any dispute over ownership of a copyrighted work, courts will carefully examine the circumstances before, during, and after publication of the work. Once it is established that a putative author has made a copyrightable contribution, the ultimate outcome will depend on the finding of a shared intention to create a joint work. The court’s analysis will depend on the facts surrounding the collaboration, and these facts will most certainly be in dispute. There is perhaps no better evidence of the intent of collaborators to a creative work than a well-drafted ownership agreement.

J. William Dockrey is Counsel at Brinks Hofer Gilson & Lione. The views expressed in this article are those of the author and do not necessarily represent those of Brinks Hofer Gilson & Lione. He can be reached at jdockrey@usebrinks.com.

Endnotes

1. *Janky v. Lake County Convention and Visitors Bureau*, 576 F.3d 356 (7th Cir. 2009).
2. *Janky v. Farag*, 79 USOQ2d 1564 (N.D. Ind. 2006).
3. *Janky*, 576 F.3d at 362.
4. *Childress v. Taylor*, 945 F.2d 500, (2d Cir. 1991).
5. *Erickson v. Trinity Theatre, Inc.*, 13 F.3d1061 (7th Cir. 1994).
6. *Id.* at 1065.
7. *Erickson* at 1068–69.
8. *Nimmer on Copyright* § 6.07.
9. *Erickson* at 1071.
10. *Janky v. Lake County Convention and Visitors Bureau*, 576 F.3d at 364 (J. Ripple *dissent*).
11. *Id.* at 365.
12. *Thomson v. Larson*, 147 F.3d 195 (2d Cir. 1998).
13. *Ulloa v. Universal Music and Video Distribution Corp.*, 303 F. Supp. 2d 409 (S. Dist. NY 2004).
14. *Id.* at 418.
15. *Ulloa v. Universal Music and Video Distribution Corp.*, 2004 WL 840279 (S. Dist. NY 2004).

16. This case is also noteworthy for its illustration of the array of legal claims that can be brought when an artist makes a copyrightable contribution to a musical work and is denied benefit of that contribution. Even where the contribution is small relative to the total extent of the work, if the contribution satisfies the requirements for copyright protection, the creator enjoys legal rights in the contribution. In this case, the plaintiff asserted both joint ownership and copyright infringement, which represent alternative forms of relief. A coauthor cannot be liable to another author for copyright infringement since all authors have an unfettered right to exploit the work. Asserting alternative legal claims can be an effective strategy. Here, although the court dismissed the coauthorship claim, the copyright infringement claim survived the defendant's motion to dismiss.

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

18. *Burrow-Giles Lithography Co. v. Sarony*, 111 U.S. 53 (1883).

19. *Aalamuhammed*, USPQ2d at 1665.

20. *Janky v. Lake County Convention and Visitors Bureau*, 576 F.3d at 363.