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WHO'S AFRAID OF SWISS CHEESE? RESOLVING THE COPYRIGHT CLAIMS OF NON-COAUTHORS

*D. Sean West\**

*Driven by a fear of making “Swiss cheese” out of movie copyrights, courts have consistently rejected any possibility that an actor or director may hold an independent copyright interest in his or her movie performance or direction. To justify the exclusion of such contributions from the canon of copyright, courts have resorted to redefining the constitutional and statutory limits on copyrightable subject matter. While their efforts succeed in squeezing out the authorship claims of actors and directors, the collateral damage wrought by their new restrictions on what constitutes a “work of authorship” has not previously been evaluated.*

*In this Comment, I suggest these new doctrines, which are inconsistent with foundational principles of copyright law and established case law, ought to be rejected as there is no need to fear the authorship claims of actors and directors. The 1976 Copyright Act envisions nine circumstances under which one may contribute to a larger work; all contribution claims can be resolved within that framework. Furthermore, courts have existing gatekeeping doctrines to mitigate their policy fears without altering existing copyright law. Copyright claims from those making creative contributions should not drive courts to implement ill-conceived novel solutions, thereby distorting collaborative forms of authorship, such as movies. Instead, by enforcing traditional copyright doctrines, courts can provide the stable framework necessary to facilitate bargaining among the multiple authors involved in these complex creative works.*

INTRODUCTION

While everyone from the producer and director to casting director, costumer, hairstylist, and “best boy” may make creative contributions to a movie, courts consistently reject coauthorship claims by anyone whose name does not appear near the top of the screen credits.<sup>1</sup> The Second and Ninth Circuits, those that hear the majority of copyright appeals, have become particularly adept at resolving coauthorship claims based on the nature of the contribution the claimant made and the subjective intent of other contributors.<sup>2</sup> While coauthorship case law has become more developed, courts and

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<sup>1</sup> See generally Mary LaFrance, *Authorship, Dominance, and the Captive Collaborator: Preserving the Rights of Joint Authors*, 50 EMORY L.J. 193 (2001).

<sup>2</sup> *Id.*

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commentators have left unresolved whether individuals who contribute to works but are not coauthors nonetheless have any residual copyright interest.<sup>3</sup>

Courts almost never address the copyright status of contributions to motion pictures made by non-coauthors, partially because optimistic plaintiffs fail to include an alternative plea to their joint authorship claims.<sup>4</sup> However, a small number of recent cases presenting the question of whether a contribution to a motion picture can support a copyright interest outside of a coauthorship claim have come before the Second and Ninth Circuits.<sup>5</sup> Both circuits rejected such claims.<sup>6</sup> These cases have wrongly been described as “consistent with current copyright doctrine”<sup>7</sup>—they are merely consistent in limiting copyright interest in movies to those near the top of the screen credits.<sup>8</sup>

The contribution analysis in these circuits’ decisions represent a troubling break from established copyright doctrine, and their rationales, if widely adopted, would have far-reaching implications for copyright law. While the Second and Ninth Circuits were compelled by a fear of making “Swiss cheese of copyrights[,]”<sup>9</sup> copyright law was already equipped to handle this concern without resorting to the radical reworking of existing doctrines.

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<sup>3</sup> See, e.g., *Aalmuhammed v. Lee*, 202 F.3d 1227, 1236 (9th Cir. 2000) (copyright interest in contributions of one found not to be a coauthor and not addressed by court); *Thomson v. Larson*, 147 F.3d 195, 205 (2d Cir. 1998) (copyright interest in contributions of one found not to be a coauthor and said to be “somewhat of a conundrum.”).

<sup>4</sup> *Id.*

<sup>5</sup> See, e.g., *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 255 (2d Cir. 2015); *Garcia v. Google, Inc.*, 786 F.3d 733, 738 (9th Cir. 2015).

<sup>6</sup> *Id.*

<sup>7</sup> Diana C. Obradovich, *Garcia v. Google: Authorship in Copyright*, 31 *BERKELEY TECH. L.J.* 785, 809 (2016).

<sup>8</sup> See *Aalmuhammed*, 202 F.3d at 1233 (movie copyright claims are generally limited “to someone at the top of the screen credits, sometimes the producer, sometimes the director, possibly the star, or the screenwriter—someone who has artistic control.”).

<sup>9</sup> *16 Casa Duse*, 791 F.3d at 258; *Garcia*, 786 F.3d at 742.

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This Comment begins, in Part I, with a review of the types of creative expression that give rise to copyright interests before examining, in Part II, how that framework is applied to authors who contribute creative expression to another work. As will be shown, the copyright status of a contribution is a function of both the nature of the contribution and the nature of the contributor's intention. With three contribution types and three contributor intentions recognized by the Copyright Act, nine contribution scenarios emerge.

The Copyright Act expressly addresses all but two of the scenarios in which an author contributes to another work.<sup>10</sup> When a contributor intends neither to merge his or her contribution into a joint work nor to designate his or her contribution a work for hire, judges have been left to resolve for themselves the copyright status of separable interdependent contributions and inseparable contributions.<sup>11</sup>

While resolving questions about separable interdependent contributions have presented courts with little trouble, Part III examines the difficulty courts have had in resolving questions about inseparable contributions. The Ninth Circuit's *Garcia v. Google* and the Second Circuit's *16 Casa Duse v. Merkin* decisions are examined in detail, and how these decisions alter copyright law to reach their desired outcomes are highlighted. Finally, this Comment concludes, in Part IV, with recommendations on how established gatekeeping doctrines can be employed to achieve the majority of the desired policy outcomes of the *Garcia* and *16 Casa Duse* courts without altering copyright law.

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<sup>10</sup> See discussion *infra* Part II.

<sup>11</sup> See discussion *infra* Part II.D.

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I. COPYRIGHTABLE EXPRESSION GENERALLY

Not all human expression gives rise to copyright interests. While the author of a quickly jotted down limerick has a copyright interest in her work, the author of a spontaneously composed spoken word poem receives no such interest.<sup>12</sup> While the recognition of a copyright interest in some expressions and not others may be felt to be uneven, it is not unpredictable. Within the vast domain of human expression, the sizable zone in which an expression will give rise to a copyright interest is circumscribed by three conjunctive definitions: “original,” “work of authorship,” and “fixation.”<sup>13</sup> That is to say, only expression that constitutes an original work of authorship fixed in a tangible medium receives copyright protection.<sup>14</sup>

The first two definitions, originality and work of authorship, address the substance a protectable work must possess; the final definition, fixation, addresses the form a protectable work must take.

A. “Original”

Originality, despite having been described as “[t]he *sine qua non* of copyright[.]”<sup>15</sup> is not actually defined in the Copyright Act. The omission of a specific definition was intended to “incorporate[.] without change[.] the standard of originality established by the courts under the [1909] copyright statute.”<sup>16</sup> While the 1909 Copyright Act neither defined originality nor required works be original, courts found Congress’s power to recognize

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<sup>12</sup> See *Fritz v. Arthur D. Little, Inc.*, 944 F. Supp. 95, 100 (D. Mass. 1996) (“‘Original’ words spoken aloud can be copied (and independently copyrighted) by all, if they have not previously been fixed in a tangible medium of expression.”) (quoting *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903)).

<sup>13</sup> 17 U.S.C. § 102 (1990).

<sup>14</sup> *Id.*

<sup>15</sup> *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

<sup>16</sup> *Id.* at 355 (quoting H.R. REP. NO. 94-1476, at 120 (1976)).

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copyright interests limited by the [c]onstitutional requirement that copyright protection only be afforded to the works of “[a]uthors[.]”<sup>17</sup>

The constitutional requirement of originality is satisfied, and works are considered authored, when works are independently created and possess a modicum of creativity.<sup>18</sup> Thus, while originality is a remarkably low threshold, it is still a threshold. Creative expression that is a copy of another work and creative expression “in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent” are excluded from the subject matter of copyright by this requirement.<sup>19</sup> All other creative expression is regarded as original and a work of authorship in the constitutional sense.

*B. “Work of Authorship”*

Even though a work may be authored in the constitutional sense, the work must also be a “work of authorship” within the meaning of the Copyright Act for a copyright interest to be recognized.<sup>20</sup> Work of authorship functions as a term of art within the Copyright Act, used to identify the subset of constitutionally protectable works that Congress chose to extend copyright protection to.<sup>21</sup> The phrase “works of authorship” was “purposely left undefined” as the Copyright Act’s drafters sought neither to “freeze the scope of copyrightable subject matter at the present stage of communications technology

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<sup>17</sup> U.S. CONST. art. 1 § 8, cl. 8.

<sup>18</sup> See *Feist Publications*, 499 U.S. at 358. While the independent creation and modicum of creativity requirements are typically evaluated by courts together as part of an inquiry into “originality,” some advocate bifurcated the analysis into separate inquiries for originality and creativity. See *Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663, 668 n.6 (7th Cir. 1986) (“For the sake of clarity, we shall use ‘originality’ to mean independent authorship and ‘creativity’ to denote intellectual labor.”).

<sup>19</sup> *Feist Publications*, 499 U.S. at 359.

<sup>20</sup> 17 U.S.C. § 102 (1990).

<sup>21</sup> See H.R. REP. NO. 94-1476, at 51 (1976) (“In using the phrase ‘original works of authorship,’ rather than ‘all the writings of the author’ now in section 4 of the [1909] statute, the committee’s purpose is to avoid exhausting the constitutional power of Congress to legislate in this field . . .”).

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[n]or to allow unlimited expansion into areas completely outside the present congressional intent.”<sup>22</sup>

In lieu of a definition, eight broad categories are identified as works of authorship:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.<sup>23</sup>

The example categories are “illustrative and not limitative.”<sup>24</sup> Courts have recognized that works not falling squarely within one of the categories may still be sufficiently similar or analogous to one of the example categories to be considered works of authorship.<sup>25</sup>

*C. “Fixation”*

Finally, copyright protection is only extended to those works that are “fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated . . . .”<sup>26</sup> Fixation is a constitutional requirement. The Constitution only grants Congress the authority to extend copyright protection to the “[w]ritings” of

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<sup>22</sup> *Id.* This intentional statutory ambiguity aligns with judicial reluctance to narrowly circumscribe what qualifies as works of authorship because of the narrowing effect that could be expected to occur if “persons trained only to the law [constituted] themselves final judges of” artistic merit. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

<sup>23</sup> 17 U.S.C. § 102(a) (1990).

<sup>24</sup> 17 U.S.C. § 101 (2010) (“including” definition).

<sup>25</sup> *See* H.R. REP. NO. 94-1476, at 53. *Compare* Nat’l Conference of Bar Examiners v. Multistate Legal Studies, Inc., 495 F. Supp. 34, 36 (N.D. Ill. 1980), *aff’d*, 692 F.2d 478 (7th Cir. 1982) (Multistate Bar Examination is sufficiently similar to enumerated categories to receive copyright protection) *with* Nat’l Basketball Ass’n v. Motorola, Inc., 105 F.3d 841, 846 (2d Cir. 1997) (basketball games are neither “similar nor analogous to any of the listed categories”).

<sup>26</sup> § 102(a).

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authors, thus works must be fixed in a tangible form to be regarded as “[w]ritings” to be eligible for protection.<sup>27</sup>

Fixation alone, even while producing a tangible object capable of being regarded as a writing, would not necessarily produce the writings of an author. For example, a bootleg recording of a live musical performance would fix that performance into a “writing,” but it would not be the musician-author’s writing. To ensure that only the writings of authors are afforded copyright protection, the only fixation recognized under the Copyright Act is fixation that occurs “by or under the authority of the author[.]”<sup>28</sup>

II. CONTRIBUTIONS AS COPYRIGHTABLE EXPRESSION

The foundational analysis of whether an expression gives rise to a copyright interest is not altered by whether the expression stands alone or is incorporated into a larger work. An original work of authorship fixed in a tangible medium can give rise to a copyright interest even though it is part of larger work.<sup>29</sup> However, the contours of a copyright interest that may arise is affected by the nature of the contribution and the contributor’s intention in making the contribution.

Three types of contributions are contemplated by the Copyright Act: contributions that are separable and independent from a larger work, contributions that are separable but interdependent on a larger work, and contributions that are inseparable from a larger work.<sup>30</sup> These categories are not laid out explicitly in the Copyright Act but are implicit in definitions of collective and joint works.<sup>31</sup> In the context of motion pictures, interdependent

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<sup>27</sup> U.S. CONST. art. 1, § 8, cl. 8.

<sup>28</sup> § 101 (“fixed” definition).

<sup>29</sup> *See, e.g.*, 17 U.S.C. § 101 (2010) (“collective work” and “joint work” definitions).

<sup>30</sup> *See id.*

<sup>31</sup> *See id.*



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contributions may be those like special effects sequences or audio tracks. Although it is possible to isolate these elements from the rest of the motion picture, they are dependent on the rest of the motion picture for part of their meaning.<sup>32</sup> Inseparable contributions may be those like the acting performance at issue in *Garcia* or the directing performance at issue in *16 Casa Duse*. Such elements cannot be isolated from the rest of the motion picture and are thus completely dependent on the motion picture for their meaning.<sup>33</sup>

Additionally, three types of contributor's intentions are contemplated: a contributor may intend to merge his contribution together with the contributions of others, a contributor may intend to have another be considered the author of his contribution, or a contributor may intend to retain his independent copyright interest in his contribution. Again, these intentions are not explicitly laid out in the Copyright Act but are implicit in the definitions of collective works, joint works, and works for hire.<sup>34</sup>

As there are three possible contribution types and three possible contributor intentions, there are nine permutations for how they might be combined. As demonstrated in the matrix below, most of these permutations are explicitly provided for in the Copyright Act; however, there are two notable exceptions. Each of these combinations will be discussed in turn.

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<sup>32</sup> See F. Jay Dougherty, *Not A Spike Lee Joint? Issues in the Authorship of Motion Pictures Under U.S. Copyright Law*, 49 UCLA L. REV. 225, 297, 303, 310 (2001) (recognizing that some recordings are capable of being regarded as interdependent parts of a motion picture “[b]ecause the music and recordings are capable of existing independently from the rest of a film[.]”).

<sup>33</sup> See *id.* at 297, 303 (recognizing that “[c]inematography is one of the key, inseparable components of film authorship” and that “acting involves movement, posture, and gesture, which are analogous to copyrightable pantomime or choreography.”).

<sup>34</sup> See § 101 (“collective work,” “joint work,” and “work made for hire” definitions); see also discussion *infra* Parts II.A, II.B, and II.C.

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	<b>Contributors intend to merge their contributions</b>	<b>Contributor intends to have another be considered the author of their contribution</b>	<b>Contributor intends neither to merge their contribution nor to have another be its author</b>
<b>Separable Independent Contribution</b>	<u>Collective Work</u> Each contributor is a co-owner of copyright in the collective work but retains sole copyright in their contribution. <sup>35</sup>	<u>Work for Hire</u> The entity for whom a contribution to a collective work was prepared may be considered the author. <sup>36</sup>	<u>Collective Work</u> Contributor retains copyright in their contribution separate from any copyright in the collective work. <sup>37</sup>
<b>Separable Interdependent Contribution</b>	<u>Interdependent Joint Work</u> Each contributor is a co-owner of copyright in the work. <sup>38</sup>	<u>Work for Hire May Apply</u> In the context of motion pictures, the entity who commissions an interdependent contribution may be considered its author. <sup>39</sup>	<u>Not Addressed by Statute</u> Strong consensus around recognizing an independent copyright interest in such contributions. <sup>40</sup>
<b>Inseparable Contribution</b>	<u>Inseparable Joint Work</u> Each contributor is a co-owner of copyright in the work. <sup>41</sup>	<u>Work for Hire May Apply</u> Ambiguity as to whether the entity who commissions an inseparable contribution may be considered its author. <sup>42</sup>	<u>Not Addressed by Statute</u> The issue addressed by <i>Garcia and 16 Casa Duse</i> . <sup>43</sup>

<sup>35</sup> 17 U.S.C. §§ 101, 201(c).

<sup>36</sup> 17 U.S.C. §§ 101, 201(b).

<sup>37</sup> 17 U.S.C. §§ 101, 201(c).

<sup>38</sup> 17 U.S.C. §§ 101, 201(a).

<sup>39</sup> 17 U.S.C. §§ 101, 201(b).

<sup>40</sup> See discussion *infra* Sections II.D.1.

<sup>41</sup> 17 U.S.C. §§ 101, 201(a).

<sup>42</sup> 17 U.S.C. §§ 101, 201(b).

<sup>43</sup> See discussion *infra* Sections III.

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### *A. Collective Works*

When a number of contributions, each constituting separate and independent works in themselves, are selected, coordinated, or arranged in such a way that the resulting work, as a whole, constitutes an original work of authorship, the resulting work is considered a “collective work.”<sup>44</sup> The creation of a collective work does not merge the copyright interests in the separable independent contributions that comprise the collective work; rather, collective works give rise to a new copyright interest that is independent from its constituent parts.<sup>45</sup> That new copyright interest recognizes the selection and arrangement of the constituent parts of a collective work as being itself an act of authorship.<sup>46</sup>

If the conditions of joint authorship are fulfilled, contributors to a collective work might be considered coauthors of the copyright interest in the selection and arrangement of the collective work.<sup>47</sup> However, since the joint authorship definition does not extend to separable independent contributions, each contributor to a collective work would retain the copyright interest in their separable independent contributions.<sup>48</sup>

### *B. Joint Works*

When two or more authors intend “their contributions be merged into inseparable or interdependent parts of a unitary whole[,]” the resulting work they produce is considered a “joint work.”<sup>49</sup> Each author of the joint work is a co-owner of the copyright,<sup>50</sup> and courts

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<sup>44</sup> § 101 (“collective work” and “compilation” definitions).

<sup>45</sup> *See* *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991) (“[I]f the selection and arrangement are original, these elements of the work are eligible for copyright protection.”).

<sup>46</sup> *See id.*

<sup>47</sup> 17 U.S.C. § 101 (2010) (“joint work” definition).

<sup>48</sup> *Id.*

<sup>49</sup> *Id.*

<sup>50</sup> 17 U.S.C. § 201 (1978).

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traditionally regard all joint authors as possessing equal shares in the ownership of the joint work unless an agreement to the contrary has been made.<sup>51</sup>

No statutory definitions for “interdependent” or “inseparable” are provided in the Copyright Act, but the House Report on the 1976 Act gives novels and paintings as examples of inseparable joint works, and the lyrics and melody of a song as an example of an interdependent joint work.<sup>52</sup> The Copyright Act treats both types of joint works identically, and both those who contribute inseparable and separable contributions are regarded as authors of the resulting joint work.<sup>53</sup>

As coauthors’ equal shares in a work allow them to equally partake in a work’s profit, the large financial implications of joint authorship exist in tension with the minimal statutory requirements for joint authorship. This tension has, at times, been resolved by the introduction of a number of non-statutory tests.<sup>54</sup> These tests take a conservative approach to defining joint authorship, allowing courts to reject the claims of contributors who are not truly thought to be “authors” of the resulting work.<sup>55</sup> One such test, focusing on the nature of the contribution made by each party claiming coauthorship, is relevant to whether contributions may be independently copyrightable.

The classic formulation of the contribution test, originally proposed by Professor Paul Goldstein, requires each coauthor to make a contribution that would be independently copyrightable.<sup>56</sup> The requirement of independent copyrightability was adopted by the

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<sup>51</sup> See, e.g., *Greene v. Ablon*, 794 F.3d 133, 151 (1st Cir. 2015).

<sup>52</sup> See H.R. REP. NO. 94-1476, at 120.

<sup>53</sup> 17 U.S.C. § 101 (2010) (“joint work” definition).

<sup>54</sup> See, e.g., *Aalmuhammed v. Lee*, 202 F.3d 1227, 1233 (9th Cir. 2000) (introduction of “master mind” test to deny a contributor to a motion picture joint authorship status).

<sup>55</sup> *Id.*

<sup>56</sup> PAUL GOLDSTEIN, *COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE* § 4.2.1.2 (1989).

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Second and Ninth Circuits, among others.<sup>57</sup> The implication of such a test is that inseparable contributions, under some circumstances, must be independently copyrightable. If inseparable contributions were incapable of being regarded as original works of authorship fixed in a tangible medium, the adoption of an independent copyrightability requirement would render half of the joint works definition null.

#### *C. Works for Hire*

When a work is regarded as “made for hire,” the Copyright Act allows a contributor of creative expression to designate another to be recognized as the author of that expression.<sup>58</sup> “Works made for hire” are the only exception to the Copyright Act’s default rule that copyright interest initially vests with the originator of copyrightable expression.<sup>59</sup> Commissioners of works may prefer the work for hire arrangement over being assigned the copyright interest in a contribution because being regarded as the work’s author from its inception eliminates the possibility an original author will assert the right to terminate the transfer of copyright interest after 35 years.<sup>60</sup>

Only two categories of works may be regarded as having been made for hire: works prepared by an employee within the scope of his or her employment or works

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<sup>57</sup> See, e.g., *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 521 (9th Cir. 1990) (“[O]ur circuit holds that joint authorship requires each author to make an independently copyrightable contribution”); *Thomson v. Larson*, 147 F.3d 195, 200 (2d Cir. 1998) (“[T]he contribution of each joint author must be independently copyrightable.”). Although in dicta, the Second Circuit has recently speculated that a copyrightable contribution may be sufficient to establish joint authorship, even if the contribution would not be independently copyrightable. *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 255 n.3 (2d Cir. 2015). “Copyrightable” under such a relaxed test appears to be intended as a misnomer for “product of authorship,” but it is unclear whether constitutional or statutory conceptions of authorship are intended or how such a test would be applied. 2 WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 5:15 (2018). For a discussion of the circuit split on this matter, see Jeannette Gunderson, *An Unaccountable Familiarity: A Dual Solution to the Problem of Theft in Theatrical Productions*, 31 SEATTLE U. L. REV. 667, 679–80 (2008).

<sup>58</sup> 17 U.S.C. § 101 (2010); 17 U.S.C. § 201(b) (1978).

<sup>59</sup> § 201(a)–(b).

<sup>60</sup> 17 U.S.C. § 203 (2002). See also 3 MELVILLE B. NIMMER AND DAVID NIMMER, *NIMMER ON COPYRIGHT* § 11.07(E)(2)(c)(iv) (2018).

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commissioned for one of nine purposes.<sup>61</sup> In the latter case, the parties must “expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.”<sup>62</sup>

Two of the nine purposes that a work for hire may be commissioned for are only capable of producing contributions to other works.<sup>63</sup> The creators of works commissioned for use as a contribution to a collective work or as a part of a motion picture can designate their contributions as works for hire.<sup>64</sup> The inclusion of contributions in the work for hire doctrine is significant because the doctrine only affects the person regarded as the author of a work, not what is recognized as a work under the Copyright Act. Therefore, the inclusion of contributions signals an understanding that some contributions may themselves be works.

Separable independent contributions are explicitly included in the work for hire framework by its reference to contributions to collective works.<sup>65</sup> Interdependent contributions and inseparable contributions are also implicitly included in the work for hire framework by its reference to contributions to motion pictures. To prevent “work specially ordered or commissioned for use . . . as a part of a motion picture or other audiovisual work” from being mere surplusage, it must be understood as applying to different types of contributions than those considered contributions to collective works; that is, it must refer

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<sup>61</sup> § 101 (“work made for hire” definition). The nine purposes a work for hire may be commissioned for are: (1) as a contribution to a collective work, (2) as a part of a motion picture or other audiovisual work, (3) as a translation, (4) as a supplementary work, (5) as a compilation, (6) as an instructional text, (7) as a test, (8) as answer material for a test, or (9) as an atlas. *Id.*

<sup>62</sup> *Id.*

<sup>63</sup> See 17 U.S.C. § 101 (2010). For example, “work specially ordered or commissioned for . . . use as an atlas” may be intended as either a standalone work or as a part of another work.

<sup>64</sup> *Id.*

<sup>65</sup> Collective works must be comprised of contributions capable of being regarded as “separate and independent works in themselves[.]” § 101 (“collective work” definition).

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to contributions that do not constitute “separate and independent works in themselves[.]”<sup>66</sup>

This means the work for hire doctrine applies to separable interdependent contributions to movies, inseparable contributions to movies, or both types of contributions to movies.

Interdependent contributions to movies were clearly understood by the House Report on the 1976 Act as capable of being “parts” of a movie. Motion pictures were listed in the report, along with the words and music of a song, as examples of interdependent joint works.<sup>67</sup> The classification of movies as interdependent works that can be neatly segmented into interdependent parts appears to have its roots in the House’s attempts to allay the concerns of writers and musicians whose scripts and scores were being used in movies.<sup>68</sup> While interdependent contributions should be recognized as component parts of a movie, regarding movies as only being the products of their interdependent scripts and scores denies the real, often inseparable, contributions made by others.

Inseparable contributions to motion pictures are also recognized, albeit indirectly, by the House Report on the 1976 Act as capable of being “parts” of a movie.<sup>69</sup> While motion pictures are spoken of as interdependent works, elsewhere the report recognizes the act of directing as being an act of authorship.<sup>70</sup> The directing of a live football broadcast, involving the creative expression of framing and selecting shots, left the Report drafters with “little doubt” that the director was engaged in an act of authorship.<sup>71</sup> Directing cannot

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<sup>66</sup> *Id.*

<sup>67</sup> *See* H.R. REP. NO. 94-1476, at 120. In contrast, novels and paintings are provided as examples of inseparable joint works.

<sup>68</sup> *See id.* (“The definition of ‘joint works’ has prompted some concern lest it be construed as converting the authors of previously written works, such as plays, novels, and music, into coauthors of a motion picture in which their work is incorporated.”).

<sup>69</sup> *See id.* at 52.

<sup>70</sup> *See generally id.*

<sup>71</sup> *Id.* at 52 (“When a football game is being covered by four television cameras, with a director guiding the activities of the four cameramen and choosing which of their electronic images are sent out to the public

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be considered less a work of authorship in the context of motion pictures than in the context of football broadcasts.

Courts and the Copyright Office<sup>72</sup> also have not followed the House Report's limited understanding of movies as being only comprised of interdependent parts. The Copyright Office recognizes, in the context of joint works, that motion pictures can be the product of either interdependent or inseparable contributions.<sup>73</sup> Acting performances are specifically recognized as a type of inseparable contribution that can make one a joint author of a movie.<sup>74</sup> Similarly, courts have recognized that a motion picture can be a joint work comprised of the inseparable contributions made by actors and directors.<sup>75</sup>

Only one reason exists as to why the parts of a motion picture should be conceived of differently in the context of joint works than in the context of works for hire: While the joint works definition speaks of the "contributions" made by each coauthor,<sup>76</sup> the work for hire definition speaks of a "work" commissioned for use as part of a motion picture.<sup>77</sup> However, any difference between a contribution and a work is effectively collapsed by the imposition of a joint authorship test that requires each coauthor's contribution to be

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and in what order, there is little doubt that what the cameramen and the director are doing constitutes 'authorship.'").

<sup>72</sup> See generally UNITED STATES COPYRIGHT OFFICE: A BRIEF INTRODUCTION AND HISTORY, <https://www.copyright.gov/circs/circ1a.html> (Apr. 1, 2018) [<https://perma.cc/59KC-JQU5>].

<sup>73</sup> Brief in Response to Suggestion of Rehearing En Banc at appx., ADD47, *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. 2015) (No. 12–57302) (Letter from Robert J. Kasunic, Assoc. Register of Copyrights and Dir. of Registration Policy and Practices, U.S. Copyright Office, to M. Cris Armenta, The Armenta Law Firm (Mar. 6, 2014)).

<sup>74</sup> *Id.*

<sup>75</sup> See, e.g., *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 258 (2d Cir. 2015) ("The director of a film may, of course, be the sole or joint author of that film, such that she or he can secure copyright protection for the work"); *Aalmuhammed v. Lee*, 202 F.3d 1227, 1233 (9th Cir. 2000) (recognizing that the coauthor of a motion picture may be "someone at the top of the screen credits, sometimes the producer, sometimes the director, possibly the star, or the screenwriter—someone who has artistic control.").

<sup>76</sup> See 17 U.S.C. § 101 (2010) ("joint work" definition).

<sup>77</sup> See § 101 ("work made for hire" definition).



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independently copyrightable.<sup>78</sup> Therefore, consistency requires applying the work for hire doctrine to both interdependent and inseparable parts of motion pictures.

*D. Unaddressed Situations*

Two pairings of contribution type and contributor intention are not addressed directly by the Copyright Act. When a contributor intends neither to merge their contribution with the contributions of others nor to have another considered the author of their contribution, the copyright status of separable interdependent contributions and inseparable contributions are unclear. While a strong copyright norm has coalesced around the treatment of separable interdependent contributions, courts have struggled to resolve the question of inseparable contributions.

1. Independent interests in separable interdependent contributions

While independent copyright interests in separable interdependent contributions are not addressed in the Copyright Act, courts and parties routinely recognize independent copyright interests in such contributions.<sup>79</sup> The failure of courts or litigants to raise this issue demonstrates a strong consensus that, at least in the context of separable contributions, the recognition of a copyright interest in copyrightable expression is a default position that is undisturbed by statutory silence about a particular context the copyrightable expression may be created for.

*Effects Assocs., Inc. v. Cohen* provides an example of how strong this consensus is. Effects Associates produced special effects footage for use in the low-budget alien invasion movie “The Stuff.”<sup>80</sup> When the footage was incorporated in the final film, despite not

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<sup>78</sup> See discussion *supra* Part II.B.

<sup>79</sup> See, e.g., *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 559 (9th Cir. 1990).

<sup>80</sup> *Id.* at 555–56.

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having been fully paid for, Effects Associates brought a suit for copyright infringement against the director and production company.<sup>81</sup> Neither party claimed the motion picture was a joint work, and the special effects sequences were found not to be works made for hire.<sup>82</sup>

The *Effects Assocs.* court recognized the interdependent nature of the special effects sequences when it observed that the sequences may not have much market value apart from the movie they had been commissioned for.<sup>83</sup> Despite the interdependent nature of Effects Associates' contribution, their independent copyright interest in the special effects footage was not disputed by the defendant or the court.<sup>84</sup>

## 2. Independent interests in inseparable constitutions

Independent copyright interests in inseparable contributions are also not addressed in the Copyright Act, and, as a result, courts and litigants routinely object to recognizing independent copyright interests in such contributions.<sup>85</sup> However, the rejection of such interests sits uneasily with the consensus evident in other contexts—that statutory silence causes the copyright interest in works of authorship to fall into the default of vesting with the author of the work rather than into oblivion.<sup>86</sup> The problematic rationales courts have put forward to attempt to exclude inseparable contributions from this default is the subject of the next Part.

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<sup>81</sup> *Id.* at 556.

<sup>82</sup> *Id.* at 557.

<sup>83</sup> *Id.* at 559 (“[I]t remains to be seen whether there’s a market for shots featuring great gobs of alien yogurt oozing out of a defunct factory.”).

<sup>84</sup> *Id.* at 556.

<sup>85</sup> See discussion *infra* Part III.

<sup>86</sup> 17 U.S.C § 201(a) (1978) (“Copyright in a work protected under this title vests initially in the author or authors of the work.”). See also discussion *supra* Part II.D.1.

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### III. SWISS CHEESE CASES

The two circuit cases to address the issue of inseparable contributions, *Garcia v. Google* and *16 Casa Duse*, are united by the common fear that the possibility of recognizing such interests would “make Swiss cheese of copyrights.”<sup>87</sup> Despite this common fear, these courts take divergent paths to avoid recognizing such interests. The *Garcia* court attempts to argue that inseparable contributions are not “authored” in the constitutional sense, and the *16 Casa Duse* court attempts to argue that inseparable contributions are not “works of authorship” in the statutory sense.<sup>88</sup> Although the courts attempt to characterize their treatment of inseparable contributions as consistent with how other works are treated, both rationales are inconsistent with the statutory framework and established precedent.

#### A. *Garcia v. Google*

In *Garcia v. Google* an actress claimed an independent copyright interest in her “audio-visual dramatic performance” in a film.<sup>89</sup> Although a Ninth Circuit panel initially found Garcia, the actress claiming the copyright interest, likely to succeed on the merits of her claim,<sup>90</sup> an en banc panel later reached the opposite conclusion.<sup>91</sup>

Cindy Lee Garcia responded to a casting call for an action-adventure thriller titled *Desert Warrior* in July 2011.<sup>92</sup> As a result, she was ultimately cast in a small part that required her to deliver two lines and “seem[ ] concerned.”<sup>93</sup> Garcia, who never signed a

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<sup>87</sup> See *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 258 (2d Cir. 2015); *Garcia v. Google, Inc.*, 786 F.3d 733, 742 (9th Cir. 2015).

<sup>88</sup> See discussion *infra* Parts III.A and III.B.

<sup>89</sup> *Garcia*, 786 F.3d at 738.

<sup>90</sup> *Garcia v. Google, Inc.*, 766 F.3d 929, 933–36 (9th Cir. 2014), on *reh'g en banc*, 786 F.3d 733 (9th Cir. 2015).

<sup>91</sup> *Garcia*, 786 F.3d at 740–44.

<sup>92</sup> *Id.* at 737.

<sup>93</sup> *Id.*

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work for hire agreement, was paid \$500 for her performance, which was filmed over four days.<sup>94</sup>

Although *Desert Warrior* was never completed, five seconds of Garcia's performance recorded for the movie were incorporated into a new short film entitled *Innocence of Muslims*.<sup>95</sup> Far from the action-adventure thriller Garcia auditioned for, *Innocence of Muslims* is an anti-Islam polemic that depicts the Prophet Mohammed as, among other things, a murderer, pedophile, and homosexual.<sup>96</sup> While Garcia's performance is displayed in *Innocence of Muslims*, her original lines were dubbed over with a voice asking, "Is your Mohammed a child molester?"<sup>97</sup>

After *Innocence of Muslims* was posted on YouTube, the video-sharing website owned by Google, in June 2012, the film was translated into Arabic and "fomented outrage across the Middle East[.]"<sup>98</sup> The film is purported to have played a role in inciting the September 11, 2012, attack on the United States Consulate in Benghazi, Libya.<sup>99</sup> Shortly after the Benghazi attack, an Egyptian cleric issued a fatwa against anyone associated with *Innocence of Muslims*, and Garcia received multiple death threats.<sup>100</sup>

Seeking to minimize the film's visibility online, Garcia ultimately filed suit in the United States District Court for the Central District of California naming Google and the film's director as co-defendants.<sup>101</sup> Garcia alleged copyright infringement against both

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<sup>94</sup> *Garcia*, 766 F.3d at 936. An agreement, purported to be signed by Garcia that transferred all her rights in her performance to the film's producers, was introduced in the district court but Garcia challenged its authenticity; the district court didn't address the agreement or its authenticity. *Id.* at 936 n.5.

<sup>95</sup> *Garcia v. Google, Inc.*, 786 F.3d 733, 737 (9th Cir. 2015).

<sup>96</sup> *Id.*

<sup>97</sup> *Id.*

<sup>98</sup> *Id.* at 737–38.

<sup>99</sup> *Id.* at 738.

<sup>100</sup> *Id.*

<sup>101</sup> *Id.*

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defendants and moved for a temporary restraining order; specifically, she sought to enjoin Google from hosting *Innocence of Muslims* on YouTube or other Google-run websites.<sup>102</sup> The district court ultimately denied Garcia's motion for a preliminary injunction, relying, in part, on its conclusion that Garcia failed to establish a likelihood of success on the merits of her copyright infringement claim.<sup>103</sup>

Initially, a divided Ninth Circuit panel found Garcia likely to succeed on her copyright infringement claim;<sup>104</sup> however, after the Ninth Circuit reviewed Garcia's claim en banc, the court then reversed its initial holding.<sup>105</sup> The en banc court found Garcia's copyright claim unlikely to succeed for two reasons, either of which would be sufficient on its own: Garcia's performance was not a "work of authorship," and Garcia's performance was not fixed by her or under her authority.<sup>106</sup>

1. Constitutional authorship

While Garcia claimed her acting performance as a work of authorship because it manifested "some minimal level of creativity or originality," the en banc court rejected that standard.<sup>107</sup> The court turned to its earlier decision in *Aalmuhammed v. Lee* as a "useful foundation" for evaluating Garcia's claims on this point.<sup>108</sup> The court held that, as in *Aalmuhammed*, such a low bar for defining works of authorship must be rejected because

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<sup>102</sup> *Id.*

<sup>103</sup> *Id.*

<sup>104</sup> Garcia v. Google, Inc., 766 F.3d 929, 940 (9th Cir. 2014), on *reh'g en banc*, 786 F.3d 733 (9th Cir. 2015).

<sup>105</sup> *Id.* at 740–44.

<sup>106</sup> *Id.* at 742–44.

<sup>107</sup> *Id.* at 742.

<sup>108</sup> *Id.*

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it “would be too broad and indeterminate to be useful” and would “fragment copyright protection” of movies and other large creative projects.<sup>109</sup>

While the court was clear about both the standard it rejects and the fear prompting that rejection, the court ultimately failed to articulate the work of authorship definition Garcia’s claim should be evaluated under. Instead, the court concluded its rejection of Garcia’s acting performance as a work of authorship with the policy statement that “Garcia’s theory of copyright law would result in the legal morass we warned against in *Aalmuhammed*.”<sup>110</sup> The failure to articulate a work of authorship definition can be read as the court’s categorical exclusion of acting performances from qualifying as works of authorship.

Unfortunately, *Aalmuhammed* served as a very weak foundation for an evaluation of Garcia’s copyright claims, as the en banc opinion got *Aalmuhammed*’s facts, holdings, and policy concerns wrong. The en banc court characterized *Aalmuhammed* as a case that examined the definition of what constituted a “work” for purposes of the Copyright Act; however, the real issue at stake was the definition of “joint work.”<sup>111</sup> Jefri Aalmuhammed, a consultant working on the movie *The Autobiography of Malcolm X*, claimed joint authorship of the movie based on his contributions to the film.<sup>112</sup> Accepting Aalmuhammed’s claims as true, since the issue was before the court on motion for summary judgment, the court recognized that Aalmuhammed’s rewriting of several

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<sup>109</sup> *Id.*

<sup>110</sup> *Id.* at 742.

<sup>111</sup> *Aalmuhammed v. Lee*, 202 F.3d 1227, 1230 (9th Cir. 2000).

<sup>112</sup> *Id.* at 1229–30.

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passages of dialogue and creating an original scene constituted “works” that were independently copyrightable.<sup>113</sup>

Having misunderstood the issue before the court in *Aalmuhammed*, the *Garcia* en banc court correctly credited *Aalmuhammed* as defining a “work” based upon “some minimal level of creativity or originality . . . too broad and indeterminate to be useful.”<sup>114</sup> Although the en banc opinion did not indicate any abridgement of its *Aalmuhammed* quote, *Aalmuhammed* actually held that such a definition “would be too broad and indeterminate to be useful *if applied to determine who are ‘[joint] authors’ of a movie.*”<sup>115</sup> Far from rejecting the minimal level of creativity standard for determining when something may be considered a work of authorship, the *Aalmuhammed* court explicitly affirmed the minimal level of creativity test as the applicable standard in most, if not all, contexts outside of joint authorship claims.<sup>116</sup>

The en banc court also misstated the policy concerns of the *Aalmuhammed* court.<sup>117</sup> Although the en banc court stated *Aalmuhammed* warned about the legal morass of splintering a movie into many different works,<sup>118</sup> no party in *Aalmuhammed* attempted to claim part of *The Autobiography of Malcolm X* as an independent work.<sup>119</sup> All parties agreed their contributions merged into a single work; it was the status of that undivided interest that was at issue.<sup>120</sup>

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<sup>113</sup> *Id.* at 1231.

<sup>114</sup> *Garcia v. Google, Inc.*, 786 F.3d 733, 742 (9th Cir. 2015).

<sup>115</sup> *Aalmuhammed*, 202 F.3d at 1233 (emphasis added).

<sup>116</sup> *Id.* at 1232.

<sup>117</sup> *See Garcia*, 786 F.3d at 742.

<sup>118</sup> *Id.*

<sup>119</sup> *Aalmuhammed*, 202 F.3d at 1232.

<sup>120</sup> *Id.*

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*Aalmuhammed*, correctly read, clearly calls for the application of, and not the rejection of, the minimal level of creativity test to Garcia's claim. Applying that test, it is hard to argue that an acting performance is so devoid of creativity as to render it not a work of authorship in the constitutional sense.<sup>121</sup> No analysis of acting performances as statutory works of authorship was presented by the *Garcia* court, but the fixation requirement was also held to bar Garcia's claim.<sup>122</sup>

2. Fixation

The *Garcia* court found firmer analytical footing when it applied the fixation requirement, as the court clearly articulated the standard it applied.<sup>123</sup> As fixation must occur "by or under the authority of the author" for a copyright interest to be recognized,<sup>124</sup> the court first evaluated whether Garcia was an author. In defining "author," the court noted that "[a]ccording to the Supreme Court, 'the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.'"<sup>125</sup> Finding that "Garcia did nothing of the sort," the court held she was not an author and thus was incapable of satisfying the fixation requirement.<sup>126</sup>

Despite having adopted an author definition that would categorically exclude Garcia, the en banc court also held that *Innocence of Muslims* was not fixed "by or under

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<sup>121</sup> See *Garcia v. Google, Inc.*, 766 F.3d 929, 934 (9th Cir. 2014), on *reh'g en banc*, 786 F.3d 733 (9th Cir. 2015) (stating that an actor's creative embodiment of her role includes "body language, facial expression and reactions to other actors and elements of a scene.").

<sup>122</sup> *Garcia*, 786 F.3d at 743–44.

<sup>123</sup> *Id.* Although the court cites to 17 U.S.C. § 101 as the source of the fixation requirement, only the definition of fixation is found there. As noted earlier, the fixation requirement is found in 17 U.S.C. § 102(a).

<sup>124</sup> 17 U.S.C. § 102(a) (2010).

<sup>125</sup> *Garcia*, 786 F.3d at 744 (quoting *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989)).

<sup>126</sup> *Id.*



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[Garcia's] authority."<sup>127</sup> The court reasoned that fixation could not have occurred under Garcia's authority because "Garcia claims that she never agreed to the film's ultimate rendition or how she was portrayed in *Innocence of Muslims*."<sup>128</sup>

In its fixation analysis, the en banc court's reasoning again suffered from the truncation of quoted precedent. The Supreme Court's holding that "the author is the party who actually creates the work" is prefaced with the introductory clause: "As a general rule[.]"<sup>129</sup> By omitting this qualification, the en banc opinion converted a default rule into an absolute.

"Author" cannot have such an absolute definition though, as the fixation requirement is satisfied when a work is embodied "by or under the authority of the author."<sup>130</sup> An absolute requirement that an author be the party who translates an idea into a fixed form would render the statutory language that a work may be fixed "under the authority of the author" a nullity. The inadequacy of the en banc court's author definition was recognized by the court when it went on to evaluate whether Garcia's performance might be considered as fixed under her authority, despite already holding she was not an author.<sup>131</sup>

The court's reasoning on whether Garcia's performance was fixed under her authority was also flawed, as it improperly weighed Garcia's claim of fraud and evaluated the wrong work.<sup>132</sup> A party who induced Garcia to allow fixation of her performance under

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<sup>127</sup> *Id.* (citing 17 U.S.C. § 101).

<sup>128</sup> *Id.*

<sup>129</sup> *Reid*, 490 U.S. at 737 ("As a general rule, the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection. § 102.").

<sup>130</sup> 17 U.S.C. § 101 (2010).

<sup>131</sup> *See Garcia*, 786 F.3d at 743–44.

<sup>132</sup> *See Garcia*, 786 F.3d at 744.

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her authority would be estopped from later claiming their fraudulent inducement vitiated her consent, rendering the fixation as not being under her authority.<sup>133</sup> However, the question of fraud may not ultimately be relevant to Garcia's fixation claim when the proper work is considered.

Although *Innocence of Muslims* was the film that Garcia claimed infringed her copyright, *Innocence of Muslims* is not the film Garcia would argue was fixed under her authority. A proper analysis of the fixation question must regard *Innocence of Muslims* as a derivative work of the aborted *Desert Warrior* film; therefore, any fraud involved in the production of *Innocence of Muslims* would not properly enter a fixation analysis.

Unlike the work of authorship requirement, where precedent clearly favors recognizing Garcia's acting performance as a work of authorship in the constructional sense, the fixation requirement, properly analyzed, does not necessarily favor Garcia. A full analysis of Garcia's fixation claim is beyond the scope of this Comment,<sup>134</sup> but it is important to consider how both the court's work of authorship analysis and fixation analysis are deeply flawed. The source of these flaws seems apparent: the court was not engaged in the application of precedent as much as the application of policy.

*B. 16 Casa Duse, LLC v. Merkin*

In *16 Casa Duse, LLC v. Merkin*, a director claimed an independent copyright interest in his directorial contributions to a film.<sup>135</sup> The Second Circuit, in a panel decision,

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<sup>133</sup> See RESTATEMENT (SECOND) OF TORTS § 894 (2nd 1979).

<sup>134</sup> Such an argument is made by Judge Kozinski in dissent, relying heavily on the Register of Copyrights being a signatory to the Beijing Treaty on Audiovisual Performances treaty that provides that "performers" have the "exclusive right of authorizing . . . the fixation of their unfixed performances." *Garcia*, 786 F.3d at 751 (Kozinski, J., dissenting).

<sup>135</sup> *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 255 (2d Cir. 2015).

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upheld the trial court's grant of summary judgment against the director's copyright claim.<sup>136</sup> In rejecting the director's copyright claim, the court echoed the *Garcia* court's fear of "[making] Swiss cheese of copyrights"<sup>137</sup> and, as with the analysis presented in *Garcia*, that fear was, at times, allowed to stand in the place of consistent legal reasoning.

After the production company, 16 Casa Duse, LLC, acquired the rights to a screenplay entitled *Heads Up*, it engaged Alex Merkin to direct a short film based on the screenplay.<sup>138</sup> Prior to filming, Merkin and all other crew members were asked to sign agreements stating 16 Casa Duse would "engage the services [of the cast or crew member] as 'work for hire' of an independent contractor. . . ."<sup>139</sup> Merkin, alone, did not sign the requested agreement.<sup>140</sup> Although Merkin acknowledged receipt of the agreement, he did not return a signed agreement at that time and did not respond to three later requests from 16 Casa Duse to execute the agreement.<sup>141</sup>

Despite 16 Casa Duse's failure to execute a work-for-hire agreement with Merkin, it allowed the production to go forward with Merkin acting as director.<sup>142</sup> During the three days of shooting, "Merkin performed his role as director by advising and instructing the film's cast and crew on matters ranging from camera angles and lighting, to wardrobe and makeup, to the actors' dialogue and movement."<sup>143</sup> After shooting concluded, 16 Casa Duse and Merkin continued to work together on the project.<sup>144</sup>

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<sup>136</sup> *Id.* at 259.

<sup>137</sup> *Id.* at 258 (quoting *Garcia*, 786 F.3d at 742).

<sup>138</sup> *Id.* at 251.

<sup>139</sup> *Id.*

<sup>140</sup> *Id.*

<sup>141</sup> *Id.*

<sup>142</sup> *Id.*

<sup>143</sup> *Id.*

<sup>144</sup> *Id.* at 251–52.

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16 Casa Duse engaged Merkin to edit the raw film footage, and the parties entered into a “Media Agreement” under which Merkin would edit but not license, sell, or copy the footage for any purpose without the permission of 16 Casa Duse.<sup>145</sup> Over the next five months, the parties negotiated proposed alterations to the Media Agreement and abelated work-for-hire agreement, but their negotiations and relationship deteriorated.<sup>146</sup>

Finally, Merkin purported to deny 16 Casa Duse permission to “use [his] work in any edit without [his] involvement[,]” and Merkin threatened to contact film festivals to inform them that 16 Casa Duse lacked rights to the film if 16 Casa Duse finished the short film without his involvement.<sup>147</sup> When Merkin followed through on his threat, causing the New York Film Academy to cancel a screening of *Heads Up*, 16 Casa Duse filed an action seeking, in part, a declaratory judgment that Merkin did not possess any copyright interest in the film.<sup>148</sup>

1. Statutory authorship

The court rejected Merkin’s claimed copyright interest in his directorial contribution.<sup>149</sup> While the court appeared to assume Merkin’s contribution met the constitutional threshold of originality, the court found his contribution failed to meet the statutory “work of authorship” threshold.<sup>150</sup> Directorial contributions, being non-freestanding, were held not to be “works of authorship” and thus not capable of supporting

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<sup>145</sup> *Id.* at 252.

<sup>146</sup> *Id.*

<sup>147</sup> *Id.*

<sup>148</sup> *Id.* at 253.

<sup>149</sup> *Id.* at 256–59.

<sup>150</sup> *Id.*

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a copyright claim.<sup>151</sup> The court found this position to be supported by the Copyright Act's example list of works of authorship, definitions, and history.<sup>152</sup>

a. Statutory examples of works of authorship

No references to contributions appear in the Copyright Act's list of example works of authorship,<sup>153</sup> and the court found this to be a meaningful omission.<sup>154</sup> Although the list is recognized as non-exhaustive, the examples given by the Copyright Act nonetheless represent a limit, albeit a fuzzy one, on what may be considered copyrightable subject matter.<sup>155</sup> The *16 Casa Duse* court attempted to police this fuzzy boundary by listening for discordant notes and held that categories of creative efforts not "similar [ ] or analogous to any of the listed categories" are unlikely to be themselves regarded as works of authorship.<sup>156</sup>

While the court moved directly from stating the need to compare claimed works to the example works of authorship, implicit in the court's analysis, although unacknowledged in its opinion, was an understanding that creative efforts must first be extrapolated into abstractions before they can be compared for anything other than literal similarity.<sup>157</sup> This process of abstraction was what the court engaged in when it sought to identify some feature common to all the example works; a feature which, in turn, other

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<sup>151</sup> *Id.*

<sup>152</sup> *Id.* at 257.

<sup>153</sup> 17 U.S.C. § 102(a) (2010).

<sup>154</sup> *16 Casa Duse v. Merkin*, 791 F.3d 247, 256 (2d Cir. 2015).

<sup>155</sup> *Id.*

<sup>156</sup> *Id.* (quoting *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 846 (2d Cir. 1997)).

<sup>157</sup> The need to create abstractions of works in order to identify non-literal similarities between works has been explicitly, and often eloquently, acknowledged in earlier Second Circuit precedents. *See e.g.*, *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706–12 (2d Cir. 1992); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930). Although the need to compare works most often arises in the context of evaluating substantial similarity when an infringement claim has been made, abstraction is also necessary when two categories of works are being compared for similarities.

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creative efforts must also possess to be considered similar to the example works. This is an important step to make explicit in the court's reasoning because how widely or narrowly an abstraction of a work is construed and which features are identified as essential to that abstraction will determine the results of any later comparisons.

Although not stated explicitly in these terms, the court identified an essential characteristic shared by all of the example works: the example works are not constituent parts of other works.<sup>158</sup> As this characteristic was identified by the court as being an essential one, no creative effort that is a constituent part of another work could be regarded as similar to any of the example works. The court concluded its analysis of the example works of authorship by stating the example list “suggests that non-freestanding contributions to works of authorship are not ordinarily themselves works of authorship.”<sup>159</sup>

The sudden pivot from reasoning regarding “contributions” to a holding limited to “non-freestanding contributions” can be explained by judicial restraint, but this pivot also obfuscates inconsistencies between the court's reasoning and other provisions of the Copyright Act. As the court's analysis provides no reason to treat freestanding contributions differently from non-freestanding contributions, its holding must be regarded as supporting the more general proposition that “contributions to works of authorship are not ordinarily themselves works of authorship.” Such a broad presumption runs contrary to the work for hire doctrine, which applies to “works” commissioned for use “as a contribution to a collective work” and “as a part of a motion picture.”<sup>160</sup>

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<sup>158</sup> See *16 Casa Duse*, 791 F.3d at 257 (“But the Act lists none of the constituent parts of any of [the example works] as ‘works of authorship.’”).

<sup>159</sup> *Id.* at 257. Although the court draws a distinction between freestanding and non-freestanding contributions, no definition for “freestanding” or “non-freestanding” are provided by the court.

<sup>160</sup> See 17 U.S.C. § 101 (2010). See also discussion *supra* Part II.C.

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If contributions to other works are presumed not to be works themselves, it is unclear what, if anything, could be considered a “work” commissioned for use as part of a motion picture. The work for hire doctrine cannot itself resolve this contradiction by rebutting a presumption that contributions are not considered works in the context of movies. This is because the doctrine is only a mechanism for affecting a change in who is regarded as the author of a work; not for affecting a change as to what is regarded as a work.<sup>161</sup> Further inconsistencies with the court’s holding also arise in the context of joint and collective works, as became apparent from the court’s analysis of the Copyright Act’s definitions of “joint work” and “collective works.”<sup>162</sup>

#### b. Statutory definitions that reference contributions

References to contributions appear three times in the Copyright Act’s definition section: in the definition for “joint works,” in the definition for “collective work,” and in the definition for “work made for hire.”<sup>163</sup> The *16 Casa Duse* court found support for its position in the first two references but failed to address the third.<sup>164</sup>

Under the joint works definition, a joint work is one prepared by multiple authors “with the intention that their *contributions* be merged into inseparable or interdependent parts of a unitary whole.”<sup>165</sup> To the court, the Copyright Act’s failure to describe the contribution each coauthor makes as being a “work” suggested that “such inseparable contributions are not themselves ‘works of authorship.’”<sup>166</sup>

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<sup>161</sup> See § 101. See also discussion *supra* Part II.

<sup>162</sup> See *16 Casa Duse*, 791 F.3d at 257–58.

<sup>163</sup> See § 101.

<sup>164</sup> *16 Casa Duse*, 791 F.3d at 257–58.

<sup>165</sup> § 101 (emphasis added). See also discussion *supra* Part II.B.

<sup>166</sup> *16 Casa Duse*, 791 F.3d at 257.

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Again, the sudden pivot from reasoning regarding “contributions” to a holding limited to “inseparable contributions” obfuscates problems in the court’s reasoning. As the constituent parts of both interdependent and inseparable joint works are described as contributions, if the reference to contributions is held to be significant, it must be regarded as significant when applied both to interdependent and inseparable contributions. Therefore, if the court’s reasoning is applied consistently, both inseparable and interdependent contributions would be regarded as “not ordinarily themselves works of authorship.” Such a formulation would again render part of the work for hire doctrine a nullity. As explained in Part II.C, the language of “work specially ordered or commissioned for use . . . as a part of a motion picture or other audiovisual work” would be mere surplusage in the work for hire definition unless that language applied to inseparable and interdependent contributions to movies. If both inseparable and interdependent contributions are not ordinarily works of authorship, it is unclear how a work commissioned to be used as part of a motion picture could be considered a work under the work for hire doctrine.

The court next turned to the definition of collective works for support.<sup>167</sup> Under the collective work definition, a collective work is one that assembles “a number of contributions” each of which “[constitutes] separate and independent works in themselves . . . .”<sup>168</sup> The court read this definition as containing a “requirement that contributions be ‘separate and independent’ in order to obtain their own copyright protection . . . .”<sup>169</sup> That

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<sup>167</sup> *Id.*

<sup>168</sup> 17 U.S.C. § 101 (2010).

<sup>169</sup> *16 Casa Duse*, 791 F.3d at 257.



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presumed requirement is then held to indicate “that inseparable contributions integrated into a single work cannot separately obtain such protection.”<sup>170</sup>

While not explicitly stated, the court’s reading of the collective work definition may also serve as the basis for the distinction it earlier attempted to draw between non-freestanding and freestanding contributions. If the reference to contributions that are sufficiently separate and independent to constitute works in themselves is taken to rebut the normal presumption that contributions are not to be themselves considered works, then freestanding contributions may justifiably be treated differently. If this deduction is correct, then a freestanding contribution must both be freestanding in terms of fixation and freestanding in terms of meaning; in effect, it must be a separate work.

This distinction is unavailing though as the court’s reading of the collective work definition suffers from an association fallacy. Although the Copyright Act requires that a collective work be comprised of contributions that constitute separate and independent works,<sup>171</sup> it does not follow that all expression capable of being recognized as a work must be separate and independent. Again, the work for hire doctrine is instructive. As the doctrine applies both to works “specially ordered or commissioned for use as a contribution to a collective work” as well as to works “specially ordered or commissioned for use . . . as a part of a motion picture,”<sup>172</sup> the Copyright Act’s conception of a work cannot be as limited as the *16 Casa Duse* court concluded.

c. Reference to motion pictures in the House Report

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<sup>170</sup> *Id.*

<sup>171</sup> *See* § 101 (“collective work” definition).

<sup>172</sup> § 101 (“work made for hire” definition).

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Finally, the court looked to the legislative history of the Copyright Act for support.<sup>173</sup> Specifically, the court notes that the House Report on the 1976 Act stated:

[A] motion picture would normally be a joint rather than a collective work with respect to those authors who actually work on the film, although their usual status as employees for hire would keep the question of coownership from coming up. On the other hand, although a novelist, playwright, or songwriter may write a work with the hope or expectation that it will be used in a motion picture, this is clearly a case of separate or independent authorship rather than one where the basic intention behind the writing of the work was for motion picture use.<sup>174</sup>

From this, the court concluded that Congress did not intend for contributions to a motion picture to qualify for independent copyright interests “unless the motion picture incorporates separate, freestanding pieces that independently constitute ‘works of authorship.’”<sup>175</sup> Such an argument can only be understood as an attempt to justify a desired outcome, as it represents a cherry picking of arguments from the House Report that are inconsistent with the view of motion pictures the *16 Casa Duse* court expresses elsewhere.<sup>176</sup>

Although joint works may be made up of either interdependent or inseparable contributions, the section of the House Report the court quotes from provides motion pictures as an example of interdependent works.<sup>177</sup> It is only by excluding consideration of inseparable contributions that a dichotomy between joint and collective works makes sense; as interdependent joint works and collective works share the feature of being made

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<sup>173</sup> See *16 Casa Duse*, 791 F.3d at 257.

<sup>174</sup> *Id.* (quoting H.R. REP. NO. 94-1476, at 120 (1976)).

<sup>175</sup> *Id.*

<sup>176</sup> See *id.* at 258.

<sup>177</sup> See H.R. REP. No. 94-1476, at 120 (1976) (motion pictures are provided as an example of interdependent joint works). The House Report’s inconstancy on recognizing inseparable contributions, such as those made by directors, is discussed in Part II.B.

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up of separable contributions, the classification of a work as being either joint or collective would only be dependent on the relationship the contribution has to the larger work.<sup>178</sup> However, the *16 Casa Duse* court takes a more expansive view of motion pictures elsewhere, recognizing they can be comprised of both separable and inseparable contributions, when it states that a “director of a film may, of course, be the sole or joint author of that film.”<sup>179</sup>

Alternatively, if the House Report’s dichotomy of motion pictures as being either joint or collective works is assumed to encompass inseparable joint works, the quoted passage’s reference to the work for hire doctrine would directly conflict with the *16 Casa Duse* court’s exclusion of contributions from being regarded as works.<sup>180</sup> If contributors’ “usual status as employees for hire would keep the question of coownership from coming up” and contributors are assumed to include those making inseparable contributions, then inseparable contributions must be regarded as works or the work for hire doctrine would not apply to them.<sup>181</sup>

#### IV. NOTHING TO FEAR

In shrinking the subject matter of copyright down to a sufficiently small size so that inseparable contributions are no longer within its scope, the *Garcia* and *16 Casa Duse* decisions radically alter copyright law: *Garcia* by raising the originality threshold, and *16 Casa Duse* by excluding all contributions from being considered works.<sup>182</sup> Yet, such

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<sup>178</sup> See Table 1 *supra* Part II.

<sup>179</sup> *16 Casa Duse*, 791 F.3d at 258.

<sup>180</sup> See *id.* at 257.

<sup>181</sup> 17 U.S.C. § 101 (2010) (“work made for hire” definition).

<sup>182</sup> See discussion *supra* Part III.

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radical changes are not necessary because the fixation requirement and the doctrine of implied licenses can alleviate many of the Swiss cheese fears.

#### *A. Fixation as a Gatekeeper*

Although the *Garcia* court's analysis of the fixation requirement was flawed,<sup>183</sup> the fixation requirement provides future courts a narrower and better-established ground upon which to evaluate copyright claims inseparable contributions. Whether authors who intend neither to merge their inseparable contributions into a joint work nor to designate their inseparable contributions as works for hire authorize the fixation of their contributions such that fixation occurs "under their authority" is a question that deserves close scrutiny. The resolution of that question is beyond the scope of this Comment, but should courts recognize the authorization of fixation under those circumstances as amounting to fixation occurring under the contributor's authority, it does not follow that a contributor would necessarily prevail on an infringement claim. One who authorized another to fix their inseparable contribution would also likely be found to have granted an implied license for the party undertaking the fixation to make use of the contribution.

#### *B. Implied Licenses as a Gatekeeper*

While a transfer of copyright ownership must typically be in writing to be effective,<sup>184</sup> the granting of a non-exclusive license is not regarded as a "transfer of copyright ownership."<sup>185</sup> Therefore, while an exclusive license may not be implied from conduct, a non-exclusive license may be inferred when a party's conduct indicates an

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<sup>183</sup> See discussion *supra* Part III.A.2.

<sup>184</sup> 17 U.S.C. § 204(a) (1976).

<sup>185</sup> § 101 ("transfer of copyright ownership" definition).

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intention to grant another a license to use its work. Implied licenses to use copyrighted works have been recognized by both the Second Circuit<sup>186</sup> and the Ninth Circuit.<sup>187</sup>

While resolving claims of copyright interests to inseparable contributions to motion pictures on the basis of implied non-exclusive licenses would not keep the copyright interest in a motion picture concentrated in a single entity, such an objective is misguided. The holes in a movie's copyright interest should not be feared for their own sake, but because of the friction they may cause in the licensing and performance of the motion picture. Even though a contributor may retain a copyright interest in his or her contribution, an implied license lubricates any friction that holes in a movie's copyright interest might otherwise have caused.<sup>188</sup> While producers of motion pictures have non-exclusive licenses that allow them to make use of motion pictures, contributors cannot similarly make use of motion pictures because even though they still retain a right to their contributions, motion pictures are comprised of other elements they are not authorized to make use of.

Implied licenses would also free courts from the straightjacket of binary interests the *Garcia* and *16 Casa Duse* courts contorted themselves into. Instead of having to resolve claims of copyright interest in inseparable contributions by resolving the status of all

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<sup>186</sup> See *Graham v. James*, 144 F.3d 229, 236 (2d Cir. 1998) (programmer, who coded a program at the request of a CD-ROM marketer, found to have impliedly granted the marketer a non-exclusive license to use the program on the CD-ROMs that were being sold); *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82, 93 n.15 (2d Cir. 1998) (in dicta the court states "we may assume that the authors of the articles, by submitting them to their newspaper publishers, gave the publishers an implied license to use the articles in the newspaper compilations").

<sup>187</sup> See *Foad Consulting Grp., Inc. v. Azzalino*, 270 F.3d 821, 828–31 (9th Cir. 2001) (engineering firm, which drafted a plot plan for shopping center project at the request of developer, found to have impliedly granted developer non-exclusive license to reproduce, adapt, and publish the plot plan in conjunction with the shopping center development); *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990) (special effects company, which created footage at request of moviemaker, found to have impliedly granted moviemaker non-exclusive license to incorporate footage into movie).

<sup>188</sup> See 2 WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 5:17 (2018) ("The correct approach to resolving the situation where an individual . . . contributes expression to a work but is found not to be a joint author is to find an implied license.").

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potential copyright claims in inseparable contributions, an implied license analysis would free courts to make individualized inquiries into the evidence revealing the intent of the parties and the scope of any license that is found to exist.

Although, as both courts observe,<sup>189</sup> implied licenses are not a perfect solution for one seeking to concentrate the copyright interest in a movie in a single party, neither court provides a reason why courts should rescue parties who fail to contract for the copyright interest they desire under the work for hire doctrine. Resolving these claims by finding implied licenses would not only prevent the alteration of copyright law, but it would also be consistent with courts' traditional refusal to rescue litigants who failed to contract for the copy.

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<sup>189</sup> See *Garcia v. Google, Inc.*, 786 F.3d 733, 743 (9th Cir. 2015) (“Third-party content distributors, like YouTube and Netflix, won’t have easy access to the licenses; litigants may dispute their terms and scope; and actors and other content contributors can terminate licenses after thirty five years”); *Casa Duse, LLC v. Merkin*, 791 F.3d 247, 259 n.5 (2d Cir. 2015) (“[T]here are at least some circumstances in which the implied license approach may not permanently resolve the dispute.”).