

## Cheddar, Not Swiss: A Director's Interest in Copyright

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## I. INTRODUCTION

Imagine a world in which authors were denied ownership of their creative work after investing their time and energy, with the credit instead being given to their editor or publisher. It would be unconscionable. Similarly, imagine a world in which songwriters did not own the songs they wrote, but instead the copyright went to the sound mixer. The results seem unpalatable—because they go against human intuition and are supposed to be legally prohibited through the protection of copyright law. Nonetheless, a version of the previous scenario is what happened to the film director in *16 Casa Duse, LLC v. Merkin*.<sup>1</sup> After creating the film “Heads Up,” the Second Circuit denied the film director any copyright interest or protection.<sup>2</sup> This comment analyzes the legal implications of the holding in the case *16 Casa Duse, LLC v. Merkin*, which was one of first impression for the Second Circuit.

Part II sets forth the history and expansion of the copyright statute. Part III provides the facts from the case of *16 Casa Duse, LLC v. Merkin*. Part IV addresses the standard of joint authorship. Part V then examines why a director’s contribution to a film is a work of authorship because it is a writing that is original to the author, that is fixed in a tangible medium. Part VI suggests that the Second Circuit decision was influenced by unfounded fears due to the work made for hire doctrine. Finally, Part VII concludes with a plain reading of the copyright statute and application to the case at hand.

## II. THE REQUIREMENTS OF COPYRIGHT PROTECTION AND ITS CONTINUED EXPANSION

Since copyright law began in America, it has sought to protect creative works while also fostering creativity and progress. As the law developed, it furthered these aims by being expansive and continuously widening its breadth of coverage. The first copyright law enacted in 1790 was an exercise of Congress’s constitutional power, “[t]o promote the Progress of Science and useful Arts, by securing the limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>3</sup> The Copyright Act provides creators protection by giving them certain exclusive rights such as the right;

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<sup>1</sup> *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 254 (2d Cir. 2015).

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

<sup>3</sup> U.S. CONST. art. I, § 8, cl 8.

(1) to reproduce, (2) to create derivative works, (3) to distribute copies to the public by sale or other means, (4) to perform publicly, and (5) to display publicly.<sup>4</sup> Copyright protection has expanded to include protection for new technologies, industries and business relationships through new enactments and revisions by Congress<sup>5</sup> along with Supreme Court interpretations.<sup>6</sup> As a result, the types of works that are entitled to protection has grown and expanded.

A work must meet two fundamental criteria to benefit from the statute's protection; it must be an original work of authorship and be fixed in a tangible medium.<sup>7</sup> Beyond these two threshold requirements, the Act maintains wide coverage by requiring only minimal levels of creativity, or aesthetic merit, rather than applying a heightened standard.<sup>8</sup> Therefore, the prerequisites to receive protection do not prevent room for broad coverage or the possibility to expand over time as technology and creativity continue to grow.

The first requirement that a work must meet to be under the purview of the copyright statute is that it is an original work of authorship.<sup>9</sup> The Act does not set forth a specific definition for an original work of authorship and includes a non-exhaustive list that courts interpret broadly.<sup>10</sup> In fact, there has been a great expansion in the definition of a work of authorship since the adoption of copyright protection in America. At the time of adoption, the first copyright statute only gave protection to, “map[s], chart[s], . . . or books.”<sup>11</sup> It was not until later enactments that works such as music and drama became included in the Act even though these forms of expression were clearly present well before their authorship was recognized. Through each enactment, the Act has become broader in coverage—from the original list of protected works.<sup>12</sup> The statute currently includes: (1)

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<sup>4</sup> 17 U.S.C. § 106 (2015).

<sup>5</sup> H.R. REP. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659.

<sup>6</sup> In *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884), the Supreme Court recognized that photographers receive copyright protection in their photographs. Copyright was created as a matter of law in the photo because of the choices and arrangement selections made, even though photographs were not listed in the statute. Photographs were not listed because photography as an art was then unknown, due to the fact that the science and chemistry behind it was not in existence. Then, in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), the Supreme Court gave copyright protection to circus advertisements, stating that commercial use did not remove an illustration from the fine arts category.

<sup>7</sup> 17 U.S.C. § 102 (2015).

<sup>8</sup> H.R. REP. 94-1476, at 51 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664.

<sup>9</sup> § 102.

<sup>10</sup> *Id.*

<sup>11</sup> *Wheaton v. Peters*, 33 U.S. 591, 660 (1834).

<sup>12</sup> *Id.*

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>13</sup> The Act is even broader than a facial reading may suggest since the Act's use of the word "include" makes clear that the listing is illustrative and not limitative, meaning that although eight works are explicit in the statute, other works not listed are also eligible as works of authorship.<sup>14</sup> Since its inception, the Act's coverage has been continuously expanding the meaning of what constitutes a work of authorship. In light of both Congress's and the courts' interpretation of the Act, expansion of what forms of expression receive protection should continue as new ways of expression are constantly being created and have much faster publication abilities.

The second requirement for a work to be copyrighted is that it must be fixed in a tangible medium.<sup>15</sup> This prerequisite is also interpreted broadly; a work can be "fixed in any tangible medium of expression, now known or later developed."<sup>16</sup> This language suggests that the requirement that a work is "fixed" is an opened-ended category, which can be satisfied by many options including those that do not currently exist.<sup>17</sup> As the statute itself states; "Under the bill it makes no difference what the form, manner, or medium of fixation may be . . . whether embodied in a physical object in written, printed, photographic, sculptural, punched, magnetic, or any other stable form;" as long as it is fixed, it is eligible for statutory protection.<sup>18</sup>

After a work qualifies for protection under the Copyright Act, there are still other factors that need to be examined for a creator to understand her rights completely under the Act. Other factors include how the work was created, who created it, and any contractual obligations, all of which will affect the author's rights. A work could be a solo work, a joint work with another author, or an independent work included in a collective work. The classification of the work affects the rights and copyright claims a creator can make if there are multiple authors.

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<sup>13</sup> § 102.

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

<sup>15</sup> *Id.*

<sup>16</sup> *Id.*

<sup>17</sup> *Id.*

<sup>18</sup> 17 U.S.C. § 103 (2015). See H.R. REP. 94-1476, at 52 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5665 (explaining the broad application of this requirement).

Sometimes even though a creative work is a work of authorship fixed in a tangible medium, the copyright protection does not vest with the author. Copyright might vest with someone other than the author when a work was created according to the “work made for hire” doctrine. The statute sets out two ways for a work to be considered a work made for hire: (1) the work is prepared by an employee within the scope of his or her employment, or (2) a work is specially ordered or commissioned.<sup>19</sup> If an employee prepares a work within the scope of employment, the copyright vests with the employer automatically; however, if it is a commissioned work then there must be a written document that expressly states the parties’ agreement that the work shall be considered a work made for hire.<sup>20</sup> Without such a written agreement, the owner of the work commissioned does not receive the copyright for the work created, but rather the author of the work receives the copyright.<sup>21</sup>

All these considerations came into play when the Second Circuit addressed a question of first impression in *16 Casa Duse, LLC v. Merkin*.<sup>22</sup> The court in that instance asked, “[m]ay a contributor to a creative work whose contributions are inseparable from, and integrated into, the work maintain a copyright interest in his or her contributions alone?”<sup>23</sup> The statute has multiple elements that a court must examine before deciding whether or not a creative work falls under the purview of the copyright statute. However, this comment contends that if a work meets all the required elements, and is neither a joint work nor a work made for hire, a court should not deny protection because of unfounded fears that copyright would become “Swiss cheese” with too many potential interests, when the statute has a history of being welcoming towards expansion.<sup>24</sup>

### III. CASE OF FIRST IMPRESSION FOR THE SECOND CIRCUIT: *16 CASA DUSE, LLC V. MERKIN*

On June 29<sup>th</sup>, 2015, the Second Circuit was faced with the challenge of deciding whether or not to expand protection of the Copyright Act to a director’s contribution to a film. The only

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<sup>19</sup> 17 U.S.C. § 101 (2015).

<sup>20</sup> *Id.*

<sup>21</sup> *Id.*

<sup>22</sup> *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 254 (2d Cir. 2015).

<sup>23</sup> *Id.*

<sup>24</sup> *Id.* at 258.

analogous case is *Garcia v. Google, Inc.*, decided in the Ninth Circuit.<sup>25</sup> In that case, the court addressed whether an actress has “an independently copyrightable contribution” to a motion picture.<sup>26</sup> In the Ninth Circuit, the panel hearing the case answered in the affirmative stating that the actress, Garcia, had established a copyright interest in the film “Innocence of Muslims.”<sup>27</sup> However, the decision was reversed en banc.<sup>28</sup>

The Second Circuit case centered around Alex Merkin (“Merkin”) a film director who relied on the Copyright Act to protect his creative work of directing a motion picture. The creative aspects of his work included, “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>29</sup> This creative work was *fixed* in the film “Heads Up” produced by film production company 16 Casa Duse, LLC (“Casa Duse”) who also looked to the Copyright Act to protect their contribution in the film.<sup>30</sup> However, the Second Circuit held that only Casa Duse’s contribution to the film constituted a copyrightable work.<sup>31</sup> This decision ripped away any protection and interest Merkin had and left him without any protection or claim to his creative work.<sup>32</sup> This result ignores the purpose of the Copyright Act to encourage creation and is based on unfounded fears. The court worried that giving directors, like Merkin, a copyright interest in their contributions, in an already recognized work of authorship would “make Swiss cheese of copyrights,” by having too many interests in one work.<sup>33</sup>

Robert Krakovski (“Krakovski”) owns and operates Casa Duse and in September 2010 he purchased the rights to the screenplay for “Heads Up” and soon after asked Merkin to direct the film.<sup>34</sup> Although other members of the film signed work for hire agreements that stated that Casa Duse would be the recipient of all the rights in the film

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<sup>25</sup> *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014), *overruled by* *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. 2015).

<sup>26</sup> *Id.* at 1262–63.

<sup>27</sup> *Id.* at 1268–69.

<sup>28</sup> An en banc panel of the 9<sup>th</sup> Circuit reversed its previous holding that a performance that exhibited at least a “minimal degree of creativity” engaged in an original act of authorship, for fear that such a holding would result in “[a] legal morass[,] . . . [making] Swiss cheese of copyrights.” *Garcia v. Google, Inc.*, 786 F.3d 733, 742 (9th Cir. 2015).

<sup>29</sup> *Casa Duse*, 791 F.3d at 251.

<sup>30</sup> *Id.*

<sup>31</sup> *Id.* at 259.

<sup>32</sup> *Id.*

<sup>33</sup> *Garcia*, 786 F.3d at 742.

<sup>34</sup> *Casa Duse*, 791 F.3d at 251.

including copyright, Merkin never signed such an agreement.<sup>35</sup> Krakovski had sent Merkin numerous requests to sign a “Director Employment Agreement” that required Merkin to sign away his rights in the films, but Merkin ultimately never signed one.<sup>36</sup> Despite failing to receive a proper work for hire agreement, Krakovski allowed Merkin to perform his role as director.<sup>37</sup> After Merkin had completed his work on the film and contributed his creative work, both parties attempted to negotiate an agreement.<sup>38</sup> Throughout the process, Merkin maintained that he was “not giving up any creative or artistic rights he had in the project and all of [his] creative work . . . is still [his] work and not the property of 16 Casa Duse, LLC.”<sup>39</sup>

Negotiations ultimately collapsed between the parties as Casa Duse did not want “Heads Up” to be a joint venture, and Merkin did not want to give up any of his rights.<sup>40</sup> In January 2012, without Casa Duse’s permission, Merkin asserted himself as the sole author.<sup>41</sup> He registered a copyright in the film as a motion picture with the United States Copyright Office and entitled the project “Raw Footage in the film ‘Heads Up.’”<sup>42</sup> Then in March 2012, as part of Krakovski’s plan to publicize the film, he started submitting “Heads Up” to various film festivals.<sup>43</sup> He scheduled a screening for seventy people at the New York Film Academy (NYFA) with a reception at a restaurant afterward, which cost him \$1,956.58.<sup>44</sup> In response, Merkin threatened to send a cease and desist order to the NYFA. The order led to the cancellation of the screening, the loss of Casa Duse’s restaurant deposit, and failure to secure any other film festival screenings.<sup>45</sup>

In the aftermath, Casa Duse filed suit against Merkin seeking a temporary restraining order and injunction enjoining Merkin from interfering with Casa Duse’s use of “Heads Up.”<sup>46</sup> The district court ultimately granted the restraining order and injunction.<sup>47</sup> Subsequently, Casa Duse filed an amended complaint requesting a judgment that declared that Casa Duse was not liable to Merkin for

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<sup>35</sup> *Id.*

<sup>36</sup> *Id.*

<sup>37</sup> *Id.*

<sup>38</sup> *Id.* at 252

<sup>39</sup> *Id.* (internal quotation marks omitted).

<sup>40</sup> *Casa Duse*, 791 F.3d at 252.

<sup>41</sup> *Id.* at 252–53.

<sup>42</sup> *Id.*

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* at 253.

<sup>45</sup> *Id.*

<sup>46</sup> *Casa Duse*, 791 F.3d. at 253.

<sup>47</sup> *Id.*

copyright infringement, Merkin did not own copyright interest in the film, and also requested that Merkin withdraw his copyright registration.<sup>48</sup> In response, Merkin filed an Amended Answer that included counterclaims that requested a judgment declaring that a motion picture director is an author, that the copyright statute has no provision for a merged work, that there could be no work for hire without an express writing, and finally that Merkin's copyright registration was valid.<sup>49</sup> Ultimately the district court found that Merkin could not copyright his creative contributions.<sup>50</sup> This comment contends that both decisions denied an author who created an original work of authorship that was fixed in a tangible medium of express copyright protection.

#### IV. SINCE NEITHER MERKIN NOR KRAKOVSKI INTENDED THEIR WORKS TO MERGE INTO ONE THEY ARE NOT JOINT AUTHORS

Not all creative works are going to have one author. Often, people will work collaboratively to create a new piece of work. Examples include co-authored novels and famous songwriting teams such as Robert Lopez and Kristen Anderson-Lopez, who wrote the award-winning song "Let It Go" for the film *Frozen*.<sup>51</sup> The Copyright Act has provided for this occurrence with its inclusion of the joint work provision. Under the Act, a joint work is defined 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."<sup>52</sup> The joint authorship provision gives each author an equal and undivided interest in the whole work.<sup>53</sup> Each joint author then receives the right to use or to license the work as they desire but he or she must provide the other joint author with any profits made from the use of that work.<sup>54</sup>

However, not all works that have multiple authors are recognized as works of joint authorship. To determine whether or not a work qualifies as a joint work, the Second Circuit uses a standard developed in *Childress v. Taylor*.<sup>55</sup> In that case, an actress claimed that her

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

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

<sup>50</sup> *Id.* at 255.

<sup>51</sup> *Robert Lopez Biography*, IMDB, [http://www.imdb.com/name/nm0520188/?ref=nm\\_ov\\_bio\\_lk1](http://www.imdb.com/name/nm0520188/?ref=nm_ov_bio_lk1) (last visited Jan. 23, 2016).

<sup>52</sup> 17 U.S.C. § 101 (2015).

<sup>53</sup> *Thomson v. Larson*, 147 F.3d 195, 199 (2d Cir. 1998).

<sup>54</sup> *Id.*

<sup>55</sup> *Childress v. Taylor*, 945 F.2d 500 (2d Cir. 1991).



contributions that were limited to providing research material to a play entitled her to joint authorship and shared rights to the play.<sup>56</sup> The elements of the test are that: (1) the contribution of each joint author must be copyrightable and (2) that the parties must have intended to be joint authors.<sup>57</sup> These requirements help protect authors from being denied exclusive authorship status because another person provided some form of assistance and minimal contribution that did not have any substantive bearing on the work.<sup>58</sup> It also provides safeguards to ensure that when equal rights are at stake, they are only reserved for relationships in which the participants fully intend to share those rights and do not end up forcing two unwilling partners to share ownership and rights on one piece of property.<sup>59</sup>

Although the *Childress* test seems to be straightforward, a problem arises when both authors have collaborated in some sense, but dispute whether or not there was a mutual intent to create a joint work.<sup>60</sup> However, based on the language of the statute which requires “with the intention that their contributions be merged,”<sup>61</sup> there must be some level of intent so that mere collaboration alone is not enough.<sup>62</sup> The court in *Erickson v. Trinity Theatre, Inc.* pointed out that requiring collaboration alone would affect the quality of work created as “[t]hose seeking copyrights would not seek further refinement that colleagues may offer if they risked losing their sole authorship.”<sup>63</sup> This risk would mean that creators would not seek out criticism or help in making their work better for fear of having to share ownership, which would be harmful to the world of creation.<sup>64</sup>

In the creation of “Heads Up,” Krakovski and Merkin automatically fail the second factor of the *Childress* test because neither party had the intent to merge their contributions.<sup>65</sup> Their lack of intent is evident by the failed negotiations between the two parties which stemmed from Krakovski’s efforts to get Merkin to sign a work for hire agreement and Merkin’s refusal sign away his rights.<sup>66</sup> Although Merkin’s contribution to the motion picture fails the

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<sup>56</sup> *Id.*

<sup>57</sup> *See Id.* at 507; *Thomson*, 147 F.3d at 199; *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1068–69 (7th Cir. 1994).

<sup>58</sup> *See Thomson*, 147 F.3d at 200; *Childress*, 945 F.2d at 509.

<sup>59</sup> *Childress*, 945 F.2d at 509.

<sup>60</sup> *Erickson*, 13 F.3d at 1068.

<sup>61</sup> 17 U.S.C. § 101 (2015).

<sup>62</sup> *Erickson*, 13 F.3d at 1068.

<sup>63</sup> *Id.* at 1069.

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

<sup>65</sup> *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 255 (2d Cir. 2015).

<sup>66</sup> *Id.* at 252.

*Childress* test and statutory requirement of intent, there are cases “in which the parties share a pre-concerted intent that their works be merged to form a unitary whole yet still do not contemplate that the result of their labors will be a work of joint authorship.”<sup>67</sup> That describes the situation here, where both parties, Casa Duse, and Merkin, were aware of the fact that the final product of their creative efforts would be a single motion picture, yet did not intend for their rights to become merged as joint authors.

In an extremely analogous case, the Second Circuit was asked to determine whether a dramaturge’s<sup>68</sup> contributions to a play, that were more than *de minimis*, qualified the dramaturge as an author of the copyrightable material.<sup>69</sup> In *Thomson v. Larson*, the dramaturge worked extensively on the script of the musical “Rent” with the original and well-known author Jonathan Larson.<sup>70</sup> The product of their work together was a new version of the script that was “characterized by experts as a radical transformation of the show.”<sup>71</sup> The court rejected the premise that Thomson, the dramaturge, was a joint author because of lack of intent evidenced by Larson’s sole decision-making authority and billing.<sup>72</sup> However, Thomson then went on to claim that in regard to copyrightable material, a co-created work should be separated into its components and that she had a copyright claim in her component.<sup>73</sup>

The dramaturge’s claims raised the question of, “whether a person who makes a *non-de minimis* copyrightable contribution but cannot meet the mutual intent requirement of co-authorship, retains, in the absence of a work-for-hire agreement or of any explicit contractual assignment of the copyright, any rights and interests in his or her own contribution.”<sup>74</sup> The Second Circuit was able to avoid answering that question on procedural grounds since Thomson did not raise the exclusive right argument until her appeal, thus leaving the question open until now.<sup>75</sup>

By denying Merkin a copyright interest in his creative contribution to “Heads Up,” the Second Circuit finally answered this question. However, this comment contends that the court erred in this

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<sup>67</sup> 1-6 NIMMER ON COPYRIGHT § 6.07[B] (2012).

<sup>68</sup> *Dramaturge*, OXFORD ONLINE DICTIONARY, (Nov. 2015), <http://www.oxforddictionaries.com>.

<sup>69</sup> *Thomson v. Larson*, 147 F.3d 195 (2d Cir. 1998).

<sup>70</sup> *Id.* at 197.

<sup>71</sup> *Id.* at 198 (internal quotation marks omitted).

<sup>72</sup> *Id.* at 205.

<sup>73</sup> *Id.* at 206.

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

<sup>75</sup> *Thomson*, 147 F.3d at 206.

decision. Even though Merkin and Casa Duse do not meet the precise intent elements of a joint work, Merkin should not be denied his copyright rights since “nothing in the Copyright Act suggests that a copyright interest in a creative contribution to a work simply disappears because the contributor doesn’t qualify as a joint author of the entire work.”<sup>76</sup>

The Second Circuit relied on only two lines of reasoning to make its decision. Its first reason focuses on the word “inseparable” in the definition of joint work in the Act. The court stated that the use of the word “inseparable” in the definition suggests that since the contributions themselves cannot be separated, they are not considered works of authorship.<sup>77</sup> The basis for this argument comes from another term defined in the Act, which is a “collective work.” A “collective work” is one in which a number of contributions, constituting separate and independent works in themselves are assembled into a collective whole.<sup>78</sup> The court reasoned that since a “collective work” requires each contribution to be separate and independent “in order to obtain their own copyright protection also indicates that inseparable contributions integrated into a single work cannot separately obtain such protection.”<sup>79</sup> In order to support this conclusion, the court relied on a House Report on the 1976 Copyright Act, which stated that motion pictures are *usually* a joint work.<sup>80</sup> However, the court did not mention that the same report also said that the question of copyrights in contributions in films does not typically arise because of the Work Made For Hire Doctrine.<sup>81</sup>

The reasoning of the court is flawed because it ignores the Work Made For Hire Doctrine, and also assumes that inseparable contributions are not independently copyrightable based on their entwined nature. Even though at the time the House Report was written it stated that separate copyrights do not exist in a film unless the motion picture incorporates separate, freestanding pieces that independently constitute “works of authorship,” significant time has passed since 1976.<sup>82</sup> Since then, copyright protection has expanded in a variety of areas due to the expansion of creativity and technology. Such

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<sup>76</sup> *Garcia v. Google, Inc.*, 743 F.3d 1258, 1263 (9th Cir. 2014), *overruled by* *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. 2015).

<sup>77</sup> *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 257 (2d Cir. 2015).

<sup>78</sup> 17 U.S.C. § 101 (2015).

<sup>79</sup> *Casa Duse*, 791 F.3d at 257.

<sup>80</sup> H.R. REP. 94-1476, at 120 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5736 (emphasis added).

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

<sup>82</sup> H.R. REP. 94-1476, at 122 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5737.

protection is bound to keep expanding further with the never-ending growth of today's technology and the use of the internet.<sup>83</sup> The law should continue to keep up with society's culture and technology. Expansion in protection is in line with the history and tradition of the Act. Additionally, if a work qualifies as a work of authorship, there should be no restriction on its protection just because it is intertwined with another work of authorship.

#### V. A DIRECTOR'S CONTRIBUTION TO A FILM IS A WORK OF AUTHORSHIP

Since the purpose of copyright, as stated in the Constitution, is to promote the progress of the useful arts,<sup>84</sup> the Supreme Court has set a very low bar of creativity and originality for a work to receive protection and thus promote the arts.<sup>85</sup> The Copyright Act itself does not include a definition of a work of authorship; however, the Supreme Court has provided guidance by holding that "to qualify for copyright protection, a work must be original to the author"<sup>86</sup> and that "copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity."<sup>87</sup> Even though there needs to be more than a *de minimis* level of creativity, the Act does not require novelty but only a "minimal creative spark."<sup>88</sup> Merkin's contribution to the film met the minimal requirement of creativity since it involved innovative thought and influence.

##### *A. By Giving Meaning to the Work as a Whole, Merkin's More than De Minimis Contribution to "Heads Up" is Copyrightable*

In a Supreme Court case, *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, a telephone service used a rival company's telephone book without permission to retrieve phone numbers to use in its telephone directory.<sup>89</sup> The telephone service was then sued for copyright

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<sup>83</sup> In *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 919 (2005) a new sub-species of copyright infringement was created in response to the expansion of the internet that renders a defendant liable for copyright infringement if he has "distribute[d] a device with the object of promoting its use to infringe copyright, as shown by clear expression or other affirmative steps taken to foster infringement."

<sup>84</sup> U.S. CONST. art. I, § 8, cl 8.

<sup>85</sup> See *Trade-Mark Cases*, 100 U.S. 82 (1879); *Feist Publ'ns Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991).

<sup>86</sup> *Feist Publ'ns Inc.*, 499 U.S. at 345.

<sup>87</sup> *Feist Publ'ns, Inc.*, 499 U.S. at 363; *Erickson*, 13 F.3d at 1067-72 (7th Cir. 1994) (holding that an actor's suggestions to a script were *de minimis* and thus there was not joint ownership).

<sup>88</sup> *Feist Publ'ns, Inc.*, 499 U.S. at 363.

<sup>89</sup> *Id.* at 344.

infringement by its competitor.<sup>90</sup> The Supreme Court acknowledged that even though originality is not a stringent requirement, the copying of facts did not have “the modicum of creativity necessary to transform mere selection into copyrightable expression”<sup>91</sup> and that “copyright rewards originality.”<sup>92</sup> Even though the Court stated that only an iota of originality is required to be covered by the Copyright Act, the copying of facts does not even meet that extremely low bar.<sup>93</sup>

Since “the requisite level of creativity is extremely low; [and] even a slight amount will suffice,” a director’s contribution to a film passes the extremely low bar of creativity required to be covered by the statute.<sup>94</sup> Merkin’s contribution as an director included advising and instructing the film’s cast and crew on the following decisions: what camera angles to use; what lighting best fit the scene; and what the character should be wearing, doing and saying.<sup>95</sup> It is the job of the director to “interpret the script, coach the performers . . . [and] to attend . . . to endless minor nuances and gestures.”<sup>96</sup> Each one of these elements requires thought and ingenuity on the part of the director. A director creates a particular style and visual for a film that is different from any other motion picture and even different from that another director might have created. It is the director’s job to innovate and translate the written word or script into specific scenes with particular looks, themes and images thereby creating the point of view of the film.<sup>97</sup> Based on the fact that a compilation of factual material can gain copyright protection if the compiler’s arrangement is unique, a director’s particular take on a script that results in a one of a kind film should also gain copyright protection.<sup>98</sup>

Both the Second and Ninth Circuit have a history of protecting the story-telling tools used in dramatic works. As early as 1936, the Second Circuit acknowledged the significance of movements in a dramatic work.<sup>99</sup> In *Sheldon v. Metro-Goldwyn Pictures Corp.*, the Second Circuit held that “a nod, a movement of the hand, or a pause become bound together in an inseparable unity that depicts the dramatic

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<sup>90</sup> *Id.* at 340.

<sup>91</sup> *Id.* at 362.

<sup>92</sup> *Id.* at 364.

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

<sup>94</sup> *Feist Publ’ns, Inc.*, 499 U.S. at 345.

<sup>95</sup> 16 Casa Duse, LLC v. Merkin, 791 F.3d 247, 251 (2d Cir. 2015).

<sup>96</sup> *Responsibilities and Job Skills of a Film Director*, THE FILM DIRECTOR, <http://www.filmmakers.com/stories/Director.htm> (last visited Nov. 12, 2016).

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

<sup>98</sup> 1-2 NIMMER ON COPYRIGHT § 2.11 (2012).

<sup>99</sup> *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir.1936).

meaning and any use of which without permission is copyright infringement.”<sup>100</sup> *Sheldon* involved a copyright infringement claim stemming from a movie that was based on a true story from Scotland involving a controversial murder by a young woman.<sup>101</sup> The same story had previously been made into a play by the plaintiff who filed suit stating that the movie infringed on his copyright.<sup>102</sup> In defense to the claim, the movie studio said that it only took the play’s unprotected elements because the story itself was one of fact and that dialogue came from the play.<sup>103</sup> However, the court noted that the scenes in the movie mimicked scenes and sequences from the play almost exactly.<sup>104</sup> The court said “[s]peech is only a small part of a dramatist’s means of expression” and that “a play may lapse into pantomime at its most poignant and significant moments . . . [that] tell the audience more than words could tell.”<sup>105</sup> If copyright protects the medium of expression that an author may use to give his work dramatic meaning, which is what a director’s contribution to film does, then his contribution must also be copyrightable. A director’s work on a movie involves creating the movement of a film through his direction of the actors as well as other decisions that gives the film dramatic significance and the scenes meaning, which the Second Circuit has already said is protected material.<sup>106</sup>

The Ninth Circuit made reached a similar decision. The court stated that even though “[m]ere motions, voice, and postures of actors and mere stage business are not subject of copyright protection . . . the means of expressing an idea is [protected].”<sup>107</sup> In *Universal Pictures Co. v. Harold Lloyd Corp.*, the Harold Lloyd Corporation sued Universal Pictures for copyright infringement of its movie “Movie Crazy” because fifty-seven scenes including the ‘Magician’s Coat Sequence’ were reproduced in Universal’s movie “So’s Your Uncle.”<sup>108</sup> Universal’s defense was that the sequence depicted only comic gags and stage business, which is not copyrightable because it does not tell a story.<sup>109</sup> Using the same reasoning found in the Second Circuit’s decision in *Sheldon*, the Ninth Circuit held that such elements,

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<sup>100</sup> *Id.* at 56.

<sup>101</sup> *Id.* at 53.

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

<sup>103</sup> *Id.* at 54.

<sup>104</sup> *Id.* at 55.

<sup>105</sup> *Sheldon*, 81 F.2d at 55.

<sup>106</sup> *Id.*

<sup>107</sup> *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 363 (9th Cir. 1947).

<sup>108</sup> *Id.* at 358.

<sup>109</sup> *Id.* at 363.

when combined to create an original combination that is important to establish the storyline with dialogue and action, become copyrightable.<sup>110</sup> Additionally, the court stated that “[t]he means of expressing an idea is subject to copyright protection, and where one uses his own method or way of expressing his idea, such adornment constitutes a protectable work.”<sup>111</sup>

In adopting this line of reasoning used by both the Ninth and Second Circuit, it is unmistakable the Merkin’s contribution to the film is copyrightable. The dramatic composition of a movie stems from the director’s command of the scene. The director controls every decision from what the actors wear, to where they stand, how they move, and what they say. Those decisions coupled with camera angles, lighting, and other significant aspects of the director’s authority affect the story and meaning of each scene and are the driving force behind the creation of the storyline of the movie overall.

*B. A Director’s Contribution to a Motion Picture is Original to the Director*

Through a series of Supreme Court cases, the word “writings” has been established to have a broad meaning.<sup>112</sup> The Court began to interpret this word broadly in the late nineteenth century when two significant copyright cases came before the Supreme Court. They were the *Trade-Mark Cases*,<sup>113</sup> and *Burrow-Giles Lithographic Co. v. Sarony*.<sup>114</sup> In the *Trade-Mark Cases*, the Supreme Court had to review the constitutionality of the Trademark Act. Then in *Burrow-Giles*, the Court had to address a copyright infringement claim regarding a photo of Oscar Wilde in which the defendant argued that Congress’s constitutional right to confer rights of authorship did not extend to the creator of a photograph. With these questions in mind, the Court had to define the crucial terms of “authors” and “writings” and in both instances, the Court focused on the importance of originality.<sup>115</sup>

When Congress tried to regulate trademark rights through the Copyright and Patent Clause of the Constitution, the Court had to address whether or not a trademark fell within that power.<sup>116</sup> Since the

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

<sup>111</sup> *Id.*

<sup>112</sup> 1-1 NIMMER ON COPYRIGHT § 1.08[B] (2015).

<sup>113</sup> *Trade-Mark Cases*, 100 U.S. 82 (1879).

<sup>114</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

<sup>115</sup> *See Trade-Mark Cases*, 100 U.S. 82; *Burrow-Giles Lithographic*, 111 U.S. 53; *Feist Publ’ns, Inc.*, 499 U.S. at 346.

<sup>116</sup> *Trade-Mark Cases*, 100 U.S. at 93.

Copyright Clause only protects the writings of authors, the Court had to determine what should be considered a writing of an author.<sup>117</sup> The Court held that even though “the word ‘writings’ may be liberally construed,” it only does so if they are original and “founded in the creative powers of the mind” in other words “the writings which are . . . protected are the fruits of intellectual labor.”<sup>118</sup>

The originality requirements founded in these two cases remain the criteria of copyrightable material today and the very premise of copyright law protection.<sup>119</sup> In light of this broad interpretation of the word “writings,” Merkin’s work on the film “Heads Up” fits into the expansive interpretation of the word “writings.”<sup>120</sup> By requiring merely a “physical rendering of the fruits of creative intellectual or aesthetic labor,” a director’s creative input in a film is considered a writing. It is the product of the director’s own thoughts and interpretations that then get embodied physically in the movie.<sup>121</sup> Nimmer goes on to suggest that the scope of what is considered a writing encompasses non-verbal expressions which includes other non-verbal works than just the photograph held copyrightable in *Burrow-Giles*.<sup>122</sup>

In *Bleistein v. Donaldson Lithographing Co.*, the Supreme Court held that an illustration on a circus poster was copyrightable which lead to the conclusion that the poster was a writing under the statute.<sup>123</sup> The combination of the court’s decisions in both *Bleistein* and *Burrow-Giles* establishes that graphic, nonverbal representations may constitute a writing in the constitutional sense.<sup>124</sup> When looking at the definition of the term graphic, which means relating to visual art, it becomes clear that Supreme Court precedent suggests that a director’s creation involved in a motion picture falls within the scope of a writing because it is a graphic, nonverbal representation of a creative work.<sup>125</sup>

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<sup>117</sup> *Id.*; See U.S. CONST. art. I, § 8, cl. 8.

<sup>118</sup> *Trade-Mark Cases*, 100 U.S. at 94.

<sup>119</sup> *Feist Publ’ns, Inc.*, 499 U.S. at 347. See, e.g., *Golan v. Holder*, 132 S. Ct. 873 (2012); *Eldred v. Ashcroft*, 537 U.S. 186 (2003); *N.Y. Mercantile Exch., Inc. v. Intercontinental Exchange, Inc.*, 497 F.3d 109 (2d Cir. 2007); *Medforms, Inc. v. Healthcare Mgmt. Solutions, Inc.*, 290 F.3d 98 (2d Cir. 2002).

<sup>120</sup> *Goldstein v. Cal.*, 412 U.S. 546, 561 (1973).

<sup>121</sup> 1-1 NIMMER ON COPYRIGHT § 1.08 (2015). See, e.g., *Burrow-Giles*, 111 U.S. at 53; *Goldstein*, 412 U.S. at 561.

<sup>122</sup> 1-1 NIMMER ON COPYRIGHT § 1.08.

<sup>123</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903).

<sup>124</sup> See e.g., *Burrow-Giles*, 111 U.S. at 60; *Bleistein*, 188 U.S. at 251–52.

<sup>125</sup> *Graphic*, OXFORD ONLINE DICTIONARY, (Nov. 2015), [www.oxforddictionaries.com](http://www.oxforddictionaries.com).



Later, *Burrow-Giles* reaffirmed that the words “writings” and “authors” require a broad and encompassing reading.<sup>126</sup> In regard to authors, the Court went on to specify that an author is the one involved in “originating, making, producing, as the inventive or master mind, [of] the thing which is to be protected.”<sup>127</sup> As for writings, the Court detailed that Congress had included any “[means] by which the idea of the mind of the author are given visible expression.”<sup>128</sup> The Court reasoned that the lack of photographs being on the protected list enacted in 1802 was because photographs probably did not exist at that time, but that the Act is broad enough to cover them as long they are “representatives of original intellectual conceptions of the author.”<sup>129</sup> In order for a work to be covered by the Act, it must contain the elements of “originality, of intellectual production, of thought, and conception on the part of the author.”<sup>130</sup> Concerning the Oscar Wilde photo, since it was made entirely from the photographer’s mind by his actions of “posing . . . Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph” therefore “it was an original work of art, the product of . . . intellectual invention” original to the author.<sup>131</sup>

It may seem simple enough to apply the originator standard to a filmmaker’s contribution, but motion pictures create a unique problem when trying to determine to “whom [it] owes its origin” since by definition, motion pictures are works expected to contain contributions from multiple individuals.<sup>132</sup> Further complicating the problem is that these contributions merge to create one unitary whole, making it hard to determine who is the originator.<sup>133</sup>

A similar problem arose in *Aalmuhammed v. Lee*, when Aalmuhammed worked as a consultant for Spike Lee’s film “Malcolm X.”<sup>134</sup> As a consultant, he reviewed the script, suggested revisions and rewrote scenes for accuracy.<sup>135</sup> In the credits, Aalmuhammed was

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<sup>126</sup> *Burrow-Giles*, 111 U.S. at 57–58.

<sup>127</sup> *Id.* at 61.

<sup>128</sup> *Id.* at 58.

<sup>129</sup> *Id.*

<sup>130</sup> *Id.* at 60.

<sup>131</sup> *Id.*

<sup>132</sup> *Burrow-Giles*, 111 U.S. at 58.

<sup>133</sup> 16 Casa Duse, LLC v. Merkin, 791 F.3d 247, 257 (2d Cir. 2015). *See* Richlin v. Metro-Goldwyn-Mayer Pictures, Inc., 531 F.3d 962, 975 (9th Cir. 2008) (“A motion picture is a work to which many contribute; however, those contributions ultimately merge to create a unitary whole.”).

<sup>134</sup> *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000).

<sup>135</sup> *Id.* at 1229–30.

listed only as an Islamic Technical Consultant.<sup>136</sup> After the film was released, however, he brought an action stating that the movie was a joint work and that he was a co-author and therefore a legal co-owner.<sup>137</sup> As discussed above, a joint work requires two or more authors, and in this instance, the Ninth Circuit had to figure out how to determine who is an author when, as in a movie, “the number of contributors grows and the work itself becomes less the product of one or two individuals who create it.”<sup>138</sup> The court applying the *Trade-Mark* and *Burrow-Giles* standard pointed out that the requirement that an author is “the originator or the person who causes something to come into being,” is difficult in application.<sup>139</sup> Although the contributions need to be creative, this provides no assistance in reducing the possible originators of a motion picture because it is seldom that a contribution to a film is not creative.<sup>140</sup> The court went on to list some of the possibilities that exist when determining who the author of a movie is, with one of those possibilities being the director.<sup>141</sup> The court stated that:

For a movie, [an author] might be the producer who raises the money. Eisenstein thought the author of a movie was the editor. The “auteur” theory suggests that it might be the director, at least if the director is able to impose his artistic judgments on the film. Traditionally, by analogy to books, the author was regarded as the person who writes the screenplay, but often a movie reflects the work of many screenwriters. Grenier suggests that the person with creative control tends to be the person in whose name the money is raised, perhaps a star, perhaps the director, perhaps the producer, with control gravitating to the star as the financial investment in scenes already shot grows. Where the visual aspect of the movie is especially important, the chief cinematographer might be regarded as the author. And for, say, a Disney animated movie like “The Jungle Book,” it might perhaps be the animators and the composers of the music.<sup>142</sup>

As in *Casa Duse*, the situation between Aalmuhammed and Lee was further complicated because there was no contract between the

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<sup>136</sup> *Id.* at 1230.

<sup>137</sup> *Id.*

<sup>138</sup> *Id.* at 1232.

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

<sup>140</sup> *Aalmuhammed*, 202 F.3d at 1232.

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

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

parties. Therefore, the court had to examine the circumstances of the film based on the standards laid out in *Burrow-Giles*. The court pointed out that the author would be the one that would exercise control and likely be the person “who has actually formed the picture by putting the persons in position, and arranging the place where the people are to be - the man who is the effective cause of that, or . . . gives effect to the idea[s].”<sup>143</sup> By using this reasoning, the court determined that Aalmuhammed did not have any authority in the film and that the oversight of its creation remained with Spike Lee, the director, and Warner Brothers, the production company.<sup>144</sup> Spike Lee was not bound to accept any of the recommendations that Aalmuhammed made and, therefore, it cannot be said that the film owed its origin to him.<sup>145</sup>

Unlike Aalmuhammed, whose only capacity in the making of the movie “Malcolm X” was to make suggestions in order to make the movie more accurate, Merkin’s role for “Heads Up” was more similar to that of an author as defined in the *Trade-mark Cases* and *Burrow-Giles*. As the director, Merkin is the originator of many aspects of the movie, and it is impossible to know what the film would be without his contributions. Whereas Aalmuhammed’s suggestions could be disregarded by director Spike Lee as the director himself, Merkin did not make suggestions, rather he made decisions that created the film. Merkin controlled and made decisions about everything from camera angles and lighting, to wardrobe and makeup, including the actors’ dialogue and movement.<sup>146</sup> The way those elements appear in the movies did not exist before him and were within his sole discretion and authority. Using the same House Report relied on by the Second Circuit to deny Merkin protection, the House stated that a director of a football game was an author by using multiple cameras and deciding which ones were sent out to the public.<sup>147</sup> This shows that what a director adds, even in an uncreative setting, such as a football game where the outcome is left up to the players and not the director, is a work of authorship. Therefore, it must lead to the same result where the director is contributing even more in a creative setting, such as a motion picture. In the Ninth Circuit’s list of possible motion picture

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<sup>143</sup> *Id.* at 1234.

<sup>144</sup> *Id.* at 1235.

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

<sup>146</sup> 16 Casa Duse, LLC v. Merkin, 791 F.3d 247, 251 (2d Cir. 2015).

<sup>147</sup> H.R. REP. 94-1476, at 51 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664 (“[w]hen 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 and in what order, there is little doubt that what the cameramen and the director are doing constitutes ‘authorship.’”).

authors, a director was mentioned as a possible author, if the director can impose his artistic judgments on the film.<sup>148</sup> Merkin was able to impose his artistic judgments based on his assigned duties and the work he put into the film.<sup>149</sup> Importantly, the court did not consider Spike Lee as an author because of the “work-for-hire” agreement that he signed, assigning his right to Warner Brothers, an agreement that Casa Duse was aware Merkin never signed when production began.<sup>150</sup>

*C. A Director’s Contribution to a Film is Fixed in a Tangible Medium of Expression*

While some courts have offered a broad interpretation of the terms “writings” and “authors,” courts have also broadly construed the requirement that the work be fixed in a tangible medium of expression. This broad reading comes straight from the plain language of the statute that states that the medium “may be one ‘now known or later developed.’”<sup>151</sup> This prevents courts from picking and choosing which mediums deserve copyright protection more than others.<sup>152</sup> The statute places great emphasis on fixation so that works that remain unrecorded do not receive the same statutory protection as those works that become permanent receive.<sup>153</sup> Under the statute, a work is fixed if there is an authorized embodiment that is permanent or stable.<sup>154</sup> The performance of a play, or other work, is not considered a writing capable of copyright protection because it is not thoroughly embodied permanently.<sup>155</sup> If the performance is encased in “written” form, such as a motion picture, however, then it becomes capable of copyright protection.<sup>156</sup>

In *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, a 2008 case, the Second Circuit addressed whether copyrighted material, which was only fixed for a brief period in between buffering before it was automatically rewritten, constituted copyright infringement.<sup>157</sup> The court pointed out that for a work to be fixed in a tangible medium, it must meet two requirements: “the work must be embodied in a medium . . . such that it can be perceived [and] reproduced . . . [and

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<sup>148</sup> *Aalmuhammed*, 202 F.3d at 1232.

<sup>149</sup> *Id.*

<sup>150</sup> *Casa Duse*, 791 F.3d at 251.

<sup>151</sup> 17 U.S.C. § 102 (2015).

<sup>152</sup> H.R. REP. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659.

<sup>153</sup> § 102.

<sup>154</sup> *Id.*

<sup>155</sup> 1-1 NIMMER ON COPYRIGHT § 1.08 (2015).

<sup>156</sup> *Id.*

<sup>157</sup> *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121 (2d Cir. 2008).

that it is perpetual].”<sup>158</sup> Since the buffered information did not meet the permanency requirement, it was not fixed.<sup>159</sup>

While applying the Second Circuit’s two “fixed” requirements to Merkin’s contributions to “Heads Up,” it is clear that it was indeed fixed in a tangible medium.<sup>160</sup> Although at first, the director’s contributions are merely thoughts in the director’s head, once those ideas are acted out by the actors, and then filmed, they become fixed in the finished project in the medium of motion picture; thus meeting the first requirement. Each time the movie “Heads Up” is played, the audience watches Merkin’s ideas, thoughts and overall concept of the movie permanently displayed in the motion picture. Once a film is recorded with the director’s instructions, the instructions are embodied in a manner that is permanent; hence direction necessarily meets the minimal amount of fixation requirement, which makes it fall under the purview of the statute as fixed in a tangible medium.

#### VI. THE SLIPPERY SLOPE OF FRACTURED COPYRIGHT PROTECTION IS UNFOUNDED BECAUSE OF THE WORK MADE FOR HIRE DOCTRINE

The Ninth and Second Circuits have expressed concerns that extending copyrights to parts of a collaborative work will open the floodgates to copyright claims from any person who contributed to the work. This concern, however, is diminished by the Work Made For Hire Doctrine. Casa Duse permitted Merkin to proceed as a director of the film without receiving a signed work for hire agreement from him; however, Casa Duse tried to have him sign such an agreement, which demonstrates that it understood there was a need for Merkin to sign one. If Casa Duse succeeded in getting Merkin’s signature, or rather hired another director willing to sign away his or her copyright interest, Merkin would have no claim and this case would not exist.

The commonality between the cases analyzed has been the lack of a work for hire agreement between the parties. The dramaturge in *Thomson* did not have a contract with the playwright, the consultant in *Aalmuhammed* did not have a contract with the director, nor did the actress in *Garcia* have a contract with the director, and finally, Merkin did not have an agreement with Casa Duse.<sup>161</sup> The reason that all of

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<sup>158</sup> *Id.* at 127.

<sup>159</sup> *Id.*

<sup>160</sup> *Id.*

<sup>161</sup> *Thomson v. Larson*, 147 F.3d 195 (2d Cir. 1998); *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000); *Garcia v. Google, Inc.*, 743 F.3d 1258, 1263 (9th Cir. 2014),

these creative work relationships resulted in court cases is because they lacked the security and clarity of a contract that laid out exactly what each parties' rights were in the creative work that resulted after their collaborations.

Typically, under the Copyright Act, ownership belongs to the author or creator of the work that turned the idea into a fixed tangible expression.<sup>162</sup> An exception to the rule is the Work Made For Hire Doctrine as outlined above. Under this doctrine, the copyright does not go to the creator, but rather the person who commissioned the work, if there is an express written agreement between the artist and the commissioner, or to the creator's employer.<sup>163</sup> The Work For Hire Doctrine was examined by the Supreme Court in *Community for Creative Non-Violence v. Reid*, where a sculpture was created by an artist who was hired by the organization.<sup>164</sup> Freelance creators are the biggest class affected by this doctrine, which would include the directors, dramaturges, actresses and consultants of the cases discussed thus far.<sup>165</sup> If the parties involved had clear contracts laying out who retained the rights and the specifically limited roles each party was to play, the courts would not have been involved because there would not be much to question.

In its reversal of *Garcia*, the Ninth Circuit stated that "Garcia's theory of copyright law [which gave actresses' copyright interest in the contribution to the film] would . . . splinter[] a movie into many different 'works,' [which would] make[] Swiss cheese of copyrights."<sup>166</sup> This quote was then applied by the Second Circuit in its decision in *Casa Duse*. The Second Circuit based its agreement on the fact that:

Filmmaking is a collaborative process typically involving artistic contributions from large numbers of people . . . and [if] copyright subsisted separately in each of their contributions to the completed film, the copyright in the film itself, which is recognized by statute as a work of authorship, could be undermined by any number of individual claims.<sup>167</sup>

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overruled by *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. 2015); 16 *Casa Duse, LLC v. Merkin*, 791 F.3d 247, 247 (2d Cir. 2015).

<sup>162</sup> 17 U.S.C. § 201(a) (2015).

<sup>163</sup> *Id.*

<sup>164</sup> *Cmty. for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989).

<sup>165</sup> *Id.* at 737.

<sup>166</sup> *Garcia*, 786 F.3d at 742 (internal quotation marks omitted).

<sup>167</sup> 16 *Casa Duse, LLC v. Merkin*, 791 F.3d 247, 258 (2d Cir. 2015).

Although this description is accurate, it neglects the fact that most motion pictures are created with work for hire agreements for most of the parties involved in their creation. The court listed producers, directors, screenwriters, actors, designers, cinematographers, camera operators, and a host of skilled technical contributors as those who contribute to the film and would have a copyright claim if the court had found for Merkin.<sup>168</sup> Despite this type of slippery slope fear that both the Ninth and Second Circuits expressed, the only cases that appear before the courts are those that lack valid written agreements. In *Aalmuhammed*, the court commented on the fact that Warner Brothers required Spike Lee to sign a work for hire agreement so that even Lee would not be a co-author and co-owner with Warner Brothers.<sup>169</sup> This example illustrates how producers can protect themselves—simply by relying upon standard contract law.<sup>170</sup>

The dissenting opinion in *Garcia*'s reversal delineated the flaws in the majority opinion in denying the actress her copyright, especially in regard to its overlooking the importance of contracts in such areas.<sup>171</sup> Judge Kozinski rightly stated that “[a]ctors usually sign away their rights when contracting to do a movie, . . . [and] the absence of a contract always complicates things.”<sup>172</sup> Without such contracts, the parties are left with whatever rights the copyright law gives them, and the copyright doctrine should not be subverted by the failure of a contractual arrangement. Without a contract setting forth contrary terms, a director whose contribution to a motion picture, which qualifies as a work of authorship fixed in a tangible medium, acquires a copyright in his interest.<sup>173</sup>

## VII. CONCLUSION

The plain language of the Copyright Act states, “[c]opyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>174</sup> Since Merkin’s contribution to the film “Heads Up” was an original work of authorship that was fixed in a tangible medium of

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<sup>168</sup> *Id.*

<sup>169</sup> *Aalmuhammed v. Lee*, 202 F.3d 1227, 1235 (9th Cir. 2000).

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

<sup>171</sup> *Garcia*, 786 F.3d at 749 (Kozinski, J., dissenting).

<sup>172</sup> *Id.* at 751.

<sup>173</sup> *Id.*

<sup>174</sup> 17 U.S.C. § 102 (2015).

expression, it follows that he should have had a copyright interest in the film. The Second Circuit, however, denied him of such interest out of public policy concerns for allowing creative team members, such as actors and directors, a copyright interest in their portions of the film as it would open the floodgates to litigation and shake the foundations of copyright law. These concerns are baseless, as most actors, directors, set designers, and costume designers sign work for hire agreements, which would bar such claims. Casa Duse was aware that Merkin had not signed any work agreement when it let him direct the film, an action that should not have occurred if it meant to retain all rights. The failure to do its due diligence should not diminish Merkin's rights.