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Weissmann V. Freeman: Derivative Works By Joint Authors-Originality And Copyright Infringement In The Second Circuit

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**WEISSMANN v. FREEMAN:
DERIVATIVE WORKS BY JOINT AUTHORS --
ORIGINALITY AND COPYRIGHT
INFRINGEMENT IN THE SECOND CIRCUIT***

INTRODUCTION

Copyright protection applies to an original work of authorship.¹ It is given "only to the expression of the idea -- not the idea itself."² The United States Constitution empowers Congress to protect the writings of authors.³ Copyright protection is, therefore, governed by federal law as provided by the 1976 Copyright Act.⁴

There are two conflicting public policies regarding copyright. One is that the author's efforts must be rewarded.⁵ The other is

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1. 17 U.S.C. § 102(a) (1988). "Copyright protection subsists . . . in *original* works of authorship fixed in any tangible medium of expression" *Id.* (emphasis added).

2. *Mazer v. Stein*, 347 U.S. 201, 217 (1954); *see* 17 U.S.C. § 102(b) which provides, in pertinent part: "In no case does copyright protection for an original work of authorship extend to any idea" *Id.*

3. The copyright clause of the United States Constitution provides: "The Congress shall have the power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

4. *See* 17 U.S.C. §§ 101-801 (1988).

5. *Mazer*, 347 U.S. at 219 ("The monopoly created by copyright thus

“the public’s interest in the dissemination of information.”⁶ As a result of this conflict, there are limits on the duration of copyright protection.⁷ Copyright protection endures for “the life of the author and fifty years after the author’s death.”⁸ In the case of a joint work, the copyright endures for the life of the last surviving author plus fifty years.⁹ “A ‘joint work’ is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”¹⁰

When joint authors each contribute to a work, the work is jointly owned and each joint owner has ownership rights in the final work.¹¹ Each joint author has a copyright interest in the joint work and, pursuant to the 1976 Copyright Act,¹² the right

rewards the individual author in order to benefit the public.”)

6. *Weismann v. Freeman*, 868 F.2d 1313, 1323 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). In a report to Congress, prior to the revision of the Copyright Act, the register of copyright stated: “[T]he ultimate task of the copyright law is to strike a fair balance between the author’s right to control the dissemination of his works and the public interest in fostering their widest dissemination.” Register of Copyright, 87th Cong., 1st Sess., Copyright Law Revision, Rep. on the Gen. Revision of the U.S. Copyright Law 6 (H. Jud. Comm. Print 1961).

7. See 17 U.S.C. § 302(a) (1988). “Copyright in a work . . . subsists from its creation . . . endures for a term consisting of the life of the author and fifty years after the author’s death.” *Id.*

8. *Id.*

9. *Id.* § 302(b). “In the case of a joint work . . . the copyright endures for a term consisting of the life of the last surviving author and fifty years after such last surviving author’s death.” *Id.*

10. *Id.* § 101.

11. *Id.* § 201(a). Section 201(a) provides: “Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of the copyright in the work.” *Id.*; see Brian Murray, Note, *Weissmann v. Freeman: The Second Circuit Errs In Its Analysis of Derivative Works By Joint Authors*, 63 ST. JOHN’S L. REV. 601, 601-02 (1989) [hereinafter *Derivative Works*]. Each author “has an undivided ownership interest in the copyright of the finished product, subject to a duty to account to the other author for half the profits.” *Id.* (footnotes omitted).

12. See 17 U.S.C. § 106 (1988). Section 106 of the Act, entitled “Exclusive rights in copyrighted works,” provides that the owner of a copyright has the exclusive right “to prepare derivative works based upon the copyrighted work.” *Id.* § 106(2).

to create a new, copyrightable, derivative work¹³ based upon the prior joint work, and to retain copyright protection of the original joint work.¹⁴ The joint author can thereby protect original contributions to both the underlying joint work and a subsequent derivative work. The copyright protection of the derivative work extends only to the new matter introduced in that derivative work.¹⁵

This Note examines joint authorship, derivative works, standards of originality, copyright infringement and plagiarism. Part I discusses the factual setting of *Weissmann v. Freeman*¹⁶ and the professional relationship that existed between Doctors Weissmann and Freeman. Part II analyzes the relationship between intent and joint authorship. Part III examines the relationship between intent and derivative works. In both Parts II and III, a question is raised as to whether intent should be governed by an objective or subjective standard. Part IV discusses copyrightability and derivative works, asking whether the appropriate standard of originality for determining whether a work is a derivative work should be “minimal but more than merely trivial” or the “more substantial” standard of originality. This Note advocates the application of the “more substantial” standard be applied when

13. “A ‘derivative work’ is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a ‘derivative work.’” 17 U.S.C. § 101 (1988).

14. *Weissmann*, 868 F.2d at 1317 (citing 17 U.S.C. § 103(b) (1988)).

15. Section 103(b) of the Copyright Act provides that:

The copyright in a . . . derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

17 U.S.C. § 103(b) (1988).

16. 648 F. Supp. 1248 (S.D.N.Y. 1988), *aff’d in part, rev’d in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

the prior work was jointly created. Part V discusses the statutory defense of fair use, analyzing the required four factors.¹⁷ This Note concludes that Dr. Freeman should be permitted the defense of fair use. Part VI criticizes the four factor approach, and proposes a new approach. Part VII asks whether in this situation copyright infringement constitutes plagiarism and answers that question in the negative. Part VIII discusses the availability of attorney's fees as a remedy in the event of copyright infringement. Part IX explores the negative aspects of the *Weissmann v. Freeman* decision on joint scientific research within the academic community. Part X examines the recent decision by the United States Court of Appeals for the Ninth Circuit in *Ashton-Tate Corp. v. Ross*.¹⁸ The decision is in accord with the United States Court of Appeals for the Second Circuit's decision, *Weissmann v. Freeman* decision and, therefore, indicates that the analysis in *Weissmann v. Freeman* is unlikely to be overturned.¹⁹ This Note concludes that as a result of *Weissmann v. Freeman*, joint authors must take steps to protect themselves from the consequences of the unauthorized use of copyrightable derivative works based upon prior joint authorship.

I. STATEMENT OF FACTS

In the first decision regarding joint authorship and derivative works by a court of appeals since enactment of the 1976 Copyright Act, the Second Circuit, in *Weissmann v. Freeman*,²⁰ held that a derivative work, derived from joint authorship, was separately owned, although the underlying work remained jointly

17. See 17 U.S.C. § 107 (1988).

18. 916 F.2d 516 (9th Cir. 1990).

19. Subsequent to the writing of this Note, the Second Circuit decided the case of *Childress v. Taylor*, 945 F.2d 500 (2d Cir. 1991), which ruled that joint works will only result where the contribution of each co-author is separately copyrightable, and where the co-authors intend to regard themselves as joint authors at the time of the work's creation. *Id.* at 507-09. For a discussion of intent and joint authorship see *infra* notes 63-122 and accompanying text.

20. 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

owned.²¹

A key determination in joint ownership of a derivative work is the intent to make a solely owned derivative work.²² A major question in copyright law is whether that intent should be governed by an objective or subjective standard.²³ Moreover, whether joint ownership of a separately owned derivative work is created depends not only upon intent but also upon originality of the new material.²⁴ In the Second Circuit, the standard for origi-

21. *Id.* at 1317.

22. *See Derivative Works*, *supra* note 11, at 607-09. "The touchstone here is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit." *Id.* at 607 n.40 (citing H.R. REP. No. 1476, 94th Cong., 2d Sess. 120 (1976)).

23. *See* Therese M. Brady, Note, *Manifest Intent and Copyrightability: The Destiny of Joint Authorship*, 17 FORDHAM URB. L.J. 257 (1989) [hereinafter *Manifest Intent*]. "Due to the ambiguity in the terms 'intention' and 'authors' courts and treatises have misinterpreted the statutory definition. Through the subsequent misapplication of the joint authorship doctrine, these ambiguities deny property rights to co-authors." *Id.* at 258. "'Common design' is the precursor of the objective intent standard of the 1976 Act's joint work definition. In *Maurel v. Smith*, Judge Learned Hand adopted the first American definition of joint authorship from the English decision *Levy v. Rutley*." *Id.* at 260 (citing 220 F. 195, 199 (S.D.N.Y. 1915), *aff'd*, 271 F. 211 (2d Cir. 1921)). "[T]o constitute joint authorship there must be a common design." *Id.* (quoting *Levy v. Rutley*, L.R. 6 C.P. 523, 529 (1871)). "In *Edward B. Marks Music Corp. v. Jerry Vogel Music Co., Inc.*, Judge Hand replicated his common design theory from *Maurel*. He determined that the merger of the author's contribution with those of others into a single work evinced the intent of the authors to create a joint work." *Id.* at 261 (citing *Edward B. Marks Music Corp. v. Jerry Vogel Music Co., Inc.*, 140 F.2d 266, 267 (2d Cir. 1944)). "In '*Melancholy Baby*,' the case which determined the authorship rights of the first lyricist, the composer and the second lyricist, a subjective standard replaced the objective standard of common design." *Id.* at 261-62 (citing, *inter alia*, *Edward B. Marks Music Corp. v. Jerry Vogel Music Co., Inc.* ["*Melancholy Baby*"], 42 F. Supp. 859 (S.D.N.Y. 1942)). "The '*Melancholy Baby*' court distorted the reasoning of *Marks* . . . by considering only the composer's subjective intent to create a song and ignoring the vesting of joint authorship of the first lyricist. By granting the second lyricist rights in the whole, the court wrongfully diluted the rights of the initial. A state of mind standard, disregarding the ownership rights of the first lyricist, replaced the standard of common design." *Id.* at 262. (footnote omitted).

24. 17 U.S.C. § 102(a) (1988); *see supra* note 1 for text.

nality has been quite low.²⁵

Weissmann involved the question of copyright infringement of a derivative work by a former joint author.²⁶ Doctors Freeman and Weissmann were both noted physicians and researchers at the Montefiore Medical Center and the Albert Einstein College of Medicine.²⁷ Dr. Weissmann, as a fourth year resident and the junior author, began to work under Dr. Freeman's tutelage in 1977.²⁸ Two years later, Freeman and Weissmann published their first joint paper on the radiopharmaceutical, iminodiacetic acid (IDA), a substance used to assist in the diagnosis of diseases of the liver and biliary tract.²⁹ Subsequently, they published many joint articles in the field of IDA derivatives.³⁰ Beginning in 1980, they jointly authored a syllabus to accompany lectures for refresher courses on IDA imaging.³¹ The syllabus was then jointly updated for the next five years.³²

In 1985, Weissmann updated a jointly written syllabus under her own name, entitled "Hepatobiliary Imaging" (P-1), for the Radiological Society of North America (RSNA) review course.³³ The article was derived from previous papers jointly authored by both Freeman and Weissmann and incorporated Freeman's previ-

25. See *Weissmann v. Freeman*, 868 F.2d 1313, 1321 (2d Cir.), cert. denied, 110 S. Ct. 219 (1989).

In the law of copyright only an unmistakable dash of originality need be demonstrated, high standards of uniqueness in creativity are dispensed with "All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'"

Id. (quoting *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951)). "The originality requirement for a revised version is a 'minimal' or 'modest' one." *Id.* (citations omitted).

26. *Id.* at 1315.

27. *Id.*

28. *Id.*

29. *Id.*

30. *Id.*

31. *Id.*

32. *Id.*

33. *Weissmann v. Freeman*, 684 F. Supp. 1248, 1250 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), cert. denied, 110 S. Ct. 219 (1989).

ous work entitled, "False-Positive Studies for Acute Cholecystitis" (False-Positive).³⁴

Although Weissmann's article included a few new elements,³⁵ the textual additions were minor and the reorganization was minimal and mechanical.³⁶ Freeman did not object to Weissmann's use of P-1 when it was released because it was the customary practice of Freeman and Weissmann to routinely update their joint work under the name of both or either authors.³⁷

In 1987, Freeman was invited to give a refresher course at the Mount Sinai School of Medicine.³⁸ He attempted to present Weissmann's paper on "Hepatobiliary Imaging" (P-1), adding three additional words to the title.³⁹ He eliminated Weissmann's name as author and substituted his own.⁴⁰ No other changes were made. Fifty copies of the syllabus were prepared.⁴¹ At Weissmann's request, Freeman removed the article from the packet of course materials and presented his lecture without the article.⁴² Freeman received a \$250 honorarium for the lecture.⁴³ Without Weissmann's prior knowledge, Freeman also published a verbatim copy of P-1 under his own name for a symposium in the Republic of China (Taiwan Publication) in December, 1986.⁴⁴

Weissmann subsequently filed a suit against Freeman alleging copyright infringement in violation of the copyright statute,⁴⁵

34. *Id.* at 1256. "A 'false positive' occurs when a test result indicates that a patient has a particular condition (acute cholecystitis) but is later found in fact not to have that condition." *Id.*

35. *Weissmann*, 868 F.2d at 1316. "Weissmann's exhibits include[d] the following new elements: (1) a new selection of photo illustrations and associated captions; (2) references to four recent reports in the pertinent literature; (3) new textual additions; and (4) reorganization of previous material." *Id.*

36. *Weissmann*, 684 F. Supp. at 1257.

37. *Id.* at 1255-56.

38. *Id.* at 1257.

39. *Id.*

40. *Id.*

41. *Id.*

42. *Id.*

43. *Id.* at 1260.

44. *Weissmann*, 868 F.2d at 1317.

45. Specifically, § 501(a) states: "Anyone who violates any of the

seeking damages and an injunction to prevent Freeman from engaging in copyright infringement.⁴⁶ She argued that P-1 was not jointly authored, but, was a derivative work owned by her alone and entitled to independent copyright protection.⁴⁷ Weissmann further argued that Freeman was not entitled to the defense of fair use.⁴⁸ Freeman argued that he was a joint author of P-1 or, in the alternative, should the court determine P-1 to be a derivative work entitled to copyright protection, that he was entitled to the defense of fair use.⁴⁹ The district court found no copyright infringement.⁵⁰ It held that Freeman was a joint author of P-1, finding the new material not sufficiently original to be copyrightable.⁵¹ The court also found that Weissmann's modifications of previous joint works were insignificant and trivial,⁵² and that her changes did not meet the originality requirement of a copyrightable derivative work.⁵³ However, if P-1 were copyrightable, the court, in dicta, stated that Freeman would be entitled to the fair use defense.⁵⁴

Weissmann consented to dismissal of her claim for attorney's fees because she had not registered her copyright on P-1 before commencing suit.⁵⁵ Both sides appealed. Weissmann sought reversal with a permanent injunction restraining Freeman from copyright infringement, and Freeman pursued an award of attorney's fees.⁵⁶

The Second Circuit reversed the district court and held that

exclusive rights of the copyright owner . . . is an infringer of the copyright." 17 U.S.C. § 501(a) (1988).

46. *Weissmann*, 684 F. Supp. at 1250.

47. *Id.* at 1257.

48. Brief for Plaintiff-Appellant at 41, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

49. *Weissmann*, 684 F. Supp. at 1251.

50. *Id.* at 1261.

51. *Id.*

52. *Id.*

53. *Id.*

54. *Id.* at 1261-62.

55. *Id.* at 1250-51. "Copyright registration is a prerequisite to the filing of an infringement suit." *Id.* at 1251 n.2 (citing 17 U.S.C. § 411 (1988)).

56. *Weissmann*, 868 F.2d at 1317.

Weissmann's article was a derivative work and that Freeman was not a joint author of the new material in the revised, updated, derivative work.⁵⁷ Copyright protection was extended only to Weissmann, the author of the derivative work, which was derived from a collaborative effort between joint authors.⁵⁸ Furthermore, the court stated that Freeman was not entitled to the defense of fair use against the allegation of copyright infringement.⁵⁹ The case was remanded to the district court with directions that judgment be entered in favor of appellant Weissmann.⁶⁰ The United States Supreme Court denied Freeman's petition for *writ of certiorari*.⁶¹

This Note submits that *Weissmann v. Freeman*⁶² was decided correctly by the district court and should not have been reversed by the Second Circuit. Weissmann's article lacked the sufficient level of originality to be a copyrightable derivative work. The context of the prior associations of Weissmann and Freeman and the mechanical contributions of Weissmann signify an incorrect application of the minimal standard of originality by the Second Circuit. In the alternative, a more substantial standard of originality should have been applied. Or, P-1 could have been found to be a joint derivative work, owned by both prior authors. Furthermore, even if Freeman were not a joint author of P-1, he should have been entitled to the defense of fair use. As a result, Freeman, a joint author, was unfairly deprived of the fruits of his work, even though he continued to have rights in the original joint work.

II. INTENT AND JOINT AUTHORSHIP

Joint authorship involves "joint laboring in furtherance of a

57. *Id.* at 1327.

58. *Id.* at 1323.

59. *Id.* at 1326.

60. *Id.* at 1327.

61. 110 S. Ct. 219 (1989).

62. 684 F. Supp. 1248 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

preconcerted common design.”⁶³ The product of joint authorship is a “joint work.”⁶⁴ To be a joint work, the joint authors must *intend* that their efforts be merged.⁶⁵ Joint authors are co-owners of copyright in their works, each contributor acquiring an undivided ownership in the entire work.⁶⁶ A joint author cannot infringe her own copyright and may license the joint work without the other joint author’s consent, “subject only to a duty to account” to the other joint author.⁶⁷

Freeman, as senior investigator, and Weissmann, as junior investigator, together published many joint works.⁶⁸ In *Weissmann*, Freeman argued that P-1 was a joint work even if published only under Weissmann’s name.⁶⁹ Because Freeman and Weissmann had collaborated on many prior joint works involving updates, Freeman argued that P-1 was simply an update of a joint work.⁷⁰ He argued that Weissmann’s “addition of the new matter was a ‘joint laboring in furtherance of a preconcerted common design.’”⁷¹ Furthermore, Freeman argued that he and Weissmann

63. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 6.03 at 6-6 (1990) [hereinafter 1 NIMMER].

64. 1 *id.*

65. 1 *id.*; see § 101 of the Copyright Act which provides that: “A ‘joint work’ is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.” 17 U.S.C. § 101 (1988).

66. 1 NIMMER, *supra* note 63, § 6.06[A] at 6-16. “In a joint work . . . where both authors work pursuant to a preconcerted common design, each author obtains an undivided ownership in the whole of the joint work, including any portion thereof.” *Id.*

67. *Weissmann v. Freeman*, 684 F. Supp. 1284, 1260 (citing *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429, 430-31 (S.D.N.Y. 1974)), *aff’d in part, rev’d in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

68. *Weissmann v. Freeman*, 868 F.2d 1313, 1316 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). “[P-1] admittedly was derived from previous papers jointly written by the parties during the course of their professional relationship that extended from 1977 to 1984.” *Id.*

69. Brief for Defendant-Appellee at 20, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

70. *Id.* at 17.

71. *Id.* at 14 (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 6.03 at 6-6 (1985)).

were joint authors of P-1, even though their contributions were made at different times involving different versions of substantially the same material.⁷² After all, a joint work need not be written simultaneously.⁷³ Thus, Freeman argued that if he was a joint author of P-1, he could not be liable for infringing a copyright he owned.⁷⁴

Weissmann argued, however, that neither she nor Freeman was a joint author of P-1.⁷⁵ Weissmann stated that she was not acting as a joint author when she wrote P-1 and that Freeman was not acting as a joint author when he copied P-1.⁷⁶

Weissmann, as a prior joint author, was certainly entitled to write a derivative work based on prior joint authorship. Had she wished, she could have invited Freeman to become a joint author of P-1. Instead, she did not want Freeman to have any ownership rights in P-1, arguing that she and Freeman were competitors instead of colleagues.⁷⁷

Yet, even if Weissmann was the sole author of P-1, Freeman was still protected by the copyright statute.⁷⁸ He remained a joint author of the prior works to which he retained ownership rights

72. *Id.* at 16. "A joint work 'can result from the labors of persons . . . who work at different times.'" *Id.* (quoting *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 424, 430 (S.D.N.Y. 1974)).

73. *See Weissmann v. Freeman*, 684 F. Supp. 1248, 1260 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). "[A] joint work can result from the labors of persons who are strangers to each other and *who work at different times*, if each contributor contemplates that his work will form part of a whole to which someone else will contribute." *Id.* (citing *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266 (2d Cir. 1944)) (emphasis added).

74. Brief for Defendant-Appellee's at 20, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7345, 7465) (citing *Cortner v. Israel*, 732 F.2d 267, 271 (2d Cir. 1984); *Donna v. Dodd, Mead & Co.*, 324 F. Supp. 424, 430 (S.D.N.Y. 1974)).

75. Brief for Plaintiff-Appellant at 25-26, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

76. *Id.* at 26-27.

77. *Id.* at 49.

78. *See* 17 U.S.C. § 106(2) (1988). "[T]he owner of copyright . . . has the exclusive right . . . to prepare derivative works based upon the copyrighted work . . ." *Id.*

and copyright protection, and could have written his own derivative work based upon the prior joint work.⁷⁹ Freeman could also have written a new work, citing P-1 as references. Weissmann argued that Freeman should be prevented from copying P-1 verbatim.⁸⁰

The district court held that, although Weissmann was using only her own name on the 1985 RSNA syllabus (P-1), the inclusion of Freeman's section, "False-Positive," meant joint authorship of the syllabus.⁸¹ As joint author of P-1, Freeman could not be held liable for copyright infringement.⁸² The trial judge noted that Weissmann had routinely "submitted drafts to Freeman before publication," indicating her intent that he be a joint author.⁸³

The Second Circuit held that the district court's decision was based on the mistaken premise that "joint [ownership] of the prior existing works automatically makes the joint authors co-owners of the derivative work."⁸⁴ The Second Circuit stated that to be a joint author of a derivative work: "First, each putative author must have 'contributed' to the work. Second, each author must intend to contribute to a joint work at the time his or her alleged contribution is made."⁸⁵

79. *Id.*

80. Brief for Plaintiff-Appellant at 14, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

81. *Weissmann v. Freeman*, 684 F. Supp. 1248, 1256 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). The court stated that "Freeman's participation is strikingly illustrated by inclusion in P-1 of the section entitled 'False-Positive Studies for Acute Cholecystitis' which unquestionably he composed. His authorship thereof was unequivocally established at trial." *Id.*

82. *Id.* at 1260. "A joint owner cannot be liable to a co-owner for copyright infringement, since a copyright owner cannot infringe his own copyright." *Id.* (citing *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 424, 430 (S.D.N.Y. 1974)).

83. *Id.* at 1254, 1256.

84. *Weissmann v. Freeman*, 868 F.2d 1313, 1317 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). The court stated that: "Such a ruling stands copyright law on its head. It flies in the face of the Copyright Act which affords protection to each work at the moment of its creation." *Id.*

85. *Id.* at 1318; *see supra* note 19 and accompanying text.

In discussing the requirement of actual contribution to the derivative work, the Second Circuit relied on the plain meaning of the Copyright Act⁸⁶ and on its legislative history.⁸⁷ The Second Circuit observed that the legislative history of the 1965 Copyright Law revision “clearly indicated that one cannot be deemed to be a joint author without actually collaborating in the work’s preparation.”⁸⁸ Furthermore, that Freeman had “conceded that he had not participated in drafting the new matter included in P-1.”⁸⁹ The Second Circuit correctly noted that Weissmann did not consult with Freeman prior to the publication of P-1.⁹⁰ However, the court conceded that Freeman could not

86. *Id.*

A review of the meaning of §§ 101 and 103(b) and of their legislative history reveals two basic criteria that must be satisfied before one is a joint author of a derivative work. First, each putative author must have “contributed” to the work. Second, each must intend to contribute to a joint work at the time his or her alleged contribution is made.

Id.

87. *Id.*

88. *Id.* (citing H.R. REP. No. 1476, 94th Cong., 2d Sess. 120 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5736).

89. *Id.* The court stated that:

[I]t follows as a logical corollary, therefore, that he acquired no interest in or right to use P-1 beyond those rights which he had as co-author in the prior joint material incorporated into P-1. Even though one co-author has the right to revise a joint work in order to create an individual derivative work, the other co-author acquires no property rights in the newly created work prepared without his involvement.

Id. (citing, *inter alia*, *Dynamic Solutions, Inc. v. Planning and Control, Inc.*, 646 F. Supp. 1329, 1338-39 (S.D.N.Y. 1986)).

90. *Id.* at 1320. The court stated that:

[H]ad the trial court separately considered P-1, it would have concluded that appellant’s article was the only work with respect to which it was repeatedly conceded that appellee had played no role [T]he trial judge found that “plaintiff did almost all of the writing” for the works listed on her resume of which Freeman was a “co-author” and that she routinely “submitted drafts to Dr. Freeman before publication.” It also found that “[s]he would always make sure to leave a copy of a manuscript on his desk if he was not in town or busy with other commitments; she did not always get comments back, but often she did.” Hence, it is significant on the issue of appellant’s intent that P-1 was one of those few works that was not submitted for Dr. Freeman’s

have anticipated that his work on “False-Positive” might later be used by Weissmann because, prior to P-1, she had never attempted to author an original work on her own.⁹¹

Freeman’s argument that subsequent additions to a work can constitute a joint work is supported by the *12th Street Rag*⁹² case.⁹³ In *12th Street Rag*, a composer created an instrumental piano solo.⁹⁴ Subsequently, the rights were assigned to a publisher who commissioned lyrics to be written for the work.⁹⁵ The court held that the resulting combination of the music and lyrics constituted a joint work.⁹⁶

review and on which she did not receive his comments.

Id. (quoting *Weissmann v. Freeman*, 684 F. Supp. 1248, 1254 (S.D.N.Y. 1988)).

91. *Id.* The court reasoned that:

The incorporation of [“False-Positive”] into P-1 is irrelevant to the question of whether or not the parties intended P-1 to be a joint work [T]he inclusion of the “False-Positive” section is not proof of any intention on Dr. Freeman’s part to make a contribution to P-1 because, prior to 1985, he could not have formed an intent to contribute his efforts to her then non-existent work.

Id.

92. *Shapiro, Bernstein & Co., Inc. v. Jerry Vogel Music Co.*, [12th Street Rag], 221 F.2d 569 (2d Cir.), *modified on reh’g*, 223 F.2d 252 (2d Cir. 1955). The district court in *Weissmann* noted that the *12th Street Rag* case is supportive of Freeman’s argument since the case held that “even if at the time one element of a joint work is created no intent to contribute to a joint work exists, if at any time thereafter the author or his assignee conceives and carries out such an intention, the resulting combination will be joint.” *Weissmann v. Freeman*, 648 F. Supp. 1248, 1260 (S.D.N.Y. 1988), *aff’d in part, rev’d in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

93. However, the district court stated that “[t]he continued validity of the *12th Street Rag* doctrine is unclear, and the current Copyright Act, which defines joint ownership, has been said to reject the *12th Street Rag* doctrine.” *Weissmann v. Freeman*, 684 F. Supp. 1248, 1260 (S.D.N.Y. 1988) (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 6.03 at 6-8, 6-9 (1988)), *aff’d in part, rev’d in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

94. *Shapiro*, 221 F.2d at 570.

95. *Id.*

96. *Id.* The court stated that:

[O]rdinarily we look to the consent of the first author to see whether or not we have a joint work; when the first author has assigned away all

In *Weissmann*, the district court correctly raised the issue of the 'False-Positive' work.⁹⁷ Although Weissmann was only using her own name on the syllabus, the inclusion of Freeman's work on 'False-Positive' meant that Weissmann intended joint authorship of the 1985 RSNA syllabus (P-1).⁹⁸ Thus, the district court concluded that as joint author of P-1, Freeman could not be held liable for copyright infringement of his own work.⁹⁹

It is precisely the use of Freeman's original work by Weissmann in P-1, without credit, that supports Freeman's contention that both doctors were acting as joint authors. Each doctor had routinely updated his or her joint stock pieces, using each other's contributions, published both jointly and separately.¹⁰⁰

Freeman had good reason to consider himself a joint author of P-1 because most of it was the product of his earlier efforts.¹⁰¹ Freeman subjectively intended that those efforts should result in future joint updated works. Assuming that P-1 was a joint work, Freeman had no need to contribute further to it to preserve ownership rights.

In its reasoning regarding intent, the Second Circuit relied upon the *objective interpretation of intent* as explicated by Judge Learned Hand in *Edward B. Marks Music Corp. v. Jerry Vogel Music Co., Inc.*,¹⁰² in addition to an interpretation of the

his rights which he can assign, we look to the intent of the assignee. In the case at bar, when the assignee . . . procured the writing of the lyrics, [the assignee's] intent was that the lyrics and music be performed together as a single work, a song. That intent should govern. Since that intent was to merge the two contributions into a single work to be performed as a unit . . . we should consider the result "joint"

Id.

97. *Weissmann*, 684 F. Supp. at 1256.

98. *Id.* at 1255-56.

99. *Id.* at 1260.

100. *Id.* at 1254. "P-1 is a 1985 update of a continually evolving piece of a syllabus used by the parties and continuously styled in the same general format" *Id.*

101. *See infra* note 167 and accompanying text.

102. 140 F.2d 266 (2d Cir. 1944); *Weissmann v. Freeman*, 868 F.2d 1313, 1319 (2d Cir.) (citing *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944)), *cert. denied*, 110 S. Ct. 219 (1989).

Copyright Act¹⁰³ and the Act's legislative history.¹⁰⁴ In *Weissmann*, the court stated that for a work to be deemed a joint work, "the parties must evince 'the intention that their contributions be merged at the time that the writing is done.'"¹⁰⁵ Although the court may have applied Judge Hand's objective interpretation of intent, it stated that "*each author must intend to contribute to the joint work when that work is created.*"¹⁰⁶

The Second Circuit, in support of its position, relied upon *Marks*.¹⁰⁷ However, its reliance on *Marks* may have been misplaced. In *Marks*, one person wrote the lyrics and the other composed the music.¹⁰⁸ The lyricist and the composer never met until years later but intended a joint work.¹⁰⁹ The resulting song, "*December and May*," was found to be a joint work.¹¹⁰ The *Weissmann* court noted that in *Marks*, both parties were equally aware that their efforts would later be combined, not unlike the circumstances surrounding P-1.¹¹¹ However, the Second Circuit

103. 17 U.S.C. § 101 (1988); *Weissmann*, 868 F.2d at 1319.

104. H.R. REP. No. 1476, 94th Cong., 2d Sess. 120 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5736; *Weissmann*, 868 F.2d at 1319. See PRELIMINARY DRAFT FOR REVISED U.S. COPYRIGHT LAW, COPYRIGHT LAW REVISION, 265 (1964). American Bar Association Committee 302 Chairman Harry R. Olson, Jr. stated: "[A] 'joint work' should be defined as a work which appears to be a unitary whole, and whether a work is a 'joint work' or not should have nothing to do with the intentions or mental state of the authors who worked on it." *Id.*; see also *Manifest Intent*, supra note 23, at 263. "Although the term 'common design' does not appear in the 1976 Act of the House Report accompanying it, the objective standard of common design as expounded by *Maurel* and *Marks* can be read into these documents, since the intent on which the statute focuses follows 'traditional notions.'" *Id.* (citing A. LATMAN, R. GORMAN & J. GINSBERG, COPYRIGHT FOR THE EIGHTIES 228 (2d ed. 1985)).

105. *Weissmann*, 868 F.2d at 1319 (quoting H.R. REP. No. 1476, 94th Cong., 2d Sess. 120 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5736).

106. *Id.* (emphasis added).

107. *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266 (2d Cir. 1944); *Weissmann*, 868 F.2d at 1319.

108. *Marks*, 140 F.2d at 266.

109. *Id.* at 267.

110. *Id.*

111. *Weissmann*, 868 F.2d at 1319. The court stated:

In the present case, Drs. Weissmann and Freeman collaborated in the

failed to note that intent may be implied rather than express. In fact, the intent to create a joint work may exist even when its authors do not work together or even know each other.¹¹²

A subjective standard of intent was applied in the “*Melancholy Baby*”¹¹³ case, where the court held that a joint work need not be written simultaneously.¹¹⁴ In “*Melancholy Baby*,” a composer created the music and his wife wrote the lyrics.¹¹⁵ Subsequently, new lyrics were written with the consent of the composer.¹¹⁶ The court held that the composer of the music and the author of the new lyrics were joint authors of the resultant song, which was regarded as a joint work.¹¹⁷ However, the court only considered the composer’s subjective intent to create a song.¹¹⁸

“*Melancholy Baby*” supports Freeman’s argument that a joint

preparation and publication of the works from which P-1 was divided. Yet, there is no evidence that they intended their joint product to be forever indivisible like the finite whole of the completed single song in *Marks*. The facts point to a contrary conclusion. Scientific research is a quest for new discoveries and the preexisting joint works by definition were continually evolving. Dr. Weissmann believed she had a new and better approach and decided to author her research alone.

Id.

112. *Marks*, 140 F.2d at 267. “[I]t makes no difference whether the authors work in concert or even whether they know each other; it is enough that they mean their contributions to be complementary in the sense that they are to be embodied in a single work to be performed as such.” *Id.*

113. *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947).

114. *Id.* at 409. The court stated that:

The words and music of a song constitute a “musical composition” in which the two contributions merge into a single work to be performed as a unit for the pleasure of the hearers; they are not a “composite” work, like the articles in an encyclopedia, but are as little separable for purposes of the copyright as are their individual musical notes which constitute the melody.

Id.

115. *Id.* at 407.

116. *Id.* at 408.

117. *Id.* at 410; *see, e.g.*, 1 NIMMER, *supra* note 63, § 6.03, at 6-7, 6-8 (citing *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947)).

118. *Shapiro*, 161 F.2d at 410.

work need not be written simultaneously as long as both joint authors contributed to the joint work and intended a joint work.¹¹⁹ Freeman's and Weissmann's contributions, although made at different times, involved different versions of substantially the same material¹²⁰ and should be considered as intent to create a joint work.

Legal commentator Melville Nimmer noted that both *Marks* and "*Melancholy Baby*" are good law under the 1976 Copyright Act;¹²¹ therefore, both the objective and subjective standards of intention and joint authorship are acceptable standards.

In a note authored by Therese Brady, the argument was made that the Second Circuit correctly applied an objective standard of intent regarding joint authorship.¹²² Although the author may

119. See *id* at 410; see also 1 NIMMER, *supra* note 63, § 6.03 at 6-7, 6-8. [T]he "*Melancholy Baby*" case[] h[e]ld that the design of collaboration between joint authors need be preconcerted only in the sense that at the time each author makes his contribution he intends that it shall be an integrated part of a greater work with supplementary contributions to be made by one or more others.

1 NIMMER, *supra* note 63, § 6.03 at 6-8.

120. See *Weissmann v. Freeman*, 684 F. Supp. 1248, 1253-54 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 1989).

The parties began collaborating on and pursuing a common design of investigating the use of IDA derivatives while Weissmann was a fourth-year resident. They published their first jointly authored article concerning IDA scanning, or scintigraphy, in January 1979. A series of journal articles followed over the next several years on the use of IDA scanning in biliary disease, published in the names of Weissmann, Freeman and other investigators The allegedly infringed syllabus ("P-1") originated as a result of this collaboration between the plaintiff and the defendant Plaintiff testified, in substance, that from the very beginning when she started as a resident, Dr. Freeman had made it clear to her that there are different kinds of articles that "we" write She testified that "he was responsible for what I was saying, but I really was doing the primary research."

Id. at 1253-54.

121. See 1 NIMMER, *supra* note 63, § 6.03 at 6-8.

122. *Manifest Intent*, *supra* note 23, at 272-73 (citing, *inter alia*, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. (1989)). For a discussion regarding the relationship between intent and joint authorship, see Michael F. Bowman, Comment, *The Second Circuit's Analysis*

indeed be correct, her argument ignores both Freeman's and Weissmann's subjective intent. It is worth asking whether the Second Circuit's decision would change if it could be demonstrated that at the time of publication of P-1, Weissmann intended Freeman to be a joint author, even if she omitted Freeman's name. According to the Brady article and the Second Circuit, Weissmann's *original* subjective intent can be disregarded. Instead, the court, as an objective observer, would decide the nature of the intent. It is this author's submission that the objective standard of intent is too inflexible and may lead to inequitable results.

III. INTENT AND DERIVATIVE WORKS

Weissmann and Freeman, as joint authors, each had the right to create a solely owned derivative work based upon the jointly authored work.¹²³ Joint authorship and derivative works may be mutually exclusive.¹²⁴ The district court disregarded Weissmann's attempt to prove her intent to make a derivative work by questioning her credibility in pursuing the copyright suit.¹²⁵ The court found that the suit was actually brought for personal reasons against Montefiore Hospital and Freeman.¹²⁶ It

of Derivative Works by Joint Authors: Good Law -- Poor Application, 56 BROOK. L. REV. 551, 568-75 (1990) [hereinafter *Joint Authors*].

123. See *Weissmann v. Freeman*, 868 F.2d 1313, 1319 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

124. See *id.* at 1318.

[B]ecause Dr. Freeman conceded that he had not participated in drafting the new matter included in P-1, it follows as a logical corollary, therefore, that he acquired no interest in or right to use P-1 beyond those rights which he had as co-author in the prior joint material incorporated into P-1.

Id.

125. *Weissmann v. Freeman*, 684 F. Supp. 1248, 1258 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). The court, "[b]ased upon the parties' testimony and demeanor, illumined by the documentary evidence and the testimony of non-party witnesses . . . resolve[d] the issues of credibility in favor of defendant and against plaintiff." *Id.*

126. *Id.*

noted Weissmann's hostile demeanor and that her responses to questions were contradictory to "testimonial proof."¹²⁷

The Second Circuit, however, dismissed the issue of Weissmann's credibility as unrelated to the intent to form a copyrightable derivative work.¹²⁸ Instead, the court relied on the plain meaning of the copyright statute regarding a derivative work to find Freeman in violation of the Copyright Act.¹²⁹

The court criticized Freeman for "fail[ing] to rebut the *prima facie* showing of copyrightability [Weissmann] obtained by her certificate of copyright registration."¹³⁰ Copyright registration is, however, permissive; it is not a condition of copyright protection.¹³¹ The owner of the copyright may register after learning of the infringement and then immediately file suit.¹³² In a note by Brian Murray, the author incorrectly argued that had Weissmann intended to write a copyrightable derivative work, she would have immediately obtained a certificate of copyright.¹³³

The Second Circuit correctly stated that the intention to have a solely owned copyrightable derivative work should prevail since both joint authors have the right to create a derivative work based

127. *Id.*

128. *Weissmann v. Freeman*, 868 F.2d 1313, 1323 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). The court stated that "[c]redibility might have been relevant, for example, had the question of who actually authored the new material been contested. But it is scarcely pertinent to determining whether the newly-added material satisfies the statutory requirements for protectability." *Id.*

129. *Id.* at 1322-23 (citing 17 U.S.C. §§ 101, 103(b) (1988)); *see supra* note 86 and accompanying text.

130. *Id.* at 1323.

131. *See* 17 U.S.C. § 408(a) (1988). "At any time during the subsistence of copyright in any published or unpublished work, the owner of copyright in the work *may* obtain registration of the copyright claim" *Id.*

132. *Id.* § 411(a). "[N]o action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made" *Id.*

133. *Derivative Works*, *supra* note 11, at 607-08. The author stated that: "[H]ad Dr. Weissmann filed for a certificate for P-1 immediately after she completed it, this would have evinced an intent to have written an individual derivative work." *Id.* at 608 n.41.

on joint authorship.¹³⁴ However, the Second Circuit could have held that P-1 was a joint derivative work.¹³⁵

IV. WHAT STANDARD OF ORIGINALITY SHOULD HAVE BEEN APPLIED IN ORDER TO MAKE A SOLELY OWNED COPYRIGHTABLE DERIVATIVE WORK BASED UPON A JOINT WORK

A work of authorship must be original to be entitled to copyright protection.¹³⁶ Therefore, a derivative work must also be original in order to receive copyright protection.¹³⁷

“In determining whether [the new] work based upon a prior work is separately copyrightable as a derivative or collective work the court may *not* properly consider whether the new work is a qualitative improvement over the prior work.”¹³⁸ Additionally, to be original, the work must be independently created.¹³⁹ The standard of originality, in the Second Circuit, for a copyrightable derivative work is “more than a ‘merely trivial’ variation.”¹⁴⁰

134. See *Weissmann*, 868 F.2d at 1318-20.

135. *Id.* at 1327 (Pierce, J., concurring). “[H]ad [Dr. Weissmann] intended the work to be joint[,] Dr. Freeman could have been deemed a joint author simply by virtue of his contributions to the earlier work, into which Dr. Weissmann’s material would have been ‘merged.’” *Id.* (citing, *inter alia*, *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944)).

136. See 17 U.S.C. § 102(a) (1988); see *supra* note 1 for text.

137. I NIMMER, *supra* note 63, § 3.03 at 3-9 (1990). “A derivative work consists of a contribution of original material to a pre-existing work so as to recast, transform or adapt the preexisting work.” *Id.* (footnote omitted).

138. 1 *id.* § 3.03 at 3-10 (emphasis added).

139. *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219, 1223 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987). “It is not necessary that the work be novel or unique, but only that the work have its origin with the author — that it be independently created.” *Id.* (citing *Hutchinson Telephone Co. v. Frontier Directory Co. of Minnesota, Inc.*, 770 F.2d 128, 131 (8th Cir. 1985)).

140. *Weissmann v. Freeman*, 868 F.2d 1313, 1321 (2d Cir.) (quoting *Alfred E. Bell & Co. v. Cataldo Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951)), *cert. denied*, 110 S. Ct. 219 (1989).

A key issue in *Weissmann*¹⁴¹ was whether Freeman's appropriation of P-1 constituted copyright infringement.¹⁴² Freeman argued that P-1 consisted mainly of his own original work and therefore could not be accused of verbatim copying of his own work.¹⁴³ Thus, it must be determined whether Weissmann's minimal contributions in P-1 rise to the level of "more than merely trivial and were, thus, original."¹⁴⁴

In *West Publishing Co. v. Mead Data Central, Inc.*,¹⁴⁵ West Publishing Co. alleged Mead Data had infringed West's copyright in its "star pagination" system.¹⁴⁶ The United States Court of Appeals for the Eighth Circuit held that West's particular arrangement of legal decisions was original¹⁴⁷ and was entitled to copyright protection. Therefore, Mead Data's "wholesale appropriation of pagination from West's legal case

141. 684 F. Supp. 1248 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

142. *Id.* at 1260.

143. *Id.* at 1257.

144. See *Alfred E. Bell & Co. v. Cataldo Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951). "All that is needed to satisfy the Constitution and the statute is that the 'author' contributed something recognizably 'his own.'" *Id.* (citation omitted).

145. 799 F.2d 1219 (8th Cir. 1986).

146. *Id.* at 1221. The court found that:

[Mead's "star pagination"] service, named the LEXIS Star Pagination Feature . . . would insert page numbers from West's National Reporter System into the body of LEXIS reports, providing "jump" or "pinpoint" citations to the location in West's reporter of the material viewed on LEXIS. Thus, with the LEXIS Star Pagination Feature, LEXIS users would be able to determine the West page number corresponding to the portion of an opinion viewed on LEXIS without ever physically referring to the West publication in which the opinion appears.

Id. at 1222.

147. *Id.* at 1227. The court stated that "[t]o be the original work of an author, a work must be the product of some 'creative intellectual or aesthetic labor.'" *Id.* at 1223 (quoting *Goldstein v. California*, 412 U.S. 546, 561 (1973)). The court concluded "that the arrangement West produces through [its publishing] process is the result of considerable labor, talent, and judgment." *Id.* at 1226. Therefore, the court found that West's case arrangements met the "intellectual-creation requirements." *Id.* at 1227.

reports would infringe its copyright in arrangement.”¹⁴⁸

In *Weissmann*,¹⁴⁹ the district court found that Weissmann’s modifications were merely trivial.¹⁵⁰ The court stated that the minimal changes made in P-1 represented typical updating of an annual joint syllabus and, thus, were not original, foreclosing copyright protection.¹⁵¹

The Second Circuit, in its *de novo* review, reversed, finding that Weissmann’s modifications met the criteria for originality.¹⁵² The court stated that two basic principles were involved: “(1) A derivative work must be more than ‘merely trivial’ to be copyrightable¹⁵³ and (2) the protection afforded the copyright work must reflect the degree to which the derivative work relies upon the pre-existing work.”¹⁵⁴ Both the district court¹⁵⁵ and the Second Circuit¹⁵⁶ applied the same standard of originality: *more than merely trivial*. However, the two courts, applying the same facts, reached opposite conclusions as to whether P-1 was a derivative work entitled to copyright protection.¹⁵⁷

148. *Id.* at 1228.

149. 684 F. Supp. 1248 (S.D.N.Y. 1988), *aff’d in part, rev’d in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

150. *Id.* at 1261. The court found that “[t]he few sentences and ‘paragraph or two’ that Freeman concedes Weissmann may have added to the prior jointly authored works amounts to ‘only a miniscule variation, demonstrating no more than trivial originality.’” *Id.* (quoting *Past Pluto Productions Corp. v. Dana*, 627 F. Supp. 1435, 1441 (S.D.N.Y. 1986)).

151. *Id.*

152. *Weissmann v. Freeman*, 868 F.2d 1313, 1322-23 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). “The originality requirement for a revised version is a ‘minimal’ or ‘modest’ one.” *Id.* at 1321 (citing *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 35 (2d Cir. 1982)).

153. *Id.* (citing *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 909 (2d Cir. 1980)).

154. *Id.*

155. *Weissmann v. Freeman*, 684 F. Supp. 1248, 1260 (S.D.N.Y. 1988), *aff’d in part, rev’d in part*, 868 F.2d 1313 (2d Cir. 1989), *cert. denied*, 110 S. Ct. 219 (1989).

156. *Weissmann v. Freeman*, 868 F.2d 1313, 1321 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

157. The circuit court stated:

[T]he district court’s holding that Weissmann could not acquire a copyright in a derivative work based upon a jointly authored work was

The Second Circuit stated that “[i]n the law of copyright, only an unmistakable dash of originality need be demonstrated, high standards of uniqueness are dispensed with.”¹⁵⁸ The Second Circuit’s standard for originality is generally a minimal one.¹⁵⁹ However, some of the other circuits have a more substantial standard of originality,¹⁶⁰ which may be more appropriate when, as in this case, a derivative work is based on a prior joint work.¹⁶¹ The Second Circuit failed to acknowledge that the court in *Durham Industries, Inc. v. Tomy Corp.*¹⁶² stated that copyrightability requires “some *substantial*, not merely trivial,

an error of law that disregarded the provision of [17 U.S.C.] § 103(b) and the protection it extends to derivative works. Moreover, Dr. Freeman failed to rebut the *prima facie* showing of copyrightability appellant obtained by her certificate of copyright registration. As a consequence, [the circuit court held] that Dr. Weissmann’s additions and modifications to the preexisting joint work satisfy the modest requirements set forth in § 103(b) and in relevant case law sufficient to make P-1 entitled to copyright protection as a derivative work.

Weissmann, 868 F.2d at 1323.

158. *Id.* at 1321; *but see Derivative Works*, *supra* note 11, at 603 n.8 (“It is well settled that in order to qualify for a separate copyright, the derivative work must contain some substantial and not merely trivial originality.”) *Id.* (quoting *Sherry Mfg. Co. v. Towel King of Fla., Inc.*, 753 F.2d 1565, 1568 (11th Cir. 1985)).

159. *See supra* note 152 and accompanying text.

160. *See Derivative Works*, *supra* note 11, at 602-03 n.6-8. The “requirement of substantial variation is inherent in the concept of originality.” *Id.* (citing *Sherry Mfg. Co. v. Towel King of Fla., Inc.*, 753 F.2d 1565, 1568 (11th Cir. 1985) (“the derivative work must contain some substantially, not merely trivial, originality in order to qualify for separate copyright”); *L. Batlin & Sons Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir.) (en banc), *cert. denied*, 429 U.S. 857 (1976); *Donald v. Zack Meyer’s T.V. Sales & Serv.*, 426 F.2d 1027, 1030 (5th Cir. 1970) (variation must be “meaningful” and “substantial”); *Adventures in Good Eating, Inc. v. Best Places to Eat, Inc.*, 131 F.2d 809, 813 (7th Cir. 1942) (derivative copyrights may be obtained by an editor if she materially revises the work)).

161. *Weissmann*, 868 F.2d at 1315. The work at issue in the case involved an article written by a talented assistant scientist in the field of nuclear medicine based upon several scholarly scientific works previously published by the assistant jointly with her professor in the field. *Id.*

162. 630 F.2d 905 (2d Cir. 1980) (involving alleged copyright infringement by a competitor in marketing a line of toys).

originality.”¹⁶³ But even if the Second Circuit correctly adopted the minimal standard of originality, Weissmann’s modifications in P-1 fail to qualify even for that minimum. The Second Circuit noted that the new elements added by Weissmann to the existing prior/joint work¹⁶⁴ would satisfy the modest requirements of originality of section 103(b) of the copyright statute.¹⁶⁵ However, Weissmann’s “new elements,” were indeed quite minimal. Weissmann’s new elements consisted of selecting photo’s, referencing recent reports, adding new text, and rearrangement of material.¹⁶⁶ The only truly original aspect of Weissmann’s modifications was the inclusion of the section ‘false-positive,’ which was actually prepared by Freeman.¹⁶⁷ Weissmann’s remaining modifications were mechanical, not requiring much creativity. Therefore, Freeman, appears to be as

163. *Id.* at 910 (quoting *L. Batlin & Sons, Inc. v. Snyder*, 536 F.2d 486, 513 (2d Cir.) (en banc), *cert. denied*, 429 U.S. 857 (1976)).

164. *Weissmann*, 868 F.2d at 1322.

Dr. Weissmann added the following new elements to the existing prior joint work: (1) a selection and arrangement of photo illustrations and associated captions; (2) references to recent reports in the pertinent literature; (3) selections, condensation and description of additional source material; (4) several new textual additions; (5) substantial rearrangements of the manner and order of presentation of material contained in the parties’ prior joint works; and (6) the addition of a section on “congenital disorders,” a revised treatment of “chronic cholecystitis,” and the incorporation of Dr. Freeman’s “false-positive” studies.

Id.

165. *Id.* at 1323; 17 U.S.C. § 103(b) provides, in pertinent part:

The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such a work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

17 U.S.C. § 103(b) (1988).

166. *See supra* note 164.

167. *Weissmann*, 684 F. Supp. at 1256. “Freeman’s participation is strikingly illustrated by inclusion in P-1 of the section entitled ‘False-Positive Studies for Acute Cholecystitis,’ which unquestionably he composed.” *Id.*

much an author of P-1 as Weissmann. Had Weissmann's own contributions been more extensive, there would be little reason to question whether P-1 was indeed original and separately copyrightable.

A comment by Michael Bowman describes the two standards of originality, in copyright law, as the minimal or "Distinguishable Variation"¹⁶⁸ test and the "Substantial Variation"¹⁶⁹ test. Bowman accepts the minimal standard, as applied by the Second Circuit in *Weissmann*.¹⁷⁰ The Bowman comment, unlike the note by Murray,¹⁷¹ failed to recognize the application of originality, whereby either joint author may create a copyrightable derivative work based upon prior joint authorship.¹⁷²

The minimal standard of originality employed by the Second Circuit impedes the rights of joint authors. The Murray note correctly stated that the Second Circuit should apply a higher standard of originality to hold that a derivative work has been created from a joint work.¹⁷³ The higher standard of substantial originality, applied in other jurisdictions,¹⁷⁴ would preclude P-1

168. *Joint Authors, supra* note 122 at 565 . This test holds that "any distinguishable nontrivial variation will suffice for copyright protection." *Id.* at 565-66 (citing *Alfred Bell v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951)).

169. *Id.* at 566. The "Substantial Variation" test holds "that a derivative work, to be copyrightable, must be substantially different from the underlying work." *Id.* (citing *Gracen v. Bradford Exchange*, 698 F.2d 300, 305 (7th Cir. 1983)). "[H]ere, a substantial variation is required rather than the mere distinguishable variation required in *Alfred Bell*." *Id.*

170. *Id.* at 568. "[Weissmann's] additions and variations pass the 'distinguishable variation' test employed by the Second Circuit. The report was therefore properly granted copyright protection as a derivative work." *Id.*

171. *See generally Derivative Works, supra* note 11.

172. *Id.* at 610. The author commented that:

It is suggested that the standard of substantial originality is the appropriate copyright test since it would properly enable the joint author to escape the shackles of his prior collaborative efforts, and facilitate the court's role in separating legitimate derivative works from ordinary updates pursuant to a joint authorship agreement.

Id.

173. *Id.* at 607.

174. *Id.* at 612 (citing *Gracen v. Bradford Exchange*, 698 F.2d 300, 305 (7th Cir. 1983)). In *Gracen v. Bradford Exchange*, the court stated "the

from being copyrightable as a solely owned derivative work. In *Weissmann*, the minimal standard allowed Weissmann, through trivial changes in the stock piece, to deprive her senior co-author, Freeman, of some of the fruits of his endeavors.

Although the matter and the applicable standards of intent relating to joint authorship and derivative works are subject to different views, the Second Circuit has erred in finding that P-1 was a solely owned copyrightable derivative work since the only truly original part of P-1 was actually authored by Freeman. But even if P-1 was a derivative work, Freeman was entitled to the defense of fair use.

V. AVAILABILITY OF THE AFFIRMATIVE DEFENSE OF FAIR USE

In *Weissmann v. Freeman*,¹⁷⁵ Freeman argued that the use of P-1 would have been a fair use;¹⁷⁶ the district court agreed.¹⁷⁷ However, the Second Circuit, reviewing all four factors of fair use, decided against Freeman.¹⁷⁸

Fair use is an affirmative defense, described as a "mixed question of fact and law."¹⁷⁹ In determining whether the defense of fair use should be allowed, courts must weigh four statutory factors:

purpose of the term [original] in copyright law is not to guide aesthetic judgments but to assure a sufficiently gross difference between the underlying and the derivative work to avoid entangling subsequent artists depicting the underlying work in copyright problems." 698 F.2d 300, 305 (7th Cir. 1983).

175. 684 F. Supp. 1248 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

176. Brief for Defendant-Appellee at 30, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

177. *Weissmann*, 684 F. Supp. at 1261.

178. *Weissmann*, 868 F.2d at 1326. The court stated "[w]hen all of the statutory factors are considered in the context of scholarly scientific research and publication, they weigh against Dr. Freeman's right to invoke the fair use defense in Dr. Weissmann's infringement suit against him." *Id.*

179. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 560 (1985) (citing *Pacific & Southern Co. v. Duncan*, 744 F.2d 1490, 1495 n.8 (11th Cir. 1984)).

(1) the purpose and character of the use, including whether such use is for commercial or nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for the copyrighted work.¹⁸⁰

The fair use defense is difficult to understand and apply. There is no established formula for the application of these factors, but courts seem to give the most weight to the fourth factor -- effect on the market.¹⁸¹

The fair use defense could immunize certain conduct, such as Freeman's, that would otherwise be an infringement of copyright by permitting the reasonable use of copyrightable material, without consent of the owner, where that use is in the interest of the public.¹⁸² Freeman's argument, that fair use is allowed for educational purposes, is supported by the copyright statute.¹⁸³ P-1's purpose -- to aid in educating nuclear medicine physicians -- was educational.¹⁸⁴ The advancement of science is a public

180. 17 U.S.C. § 107 (1988).

181. See *Weissmann*, 868 F.2d at 1325. "The fourth factor is the most important one in determining fair use." *Id.*

182. *Id.* at 1323. "[Fair use] creates a privilege for others to use the copyrighted material in a reasonable manner despite the lack of the owner's consent." *Id.* (citing *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 306 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967)). "The doctrine balances the exclusive right of copyright owners against 'the public's interest in the dissemination of information affecting areas of universal concern, such as art, science and industry.'" *Id.* (quoting *Wainwright Securities, Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91, 94 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978)).

183. See 17 U.S.C. § 107 (1988) ("[T]he fair use of a copyright work, including such use by reproduction in copies . . . teaching . . . scholarship, or research, is not an infringement of copyright . . .") *Id.*

184. *Weissmann*, 684 F. Supp. at 1254.

The allegedly infringed syllabus ("P-1") originated as a result of this collaboration between the plaintiff and the defendant. The work in which plaintiff claims a copyright is a syllabus -- a review paper providing an overview of the potential and of the current state of the art of specific research being done in the particular field, in this case hepatobiliary imaging techniques.

Id.

interest. Freeman was intending to distribute the syllabus to help the attendees better understand the lecture.

The fair use defense attempts to balance the creator's right to profit from her expressions and the public's right to information regarding scientific discoveries.¹⁸⁵

A. *The Purpose and Character of the Use*

Freeman argued that the primary purpose of P-1 was educational, the most appropriate reason for fair use of these materials.¹⁸⁶ Commentator Nimmer's treatise emphasizes the relationship between fair use and educational purposes.¹⁸⁷ The district court stated that although Freeman used P-1 to receive an honorarium of \$250,¹⁸⁸ such purpose was not commercial in that an honorarium of \$250 is *de minimis*.¹⁸⁹

Weissmann argued that the purpose of the use of the material was indeed commercial, for Freeman's economic benefit.¹⁹⁰ The

185. See Catherine A. Diviney, Comment, *Guardian of the Public Interest: An Alternative Application of the Fair Use Doctrine in Salinger v. Random House Inc.*, 61 St. John's L. Rev. 615, 616-18, (1987). "[T]he fair use doctrine attempts to strike a balance between the public's interest and the copyright holder's interest by permitting restricted use of the public works without compensation to the author when the public's interest in the circulation of new ideas outweighs the creator's financial interest." *Id.*

186. *Weissmann*, 684 F. Supp. at 1262. ("Freeman's contemplated use was entirely noncommercial and for nonprofit educational uses.") *Id.*

187. 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 13.05[A] at 13-84 - 85 [hereinafter 3 NIMMER]. "Section 107 enumerate[s] . . . purposes . . . most appropriate for a finding of fair use. These are . . . teaching (including multiple copies for classroom use), scholarship or research." *Id.*

188. *Weissmann*, 684 F. Supp. at 1262. The court stated that "the crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price." *Id.* at 1261 (citing *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 562 (1985)).

189. *Id.* at 1262. "Freeman neither profited from the paper's use . . . nor stood to profit had he included the syllabus in the course materials." *Id.*

190. Brief for Plaintiff-Appellant at 42, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

Second Circuit, relying on *Marcus v. Rowley*,¹⁹¹ indicated that lack of a profit motive does not always indicate fair use.¹⁹² The court stated that Freeman's purpose was not just money but also recognition.¹⁹³

The district court better analyzed this factor relating to the purpose and character of the use than did the Second Circuit. A syllabus is only of value when it is used in conjunction with a more complete presentation of the material, for example, a lecture. One must also question the Second Circuit as to why Freeman would have to pay someone else for the use of "his own" work.

B. The Nature of the Work

Educational materials may consist of factual works. The law recognizes the need to disseminate factual works and textbooks rather than works of fiction.¹⁹⁴ Judge Pollack, of the district

To call this "entirely non-commercial and for non-profit educational purposes" masks the actual circumstances in this case. In the immediate sense, defendant's submissions to Mount Sinai and the Republic of China International Symposium were to meet the conference requirements that each speaker write his own paper as a condition of his appearance.

Id.

191. 695 F.2d 1171 (9th Cir. 1983).

192. *Weissmann v. Freeman*, 868 F.2d 1313, 1324 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). The court stated that "[t]he absence of a dollar and cents profit does not inevitably lead to a finding of fair use." *Id.* (citing *Marcus v. Rowley*, 695 F.2d 1175 (9th Cir. 1983) (involving the unauthorized use of a copyrighted booklet on cake decorating)).

193. *Id.* The court stated that:

[M]onetary gain is not the sole criterion. Dr. Freeman stood to gain recognition among his peers in the profession and authorship credit with his attempted use of Weissmann's article; he did so without paying the usual price that accompanies scientific research and writing Particularly in an academic setting, profit is ill-measured in dollars. Instead, what is valuable is recognition because it so often influences professional advancement and academic tenure.

Id.

194. *See* 3 NIMMER, *supra* note 187, § 13.05[A] at 13-75. "Textbooks and other material prepared for the school market would be less susceptible to the reproduction for classroom use than material prepared for general public

court, found that the *nature of the work* was nonfiction, factual, and scientific.¹⁹⁵ The district court weighed this factor heavily in favor of Freeman.¹⁹⁶

“The scope of fair use is narrower with respect to unpublished works.”¹⁹⁷ Freeman argued that the protections afforded to unpublished works are not implicated because P-1 did not report original research and had been disseminated in 1985, two years before Freeman’s use.¹⁹⁸

Weissmann rebutted Freeman’s assertions by arguing that the nature of this copyrighted work was not considered in the academic context.¹⁹⁹ The Second Circuit seemed to agree with Weissmann, stating that the “nature of the work” factor did not balance in favor of either party but noted that the district court

distribution.” *Id.* (citing, *inter alia*, Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171 (5th Cir. 1980)).

195. *Weissmann*, 684 F. Supp. at 1262. The court found that “[t]he syllabus here is factual and scientific in nature and it was disseminated by Weissmann herself and published in the 1985 RSNA booklet.” *Id.*

196. *Id.* The court stated that “[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy.” *Id.* (citing Harper & Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 563 (1985)).

197. 3 NIMMER, *supra* note 187, § 13.05[A][2] at 13-75 (citing, *inter alia*, American Medical Colleges v. Mikaelian, 571 F. Supp. 144 (E.D.Pa. 1983), *aff’d per curiam*, 734 F.2d 3 (3rd Cir. 1984)).

198. *See* Brief for the Defendant-Appellee at 32, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

199. Brief for Plaintiff-Appellant at 46-47, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465). Weissmann stated that the scientific nature of the work must be considered and that she was entitled to a fair return for her efforts:

The nature of the copyrighted work is a nonfiction reference and instructional work in the scientific area [T]he rights conferred by the copyright to such works . . . are designed to serve as an incentive to their preparation by assuring a ‘fair return’ to their authors. That return can be directly monetary or professional advancement with all of its indirect but nevertheless obvious professional and monetary benefits In a practical sense, to expand fair use to allow defendant’s conduct would effectively destroy any expectation of meaningful copyright protection for works of this kind, seriously undermining the incentive to their creation.

Id. (citation omitted).

failed to consider economic incentives.²⁰⁰ Furthermore, the court added that scientific works especially need copyright protection.²⁰¹

The district court analyzed this second factor better than the Second Circuit. The Second Circuit failed to give due emphasis to the fact that P-1 was a scientific factual work, primarily based on a prior joint work to which Freeman was a substantial contributor, and that it had previously been published.

C. The Amount and Substantiality of the Use

The third factor of the fair use determination is “the amount and substantiality of the portion used in relation to the copyrighted works as a whole”²⁰² This raises the issue of “substantial similarity” rather than whether the use is “fair.”²⁰³ This includes a determination of not just quantitative but also qualitative substantiality. In any event, whatever the use, generally it is not a fair use if the entire work is reproduced.²⁰⁴ The district court found that Freeman only reproduced a minimal amount, which represented Weissmann’s new work.²⁰⁵

Freeman argued that the “Twenty Five Hundred Word

200. *Weissmann*, 868 F.2d at 1325. The court stated that “the incentive interests . . . balance the equitable scales so that the nature of the work factor does not tip decidedly in favor of either party.” *Id.*

201. *Id.* The court stated:

[I]t is necessary to keep in mind the danger that allowing appropriation of scientific works presents. The personal gain sought by Dr. Weissmann may not be directly related to immediate financial gain, but the copyright protection extended to her work . . . provides her with an incentive to continue research -- an endeavor that . . . has led to professional and scientific benefits.

Id.

202. 17 U.S.C. § 107(3) (1988).

203. See 3 NIMMER, *supra* note 187, § 13.05 at 13-81.

204. 3 *id.* § 13.05 at 13-80 to -81.

205. *Weissmann*, 684 F. Supp. at 1262. “Although Freeman copied all of P-1, the content virtually in its entirety had been published in the name of both parties as joint authors, reducing to *de minimus* the very slight additions to the work [made by Dr. Weissmann].” *Id.*

Test”²⁰⁶ of brevity required by the congressional guidelines did not apply to all of P-1, but only to that part that was new matter.²⁰⁷

Weissmann argued that fair use should not be extended to complete verbatim copying.²⁰⁸ This position was adopted by the Second Circuit.²⁰⁹

The Second Circuit disagreed with the district court, finding that the entire work was copied and that Weissmann’s additions, incorporated into P-1, were significant.²¹⁰ The Second Circuit

206. The Congressional Guidelines for multiple copies for classroom use permits multiple copies to be made by a teacher for use in the classroom or discussions, so long as the copied material is less than 2,500 words. H.R. REP. No. 1476, 94th Cong., 2d Sess. 68 (1976).

207. Brief for Defendant-Appellee at 32-33, *Weissmann v. Freeman* 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465) (citing *Marcus v. Rowley*, 695 F.2d 1171 (9th Cir. 1983); H.R. REP. No. 1476, 94th Cong., 2d Sess. 68, 70 (1976)). Freeman argued that the 2,500 word test “could have been exceeded only if all of P-1 is considered; but Weissmann might protect only the new matter in P-1 . . . which does not exceed 2,500 words. This factor favors Dr. Freeman.” *Id.*

208 Brief for Plaintiff-Appellant at 48-49 n.67, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989), (No. 88-7435, 7465). Weissmann emphasized that verbatim copying amounts to plagiarism: “The fact that a substantial portion of the infringing work was copied verbatim is evidence of a qualitative value of the copied material, both to the originator and to the plagiarist who seeks to profit from marketing someone else’s copyrighted expression.” *Id.* (quoting *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 565 (1985)).

In *Harper*, Justice O’Connor stated that “no plagiarist can excuse the wrong by showing how much he did not pirate.” *Harper & Row*, 471 U.S. at 565 (quoting *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir.), *cert. denied*, 298 U.S. 669 (1936)).

209. *Weissmann*, 868 F.2d at 1325. “[The court has] previously held that the fair use privilege is grounded upon reasonableness, which may not be found in cases where there has been extensive verbatim copying or paraphrasing of another’s material.” See Plaintiff-Appellants’ Brief at 47, *Weissmann*, (No. 88-7435, 7465). “The fair use privilege is based upon the concept of reasonableness and extensive verbatim copying or paraphrasing of material set down by another cannot satisfy that standard.” *Id.* (quoting *Rosemont Enters. v. Random House, Inc.*, 366 F.2d 303, 310 (2d Cir. 1966), *cert.denied*, 385 U.S. 1009 (1967)).

210. *Weissmann*, 868 F.2d at 1325. “[T]he district court concluded —

relied primarily on Nimmer's comments about verbatim copying and found that verbatim copying cannot be a fair use.²¹¹ Thus, the court found that the third factor -- the amount and substantiality of the use -- was in favor of Weissmann.²¹²

Again, the district court better analyzed this statutory fair use factor. The Second Circuit failed to give sufficient weight to Freeman's contributions to the original joint work. Weissmann only had copyright protection in that part of the derivative work that was original, a very small portion of the complete work.

D. The Effect of the Market for or Value of the Copyrighted Work

Legal commentator Nimmer referred to the fourth factor as "[t]he [e]ffect upon [p]laintiff's [p]otential [m]arket."²¹³ This fourth factor -- the most important statutory factor²¹⁴ -- does more than raise "the question of the extent of damages to [a] plaintiff caused by the particular activities of the defendant."²¹⁵

In *Weissmann*, Freeman noted that Weissmann had failed to "allege any diminution in the market for the value of P-1."²¹⁶

consistent with its finding that P-1 was not a copyrightable derivative work -- that Dr. Freeman's copying of Dr. Weissmann's 'slight additions' to the underlying joint work reduced the copying to a '*de minimus*' violation. We disagree." *Id.*

211. *Id.* "[W]hatever the use, generally it may not constitute a fair use if the entire work is reproduced." *Id.* (quoting 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 13.05[A][3] at 13-88.10 to -88.11 (1985)).

212. *Id.* The court stated that "[t]he subject work was impermissibly photocopied word-for-word with the only changes being the modification of the title and the substitution of credit for authorship; such use is patently not reasonable and the trial court's finding that it was *de minimus* is clearly erroneous." *Id.*

213. 3 NIMMER, *supra* note 187, § 13.05[A][4], at 13-88.11 .

214. 3 *id.* "[T]his [is] the most important factor pos[ing] the issue of whether unrestricted and widespread conduct (. . . engaged in by the defendant or by others) . . . would result in a substantially adverse impact on the potential market for or value of plaintiff's present work." *Id.* 13.05[A] at 13-88.11 - 88.12 (citing Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 566 (1985)).

215. 3 *id.* at 13-88.12.

216. Brief for Defendant-Appellee at 33, *Weissmann v. Freeman*, 868 F.2d

Clearly, there was no adverse market effect — “the single most important element of fair use.”²¹⁷

The district court concluded that Freeman’s intended use would *not* negatively affect the market or the value of P-1, but would actually increase the market value of the work.²¹⁸ Weissmann, on the other hand, argued that Freeman was a competitor.²¹⁹

The Second Circuit found for Weissmann on this fourth factor, stating that Weissmann and Freeman were competitors and that the market value included opportunities for promotion and advancement by Weissmann.²²⁰ The court stated these opportunities

1313 (2d Cir. 1989) (No. 88-7435, 7465).

217. *Id.* (quoting *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 566 (1985)).

218. *Weissmann*, 684 F. Supp. at 1262. The court stated that:

Freeman’s contemplated use of P-1 would not impair its market value at all, if any exists, and dissemination of the results of the research at Montefiore would in all likelihood only increase the “marketability” of the paper emanating from the department “Fair use is limited to copying by others which does not materially impair the marketability of the work which is copied”. . . . On balance, Dr. Freeman’s was a fair, intended use.

Id. (quoting *Harper & Row*, 471 U.S. at 566-67; quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 1.10[D] at 1-87 (1988)).

219. Brief for Plaintiff-Appellant at 49, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

Defendant’s use was competitive and totally substituted for plaintiff’s own The Taiwan Publication in 1986 included distribution of some 200 copies to professional colleagues who attended the conference including many Americans. A use of this kind in the small world of the parties’ specialty field has obviously significant adverse consequences with respect to plaintiff’s career advancement and is thereby seriously injurious economically [T]he misleading manner of defendant’s use here is misrepresenting authorship and misleading the conferences to which he submitted papers is also considered to have a negative impact with respect to this factor.

Id. at 49-50 (citing *Salinger v. Random House*, 811 F.2d 90, 99 (2d Cir.), *cert. denied*, 484 U.S. 890 (1987)).

220. *Weissmann*, 868 F.2d at 1325. The court stated that “[a]lthough it is self-evident that publication may increase marketability of departmental papers generally, we disagree with the district court’s conclusion that this factor

were denied by Freeman's unauthorized use of P-1.

Although the Second Circuit found that Weissmann was being deprived of the fruits of her labor,²²¹ the court failed to consider that Freeman might also be injured by not being a co-author of P-1.²²²

Thus the Second Circuit found that all four factors, on balance, weighed against Freeman's right to invoke the fair use defense against Weissmann's suit for copyright infringement.²²³

The district court, again, better recognized the realities involving the syllabus than did the Second Circuit. The proposed distribution of the syllabus, which never actually took place, could only make a difficult, sophisticated subject more understandable. Such use could only increase the value of P-1 in the scientific community, to the benefit of Weissmann as well as Freeman, especially if Weissmann were given adequate credit, which she was not.

VI. CRITICISM OF THE FOUR FACTORS -- THE FUNCTION TEST

Courts evaluate whether the defense of fair use may be employed according to overall basic fairness, which is an equitable

weighed in favor of Dr. Freeman." *Id.*

221. *Id.* at 1326. The court noted that:

The fact that Dr. Freeman's planned use of P-1 was for the same intrinsic purposes as that intended by Dr. Weissmann not only undermines Dr. Weissmann's ability to enjoy the fruits of her labor, but also creates a distinct disincentive for her to continue research and publish in the field of nuclear medicine.

Id.

222. *Id.* The court stated that:

The rewards that Congress planned for Copyright holders of scientific works to reap arguably include promotion and advancement in academia, where tenure decisions are often made on a "publish or perish" approach Dr. Freeman's planned use of P-1 . . . undermines Dr. Weissmann's ability to enjoy the fruits of her labor, [and] creates a disincentive for her to continue to research and publish in the field of nuclear medicine.

Id.

223. *Id.*

determination.²²⁴ The fourth factor, effect on the market, is generally given the most weight.²²⁵ Courts frequently seem to decide on the overall result and then determine how they will apply the arbitrary, statutory factors.

However, some observers question whether the statutory factors are even necessary.²²⁶ It is doubtful whether the four factors of Section 107 offer a comprehensive framework for determination of fair use.²²⁷

Because of the many ambiguities involved in applying the four factors of fair use, Nimmer proposes, instead, a functional test that emphasizes the fourth factor: the effect on the market.²²⁸ Nimmer applied the functional test to the case of *Harper & Row, Publishers, Inc. v. Nation Enterprises*.²²⁹ In *Harper & Row*,

224. See, e.g., *Weissmann v. Freeman*, 868 F.2d 1313, 1323 (2d Cir.) (“Analysis begins not by elevating the statutory guides into inflexible rules, but with a review of the underlying equities”) (citing *Financial Information, Inc. v. Moody’s Investors Serv., Inc.*, 751 F.2d 501, 508 (2d Cir. 1984) (fair use requires “sensitive balancing of interests”)), *cert. denied*, 110 S. Ct. 219 (1989); *Marcus v. Rowley*, 695 F.2d 1171, 1175 (9th Cir. 1983) (to make use of another’s copyright material fairly presupposes that the actor acted fairly and in good faith); see also 3 NIMMER, *supra* note 187, § 13.05[A] at 13-83 (“Fair use is to be determined by a consideration of all of the evidence.”).

225. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 566 (1985). The court stated that “[t]he last factor is undoubtedly the single most important element of fair use.” *Id.* (citing 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05[A] at 13-76 (1985)).

226. See 3 NIMMER, *supra* note 187, § 13.05[A][5] at 13-88.13.

[T]he four factors of Section 107 purport merely to aid analysis of whether a given use is “fair,” not to offer a comprehensive framework from which that answer may be mechanically determined. It is open to question, however, whether even that modest goal is achieved by the amorphous language of the statute.

Id.

227. 3 *id.* “*Harper & Row, Publishers, Inc. v. Nation Enterprises* demonstrates the almost infinite elasticity of each of the four factors, and their concomitant inability to resolve difficult questions.” *Id.*

228. 3 *id.* § 13.05[B] at 13-88.19. Nimmer’s functional test asks whether “defendant’s work, although containing substantially similar material, performs a different function than that of plaintiff’s, [then] the defense of fair use may be invoked.” *Id.*

229. 471 U.S. 539 (1985). Nimmer summarized the facts of the case, stating that:

former President Ford contracted with Harper & Row to publish his memoirs, giving them the exclusive first serial rights to license prepublication excerpts.²³⁰ Harper & Row subsequently negotiated a prepublication licensing agreement with Time Magazine, which gave Time the right to excerpt 7,500 words from the manuscript.²³¹ Prior to Time's release of the excerpt, an unauthorized source provided The Nation Magazine with the unpublished manuscript.²³² Time subsequently canceled its article and refused to pay Harper & Row.²³³

Harper & Row brought an action against The Nation alleging, *inter alia*, violations of the Copyright Act.²³⁴ The United States District Court, Southern District of New York held that the Ford memoirs were protected by copyright at the time of The Nation's publication and that its use constituted an infringement under the Act.²³⁵ The United States Court of Appeals for the Second Circuit reversed, holding that The Nation publication was fair use of the copyrighted material under Section 107 of the Act.²³⁶ The

In the *Nation* case, former President Gerald Ford contracted with Harper & Row and the Reader's Digest to publish his memoirs. Under contract, the publishers enjoyed the "exclusive right to license prepublication excerpts, known in the trade as first serial rights." The publishers in turn sold exclusive first serial rights to Time magazine for \$12,500 in advance and \$12,500 upon publication. Several weeks before the Time article's scheduled release, an editor of the Nation magazine surreptitiously obtained a copy of the Ford manuscript, and hastily composed a news story of facts, quotes, and paraphrases drawn exclusively from the manuscript The Nation's 2,250 word article contained 300 words quoted directly out of Ford's 200,000 word memoirs Time [subsequently] canceled its piece and exercised its contractual right not to pay the remaining \$12,500.

3 Nimmer, *supra* note 187, § 13.05 at 13-88.13, 88-14.

230. *Harper & Row*, 471 U.S. at 542.

231. *Id.* at 542-43.

232. *Id.* at 543.

233. *Id.*

234. *See Harper & Row, Publishers, Inc. v. Nation Enters.*, 557 F. Supp. 1067 (S.D.N.Y. 1983), *rev'd*, 723 F.2d 195 (2d Cir. 1983), *rev'd*, 471 U.S. 569 (1985).

235. *Id.* at 1070 (citing 17 U.S.C. §§ 102(a)(1), 107 (1988)).

236. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 208 (2d Cir. 1983), *rev'd*, 471 U.S. 569 (1985).

United States Supreme Court reversed, holding that The Nation's article was not fair use sanctioned by Section 107 of the Act.²³⁷

Instead of applying the four statutory factors, Nimmer noted that "the functional test poses the question whether the Nation article adversely affected the value of any of the rights in the Ford manuscript, regardless of whether or not the publishers had yet exercised those rights."²³⁸ Nimmer found that "the Nation article eliminated the value of the first serial right of the Ford manuscript, regardless of whether or not it diminished the book market. Following the appearance of the Nation article . . . the market for one of the rights belonging to the copyright-holders evaporated."²³⁹ Therefore, according to Nimmer, Nation should not be entitled to the defense of fair use.²⁴⁰

How would the functional test be applied to *Weissmann v. Freeman*? Although Freeman argued that Weissmann and he were collaborators,²⁴¹ Weissmann argued that they were competitors.²⁴²

Assuming that P-1 was a derivative work entitled to copyright protection and that Weissmann and Freeman had become competitors, the application of a functional test would weigh against Freeman because they were both noted researchers and teachers in the field of nuclear medicine. Moreover, P-1 would serve the same function for defendant as it would for the plaintiff, and Dr. Freeman would not be entitled to the defense of fair use.

However, the functional test should not be dispositive in this case. Dr. Weissmann's victory deprives her prior co-author, Dr. Freeman, of his rights in material he previously supervised and

237. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 569 (1985).

238. 3 NIMMER, *supra* note 187, § 13.05[B] at 13-90.

239. 3 *id.* at 13-90 - 13.90.1.

240. 3 *id.* at 13-90.1. Nimmer noted that: "The Nation, may no more invoke the defense of fair use than could the maker of an unauthorized movie from a copyrighted novel -- both have usurped a valuable adaptation right with consequent damage to the copyright owner." *Id.* at 13-90.1.

241. Brief for Defendant-Appellee at 18, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

242. Brief for Plaintiff-Appellant at 49, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

authored.²⁴³

VII. WAS FREEMAN A PLAGIARIST?

Weissmann accused Freeman of plagiarism.²⁴⁴ The district court found that Freeman was not a plagiarist.²⁴⁵ After the Second Circuit supported Weissmann's claim of copyright infringement and petition for *writ of certiorari* was denied by the United States Supreme Court,²⁴⁶ Weissmann repeated that allegation.²⁴⁷

Freeman may have appeared inconsiderate and may have used poor judgment by removing Weissmann's name from the syllabus and substituting his own, but he is not a plagiarist.

Plagiarism is an intentional fraudulent act and is a far worse charge than copyright infringement.²⁴⁸ It is one thing to appropriate someone else's property interest without permission; it is quite different to steal someone else's ideas and pass them off as your own. Copyright infringement is an unfair practice for which there are damages.²⁴⁹ Plagiarism is a form of theft subject to punishment by a court should holders of the copyright bring suit.²⁵⁰

243. See *supra* notes 81, 120 and accompanying text.

244. See Brief for Plaintiff-Appellant at 48-49 n.67, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

245. *Weissmann v. Freeman*, 684 F. Supp. 1248, 1263 (S.D.N.Y. 1988), *aff'd in part, rev'd in part*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989). The district court stated that: "Dr. Freeman had neither motive nor need to plagiarize, considering his preeminent grasp of the subject." *Id.*

246. 110 S. Ct. 219 (1989).

247. See *Are Montefiore Hospital and The Albert Einstein College of Medicine Protecting a Plagiarist?*, N.Y. Times, May 13, 1990, § 4 (Advertisement), at 19.

248. "At best, plagiarism is the result of ignorance; at worst, it is dishonesty or the attempt to represent ideas, thoughts and words of others as one's own. It is intellectual theft." Elinor S. Schrader, *Perils and Pitfalls of Plagiarism and How to Avoid Them*, 31 ASS'N O.R. NURSES May 1980, at 981.

249. See 17 U.S.C. § 504 (1988).

250. "Plagiarism includes direct verbatim lifting of passages [t]he common characteristics of plagiarism is the failure to attribute words, ideas or

It seems ironic that Freeman should be publicly accused of plagiarism when neither the district court nor the Second Circuit found any evidence of plagiarism. The district court specifically noted that there was no evidence of plagiarism on the part of Freeman.²⁵¹ The Second Circuit made no mention of plagiarism.²⁵²

In retrospect, Freeman should probably have consulted Weissmann prior to removing her name from P-1. However, Freeman is not a plagiarist, and Weissmann and her allies are wrong to make such public accusations.²⁵³

VIII. MAY ATTORNEY'S FEES BE INCLUDED WITH OTHER REMEDIES?

Plaintiffs who prevail in copyright infringement suits may be awarded attorney's fees.²⁵⁴ Defendants who prevail will be awarded attorney's fees if the plaintiff's claims were "without arguable merit . . . or brought in bad faith."²⁵⁵

In *Weissmann*, the district court chose not to award attorney's fees to Freeman.²⁵⁶ Similarly, the Second Circuit found that

findings to their true authors Plagiarism of published work violates copyright laws as well as standards of honesty." AMERICAN MEDICAL ASSOCIATION, MANUAL OF STYLE 72 (8th ed. 1989).

251. See *supra* note 245.

252. See generally *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir.), cert. denied, 110 S. Ct. 219 (1989).

253. See, e.g., *Are Montefiore Hospital and The Albert Einstein College of Medicine Protecting A Plagiarist?*, N.Y. Times, May 13, 1990, § 4 (Advertisement), at 19; see also H.R. REP. NO. 688, 101st Cong., 2d Sess. (1990).

254. See, e.g., 17 U.S.C. § 505 (1988), which states, in pertinent part, that "the court may . . . award a reasonable attorney's fee to the prevailing party as part of the cost." *Id.*; see also 3 NIMMER, *supra* note 187, § 14.10 at 14-76.

255. *Whimsicality, Inc. v. Rubie's Costume Co., Inc.*, 891 F.2d 452, 457 (2d Cir. 1989) (quoting *Roth v. Pritikin*, 787 F.2d 54, 57 (2d Cir. 1986)). In *Whimsicality*, the Second Circuit found that Whimsicality made a willful misrepresentation in a copyright application which amounted to "bad faith." *Id.* The court, therefore, remanded the case for determination of attorney's fees to Rubie's. *Id.*

256. *Weissmann*, 684 F. Supp. at 1261. "It will serve no useful purpose to

neither Weissmann²⁵⁷ nor Freeman²⁵⁸ was entitled to attorney's fees.

Remedies for copyright infringement may consist of monetary damages and injunctive relief.²⁵⁹ The copyright owner may choose between actual and statutory damages.²⁶⁰ The copyright owner is entitled to "actual damages suffered . . . and any profits of the infringer attributable to the infringement."²⁶¹ Statutory damages can range from \$500 to \$20,000 "as the court considers just."²⁶² If the court finds that the "infringement was committed willfully," however, it may increase the statutory damages to \$100,000.²⁶³

In *Weissmann*,²⁶⁴ the remedies available for copyright infringement included an injunction and money damages, presumably limited to the \$250 honorarium Freeman received for the lecture.²⁶⁵

perpetuate [Dr. Weissmann's] feuding by imposing attorney's fees, and in an endeavor to lay the emotions here involved to rest, the Court will treat the claims as an unfortunate lapse of judgment not requiring a penalty award of attorney's fees to defendant." *Id.*

257. *Weissmann*, 868 F.2d at 1316. The court noted that the "[a]ppellant consented to the dismissal of her claim for attorney's fees because the copyright she obtained covering P-1 was not registered before the suit was commenced, and such is a statutory prerequisite to a claim for attorney's fees." *Id.*

258. *Id.* at 1327. "[A]n award of attorney's fees to appellee is inappropriate in light of our holding." *Id.*

259. *See* 17 U.S.C. §§ 502, 504 (1988).

260. Section 504(a) provides: "an infringer of copyright is liable for either (1) the copyright owner's actual damages and any additional profits of the infringer . . . or (2) statutory damages . . ." 17 U.S.C. § 504(a) (1988) (emphasis added).

261. *Id.* § 504(b).

262. *Id.* § 504(c)(1).

263. *Id.* § 504(c)(2).

264. 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

265. *Id.* at 1316, 1324.

IX. WHAT ARE THE IMPLICATIONS OF THE
SECOND CIRCUIT DECISION ON CREATIVITY
IN SCIENTIFIC RESEARCH AND UPON
THE ACADEMIC COMMUNITY?

Today, medical research requires joint efforts. There is little place for the loner. An atmosphere of trust is essential to successful joint medical research. There is a need to reward scientific researchers for their creative accomplishments. Copyright deals with the tension between the need to protect the property rights of the copyright holder and the need to inform the public of scientific discoveries.²⁶⁶ If the balance were tipped too far in either direction, the cause of science would be impeded. This author believes that the Second Circuit decision in *Weissmann* will have a chilling effect on medical research.

The decision in *Weissmann*,²⁶⁷ deprives the original co-author of the fruits of his research. Weissmann admittedly provided new textual material in P-1.²⁶⁸ Seemingly, if one applies a minimal standard of originality, an author could write 80-85% of a joint work and be denied ownership rights in the copyrightable derivative work.²⁶⁹ This decision could, therefore, imperil relationships of joint authors within the academic environment who need mutual trust and intellectual honesty in order to be successful in these endeavors.

The Bowman article reviewed the Second Circuit's decision in *Weissmann*,²⁷⁰ and concluded that the decision furthered the purpose of copyright law by protecting the author's rights in the derivative work.²⁷¹ Bowman, however, erred in his analysis. The

266. See *supra* notes 6 and 182 and accompanying text.

267. 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

268. *Id.* at 1316; see *supra* note 164.

269. See *supra* note 168 and accompanying text.

270. 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

271. See *Joint Authors*, *supra* note 122, at 575. Bowman stated:

The main concern of copyright law is utilization of works and their availability to the public. These objectives are promoted by allowing co-authors to act independently of each other. By denying Freeman's ownership rights in Weissmann's derivative work, the Second Circuit

person deprived of authorship rights was Freeman rather than Weissmann. It was Freeman who was prevented from using P-1, even though he was co-author of most of the work and author of the only significant original portion ("False-Positive").²⁷² Copyright law recognizes that the public has a right to dissemination of information.²⁷³ The academic and scientific communities benefit from the free exchange of new ideas. Bowman is incorrect when he states that copyright law is best served when Freeman is denied ownership rights. The need to inform the public is best served by allowing Freeman, in addition to Weissmann, to freely utilize and disseminate the jointly authored derivative work.

Weissmann also has implications for the academic community.²⁷⁴ Joint scientific researchers and authors must work well together in order to "publish or perish." *Weissmann* teaches us that, as in a divorce, when the personal relationship disintegrates, there is a "Humpty Dumpty" result which the law cannot remedy.

Academic research often requires a spirit of cooperation and trust. Joint researchers, who are joint authors, may alternatively report scientific findings jointly and then individually.

Freeman evidently did not appreciate Weissmann's change of mind with respect to their status as co-authors and did not seem aware of Weissmann's intent that P-1 be her own derivative work. Where as Freeman still considered Weissmann a colleague, Weissmann thought of Freeman as a competitor.²⁷⁵

Joint academic researchers will be faced with many distractions both within and outside the scientific community. Today's col-

displayed its commitment to the protection of author's rights and, thus, its commitment to the objectives of copyright law.

Id.

272. See *supra* note 81 and accompanying text.

273. See *supra* note 6 and accompanying text.

274. "The academic community is the major user and creator of copyrighted material." SCHWARTZ, M.D. & HOGAN, J.C., *Copyright Law and the Academic Community: Issues Affecting Teachers, Researchers, Students and Libraries*, 17 U.C. DAVIS L. REV. 1147, 1147-48 (1984).

275. See Brief for Plaintiff-Appellant at 49, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (No. 88-7435, 7465).

league is more likely to be tomorrow's competitor. Joint researchers should now obtain contracts to protect themselves from suits alleging copyright infringement of copyrightable derivative works based upon prior joint works. The legal fees involved in forming a contract will represent a good investment if they protect joint authors from future suits for copyright infringement.

X. ASHTON-TATE CORP. v. ROSS: THE NINTH CIRCUIT

The Second Circuit decision in *Weissmann v. Freeman*²⁷⁶ has now been supported by the United States Court of Appeals for the Ninth Circuit in *Ashton-Tate Corp. v. Ross*.²⁷⁷ *Ashton-Tate* is the second decision by a federal circuit court to deal with joint authorship and derivative works.

In *Ashton-Tate*, the developer of a computer spreadsheet program sued another software developer seeking compensation for developing a computer program.²⁷⁸ The district court granted summary judgment in favor of the defendant.²⁷⁹ The Ninth Circuit affirmed, finding that the claimant had no copyrightable interest in the software program.²⁸⁰ The Ninth Circuit held that even if the developer of the computer program had made a copyrightable contribution and had an undivided interest in the entire program, including computational and user interface components, that interest did not carry over when the interface was combined with another computer program to produce a different software program.²⁸¹

The Ninth Circuit, citing *Weissmann*, stated that "joint authorship in a prior work is insufficient to make one a joint

276. 868 F.2d 1313 (2d Cir.), *cert. denied*, 110 S. Ct. 219 (1989).

277. 916 F.2d 516, 522 (9th Cir. 1990). "Joint authorship in a prior work is insufficient to make one a joint author of a derivative work The analysis in *Weissmann* is sound, and we adopt its reasoning on this point." *Id.*

278. *Id.* at 517-18.

279. *Ashton-Tate Corp. v. Ross*, 728 F. Supp. 597, 599 (N.D. Cal. 1989).

280. *Ashton-Tate*, 916 F.2d at 523.

281. *Id.* at 522-23.

author of a derivative work.”²⁸² The court further added that “the analysis in *Weissmann* is sound and we adopt the reasoning on this point.”²⁸³ The Ninth Circuit stated that “the court in *Weissmann* also discussed the situation where a joint work is utilized or licensed for use in a derivative work by one of the co-authors of the joint work. In such a situation, no cause of action for infringement exists ‘because an individual cannot infringe his own copyright. The only duty joint owners have . . . is to account for profits from [the joint work’s] use.’”²⁸⁴

Now that the Ninth Circuit is in accord with the Second Circuit, *Weissmann*, with all its faults, is unlikely to be overturned. In addition, unless other circuits subsequently disagree, intervention by the United States Supreme Court is unlikely.

CONCLUSION

The district court found that Doctors Freeman and Weissmann were co-authors of P-1;²⁸⁵ P-1 was not a derivative work;²⁸⁶ and even if it were, Freeman was entitled to the defense of fair use.²⁸⁷ The Second Circuit reversed, finding that Freeman was not a co-author of P-1;²⁸⁸ P-1 was a derivative work owned by Weissmann and entitled to copyright protection;²⁸⁹ and Freeman was not entitled to the defense of fair use.²⁹⁰

The Second Circuit may have correctly applied the objective standard of intent, finding that Freeman was not a joint author of

282. *Id.* at 522 (citing *Weissmann*, 868 F.2d at 1317).

The court in *Ashton-Tate* continued: “If such were the law, it would eviscerate the independent copyright protection that attaches to a derivative work that is wholly independent of the protection afforded the preexisting work.” *Id.* (quoting *Weissmann*, 868 F.2d at 1317).

283. *Id.*

284. *Id.* (quoting *Weissmann*, 868 F.2d at 1318).

285. *See supra* notes 81-83 and accompanying text.

286. *See supra* notes 149-51 and accompanying text.

287. *See supra* notes 175-77 and accompanying text.

288. *See supra* notes 84-91 and accompanying text.

289. *See supra* note 152 and accompanying text.

290. *See supra* note 178 and accompanying text.

P-1. The Second Circuit could have also applied a more substantial standard of originality. Otherwise, where a minimal standard of originality was used,²⁹¹ the Second Circuit failed to properly apply that standard to the facts of the case.

The most significant error of the Second Circuit was its failure to recognize the realities of joint research, which requires joint authors to routinely update their joint works, either in one name, the other name, or in both names. The errors of the Second Circuit are compounded by not allowing the prior, senior author the defense of fair use.²⁹²

Weissmann v. Freeman really reflects a tragedy -- the dissolution of a very successful, productive, medical partnership which led to major advances in nuclear medicine. The Second Circuit's decision in this case has disastrous implications for the future of academic medicine. It is unfortunate that the energy expended in this unfortunate copyright suit could not have been better invested in medical research. As a result of *Weissmann*, more time and effort may now be invested in protection from copyright suits than in medical research.

Now that the Ninth Circuit, by its decision in *Ashton-Tate Corp. v. Ross*,²⁹³ is in accord with the Second Circuit decision in *Weissmann v. Freeman*, the Second Circuit decision, with its faults, is likely to stand. The current copyright law, as applied by the Second Circuit in *Weissmann*, is that either joint author may make relatively minor adaptations to a jointly authored work and create a solely owned derivative work subject to copyright protection.²⁹⁴ Perhaps a joint author should ask for permission from his or her partner before attempting to utilize or modify a work individually written by that partner, even if such work is

291. *Weissmann*, 868 F.2d at 1320-23.

292. *Id.* at 1323-26.

293. 916 F.2d 516 (9th Cir. 1990).

294. *Weissmann*, 868 F.2d at 1321, 1323.

based upon a previously jointly written work. Otherwise, that work may be a derivative work entitled to copyright protection and the other partner may cease to be a partner and instead become an adversarial litigant.

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