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INSPIRATION OR IMITATION: COPYRIGHT PROTECTION FOR STAGE DIRECTIONS

MARGIT LIVINGSTON*

Abstract: This Article addresses copyright protection for stage directions. Copyright law dictates that stage directions are subject to copyright protection, as they are original creative works that can easily be fixed in a tangible medium. Under their union contracts, theatre directors reserve ownership of the copyright in stage directions. Directors who believe that their staging has been misappropriated by a later director can prove infringement through showing access and substantial similarity. The doctrines of merger and *scènes à faire*, however, limit the extent of that copyright protection. If copyright law fails to fully vindicate a director's hoped-for rights in stage directions, other legal theories also pose their own hurdles. Ultimately, a director should be able to successfully sue a later director for copyright infringement if the later director closely copies the most striking features of the original director's staging.

Give my regards to Broadway! Remember me to Herald Square!

—George M. Cohan

No man but a blockhead ever wrote, except for money.

—Samuel Johnson

INTRODUCTION

Despite the growth of regional drama companies, the financial and creative heart of the American theatre remains on Broadway.¹ High-priced, slick productions of both new and classic works draw hundreds of thousands of theatergoers from across the country to

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¹ See Patricia Cohen, *Broadway Is Dry-Eyed as Monster Falls Hard*, N.Y. TIMES, NOV. 25, 2008, at C1 (discussing the significant revenues and costs associated with producing a major Broadway show).

New York City.² These productions bring together some of the American stage's greatest creative talents in complex and sophisticated collaborations.³ The most successful productions can rake in millions of dollars⁴ and enjoy multi-year runs.⁵

Traditionally, the playwright's script (or the librettist's book in the case of a musical) has been the core element in creating these lavish spectacles of theatrical art.⁶ Quite simply, without the dialogue, there is no play.⁷ It is commonly accepted that playwrights receive copyright protection for their expression because plays are original works of authorship fixed in a tangible medium.⁸ Under federal copyright law, authors enjoy the exclusive right to reproduce, adapt, perform, and distribute their copyrighted works.⁹ Authors and their heirs may exercise these rights throughout the copyright's term—the duration of the author's life plus seventy years.¹⁰ Once the copyright term for a particular work expires, it passes into the public domain and

² See *Tourism & Entertainment: 2008 City Facts*, CRAIN'S N.Y. BUSINESS, July, 7, 2008, at 40.

³ See Cohen, *supra* note 1 (discussing famed writer Mel Brooks's successful and costly musicals).

⁴ In April 2004, six months after the musical *Wicked* opened on Broadway, ticket sales for the New York production were running at \$1.2 million per week. Annie Marie Welsh, *Something "Wicked" This Way Comes*, SAN DIEGO UNION-TRIB., July 23, 2006, at F7. Two years later, combined gross ticket sales from the Broadway and Chicago runs and the national tour topped a quarter of a billion dollars. *Id.*

⁵ See Jeff Korbek, *Making a "Memory,"* LINCOLN J. STAR (Neb.), Dec. 1, 2006, at X16. The original paradigm for the successful, long-lived Broadway musical is, of course, *Cats*, which enjoyed an eighteen-year run in New York from 1982 to 2000. See *id.* Another Andrew Lloyd Webber musical phenomenon, *The Phantom of the Opera*, however, has surpassed *Cats* and has now been running on Broadway for more than twenty-one years. See *Phantom of the Opera Celebrates 20 Years*, ABC NEWS (Australia), Jan. 26, 2008, <http://www.abc.net.au/news/stories/2008/01/26/2147183.htm?section=world>. Over the course of more than 8300 performances, it has generated gross revenues in excess of \$760 million. *Id.*

⁶ See Welsh, *supra* note 4 (discussing the writer and director of the hit musical *Wicked*).

⁷ See, e.g., TENNESSEE WILLIAMS, A STREETCAR NAMED DESIRE 25, 59 (Signet 1951) (1947).

⁸ See 17 U.S.C. § 102(a) (2006). The Copyright Act expressly lists "dramatic works" as one of the eight illustrative categories of works of authorship. See *id.*

⁹ See *id.* § 106.

¹⁰ See *id.* § 302(a). The 1976 Copyright Act, of course, had provided for a term of protection of the author's life plus fifty years, but Congress tacked on another twenty years in 1998, arguably under pressure from large copyright holders such as Disney and Time-Warner. See Sony Bono Copyright Term Extension Act, Pub. L. No. 105-298, § 102(b), 112 Stat. 2827, 2827 (1998).

may be exploited by anyone.¹¹ During the term of copyright protection, however, others may not exploit the work without a license from the copyright holder.¹² The license will normally include some form of remuneration.¹³

Given the potential for significant financial gain from a successful Broadway production, it was perhaps inevitable that theatre artists, apart from the playwright, would seek the rewards of copyright protection for their own contributions to the finished dramatic product.¹⁴ In November 2006, Chicago's Mercury Theatre, which had staged a well-regarded production of *Urinetown*, was threatened with legal action if it did not share royalties and credit with the original Broadway production's director, choreographer, and designers.¹⁵ The Broadway artists asserted that "the direction, design and choreography in the Chicago *Urinetown* were nothing more than cheap copies of the Broadway production, and thus an unauthorized sham."¹⁶ The Broadway artists made similar claims regarding a *Urinetown* production in Akron, Ohio.¹⁷ In response, and presumably as a means of securing local venues, the Chicago and Akron artists filed suits in late 2006 in their respective federal districts against the Broadway artists and the Society of Stage Directors and Choreographers seeking a declaratory judgment that their productions did not violate any of the Broadway artists' rights.¹⁸ The Broadway

¹¹ See, e.g., *Frederick Warne & Co. v. Book Sales, Inc.*, 481 F. Supp. 1191, 1197 (S.D.N.Y. 1979) (noting that the defendant was legally entitled to reproduce seven public domain works).

¹² See 17 U.S.C. § 201(d) (authorizing the transfer of any of the exclusive rights accorded to copyright owners); see also 1 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT §§ 5.0-1 (3d ed. Supp. 2007) (discussing exclusive and nonexclusive copyright licenses).

¹³ See, e.g., *On Davis v. The Gap, Inc.*, 246 F.3d 152, 172 (2d Cir. 2001). Thus, damages for copyright infringement sometimes include a reasonable licensing fee. *Id.*

¹⁴ See, e.g., Chris Jones, "Urinetown" Battle Rails the World of Musicals, CHH. TRIB., Nov. 19, 2006, § 7, at 1 (noting the legal battle over a regional theatre company's staging of a Broadway play).

¹⁵ See *id.*

¹⁶ *Id.*

¹⁷ Campbell Robertson, *Creative Team of "Urinetown" Complains of Midwest Shows*, N.Y. TIMES, Nov. 15, 2006, at E3.

¹⁸ See Complaint for Declaratory Judgment at 12, *Mullen v. Soc'y of Stage Dirs. & Choreographers*, [2007] Copyright L. Dec. (CCH) ¶ 29,447 (N.D. Ill. 2007) (No. 06 Civ. 6818) [hereinafter *Mullen Complaint*]; Complaint for Declaratory Relief at 6-7, *Carousel Dinner Theatre LLC v. Carrafa*, No. 06 CV 2825 (N.D. Ohio Nov. 22, 2006). The plaintiffs in the Chicago suit specifically sought a declaratory judgment that their production of *Urinetown* was unique and did not copy protectable creative authorship lawfully owned by the defendants and that the plaintiffs did not pass off defendants' work as their own. See *Mullen Complaint*, *supra*, at 1-2. In addition, the Chicago plaintiffs requested an injunction restraining the defendants from making public statements alleging infringement by the

artists quickly brought counterclaims based on copyright infringement and other theories.¹⁹ The Chicago artists ultimately settled their lawsuit, agreed to pay an undisclosed sum to the Broadway artists, and acknowledged that the Chicago production contained “original and creative works” from the Broadway production.²⁰ The Akron suit as well later ended in a similar settlement.²¹

This Article explores the unsettled issue of copyright protection for stage directions.²² Part I of this Article presents important background information and details the issue’s developing significance in the legal and theatre worlds.²³ Part II examines whether stage directions are copyrightable subject matter under federal law.²⁴ Part III discusses the question of ownership of the copyright in stage directions if indeed they are subject to copyright protection.²⁵ Part IV explores the requisites for a copyright infringement suit involving stage directions and delves into possible barriers to such a suit, including the fair use

plaintiffs and requiring them to “place a minimum one-quarter (1/4) page advertisement in *Variety Magazine* recant[ing] their allegations and apologizing to” the plaintiffs. *Id.* at 12. The plaintiffs also sought damages, attorneys’ fees, and costs against the defendants. *Id.*

¹⁹ See Answer & Counterclaims/Complaint at 23–30, *Mullen*, [2007] Copyright L. Dec. (CCH) ¶ 29,447 [hereinafter *Mullen Answer*]; Answer & Counterclaims at 19–25, *Carousel Dinner Theatre*, No. 06 CV 2825 (N.D. Ohio Nov. 22, 2006) [hereinafter *Carousel Dinner Theatre Answer*].

²⁰ See Campbell Robertson, *A “Urinetown” Suit Is Settled*, N.Y. TIMES, Dec. 1, 2007, at B8. Earlier, in September 2007, the federal district court in the Chicago suit dismissed the declaratory judgment against one of the defendants, United Scenic Artists, the labor union representing set, costume, and lighting designers. See *Mullen*, [2007] Copyright L. Dec. (CCH) at 40,269. The court held that the Chicago plaintiffs could not seek a declaration of noninfringement against a party that had no standing to bring a suit for infringement against the Chicago artists. *Id.* Because United Scenic Artists itself did not own any proprietary interests in the set, costume, or lighting designs used in the Broadway production, it could not sue for copyright infringement. *Id.*

²¹ Interview with Ron Shechtman, Managing Partner, Pryor Cashman LLP, in N.Y., N.Y. (Aug. 20, 2008).

²² See *infra* notes 29–487 and accompanying text. For earlier treatments of this subject, see generally David Leichtman, *Most Unhappy Collaborators: An Argument Against the Recognition of Property Ownership in Stage Directions*, 20 COLUM.-VLA J.L. & ARTS 683 (1996); Jessica Litman, *Copyright in the Stage Direction of a Broadway Musical*, 7 COLUM.-VLA J.L. & ARTS 309 (1983); Talia Yellin, *New Directions for Copyright: The Property Rights of Stage Directors*, 24 COLUM.-VLA J.L. & ARTS 317 (2001); Richard Amada, Note, *Elvis, Karaoke, Shakespeare and the Search for a Copyrightable Stage Direction*, 43 ARIZ. L. REV. 677 (2001); Beth Freemal, Note, *Theatre, Stage Directions & Copyright Law*, 71 CHI.-KENT L. REV. 1017 (1996); Jennifer J. Maxwell, Comment, *Making a Federal Case for Copyrighting Stage Directions: Einhorn v. Mergatroyd Productions*, 77 J. MARSHALL REV. INTELL. PROP. L. 393 (2008).

²³ See *infra* notes 29–69 and accompanying text.

²⁴ See *infra* notes 70–154 and accompanying text.

²⁵ See *infra* notes 155–219 and accompanying text.

defense, the merger doctrine, and *scènes à faire*.²⁶ Part V looks at contract, unfair competition, unjust enrichment, and misappropriation law as possible alternate forms of legal protection for stage directors.²⁷ Finally, Part VI concludes that, in certain circumstances, stage directions are subject to a “thin” form of copyright protection, and the Part suggests the parameters of that protection.²⁸

I. ALL THE WORLD'S A STAGE: THE PUSH FOR COPYRIGHT PROTECTION FOR STAGE DIRECTIONS

On the surface, the lawsuits regarding the Chicago and Akron productions of *Urinetown* appear to be a conflict between the original Broadway director and subsequent directors over the extent to which a later director can appropriate stage directions, costumes, set design, lighting, and other production elements from an earlier staged version of the same play or musical.²⁹ Beneath the surface, however, a deeper conflict is brewing between playwrights, composers, and lyricists, on the one hand, and directors, on the other.³⁰ Under federal copyright law, the writers' work is clearly protected, and any later producer who wishes to mount a copyrighted play or musical must obtain a license from the author, which may involve sharing royalties from the subsequent production with the author.³¹ Currently, directors do not explicitly enjoy similar legal protection for their creative input into a finished production.³² Directors are usually regarded as em-

²⁶ See *infra* notes 220–332 and accompanying text.

²⁷ See *infra* notes 333–420 and accompanying text.

²⁸ See *infra* notes 421–487 and accompanying text.

²⁹ See Welsh, *supra* note 4.

³⁰ See *id.*

³¹ See 17 U.S.C. § 102(a) (2006); Approved Production Contract for Plays arts. IV (Royalties), XI (Subsidiary Rights), in DONALD C. FARBER, PRODUCING THEATRE: A COMPREHENSIVE LEGAL AND BUSINESS GUIDE 184–91, 216–21 (Limelight Editions 3d ed. 2006) (1981).

³² See John Weidman, *Protecting the American Playwright*, 72 BROOK. L. REV. 639, 649 (2007) (noting that filing a copy of stage directions with the Copyright Office does not, by itself, “establish a copyright, and in fact, there has never been a judicial determination that stage directions . . . are copyrightable”); Dramatists Guild of America, A Joint Statement by the Dramatists Guild of America and Authors Mark Hollman and Greg Kotis Regarding the Settlement of Mullen v. SSDC, et al. and the Intervention of the Department of Justice, http://www.dramatistsguild.org/about_statements_urinetown.aspx (last visited Feb. 12, 2009) (“[T]he Department of Justice intervened in the Mullen case on behalf of the U.S. Copyright Office, asserting that ‘the Register (of Copyright) denies that stage direction, as presented to the Copyright Office for registration, is copyrightable subject matter’ and asking the court to ‘hold that the Register properly refused copyright registration for [the *Urinetown* director’s] claim concerning stage direction.’”).

ployees of the producer (or, at most, independent contractors) who are paid on a project-by-project basis.³³ Traditionally, they have not been regarded as possessing any continuing rights in their work product beyond the rights stemming from their contracts with the initial producer.³⁴ If directors were to successfully assert additional rights, the financial pie from future productions would have to be divided among a greater number of participants, conceivably making the writers' share smaller.³⁵

The Society of Stage Directors and Choreographers ("SSDC"), a national labor union representing directors, has urged its members to press for subsidiary rights in the fruits of their creative endeavors.³⁶ The union argues that if a subsequent production exploits a prior director's stage directions, the director should receive some remuneration as well as acknowledgment in the production's playbill.³⁷ The SSDC has intervened in a number of lawsuits on behalf of director-members claiming that a subsequent production copied their stage directions.³⁸ In the first of these suits, the stage director Gerald Gutierrez claimed that a Chicago-area theatre had appropriated his directions for the 1956 Frank Loesser musical *The Most Happy Fella*, which he had originally staged at the Goodspeed Opera House in 1991.³⁹ Gutierrez

³³ See *infra* notes 155–191 and accompanying text (discussing the director's employment status).

³⁴ Interview with Barbara B. Hauptman, Executive Dir., Soc'y of Stage Dirs. & Choreographers, in N.Y., N.Y. (July 10, 2007).

³⁵ See Yellin, *supra* note 22, at 320 (quoting New York playwright and dramaturge Michael Paller in an Aug. 2, 2000 interview). Mr. Paller vividly described the economic hardship faced by directors and other theatre artists:

It is impossible for anybody to make a living in the theatre, and so people are scratching . . . for any advantage they can get. As far as directors are concerned, they believe that playwrights can always sell their work to movies . . . or that [the work] will have a life after the production on Broadway . . . because the play may . . . get published, and will continue to be reproduced. The director has to go out and look for another job in the meantime. . . . So I think it's because it's so hard to make any money . . . rather than try to grow the pie and make more work for everybody, [directors] want to take somebody else's already tiny share.

Id.

³⁶ See The Dramatists Guild, Inc., Approved Production Contract for Musical Plays art. XI, § 11.01 (1992), in FARBER, *supra* note 31, at 306. "Subsidiary rights" allow authors to control the use and exploitation of their works in future productions and in different media, such as radio, motion picture, television, and video cassette. See *id.*

³⁷ Interview with Barbara B. Hauptman, *supra* note 34.

³⁸ See *id.*

³⁹ See Sid Smith, *Local Production Called Too Similar to One on Broadway; Suit Threatened*, CHI. TRIB., Oct. 19, 1994, at 2. The Chicago-area production was at the Drury Lane Oakbrook

named the Chicago producer and director as defendants and asserted that they had taken his artistic innovations without consent, credit, or royalty payments.⁴⁰ Although admitting that he had viewed a videotape of Gutierrez's production, rented the previous production's sets, and hired its lead actor, the defendant director argued that his version of the show contained "huge departures" from the New York production.⁴¹ The case was settled before trial.⁴²

In 1996, two years after the Gutierrez suit, director Joe Mantello sued the Caldwell Theatre and its artistic director, Michael Hall, for infringement of Mantello's copyright in his critically acclaimed staging of Terrence McNally's *Love! Valour! Compassion!* at the Manhattan Theatre Club.⁴³ Mantello alleged that Hall and his collaborators had taken notes, among other tactics, at a New York performance of the McNally play to assist them in recreating Mantello's staging in their production in Boca Raton, Florida.⁴⁴ Mantello asserted that the defendants had "intentionally recreated his 'unique direction and staging' including 'the replication of the stage movement, design, lighting and sound.'"⁴⁵ For example, although the beginning of the McNally play indicates only a "bare stage,"⁴⁶ Mantello's production used a large doll house set atop a green mound as a central feature of the stage setting.⁴⁷ Mantello

Terrace Theatre. *Id.* The Drury Lane Theatre offers its patrons "breathtaking Broadway classics, top-rated musicals, hilarious comedies and unforgettable concert events." Drury Lane Oakbrook Terrace, Live Theatre—Overview, http://drurylaneconferencecenter.net/live_theatre.shtml (last visited Feb. 12, 2009).

⁴⁰ See Smith, *supra* note 39.

⁴¹ *Id.* After the 1991 opening of the Goodspeed Opera House production, plaintiff Gutierrez filed the annotated copy of the script for *The Most Happy Fella* with his stage directions noted on it with the U.S. Copyright Office. See Copyright Registration No. PAu-001-520-015 (registered June 6, 1991), available at <http://cocatalog.loc.gov> (enter "PAu001520015" in "Search for:" field, and select "Registration Number" in "Search by:" field).

⁴² Interview with Barbara B. Hauptman, *supra* note 34. Under the settlement, the defendants paid an undisclosed sum to Gutierrez and placed an advertisement in *Variety* containing an apology and giving credit to Gutierrez. *Id.*

⁴³ See *Mantello v. Hall*, 947 F. Supp. 92, 95–96 (S.D.N.Y. 1996). The play itself won a Tony award, and Mantello won the Outer Critics Circle, Obie, and Joe A. Calloway awards for his direction. See *id.* The plaintiff in the lawsuit also included claims for false representation under the Lanham Act, common law "reverse passing off," and unjust enrichment. *Id.* at 95.

⁴⁴ *Id.* at 96. Mantello claimed that Hall had also cast actors who had seen the New York production and had told his designers to attend the New York production to garner ideas. *Id.*

⁴⁵ *Id.*

⁴⁶ TERRENCE McNALLY, *LOVE! VALOUR! COMPASSION!* (1994), reprinted in *LOVE! VALOUR! COMPASSION! AND A PERFECT GANESH: TWO PLAYS* 9, 9 (Penguin Putnam 1995).

⁴⁷ Peter Marks, *Love, Valour, Déjà Vu*, N.Y. TIMES, Mar. 29, 1996, at C2.

claimed that the doll house was one of his copyrightable contributions that Hall had infringed in the Florida production.⁴⁸

Mantello's initial suit in a New York federal district court was dismissed for lack of personal jurisdiction over the defendants.⁴⁹ Mantello then refiled his claim in a Florida federal court, seeking \$250,000 in damages.⁵⁰ Like the Gutierrez suit, this suit was eventually settled.⁵¹ Mantello received \$7000 and the defendants' written acknowledgment that they had used elements of his work without permission.⁵² Although the SSDC cited the outcome as an affirmation of directors' legal rights, the Dramatists Guild of America noted that an out-of-court settlement has no precedential value.⁵³

In a third case decided three years ago, a director's claim for breach of contract and copyright infringement survived a motion to dismiss.⁵⁴ The plaintiff Edward Einhorn asserted that he had agreed to direct the Off-Off Broadway production of *Tam Lin* for \$1000.⁵⁵ He alleged that after completing the blocking and choreography for the play and working with the cast and set designers for several weeks, he was summarily dismissed the day before the scheduled opening.⁵⁶ The show opened as scheduled in October 2004 and, according to his complaint, used Einhorn's blocking and choreography.⁵⁷

The U.S. District Court for the Southern District of New York determined that Einhorn had sufficiently alleged contract and copyright claims to survive a motion to dismiss.⁵⁸ Einhorn predicated his contract claim on an e-mail "offer" received from the play's author:

⁴⁸ *Id.*

⁴⁹ See *Mantello*, 947 F. Supp. at 102.

⁵⁰ *Director's Suit over Rights to Go to Trial*, N.Y. TIMES, Aug. 1, 1997, at C2.

⁵¹ See Jesse McKinley, *Suit! Anger! Agreement!*, N.Y. TIMES, Mar. 26, 1999, at E2.

⁵² See *id.* Mantello donated his settlement to the SSDC Foundation. Telephone Interview with Joe Mantello, Broadway Dir., in N.Y., N.Y. (July 25, 2007).

⁵³ McKinley, *supra* note 51. Unlike the SSDC, the Dramatists Guild of America is not a labor union, but rather it is a national professional association of playwrights, composers, and lyricists "writing for the living stage." See Dramatists Guild of America, About the Dramatists Guild of America, <http://www.dramatistsguild.org/about.aspx> (last visited Feb. 12, 2009). The Guild offers model contracts designed to protect writers' interests, disseminates publications assisting writers in honing their business and artistic skills, and "acts as an aggressive public advocate for dramatists' interests." *Id.*

⁵⁴ *Einhorn v. Mergatroyd Prods.*, 426 F. Supp. 2d 189, 197 (S.D.N.Y. 2006).

⁵⁵ *Id.* at 191-92.

⁵⁶ *Id.* at 192.

⁵⁷ *Id.*

⁵⁸ *Id.* at 194, 196.

I spoke with Jonathan [Flagg, the producer] and he feels that our budget can handle the additional director's fee, so we're OK with paying you \$1000. I hope this will sway you to commit to this project. Please let me know as soon as possible if you'll do it.⁵⁹

Although the parties never signed a written contract, Einhorn argued that he had accepted the defendants' offer through his performance of the contract—namely, staging the play.⁶⁰ The court agreed that there was at least a triable issue regarding the formation of a binding contract between the parties.⁶¹

With respect to the copyright infringement claim, the defendants argued that Einhorn's stage directions were unprotectable "stage business" and could not be infringed,⁶² except perhaps by the defendants' reproduction of Einhorn's staging notes as a text.⁶³ The court ultimately declined to dismiss the copyright claim, primarily because the defendants had not addressed several key points in their motion papers, including copyright's fixation requirement and the doctrine of *scènes à faire*.⁶⁴ Although Einhorn survived the dismissal motion, the court clearly displayed a lukewarm attitude toward his copyright claim, noting that Einhorn's certificate of registration from the Copyright Office conceivably covered only his "blocking script as distinguished from images of a performance depicting positions and movements."⁶⁵ In other words, if the copyright registration covered only the stage directions as a written text, the court seemed to imply that a public performance based on that text would not be an infringement of the text itself.⁶⁶

Although litigation involving copyright protection for a director's staging is still relatively sparse, it seems apparent that the issue is not

⁵⁹ See *Einhorn*, 426 F. Supp. 2d at 193.

⁶⁰ *Id.*

⁶¹ *Id.* at 194.

⁶² The defendants' lawyer stated that Einhorn's contributions were at most trivial variations on the playwright's original stage directions and noted, "Instead of 'Exit', it's 'Exit left' . . . Instead of 'Picks up book,' it's 'Picks up red book.'" Jesse Green, *Exit, Pursued by a Lawyer*, N.Y. TIMES, Jan. 29, 2006, § 2, at 1.

⁶³ See *Einhorn*, 426 F. Supp. 2d at 196.

⁶⁴ *Id.*

⁶⁵ *Id.*

⁶⁶ See *id.* The court's passing comment on the distinction between reproduction of the text and public performance based on the text is somewhat perplexing because the Copyright Act clearly states that the owner of the copyright in a literary or dramatic work has the exclusive right "to perform the copyrighted work publicly." See 17 U.S.C. § 106(4).

going to disappear.⁶⁷ The SSDC continues to maintain that protecting a director's rights is of paramount importance and that it will sue "infringers" when necessary to establish that point.⁶⁸ Given the enormous success of certain Broadway productions and the almost irresistible urge to copy their key features, it is likely that charges of infringement will continue to arise.⁶⁹

II. STAGE DIRECTIONS AS COPYRIGHTABLE SUBJECT MATTER

This Part examines whether, as a threshold matter, stage directions qualify for federal copyright protection. If they do not meet the basic requisites for protection, the question of enforcing an alleged copyright in them becomes moot, and directors would need to look to another legal theory, such as breach of contract or unfair competition, to assert their claims.⁷⁰

A. *Categories of Works Protected*

To qualify for protection under the Copyright Act of 1976, stage directions must be "original works of authorship fixed in any tangible medium of expression, now known or later developed from which they can be perceived, reproduced or otherwise communicated."⁷¹ Congress clarified the Act's scope by listing certain categories of works that are explicitly protected, including "dramatic works" and "pantomimes and choreographic works."⁷² At the same time, the list of works of authorship is clearly intended to be illustrative, rather than exhaustive.⁷³

1. The Modern Director's Role

Stage directions could be classified as dramatic works and/or as pantomimes and choreographic works because, broadly, they consist of both the director's overall concept for staging a dramatic work and individual instructions to the actors about their movements and behav-

⁶⁷ See, e.g., *Einhorn*, 426 F. Supp. 2d at 191-93; *Mantello*, 947 F. Supp. at 95-96.

⁶⁸ Interview with Barbara B. Hauptman, *supra* note 34.

⁶⁹ See Jones, *supra* note 14; Welsh, *supra* note 4.

⁷⁰ See *infra* notes 333-420 and accompanying text.

⁷¹ 17 U.S.C. § 102(a) (2006).

⁷² See *id.* § 102(a)(3)-(4).

⁷³ See *id.* § 102(a) (using the term "include" and not "exclusive").

iors on stage.⁷⁴ The role of stage directors in mounting productions has changed and grown significantly over time, and their creative contributions to theatrical productions have increased accordingly.⁷⁵ For centuries, the director and playwright were one: Aeschylus, Shakespeare, and Molière, for example, not only wrote some of the most acclaimed plays of their respective eras, but also personally mounted the major productions of them.⁷⁶ By the nineteenth century, English and American theatrical companies were frequently under the control of an actor-manager, who hired the other actors, held rehearsals, arranged for the scenic backdrops, and procured costumes.⁷⁷ The actor-manager's control over the other actors, however, was frequently limited to directing their movements on stage rather than coaching them on interpretation.⁷⁸

It was not until the latter half of the nineteenth century that the modern concept of the theatrical director emerged.⁷⁹ Along with the rise of realism and naturalism in the European stage came the advent of the *metteur en scène*, a director who oversaw, created, and controlled all aspects of a production.⁸⁰ These modern directors selected a motif

⁷⁴ Interview with Michael Mayer, Tony Award-winning Dir., in N.Y., N.Y. (July 18, 2007) (“[Stage direction is] not just about the blocking—it’s the interpretation of the play—why is a character crossing downstage? He’s mortified.”).

⁷⁵ See *infra* notes 76–94 and accompanying text.

⁷⁶ OSCAR G. BROCKETT, *HISTORY OF THE THEATRE* 208–10 (2d ed. 1974); Helen Krich Chinoy, *The Emergence of the Director*, in *DIRECTORS ON DIRECTING: A SOURCE BOOK ON MODERN THEATRE* 3, 3–6 (Toby Cole & Helen Krich Chinoy eds., 1963).

⁷⁷ Chinoy, *supra* note 76, at 17–18; see also BROCKETT *supra* note 76, at 342–46 (describing the efforts of two English actor-managers in the early nineteenth century “to bring order out of the near chaos which had reigned since about 1815” in the English theatre).

⁷⁸ See Chinoy, *supra* note 76, at 20. The theatrical convention of the time dictated that in rehearsal, actors should avoid displays of emotion in practicing their parts:

It was the custom of London actors, especially the leading ones, to do little more at rehearsals than read or repeat the words of their parts, marking on them their entrances and exits, as settled by the stage manager, and their respective places on stage. To make any display of passion or energy would be to expose oneself to the ridicule or sneers of the green room.

Id. (quoting WILLIAM CHARLES MCCREADY, *REMINISCENCES*).

⁷⁹ See KENNETH MACGOWAN & WILLIAM MELNITZ, *THE LIVING STAGE: A HISTORY OF THE WORLD THEATRE* 364–65 (1955). The Duke of Saxe-Meiningen is often considered the first modern director. See *id.* He created an ensemble of actors and put them through a lengthy rehearsal process in which he carefully instructed both the leads and the supernumeraries on their movements and interpretation of parts. See *id.*

⁸⁰ See Chinoy, *supra* note 76, at 27. No one carried the idea of a single authority controlling all aspects of a production further than English designer and theatre philosopher Edward Gordon Craig, who even called for the actors to be replaced by *Übermarionetten*, or

for the scenery and costumes and instructed the scene and costume designers to execute their vision.⁸¹ They also thoroughly studied the play in advance of the first rehearsal and developed an overarching interpretative theme for it.⁸² At rehearsals, directors told the actors where and how to move on stage, what gestures to use, and what tone of voice and pacing of speech to employ.⁸³ With the assistance of the lighting and sound technicians, they altered the mood of the performance through changes in the illumination of the stage⁸⁴ and the use of sound effects⁸⁵ and music.⁸⁶

Thus, the modern director became the primary translator of the playwright's written word into a visual and auditory theatrical presentation.⁸⁷ These newly evolved directors needed a wide range of artistic, literary, technical, and even psychological skills to turn their vision into a finished production.⁸⁸ They had to integrate all the traditional

superpuppets, "without any ego but capable of carrying out all demands." BROCKETT, *supra* note 76, at 490-91.

⁸¹ See MAGGOWAN & MELNITZ, *supra* note 79, at 345 (discussing one English director's zeal for production details).

⁸² See *id.* at 414-18 (observing that the founders of the Moscow Art Theater, Constantin Stanislavsky and Vladimir Nemirovich-Danchenko, divided up the directorial duties between them with the former concentrating on production details and the latter "determin[ing] how each play was to be approached in order to bring out its meaning").

⁸³ See Chinoy, *supra* note 76, at 33-34.

⁸⁴ See *id.* at 40-41 (describing the pioneering contributions of Adolphe Appia to stage lighting and his use of light to create "a living theatre").

⁸⁵ The great Russian playwright Anton Chekhov's *The Cherry Orchard* concludes with a haunting, evocative sound effect suggesting the impending demise of the Russian gentry: "A sound is heard from the distance as though from heaven, a sound of a breaking string, dying away mournfully. It grows quiet, and only the clanging of an axe is heard from far away in the orchard." ANTON CHEKHOV, *THE CHERRY ORCHARD* 56 (Emily Mann ed., Dramatists Play Serv., Inc. 2000). Of course, it is the director's job to figure out precisely how to actualize that sound on stage.

⁸⁶ See ARTHUR BARTOW, *THE DIRECTOR'S VOICE* 243-44 (1988) (stating that director Harold Prince made extensive, meticulous preparations for his staging of musicals—preparations "so complete that when the show opens it is intrinsically the same as the vision he's evolved before he set foot in the rehearsal hall").

⁸⁷ See Chinoy, *supra* note 76, at 33-34.

⁸⁸ See Tom Robertson's *Theatrical Types*, in A.M. NAGLER, *A SOURCE BOOK IN THEATRICAL HISTORY* 493 (1952). In the 1850s, the English writer Thomas Robertson wrote an article for London's *Illustrated Times* in which he set forth his vision of the ideal stage director:

He should be at one and the same time a poet, an antiquarian, and a costumier; and possess sufficient authority, from ability as well as office, to advise with a tragedian as to a disputed reading, to argue with an armourer as to the shape of a shield, or to direct a wardrobe-keeper as to the cut of a mantle. . . . He should possess universal sympathies, should feel with the sublime, and have a quick perception of the ludicrous. Though unable to act himself, he

theatrical devices of color, sound, design, movement, and speech to draw the audience into a compelling fictional world that both commanded the theatergoers' attention and faithfully expressed the playwright's text.⁸⁹

The contemporary American director is a direct descendent of the nineteenth century *metteur en scène*.⁹⁰ The director serves as the captain of the theatrical ship and makes all major creative decisions about a given production.⁹¹ In addition, directors today often add the role of dramaturge to their many other duties.⁹² As dramaturges, they assist playwrights in developing new work, sometimes over a period of years.⁹³ In this role, they conduct historical research, offer suggestions about dialogue, scene structure, and plot development, and generally oversee the development of the finished script.⁹⁴ As discussed below, directors serving as dramaturges frequently receive little or no compensation for their contributions because the playwright is commonly considered the sole author of the finished product.⁹⁵

should be able to teach others, and be the finger-post, guide, philosopher, and friend of every soul in a theatre

See *id.*

⁸⁹ GARFF B. WILSON, *THREE HUNDRED YEARS OF AMERICAN DRAMA AND THEATRE: FROM YE BEAR AND YE CUB TO HAIR* 243–44 (1973). One theatre historian has recounted the emergence in the United States of the *régisseur*, or master director, in the last thirty years of the nineteenth century. See *id.* Audiences began demanding more realistic and sophisticated productions, and a “strong, controlling authority was needed to coordinate and unify all the elements which contributed to the final presentation.” See *id.*

⁹⁰ See Chinoy, *supra* note 76, at 27.

⁹¹ See Tom Robertston's *Theatrical Types*, *supra* note 88, at 464 (noting that the mid-twentieth century stage directors “were regarded as master artists . . . able to envision all the potentials of a drama and able also to embody them vividly and excitingly in a production”).

⁹² E.g., Interview with Michael Mayer, *supra* note 74 (describing his role as a dramaturge in the development of new plays that he directs).

⁹³ E.g., Interview with Cyndy A. Marion, Co-Artistic & Producing Dir., White Horse Theater Co., in N.Y., N.Y. (July 9, 2007) (stating that she worked as a dramaturge on one of her company's new plays for three years and through fourteen drafts).

⁹⁴ Interview with Christopher Cartmill, Playwright & Dir., Gad's Hill Theatre Co., in N.Y., N.Y. (July 24, 2007); see also Mark S.P. Turvin, *The Dramaturg: Modern Day Court Jester* (Jan. 21, 2001), <http://www.goldfishpublishers.com/DramaturgEssay.html> (describing the dramaturge as “part educator and part editor,” “supportive muse to the Artistic Director,” “mischievous court jester,” and “the theaure's internal critic, and their [sic] resident historian”).

⁹⁵ See *infra* notes 218–219 and accompanying text.

2. Meeting the Copyright Act's Definitions

Because Congress did not specifically define "dramatic work," "choreography," or "pantomime," one is left with generally accepted definitions in interpreting the statute.⁹⁶ Undoubtedly, the actors' movements, as dictated by the director, could be considered a form of pantomime,⁹⁷ if not choreography.⁹⁸ Those movements, most of which are not described in the playwright's text, constitute a physical embodiment of the written play.⁹⁹ Along with the writer's words, they advance the plotline, flesh out (literally and figuratively) the play's characters, and allow the audience to visualize the written text as a real-time, three-dimensional experience.¹⁰⁰

⁹⁶ See 17 U.S.C. § 102(a).

⁹⁷ Pantomime has been defined as "theatrical shows that impart action without the use of words or song." THE OXFORD DICTIONARY OF DANCE 359 (Debra Craine & Judith Mackrell eds., 2004).

⁹⁸ Interview with Neil Pepe, Artistic Dir., Atl. Theater Co., in N.Y., N.Y. (July 9, 2007) ("What I do for a play is that I move it. Stage directions are like choreography."). Although one normally thinks of choreography as being accompanied by music, that is not invariably so: according to the Copyright Office, choreography is "the composition and arrangement of dance movements and patterns, and is usually intended to be accompanied by music. . . . Choreographic works need not tell a story in order to be protected by copyright." U.S. COPYRIGHT OFFICE, COMPENDIUM II OF COPYRIGHT OFFICE PRACTICES § 450.01 (1984) [hereinafter COMPENDIUM]. Further, dance is "static and kinetic successions of bodily movement in certain rhythmic and spatial relationships." *Id.*

⁹⁹ See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 55 (2d Cir. 1936). Judge Learned Hand once noted the essential part that nonverbal elements play in any dramatic work:

Speech is only a small part of a dramatist's means of expression; he draws on all the arts and compounds his play from words and gestures and scenery and costume and from the very looks of the actors themselves. Again and again a play may lapse into pantomime at its most poignant and significant moments; a nod, a movement of the hand, a pause, may tell the audience more than words could tell.

Id.

¹⁰⁰ See *id.* at 55–56; see also *Brady v. Daly*, 175 U.S. 148, 159 (1899); *Harold Lloyd Corp. v. Witmer*, 65 F.2d 1, 24 (9th Cir. 1933); *Fuller v. Bemis*, 50 F. 926, 929 (C.C.S.D.N.Y. 1892); *Daly v. Palmer*, 6 F. Cas. 1132, 1136 (C.C.S.D.N.Y. 1868) (No. 3552). Interestingly, in 1899, in *Brady v. Daly*, the U.S. Supreme Court suggested in dictum that the particular staging of a scene is a copyrightable dramatic composition. See 175 U.S. at 159. In *Brady*, the Court alluded to an earlier federal trial court decision involving the same plaintiff and the same dramatic work, but a different defendant: *Daly v. Palmer*, decided by the Circuit Court for the Southern District of New York in 1868. See *Brady*, 175 U.S. at 159 (citing *Daly*, 6 F. Cas. 1132). In *Daly*, the court held that a so-called "railroad scene" in which a helpless victim tied to the tracks is rescued at the last moment from the onrushing train was copyrightable apart from the dialogue contained in it. *Daly*, 6 F. Cas. at 1136 ("A written work, consisting wholly of directions, set in order for conveying the ideas of the author on a stage or public place . . . is as much a dramatic composition . . . as if language or dialogue were used in it

In addition, the director's overall creative expression could be considered a dramatic work under the Copyright Act.¹⁰¹ A "dramatic work" can be defined as "any work in which performed actions, speech, or incident—or all three—convey theme, thoughts or character to an audience."¹⁰² The key distinction between dramatic works and literary works is that dramatic works, such as operas and plays, are intended to be performed,¹⁰³ whereas literary works include works that are intended primarily to be read or perhaps recited, such as poems, novels, and short stories.¹⁰⁴ The Copyright Office itself, moreover, lists as examples of dramatic works choreography, pantomimes, plays, treatments, and scripts prepared for cinema, radio, and television.¹⁰⁵ Undeniably then, the collection of directions that the stage director imparts to the actors and designers fits within the broad parameters of a dramatic work.¹⁰⁶ The director's concept for the staging and her choice of theme, era, mood, speech inflections, stage environment, movements, music, and sound effects are also clearly intended to be performed onstage before a live audience.¹⁰⁷

to convey some of the ideas."). Of course, in *Daly*, the playwright was the one claiming infringement by the subsequent production, not the stage director. *Id.* at 1132. In another nineteenth century case, *Fuller v. Bermis*, however, the Circuit Court for the Southern District of New York stated that an entertainment consisting merely of "a series of graceful movements" without any narrative element was not a copyrightable dramatic composition. See 50 F. at 929. The U.S. Court of Appeals for the Ninth Circuit later cited *Fuller* for the proposition that stage business in general is not copyrightable. *Harold Lloyd*, 65 F.2d at 24; see also *Serrana v. Jefferson*, 33 F. 347, 348 (C.C.S.D.N.Y. 1888) (holding that a water tank representing a river was not a copyrightable element of a play). *But see* *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 363 (9th Cir. 1947) (stating that although individual pieces of stage business are not copyrightable, a sequence or arrangement of such pieces may be).

¹⁰¹ See 17 U.S.C. § 102(a)(3).

¹⁰² I GOLDSTEIN, *supra* note 12, § 2.9.1.

¹⁰³ The Copyright Office defines a "dramatic work" as "one that portrays a story by means of dialog[ue] or acting and is intended to be performed." See COMPENDIUM, *supra* note 98, § 431.

¹⁰⁴ See 17 U.S.C. § 101 (defining "literary works" as "works, other than audiovisual works, expressed in words, numbers or other verbal or numerical symbols or indicia").

¹⁰⁵ See COMPENDIUM, *supra* note 98, § 430.

¹⁰⁶ See *id.* The Copyright Office specifically notes that a dramatic work "gives directions for performance or actually represents all or a substantial portion of the action as actually occurring, rather than merely being narrated or described." *Id.* § 431 (emphasis added).

¹⁰⁷ See *id.* § 430. One of the House Reports issued during the copyright revision process in the 1960s and 1970s suggested that stage directions are copyrightable subject matter:

Several witnesses at the hearings recommended the specific enumeration of additional categories of works in section 102, including . . . works of stage directors. . . . The committee concluded, however, that to the extent these works

Finally, because the works listed in Section 102 of the Copyright Act are clearly not meant to be exhaustive,¹⁰⁸ any work, although not specifically listed in Section 102, could qualify for copyright protection as long as it qualifies as an original work of authorship.¹⁰⁹ One objection, however, to including stage directions within the Act's scope is that any given set of stage directions does not, by itself, constitute a coherent story or dramatic work apart from the underlying play.¹¹⁰ In contrast, the typical pantomime or artistic dance is a complete work standing alone—the various gestures, movements, and dance steps as arranged by the creator embody a coherent work of art, whether they tell a dramatic story or not.¹¹¹ Stage directions, on the other hand, would make virtually no sense if they were isolated from the playwright's words.¹¹²

The "incomplete" quality of stage directions, however, ultimately should not be an impediment to copyright protection.¹¹³ Stage directions should instead receive copyright protection as a "derivative work."¹¹⁴ Derivative works are those derived from, or based upon, earlier works.¹¹⁵ To qualify for copyright protection, derivative works

constitute "original works of authorship" under the statute, they are already included in section 102's list.

H.R. REP. NO. 89-2237, at 46 (1966).

¹⁰⁸ The legislative history of the Copyright Act of 1976 states that "[t]he use of the word 'include,' as defined in section 101, makes clear that the listing is 'illustrative and not limitative,' and that the seven categories do not necessarily exhaust the scope of 'original works of authorship' that the bill is intended to protect." H.R. REP. NO. 94-1476, at 53 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5666.

¹⁰⁹ *Id.* (urging a flexible interpretation of the Act's coverage that would "free the courts from rigid or outmoded concepts of the scope of particular categories"). In addition, one could conceivably denominate a director's staging as a "compilation," which is specifically protected by the Copyright Act. See 17 U.S.C. § 103(a). A "compilation" comprises "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." *Id.* § 101. Although individual bits of stage business may or may not be copyrightable, the selection and arrangement of them into a coherent artistic work would bring them into the realm of copyright protection. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349-50 (1991) (discussing originality as applied to compilations of facts).

¹¹⁰ See 17 U.S.C. § 102(a)(3).

¹¹¹ See COMPENDIUM, *supra* note 98, § 450.01.

¹¹² See Leichtman, *supra* note 22, at 699 (stating that theatrical stage directions, standing alone, do not "tell a connected story or a series of events").

¹¹³ See 17 U.S.C. § 103(a); Leichtman, *supra* note 22, at 699.

¹¹⁴ See 17 U.S.C. § 103(a); Leichtman, *supra* note 22, at 699.

¹¹⁵ See 17 U.S.C. § 101 (defining derivative work as "a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionaliza-

must have sufficient creativity and constitute more than a trivial variation of the original.¹¹⁶ Stage directions are clearly derived from the playwright's script—they are the staged version of the writer's original work.¹¹⁷ As discussed in Section B of this Part, stage directions undoubtedly meet the originality requirement and almost always consist of more than a "trivial variation" of the written text.¹¹⁸

Authors of derivative works may copyright only the original elements that they have added to the earlier work.¹¹⁹ In many cases, those new elements standing alone will not constitute a coherent work of art.¹²⁰ For example, in a motion picture based on a play, if one stripped out all the dialogue derived from the play, the collection of movements, scene changes, and new dialogue in the movie would likely be an incomplete artistic work.¹²¹ The movie builds upon the play, integrating the dialogue, characters, and plot development of the earlier piece.¹²² In the same way, stage directions build upon and are integrated into the underlying dramatic work.¹²³

B. Originality: The Feist Doctrine

Even if stage directions fit into one or more of the subject matter categories of Section 102 of the Copyright Act, they must still have sufficient originality to qualify for copyright protection.¹²⁴ In 1991, in *Feist Publications, Inc. v. Rural Telephone Service Co.*, the U.S. Supreme Court enunciated the now familiar two-pronged standard for originality: (1)

tion, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted").

¹¹⁶ See *Gracen v. Bradford Exch.*, 698 F.2d 300, 304–05 (7th Cir. 1983) ("[A] derivative work must be substantially different from the underlying work to be copyrightable."); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976) (requiring that copyrightable derivative works contain "at least some substantial variation, not merely a trivial variation" on an original work).

¹¹⁷ See 17 U.S.C. § 103(a). For an interesting essay on the importance of the playwright's original stage directions and those added by the stage director, see Louis E. Catron, *Stage Directions for Directors and Actors: Your Faithful Servant—Stage Directions*, <http://lccatr.people.wm.edu/stagedirections.html> (last visited Feb. 13, 2009).

¹¹⁸ See *infra* notes 124–136 and accompanying text.

¹¹⁹ See 17 U.S.C. § 103(b) ("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 . . .").

¹²⁰ See COMPENDIUM, *supra* note 98, § 433.

¹²¹ See *id.*

¹²² See *id.* § 436.

¹²³ See *id.*

¹²⁴ See 17 U.S.C. § 102(a); *Feist*, 499 U.S. at 345.

independent creation and (2) a minimal degree of creativity.¹²⁵ In the vast majority of cases, stage directions arguably will meet this broad standard.¹²⁶ To the extent that stage directors autonomously conceive and execute the staging of a new or classic work, they will satisfy the independent creation prong.¹²⁷ Of course, a stage director who slavishly copied an earlier staging of the same work or even a different work would not meet that requirement.¹²⁸ If, on the other hand, the similarity of a director's staging to an earlier version occurred by happenstance as opposed to copying, the director would still be an independent creator.¹²⁹

In requiring a minimal degree of creativity for originality, the Supreme Court in *Feist* made it abundantly clear that this standard is extremely broad.¹³⁰ Works are original unless "the creative spark is utterly lacking or so trivial as to be virtually nonexistent."¹³¹ Original works do not need to be novel, innovative, or aesthetically pleasing to qualify for protection.¹³² As the Court noted, "The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be."¹³³

It seems that stage directions, which involve dozens of considered choices about lighting, mood, movement, tempo, and theme, would readily be viewed as creative works.¹³⁴ Just as a painter arranges splotches of color on a canvas or a writer puts together words in a story, the stage director visualizes how a dramatic work should be presented on stage and then executes that vision through combining scenic design, costuming, character arrangements and movements on stage, and actors' line inflections.¹³⁵ In other words, the director uses the building blocks of staging in a creative and often unique way to actualize an ar-

¹²⁵ See 499 U.S. at 345.

¹²⁶ See *id.*

¹²⁷ See *id.*

¹²⁸ See *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140, 144 (2d Cir. 1998) (holding that the plaintiff had not shown that he originated a particular phrase, as opposed to borrowing it from someone else).

¹²⁹ See *id.* at 143.

¹³⁰ See *Feist*, 499 U.S. at 345.

¹³¹ See *id.* at 359.

¹³² See *id.* at 345.

¹³³ See *id.*

¹³⁴ See *id.*

¹³⁵ See BARTOW, *supra* note 86, at xi-xii. For detailed descriptions of stage directors' creative processes, see generally *id.* Bartow interviewed twenty-one highly accomplished stage directors about their lives in the theatre, their goals as directors, their working methods, and their sources of inspiration. See *id.*

tistic concept just as other creative artists use the building blocks of their crafts—words, musical notes, paint, computer code, etc.—to mold their expressive impulses into a finished work of art.¹³⁶

C. Fixation in a Tangible Medium

Assuming that stage directions pass the originality test, they must still satisfy the fixation requirement to secure copyright protection.¹³⁷ Most authors of literary or dramatic works can easily demonstrate that their expression has been fixed because they will have written it down on paper or on a computer hard drive.¹³⁸ Directors, however, often employ a fluid working method in which ideas are generated during the rehearsal process and are immediately translated to the stage without being written down or otherwise memorialized.¹³⁹ To ensure that their work qualifies for copyright protection, stage directors must directly address the fixation problem.

To receive copyright protection, a work of authorship must be “fixed in any tangible medium of expression.”¹⁴⁰ Fixation is broadly defined to include any embodiment of the work pursuant to the author’s wishes in a relatively stable and permanent copy or phonorecord.¹⁴¹ Fixation is a baseline requirement for copyright protection, and the moment of fixation establishes the starting point for that protection.¹⁴²

Stage directions, especially those developed through the rehearsal process, may not be fixed initially.¹⁴³ They may consist merely of transi-

¹³⁶ See BARTOW, *supra* note 86. Many directors acknowledge the influence of the other creative arts on their own endeavors. See, e.g., Interview with Arvin Brown, in BARTOW, *supra* note 86, at 20, 22–23 (explaining the effect his earlier career as a writer had on his stage directing); Interview with Gordon Davidson, in BARTOW, *supra* note 86, at 67, 78 (describing the influence of dance and choreography on his work).

¹³⁷ See 17 U.S.C. § 102(a).

¹³⁸ See *id.*

¹³⁹ E.g., Interview with Cyndy A. Marion, *supra* note 93 (discussing her working conversations with set designers in developing staging ideas).

¹⁴⁰ 17 U.S.C. § 102(a).

¹⁴¹ See *id.* § 101. The embodiment has sufficient stability and permanence if it can “be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” *Id.*

¹⁴² See *id.* For works created on or after January 1, 1978, the term of protection begins on the date the work was created and lasts for the author’s life plus seventy years. *Id.* § 302(a). A work is “created,” in turn, “when it is fixed in a copy or phonorecord for the first time.” *Id.* § 101.

¹⁴³ See Interview with Joanne Akalaitis, Stage Dir., in BARTOW, *supra* note 86, at 1, 13 (“But I often do not know what we’re going to do when I go into rehearsal. . . . Once you walk into a rehearsal, what you’re going to do becomes clear.”).

tory instructions to the actors, designers, lighting and sound technicians, prop masters, and other participants in the production.¹⁴⁴ During rehearsals, the director may work from written notes that could consist of anything from disconnected jottings on note cards to a fully fleshed out description of all the details for mounting the production.¹⁴⁵

Historically, stage directions for the initial Broadway production of a new play were preserved in the stage manager's "prompt book."¹⁴⁶ When publishers such as Samuel French or the Dramatists Play Service then published the first edition of the play, they essentially printed the playwright's text coupled with the stage directions, prop list, and often a sketch of the set design from the first Broadway production.¹⁴⁷ Several years ago, recognizing the directors' growing demands for ownership of their creative work,¹⁴⁸ the theatrical publishers stopped publishing the "prompt book" version of new plays and now use only the text of the play as supplied by the playwright.¹⁴⁹ Thus, the published version of a new play, shorn of the stage directions, can no longer serve as the fixation of the director's staging.¹⁵⁰

¹⁴⁴ *E.g.*, Interview with Cyndy A. Marion, *supra* note 93 (discussing Ms. Marion's working relationship with her production staff).

¹⁴⁵ *E.g.*, Interview with Scott Ellis, Assoc. Artistic Dir., Roundabout Theatre, in N.Y., N.Y. (Aug. 31, 2007) (discussing his development and staging of the play *12 Angry Men*). The great German director Max Reinhardt prepared a detailed *Regiebuch*, or prompt book, for each of the plays that he directed. BROCKETT, *supra* note 76, at 495-96.

¹⁴⁶ See Jeannette Gunderson, Comment, *An Unaccountable Familiarity: A Dual Solution to the Problem of Theft in Theatrical Productions*, 31 SEATTLE U. L. REV. 667, 688 (2008).

¹⁴⁷ See generally LILLIAN HELLMAN, *ANOTHER PART OF THE FOREST* (Dramatists Play Serv., Inc. 1974) (containing stage directions and prop lists used in the play's original production).

¹⁴⁸ The SSDC maintains that the major play publishers, such as Samuel French and Dramatists Play Service, started removing the directors' notes from the published versions of plays in 1997 after receiving letters from the SSDC objecting to their inclusion. Interview with Barbara B. Hauptman, *supra* note 34.

¹⁴⁹ *Id.*; see also E-mail from Michael Q. Fellmeth, Vice President, Publ'ns & Info. Tech., Dramatists Play Serv., Inc., to Margit Livingston, Professor of Law, DePaul Univ. Coll. of Law (July 23, 2007) (on file with author). Mr. Fellmeth noted that Dramatists Play Service stopped publishing the full prompt book "at least ten years [ago], probably closer to fifteen at this point," around the same time that it became possible for playwrights to "maintain, revise, and ultimately submit their final script" in digital format. *Id.* He seemed to be suggesting that the shift away from printing the stage manager's prompt book toward publishing the playwright's version of the script had more to do with technological changes than the desire to avoid legal complications regarding directors' rights in their stage directions. See *id.*

¹⁵⁰ See 17 U.S.C. § 102(a); E-mail from Michael Q. Fellmeth, *supra* note 149. Some directors have suggested that the play publishing houses should offer theatres and production companies the option of licensing the original play with or without the Broadway

Directors, however, have other methods to fix their work. They could create their own detailed prompt books, in which they write out their notes on the stage setting, character development, specific movements, lighting cues, and other production details.¹⁵¹ In addition, they could arrange to videotape the finished production as a fixation of the staging.¹⁵² Provided directors choose some method of fixation recording their work in a more or less permanent and comprehensible way, they should have no difficulty clearing the fixation hurdle required for copyright protection.¹⁵³

Despite the controversy surrounding the copyrightability of stage directions, they appear to meet the Copyright Act's requisites for protection: (1) they fit within the subject matter categories as dramatic or choreographic works; (2) they possess, in most cases, the requisite originality demanded by *Feist*; and (3) they can be appropriately recorded in writing or on videotape for purposes of the fixation requirement.¹⁵⁴ Assuming that stage directions are copyrightable, then the question arises as to who will own the copyright in those directions—the director, the producer, or possibly even the playwright.

III. OWNERSHIP OF A COPYRIGHT IN STAGE DIRECTIONS

The Copyright Act vests initial ownership of a copyright in the work's author.¹⁵⁵ In many cases, the author is the creator of the work.¹⁵⁶

stage directions. If the original director's staging was included, then the licensee would pay a higher royalty, some of which would be paid to the original director. See Interview with Scott Ellis, *supra* note 145; Telephone Interview with Joe Mantello, *supra* note 52.

¹⁵¹ See Gunderson, *supra* note 146, at 688–89 (discussing a director's possible construction of a detailed prompt book).

¹⁵² See *id.* at 688. Only the Lincoln Center Library can videotape performances for archival purposes, and library patrons now need the director's permission to view those tapes. Interview with Neil Pepe, *supra* note 98. In the *Urinetown* cases, the Broadway director submitted an unauthorized videotape of a performance made by an audience member to the Copyright Office for registration purposes. Interview with Barbara B. Hauptman, *supra* note 34. A director relying on a videotaped fixation of her work would likely have to obtain permission from the other creative artists involved in the production (through their unions) to film a particular performance. See Lisa Jo Sagolla, *Dance/Movement: Should Stage Direction Be Copyrightable?*, BACK STAGE, May 20, 2008, http://www.backstage.com/bso/advice-columns/actors-craft/voice-movement/article_display.jsp?vnu_content_id=1003805591 (discussing issues associated with videotaping stage choreography).

¹⁵³ See 17 U.S.C. § 101 (defining "fixed"). In grappling with the fixation problem, choreographers developed two commonly accepted systems of symbols called Labanotation and Benesh notation as a means of recording various dance movements on paper. Roslyn Sulcas, *All the Right Moves*, N.Y. TIMES, Aug. 30, 2007, at E1.

¹⁵⁴ See 17 U.S.C. §§ 101, 102(a); *Feist*, 499 U.S. at 345.

¹⁵⁵ 17 U.S.C. § 201(a) (2006).

Thus, assuming a director's staging of a particular play constitutes a copyrightable work, the director would be the work's author and thus own the copyright in that work.¹⁵⁷ As the copyright owner, the director would then enjoy all of the exclusive statutory rights (e.g., the right to reproduce, the right to perform, etc.)¹⁵⁸ as well as the ability to transfer or license those rights to others.¹⁵⁹

In two situations, however, the director would lose or have to share authorship status.¹⁶⁰ First, if the director's work were considered a "work for hire," then the hiring party (i.e., the producer) would be the work's author.¹⁶¹ Alternatively, if the director were regarded as a joint author of the finished work (presumably with the playwright), then the director would share authorship with the collaborator.¹⁶² To fully understand directors' potential rights in their work, it is therefore necessary to examine the "work-made-for-hire" doctrine and the concept of joint authorship as they apply to stage directions.

A. Works Made for Hire: The Producer as Employer

Under federal law, the employer is the author of a work made for hire and thus owns the copyright in it, unless the parties agree otherwise.¹⁶³ Works made for hire can be either works created by employees within the scope of their employment or certain specially commissioned works.¹⁶⁴ Stage directions most likely would not fit into any of the specified categories for specially commissioned works, and therefore any work-for-hire claim would be made under the rubric of an employer-employee relationship.¹⁶⁵

¹⁵⁶ See F. Jay Dougherty, *Not a Spike Lee Joint? Issues in the Authorship of Motion Pictures Under U.S. Copyright Law*, 49 UCLA L. REV. 225, 230 (2001) (referring to the modern romantic notion of the author as "an innovative originator of creative material").

¹⁵⁷ See 17 U.S.C. § 201 (a); Dougherty, *supra* note 156, at 230.

¹⁵⁸ See 17 U.S.C. § 106 (listing the copyright owner's exclusive rights).

¹⁵⁹ See *id.* § 201 (d) (providing for the transfers of ownership and § 106 rights).

¹⁶⁰ See *id.* § 201 (a)-(b).

¹⁶¹ *Id.* § 201 (b).

¹⁶² *Id.* § 201 (a).

¹⁶³ See 17 U.S.C. § 201 (a). If the parties wish to opt out of this scheme, they must "have expressly agreed otherwise in a written instrument signed by them." *Id.*

¹⁶⁴ *Id.* § 101.

¹⁶⁵ See *id.* Specially commissioned works under this definition include contributions to collective works, works prepared as "a part of a motion picture or other audiovisual work," translations, supplementary works, compilations, instructional texts, tests, answers to tests, and atlases. *Id.* These specially commissioned works are deemed works made for hire, however, only if "the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire." *Id.*

In *Community for Creative Non-Violence v. Reid* ("CCNV"), the U.S. Supreme Court stated that the common law of agency determines whether a particular creator is an employee covered by the work-for-hire doctrine or is an independent contractor who retains authorship rights.¹⁶⁶ The Court listed several factors that lower courts should utilize in determining employee status, with primary emphasis on the hiring party's "right to control the manner and means by which the product is accomplished," but also including other elements such as the location of the work, the method of payment, the duration of the parties' relationship, and so forth.¹⁶⁷

In theatrical productions, producers normally hire directors to work for a specified period of time for a negotiated fee.¹⁶⁸ Applying the CCNV factors to the producer-director relationship leads to an ambiguous result.¹⁶⁹ Several factors clearly weigh in favor of employee status for the director whereas others suggest that the director is an independent contractor.¹⁷⁰ For example, under the SSDC model contracts, producers are required to provide health and pension benefits to the director,¹⁷¹ and they have control over the hiring of certain key personnel.¹⁷² In addition, in some of the model contracts, the producer is

¹⁶⁶ See 490 U.S. 730, 750–51 (1989).

¹⁶⁷ *Id.* at 751–52. Drawing on the *Restatement of Agency*, the Court stated the relevant considerations in determining whether a work is one made for hire include

the skill required; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired party; the extent of the hired party's discretion over when and how long to work; the method of payment; the hired party's role in hiring and paying assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hired party.

Id.

¹⁶⁸ See, e.g., Interview with Michael Mayer, *supra* note 74 (discussing his contract negotiations and final agreement to direct the play *Spring Awakening*).

¹⁶⁹ See CCNV, 490 U.S. at 751–52.

¹⁷⁰ See *id.*

¹⁷¹ See, e.g., The League of Off-Broadway Theatres & Producers & The Soc'y of Stage Dirs. & Choreographers, Inc., Collective Bargaining Agreement, July 1, 2005–June 30, 2010, § XI, at 15–16 (July 1, 2005) [hereinafter Off-Broadway-SSDC Collective Bargaining Agreement], available at [http://www.offbroadway.org/SSDC OB 05-10 signed.pdf](http://www.offbroadway.org/SSDC%20OB%2005-10%20signed.pdf).

¹⁷² See *id.* § XXI, at 29 (creating an arrangement whereby the producer, the director, and the author all have approval over the choice of cast, stage managers, and set, costume, and lighting designers, but the producer alone apparently has control over the hiring of the musical director, sound designer, stage combat fight director, and dance arranger). Even when the producer shares decisionmaking authority with the director, if the director

specifically designated as the “Employer”¹⁷³ and is required to pay Social Security taxes for the directors.¹⁷⁴ The producer, moreover, normally provides the rehearsal and performance space,¹⁷⁵ and mounting plays is often part of the producer’s “regular business.”¹⁷⁶

On the other hand, the key factor in the *CCNV* test—the hiring party’s right to control the manner and means by which the work is created—fits on the “independent contractor” side of the ledger for stage directors.¹⁷⁷ Although a producer certainly has some creative input regarding the production, the director makes the ultimate artistic decisions regarding the lighting, scene and costume design, actor movements and gestures, integration of music, and other production details.¹⁷⁸ Like the sculptor in *CCNV*, the director creates the finished production without the producer’s daily supervision.¹⁷⁹ Additionally, the director usually decides “when and how long to work,” constrained only by requirements of the actors’ union.¹⁸⁰

Ultimately, however, the directors’ membership in the SSDC may dictate that they be regarded as employees for copyright purposes.¹⁸¹ To participate in collective bargaining agreements with the various theatrical organizations, the directors belonging to the union must have

is not available to give approval, the producer alone may make the hiring decision, and the director is deemed to have given consent. *Id.*

¹⁷³ See, e.g., The Soc’y of Stage Dirs. & Choreographers, Inc., Special Contract § 1 (Mar. 16, 2007) [hereinafter SSDC Special Contract], available at <http://www.ssdcc.org/Special2007.pdf>.

¹⁷⁴ The Council of Stock Theatres & The Soc’y of Stage Dirs. & Choreographers, Inc., Collective Bargaining Agreement, Apr. 1, 2004–Mar. 31, 2008, § XXVI (Apr. 1, 2004), available at <http://www.ssdcc.org/COSTbook.pdf>.

¹⁷⁵ See Alan Schuster, *Things That Have Been Done to Me—Confessions of a Theatre Landlord*, in THE COMMERCIAL THEATER INST., GUIDE TO PRODUCING PLAYS AND MUSICALS 156, 159–63 (Frederick B. Vogel & Ben Hodges eds., 2006) (describing theatre licensing agreements between theatre landlords and producers).

¹⁷⁶ See generally FARBER, *supra* note 31 (examining the business of producing legitimate theatre).

¹⁷⁷ See *CCNV*, 490 U.S. at 751.

¹⁷⁸ See, e.g., Interview with Michael Mayer, *supra* note 74 (discussing his own thought processes in creating the show’s production details).

¹⁷⁹ See *CCNV*, 490 U.S. at 734–35 (describing the sculptor’s basically unsupervised work on the sculpture in his Baltimore studio with periodic visits by the hiring party). For a behind-the-scenes look at the creation of a Broadway show, including the relationship between the producer and director, see the documentary *MOON OVER BROADWAY* (New Video Group, Inc. 1998).

¹⁸⁰ E.g., Interview with Cyndy A. Marion, *supra* note 93 (discussing her efforts to balance her full time day job and her theatre duties); cf. *CCNV*, 490 U.S. at 734–53.

¹⁸¹ See, e.g., SSDC Special Contract, *supra* note 173, § 1 (noting that producers are the union director’s “employer”).

employee status.¹⁸² Independent contractors are not entitled to participate in collective bargaining agreements.¹⁸³ Thus, the SSDC has always insisted that union directors are employees of the producer.¹⁸⁴

Employees, however, can escape the copyright consequences of the work-for-hire doctrine by entering into an agreement with the employer to the effect that copyright ownership shall subsist in the employee.¹⁸⁵ The SSDC model contracts and collective bargaining agreements all have such a provision specifying that the rights in the direction "conceived by the Director . . . in the course of the rendition of his/her services . . . shall be . . . and will remain the sole and exclusive property of [the] Director."¹⁸⁶ In addition, these agreements reserve the directors' right to copyright their stage directions.¹⁸⁷ Furthermore, the theatre or producer is prohibited from authorizing the publication of the stage directions without the director's written consent.¹⁸⁸ Finally, these contracts limit the producer or theatre to using the director's stage directions only for specified productions.¹⁸⁹

¹⁸² See National Labor Relations Act § 7, 29 U.S.C. § 157 (2006) (noting that only "employees" have the power to bargain collectively through a union).

¹⁸³ Under the National Labor Relations Act, employers are required to bargain collectively only with employees; independent contractors are exempt from the Act's protection. See *id.* § 152(3) (defining employee); *id.* § 157 ("Employees shall have the right to self-organization, to form, join, or assist labor organizations, to bargain collectively through representatives of their own choosing, and to engage in other concerted activities for the purpose of collective bargaining or other mutual aid or protection.").

¹⁸⁴ See, e.g., SSDC Special Contract, *supra* note 173, § 1 (noting that producers are the employer of the director). Of course, it is quite possible that directors could be considered employees under the National Labor Relations Act and independent contractors under the Copyright Act: employee status under the former is defined by statute whereas under the latter it is determined by the common law of agency. Compare National Labor Relations Act § 2(3), 29 U.S.C. § 152(3), with *CCNV*, 490 U.S. at 750–51.

¹⁸⁵ See 17 U.S.C. § 201(b) (2006).

¹⁸⁶ See, e.g., Council of Resident Stock Theatres & The Soc'y of Stage Dirs. & Choreographers, Inc., Collective Bargaining Agreement, Jan. 1, 2005–Dec. 31, 2009, § XXVI, at 15 (Jan. 1, 2005) [hereinafter CORST-SSDC Collective Bargaining Agreement], available at <http://www.ssdcc.org/CORSTbook.pdf>.

¹⁸⁷ *Id.* The SSDC insisted on adding these clauses after an independent consultant's report (the "Latman Report") advised that such a clause was necessary to protect directors' ownership of their copyrights. Interview with Barbara B. Hauptman, *supra* note 34; see also Alan Latman & Jane C. Ginsburg, The Rights of Stage Directors and Choreographers 45–46 (Mar. 30, 1984) (unpublished report, on file with author) (urging inclusion of a property rights clause in the union's collective bargaining agreements).

¹⁸⁸ See, e.g., The League of Am. Theatres & Producers & The Soc'y of Stage Dirs. & Choreographers, Inc., Collective Bargaining Agreement, Sept. 1, 2004–Aug. 31, 2008, § XVII (Sept. 1, 2004), available at <http://www.ssdcc.org/bwy04-08BOOK.pdf>.

¹⁸⁹ See *id.* (granting the producer "a perpetual and irrevocable license" to use the stage directions in any stage production of the play in which the director "is entitled to receive a payment under an applicable SSDC minimum basic agreement").

Thus, even though stage directions are arguably works made for hire, the director-producer contract explicitly reserves to the director ownership of the copyright and other property rights in the stage directions.¹⁹⁰ In cases where a director did not explicitly reserve such rights, the producer would be both the author of the stage directions and the owner of the copyright in them, unless one could argue convincingly that the director was an independent contractor.¹⁹¹

B. Joint Authorship

Stage directors who are frustrated in their attempts to secure copyright protection for their stage directions as a stand-alone creative work might attempt to "piggyback" on the playwright's copyright in the underlying work by arguing for joint authorship of the play.¹⁹² Joint authors are co-owners of the copyright in their work, and as such, they have equal and undivided interests in it.¹⁹³ Each joint author may exercise the exclusive statutory rights of performance, reproduction, adaptation, and so forth, without obtaining permission from the other joint author or authors.¹⁹⁴ Joint authors, however, must share any profits received from these ventures with their co-authors.¹⁹⁵

Joint works are not created simply through the collaboration of two or more persons in originating a copyrightable work.¹⁹⁶ Under the

¹⁹⁰ See, e.g., CORST-SSDC Collective Bargaining Agreement, *supra* note 186, § XXVI, at 15.

¹⁹¹ See 17 U.S.C. § 201(a)-(b).

¹⁹² *Id.* § 201(a).

¹⁹³ See *id.*

¹⁹⁴ See, e.g., *Davis v. Blige*, 505 F.3d 90, 100 (2d Cir. 2007); *Bridgeport Music, Inc. v. DJ Yella Muzick*, 99 F. App'x 686, 691 (6th Cir. 2004); *McKay v. Columbia Broad. Sys., Inc.*, 324 F.2d 762, 763 (2d Cir. 1963); *Piantadosi v. Loew's, Inc.*, 137 F.2d 534, 536-37 (9th Cir. 1943).

¹⁹⁵ See, e.g., *Oddo v. Ries*, 743 F.2d 630, 633 (9th Cir. 1984); *Picture Music, Inc. v. Bourne, Inc.*, 314 F. Supp. 640, 646-47 (S.D.N.Y. 1970), *aff'd*, 457 F.2d 1213 (2d Cir. 1972).

¹⁹⁶ See 17 U.S.C. § 101 (defining "joint work"). The legislative history for the Copyright Act of 1976, however, indicates that collaboration alone may be enough to create a joint work:

[A] work is "joint" if the authors collaborated with each other, or if each of the authors prepared his or her contribution with the knowledge and intention that it would be merged with the contributions of other authors as "inseparable or interdependent parts of a unitary whole." The touchstone here is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit.

H.R. REP. NO. 94-1476, at 120 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5736. Notwithstanding this language, courts have tended to narrow the standard for a joint work through their application of the "intention" element and the creation of a copyrightable

Copyright Act, a joint work is “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”¹⁹⁷ Most courts have interpreted that definition to require both (1) that each author’s contribution be independently copyrightable¹⁹⁸ and (2) that each author intend that all contributors be joint authors at the time the work is created.¹⁹⁹ In addition to arguably being consistent with the statute,²⁰⁰ both requirements seemingly flow from a judicial desire to protect the “dominant” author from losing exclusive authorship simply because others have made editorial suggestions or insubstantial creative contributions.²⁰¹

In developing new plays, directors frequently work closely with the playwright to polish dialogue, improve scene structure and sequence, refine character depictions, and otherwise prepare the play for public performance.²⁰² In fact, many directors essentially serve as dramaturges in their collaborations with playwrights.²⁰³ Thus, directors might argue that they should be recognized as joint authors of

contribution requirement. Laura G. Lape, *A Narrow View of Creative Cooperation: The Current State of Joint Work Doctrine*, 61 ALB. L. REV. 43, 54–55 (1997).

¹⁹⁷ 17 U.S.C. § 101.

¹⁹⁸ See *Seshadri v. Kasraian*, 130 F.3d 798, 803 (7th Cir. 1997); *Childress v. Taylor*, 945 F.2d 500, 507 (2d Cir. 1991); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1493 (11th Cir. 1990). A few courts have questioned the independent copyrightability requirement for joint authorship. See, e.g., *Gaiman v. McFarlane*, 360 F.3d 644, 658–59 (7th Cir. 2004) (noting situations in which each author’s contribution to a work “couldn’t stand alone because of the nature of the particular creative process that had produced it”).

¹⁹⁹ See *Thomson v. Larson*, 147 F.3d 195, 201 (2d Cir. 1998); *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1068–69 (7th Cir. 1994); *Childress*, 945 F.2d at 508.

²⁰⁰ The “author” element of the joint work definition arguably mandates that each collaborator’s contribution be independently entitled to copyright protection. 1 GOLDSTEIN, *supra* note 12, § 4.2.1.2.

²⁰¹ See *Childress*, 945 F.2d at 504 (“Care must be taken . . . to guard against the risk that a sole author is denied exclusive authorship status simply because another person rendered some form of assistance.”).

²⁰² See Interview with Michael Mayer, *supra* note 74 (discussing his role as a dramaturge in preparing a play for production). In rare cases, directors actually generate theatrical pieces in collaboration with their acting company (e.g., the Wooster Group in New York City operated in that fashion). ROB GRAHAM, *THEATER: A CRASH COURSE* 135 (1999); Interview with Neil Pepe, *supra* note 98. The choreographer-director Michael Bennett took stories contributed by a group of dancers and wove them into the finished script for the hit musical *A Chorus Line*. Bennett’s methods, however, created legal problems years later when some of the contributing dancers came forward and demanded—and ultimately received—a share of the play’s royalties generated from subsequent first-class productions. Campbell Robertson, *Those First in “Chorus Line” Gain a Continuing Stake*, N.Y. TIMES, Feb. 2, 2008, at B8.

²⁰³ Interview with Cyndy A. Marion, *supra* note 93 (stating that she worked as a dramaturge on one of her company’s new plays for three years and through fourteen drafts).

the play; as such, they would be entitled to copyright protection in the play as a whole.²⁰⁴

There are at least two problems with a director's potential claim of joint authorship. First, the Dramatists Guild's model contracts specify that no director, actor, producer, or other person can make changes to the writer's script without the writer's prior approval and that any such changes accepted by the writer belong to the writer.²⁰⁵ That contractual provision hinders a director's claim of joint authorship.²⁰⁶

In addition, directors would typically fail to satisfy the "intent" criterion in the judicial test for joint authorship.²⁰⁷ Under the standard analysis, each putative joint author must have the intent at the time of collaboration to be a joint author.²⁰⁸ The director, in fact, may have such an intent, but in most cases, it will be impossible to show that the playwright did.²⁰⁹ In 1998, in *Thomson v. Larson*—the classic joint authorship case involving theatrical collaborators—the U.S. Court of Appeals for the Second Circuit relied on certain objective indicia of intent, such as decisionmaking authority, billing credit, and relationships with third parties, to glean the parties' intent.²¹⁰ In *Thomson*, the dramaturge Lynn Thomson worked closely with the playwright Jonathan Larson to create the hit Broadway musical *Rent*.²¹¹ Although arguably she may have made copyrightable contributions, such as dialogue and song lyrics, to the end product,²¹² the court concluded that the playwright Larson clearly intended to be the musical's sole author, and all of his actions and words supported that conclusion.²¹³ In other theatrical col-

²⁰⁴ See 17 U.S.C. §§ 101, 201.

²⁰⁵ See Dramatists Guild of Am., Benefits: DG Contracts, http://www.dramatistsguild.com/mem_benefits_dgcontracts.aspx (last visited Feb. 20, 2009) ("No additions, omissions, or alterations to the text, title or stage directions of the play may be made without the author's prior written consent, and all such approved changes are the sole property of the author, free of liens or encumbrances . . .").

²⁰⁶ See *id.*

²⁰⁷ See, e.g., *Thomson*, 147 F.3d at 201.

²⁰⁸ See *id.*

²⁰⁹ See *id.*

²¹⁰ See *id.* at 202–05.

²¹¹ See *id.* at 197–98.

²¹² The district court had concluded that Thomson had made a "non-*de minimis* copyrightable contribution" to the finished version of *Rent*. *Thomson*, 147 F.3d at 200–01. The court of appeals specifically declined to reach the question of whether her contributions were independently copyrightable because the lack of mutual intent was sufficient to demolish the joint authorship claim. *Id.* at 205.

²¹³ See *id.* at 202–05. For example, Larson had the sole authority to accept or reject any suggestion proffered by Thomson. *Id.* at 203. In all versions of the script, he listed himself as the author of *Rent* and sometimes referenced Thomson as the "dramaturg" for the play.

laboration cases, the “dominant” author similarly has been able to fend off joint authorship claims from his creative partners.²¹⁴ Unless the playwright has indicated in some fashion that he accepts the director as a co-author, most courts are likely to find that the playwright lacked the requisite intent.²¹⁵

Thus, it is fairly clear that directors, rather than producers, will own the copyright in their stage directions.²¹⁶ In most cases, directors seeking to enlarge their share of the monetary pie will fail, however, to prove joint authorship with the playwright and thus will not be able to “piggyback” on any continuing royalties that the playwright may enjoy.²¹⁷ On the other hand, directors who contribute significantly to the crafting of the play and who also have sufficient bargaining power may be able to negotiate for a share of the play’s royalties generated in subsequent productions.²¹⁸ Obviously, only the elite directors will possess that kind of leverage.²¹⁹

IV. INFRINGING THE COPYRIGHT IN STAGE DIRECTIONS: WHEN IS SIMILAR TOO SIMILAR?

A. *The Requirements for Copyright Infringement*

To establish a claim for damages or injunctive relief under the Copyright Act, the plaintiff must prove that the defendant infringed one of her statutory rights in the protected work.²²⁰ The various courts of appeals employ slightly different judicial tests for infringement, but they all require that the plaintiff demonstrate (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are

Id. at 197–98. In addition, he entered into contracts regarding production of the musical without consulting her. *Id.* at 204. Finally, on many occasions, he stated that he wished to be the sole creator of *Rent*. *Id.*

²¹⁴ See *Erickson*, 13 F.3d at 1068–69, 1073 (holding that a playwright who accepted suggestions from her acting company was the sole author of the finished plays); *Childress*, 945 F.2d at 508–09 (concluding that a playwright who incorporated research and ideas supplied by a collaborator was the play’s sole author).

²¹⁵ See, e.g., *Thomson*, 147 F.3d at 202–05.

²¹⁶ See *supra* notes 163–191 and accompanying text.

²¹⁷ See *supra* notes 192–215 and accompanying text.

²¹⁸ See *FARBER*, *supra* note 31, at 121–22 (observing that some directors who assist with writing can negotiate for “as much as 1½ or 2 percent of the gross receipts for the writing, in addition to the directing fee”). Two New York directors, who wished to remain anonymous, indicated in their interviews with the author that they routinely receive a percentage of the playwright’s royalties for their assistance with the writing of the show.

²¹⁹ See *id.*

²²⁰ See 17 U.S.C. § 106 (2006) (listing a copyright owner’s “exclusive” rights).

original.²²¹ In pursuing a copyright infringement claim, stage directors would first have to establish that they possessed a valid copyright in their stage directions.²²² They presumably could do this by showing their work's copyrightability and their ownership of that copyright either as independent authors or as employees entitled to ownership of their work under their contract with the producer.²²³ In addition, registering the copyright before or within five years of the work's first publication constitutes prima facie evidence of the copyright's validity.²²⁴

The requisites for establishing the second element of an infringement action, unlawful copying, vary among the courts of appeals.²²⁵ The U.S. Court of Appeals for the Second Circuit requires a plaintiff to prove that the defendant copied the plaintiff's work as a whole and that the copying involved unlawful appropriation of protectable elements of the work.²²⁶ The plaintiff may prove copying either through the defendant's admission or through evidence of the defendant's access to the plaintiff's work coupled with "probative" similarity between the two works.²²⁷ In determining probative similarity, the trial court may admit expert testimony to assist in dissecting the constituent elements of the works—e.g., characters, plot, pacing, and structure of a literary or dramatic work.²²⁸ In undertaking the probative similarity analysis, the trier

²²¹ See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991); *Phillips v. Audio Active Ltd.*, 494 F.3d 378, 390 (2d Cir. 2007); *Zomba Enters., Inc. v. Panorama Records, Inc.*, 491 F.3d 574, 581 (6th Cir. 2007), *cert. denied*, 128 S. Ct. 2429 (2008); *JCW Invs., Inc. v. Novelty, Inc.*, 482 F.3d 910, 914 (7th Cir. 2007); *Thompson v. Looney's Tavern Prods., Inc.*, 204 F. App'x 844, 848 (11th Cir. 2006); *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1076 (9th Cir. 2006).

²²² See *Feist*, 499 U.S. at 361.

²²³ See *supra* notes 71–154, 163–191 and accompanying text (discussing stage directions as copyrightable subject matter and ownership of that copyright). Additionally, before filing suit, a director would have to register the work with the Copyright Office. See 17 U.S.C.A. § 411 (West 2005 & Supp. III 2009) (“[N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.”).

²²⁴ 17 U.S.C. § 410(c).

²²⁵ Compare, e.g., *Jorgensen v. Epic/Sony Records*, 351 F.3d 46, 51 (2d Cir. 2003), with *Narell v. Freeman*, 872 F.2d 907, 910–12 (9th Cir. 1989).

²²⁶ See *Jorgensen*, 351 F.3d at 51; *Castle Rock Entm't, Inc. v. Carol Publ'g Group*, 150 F.3d 132, 137 (2d Cir. 1998); *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 139–40 (2d Cir. 1992).

²²⁷ See *Boone v. Jackson*, 206 F. App'x 30, 31 (2d Cir. 2006). See generally Alan Latman, “Probative Similarity” as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement, 90 COLUM. L. REV. 1187 (1990).

²²⁸ *Repp v. Webber*, 132 F.3d 882, 888–89 (2d Cir. 1997); *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

of fact should also compare the two works as a whole, including both protectable and unprotectable elements.²²⁹

Once probative similarity has been established, the plaintiff must then prove that the defendant unlawfully appropriated her protected expression under the “substantial similarity” standard.²³⁰ The defendant will have impermissibly copied the plaintiff’s work if the ordinary lay observer would find the two works substantially similar.²³¹ At this stage, analytical dissection of the two works and expert testimony are not used.²³² The trier of fact simply must determine whether the “total concept and feel” of the two works is substantially similar.²³³

In 1977, the U.S. Court of Appeals for the Ninth Circuit developed its own two-step test for assessing copyright infringement in *Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*²³⁴ Under *Krofft*’s first step, the “extrinsic test,” the trier of fact must compare the plaintiff’s and defendant’s works to determine the similarity of their ideas.²³⁵ As in the Second Circuit’s approach, the trier of fact engages in analytical dissection of both works assisted by expert testimony.²³⁶ If the trier of fact finds substantial similarity of ideas, it then moves to the second step, the “intrinsic test,” under which it examines the works as an ordinary observer without analytic dissection or use of expert testimony.²³⁷ During this process, the trier of fact judges whether the two works have “substantial similarity in expressions . . . depending on the response of the ordinary reasonable person.”²³⁸

²²⁹ *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 123 (2d Cir. 1994); 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.01[B] (2007).

²³⁰ *Castle Rock*, 150 F.3d at 137–38; *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997).

²³¹ See *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 765 (2d Cir. 1991); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (stating that there is substantial similarity between plaintiff’s and defendant’s works if “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same”). Where the two works contain both protectable and unprotectable elements, the Second Circuit has applied the “discerning ordinary observer” test, under which only the protectable elements are compared. See *Merit Diamond Corp. v. Frederick Goldman, Inc.*, 376 F. Supp. 2d 517, 525 (S.D.N.Y. 2005).

²³² See *Arnstein*, 154 F.2d at 468.

²³³ See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2d Cir. 1995).

²³⁴ 562 F.2d 1157, 1164 (9th Cir. 1977); see also *Narell v. Freeman*, 872 F.2d 907, 910 (9th Cir. 1989); *Olson v. Nat’l Broad. Co.*, 855 F.2d 1446, 1448–49 (9th Cir. 1989).

²³⁵ See *Krofft*, 562 F.2d at 1164.

²³⁶ See *Swirsky v. Carey*, 376 F.3d 841, 845 (9th Cir. 2004).

²³⁷ *Krofft*, 562 F.2d at 1164.

²³⁸ *Id.*

Over time, the Ninth Circuit's approach to infringement has moved closer to that of the Second Circuit, especially with respect to the first step, the extrinsic test.²³⁹ Recent cases have allowed the trier of fact to determine substantial similarity by looking at more than merely the two works' "ideas."²⁴⁰ Extrinsic test criteria for literary works, for example, include plot, theme, dialogue, mood, setting, pace, sequence of events, and characters.²⁴¹

Stage directors seeking to establish copyright infringement of their stage directions would have to satisfy the infringement standard applied in the particular circuit where the suit is brought.²⁴² Because the Broadway theatre industry is located in New York City, many of these suits are likely to be brought in courts within the Second Circuit.²⁴³ If it is impossible to obtain personal jurisdiction over the defendant director in New York,²⁴⁴ however, the plaintiff director may have to sue in the location in which the alleged infringing activity occurred.²⁴⁵ Apart from the Second and Ninth Circuits, the other circuits have their own variations on the legal standard for unlawful appropriation of copyrighted work.²⁴⁶

Despite the appellate courts' varying tests for copyright infringement, plaintiff directors will always be faced with establishing the familiar triad of a valid copyright, the defendant's copying of the plaintiff's work, and the defendant's unlawful appropriation of the plaintiff's protected expression.²⁴⁷ Assuming for the moment that the Second Circuit standard for infringement applies, the plaintiff director would have to show that there was a valid copyright in the plaintiff's stage directions.²⁴⁸ The plaintiff would have to convince a court that stage direc-

²³⁹ See 4 NIMMER, *supra* note 229, § 13.03[E][3][b] (discussing the evolution of the Ninth Circuit standard for substantial similarity).

²⁴⁰ See *id.*

²⁴¹ *Shaw v. Lindheim*, 919 F.2d 1353, 1356-57 (9th Cir. 1990); *Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984).

²⁴² See, e.g., *Jorgensen*, 351 F.3d at 51.

²⁴³ See, e.g., *Laureysens*, 964 F.2d at 132-33 (noting that the original case was filed in the U.S. District Court for the Southern District of New York and appealed to the U.S. Court of Appeals for Second Circuit).

²⁴⁴ See, e.g., *Mantello v. Hall*, 947 F. Supp. 92, 102 (S.D.N.Y. 1996) (holding that the court did not have personal jurisdiction over the Florida defendants director and theatre company because they had not done business in New York and their actions did not meet the requirements of the New York long-arm statute).

²⁴⁵ See, e.g., *id.*

²⁴⁶ See 4 NIMMER, *supra* note 229, § 13.03 (reviewing approaches to substantial similarity in various circuits).

²⁴⁷ See, e.g., *Krofft*, 562 F.2d at 1162-64.

²⁴⁸ See *Phillips v. Audio Active Ltd.*, 494 F.3d 378, 390 (2d Cir. 2007).

tions consist of copyrightable subject matter and are thus subject to protection under the Copyright Act.²⁴⁹ As discussed earlier, the plaintiff should be able to argue successfully that stage directions contain the requisite creativity and originality to constitute original works of authorship and that they fall within one of the categories specifically listed in the Act—namely, dramatic and/or choreographic works or pantomimes.²⁵⁰

In establishing copying, the plaintiff director should usually have little difficulty showing that the defendant director had access to the plaintiff's work.²⁵¹ If the plaintiff directed a successful Broadway or Off-Broadway production, the defendant could easily have purchased tickets to view one or more performances.²⁵² To prove probative similarity between the two sets of stage directions, the plaintiff would likely need to introduce videotaped copies of both shows and expert testimony comparing the two stagings.²⁵³ Assuming that the two productions had sufficient common elements, the plaintiff would be able to establish that the defendant copied from the plaintiff's stage directions.²⁵⁴

In fulfilling the final element for infringement—showing substantial similarity between the two works—some plaintiff directors, however, may encounter a formidable barrier.²⁵⁵ Substantial similarity necessitates proving that the defendant has impermissibly borrowed the protectable elements.²⁵⁶ As is explored more fully below, in many cases a large portion of the plaintiff's stage directions will consist of unprotectable elements, such as *scènes à faire* or expression merged

²⁴⁹ See 17 U.S.C. § 102.

²⁵⁰ See *supra* notes 71–154 and accompanying text (discussing copyrightable subject matter). To bring suit, the plaintiff must have registered the work with the Copyright Office. See 17 U.S.C.A. § 411. That requirement may pose a serious problem for the plaintiff if the Copyright Office refuses registration on the basis that stage directions are not copyrightable or for some other reason. See *id.* The Copyright Office, over time, has exhibited a schizophrenic attitude toward the registration of stage directions: it apparently refused registration for the stage directions in *Urinetown*, see *supra* note 32, but permitted registration several years earlier for Gerald Gutierrez's directions for *The Most Happy Fella*, see Richard C. Reuben, *New Clout for Stage Directors: Copyright Protection Available for Creative Work*, A.B.A. J., Oct. 1995, at 32, 32.

²⁵¹ See *Kroff*, 562 F.2d at 1162 (discussing the access requirement).

²⁵² See *id.*

²⁵³ *Boone*, 206 F. App'x at 31.

²⁵⁴ See *id.*

²⁵⁵ See *Castle Rock*, 150 F.3d at 137–38.

²⁵⁶ See *id.*

with the underlying idea.²⁵⁷ Often, the surviving protectable core of the plaintiff's expression may be small to nonexistent.²⁵⁸

Notwithstanding the possibility of almost *de minimis* impermissible borrowing by some defendant directors, there will be cases, especially involving the staging of new plays, where the original director's contribution will escape the confines of *scènes à faire* and the merger doctrine and thus enjoy a substantially greater level of protection.²⁵⁹ In these cases, although the director's concept for the staging would likely be an unprotectable idea, the specific expression of that idea through the actors' movements on stage, the use of lighting and sound, the integration of music, the pacing of the performance, and so forth could be highly original and specific, and therefore protectable.²⁶⁰ If the playwright's own stage directions are minimal—which they tend to be in contemporary works—then it would be more difficult for a defendant director to argue that the plaintiff's stage directions were dictated by the playwright or the dialogue.²⁶¹ Plaintiffs in these kinds of cases may enjoy greater success in pursuing infringement suits.²⁶²

B. *Limitations on Copyright Protection: The Fair Use Defense, the Merger Doctrine, and Scènes à Faire*

Obviously, a copyright infringement action must face all the usual defenses available in any civil action, including the statute of limitations,²⁶³ laches,²⁶⁴ and lack of personal²⁶⁵ or subject matter jurisdiction.

²⁵⁷ See *infra* notes 302–332 and accompanying text.

²⁵⁸ See *infra* notes 302–332 and accompanying text.

²⁵⁹ See 17 U.S.C. § 102.

²⁶⁰ Interview with Scott Ellis, *supra* note 145 (stating that he did not object as much to another director's borrowing his general staging concept as long as the second director did not appropriate his specific execution of that idea).

²⁶¹ See, e.g., Sally Gragin, *An Antic, Inspired Take on Mamet's "Shawl,"* BOSTON GLOBE, Jan. 30, 2002, at F5; see also *infra* notes 302–332 and accompanying text.

²⁶² See *Castle Rock*, 150 F.3d at 137–38 (describing the necessary elements in an infringement action).

²⁶³ See 17 U.S.C. § 507(b) (providing for a three-year statute of limitations for civil actions under the Copyright Act).

²⁶⁴ See, e.g., *Danjaq LLC v. Sony Corp.*, 263 F.3d 942, 947, 954 (9th Cir. 2001) (holding that laches barred a claim of co-ownership in the James Bond character even though it was brought within the three-year limitation period).

²⁶⁵ See, e.g., *Mantello*, 947 F. Supp. at 102 (holding that the court did not have personal jurisdiction over the Florida defendants director and theatre company because they had not done business in New York and their actions did not meet the requirements of the New York long-arm statute).

tion.²⁶⁶ Copyright cases, though, have their own unique limitations on protection and defenses that a plaintiff stage director must be prepared to overcome in pursuing a successful infringement case.²⁶⁷ Individually and collectively, they create several serious barriers to establishing liability under the Copyright Act—barriers that Congress and the courts have consciously built into the copyright scheme to prevent an undue monopoly over creative elements that should remain in the public domain.²⁶⁸

1. The Fair Use Defense

Originating in the common law, fair use is a statutory defense to infringement that allows the public to employ copyrighted material without authorization.²⁶⁹ The defense is part of the bargain struck between authors and users under the Copyright Act: copyright holders enjoy certain exclusive rights to exploit their creations during the monopoly period but cannot prevent the public from borrowing their creations in appropriate, limited, and socially useful ways.²⁷⁰ Parody, critique, commentary, and other transformative and critical uses often find protection in the fair use doctrine.²⁷¹

Any borrower could potentially be a fair user, including a stage director using directions from an earlier director's production, depending on how a court balances the statutory factors for fair use.²⁷² Those factors examine the borrower's purpose in borrowing, the quantity and importance of the material borrowed, the original work's character, and perhaps, most importantly, the extent to which the borrower's use may supplant the "potential market" for the borrowed work.²⁷³ The application of these factors to individual cases is

²⁶⁶ See 28 U.S.C. § 1338(a) (2006) (giving the federal courts exclusive jurisdiction over civil actions "arising under" the Copyright Act).

²⁶⁷ See *infra* notes 269–332 and accompanying text.

²⁶⁸ See *infra* notes 269–332 and accompanying text.

²⁶⁹ See 17 U.S.C. § 107 ("[F]air use of a copyrighted work . . . is not an infringement of copyright.").

²⁷⁰ See *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 799–800 (9th Cir. 2003) ("Recognizing that science and art generally rely on works that came before them and rarely spring forth in a vacuum, the Act limits the rights of a copyright owner regarding works that build upon, reinterpret, and reconceive existing works.").

²⁷¹ Section 107 of the Copyright Act, which codifies the judicially created fair use doctrine, lists several examples of possible fair uses including "criticism, comment, news reporting, teaching . . . scholarship, or research." 17 U.S.C. § 107.

²⁷² See *id.* (listing the statutory fair use factors).

²⁷³ See *id.* Section 107 lists the four nonexclusive fair use factors:

obviously very fact-specific, but a few observations about the fair use doctrine as it pertains to stage directions can be made.

First, in borrowing stage directions, the later director often has the same purpose as the original director: to stage the play in the most effective way possible.²⁷⁴ In addition, however, where regional directors appropriate staging from Broadway directors, the former are often deliberately trying to recreate the "Broadway experience" for their audiences.²⁷⁵ Rather than suffering the effort and considerable expense of actually going to New York to see the original Broadway show, theatre patrons across the country can enjoy a "simulation" of the New York production in their own hometowns.²⁷⁶ The courts frown upon this kind of nontransformative, bodily appropriation of another's creative endeavors.²⁷⁷

Second, the original director's work is normally of a highly creative nature.²⁷⁸ Intricately staging a complex production in a way that both honors the playwright's intent and also pleases the audience is a demanding task that requires the director to make dozens of artistic choices that cohere into a finished work.²⁷⁹ Thus, the second fair use

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for 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 or value of the copyrighted work.

Id.

²⁷⁴ See 17 U.S.C. § 107(1) (identifying the purpose and character of the borrower's use as a statutory fair use factor).

²⁷⁵ See, e.g., Donald Munro, "Buffalo" Seems a Bit Too Predictable, *FRESNO BEE*, Aug. 4, 2006, at E5 (noting that a regional production of *Moon over Buffalo* is "scrupulously faithful to the original production's direction and staging").

²⁷⁶ See *id.*

²⁷⁷ See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 587-88 (1994) ("[A] work composed primarily of an original, particularly its heart, with little added or changed, is more likely to be a merely superseding use, fulfilling demand for the original."); *Ty, Inc. v. Publ'ns Int'l Ltd.*, 292 F.3d 512, 517 (7th Cir. 2002) ("[C]opying that is complementary to the copyrighted work (in the sense that nails are complements of hammers) is fair use, but copying that is a substitute for the copyrighted work (in the sense that nails are substitutes for pegs or screws), or for derivative works from the copyrighted work . . . is not fair use."); *L.A. Times v. Free Republic*, 54 U.S.P.Q.2d (BNA) 1453, 1467 (C.D. Cal. 2000) (holding that the defendant's wholesale copying of the plaintiff's newspaper articles served as a substitute for the original material and was not a fair use).

²⁷⁸ E.g., Interview with Michael Mayer, *supra* note 74 (discussing the many creative decisions a director makes in staging a new play).

²⁷⁹ *Id.*

factor—"the nature of the copyrighted work"—will usually weigh in the original director's favor.²⁸⁰

Third, the extent of the later director's appropriation can push the fair use balance to one outcome or the other.²⁸¹ Borrowing a few pieces of stage business or an occasional imitation of lighting or sound effects might easily constitute a fair use, especially if the borrowed material is dictated somewhat by the underlying dramatic work.²⁸² If, however, the later director appropriates large and dramatically important portions of the earlier director's staging, then a court is less likely to find fair use, particularly if the stage directions have been copied in their most minute details.²⁸³

The final factor in the fair use analysis—the impact of the borrower's use on the market for the creator's work—is slightly more elusive in its application to stage directions than the other factors.²⁸⁴ If the second director takes large portions of the original director's staging without permission, one could argue that the appropriation by itself has an effect on the market for the staging by depriving the original director of the ability to license the copyrighted material to the second director.²⁸⁵ In addition, if audiences believe that they are getting more or less the "Broadway experience" in their local theatre, they are less likely to travel to New York to view the original production.²⁸⁶ Because many stage directors receive a portion of the royalties from the future performances of their shows, smaller audiences

²⁸⁰ See 17 U.S.C. § 107(2); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1271 (11th Cir. 2001) ("[T]here is a hierarchy of copyright protection in which original, creative works are afforded greater protection than derivative works or factual compilations."); *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992) (stating that in determining fair use, a court should consider "[w]hether the original is creative, imaginative, or represents an investment of time in anticipation of a financial return").

²⁸¹ See 17 U.S.C. § 107(3).

²⁸² See *Sony Computer Entm't Am., Inc. v. Bleem, LLC*, 214 F.3d 1022, 1028 (9th Cir. 2000) (finding a fair use where the appropriated material was "such an insignificant portion of the complex copyrighted work as a whole").

²⁸³ See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 565–66 (1985) ("[T]he fact that a substantial portion of the infringing work was copied verbatim is evidence of the 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."); *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 820–21 (9th Cir. 2003) (observing that, although extensive copying does not bar a fair use finding, it weighs against it).

²⁸⁴ See 17 U.S.C. § 107(4).

²⁸⁵ See *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 929–30 (2d Cir. 1994) (discussing copyright holders' potential loss of licensing fees acquired through exploitation of their copyrighted works).

²⁸⁶ See 17 U.S.C. § 107(4).

would mean a smaller paycheck for the original director.²⁸⁷ A touring company spun off from the Broadway show, moreover, may find that the market for the show has been saturated by the second director's imitation of the Broadway staging in a regional production.²⁸⁸ Finally, if the second director's staging is nontransformative—i.e., not a parody, commentary, or critique—but simply a duplication of the original staging, then the second director is arguably competing in the same market as the first.²⁸⁹ If the second director stages a parody of the first production,²⁹⁰ however, then presumably she is offering a different product to audiences that would not necessarily compete with the original production.²⁹¹

On the other hand, a later director borrowing stage directions from an earlier director could assert that the audiences for the two productions are different.²⁹² First, most regional audience members are not going to incur the expense of traveling to New York to view the original Broadway show.²⁹³ Second, most touring companies visit only major cities such as Chicago, Boston, Dallas, and the like.²⁹⁴ Thus, a production in Akron, Ohio, or Fargo, North Dakota, may not compete directly with a touring company production.²⁹⁵ In other words, audience members who desire to see a replica of the original Broadway production, without going to New York or a tour city, generally will have no available market substitutes.²⁹⁶ Most copyrightable works, such as books, music, movies, and posters, can be procured whether the consumer lives in New York or Laramie, Wyoming; the live theatrical pro-

²⁸⁷ E.g., Interview with Michael Mayer, *supra* note 74 (discussing his royalty agreements with the producer).

²⁸⁸ See 17 U.S.C. § 107(4).

²⁸⁹ See *id.*

²⁹⁰ One of the unusual aspects of the *Urinetown* litigation is that *Urinetown* is itself a parody of the pseudo-serious but splashy Broadway musical and contains many scenes designed to mock the over-the-top theatricality and self-conscious pretension found in some shows. See *Theater Guide*, N.Y. TIMES, June 15, 2001, at E5 ("But the show's real concern is to make sport of the Broadway musical, particularly the kind with a social conscience, from 'The Threepenny Opera' to 'Les Miserables.'"). Hence, any staging of *Urinetown* is going to contain parodic elements, and it would be difficult for subsequent directors to argue that they had transformed the original staging through parody. See *id.*

²⁹¹ See 17 U.S.C. § 107(4).

²⁹² See *id.*

²⁹³ See *id.*

²⁹⁴ See, e.g., Mark Kennedy, *Rent Goes on the Road: 3 Original Cast Members Join U.S. Tour*, PHILA. DAILY NEWS, Jan. 26, 2009, at 31 (discussing the musical *Rent*'s national tour, which includes stops in Boston, Chicago, and Dallas).

²⁹⁵ See *id.*

²⁹⁶ See *id.*

duction is one of the few exceptions.²⁹⁷ That being said, the second director still faces the problem that any wholesale appropriation of copyrighted material normally requires the copyright holder's permission and the payment of a licensing fee.²⁹⁸

Ultimately, in assessing fair use, the courts balance all four factors to determine the appropriate outcome.²⁹⁹ A later director who makes a transformative use of an earlier director's staging and borrows just enough to "conjure up" the first production might find a safe harbor in the fair use doctrine.³⁰⁰ But a director who appropriates large and significant portions from the earlier director's stage directions without attribution, without permission, and without transformation will have difficulty successfully asserting fair use.³⁰¹

2. The Merger Doctrine and Scènes à Faire

The merger doctrine and scènes à faire can be regarded either as a barrier to copyrightability or as a defense to infringement.³⁰² These doctrines, both of which originate in the notion that basic concepts and ideas should be free for all to borrow, have particular relevance to stage directions.³⁰³ Under the merger doctrine, if an idea can be expressed in only a few ways, there is a "merger" between idea and expression, which leads to one of two conclusions: either (1) the expression is not copyrightable because allowing a copyright would give the author a monopoly on the idea or (2) the expression is copyrightable but most subsequent expressions will not infringe because there are so few ways for the later author to express that particular idea.³⁰⁴

The related doctrine of scènes à faire involves standard plot devices, characters, and settings that are essential to or common in a

²⁹⁷ See 17 U.S.C. § 107(4).

²⁹⁸ See *Am. Geophysical Union*, 60 F.3d at 929–30 (discussing the potential licensing of journal articles with the publisher's permission).

²⁹⁹ See, e.g., *Kelly*, 336 F.3d at 818–22.

³⁰⁰ See *Campbell*, 510 U.S. at 579, 588.

³⁰¹ See *id.* at 595.

³⁰² See *Sportsmans Warehouse, Inc. v. Fair*, 576 F. Supp. 2d 1175, 1196 n.4 (D. Colo. 2008) (discussing the doctrine of merger and scènes à faire), *appeal dismissed*, No. 08-1314, 2009 WL 301827 (10th Cir. Feb. 9, 2009).

³⁰³ See *id.*

³⁰⁴ *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 322 (2d Cir. 1996); *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741–42 (9th Cir. 1971). Professor Goldstein has suggested that the merger doctrine is more properly applied to factual and functional works whereas the scènes à faire concept pertains to fictional works. I GOLDSTEIN, *supra* note 12, § 2.3.2.2.

particular type of story.³⁰⁵ Thus, a typical prison movie might involve a wronged convict (the hero), the hero's sidekick, a corrupt warden, a brutal guard, dingy jail cells and bleak common areas, a confrontation between the hero and the warden, and a daring escape, among other elements.³⁰⁶ Courts generally hold that scènes à faire are either not copyrightable, or if they are, it is difficult for the original author to prove infringement.³⁰⁷ Once again, the concern is over potentially awarding the original author monopoly privileges with respect to basic devices in a particular literary genre.³⁰⁸ In addition, if a subsequent prison movie has a corrupt warden, it is almost impossible to determine whether the later author borrowed that character from the public domain or from the prior author.³⁰⁹

When a director directs a play set in a specific time and place, inevitably some of the director's artistic choices are dictated by the setting, mood, characters, and plot created by the playwright.³¹⁰ Tennessee Williams's *A Streetcar Named Desire* is set in a cramped apartment in the tawdry French Quarter of New Orleans in the 1940s and contains recognizably Southern characters.³¹¹ Much of the stage business is dictated by the script—for example, the lead female character, Blanche DuBois, tries to escape from the harsh realities of life by drinking excessively³¹² and covering the bare white light in her sister's apartment with a paper lamp shade.³¹³ To be in the position to yell his famous primal "Stella, Stella," the brutish male lead character, Stanley Kowalski, has to leave his apartment, go outside, and shout up to the window of a neighboring apartment to which his wife has retreated.³¹⁴ Stanley has

³⁰⁵ *Thompson*, 204 F. App'x at 850; *Funky Films*, 462 F.3d at 1077; *Stromback v. New Line Cinema*, 384 F.3d 283, 296 (6th Cir. 2004); *Murray Hill Publ'ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 319 (6th Cir. 2004); *Gaiman v. McFarlane*, 360 F.3d 644, 659 (7th Cir. 2004); *Metcalf v. Bochco*, 294 F.3d 1069, 1074 (9th Cir. 2002); *Williams v. Crichton*, 84 F.3d 581, 588 (2d Cir. 1996); *See v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980).

³⁰⁶ *See Murray Hill Publ'ns*, 361 F.3d at 319–20.

³⁰⁷ *See Zambito v. Paramount Pictures Corp.*, 613 F. Supp. 1107, 1112 (E.D.N.Y. 1985), *aff'd*, 788 F.2d 2 (2d Cir. 1985).

³⁰⁸ *See Murray Hill Publ'ns*, 361 F.3d at 319–20.

³⁰⁹ *See id.*

³¹⁰ *See, e.g., Williams*, *supra* note 7, at 13 (describing the play's New Orleans setting).

³¹¹ *See id.* at 13, 17.

³¹² *Id.* at 22 ("I am going to take just one little tiny nip more, sort of to put the stopper on, so to speak . . .").

³¹³ *Id.* at 55 ("I can't stand a naked light bulb, any more than I can a rude remark or a vulgar action.").

³¹⁴ *Id.* at 59 (noting that "Stanley stumbles half-dressed out to the porch and down the wooden steps to the pavement before the building").

another scene in which he opens Blanche's trunk and tosses her fancy clothes around the room.³¹⁵ At one point, he pulls off his sweaty shirt to make himself more comfortable in the hot apartment.³¹⁶

To be faithful to the playwright's vision, any stage director of *Streetcar* must find ways to incorporate these specific aspects of the various scenes.³¹⁷ As a result, many productions of *Streetcar* appear somewhat similar.³¹⁸ The poker game in the third scene, for example, always involves several rough-hewn characters sitting around a table, smoking, drinking, and playing cards.³¹⁹ One could argue the idea of a late-night poker game among blue-collar chums merges with the expression of it.³²⁰ One could also observe that a poker game is often portrayed on stage in a standard or stock manner, thus coming under the rubric of *scènes à faire*.³²¹ As a result, it may be difficult to conclude in many cases that the later director impermissibly appropriated the earlier director's protectable expression.³²²

Notwithstanding the impact of the merger doctrine and *scènes à faire* on many stage directions cases, there are instances in which it is clear that a subsequent director borrowed the first director's original, creative work.³²³ In *Mantello v. Hall*, for example, the plaintiff Joe

³¹⁵ See WILLIAMS, *supra* note 7, at 35–36 (containing specific stage directions for Stanley to “pull[] open the wardrobe trunk standing in the middle of the room and jerk[] out an armful of dresses”).

³¹⁶ *Id.* at 30 (indicating that Stanley “starts to remove his shirt”).

³¹⁷ For one director's thoughts on the essential motifs of *Streetcar*, see Elia Kazan, *Notebook for A Streetcar Named Desire*, in DIRECTORS ON DIRECTING, *supra* note 76, at 364–79.

³¹⁸ See *id.* (discussing Mr. Kazan's ideas regarding the essential elements of the play).

³¹⁹ WILLIAMS, *supra* note 7, at 45–59.

³²⁰ See *Hart*, 86 F.3d at 322; *Rosenthal Jewelry*, 446 F.2d at 741–42.

³²¹ See *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir. 1986) (“Elements such as drunks, prostitutes, vermin and derelict cars would appear in any realistic work about . . . policemen in the South Bronx.”). For an early discussion of the concept of *scènes à faire* without use of that term, see *Maxwell v. Goodwin*, 93 F. 665, 667 (C.C.N.D. Ill. 1899) (finding no infringement where the similarities between the two plays stemmed only from “resemblances which may naturally occur when congressional life in Washington is the theme”).

³²² See *Sportsmans Warehouse*, 576 F. Supp. 2d at 1196–97. To overcome the *scènes à faire* problem, plaintiff directors might argue that although their staging contains some stock elements, they have created an original selection, coordination, and arrangement of those elements and thus have generated a “compilation” protected by the Copyright Act. See 17 U.S.C. § 101 (defining compilation as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship”); *id.* § 103 (including compilations as part of the “subject matter of copyright”); see also *Feist*, 499 U.S. at 357–59 (holding that compilations of facts selected, coordinated, or arranged in an original way qualify for copyright protection).

³²³ See, e.g., *Mantello*, 947 F. Supp. at 95.

Mantello took the playwright's opening scene description, "a bare stage," and created a distinctive tableau of actors arranged around a doll house situated on a green mound.³²⁴ In his copyright infringement suit, he alleged that a later Florida director had appropriated the vignette along with most other aspects of Mantello's staging.³²⁵ Similarly, in the recent *Urinetown* litigation, the Broadway artists asserted that directors in the Chicago and Akron productions had copied numerous bits of stage business, character depictions, and set designs, none of which were dictated by the *Urinetown* script itself.³²⁶ Hence, it may be possible for the plaintiff director to surmount the merger and scènes à faire hurdles where (1) the underlying script has few of its own stage directions and character and scene descriptions³²⁷ and (2) the nature of the underlying dramatic work does not virtually demand certain artistic choices.³²⁸ For example, under the second criterion, a play about young people trying to "find themselves" in a big city would allow for many different expressions as opposed to a play that depicts injured soldiers recovering in a hospital ward during World War II, where some of the directorial choices might be more limited.³²⁹

Although there is scant precedent supporting claims for copyright infringement of stage directions, a properly crafted case involving the right set of facts should lead to a finding of liability.³³⁰ If a directors can show that the protectable elements of their stage directions have been impermissibly appropriated by subsequent directors, as plaintiffs they will be able to fend off a finding of fair use in most cases because a non-transformative, bodily appropriation of copyrighted expression rarely constitutes a fair use.³³¹ Similarly, plaintiffs should be able to surmount the barriers posed by the merger doctrine and scènes à faire if their directions are truly original and not heavily dictated by the play itself.³³²

³²⁴ Interview with Barbara B. Hauptman, *supra* note 34 (discussing the *Mantello* case).

³²⁵ See *Mantello*, 947 F. Supp. at 96.

³²⁶ *Mullen Answer*, *supra* note 19, at 19–23; *Carousel Dinner Theatre Answer*, *supra* note 19, at 15–18.

³²⁷ One Broadway director suggested that, in general, playwriting has changed in the last few years to become "more of a conceptual art" with fewer specific stage directions. See Telephone Interview with Joe Mantello, *supra* note 52.

³²⁸ See *Sportsmans Warehouse*, 576 F. Supp. 2d at 1196–97.

³²⁹ See *id.*; see also *supra* notes 310–322 and accompanying text (discussing similar issues related to a production of *A Streetcar Named Desire*).

³³⁰ Cf. *Campbell*, 510 U.S. at 574–75 (discussing the alleged infringement of a musical composition).

³³¹ See *id.* at 587–88.

³³² See *Sportsmans Warehouse*, 576 F. Supp. 2d at 1196–97.

V. OTHER THEORIES OF LEGAL PROTECTION FOR STAGE DIRECTIONS

Because copyright protection for stage directions is a relatively new and untested idea, directors may be inclined to seek alternative legal theories to secure rights in their works. Claims for breach of contract, unfair competition, unjust enrichment, and misappropriation, appear, at least superficially, to provide viable avenues for relief where a director's stage directions have been borrowed without permission in a second production. These theories, however, present serious difficulties for the potential stage director plaintiff and may ultimately prove unfruitful in most cases.

A. Breach of Contract

Unionized stage directors' contracts with producers usually provide that all stage directions are owned and may be copyrighted by the director.³³³ In addition, they provide that the director is entitled to royalties from the subsequent use of the stage directions in another production of the play by the same producer.³³⁴ If a Broadway producer signed such a contract and then used the director's directions in a touring company production spun off of the Broadway production without remitting the appropriate royalties, the director can assert a breach of contract claim against the producer.³³⁵

In addition, if the producer decides to stage a revival of the same play later but has a different director incorporate the stage directions used in the first production, the original director would likely have a contract claim against the producer.³³⁶ Damages could include the licensing fee that should have been paid to the director for appropriating the directions and also arguably the same percentage of royalties specified in the original Broadway contract.³³⁷

³³³ See, e.g., Off-Broadway-SSDC Collective Bargaining Agreement, *supra* note 171, § XIV (Property Rights), at 17–18.

³³⁴ *Id.* § XIII (Participation in Subsidiary Income of the Producer), at 16–17.

³³⁵ *Id.* § XVI (Additional Companies, Transfers, and Tours), at 19–25. Generally, breach of contract claims are not preempted by Section 301 of the Copyright Act. See *Bowers v. Baystate Techs., Inc.*, 320 F.3d 1317, 1324 (Fed. Cir. 2003); *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447, 1454–55 (7th Cir. 1996); *Nat'l Car Rental Sys., Inc. v. Computer Assocs. Int'l*, 991 F.2d 426, 431–32 (8th Cir. 1993); see also *infra* notes 400–409 and accompanying text (discussing preemption).

³³⁶ See Off-Broadway-SSDC Collective Bargaining Agreement, *supra* note 171, § XIV (Property Rights), at 17–18 (noting that the original director retains ownership of the original stage directions).

³³⁷ See *id.* § VII (Royalties), at 9–11; *id.* § XIV (Property Rights), at 17–18.

Although union stage directors have protected themselves fairly well through their contracts with the original producer, a contract theory is of little help when the later director is unrelated to the original Broadway producer.³³⁸ If a director in Missouri, for example, decides to copy the original Broadway director's staging of the same play gesture for gesture, there is clearly no contractual relationship between the first and second director.³³⁹ The best line of attack for the Broadway director would be to argue that, if both directors are members of the Society of Stage Directors and Choreographers ("SSDC"), they are bound by the union's rules and regulations, including one which prohibits a member "plagiariz[ing] another member's work."³⁴⁰ In other words, although they do not have a contract with each other, they do have a contract with the union, which a director can breach by failing to adhere to union rules.³⁴¹ If the original director can demonstrate improper copying by the second director, presumably the latter would be subject to union discipline, such as a fine or suspension.³⁴²

B. *Unfair Competition*

Unfair competition is an amalgam of state and federal statutory and common law regulating inequitable business practices including false designation of origin (passing off and reverse passing off), misrepresentations about products or services, commercial disparagement, and other similar acts.³⁴³ Owners of intellectual property have attempted to use some or all of these theories to prevent others from borrowing their work without permission.³⁴⁴

For a number of years, plaintiffs seeking redress for alleged plagiarism have pursued claims under Section 43(a) of the Lanham Act.³⁴⁵

³³⁸ See *id.* § V (General Provisions), at 3–4 (noting that the contract is between the "Producer" and the "Director").

³³⁹ See *id.*

³⁴⁰ E-mail from Gretchen M. Michelfeld, Membership Coordinator, Soc'y for Stage Dirs. & Choreographers, to Margit Livingston, Professor of Law, DePaul Univ. Coll. of Law (Mar. 18, 2008) (on file with author) (containing the union's membership rules, including Rule 3, quoted here).

³⁴¹ See *id.*

³⁴² See *id.*

³⁴³ See BEVERLY W. PATTISHALL ET AL., TRADEMARKS AND UNFAIR COMPETITION 1–6 (6th ed. 2005).

³⁴⁴ See *id.* at 1–12.

³⁴⁵ See *Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775, 780–81 (2d Cir. 1994); *Lamothe v. Atl. Recording Corp.*, 847 F.2d 1403, 1406 (9th Cir. 1988); *Dahlen v. Mich. Licensed Beverage Ass'n*, 132 F. Supp. 2d 574, 589–90 (E.D. Mich. 2001). The U.S. Court of Appeals for the Second Circuit held that a claim of "reverse passing off" under § 43(a)

Section 43(a) creates a civil action for persons injured or likely to be injured by an individual's use in commerce of any "false designation of origin" or misleading descriptions or representations of fact regarding goods or services.³⁴⁶ These false or misleading statements must either (1) be likely to cause confusion as to the origins or sponsorship of the goods or services or (2) misrepresent the qualities or characteristics of the defendant's or the plaintiff's products in commercial advertising.³⁴⁷ Under Section 43(a), stage directors whose directions have been purloined by a subsequent production could argue that the later production is making a false or misleading statement about the origin of the stage directions by not attributing them to the original director.³⁴⁸

Despite precedent supporting the use of the Lanham Act to protect misattribution of copyrightable materials,³⁴⁹ in 2003, in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, the U.S. Supreme Court seemingly put to rest any notion that Section 43(a) could be used in cases where the underlying product was intellectual goods subject to the Copyright Act.³⁵⁰ In *Dastar*, the defendant Dastar had produced a series of videos that were copied from an earlier television series that Twentieth Century Fox had created about General Eisenhower's World War II European campaigns.³⁵¹ The Fox series, originally released in 1949, fell into the public domain after Fox did not renew its copyright in 1977.³⁵² Because of the expired copyright, Fox did not have an infringement claim under the Copyright Act.³⁵³ Instead, it

of the Lanham Act involves four elements: (1) the defendant must have "affixed a false designation of origin" to its product, (2) the defendant must have "used the false designation in commerce," (3) consumer confusion is likely to result from the false designation of origin, and (4) the plaintiff has been or is likely to be damaged by the false designation. See *Waldman Publ'g*, 43 F.3d at 780. In determining whether the defendant made a false designation of origin with respect to a written work, the Second and Ninth Circuits disagree as to the degree of similarity that must exist between the plaintiff's and the defendant's works: the Second Circuit adopted the "substantial similarity" standard used in copyright infringement actions, *id.* at 783, whereas the Ninth Circuit required that the defendant's work constitute a "bodily appropriation" of the plaintiff's work, *Cleary v. News Corp.*, 30 F.3d 1255, 1261 (9th Cir. 1994).

³⁴⁶ See 15 U.S.C. § 1125(a) (2006).

³⁴⁷ *Id.*

³⁴⁸ See *id.*

³⁴⁹ See, e.g., *Dahlen*, 132 F. Supp. 2d at 588–89 (discussing the Lanham Act's applicability to a copyrighted poster).

³⁵⁰ See 539 U.S. 23, 37 (2003).

³⁵¹ See *id.* at 26–27.

³⁵² *Id.* at 26.

³⁵³ See 17 U.S.C. § 106 (2006) (noting that only owners of copyrights possess the exclusive statutory rights granted by the Copyright Act). There was a separate issue regarding Dastar's possible infringement of the copyright in General Eisenhower's memoirs upon

sued Dastar under Section 43(a) of the Lanham Act, arguing that Dastar's failure to place Fox's name on the videos constituted a "false designation of origin."³⁵⁴ The U.S. District Court for the Central District of California accepted this theory and awarded Fox twice the amount of Dastar's profits.³⁵⁵ The Court of Appeals for the Ninth Circuit affirmed,³⁵⁶ but the Supreme Court, in a unanimous eight-justice opinion, held that "origin" under the Lanham Act meant the manufacturer of the physical product offered for sale to the public, not the creator of intellectual property embodied in that physical product.³⁵⁷

In rejecting the Lanham Act claim, the Court expressed concern that false designation of origin claims for intellectual goods could create "a species of perpetual patent and copyright, which Congress may not do."³⁵⁸ Drawing on several prior Supreme Court decisions, the Court said that it had consistently ruled that once the statutory monopoly afforded by patents and copyrights expires, the work passes into the public domain and is free to be used by all, with or without attribution.³⁵⁹ The Court also noted practical reasons to disallow false origin claims for works of authorship.³⁶⁰ First, there may be difficulty ascertaining the "origin" of a work when multiple talents have contributed to the finished product.³⁶¹ Second, an intellectual goods manufacturer might conceivably face "a damned if you do, damned if you don't" scenario: it could incur Lanham Act liability either by failing to give proper attribution, if that failure amounts to a false designation of origin,³⁶² or by giving proper attribution, if that attribution

which the original television series was based, but that issue was not in front of the Court when it decided the Lanham Act claim. *Dastar*, 539 U.S. at 28 n.2.

³⁵⁴ See *Dastar*, 539 U.S. at 31.

³⁵⁵ *Id.* at 28.

³⁵⁶ *Twentieth Century Fox Film Corp. v. Dastar Corp.*, 34 F. App'x 312, 316 (9th Cir. 2002), *rev'd*, 539 U.S. 23.

³⁵⁷ *Dastar*, 539 U.S. at 37-38.

³⁵⁸ *Id.* at 37 (citing *Eldred v. Ashcroft*, 537 U.S. 186, 208 (2003)).

³⁵⁹ *Id.* at 33-34. In support of its holding, the Court cited its previous decisions implicitly denying Lanham Act relief to plaintiffs whose intellectual property interests were not protected by traditional trademark, copyright, or patent law. See *id.* at 36-37 (citing *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) ("In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying."); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 214 (2000) (holding that plaintiff's product-design trade dress must have acquired secondary meaning to be protected under the Lanham Act)).

³⁶⁰ See *id.* at 35-36.

³⁶¹ See *id.* ("We do not think the Lanham Act requires this search for the source of the Nile and all its tributaries.")

³⁶² See *Dastar*, 539 U.S. at 36.

implies the original creator's "sponsorship or approval" of that particular version of the work.³⁶³

Since the *Dastar* decision in 2003, federal courts have fallen into line behind the notion that the Lanham Act cannot be used in plagiarism cases.³⁶⁴ For example, in 2003, in *Williams v. UMG Recordings, Inc.*, the U.S. District Court for the Central District of California stated that the Supreme Court had effectively overruled the Ninth Circuit precedent allowing Lanham Act claims for "reverse passing off" based on "the failure to credit the author of any idea, concept or communication embodied in the tangible goods."³⁶⁵ The court denied Lanham Act relief to a screenwriter-director who alleged that the defendant film producers had improperly omitted his name from the film credits.³⁶⁶ In addition, the court said that *Dastar* precluded Lanham Act claims in this context, whether or not the intellectual product involved was copyrighted.³⁶⁷ In the same vein, other federal courts have dismissed false origin claims brought by authors or licensees of design proposals,³⁶⁸ software,³⁶⁹ screenplays,³⁷⁰ radio programs,³⁷¹ and songs.³⁷²

The Supreme Court's resounding rejection of false origin claims for intellectual goods has made it unlikely that stage directors could successfully assert claims for false designation of origin under Section

³⁶³ *Id.* Section 43(a) prohibits false representations that are likely to confuse consumers as to "the origin, sponsorship, or approval of his or her goods . . . by another person." 15 U.S.C. § 1125(a)(1)(A).

³⁶⁴ See, e.g., *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1183–84 (C.D. Cal. 2003) (discussing *Dastar's* impact on a motion picture Lanham Act cause of action). For additional discussion of *Dastar's* impact on intellectual property law, see generally Laura A. Heymann, *The Trademark/Copyright Divide*, 60 SMU L. Rev. 55 (2007); Mary LaFrance, *When You Wish upon Dastar: Creative Provenance and the Lanham Act*, 23 CARDOZO ARTS & ENT. L.J. 197 (2005); Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. REV. 1171 (2005); Rick Mortensen, *D.I.Y. After Dastar: Protecting Creators' Moral Rights Through Creative Lawyering, Individual Contracts and Collective Bargaining Agreements*, 8 VAND. J. ENT. & TECH. L. 335 (2006).

³⁶⁵ See *Williams*, 281 F. Supp. 2d at 1184 n.10.

³⁶⁶ See *id.* at 1179, 1185.

³⁶⁷ See *id.* at 1185.

³⁶⁸ See *Larkin Group, Inc. v. Aquatic Design Consultants, Inc.*, 323 F. Supp. 2d 1121, 1126–27 (D. Kan. 2004).

³⁶⁹ *Gen. Universal Sys., Inc. v. Boaz Exp. Crating Co.*, 379 F.3d 131, 149 (5th Cir. 2004); *Bob Creeden & Assoc., Ltd. v. Infosoft, Inc.*, 326 F. Supp. 2d 876, 879–80 (N.D. Ill. 2004).

³⁷⁰ *A Slice of Pie Prods., LLC v. Wayans Bros. Entm't*, 392 F. Supp. 2d 297, 313–14 (D. Conn. 2005); *Smith v. New Line Cinema*, No. 03 Civ. 5274 (DC), 2004 U.S. Dist. LEXIS 18382, at *10–11 (S.D.N.Y. Sept. 8, 2004).

³⁷¹ *Sivak v. Versen*, No. 06cv0416-LAB (WMC), 2007 U.S. Dist. LEXIS 22430, at *22–23 (S.D. Cal. Mar. 27, 2007).

³⁷² *Hustlers, Inc. v. Thomasson*, 73 U.S.P.Q.2d (BNA) 1923, 1925 (N.D. Ga. 2004).

43(a) of the Lanham Act in the event that subsequent producers or directors misappropriate their work.³⁷³ Similarly, state law unfair competition claims are likely to be dismissed under federal preemption doctrine.³⁷⁴ The Court in *Dastar*, however, did leave open at least one possible claim under Section 43(a) of the Lanham Act when intellectual goods are involved.³⁷⁵ Conceivably, stage directors might use this remaining Lanham Act claim in appropriate circumstances.³⁷⁶

In addition to proscribing false designations of origin, Section 43(a) also prohibits false advertising, and in particular, misrepresentations "in commercial advertising or promotion" of the "nature, characteristics, qualities, or geographic origin of his or her or another's person's goods, services, or commercial activities."³⁷⁷ In *Dastar*, Justice Scalia, writing for the Court, stated that this kind of false advertising claim would still be permissible under the Lanham Act.³⁷⁸ He suggested that if the defendant *Dastar* had advertised or promoted its video so as to "give purchasers the impression that the video was quite different from [the plaintiffs'] series," when in fact the defendant's video was largely a wholesale copy of the plaintiffs' work, then the plaintiffs would have an action under Section 43(a)(1)(B) of the Lanham Act.³⁷⁹

With stage directions, one can imagine a situation where a theatre company appropriated the staging of a Broadway show and then adver-

³⁷³ See *Dastar*, 539 U.S. at 37. Interestingly, although his complaint was filed post-*Dastar*, the Broadway director in the *Urinetown* cases asserted false designation of origin claims under § 43(a) in his counterclaim against subsequent directors of *Urinetown* productions in Akron and Chicago. See *Mullen Answer*, *supra* note 19, at 27–29; *Carousel Dinner Theatre Answer*, *supra* note 19, at 22.

³⁷⁴ See *Kodadek v. MTV Networks, Inc.*, 152 F.3d 1209, 1212–13 (9th Cir. 1998); *Lacour v. Time Warner, Inc.*, No. 99 C 7105, 2000 U.S. Dist. LEXIS 7286, at *26 (N.D. Ill. May 22, 2000); *Kregos v. The Associated Press*, 795 F. Supp. 1325, 1336–37 (S.D.N.Y. 1992), *aff'd*, 3 F.3d 656 (2d Cir. 1993). For a fuller discussion of federal preemption of state law claims involving underlying copyright issues, see *infra* notes 400–409 and accompanying text.

³⁷⁵ See 539 U.S. at 38 (noting that plaintiffs may have a misrepresentation claim under the Lanham Act).

³⁷⁶ See *id.*

³⁷⁷ 15 U.S.C. § 1125 (a)(1)(B).

³⁷⁸ See 539 U.S. at 38.

³⁷⁹ See *id.*; see also *Antidote Int'l Films, Inc. v. Bloomsbury Publ'g, PLC*, 467 F. Supp. 2d 394, 399–400 (S.D.N.Y. 2006) (stating that *Dastar* may have left open the possibility of Lanham Act claims for "a misrepresentation going to the substance of a work"). A few courts have even read *Dastar* as permitting false authorship claims to be asserted under the false advertising provision of § 43(a). See *Zyla v. Wadsworth, Div. of Thomson Corp.*, 360 F.3d 243, 252 n.8 (1st Cir. 2004); *Clauson v. Eslinger*, 455 F. Supp. 2d 256, 261 (S.D.N.Y. 2006).

tised its production in a misleading way.³⁸⁰ For example, the theatre company might state that its staging was “completely new and original” or that its production “was nothing like anything that’s been done before.”³⁸¹ Such advertising could be construed as a misrepresentation of the qualities and characteristics of the company’s “product”—i.e., its theatrical production.³⁸² Thus, the Broadway director might have a cause of action under Section 43(a) if the company’s director had simply copied the Broadway production’s stage directions.³⁸³ The difficulty in this hypothetical is that later producers of hit Broadway shows usually want their audiences to get the impression that what they are seeing is in fact a fairly faithful replica of the original Broadway production.³⁸⁴ As a result, they are unlikely to suggest in advertising that they have some novel spin on a tried-and-true blockbuster like *Cats* or *Wicked*.³⁸⁵

C. Unjust Enrichment and Misappropriation

Stage directors who believe that a later producer or director has borrowed their directions without permission and without attribution could conceivably bring unjust enrichment or misappropriation claims against the illicit borrowers.³⁸⁶ In this context, both unjust enrichment and misappropriation claims have a common legal core: the notion that the defendant has deprived the plaintiff of something that rightfully belongs to the plaintiff.³⁸⁷ Misappropriation³⁸⁸ is a tort claim leading to the recovery of damages³⁸⁹ whereas unjust enrichment, although

³⁸⁰ See *Dastar*, 539 U.S. at 38.

³⁸¹ See *id.*

³⁸² See *id.*

³⁸³ See *id.*

³⁸⁴ See *id.*

³⁸⁵ See *Dastar*, 539 U.S. at 38.

³⁸⁶ See *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1198 (S.D.N.Y. 1983) (discussing unjust enrichment); PATTISHALL, *supra* note 343, at 490.

³⁸⁷ See *Bi-Rite*, 555 F. Supp. at 1198; PATTISHALL, *supra* note 343, at 490.

³⁸⁸ Misappropriation is often considered a species of unfair competition, but, for the purposes of this Article, it will be discussed and compared with unjust enrichment. See *Bd. of Trade v. Dow Jones & Co.*, 456 N.E.2d 84, 90 (Ill. 1983) (holding that direct competition between plaintiff and defendant is not necessary for liability in misappropriation). See generally Edmund J. Sease, *Misappropriation Is Seventy-Five Years Old; Should We Bury It or Revive It?*, 70 N.D. L. Rev. 781 (1994).

³⁸⁹ See *Victor G. Reiling Assocs. v. Fisher-Price, Inc.*, No. 3:03cv222 (JBA), 2006 U.S. Dist. LEXIS 22813, at *5–6 (D. Conn. Apr. 25, 2006) (discussing measurement of compensatory damages in misappropriation cases).

here it has tort-like underpinnings, is a restitution claim leading to the disgorgement of the defendant's ill-gotten gains.³⁹⁰

Wronged stage directors would argue that the subsequent production misappropriated their specific directions, the idea or concept for their staging, or both.³⁹¹ Damages would be calculated according to a reasonable licensing fee that the defendant would have paid for use of the directions.³⁹² An unjust enrichment claim would be predicated on the idea that the defendant wrongfully benefited from the unlicensed appropriation of the plaintiff's work.³⁹³ The defendant would be required to disgorge her unjust gain by paying the plaintiff the portion of profits attributable to the wrongful use of the plaintiff's stage directions.³⁹⁴ If profits proved too difficult to calculate, the court might award a reasonable licensing fee as the measure of the benefit or "savings" that the defendant realized through the wrongful act.³⁹⁵

Misappropriation and unjust enrichment claims hold a certain appeal where arguably the plagiarized material is not subject to copyright protection.³⁹⁶ For example, ideas are not copyrightable, and hence directors who believe that their ideas were stolen would not have a copyright claim.³⁹⁷ Similarly, it is by no means certain that courts will accept the notion that stage directions themselves are copyrightable.³⁹⁸ In these contexts, stage directors might look to misappropriation or unjust enrichment theories as legal mechanisms for protecting their work.³⁹⁹

³⁹⁰ See *Roman Mosaic & Tile Co. v. Vollrath*, 313 A.2d 305, 307 (Pa. Super. Ct. 1973) (stating that the plaintiff asserting an unjust enrichment claim "must show that [the party against whom recovery is sought either] wrongfully secured or passively received a benefit that it would be unconscionable for [the party to retain] without compensating" the provider).

³⁹¹ See *Bd. of Trade*, 456 N.E.2d at 88–89 (discussing the tort of misappropriation).

³⁹² See *Reiling*, 2006 U.S. Dist. LEXIS 22813, at *4–6. In addition, if the defendant's conduct were found to be particularly egregious, the plaintiff might be entitled to an award of punitive damages as well. *JustMed, Inc. v. Byce*, 84 U.S.P.Q.2d (BNA) 1174, 1185–86 (D. Idaho 2007).

³⁹³ *Chalfant v. Tubb*, 453 F. Supp. 2d 1308, 1321 (N.D. Okla. 2006); *Moses v. MacFarlan*, 2 Burr. 1005, 97 Eng. Rep. 676, 680–81 (K.B. 1760).

³⁹⁴ See 1 DAN B. DOBBS, *LAW OF REMEDIES* 566–67 (2d ed. 1993) (discussing various methods for measuring a defendant's gain in a restitution action).

³⁹⁵ *Id.*

³⁹⁶ See, e.g., *Reiling*, 2006 U.S. Dist. LEXIS 22813, at *1–2 (involving a fight over an uncopyrightable "concept").

³⁹⁷ See 17 U.S.C. § 102(b) (noting that ideas cannot receive copyright protection).

³⁹⁸ See *id.*; see also *supra* notes 71–154 and accompanying text (discussing copyright's subject matter requirement).

³⁹⁹ See, e.g., *Reiling*, 2006 U.S. Dist. LEXIS 22813, at *1–2.

The problem with these claims, however, is that most are likely preempted by federal law. The Copyright Act preempts a state law cause of action if two elements are met.⁴⁰⁰ First, the rights that a plaintiff asserts under state law must be “rights that are equivalent” to those protected by the Copyright Act.⁴⁰¹ Second, the work involved must fall within the Copyright Act’s “subject matter” as set forth in Sections 102 and 103.⁴⁰² The “equivalent rights” element is satisfied if the state law cause of action provides for the same rights afforded by copyright—namely, the exclusive rights, under Section 106 of the Copyright Act, of reproduction, adaptation, distribution, public performance, and public display.⁴⁰³ An action for misappropriation or unjust enrichment in the context of unlicensed copying of stage directions could easily be said to duplicate the rights given by the Copyright Act.⁴⁰⁴ In a misappropriation claim, the plaintiff would argue that the defendant had used the plaintiff’s stage directions without permission and thereby interfered with the plaintiff’s exclusive right to reproduce and publicly perform the stage directions.⁴⁰⁵ In an unjust enrichment claim, the plaintiff would assert that the defendant’s unlicensed use of the plaintiff’s stage directions caused the defendant to enjoy a wrongful gain—wrongful because it violated the plaintiff’s exclusive reproduction and performance rights.⁴⁰⁶

In examining the “equivalent rights” aspect of preemption, courts have used the “extra element” test to ascertain whether the state law claim basically duplicates a copyright infringement action.⁴⁰⁷ Under this test, the court seeks to determine whether the state law cause of action requires proof of an element qualitatively different from the

⁴⁰⁰ See 17 U.S.C. § 301(a).

⁴⁰¹ See *id.*

⁴⁰² *Id.* Section 102 affords copyright protection to “original works of authorship fixed in any tangible medium of expression” and list several specific types of works covered, including literary works, musical works, and dramatic works. *Id.* § 102(a). Section 103 brings compilations and derivative works within the scope of the Copyright Act with the caveat that 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.” *Id.* § 103.

⁴⁰³ See, e.g., *Ehat v. Tanner*, 780 F.2d 876, 878 (10th Cir. 1985).

⁴⁰⁴ See 17 U.S.C. § 301(a).

⁴⁰⁵ See, e.g., *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1143–44 (9th Cir. 2006).

⁴⁰⁶ See, e.g., *Cooper v. Sony Music Entm’t, Inc.*, No. 01-0941, 2002 U.S. Dist. LEXIS 3832, at *9–11 (S.D. Tex. 2002).

⁴⁰⁷ See *id.* at *7–8.

proof required for an infringement action.⁴⁰⁸ The typical misappropriation claim does not have the required additional element.⁴⁰⁹

If a defendant wrongfully copied the plaintiff's stage directions, the standard unjust enrichment claim would likely produce the same outcome as the misappropriation claim.⁴¹⁰ If the plaintiff and the defendant, however, were found to have a fiduciary relationship, breach of that relationship might supply the "extra element" needed to avoid preemption of an unjust enrichment claim.⁴¹¹ Normally, the defendant director does not have any express trust or even contractual relationship with the original Broadway director.⁴¹² But, as suggested previously, often both the plaintiff and defendant directors are members of the professional directors' union, the SSDC.⁴¹³ Union rules prohibit one director from plagiarizing another director's work.⁴¹⁴ By joining the union, the defendant director agrees to abide by union regulations, including the prohibition against plagiarism.⁴¹⁵ That promise might be construed to create a fiduciary duty on the part of the defendant director to respect the rights of fellow directors and to refrain from plagiarizing their work.⁴¹⁶ It is highly debatable, however, whether a court would accept the notion of a fiduciary relationship among union members and would apply it in this context.⁴¹⁷

Thus, most noncopyright theories for protecting stage directions hold little promise for possible plaintiffs. The contract theory leads to

⁴⁰⁸ See *Daboub v. Gibbons*, 42 F.3d 285, 288-90 (5th Cir. 1995); *Trandes Corp. v. Guy F. Atkinson Co.*, 996 F.2d 655, 659-60 (4th Cir. 1993); *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 716-17 (2d Cir. 1992); *Madison River Mgmt. Co. v. Bus. Mgmt.*, 351 F. Supp. 2d 436, 442-43 (M.D.N.C. 2005).

⁴⁰⁹ See *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 849 (2d Cir. 1997) (holding that even when a defendant had misappropriated uncopyrightable elements of the plaintiff's broadcasts, the state law misappropriation claim was still preempted).

⁴¹⁰ See *Briarpatch Ltd. v. Phoenix Pictures, Inc.*, 373 F.3d 296, 304-06 (2d Cir. 2004) (holding that an unjust enrichment claim was not "qualitatively different from a copyright infringement claim" and was therefore preempted); *Sys. XIX, Inc. v. Parker*, 30 F. Supp. 2d 1225, 1230-31 (N.D. Cal. 1998); *Curtin v. Star Editorial, Inc.*, 2 F. Supp. 2d 670, 674-75 (E.D. Pa. 1998).

⁴¹¹ See *Dun & Bradstreet Software Servs. v. Grace Consulting, Inc.*, 307 F.3d 197, 217-18 (3d Cir. 2002).

⁴¹² See, e.g., *Off-Broadway-SSDC Collective Bargaining Agreement*, *supra* note 171, § V, at 3-4 (noting that the contract is between the producer and the director).

⁴¹³ See *supra* note 340 and accompanying text.

⁴¹⁴ See *supra* note 340 and accompanying text.

⁴¹⁵ See *supra* note 340 and accompanying text.

⁴¹⁶ See *Dun & Bradstreet*, 307 F.3d at 217-18.

⁴¹⁷ See *id.* Under federal law, union officers and agents, however, owe fiduciary duties to the union and its members. *United Transp. Union v. Bottalico*, 120 F. Supp. 2d 407, 408 (S.D.N.Y. 2000).

liability only where the original producer, in violation of a contract with the director, duplicated the director's staging without sharing royalties.⁴¹⁸ The Lanham Act is largely unavailable as a means of protecting intellectual goods unless false advertising is involved.⁴¹⁹ Additionally, state law unfair competition, misappropriation, and unjust enrichment claims are likely to be preempted in most cases.⁴²⁰ Consequently, copyright law remains the surest avenue for directors desiring to protect their work.

VI. INSPIRATION OR IMITATION: WHERE SHOULD WE DRAW THE LINE?

Even though conventional application of copyright doctrine supports recognition of protection for stage directors, such protection still raises a number of practical and policy concerns. In providing for copyright protection in the Constitution, the Founders intended to encourage the creation of artistic and other works that would redound to the public benefit.⁴²¹ By giving authors exclusive rights in their works for a fixed time, copyright protection would provide an economic incentive for them to create new books, poems, plays, musical compositions, and other works.⁴²² These new creative works would be available to the public (presumably for a fee) during the copyright term and would eventually pass into the public domain to be enjoyed by all and to provide the building blocks for later creative endeavors.⁴²³ Since its inception, copyright law always has trodden a fine line between private incentives and public welfare.⁴²⁴ As Congress has extended the copyright term and the Supreme Court has adopted a broad standard for "original works of authorship," the private incen-

⁴¹⁸ See *supra* notes 333–342 and accompanying text.

⁴¹⁹ See *supra* notes 343–385 and accompanying text.

⁴²⁰ See *supra* notes 386–409 and accompanying text.

⁴²¹ See U.S. CONST. art. I, § 8, cl. 8 ("Congress shall have Power . . . [t]o promote the Progress of Science . . . by securing [to Authors] for limited Times . . . the exclusive Right to their . . . Writings."); *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

⁴²² *Mazer*, 347 U.S. at 219 ("The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.'").

⁴²³ See 17 U.S.C. § 106 (2006) (listing a copyright holder's exclusive rights); *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4436) ("In truth, in literature, in science and in art, there are, and can be, few, if any, things, which, in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before.").

⁴²⁴ See *Eldred v. Ashcroft*, 537 U.S. 186, 214–15 (2003).

tive component of copyright law has increased whereas the public welfare component has arguably diminished.⁴²⁵

The issue of copyright protection for stage directions reflects this tension between private and public interests.⁴²⁶ Unquestionably, borrowing from prior work is a strong theatre tradition.⁴²⁷ Early creative endeavors should rightly serve as inspiration for later ones.⁴²⁸ Over time, Western theatre has developed a deep depository of conventions, ideas, practices, and even gimmicks that others freely borrow and adapt to new productions.⁴²⁹ The thought that any individual should "own" this body of work or any part of it is anathema to the theatre's communitarian ideals.⁴³⁰

On the other hand, the theatre world, like other aspects of American society, is not immune to proprietary impulses—i.e., "if I create it, I own it."⁴³¹ Stage directors have begun to view themselves as the only ones at the party not getting a piece of the cake.⁴³² Broadway producers use their strong economic position to protect themselves and to ensure that they and their investors enjoy a profit.⁴³³ Playwrights have a copyright in their scripts, and costume, scenic, and lighting designers presumably are entitled to copyright protection in their sketches (if not in the execution of those sketches) as pictorial or graphic works.⁴³⁴ Not

⁴²⁵ See *id.* at 218 (upholding a copyright extension act); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (noting that the Copyright Act's "originality" requirement is extremely broad).

⁴²⁶ See *Eldred*, 537 U.S. at 218; *Feist*, 499 U.S. at 345.

⁴²⁷ Shakespeare, for instance, relied heavily on earlier dramatic works in creating his magnificent plays, but of course, his consummate artistic talent elevated these older plays to works of genius. See, e.g., *Introduction to The Taming of the Shrew*, in *THE COMPLETE WORKS OF SHAKESPEARE* 325–26 (George Lyman Kittredge ed., 1936).

⁴²⁸ See *id.*

⁴²⁹ E.g., Interview with Cyndy A. Marion, *supra* note 93 (discussing her borrowing from earlier productions of *Tokyo Bar* when directing a new version of the play).

⁴³⁰ See *id.* (discussing a "public community of bits and pieces of things that everyone draws freely upon").

⁴³¹ E.g., Telephone Interview with Joe Mantello, *supra* note 52 ("I want someone to come up with their [sic] own production."). One prominent New York director described a later director's copying of Joe Mantello's stage directions for *Love! Valour! Compassion!* as simply "theft." Austin Pendleton, Visiting Artist, Remarks at DePaul University College of Law (Jan. 25, 2007) (on file with author).

⁴³² Interview with Michael Mayer, *supra* note 74 (discussing his fight to secure compensation for his work as a dramaturge).

⁴³³ See, e.g., Off-Broadway-SSDC Collective Bargaining Agreement, *supra* note 171, § VII (Royalties), at 9–11 (noting the producer's and director's share of production revenues).

⁴³⁴ 17 U.S.C. §§ 101, 102(a)(5). Pictorial, graphic, and sculptural works that are also utilitarian objects enjoy copyright protection only for the "pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.* § 101. Because costumes and sets arguably have

surprisingly, many stage directors view their creative contributions to a finished production as equal or superior to the contributions of these other participants.⁴³⁵ Stage directors control almost every aspect of the final product.⁴³⁶ They cast the actors, decide on a theme or style for the production (e.g., *Romeo and Juliet* in 1930s Chicago), originate the vision for the sets, lighting, sound, and costumes, make hiring and firing decisions, integrate music into the staging, create the stage pictures, and direct the actors in their movements.⁴³⁷ They make the playwright's written words move and assume three-dimensional form.⁴³⁸ Some believe that a great director can elevate and even "save" a mediocre play.⁴³⁹

The question is no longer whether directors are entitled to at least some copyright protection for their creative endeavors.⁴⁴⁰ Instead, the issue is the extent of that protection.⁴⁴¹ The director's "creation" is an amalgam of ideas, stage business, standard theatrical conventions, and innovative devices.⁴⁴² If a director decides to stage Shakespeare's *Hamlet* on an imagined Mars, that concept is presumably an unprotectable idea.⁴⁴³ Similarly, stage business dictated by the script (e.g., Polonius hiding behind a curtain)⁴⁴⁴ would be considered outside the scope of copyright protection as *scènes à faire*.⁴⁴⁵ Standard stage conventions,

a utilitarian purpose, it is unclear to what extent these items (apart from the design sketches for them) can be copyrighted. See U.S. Copyright Office, Policy Decision: Registrability of Costume Designs, 56 Fed. Reg. 56,530, 56,532 (1991) (finding that "fanciful" costumes, as opposed to "garment designs," are "useful articles," and therefore copyright-ineligible taken as a whole, but that elements of fanciful costumes may themselves be copyrighted, so long as those elements meet the requirements of physical or conceptual separability).

⁴³⁵ Interview with Michael Mayer, *supra* note 74 (discussing his experience in reworking and directing new plays).

⁴³⁶ *Id.*

⁴³⁷ *Id.* (discussing the variety of creative choices involved in staging a new play).

⁴³⁸ *Id.*

⁴³⁹ Interview with John Clinton Eisner, Producing Dir., Lark Theatre, in N.Y., N.Y. (June 25, 2007).

⁴⁴⁰ See *supra* notes 71–262 and accompanying text (describing stage directions as copyrightable subject matter and the elements of an infringement action).

⁴⁴¹ See *supra* notes 263–332 and accompanying text (discussing the common defenses to copyright infringement that could limit the protection afforded to stage directions).

⁴⁴² Interview with Michael Mayer, *supra* note 74 (discussing the variety of creative choices made in staging a new play).

⁴⁴³ See 17 U.S.C. § 102(b).

⁴⁴⁴ WILLIAM SHAKESPEARE, *HAMLET* act 3, sc. 4.

⁴⁴⁵ See, e.g., *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1077 (9th Cir. 2006).

such as the delivering of a soliloquy facing the audience, also would be unprotectable.⁴⁴⁶

After the unprotectable elements are set aside, what remains is the director's specific expression of the idea for a Martian *Hamlet*.⁴⁴⁷ This expression could consist, for example, of actors in green face paint, dressed in futuristic garb, talking in high, squeaky voices, and having antennae protruding from their heads.⁴⁴⁸ Very quickly, however, the director claiming protection in these elements could run afoul of the merger doctrine—the idea of *Hamlet* on a fictional Mars might dictate a certain skin color, voice quality, and manner of movement.⁴⁴⁹ On the other hand, a director staging a Martian *Hamlet* might easily refrain from such obvious choices borrowed from a stock fictional vision of Martians and instead have the actors wear very pale makeup to suggest the low level of sunlight, sport military-style uniforms to indicate a totalitarian government, speak slowly and heavily to portray a world-weary society, and so forth.⁴⁵⁰ To the extent that these choices are independently generated by the director, minimally creative, and not inevitably dictated by the fundamental conceit of *Hamlet* on Mars, they constitute protectable expression.⁴⁵¹

The schism between protectable and unprotectable expression, which affects every protected work from illustrations to songs to computer programs, may ultimately mean that a particular staging of a play may not contain enough original elements to qualify for copyright protection.⁴⁵² In fact, some directors have admitted that not all of their work has the distinctive, original qualities that they believe warrant protection.⁴⁵³ A staging of Henrik Ibsen's *Ghosts*, for example,

⁴⁴⁶ See *id.*

⁴⁴⁷ See *id.* (noting that in an infringement analysis, a court must set aside the unprotectable elements).

⁴⁴⁸ Interview with John Clinton Eisner, *supra* note 439 (discussing a hypothetical production of *Hamlet* on Mars).

⁴⁴⁹ See *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 322 (2d Cir. 1996) (discussing the merger doctrine). This point is more readily apparent in the context of a world that actually exists, e.g., *Hamlet* set in the antebellum South. See *id.* In such a world, one would expect Southern accents, a white upper class, black slaves, hoop skirts, magnolia trees, and mahogany furniture. See *id.*

⁴⁵⁰ See, e.g., *Funky Films*, 462 F.3d at 1081 (noting that original nongeneric creative works are protected by the Copyright Act).

⁴⁵¹ See *id.* at 1077, 1081.

⁴⁵² See *id.*

⁴⁵³ Interview with Barbara B. Hauptman, *supra* note 34 (observing that Gerald Gutierrez, who sought copyright registration for his staging of *The Most Happy Fella*, did not seek it for his staging of other works that he considered less original); Interview with Mi-

may be a faithful replica of a now unprotected early twentieth-century staging,⁴⁵⁴ to which the contemporary director had access through a preserved prompt book.⁴⁵⁵ In that case, it is hard to argue that the later director has contributed anything new or original.⁴⁵⁶ Even where the second production is not an exact duplicate of the earlier one, the second director's contributions may be so minimal (e.g., the players have coffee rather than tea in one scene) or unremarkable (e.g., amber lighting seen through a window is used to suggest the orphanage fire offstage)⁴⁵⁷ that they are not copyrightable.⁴⁵⁸

The issue of copyright protection for stage directions becomes even more complicated when one examines the creative journey involved in developing and staging a new play.⁴⁵⁹ Again, one might go through the finished staging and remove unprotectable elements, such as *scènes à faire* and broad ideas, so as to identify a protectable core of expression.⁴⁶⁰ The difficulty lies in ascertaining the ownership or source of that core.⁴⁶¹ In contemporary theatre, new plays go through a lengthy and often difficult development process during which any number of "hands" touch what becomes the final staged product.⁴⁶² As discussed earlier, directors, serving essentially as dramaturges, frequently work closely with playwrights to refine the script, suggest different dialogue and scene order, recommend cuts or expansions, and urge character modifications.⁴⁶³ Playwrights often accept these proffered changes and incorporate them into the completed text.⁴⁶⁴

chael Mayer, *supra* note 74 (stating that although much of his work is highly original and creative, a few projects have been more formulaic).

⁴⁵⁴ The earlier staging, if ever protected, would now be in the public domain, because, for example, a staging copyrighted in 1910 would have had an initial term of protection of twenty-eight years followed by a renewal term of forty-seven years, and thus, the work would have passed into the public domain by 1985. See Copyright Act of 1909, ch. 320, § 23, 35 Stat. 1075, 1080 (Mar. 4, 1909), *amended by* Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541.

⁴⁵⁵ See HENRIK IBSEN, *GHOSTS: A FAMILY DRAMA IN THREE ACTS* (Lanford Wilson trans., 2003).

⁴⁵⁶ See 17 U.S.C. § 102.

⁴⁵⁷ IBSEN, *supra* note 455, at 43.

⁴⁵⁸ See 17 U.S.C. § 102.

⁴⁵⁹ Interview with Cyndy A. Marion, *supra* note 93 ("Everyone in the theatre community contributes as a group.")

⁴⁶⁰ See, e.g., *Funky Films*, 462 F.3d at 1081.

⁴⁶¹ See 17 U.S.C. § 201(a) (stating that initial ownership of a copyright vests in the work's author).

⁴⁶² Interview with Cyndy A. Marion, *supra* note 93.

⁴⁶³ Interview with Michael Mayer, *supra* note 74 (discussing his collaboration with the playwright).

⁴⁶⁴ *Id.*

In addition, before a play arrives on Broadway or Off-Broadway, it may have had countless earlier productions in workshops or regional theatres.⁴⁶⁵ The directors of these earlier productions undoubtedly will have given input on dialogue, scene progression, and other staging details.⁴⁶⁶ Actors and designers participating in the prior stagings also may have offered their own suggestions.⁴⁶⁷ Often, the playwright will integrate these new perspectives into the play in an effort to make it more polished, more exciting, and more marketable.⁴⁶⁸

When the play finally reaches the upper tier of New York theatres, it will be almost impossible to separate the contributions of these many "collaborators" from the playwright's independently generated expression.⁴⁶⁹ Of course, these putative "collaborators" understand, in most cases, that any of their suggestions incorporated into the play belong to the playwright.⁴⁷⁰ Playwright ownership of the written text has been part of the theatre community's tradition and common understanding for decades, and playwrights often assure their ownership through their contracts with producers.⁴⁷¹

One can posit a situation in which a new play has gone through several "lesser" productions before arriving on Broadway.⁴⁷² The same director may have directed the earlier productions and may now be staging the Broadway version.⁴⁷³ The director may have offered changes to the text that the playwright incorporated along the way.⁴⁷⁴ In addition, various stage directions created by the director conceiva-

⁴⁶⁵ Interview with John Clinton Eisner, *supra* note 439.

⁴⁶⁶ *Id.*

⁴⁶⁷ *Id.*

⁴⁶⁸ *Id.*

⁴⁶⁹ *Id.*

⁴⁷⁰ *E.g.*, Interview with John Clinton Eisner, *supra* note 439 ("Any idea that is generated from a workshop belongs to the playwright—everybody understands that."); Interview with Cyndy A. Marion, *supra* note 93 (stating that she understands that her dramaturgical contributions belong to the playwright).

⁴⁷¹ See The Dramatists Guild, Inc., Approved Production Contract for Plays art. VIII, § 8.01(b) (1985), in FARBER, *supra* note 31, at 177, 202 ("No addition, omission, or alteration in the manuscript or title of the Play as contracted for production without the consent of the other.").

⁴⁷² Interview with John Clinton Eisner, *supra* note 439.

⁴⁷³ *Id.*

⁴⁷⁴ *Id.* John Weidman, President of the Dramatists Guild of America, has argued that recognition of copyright protection for stage directions "will drastically limit a playwright's ability to control the work which he creates, it will inevitably undermine the spirit of trust and openness which is essential to the collaborative process that makes theatre happen, and it will have a deeply disruptive potentially paralyzing effect on theatrical production generally." Weidman, *supra* note 32, at 646.

bly may be integrated into the script by the playwright.⁴⁷⁵ The playwright's contract with the producer will specify the playwright's ownership of the play's text.⁴⁷⁶ The director's contract with the producer will affirm the director's ownership of stage directions.⁴⁷⁷ Assuming that the director and the playwright do not directly contract with each other, there might be considerable ambiguity concerning the ownership of particular stage directions that the director generated in earlier productions and that the playwright subsequently added to the text.⁴⁷⁸

Furthermore, this hypothetical does not address situations where, during the development and "workshopping" process, several different directors are used.⁴⁷⁹ Director A may have used certain staging devices in the Off-Off Broadway production that Director B adopted in part for the Off-Broadway production.⁴⁸⁰ Finally, Director C may cobble together elements of the first two directors' directions along with new, original directions in the Broadway production.⁴⁸¹ If the three directors all have a required SSDC contract with the producer, they will be contractually entitled to property rights in their specific contributions.⁴⁸² This division of rights among the three hypothetical directors could easily lead to disputes over who contributed what to

⁴⁷⁵ Interview with John Clinton Eisner, *supra* note 439.

⁴⁷⁶ See The Dramatists Guild, Inc., *supra* note 471, art. I, § 1.06(b), at 202 (noting that the author retains sole and complete title in the play).

⁴⁷⁷ See, e.g., Off-Broadway-SSDC Collective Bargaining Agreement, *supra* note 171, § XIV (Property Rights), at 17–18.

⁴⁷⁸ Interview with John Clinton Eisner, *supra* note 439. The author recently had the opportunity to watch two different productions, one in Chicago and one in New York, of *The Sunset Limited*, a new play by the novelist Cormac McCarthy. The two actors and the director were the same in both productions, and the playwright sat in on rehearsals in Chicago. Interview with Austin Pendleton, Actor, in Chi., Ill. (Jan. 25, 2007). One of the two characters, White, keeps saying throughout the play, "I have to go." In the Chicago production, the actor playing White actually got up on those lines as if to leave. By the time the production got to New York, the actor usually remained seated during those lines, as if he were conflicted about leaving. The direction to remain seated may have come from the director (or perhaps even the actor). Suppose the writer were to incorporate that direction into the play itself—i.e., "White: I have to go (remaining seated)." In that situation, the playwright and the director both would want to claim authorship of that particular direction.

⁴⁷⁹ Interview with John Clinton Eisner, *supra* note 439.

⁴⁸⁰ *Id.*

⁴⁸¹ *Id.*

⁴⁸² See, e.g., Off-Broadway-SSDC Collective Bargaining Agreement, *supra* note 171, § XIV (Property Rights), at 17–18.

the final production.⁴⁸³ It might be extremely difficult, if not impossible, to slice apart the Broadway staging to determine which director is entitled to “own” particular elements.⁴⁸⁴ It is also problematic to categorize all three directors as joint authors because it is not clear that either element of joint authorship is satisfied—namely, the intent on the part of all authors to be joint authors and the independent copyrightability of each joint author’s contribution.⁴⁸⁵ Presumably, at least the Broadway director would not likely have the intent to be a joint author with the earlier directors.⁴⁸⁶ In addition, if the Broadway director borrows just a few (although important) elements or motifs from the earlier productions, the earlier directors’ contributions might not be considered independently copyrightable.⁴⁸⁷

CONCLUSION

Certainly, a straightforward application of traditional copyright law would dictate that stage directions are subject to copyright protection. They are, in most cases, original creative works that can easily be fixed in a tangible medium either through videotaping a performance or by detailed notations in a prompt book. The Society of Stage Directors and Choreographers (“SSDC”) contracts used by union directors reserve ownership of the copyright in stage directions in the director as opposed to the producer of the show, thus overriding the work-made-for-hire doctrine. Directors who believe that their staging has been misappropriated by later directors can prove infringement through showing the later directors’ access to their work and probative and substan-

⁴⁸³ Interview with John Weidman, President, Dramatists Guild of America, in N.Y., N.Y. (June 7, 2007) (arguing that copyright protection for stage directions “could pit director against director” in an unhealthy way).

⁴⁸⁴ *Id.* For example, in Joe Mantello’s production of *Love! Valour! Compassion!*, he staged the opening scene as a tableau of actors surrounding a doll house. Interview with Barbara B. Hauptman, *supra* note 34. He regarded that particular staging as one of his notable creative contributions. *Id.* Hypothetically, suppose an earlier workshop production of the same play directed by another director had involved three doll houses in the opening scene with some of the actors standing next to each one. Subsequently, Mantello decides to pare down the doll houses to a single doll house with all of the actors clustered around it on the basis that that kind of staging creates a greater impact. Would the earlier director in this hypothetical have ownership of the “doll house opening,” or would Mantello own it because of the changes he made? Would Mantello be viewed as having created a work derivative of the original staging, or would he be regarded as a joint author with the original director?

⁴⁸⁵ See *Thomson v. Larson*, 147 F.3d 195, 201 (2d Cir. 1998); *Seshadri v. Kasraian*, 130 F.3d 798, 803 (7th Cir. 1997).

⁴⁸⁶ See *Thomson*, 147 F.3d at 201.

⁴⁸⁷ See *Seshadri*, 130 F.3d at 803.

tial similarity between the two stagings. Fair use will seldom operate as a defense unless the subsequent director's staging is transformative (such as a parody) or an insignificant borrowing of the earlier director's work.

Notwithstanding what appears to be the basic protectability of stage directions under copyright law, directors may still find the ultimate level of protection somewhat limited. In particular, the doctrines of merger and *scènes à faire* will remove from protection any standard devices used to portray a particular setting or era and any directions that necessarily follow from the dialogue and playwright-created stage business. Additionally, because ideas are not subject to copyright protection, a second director is always be free to borrow an earlier director's motif or concept for staging—e.g., setting Shakespeare's *Henry V* during the American Civil War.

Finally, if copyright law fails to vindicate fully a director's hoped-for rights, other legal theories, such as contract, unfair competition, misappropriation, and unjust enrichment, pose their own hurdles. Contract theories will assist directors where the original producer has misappropriated the directions in a subsequent production without attribution or compensation. But where a later director, not associated in any way with the original production, makes an unauthorized use of that production's stage directions, the original director will not have any contractual relationship with the later director. Federal unfair competition law under Section 43(a) of the Lanham Act also appears to be a dead letter as applied to unauthorized appropriation of intellectual goods (reverse passing off situations) after the U.S. Supreme Court's 2003 ruling in *Dastar v. Twentieth Century Fox Corp.* Lastly, many state law unfair competition and misappropriation claims will be preempted under the Copyright Act. An unjust enrichment claim will share the same preemption fate unless the plaintiff director can convince a court that union directors owe fiduciary duties to one another.

Ultimately, a director who creates a truly novel staging of a classic or new play should be able to sue successfully a later director for copyright infringement if the later director closely copies the most striking features of the original director's staging. That result is consistent with copyright doctrine and policies, which seek to encourage creation of artistic works while allowing second comers to be inspired by earlier efforts, and with the theatre's long tradition as both an individual and collaborative art.