Creating and Selling Films & Printed Documents: The Challenge of the Joint Authorship and First Sale Doctrines

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Creating and Selling Films & Printed Documents: 
The Challenge of Joint Authorship and First Sale Doctrines

SHERRI BURR*

I. INTRODUCTION

The joint creation of intellectual property can arise in many forms. The lives of two men intersect and they create a computer named Apple.1 A married couple who once served as President and First Lady of the United States co-write a memoir.2 A screenwriter develops an idea for a film and asks a buddy to co-write it with him.3 Two law professors agree to co-author a casebook.4 Three University of Southern California graduates collaborate to film a documentary that captures the breakdowns of a 1972 Volkswagen van as it is driven from Tulsa, Oklahoma, to Los Angeles,

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1 Regents Professor of Law at the University of New Mexico School of Law and the author or co-author of twenty books. She is a graduate of Mount Holyoke College, Princeton University, and the Yale Law School. She has produced and co-hosted the award-winning television show ARTS TALK on cable access television since 1998.
   1. For an account of the collaboration between Steve Jobs and Steve Wozniak that led to the birth of the first Apple Computer, see WALTER ISAACSON, STEVE JOBS 63-70 (2011).
California. With all these examples, legal issues may arise concerning joint authorship.

The selling of intellectual property can also take different forms. Some products are single items, such as art work, that can be sold once, and the creator loses control over subsequent re-sales. Whereas other products, like computer programs, can be licensed and sold multiple times with restricted use to different individuals. The first example invokes the Copyright laws’ first sale doctrine, whereas the latter involves licensing.

This article takes a critical look at the copyright provisions governing joint authorship and first sales of work. Of particular concern is the influence of these doctrines on film and the printed word. Joint film products begin with idea treatments and screenplays that may be co-written with two or more authors, and include directors who oversee the making of the entire film, and actors who make the screenwriters’ words come alive. The First Sale Doctrine affects the film industry and the printed word by placing limits on the ability of intellectual property-related industries to control the distribution of their output.

II. JOINT AUTHORSHIP

The Copyright Act proclaims, “a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners [sic] of copyright in the work.” To be considered a joint work, “contributions [must] be merged into inseparable or interdependent parts of a unitary whole.”

Under these provisions, all joint authors are considered co-tenants in the work, meaning they possess an undivided interest in the entire work and are responsible to the other authors for any funds earned from the work. This responsibility applies to all copyrighted works, whether there are two or ten joint owners.

Consider Table 1, which provides data on single versus jointly authored law review articles. For each law journal publication, the statistics in Table 1 represent all articles, comments, notes, and essays published in issues during the 2010 calendar year, listed on individual journal websites. The results of this table indicate that lawyers, law professors, and students are more likely to write solo articles rather than collaborate with two or more authors. Of 626 total pieces, 535 were produced by one author, seventy-two
by two authors, eighteen by three authors, and only one by four authors. Statistically, eighty-three percent of the articles, comments, notes, and essays in this sample were authored individually and seventeen percent were joint pieces.

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10. With exception of the Harvard Law Review, all other journals include articles, comments, notes and essays. The Harvard Law Review lists only articles with named author bylines. For each law school publication, the statistics above represent all articles, comments, notes and essays published in issues from the calendar year 2010, listed on individual journal websites. This Table was prepared by Caroline Seigel, Research Assistant to Professor Burr.
Why the tendency to write solo? The biggest advantage is that there is someone to share the workload and collaborate on ideas. The biggest disadvantage is that the likelihood of conflict increases with each additional contributor. People are less likely to engage in disputes with themselves over their own work. Add a partner, however, and there is now a person who could be blamed for the work’s faults.

The film industry and printed media have been the source of many joint authorship problems, which will be considered below. Conflicts may center on creation, management, and dissolution of collaborations. One could analogize the joint authorship process to the complexity of courtship. Parties date to decide if they wish to engage in a relationship with each other. The actual creation process can be as complex as a marriage. Once committed, partners must divvy up the chores necessary to finishing the work. Dissolving joint authorships can be as difficult as divorcing a spouse. If a work (or baby) has been created, then both partners will be forever connected to the product and to each other as joint authors.

The forms that give rise to joint authorship disputes are numerous. Creative people have sued each other in instances when a person contributed to a movie and sought to be acknowledged as a co-author,11 two musicians decided to fuse the lyrics of one party with the music of another to create one song,12 a researcher contributed information to a play author,13

| University of California Berkeley | 57 | 6 | 1 | 64 |
| University of Virginia | 25 | 7 | 32 |
| Duke | 35 | 3 | 39 |
| Northwestern University | 40 | 5 | 45 |
| Cornell | 29 | 2 | 33 |
| Georgetown | 36 | 4 | 44 |
| University of Texas at Austin | 45 | 4 | 49 |
| TOTALS: | 535 | 72 | 18 | 626 |

11. See, e.g., Aalmuhammed v. Lee, 202 F.3d 1227, 1229-30 (9th Cir. 2000).
12. See, e.g., Shapiro, Bernstein & Co., Inc. v. Jerry Vogel Music Co., Inc., 223 F.2d 252, 253-54 (9th Cir. 1955). In Shapiro, Bernstein & Co., Inc. v. Jerry Vogel Music Co., Inc., the United States Court of Appeals for the Ninth Circuit Court considered whether the musician who wrote the lyrics can assign his renewal rights. Id. at 253-54. The court said yes. Id. at 254. It determined that Summer, who wrote the lyrics to Bowman’s music, had the right to renew his copyright and re-assign the joint work. Id. at 253-54; see also Shapiro, Bernstein & Co., Inc. v. Jerry Vogel Music Co., Inc., 221 F.2d 569, 570-71 (9th Cir. 1955).
or two academics collaborated on a book. In each of these interactions, what is critical for the designation of joint authorship is that all contributors intend to merge separable or independent parts into a unitary whole. The idea behind this merger is that one work will be created from two or more parts.

The next three sections explore issues associated with joint author creation, management of jointly authored works, and dissolving joint author partnerships.

A. Joint Authorship Creation

In any context, including film and print media, a work may be considered joint if it meets the following three criteria. First, there must be a copyrightable work. Second, it must involve the creative output of two or more authors. Third, these authors must intend to merge their contributions into inseparable or interdependent parts of a unitary whole.

For films, many individuals will receive credit for their contributions, but usually the studio or film company is the author who claims the copyright. Credits accord recognition to the talent who participated in the entertainment product by listing the person’s name next to his or her function in the picture. If someone receives the credit of screenwriter, for example, then the person penned the picture.

Credits have both psychological and economic value to participants. Their psychological importance is associated with getting acknowledgement for a role in a project. In the Silent Film era, no credit was given to the actors, directors, or others involved in the creative process. The audience would only learn the name of the film and the production company. According to author William Goldman, “performers began to become favorites. . . . If you wrote to them, you would have to send off your fan letter to ‘The Butler with the Mustache’ or ‘The Girl with the Curly Blonde

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13. Childress v. Taylor, 945 F.2d 500, 502-03 (2d Cir. 1991). The court considered whether the researcher for a play could be considered a joint author of the resulting work. Id. at 504-05. The court answered the question negatively. Id. at 509.

14. In McMunigal, a California district court considered whether a criminal law casebook produced by two academics was a collective work or a joint work. McMunigal, 2010 WL 5399219, at *3. It ruled the work joint. Id. at *4.

15. 17 U.S.C. § 101 ("a ‘joint work’ is prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.” (emphasis added)).

16. See infra Part II.A-C.


18. Id.

19. Id.
Credit arose as a selling mechanism once production companies started to realize that audience members identified with actors and would go see their films again and again.

The economic aspect of credit is associated with increased financial remuneration because a member of the entertainment industry’s reputation is based on credit. The better their films do at the box office, the more screenwriters can earn for their next projects. That old saying that a success has many fathers and a failure is an orphan definitely applies to films. A film may be considered a disaster, like 2013’s The Lone Ranger, which “cost approximately $250 million to produce, and more than $150 million to market and distribute around the globe,” but only earned a dismal $81 million during the first twenty days of its run. By comparison, Despicable Me 2 earned $279,463,495 during the same twenty-day period, but cost only $76 million to produce. When a movie is a commercial success, people have been known to sue for appropriate credit and sometimes to claim authorship.

On the film Malcolm X, Jefri Aalmuhammed was given the credit of Technical Consultant: Islam. Aalmuhammed was paid for his services, yet he registered a copyright in the film. He then sued director Spike Lee and others connected with the film, seeking to be acknowledged as a joint author of the film. Aalmuhammed v. Lee considered the question of whether a contributor of (1) two scenes with new characters, (2) Arabic translation

24. For example, film actress Sophia Loren sued Samuel Bronston Productions when the company failed to ensure that her name was emblazoned on a Broadway sign in the same type of the same size and on the same line as her co-star Charlton Heston. 32 Misc.2d 602, 224 N.Y.S.2d 959 (1962). Television actor William Smithers sued MGM Studios for breach of contract when he did not receive upfront billing under a most favorite nation’s clause of his contract. 139 Cal.App.3d 643, 189 Cal. Rptr. 20 (Cal.App. 2 Dist. 1983). When Nick Marino failed to be awarded screen writing credit for the Godfather III, he sued the Writers Guild of America, 992 F.2d 1480; cert. den. 510 U.S. 978; reh. den. 510 U.S. 1066.
26. 202 F.3d 1227.
into English subtitles, and (3) selected Muslim prayers can be considered a joint author of the movie Malcolm X.\textsuperscript{27}

The United States Court of Appeals for the Ninth Circuit agreed that Aalmuhammed made valuable contributions to the film, but focused on whether he had made a copyrightable contribution necessary to be considered a joint author.\textsuperscript{28} The court answered this question in the negative, deciding that Aalmuhammed was not one of the film’s authors.\textsuperscript{29} The author is the “originator or the person who causes something to come into being.”\textsuperscript{30}

Aalmuhammed did not cause the film to come into being.\textsuperscript{31} Rather, his contributions were incorporated after the screenplay had been written, and the cast and crew had been hired.\textsuperscript{32} Indeed, actor Denzel Washington hired Aalmuhammed “to assist him in his preparation for the starring role because Aalmuhammed knew a great deal about Malcolm X and Islam. Aalmuhammed, a devout Muslim, was particularly knowledgeable about the life of Malcolm X, having previously written, directed, and produced a documentary film about Malcolm X.”\textsuperscript{33}

When the court examined Aalmuhammed’s contributions, it determined that they did not constitute copyrightable work.\textsuperscript{34} According to the court,

Aalmuhammed submitted evidence that he directed Denzel Washington and other actors while on the set, created at least two entire scenes with new characters, translated Arabic into English for subtitles, supplied his own voice for voice-overs, selected the proper prayers and religious practices for the characters, and edited parts of the movie during post production.\textsuperscript{35}

Further, Denzel Washington testified in his deposition that Aalmuhammed’s contribution to the movie was “great” because he “helped to rewrite, to make more authentic.”\textsuperscript{36} “Once production ended, Aalmuhammed met with numerous Islamic organizations to persuade them that the movie was an accurate depiction of Malcolm X’s life.”\textsuperscript{37}

\begin{itemize}
  \item \textsuperscript{27} \textit{Id.} at 1229-30.
  \item \textsuperscript{28} \textit{Id.} at 1231-36.
  \item \textsuperscript{29} \textit{Id.} at 1235-36.
  \item \textsuperscript{30} \textit{Id.} at 1232.
  \item \textsuperscript{31} See \textit{Aalmuhammed}, 202 F.3d at 1229-30, 1235.
  \item \textsuperscript{32} \textit{Id.} at 1229-30.
  \item \textsuperscript{33} \textit{Id.} at 1229.
  \item \textsuperscript{34} \textit{Id.} at 1235.
  \item \textsuperscript{35} \textit{Id.} at 1230.
  \item \textsuperscript{36} \textit{Aalmuhammed}, 202 F.3d at 1230 (internal quotation marks omitted).
  \item \textsuperscript{37} \textit{Id.}
These types of contributions differ from a screenplay writer who creates a script based on a prior work, like a novel, or out of whole cloth. In both instances, the screenplay writer is creating a blueprint for an entire film. Aalmuhammed's contributions clearly did not amount to a blueprint for the entire film.

The court also noted that:

Aalmuhammed never had a written contract with Warner Brothers, Lee, or Lee's production companies, but he expected Lee to compensate him for his work. He did not intend to work and bear his expenses in New York and Egypt gratuitously. Aalmuhammed ultimately received a check for $25,000 from Lee, which he cashed, and a check for $100,000 from Washington, which he did not cash.38

It is curious that Aalmuhammed would cash a check from Lee, and then sue him, but did not cash a check that was four times greater from Denzel Washington, whom he did not sue. His approach to the money seems as ill-considered as his lawsuit claiming joint authorship.

While Aalmuhammed's contributions to Malcolm X failed to meet the legal requirements of a joint work, consider the following example of joint screenplay creation. I interviewed Joshua Michael Stern who is credited with directing and co-writing, along with Jason Richman, the screenplay to Swing Vote.39 About his creative interaction with Jason Richman, Stern said:

Jason Richman had the original story. I came on to help him. The logline was, "What if the election came down to one vote?" We outlined every scene, including the slug lines, the Introduction, Act one, two, three. Richman would take the first thirty pages. I wrote the next thirty pages. Richman took the next thirty pages. Then we did separate passes. Then we sat down together and went over every scene together. I also acted it out.40

This collaboration clearly meets the criteria for joint authorship.

First, Stern and Richman produced a copyrightable work. Screenplays are copyrightable works in their own right before they are assigned to a

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38. Id.
production company or studio. When screenplays are incorporated into an entire film, they become a new work, which receives one copyright.

Second, this collaboration involved the creative output of two authors, Richman and Stern. And third, Richman and Stern intended to merge their contributions into inseparable or interdependent parts of a unitary whole—the screenplay for *Swing Vote*. Notice that Stern said that Richman came up the original idea: “What if the election came down to one vote?” Notice also that Stern said he and Richman took turns writing a new work, pages at a time, and then sat down together to go over every scene. Once they were finished, there were no separate Stern parts and Richman parts. There was just one screenplay.

Not all joint author creations work as well as that of Stern and Richman. Some are problematic even when fashioned by people who have known each other a long time.

For example, consider former President Jimmy Carter and First Lady Rosalynn Carter, who had survived a decade-long marriage before deciding to co-author a book. Their prior adventures included raising four children, running a peanut farm, governing the state of Georgia, and leading the free world from the White House. Yet, when the two of them decided to jointly write *Everything to Gain: Making the Most of the Rest of Your Life* in 1995, their marriage almost collapsed. What they found is that they did not remember the same events or the same dialogue in the same way, or reflect in the same way on the significance or meaning of events. In the end, they published their memoir with separate his and her parts, and with different typesets so that you knew when Jimmy was speaking and when Rosalynn was speaking.

If a long married couple like Jimmy and Rosalynn Carter had problems co-authoring together, what are the potential tribulations for the rest of humanity? While the Carters ultimately produced one book, reading their words in different fonts begs the question of whether the individuals’ text merged into an inseparable whole. Because of the different font, a publisher could reasonably have separated the one book into two. However, if separation could easily defeat a joint authorship claim, this would destroy most co-created musical works.

*Rodgers and Hammerstein’s Cinderella*, for example, is a musical written for television with music by Richard Rodgers and a book and lyrics by Oscar Hammerstein II. While the music could have been independently copyrighted by Rodgers, his intent was to mold a musical production with Hammerstein. Without Hammerstein’s lyrics, there is no

musical for Rodgers to sell. Once again, it boils down to a question of intent. Rodgers and Hammerstein intended to create musicals. Jimmy and Rosalynn Carter intended to write a joint memoir.

Over the years, courts have also considered other joint authorship problems related to the media, from joint authorship of articles and chapters of books, to complete books. For example, what if the person with the idea proposed collaboration with another person, who accepts the offer by working on an outline and two chapters, and then the original idea person decides to dissolve the partnership? Is the person who worked on the outline and two chapters still entitled to be considered a joint author of the resulting book?

In Maurizio v. Goldsmith, Cynthia Maurizio claimed "she wrote or collaborated on the book outline and two draft chapters of the successful novel The First Wives Club, which also became a film starring Goldie Hawn, Bette Midler, and Diane Keaton. However, it was Olivia Goldsmith "who submitted the book outline and the complete book for publication, who is recognized as its author, and who has not given Maurizio the credit or the share of royalties and film production rights to which Maurizio claims she is entitled." Maurizio claims that Goldsmith proposed that they co-write the novel together, and said it would "make a lot of money." When Maurizio attempted to formalize their agreement by asking for co-authorship credit and twenty-five percent of the profits from the book, she claims Goldsmith reacted "very badly."

In a confusing opinion, the United States District Court for the Southern District of New York granted Goldsmith's motion for summary judgment on Maurizio's joint authorship claim, while indicating in another part of its opinion it was ripe for consideration. The district court applied the Second Circuit's two-part test for joint authorship requiring "each putative co-author must have (1) intended, at the time of creation, to be a co-author and (2) made independently copyrightable contributions to the work." It found Maurizio "ha[d] proffered sufficient evidence that, during the time that she made her contributions, Goldsmith intended Maurizio to be a co-author of FWC." The district court stated, "a trier of fact could reasonably

42. 230 F.3d 518 (2d Cir. 2000).
43. Id. at 519.
45. Maurizio v. Goldsmith, 230 F.3d at 519.
47. Id. at 460.
48. Id. at 465-67, 469.
49. Id. at 465.
50. Id.
find intent based on Goldsmith’s April 20 request that Maurizio co-author FWC, followed by Maurizio’s work on the outline and draft chapters until May 10, 1990.”

The district court also found that “genuine issues of fact exist[ed] as to the copyrightability of Maurizio’s contributions that render summary judgment improper.”

The opinion is confusing because in the analysis section, the district court determines that there are joint author issues that survive summary judgment, and yet it grants summary judgment by finding that Maurizio’s joint authorship claim was barred by the Copyright Act’s three-year statute of limitations. The district court determined that the joint authorship claim accrued when “Maurizio became aware on January 23, 1991—more than five years prior to the filing of this action—that the movie rights to First Wives Club had been sold.”

The United States Court of Appeals for the Second Circuit upheld the grant of summary judgment because it found that the district court did not abuse its discretion in deciding not to apply the federal equitable tolling doctrine to Maurizio’s joint authorship claim. Maurizio argued that her copyright claim was tolled during the pendency of a contract action in state court, but the court disagreed, and affirmed the dismissal of her joint authorship claim.

The conclusion that can be drawn is that Maurizio might have made a successful claim for joint authorship had she filed her lawsuit within three years of the accrual of her claim under the Copyright Act.

B. Joint Authorship Management: The Problem of Subsequent Derivative Works

To continue using marital analogies, suppose two individuals produce joint works—or babies—together. Who controls the offspring? Does the co-author of a joint work have the right to be considered co-author of all subsequent, derivative works? Managing the products of joint authorship can be as difficult as creating them.

In Weissmann v. Freeman, the Second Circuit considered the question of who can claim authorship of subsequent derivative works based on a jointly authored piece. Heidi Weissmann was the former assistant to

51. Maurizio, 84 F. Supp. 2d at 466.
52. Id.
53. Id. at 463-64
54. Maurizio, 230 F.3d at 520.
55. Id.
56. Id. at 520-21.
57. 868 F.2d 1313 (2d Cir. 1989).
58. Id. at 1315.
researcher Leonard Freeman. The parties collaborated on seventy-one of Weissmann’s eighty-eight articles. When Weissmann wrote a work on Radiopharmaceutical, Immunodiacetic Acid (“IDA”) and published it in her name, Freeman questioned whether it was a derivative of prior co-authored works, and thus postulated that he should share the credit.

Congress considers a derivative of a joint work to be an independent work. The Second Circuit cited a House Report that stated Congress intended that “copyright in a derivative work is independent of, and does not enlarge the scope of rights in, any pre-existing material incorporated in it.” With each creative output, to make a work joint, the parties must intend to do so, and each must contribute. By analogy, if two individuals produce a child together and they next produce separate children with other individuals, they cannot claim parenthood of the children to which they did not contribute genetic material.

In Weissmann, “Dr. Freeman conceded that he had not participated in drafting the new matter included in P-1.” The Court thus determined:

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

Dr. Freeman acknowledged that he did not participate in drafting the new matter prepared by Weissmann. Thus, he acquired no property rights in the newly created work, and did not obtain the right to put his name on Weissmann’s paper, as he did and include it into a collection of his work. Here, Dr. Freeman manifested no intent to contribute to Weissmann’s derivative work. If he had, then he could have reasonably claimed joint authorship.

The implications for the film industry are important because of the tendency of studios to produce sequels and reproductions of prior successful films. With the 2003 Pirates of the Caribbean: The Curse of the Black

59. Id. at 1315-16.
60. Id. at 1320.
61. Id. at 1316.
64. Id. at 1318.
65. Id.
66. Id.
CREATING AND SELLING

Pearl, for example, six individuals received writing credits.67 Ted Elliott & Terry Rossio and Stuart Beattie and Jay Wolpert received screen story credit, and Ted Elliott & Terry Rossio received screenplay credit.68 The film industry distinguishes between the uses of ampersand “&” and the word “and” to determine which individuals worked together (&) or later contributed to the work (and). For this Pirates of the Caribbean movie, “Ted Elliott & Terry Rossio” worked together, whereas “Stuart Beattie and Jay Wolpert” later contributed to the story. For copyright purposes, Ted Elliott & Terry Rossio would be considered the copyright owners of the story and the screenplay they created. But can they claim to be joint authors of subsequent Pirates of the Caribbean sequels?

The Weissmann case implies the answer would be negative unless Elliott and Rossio actually contributed to the subsequent works. In the 2006 Pirates of the Caribbean: Dead Man’s Chest, the 2007 Pirates of the Caribbean: At World’s End, and the 2011 Pirates of the Caribbean: On Stranger Tides, the same individuals were given story and screenplay credits.69 In Pirates of the Caribbean: Dead Men Tell No Tales, scheduled for release in 2016, however, only one person, Jeff Nathanson, is scheduled to receive screenplay credit.70 While Beattie, Elliott, Rossio, and Wolpert will receive credit for creating the characters,71 their contributions to the new work will be considered limited. They would have no claim to Nathanson’s contributions.

C. Joint Authorship Dissolutions

What happens to the product of joint authorships when the partners do not get along and decide to dissolve their collaboration? In McMunigal v. Bloch,72 two law professors co-authored a casebook together, but when they started having problems working together they decided to not collaborate on subsequent editions.73 McMunigal sought to have their casebook be

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68. Id.
71. Id.
73. Id. at **1-2.
considered a collective work rather than a joint work. A collective work can be separated into individual copyrightable parts, unlike a joint work where the parties have merged their individual contributions into a unitary whole.


Because their partnership did not fare well, they agreed to separate and reached a separation agreement in November 2007. Aspen agreed to give them individual contracts on the condition they separate in writing. McMunigal submitted a proposal for a new casebook, and Aspen accepted it. Bloch did not submit a new proposal and repudiated the separation agreement. A small portion of it is displayed in Table 2:

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<td>* Problems 2.3</td>
<td>* Problems 2.1 and 2.2</td>
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<td>* Kant edit, p. 40</td>
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<td>* Michael</td>
<td>* Problems 2.8, 2.9, 2.10</td>
<td>* Intro p. 28-39</td>
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<td>Moore excerpt</td>
<td>* Question 4, p. 33</td>
<td>* Problems 2.4, 2.5, 2.6</td>
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<td></td>
<td>* Recorder article on p. 40-41</td>
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74. The Copyright Act, 17 U.S.C. § 101 defines a “collective work” as “a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves are assembled into a collective whole.” Law journals exemplify this definition. The individual articles are separately copyrightable and merely assembled into a collective whole.

76. *Id.*
77. *Id.*
78. *Id.* at *2.*
79. *Id.*
81. *Id.*
82. *Id.*
As you can see from Table 2, McMunigal went through Chapter 2 and produced three columns: one for joint ownership, another for Bloch’s sole copyrighted materials, and a third for McMunigal’s sole copyrighted materials. The problem is none of this was indicated in the book, like with the separate fonts in Jimmy and Rosalynn Carter’s memoir.

After Bloch repudiated the Separation Agreement, McMunigal sued Bloch, and claimed the casebook was a collective work and not a joint work. Such a ruling would permit McMunigal to separate his contributions to the book for use in his next project.

As mentioned earlier, the Copyright Act defines joint work as “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.” It defines a collective work as “a work in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.” Examples of collective works include periodicals, anthologies, and encyclopedias.

In addition to the intent factor discussed earlier with regard to creating joint works, the McMunigal court examined whether (1) the parties superintended the work by exercising control; (2) the audience appeal of the work can be contributed to both authors; and (3) the share of each in its success cannot be appraised.

The United States District Court for the Northern District of California found that the casebook was a joint work. As for intent, the district court cited the contract with Aspen as evidence of objective manifestation of intent to be co-authors. In the contract, both McMunigal and Bloch were described as co-authors. The contract also mentioned their joint obligations, and required them to submit a single manuscript.

83. Id. at **2-3.
85. Id.
86. See McMunigal, 2010 WL 5399219, at *4.
87. Id. at *5.
88. Id. at *4.
89. Id.
90. Id.
Concerning the control factor, the district court noted that "both plaintiff and defendant supervised the Casebook by exercising control" to create a unitary whole. Further, the district court expressed concern that McMunigal did not sufficiently explain what parts he authored independently and whether those pieces of the casebook could "stand alone."

When it came to audience appeal, the district court found that the appeal of the book could be attributed to both authors. The casebook does not list who authored which chapters, and as such could not be partitioned.

If Bloch had been willing to transfer her portion of the copyright to McMunigal, the Copyright Act requires that she do so in writing. Thus, the court refused to issue a declaratory judgment to enforce the Separation Agreement because Bloch never signed it. Further, the facts did not indicate that Bloch received and acknowledged a final e-mail memorialization of an agreement.

To continue the courtship analogy, McMunigal v. Bloch is an example of why states have no-fault divorce laws. If one party wants to divorce and the other one does not, they remain married. Similarly, the way the copyright law is written, if one co-author wants to end the collaboration and separate the parts that are his, they remain joint authors of the underlying work. The exception would seem to be if the authors had somehow clearly indicated in the book itself which parts belonged to each author. For example, if McMunigal and Bloch had divided their book chapter by chapter, then the outcome might have been different because the resulting casebook would have been less commingled.

Yet the information in the Separation Agreement in Table 2 indicates that each chapter had contributions from both authors, individually and jointly. This makes for a work that is difficult to split while maintaining its character as a freestanding book. Unlike the earlier example of Rodgers and Hammerstein's Cinderella, where Rodgers contributed the music and Hammerstein the lyrics, the individual contributions of McMunigal and Bloch could not stand independently as a book.

How common is joint authorship of legal publications such as casebooks? Table 3 provides data on the authorship of books by West and Aspen, two of the leading academic publications. Table 3 indicates that for
both publishers, approximately half of all books are individually authored (1,371 out of 2,758) and half have two or more authors (1,387 out of 2,758).

<table>
<thead>
<tr>
<th># Authors:</th>
<th>1</th>
<th>2</th>
<th>3</th>
<th>4</th>
<th>5</th>
<th>6</th>
<th>7</th>
<th>8</th>
<th>Total#</th>
</tr>
</thead>
<tbody>
<tr>
<td>WEST⁹⁷</td>
<td>137</td>
<td>173</td>
<td>131</td>
<td>85</td>
<td>12</td>
<td>1</td>
<td>0</td>
<td>0</td>
<td>539</td>
</tr>
<tr>
<td>Aspen⁹⁸</td>
<td>1,234</td>
<td>650</td>
<td>235</td>
<td>62</td>
<td>26</td>
<td>7</td>
<td>3</td>
<td>2</td>
<td>2,219</td>
</tr>
<tr>
<td>TOTALS:</td>
<td>1,371</td>
<td>823</td>
<td>366</td>
<td>147</td>
<td>38</td>
<td>8</td>
<td>3</td>
<td>2</td>
<td>2,758</td>
</tr>
</tbody>
</table>

Based on the discussion in this section, what should be the advice for collaborating authors? First, memorialize the contributions in writing, even if only on a napkin to indicate who is responsible for which parts. Second, draft a schedule and stick to it. Third, and perhaps most importantly, decide, while the authors like each other, how to someday end the collaboration if necessary. This is the equivalent of adopting a prenuptial agreement while enraptured by love rather than waiting until a contentious divorce to try to end the collaboration and divide the property.

III. THE FIRST SALE DOCTRINE

Once joint works are created, authors desire to distribute and sell them. Section 109(a) of Title 17 of the United States Code provides: “Notwithstanding the provisions of section 106(3), the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord.”⁹⁹ This has become known as the First Sale Doctrine.¹⁰⁰

97. WEST: Publications surveyed from WEST only include casebooks and casebook supplements, listed by subject area from the publisher’s website, http://west.thomson.com/products/law-students/default.aspx, as of 4/11. Subject areas not surveyed are: Career Success, Law School Success, Lawyering Skills, Legal Research and Legal Writing.

98. Aspen Publications include Wolters Kluwer publications. Publications surveyed include ALL [casebooks, treatises, yearbooks, study aids, etc.] those listed by practice area through “International Business Law” on the publisher’s website, http://www.aspenpublishers.com/?utm_source=GAN&utm_medium=affiliate&utm_content=AspenPublishers&utm_campaign=k271169, as of 4/11. The only publication type not included in the survey are those with a corporate author. The Aspen survey is NOT comprehensive; it includes all publications from “Administrative Law” through “International Business Law”, but not those from “Investment Management” through “Venture Capital” (See index by practice area on left side bar of website).


100. Section 109 further provides:

(a) Notwithstanding the preceding sentence, copies or phonorecords of works subject to restored copyright under section 104A that are manufactured before the date of restoration of
copyright or, with respect to reliance parties, before publication or service of notice under section 104A(e), may be sold or otherwise disposed of without the authorization of the owner of the restored copyright for purposes of direct or indirect commercial advantage only during the 12-month period beginning on—

(1) the date of the publication in the Federal Register of the notice of intent filed with the Copyright Office under section 104A(d)(2)(A), or

(2) the date of the receipt of actual notice served under section 104A(d)(2)(B), whichever occurs first. (b)(1)(A).

(b)(1)(A) Notwithstanding the provisions of subsection (a), unless authorized by the owners of copyright in the sound recording or the owner of copyright in a computer program (including any tape, disk, or other medium embodying such program), and in the case of a sound recording in the musical works embodied therein, neither the owner of a particular phonorecord nor any person in possession of a particular copy of a computer program (including any tape, disk, or other medium embodying such program), may, for the purposes of direct or indirect commercial advantage, dispose of, or authorize the disposal of, the possession of that phonorecord or computer program (including any tape, disk, or other medium embodying such program) by rental, lease, or lending, or by any other act or practice in the nature of rental, lease, or lending. Nothing in the preceding sentence shall apply to the rental, lease, or lending of a phonorecord for nonprofit purposes by a nonprofit library or nonprofit educational institution. The transfer of possession of a lawfully made copy of a computer program by a nonprofit educational institution to another nonprofit educational institution or to faculty, staff, and students does not constitute rental, lease, or lending for direct or indirect commercial purposes under this subsection.

(2)(A) Nothing in this subsection shall apply to the lending of a computer program for nonprofit purposes by a nonprofit library, if each copy of a computer program which is lent by such library has affixed to the packaging containing the program a warning of copyright in accordance with requirements that the Register of Copyrights shall prescribe by regulation.

(B) Not later than three years after the date of the enactment of the Computer Software Rental Amendments Act of 1990, and at such times thereafter as the Register of Copyrights considers appropriate, the Register of Copyrights, after consultation with representatives of copyright owners and librarians, shall submit to the Congress a report stating whether this paragraph has achieved its intended purpose of maintaining the integrity of the copyright system while providing nonprofit libraries the capability to fulfill their function. Such report shall advise the Congress as to any information or recommendations that the Register of Copyrights considers necessary to carry out the purposes of this subsection.

(3) Nothing in this subsection shall affect any provision of the antitrust laws. For purposes of the preceding sentence, "antitrust laws" has the meaning given that term in the first section of the Clayton Act and includes section 5 of Subject Matter and Scope of Copyright § 109 24 Copyright Law of the United States the Federal Trade Commission Act to the extent that section relates to unfair methods of competition.

(4) Any person who distributes a phonorecord or a copy of a computer program (including any tape, disk, or other medium embodying such program) in violation of paragraph (1) is an infringer of copyright under section 501 of this title and is subject to the remedies set forth in sections 502, 503, 504, and 505. Such violation shall not be a criminal offense under section 506 or cause such person to be subject to the criminal penalties set forth in section 2319 of title 18.
In *Kirtsaeng v. John Wiley & Son, Inc.*, the Supreme Court of the United States considered the impact of the words "lawfully made under this title" in the context of distribution. After a work is legally sold in the United States, the author or authors lose control over subsequent sales of the same copy. What most concerned the Court was works that were "printed abroad and then initially sold with the copyright owner's permission." The Court asked, "Does the 'first sale' doctrine still apply? Is the buyer, like the buyer of a domestically manufactured copy, free to bring the copy into the United States and dispose of it as he or she wishes?"

These questions are further complicated by section 602(a)(1) of the Copyright Act, which states that "Importation into the United States, without the authority of the owner of copyright under this title, of copies or phonorecords of a work that have been acquired outside the United States is an infringement of the exclusive right to distribute copies or phonorecords under section 106 . . . ." Thus, there is a conflict between the First Sale Doctrine, where the copyright holder loses control, and the Copyright Importation Clause which gives the copyright holder control over how works are brought into the United States. Section 602 states that

(c) Notwithstanding the provisions of section 106(5), the owner of a particular copy lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to display that copy publicly, either directly or by the projection of no more than one image at a time, to viewers present at the place where the copy is located.

(d) The privileges prescribed by subsections (a) and (c) do not, unless authorized by the copyright owner, extend to any person who has acquired possession of the copy or phonorecord from the copyright owner, by rental, lease, loan, or otherwise, without acquiring ownership of it.

(e) Notwithstanding the provisions of sections 106(4) and 106(5), in the case of an electronic audiovisual game intended for use in coin-operated equipment, the owner of a particular copy of such a game lawfully made under this title, is entitled, without the authority of the copyright owner of the game, to publicly perform or display that game in coin-operated equipment, except that this subsection shall not apply to any work of authorship embodied in the audiovisual game if the copyright owner of the electronic audiovisual game is not also the copyright owner of the work of authorship.

102. *Id.* at 1358.
103. *Id.* at 1358-60.
104. *Id.* at 1355.
105. *Id.* at 1355-56.
106. *Kirtsaeng*, 131 S. Ct. at 1355.
108. *Kirtsaeng*, 131 S. Ct. at 1355.
importing a copy without the permission of the copyright owner violates his or her section 106 exclusive distribution rights.\footnote{109}

For the Court, the clash gave rise to additional questions. It asked,

[W]hether the “first sale” doctrine applies to protect a buyer or other lawful owner of a copy (of a copyrighted work) lawfully manufactured abroad. Can that buyer bring that copy into the United States (and sell it or give it away) without obtaining permission to do so from the copyright owner? Can, for example, someone who purchases, say at a used bookstore, a book printed abroad subsequently resell it without the copyright owner’s permission?\footnote{110}

By holding that the “first sale” doctrine “applies to copies of a copyrighted work lawfully made abroad,” the Court concluded that the First Sale Doctrine trumped the right to control importation from abroad.\footnote{111}

All of these questions impact the film industry as the business has globalized to the point where many top films take in half or more of their revenue from global sales, as illustrated in Table 1-1 from the book Entertainment Law: Cases and Materials in Established and Emerging Media.\footnote{112} In 2010, for example, Avatar earned 72.6% of its revenue abroad, compared to 27.4% in the United States.\footnote{113} The 2008 film The Dark Knight was the only movie on the chart to generate more revenue domestically (53.2%) than overseas (46.8%).\footnote{114} For some reason, The Dark Knight was a film that resonated more with local, rather than global or international audiences. Because of this trend, whereby movies generate more of their revenue abroad than domestically, action films are now tailored to appeal to broader audiences.

\footnotesize{
110. Kirtsaeng, 131 S. Ct. at 1355.
111. See id. at 1355-56.
}
<table>
<thead>
<tr>
<th>Rank</th>
<th>Title</th>
<th>Worldwide</th>
<th>Domestic/ %</th>
<th>Overseas/ %</th>
<th>Year</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td><em>Avatar</em></td>
<td>$2,776,800,000</td>
<td>$760,400,000/27.4%</td>
<td>$2,016,400,000/72.6%</td>
<td>2009</td>
</tr>
<tr>
<td>2</td>
<td><em>Titanic</em></td>
<td>$1,843,200,000</td>
<td>$600,800,000/32.6%</td>
<td>$1,242,400,000/67.4%</td>
<td>1997</td>
</tr>
<tr>
<td>3</td>
<td><em>The Lord of the Rings: The Return of the King</em></td>
<td>$1,119,100,000</td>
<td>$377,000,000/32.6%</td>
<td>$742,100,000/66.3%</td>
<td>2003</td>
</tr>
<tr>
<td>4</td>
<td><em>Pirates of the Caribbean: Dead Man's Chest</em></td>
<td>$1,066,200,000</td>
<td>$423,300,000/39.7%</td>
<td>$642,900,000/60.3%</td>
<td>2006</td>
</tr>
<tr>
<td>5</td>
<td><em>Toy Story 3</em></td>
<td>$1,061,100,000</td>
<td>$414,300,000/39.0%</td>
<td>$646,800,000/61%</td>
<td>2010</td>
</tr>
<tr>
<td>6</td>
<td><em>Alice in Wonderland (2010)</em></td>
<td>$1,024,300,000</td>
<td>$334,200,000/32.6%</td>
<td>$690,100,000/67.4%</td>
<td>2010</td>
</tr>
<tr>
<td>7</td>
<td><em>The Dark Knight</em></td>
<td>$1,001,900,000</td>
<td>$533,300,000/53.2%</td>
<td>$468,600,000/46.8%</td>
<td>2008</td>
</tr>
<tr>
<td>8</td>
<td><em>Harry Potter and the Sorcerer's Stone</em></td>
<td>$974,700,000</td>
<td>$317,600,000/32.6%</td>
<td>$657,200,000/67.4%</td>
<td>2001</td>
</tr>
<tr>
<td>9</td>
<td><em>Pirates of the Caribbean: At</em></td>
<td>$961,000,000</td>
<td>$309,400,000/32.2%</td>
<td>$651,600,000/67.8%</td>
<td>2007</td>
</tr>
</tbody>
</table>

Table 6: Top Box Office Grosses (as of November 2010)\(^{15}\)
<table>
<thead>
<tr>
<th>World’s End</th>
<th>Harry Potter and the Order of the Phoenix</th>
<th>$938,200,000</th>
<th>$292,000,000</th>
<th>$646,200,000</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td></td>
<td>/ 31.1%</td>
<td>/ 68.9%</td>
<td></td>
</tr>
</tbody>
</table>

To the extent a film distribution company sells DVD copies abroad at lower prices, it expects, as John Wiley & Sons did in *Kirtsaeng*, that the media content will be consumed in the country where the movies are sold.

In concluding that the First Sale doctrine applies to material printed abroad, the Court’s decision impacts the film industry as DVDs are often reproduced less expensively abroad for distribution only in local markets. The decision also impacts printed media because it limits the ability of publishers like John Wiley & Sons to control the importation of their books into this country. Author Mark Twain, who was a constant victim of foreign publishers printing his books abroad without permission and then importing his work into the United States, would, perhaps, have been appalled at the outcome of this case. As one commentator postulated, it is now up to Congress to fix the problem created by the Supreme Court’s decision.

To summarize, both the First Sale and Joint Authorship doctrines have important ramifications for film and printed media. The concerns can be immense, and thus creators are advised to consider potential problems before embarking on the creation and distribution of their products.

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