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Recommended Citation

Murray, Brian (1989) "Weissmann v. Freeman: The Second Circuit Errs in Its Analysis of Derivative Works by Joint Authors," *St. John's Law Review*: Vol. 63 : No. 3 , Article 8.

Available at: <https://scholarship.law.stjohns.edu/lawreview/vol63/iss3/8>

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WEISSMANN V. FREEMAN: THE SECOND CIRCUIT ERRS IN ITS ANALYSIS OF DERIVATIVE WORKS BY JOINT AUTHORS

When one hears the mellifluous strains of "Melancholy Baby" it is easy to overlook the fact that the lyricist and composer worked independently.¹ Nevertheless, each is considered a joint author of the work² and has an undivided ownership interest in the copyright of the finished product,³ subject to a duty to account to

¹ See *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406, 407-08 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947).

² See *id.* at 409. The *Shapiro* court stated, "[w]e think they were [coauthors]. The words and music of a song constitute a 'musical composition' in which the two contributions merge into a single work to be performed as a unit for the pleasure of the hearers; they are not a 'composite' work, like the articles in an encyclopedia." *Id.*

The Copyright Act of 1976 (the "Act") defined a 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." 17 U.S.C. § 101 (1982). Joint authors need not know each other, provided that they intend that their contributions eventually merge into a single work. See *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944); *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429, 430 (S.D.N.Y. 1974). One commentator has suggested that "[t]he essence of joint authorship is a joint laboring in furtherance of a preconcerted common design," a definition allowing for the joint authors to toil separately, provided they are acting pursuant to a collaboration agreement. See 1 M. NIMMER, NIMMER ON COPYRIGHT § 6.03 (1988).

³ See *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1498 (D.C. Cir.), *cert. granted*, 109 S. Ct. 362 (1988); *Picture Music, Inc. v. Bourne, Inc.*, 314 F. Supp. 640, 645 (S.D.N.Y. 1970), *aff'd*, 457 F.2d 1213 (2d Cir.), *cert. denied*, 409 U.S. 997 (1972); M. NIMMER, *supra* note 2, at § 6.03; Cary, *Joint Ownership of Copyrights*, in *STUDIES ON COPYRIGHT* 703 (1963). The Act provides: "Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of the copyright in the work." 17 U.S.C. § 201(a) (1982).

While joint authors are joint owners, joint owners are not necessarily joint authors. See M. NIMMER, *supra* note 2, at § 6.01. Joint ownership results when: a) a writer grants part of his copyright to another person; b) a copyright passes from a sole author to more than one person, through sale, inheritance, or bifurcated renewal rights; or c) when the sole author lives in a community property state. See *id.*; see also Note, *Accountability Among Co-Owners of Statutory Copyright*, 72 HARV. L. REV. 1550, 1551-53 (1959) (discussing various origins of co-ownership of copyright). For a further discussion of the effect of community property laws on copyright ownership, see M. NIMMER, *supra* note 2, at § 6.13. See generally Nimmer, *Copyright Ownership by the Marital Community: Evaluating Worth*, 36 UCLA L. REV. 383 (1988) (discussing relationship between copyright and community property law).

the other author for half the profits.⁴ Among the most important ownership rights is the right to prepare a derivative work based on the underlying joint composition.⁵ The derivative work itself may be copyrighted, but the copyright extends only to those aspects which are original to the derivative work.⁶ Courts are divided as to the level of originality required for such a copyright, holding the derivative work to either a "minimal"⁷ or a "substantial"⁸ level of

⁴ A joint author must account to his coauthor for any profits resulting from the use or license of the work. See *Community for Creative Non-Violence*, 846 F.2d at 1498; *Oddo v. Ries*, 743 F.2d 630, 633 (9th Cir. 1984); *Cary*, *supra* note 3, at 697; *Note*, *supra* note 3, at 1559; see also *Comment, Problems in Co-Ownership of Copyrights*, 8 UCLA L. REV. 1035, 1040-44 (1961) (describing theories supporting accountability process). But see *Jerry Vogel Music Co. v. Miller Music, Inc.*, 272 App. Div. 571, 574, 74 N.Y.S.2d 425, 427 (1st Dep't 1947) (dictum that joint authors must share in proceeds from licensing but not from use of joint work), *aff'd*, 299 N.Y. 782, 87 N.E.2d 681 (1949).

In the absence of an express agreement to the contrary, joint authors must share equally in the proceeds from a joint work despite the fact that one author contributed more than the other. See *Sweet Music, Inc. v. Melrose Music Corp.*, 189 F. Supp. 655, 659 (S.D. Cal. 1960); *Eliscu v. T.B. Harms Co.*, 151 U.S.P.Q. (BNA) 603, 604 (Sup. Ct. N.Y. County 1966).

⁵ See 17 U.S.C. § 106 (1982). The Act states, "[s]ubject to sections 107 through 118, the owner of copyright under this title has the exclusive right . . . to prepare [or authorize preparation of] derivative works based upon the copyrighted work." *Id.*; see also *Weinstein v. University of Ill.*, 811 F.2d 1091, 1095 (7th Cir. 1987) ("Each coowner of a copyright may revise the work (that is, make a derivative work) and publish the original or the revision"); *Ellingson, The Copyright Exception for Derivative Works and the Scope of Utilization*, 56 IND. L.J. 1, 4 (1980) (copyright owner must consent to use of work in derivative work).

A derivative work is defined as:

[A] work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

17 U.S.C. § 101 (1982).

⁶ See *Adventures in Good Eating, Inc. v. Best Places to Eat, Inc.*, 131 F.2d 809, 813 (7th Cir. 1942); *Dorsey v. Old Sur. Life Ins. Co.*, 98 F.2d 872, 873 (10th Cir. 1938); *Dynamic Solutions, Inc. v. Planning & Control, Inc.*, 646 F. Supp. 1329, 1340 (S.D.N.Y. 1986); *M. NIMMER*, *supra* note 2, at § 3.04; *Hennes, The Adaptation of Copyright Law to Video Games*, 131 U. PA. L. REV. 171, 181 (1982).

The Act provides that the "copyright in a . . . derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material." 17 U.S.C. § 103(b) (1982).

⁷ See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951). *Catalda* is the leading case in the area of minimal originality, and many courts have quoted its holding that "[a]ll that is needed . . . is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'" *Id.*; see, e.g., *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 438 (4th Cir. 1986); *Tennessee Fabricating Co. v. Moultrie Mfg. Co.*, 421 F.2d 279, 281 (5th Cir.), *cert. denied*, 398 U.S. 928 (1970); see also *Gelles-*

originality. Recently, in *Weissmann v. Freeman*,⁹ the United States Court of Appeals for the Second Circuit held that copyright protection extended to a derivative work with a minimal degree of originality, even though the underlying work was the product of an

Widmer Co. v. Milton Bradley Co., 313 F.2d 143, 146-47 (7th Cir.) (originality means little more than prohibition against actual copying), *cert. denied*, 373 U.S. 913 (1963).

The Second Circuit may be moving toward adopting more than a minimal originality standard. See *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir.) (en banc) (requirement of substantial variation is inherent in concept of originality), *cert. denied*, 429 U.S. 857 (1976). The dissent in *Batlin* argued that the court erred in holding an author to a substantial variation standard, and added that courts "should require only minimal variations to find copyrightability." *Id.* at 492 (Meskill, J., dissenting). Nevertheless, *Batlin* is often cited in support of a minimal variation standard since that opinion cited the *Catalda* case with approval. See, e.g., *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 668 (7th Cir. 1986) (construing *Batlin* as requiring minimal amount of creativity), *cert. denied*, 480 U.S. 941 (1987); *Knickerbocker Toy Co. v. Winterbrook Corp.*, 554 F. Supp. 1309, 1317 (D.N.H. 1982) (reading *Batlin* as requiring a low threshold of originality); *Follett v. New Am. Library, Inc.*, 497 F. Supp. 304, 311 (S.D.N.Y. 1980) (quoting *Batlin* as supporting *Catalda* standard); *Dollcraft Indus. Ltd. v. Well-Made Toy Mfg. Co.*, 479 F. Supp. 1105, 1114 (E.D.N.Y. 1978) (reading *Batlin* as requiring a low threshold of creativity). Some commentators believe that *Catalda* is still the proper approach. See, e.g., M. NIMMER, *supra* note 2, at § 3.03 (quoting *Catalda* and stating proper standard is one of "distinguishable variation"); Page, *The Works: Distinguishing Derivative Creations Under Copyright*, 5 CARDOZO ARTS & ENT. L.J. 415, 421 (1986) (stating *Catalda* approach is generally correct).

⁹ See *Sherry Mfg. Co. v. Towel King of Fla., Inc.*, 753 F.2d 1565, 1568 (11th Cir. 1985) ("It is well settled that in order to qualify for a separate copyright, the derivative work must contain some substantial, and not merely trivial, originality"); *Donald v. Zack Meyer's T.V. Sales & Serv.*, 426 F.2d 1027, 1030 (5th Cir. 1970) (variation must be "substantial" and "meaningful"), *cert. denied*, 400 U.S. 992 (1971); *Adventures in Good Eating*, 131 F.2d at 813 (editor may obtain derivative copyrights if he materially revises work); *M.M. Business Forms Corp. v. Uarco, Inc.*, 347 F. Supp. 419, 425 (S.D. Ohio 1972) (opting for substantial variation test), *aff'd*, 472 F.2d 1137 (6th Cir. 1973); *Norden v. Oliver Ditson Co.*, 13 F. Supp. 415, 417 (D. Mass. 1936) (musical composition must be "substantially a new and original work" to be copyrightable). Some commentators have read *Gracen v. Bradford Exch.*, 698 F.2d 300 (7th Cir. 1983) (Posner, J.), as requiring a substantial degree of originality to copyright a derivative work. See *Brown, The Widening Gyre: Are Derivative Works Getting Out of Hand?*, 3 CARDOZO ARTS & ENT. L.J. 1, 6 (1984); *Francione, Facing The Nation: The Standards for Copyright Infringement, and Fair Use of Factual Works*, 134 U. PA. L. REV. 519, 539 n.111 (1986).

The Act mentions originality but does not state which standard of originality is to be applied. See 17 U.S.C. § 101 (1982). The House Report observed:

The phrase "original works of authorship," which is purposely left undefined, is intended to incorporate without change the standard of originality established by the courts under the present copyright statute. This standard does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of copyright protection to require them.

H.R. REP. NO. 1476, 94th Cong., 2d Sess. 51 (1976); see *Toro Co. v. R & R Prod. Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986) (common law standard of originality unchanged by Act); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 909 n.7 (2d Cir. 1980) (stating House Report left *Batlin* standard undisturbed).

⁹ 868 F.2d 1313 (2d Cir. 1989).

ongoing collaborative effort between joint authors, one of whom penned the derivative work.¹⁰ Moreover, the *Weissmann* court held that where the derivative work determination is based solely on documentary evidence, any evidence of the author's credibility is "scarcely pertinent" and irrelevant.¹¹

In *Weissmann*, Drs. Freeman and Weissmann worked together closely in the field of radionuclide imaging, which involved research on radiopharmaceutical, iminodiacetic acid ("IDA"), a substance used to assist in the diagnosis of certain liver and biliary diseases.¹² Their professional relationship began in the late 1970's when Dr. Freeman began developing a patient data base for IDA analogs.¹³ Dr. Weissmann, then a fourth-year resident, worked under Dr. Freeman's tutelage on the project, and beginning in 1979, the two coauthored many articles in the field of IDA derivatives.¹⁴ In 1980, the two doctors coauthored a syllabus which was to accompany lectures for refresher courses on IDA imaging.¹⁵ The parties jointly updated the syllabus on a yearly basis from 1980 to 1985.¹⁶ In 1985, Dr. Weissmann authored an article entitled "Hepatobiliary Imaging" ("P-1"), which was admittedly based on previous papers jointly written by the parties.¹⁷ Dr. Weissmann thwarted Dr. Freeman's attempt to use P-1 at a review course in 1987, and later filed suit, claiming that Dr. Freeman had infringed her copyright in P-1.¹⁸

¹⁰ See *id.* at 1321-22.

¹¹ *Id.* at 1322.

¹² *Id.* at 1315-16.

¹³ *Id.* Dr. Freeman's reputation in the field of nuclear medicine made FDA approval possible for the IDA research. See *Weissmann v. Freeman*, 684 F. Supp. 1248, 1253 (S.D.N.Y. 1988), *rev'd in part, aff'd in part*, 868 F.2d 1313 (2d Cir. 1989). Dr. Freeman was ultimately responsible for all the work done with the patients. *Id.* In Dr. Weissmann's words, "the buck stop[ped]" with Dr. Freeman. *Id.*

¹⁴ *Weissmann*, 868 F.2d at 1315. Dr. Weissmann admitted that there was "no peer-reviewed paper or abstract" on her curriculum vitae other than those coauthored by Dr. Freeman. *Weissmann*, 684 F. Supp. at 1254.

¹⁵ *Weissmann*, 868 F.2d at 1315. The trial court defined a syllabus as "a review paper providing an overview of the potential and of the current state of the art of specific research being done in the particular field." *Weissmann*, 684 F. Supp. at 1254.

¹⁶ *Weissmann*, 868 F.2d at 1316.

¹⁷ *Id.* P-1 was originally included in a book prepared by the Radiological Society of North America ("RSNA"), which listed Dr. Weissmann as the sole author of the article. *Id.* RSNA later copyrighted the book which contained the article. *Id.*

¹⁸ *Id.* Although Dr. Freeman proceeded with his lecture without the aid of P-1, Dr. Weissmann sought a permanent injunction asking for actual damages and profits, a prohibition against Dr. Freeman's use of P-1, and a declaration that Dr. Freeman had infringed her copyright. *Id.*

After examining the credibility of the parties, Judge Pollack of the United States District Court for the Southern District of New York dismissed Dr. Weissmann's claims, holding that Dr. Freeman was a coauthor of P-1 and was therefore entitled to the same copyright privileges as Dr. Weissmann.¹⁹

The Court of Appeals for the Second Circuit reversed, holding that Dr. Freeman was not a joint author of P-1, and that Dr. Weissmann was the sole owner of a derivative copyright in the new material in P-1.²⁰ Writing for the court, Judge Cardamone posited that in order for a derivative work to be a joint work, each author must have intended to contribute to a joint work at the time of his or her contribution.²¹ Therefore, the fact that P-1 had only Dr. Weissmann's name on it was held to be *prima facie* proof of her intention to make P-1 an individual derivative work and not a further joint work.²² Judge Cardamone also reasoned that since Dr. Freeman did not contribute to P-1, he could not have been a joint author of it.²³ Judge Cardamone concluded that the district court's finding of coauthorship based on Dr. Freeman's contributions to the preexisting works was clearly erroneous.²⁴ After dismissing the district court's findings on witness credibility as immaterial to the issue of P-1's originality,²⁵ the court examined P-1 for the level of originality required of a derivative work copyright.²⁶ Adhering to precedent indicating that only a minimal standard of originality

¹⁹ *Weissmann*, 684 F. Supp. at 1260. Judge Pollack further noted that even if Dr. Freeman had not been a joint author, his use of P-1 was a "fair use" of the article which did not result in copyright infringement. *Id.* at 1261.

²⁰ *See Weissmann*, 868 F.2d at 1327. The *Weissmann* court also held that Dr. Freeman's use of P-1 did not fall within the "fair use" exception to copyright infringement. *Id.* at 1326.

²¹ *See id.* at 1318. Judge Cardamone initially found that since Dr. Freeman did not contribute to P-1, he could not be a coauthor. *Id.* The court stated: "Yet, there is no evidence that they intended their joint product to be forever indivisible like the finite whole of the completed single song . . . The facts point to a contrary conclusion." *Id.* at 1319.

²² *See id.* at 1320. Judge Cardamone apparently ignored the trial court's finding that there was "a practice that, rather than designating the authorship, the by-line name appearing on such review course material was utilized as an identification of the reviewer or lecturer who was to appear before the audience." *Weissmann*, 684 F. Supp. at 1255.

²³ *Weissmann*, 868 F.2d at 1318.

²⁴ *See id.* at 1320.

²⁵ *See id.* at 1322. The court asserted that credibility was "scarcely pertinent to determining whether the newly-added matter satisfies the statutory requirements for protectability . . . [and] the trial judge cannot insulate his findings on originality from appellate review by calling them credibility determinations." *Id.*

²⁶ *See id.*

was necessary,²⁷ Judge Cardamone concluded that the new material²⁸ satisfied this standard and was therefore entitled to copyright protection.²⁹

Although concurring in the decision, Judge Pierce rejected the reasoning underlying Judge Cardamone's conclusion that Dr. Freeman was not a joint author of P-1.³⁰ Judge Pierce contended that a joint author need not contribute to "each incremental addition to the work."³¹ Therefore, had Dr. Weissmann intended the work to be joint, Judge Pierce would have found Dr. Freeman to be a joint author based on his contribution to the preexisting work.³² Judge Pierce would also have considered Dr. Weissmann's incorporation of Dr. Freeman's "false positives" study³³ into P-1 as evidence of Dr. Weissmann's intent to write a joint work when she wrote P-1.³⁴ Judge Pierce concluded, however, that Dr. Freeman did not present enough aggregate evidence to show that Dr. Weissmann's intent was to create a joint work.³⁵

Judge Lumbard dissented "for the reasons stated in Judge Pollack's thorough and reasoned opinion" in the district court.³⁶

²⁷ See *id.* at 1321.

²⁸ The court stated that the new material added by Dr. Weissmann included: (1) a selection and arrangement of photo illustrations and associated captions; (2) references to recent reports in the pertinent literature; (3) selection, condensation, and description of additional source material; (4) several new textual additions; (5) substantial rearrangement of the manner and order of presentation of material contained in the parties' prior joint works; and (6) the addition of a section on "congenital disorders," a revised treatment of "chronic cholecystitis," and the incorporation of Dr. Freeman's "false positive" studies.

Id. at 1322. The district court found that "only four new references were added," and that "[o]nly trivial variations were stated in P-1, adding nothing." *Weissmann v. Freeman*, 684 F. Supp. 1248, 1257 (S.D.N.Y. 1988), *rev'd in part, aff'd in part*, 868 F.2d 1313 (2d Cir. 1989).

²⁹ See *Weissmann*, 868 F.2d at 1323.

³⁰ See *id.* at 1327 (Pierce, J., concurring).

³¹ *Id.* (Pierce, J., concurring).

³² See *id.* (Pierce, J., concurring). Judge Pierce reasoned that Dr. Freeman's lack of contribution to P-1 would have been immaterial if Dr. Weissmann's intent had been to write a joint work. See *id.* (Pierce, J., concurring).

³³ See *id.* at 1328 (Pierce, J., concurring). Dr. Freeman wrote an article in 1983 on reported erroneous results reached using IDA imaging. See *Weissmann v. Freeman*, 684 F. Supp. 1248, 1256 (S.D.N.Y. 1988), *rev'd in part, aff'd in part*, 868 F.2d 1313 (2d Cir. 1989). The article was included verbatim in P-1. *Id.*

³⁴ See *Weissmann*, 868 F.2d at 1328 (Pierce, J., concurring). Judge Pierce argued that "the parties' past willingness to have their works absorbed into the syllabus was relevant to the question of the appellant's intent when she reshaped the syllabus into P-1." *Id.* (Pierce, J., concurring).

³⁵ See *id.* (Pierce, J., concurring).

³⁶ *Id.* (Lumbard, J., dissenting).

It is submitted that the *Weissmann* court properly recognized that to forbid an author from writing a derivative work based upon his own jointly authored original text would make each coauthor a permanent partner of his one-time collaborator. However, because the intent of the derivative author at the time of writing determines whether the work is joint, it is suggested that his credibility is in fact a dispositive factor since his intent will be placed in issue if his coauthor alleges that the new work was created pursuant to an agreement that it would be considered a joint effort. It is further submitted that the proper standard of originality should be a test of substantial originality inasmuch as a lower standard will impede the other joint author's right to produce a derivative work based on the underlying joint work. This Comment will examine the role of a putative derivative author's credibility in an infringement action against his former coauthor, and propose a standard of originality which would be appropriate in such actions.

EVIDENCE OF THE AUTHOR'S CREDIBILITY

The *Weissmann* court stated that the author's intention at the time of writing is determinative as to whether the work is joint or individual.³⁷ Since a joint author may work independently of his coauthor,³⁸ pursuant to an implied agreement to eventually merge the works,³⁹ his intention at the time he undertakes to write the putative derivative work will determine whether or not the work is a further joint work or a copyrightable individual derivative work.⁴⁰ It is suggested that the *Weissmann* court should have con-

³⁷ See *id.* at 1319. The focus is on the author's intent at the time of writing, and not at some later date. See *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944) (L. Hand, J.); *Eckert v. Hurley Chicago Co.*, 638 F. Supp. 699, 702 (N.D. Ill. 1986); M. NIMMER, *supra* note 2, at § 6.03.

³⁸ See *Edward B. Marks*, 140 F.2d at 267; *Eckert*, 638 F. Supp. at 702.

³⁹ See *Ferrer v. Columbia Pictures Corp.*, 149 U.S.P.Q. (BNA) 236, 237 (N.Y. Sup. Ct. Westchester County 1966) (joint author need not have express collaboration agreement with coauthor).

⁴⁰ See H.R. REP. No. 1476, *supra* note 8, at 120. The report stated "[t]he touchstone here is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit." *Id.* In the instant case, the circuit court found that the district court had made no express finding regarding Dr. Weissmann's intent. *Weissmann*, 868 F.2d at 1319. However, the district court stated that P-1 was "a 1985 update of a continually evolving stock piece." *Weissmann v. Freeman*, 684 F. Supp. 1248, 1254 (S.D.N.Y. 1988), *rev'd in part, aff'd in part*, 868 F.2d 1313 (2d Cir. 1989). The district court also stated that "[t]he parties had agreed, at least impliedly if not overtly, that the stock piece could be used as a handout by either of them." *Weissmann*, 684 F. Supp. at 1255-56. It is suggested that

sidered evidence concerning Dr. Weissmann's credibility. To this end, it bears noting that Dr. Weissmann did not file for a certificate of copyright until two years after she wrote the putative derivative work.⁴¹

When an unrelated party applies for a copyright on a work based on prior author's efforts, the work by definition will be derivative because the prior author could not have intended the work to be joint; the requisite intent that the works be eventually merged would have been lacking when the original work was written.⁴² However, when the preexisting work is coauthored pursuant to an implied agreement to merge the authors' works at a subsequent date, it is submitted that the intent of one of the authors to write a derivative work should be a triable issue of fact if the coauthor claims the new work is actually a joint work.⁴³ Thus, the credibility of a joint author claiming derivative status for the new work should play a role in the court's determination of that author's intent.⁴⁴ Accordingly, it is submitted that Dr. Weissmann's credibil-

in finding an implied agreement to make P-1 a joint effort, the district court implicitly found Dr. Weissmann's intent was to contribute to a joint effort when she wrote P-1. If such a finding was warranted, then Judge Pierce would have found them to be joint authors of the work. *See Weissmann*, 868 F.2d at 1327 (Pierce, J., concurring) (each joint author need not contribute to each incremental step if intent is to write a joint work).

⁴¹ *See Weissmann*, 868 F.2d at 1316. It is submitted that had Dr. Weissmann filed for a certificate for P-1 immediately after she completed it, this would have evinced an intent to have written an individual derivative work. However, Dr. Weissmann did not file for the certificate until two years after the work was completed, *id.*, and her intention when she wrote the work is dispositive in this case. *See supra* note 21 and accompanying text.

⁴² *See* 17 U.S.C. § 101 (1982). If the underlying work is copyrightable, the new author and the prior author could not have the requisite statutory intention "that their contributions be merged into inseparable or interdependent parts of a unitary whole." *Id.* The new work, since it is based on "one or more preexisting works," can be a derivative work only if it represents "an original work of authorship." *Id.*

⁴³ In the instant case, the gravamen of Dr. Freeman's defense to the infringement claim was that the work was joint, which would have made him immune from an infringement suit. *See Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429, 430 (S.D.N.Y. 1974) (neither author nor illustrator of children's books could be held liable to other for copyright infringement as each owned an undivided interest in whole); M. NIMMER, *supra* note 2, at § 6.03.

⁴⁴ *See Weissmann*, 684 F. Supp. at 1258. Since the touchstone is the intention at the time the writing is done, it is submitted that the court should have considered the credibility of the authors along with the documentary evidence. If the author's credibility is considered a factor in determining whether the work is derivative or joint, an appellate court could not conduct a *de novo* review of the trial court's finding. *See Apex Oil Co. v. Vanguard Oil & Serv. Co.*, 760 F.2d 417, 424 (2d Cir. 1985) (Oakes, J., concurring); *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1093 (2d Cir. 1977). Federal Rule of Civil Procedure 52(a) states, "[f]indings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses." FED. R. CIV. P. 52(a). In the

ity should have been considered by the court as a factor bearing on her intent to write a joint or derivative work.⁴⁵

A. SUBSTANTIAL LEVEL OF ORIGINALITY AS THE STANDARD FOR DERIVATIVE WORKS BY A JOINT AUTHOR

Assuming a former joint author passes the first hurdle by disproving his coauthor's allegation of an intention to write a joint work, the court still must determine whether the work is sufficiently original to warrant copyright protection as a derivative work.⁴⁶ The *Weissmann* court applied the minimal level of originality test to determine whether the derivative work should be afforded copyright protection.⁴⁷ It is proposed that under the facts of this case the court should have created an exception to its usual standard⁴⁸ and applied the substantial originality test. When a work is being revised on a regular basis, each revision has a measure of originality since it naturally contains some new material.⁴⁹ While the revision may have been done in the ordinary course of business pursuant to an agreement to work jointly on the piece,

instant case, Dr. Weissmann's demeanor was a factor considered by the trial court in reaching its decision. *Weissmann*, 684 F. Supp. at 1258. Since "[t]he demeanor of a witness is always assumed to be in evidence," *The William J. Riddle*, 102 F. Supp. 884, 887 (S.D.N.Y. 1952), *aff'd sub nom. United States v. United States Lines Co.*, 200 F.2d 608 (2d Cir. 1952), it is submitted that the court properly considered Dr. Weissmann's demeanor on the stand. See 3A WIGMORE ON EVIDENCE § 946 (J. Chadborn rev. ed. 1970).

⁴⁵ The trial court found that the instant case was brought for personal reasons by Dr. Weissmann. *Weissmann*, 684 F. Supp. at 1258. The court could properly consider this as a factor affecting Dr. Weissmann's credibility as a witness. See E. CLEARY, MCCORMICK ON EVIDENCE § 40 (3d ed. 1984) ("Partiality, or any acts, relationships or motives reasonably likely to produce it, may be proved to impeach credibility"). Furthermore, Dr. Weissmann had a sexual discrimination suit pending against the hospital at the time she instigated the litigation in this case. See Brief for Appellee at 2, *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989) (Nos. 88-7435, 88-7465). Pending suits may also be considered by the court in assessing witness credibility. See E. CLEARY, *supra*, at § 40; see also *State v. Michelski*, 66 N.D. 760, 772, 268 N.W. 713, 717 (1936) (pending civil suit against defendant may impeach witness in criminal action); *Blake v. State*, 365 S.W.2d 795, 796 (Tex. Crim. App. 1963) (same). It is suggested that such factors should also be considered by the court to aid in ascertaining Dr. Weissmann's intent to write a derivative or joint work.

⁴⁶ See *Weissmann*, 868 F.2d at 1321.

⁴⁷ See *id.* The court stated that "only an unmistakable dash of originality need be demonstrated," *id.*, and cited *Catalda* to support the proposition. See *supra* note 7 (discussion of *Catalda* and its progeny).

⁴⁸ See *supra* note 7.

⁴⁹ See *Weissmann*, 684 F. Supp. at 1257. Despite the fact that "most of everything that has had to be done with this agent [IDA] has become established," the district court still found that four references were added. *Id.* It is suggested that any revision contains something new or original, otherwise there would have been no need to revise the work.

holding a derivative copyright claimant to only a minimal level of originality would enable a joint author to claim, *post hoc*, that the revision was actually a copyrightable derivative work.⁵⁰

However, as the *Weissmann* court properly recognized, joint authors should not be deemed inseparable partners because a joint author may prefer to write a derivative work independently of his former coauthor and copyright its original aspects.⁵¹ It is suggested that the standard of substantial originality is the appropriate copyright test since it would properly enable the joint author to escape the shackles of his prior collaborative effort,⁵² and facilitate the court's role in separating legitimate derivative works from ordinary updates pursuant to a joint authorship agreement.

THE MINIMAL STANDARD IMPEDES A JOINT AUTHOR'S RIGHT TO REVISE THE WORK

It is well established that where two authors write identical works, each work is copyrightable if it is the product of original authorship.⁵³ An author of the underlying work who has not yet

⁵⁰ See 17 U.S.C. § 101 (1982) (revisions may constitute a derivative work). The copyright would extend only to those elements of the derivative work that are original. *Id.*; see *Donald v. Zack Meyer's T.V. Sales & Serv.*, 426 F.2d 1027, 1029 (5th Cir. 1970), *cert. denied*, 400 U.S. 992 (1971); Ellingson, *The Copyright Exception for Derivative Works and the Scope of Utilization*, 56 IND. L.J. 1, 2-3 (1980); Page, *The Works: Distinguishing Derivative Creations Under Copyright*, 5 CARDOZO ARTS & ENT. L.J. 415, 416 (1986).

⁵¹ See *Weissmann*, 868 F.2d at 1319. The *Weissmann* court stated that § 103(b) of the Act gives the author a right to copyright a derivative work as a way of protecting derivative ideas. *Id.*

⁵² See *infra* note 60.

⁵³ See *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1093 n.3 (2d Cir. 1977); *Donald v. Uarco Business Forms*, 478 F.2d 764, 766 (8th Cir. 1973); *M.M. Business Forms Corp. v. Uarco, Inc.*, 472 F.2d 1137, 1139 n.5 (6th Cir. 1973); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951); *Merritt Forbes & Co. v. Newman Inv. Sec., Inc.*, 604 F. Supp. 943, 951 (S.D.N.Y. 1985); *Knickerbocker Toy Co. v. Winterbrook Corp.*, 554 F. Supp. 1309, 1317 (D.N.H. 1982); *Knickerbocker Toy Co. v. Etone Int'l Inc.*, 211 U.S.P.Q. (BNA) 414, 414 (D.N.J. 1980); *Professional Sys. & Supplies, Inc. v. Databank Supplies & Equip. Co.*, 202 U.S.P.Q. (BNA) 693, 696 (W.D. Okla. 1979); *R. Dakin & Co. v. Charles Offset Co.*, 441 F. Supp. 434, 439 (S.D.N.Y. 1977); M. NIMMER, *supra* note 2, at § 2.01. Judge Learned Hand thus summed up the concept of identical original works:

[I]f by some magic a man who had never known it were to compose anew Keat's Ode on a Grecian Urn, he would be an "author," and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's. . . . [this] owner's protection is more limited, for just as he is no less an "author" because others have preceded him, so another who follows him, is not a tort-feasor unless he pirates his work.

Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 54 (2d Cir.), *cert. denied*, 298 U.S.

revised the writing still has the right to prepare a derivative work.⁵⁴ In the event that both authors desire to revise a scientific work, it is suggested that the revisions will, by necessity, resemble each other since they will both reflect the latest advances in the field.

If Dr. Freeman had desired to revise the preexisting work after Dr. Weissmann had already done so, it is likely that his revision ("P-2") would be very similar to P-1.⁵⁵ Dr. Freeman would naturally want to include his report on "false positive" studies in his revision, as Dr. Weissmann had done, and this inclusion would cause P-2 to resemble P-1.⁵⁶ While Dr. Weissmann would have the burden of proving Dr. Freeman copied P-1 in order to prevail on an infringement claim,⁵⁷ she would be able to do so with circumstantial evidence that Dr. Freeman had access to P-1 while he was writing P-2 and that P-2 was substantially similar to P-1.⁵⁸

However, it is submitted that if the substantial standard of originality had been applied, Dr. Weissmann would have been

669 (1936) (citations omitted).

⁵⁴ See 17 U.S.C. § 106 (1982); see also *Weinstein v. University of Ill.*, 811 F.2d 1091, 1095 (7th Cir. 1987) (each owner of copyright may revise work).

⁵⁵ It is asserted that the fact that IDA research had run its course would preclude any dramatic discoveries in a revised work. Nevertheless, since Dr. Weissmann was permitted to copyright a minimally original revision, Dr. Freeman might be liable for copyright infringement if he were to present the same minor news in the same way.

⁵⁶ See *Weissmann*, 684 F. Supp. at 1256. It is submitted that in order to avoid a possible copyright infringement suit, Dr. Freeman might be put in the embarrassing position of having to omit his own article from P-2.

⁵⁷ See *Whelan Assocs., Inc. v. Jaslow Dental Laboratory, Inc.*, 609 F. Supp. 1307, 1321 (E.D. Pa. 1985), *aff'd*, 797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987); *Merritt Forbes*, 604 F. Supp. at 138; *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125, 138 (D.N.J. 1982), *aff'd*, 775 F.2d 70 (3d Cir. 1985), *cert. denied*, 475 U.S. 1047 (1986); *Smith v. Little, Brown & Co.*, 245 F. Supp. 451, 457 (S.D.N.Y. 1965), *aff'd*, 360 F.2d 928 (2d Cir. 1966).

⁵⁸ See, e.g., *Eden Toys, Inc. v. Marshall Field & Co.*, 675 F.2d 498, 500 (2d Cir. 1982) (copying may be established by showing access and substantial similarity); *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977) (copying may be shown by circumstantial evidence of access and similarity); *Novelty Textile Mills v. Joan Fabrics Corp.*, 558 F.2d 1090, 1092 (2d Cir. 1977) (plaintiff may prove copying by showing access to original); *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (trier of fact may infer copying from access to original); *R. Dakin & Co. v. Charles Offset Co.*, 441 F. Supp. 434, 439 (S.D.N.Y. 1977) (plaintiff makes prima facie case by showing access and similarity); see also *Franklin Mint Corp. v. National Wildlife Art Exch. Inc.*, 575 F.2d 62, 64 (3d Cir.) (plaintiff may prove copying by circumstantial evidence if direct evidence is lacking), *cert. denied*, 439 U.S. 880 (1978); *Klitzner Indus., Inc. v. H.K. James & Co.*, 535 F. Supp. 1249, 1254 (E.D. Pa. 1982) (plaintiff need not introduce direct evidence of copying but may prove case circumstantially).

compelled to show that P-1 was significantly different from the preexisting work before becoming entitled to copyright protection. Under this standard, it is unlikely that a "P-2" would accidentally resemble a "P-1," whereas such resemblance could easily arise where only "more than trivial" originality is necessary to copyright "P-1."⁵⁹ It is submitted that had the *Weissmann* court applied the test of substantial originality, Dr. Weissmann would have retained the freedom to prepare her derivative work, while Dr. Freeman's right to prepare his own derivative would have also been protected without placing him at a disadvantage in any ensuing litigation.⁶⁰

CONCLUSION

Each joint author's right to prepare a derivative work based on the underlying work must be protected, and coauthors should not be forced into an unwanted permanent partnership. Since the intent of a coauthor is dispositive in determining whether a new work is a derivative, and thus copyrightable, evidence as to that coauthor's credibility should be examined. The substantial degree of originality test for copyrightability would protect a coauthor's interest in a true derivative work without prejudicing any legitimate claim that the work was actually written pursuant to an agreement that future revisions would be joint works. Further-

⁵⁹ Cf. *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983). Judge Posner, writing for the *Gracen* court, stated "the purpose of the term [original] in copyright law is not to guide aesthetic judgments but to assure a sufficiently gross difference between the underlying and the derivative work to avoid entangling subsequent artists depicting the underlying work in copyright problems." *Id.* It is suggested that a higher standard of originality will facilitate the difficult factual determinations necessary in derivative suits, especially those with facts similar to the case at bar. Cf. Hazen, *Contract Principles as a Guide for Protecting Intellectual Property Rights in Computer Software: The Limits of Copyright Protection, the Evolving Concept of Derivative Works, and the Proper Limits of Licensing Arrangements*, 20 U.C. DAVIS L. REV. 105, 117 (1986) (broad definition of derivative work precludes bright-line test and makes each determination highly factual).

⁶⁰ Cf. *Gracen*, 698 F.2d at 305. The *Gracen* court stated:

The requirement of originality is significant chiefly in connection with derivative works, where if interpreted too liberally it would paradoxically inhibit rather than promote the creation of such works by giving the first creator a considerable power to interfere with the creation of subsequent derivative works from the same underlying work.

Id. Under the *Gracen* rationale, a requirement of substantial originality would allow authors of derivative works to copyright them, while also allowing other authors to create derivative works based on the underlying work. *Id.*

more, the higher level of originality necessary will facilitate the court's task of making factual determinations in such cases.

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