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Interactive Computing: Joint Work Status for User and Programmer

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Birnbaum: Interactive Computing

INTERACTIVE COMPUTING: JOINT WORK STATUS FOR USER AND PROGRAMMER

Both our inventions meet and jump in one.

William Shakespeare¹

INTRODUCTION

Until the United States Supreme Court decided the case of *Feist Publications, Inc. v. Rural Telephone Service Co.*,² the law of copyright pertaining to telephone directories was uncertain. *Feist* resolved the issue of whether the copying of geographical listings from a white pages directory constituted copyright infringement.³ The defendant *Feist*, was a publishing company that distributed telephone directories over a large geographical area.⁴ The plaintiff *Rural*, was a public utility that published an ordinary telephone directory comprised of both white and yellow pages.⁵ While preparing to publish an area-wide directory, *Feist* requested various white pages listings from eleven telephone companies, including *Rural*, and offered to pay each company for the use of its listings.⁶ *Rural* was not interested, and, therefore, declined to assist *Feist*.⁷ Without *Rural*'s listings, *Feist*'s directory would have been incomplete; therefore, *Feist* took the initiative of using *Rural*'s listings without *Rural*'s permission.⁸ This prompted *Rural* to bring

1. WILLIAM SHAKESPEARE, *THE TAMING OF THE SHREW* act 1, sc. 1.

2. 499 U.S. 340 (1991).

3. *Id.* at 344. In addition, *Feist* decided the broader issue of copyright protection for factually based works, in particular, whether the sweat of the brow doctrine was valid. *Id.* at 352-55. The sweat of the brow doctrine afforded a copyright as a reward for hard work associated with the compilation of facts. *Id.* at 352. This doctrine was rejected in *Feist* because "to accord copyright protection on this basis alone distorts basic copyright principles in that it creates a monopoly in public domain materials without the necessary justification of protecting and encouraging the creation of 'writings' by 'authors.'" *Id.* at 354 (citation omitted).

4. *Id.* at 342.

5. *Id.*

6. *Id.* at 343.

7. *Id.*

8. *Id.*

suit for copyright infringement, arguing that “Feist, in compiling its own directory, could not use the information contained in Rural’s white pages.”⁹ Feist replied that the copied listings were not within the scope of copyright protection.¹⁰ The United States Supreme Court held for Feist, on the ground that Rural’s listings were not copyrightable¹¹ because the alphabetical directory of Rural’s white pages lacked the requisite originality under the Copyright Act.¹²

Although this determination demonstrates that an alphabetical listing of factual information, without more, is not copyrightable, *Feist* does not stand for the proposition that a telephone directory can never be copyrightable. For example, it is possible to devise a non-alphabetical white pages directory that could actually receive copyright protection.¹³ It appears, however, that there would be more room for creativity and originality in yellow page listings because of the greater opportunity for creativity in the design and format of the listings.¹⁴

Although *Feist* did not raise this issue, a computer programmer could design a program to be used to create a new and original way to display the yellow pages.¹⁵ In fact, a user may employ the program for this exact purpose, and thus, create a new way to

9. *Id.* at 344.

10. *Id.*

11. *Id.* at 363.

12. *Id.* at 363-64.

13. One may wonder whether this type of directory would be useful since it is difficult to find information in a directory without any alphabetical format.

14. See, e.g., *Bellsouth Advertising and Publishing Corp. v. Donnelley Info. Publishing, Inc.*, 999 F.2d 1436, 1443 (11th Cir. 1993) (criticizing the lower court’s suggestions for arrangement of the yellow pages including “arrang[ing] its headings according to the number of advertisers or to list its subscribers under each heading according to the length of time for which that subscriber appeared under that heading . . .”); *Key Publications, Inc. v. Chinatown Today Publishing Enters.*, 945 F.2d 509, 514 (1991) (“The format of the Key Directory is common to most classified directories Nevertheless, some of the categories are of particular interest to the Chinese-American community and not common to yellow pages . . .”).

15. The yellow pages were chosen as opposed to the white pages for the purposes of this hypothetical because there is greater ability to create new designs, formats, and styles in the yellow pages.

present the yellow pages. This work, which will be referred to as "The Yellow Pages," would likely warrant copyright protection; however, a problem arises as to who would own the copyright. The possibilities include the user, the programmer, or perhaps a joint work¹⁶ shared by both.

This Comment, while by no means limited to this particular hypothetical situation, will discuss the aspects of copyright protection with respect to a work resulting from a great deal of input, directly or indirectly, by a user and a programmer. Part I will explore whether the creator of the computer software or the user of the software should be given exclusive copyright protection. Part II will examine the possibility that a joint work, whereby the user and the programmer share the copyright protection, should be utilized for protection. This Comment will conclude by finding that a joint work is most consistent with case law, statutory provisions, and authoritative opinions.

I. USER AND/OR PROGRAMMER AS AUTHOR

A computer program, like the one which ultimately designed "The Yellow Pages," may have the potential to produce a creative, original way to display the yellow pages of a telephone directory, or some other interactive work. This, however, may arise in one of three ways, each resulting in a different copyright situation.

First, the software may be designed to request only brief inputs and suggestions from the user.¹⁷ For instance, one may create software which selects musical notes randomly after the user depresses a computer key.¹⁸ This series of notes may create an

16. 17 U.S.C. § 101 (1988). "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." *Id.*

17. See, e.g., Michael Feuer, *VLSI Design Automation: An Introduction*, 71 PROC. OF THE IEEE 5 (1983).

18. See UNITED STATES CONGRESS, OFFICE OF TECHNOLOGY ASSESSMENT, INTELLECTUAL PROPERTY RIGHTS IN AN AGE OF ELECTRONICS AND INFORMATION 69-73 (1986) [hereinafter OTA REPORT]. This software, developed by the programmer, selects notes at random from the standard scale and uses these notes as variables in a music composing algorithm. *Id.* at 71. The

original musical piece. The user, however, did not contribute a great deal of original expression to the process. This type of situation suggests that it was the computer, or rather the programmer, who in fact created the resulting form of expression. In *Feist* the Court employed a three part test for determining originality: "(1) the collection and assembly of pre-existing material, facts, or data; (2) the selection, coordination, or arrangement of those materials; and (3) the creation, by virtue of the particular selection, coordination, or arrangement, of an 'original' work of authorship."¹⁹ Applying this test, the user who merely depressed a computer key would fail to satisfy the originality requirements set forth in *Feist*.

Additionally, the contributions made by the user may be considered to be *de minimis*.²⁰ In other words, although the user did contribute keystrokes, in comparison to the created output, this contribution is not sufficiently substantial to warrant copyright protection. It was not this particular user's keystroke that created the melody. *Any* keystroke from *any* user would have produced the same work. Therefore, the user's contributions would probably not satisfy even the minimal creativity standard developed in *Feist*.

Alternatively, the software may be designed to perform its function without extensive, elaborate, or sophisticated input from the user.²¹ For example, artists may use the aid of a computer program to color areas on animation frames.²² This can significantly reduce the amount of time needed to create an

program processes the notes into "pleasing harmonic, rhythmic, and thematic structures." *Id.*

19. *Feist*, 499 U.S. at 357.

20. For a discussion of Professor Nimmer's *de minimis* test, see *infra* notes 113-22 and accompanying text.

21. See Pamela Samuelson, *Allocating Ownership Rights in Computer-Generated Works*, 47 U. PITT. L. REV. 1185, 1200 n.71 (1986). The author sets forth an interesting illustration concluding that her paper is still copyrightable despite the use of a word processing program in writing the paper. *Id.* The word processing program does not add its own originality or expression, so the programmer will not be able to share in the copyright of her paper. *Id.*; see also NATIONAL COMM'N ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS, FINAL REPORT 44 (1979) [hereinafter CONTU REPORT].

22. See CONTU REPORT, *supra* note 21, at 44

animated work.²³ In this type of program, the user has previously drawn and designed animation tracks. When the computer assisted this user, it added certain colors to the tracks which the user had chosen. In this situation, the user's role would sufficiently satisfy the originality requirement to obtain a copyright because the software programmer's contribution would be considered de minimis. In other words, the program was designed to add colors only upon request. The programmer's contributions would not contain the creativity required for copyright protection, and, therefore, only the user would be entitled to copyright protection in the completed work.

Finally, the computer software and the user may work interactively.²⁴ This interaction may require elaborate inputs on the part of the user, while the software would consistently add creative designs to each instruction.

The first two examples illustrate the extremes. The first scenario shows the programmer of the software solely expressing a given idea, while the second demonstrates a situation in which the user is performing all of the expressions of the idea. In both of these circumstances, the other party's role is minimal. It is a long standing proposition in copyright law that an idea itself may not be copyrighted.²⁵ Rather, it is the expression of the idea which may be copyrightable.²⁶ Therefore, in reference to the first two scenarios, even if the other party conceived a brilliant idea, that party would not likely be afforded copyright protection unless some form of original expression was demonstrated.²⁷ In the first situation, it appears that the programmer's software creates virtually all of the expression. As a result, the programmer would probably be the only party to obtain a copyright in the completed

23. See CONTU REPORT, *supra* note 21, at 44.

24. See OTA REPORT, *supra* note 18, at 69.

25. See Copyright Act of 1976, 17 U.S.C. § 102(b) (1993). "In no case does copyright protection for an original work of authorship extend to any idea . . . regardless of the form in which it is described, explained, illustrated, or embodied in such work." *Id.*; *Mazer v. Stein*, 347 U.S. 201 (1954); *Baker v. Selden*, 101 U.S. 99 (1879); *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061 (7th Cir. 1994).

26. See *supra* note 25.

27. See *supra* note 25.

work.²⁸ Conversely, in the second situation, the user of the software is inputting sophisticated data, and in essence, solely performing the act of expression. Here, only the user should be entitled to obtain copyright protection.²⁹

The third scenario, whereby the user works interactively and fairly equivalently with the programmer's software, is the main focus of this paper. For the following reasons, these situations should be viewed as a joint work, and hence, should constitute a copyright for both the user and the programmer.

A. User

It may be suggested that the user of a computer program deserves exclusive copyright protection in the completion of a created work.³⁰ It can be argued that the "user of a generator program will have been the human instrument of fixation of computer-generated output and will have often contributed substantially to the originality of expression in such output"³¹

One commentator provided an argument regarding the user of a program who composed music.³² The commentator suggested that although the program may be able to set forth a series of notes in various selections, only an experienced musical composer would know which selections were better than others.³³ Thus, it is the user who ultimately understands and chooses the piece.³⁴

While this argument does have some merit, it seems that it is still the programmer who produced the music in the first place. After all, a sufficiently experienced and talented user would most likely not have sought the assistance of the program. Therefore, simply

28. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01, at 2-6 (1994) ("[C]opyright protection subsists only in 'original works of authorship.'").

29. *Id.*

30. See Samuelson, *supra* note 21, at 1204.

31. See Samuelson, *supra* note 21, at 1204.

32. See Samuelson, *supra* note 21, at 1204.

33. See Samuelson, *supra* note 21, at 1204.

34. See Samuelson, *supra* note 21, at 1204 ("It may be that an experienced composer must use the program in order to create the quality of music that the programmer had hoped for.").

because the user would have had the final word in determining which notes sounded better together, the sequence of notes may not have existed at all without the help of the program. As a result, the programmer should not be excluded from copyright protection in the completed expression.

It has also been argued that the user is in “the best position to take the initial steps that will bring a work into the marketplace.”³⁵ This argument refers to the incentives and rewards available to those who bring a completed work into the market for public knowledge and use.³⁶ By rewarding the user with copyright protection in the finished work, users will be encouraged to bring their work into the public domain. However, for the same reasons, the programmer should be equally rewarded with copyright protection. The programmer substantially enabled the production of the output, and should be encouraged to continue to create and develop software. A copyright would further this goal by serving as an incentive for both users and programmers by encouraging each of them to bring their work into the marketplace.

Concededly, these arguments are strong reasons why a user should be given a copyright in the work. They fail, however, to explain why the user should be afforded *sole* protection. After all, the programmer of the software is as much a “human instrument” who “contributed substantially to the originality of expression in such output” as the user.³⁷ Without the programmer’s software to assist the user, there might not have been any fixed expression warranting copyright protection in the first place.

While the user may be in the best position, by definition, to make use of the software and “bring a work into the marketplace,” the user is only in this position because of the programmer’s contribution of software. Therefore, a user should be entitled to copyright protection in a work; however, this protection should not be exclusive to the user.

35. See Samuelson, *supra* note 21, at 1227.

36. See Samuelson, *supra* note 21, at 1227 (noting public interest in availability of such works to the public).

37. See Samuelson, *supra* note 21, at 1204.

B. Programmer

It is settled law that computer programs are eligible for copyright protection.³⁸ One who writes a computer program, such as "The Yellow Pages," appears to have some legal claim of copyright on any output produced, since without this program, the generated work would, in all likelihood, not exist. The programmer encoded a set of instructions into a computer, setting forth an accessible means by which to assist a user in the creation of a particular product. As a result, this program may be able to produce various creations for many different users. Therefore, in these situations, the programmer should have a copyright claim on the software.

One critic suggests that a programmer has the option of withholding the software from the public in order to safely protect his or her interests.³⁹ While this may be a valid option, it is altogether impractical. Programmers typically design such software to aid others in creating original work and not to withhold it from the outside world. In fact, the programmer would surely be proud of the software and hope to market it so that many people would be able to utilize it. This critic's suggestion also appears to undermine public policy principles of copyright law, which seek to promote creativity for the public good.⁴⁰

The programmer has a valid interest in a copyright of the finished work, but it is doubtful that the copyright should be limited solely to the programmer. As one commentator states, "[g]ranting all rights to the programmer would mean that the programmer would automatically own everything the program was *capable* of generating. This solution over-rewards the programmer, particularly in light of the fact that the programmer is no more able

38. See *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1249 (3d Cir. 1983) ("[A] computer program, whether object code or source code, is a 'literary work' and is protected from unauthorized copying . . ."), *cert. dismissed*, 464 U.S. 1033 (1984); see also Jeffrey Allen Berkowitz, Comment, 4 TOURO L. REV. 97, 102 (1987) ("[I]t is now settled that computer programs are within the scope of copyright law protection.").

39. See Samuelson, *supra* note 21, at 1207.

40. See, e.g., *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (stating that the objective of copyright law is to "serve the cause of promoting broad public availability of literature, music, and the other arts").

to anticipate the output than anyone else.”⁴¹ An exclusive right to the program and in everything generated by the computer would not be fair, assuming someone else’s input caused the resulting output. While the programmer appears to be a valid candidate to own the copyright, the programmer does not seem solely deserving of the copyright. Therefore, a suggested solution to this dilemma is to establish joint copyright protection for both the user and the programmer.

II. BOTH USER AND PROGRAMMER IN A JOINT WORK

Joint authors of a joint work hold undivided interests in the whole of a given work, regardless of the proportion of their individual contributions.⁴² Therefore, even if one party’s individual contribution is relatively minor, once joint authorship is achieved, the benefits to both authors are significant.⁴³ To reap the benefits of a joint work copyright, both creators must first be established as “authors.”⁴⁴ The United States Supreme Court defined the term author as “the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.”⁴⁵

In determining whether joint authorship exists, courts consider two factors: intent and contribution. First, courts examine whether the parties intended, at the time of creating their work, that their work would be merged with another person’s work.⁴⁶ Second, the courts inquire into the actual contribution of each party.⁴⁷

41. See Samuelson, *supra* note 21, at 1208.

42. 17 U.S.C. § 201(a) (1988). This provision provides in pertinent part: “The authors of a joint work are coowners of copyright in the work.” *Id.*

43. See *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1498 (D.C. Cir. 1988) (stating that absent an agreement to the contrary, profits earned by joint work are shared equally although authors’ contributions to the work are not equal), *aff’d on other grounds*, 490 U.S. 730 (1989).

44. See *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1069 (7th Cir. 1994).

45. *Reid*, 490 U.S. at 737.

46. See generally *infra* notes 48-112 and accompanying text.

47. See generally *infra* notes 113-35 and accompanying text.

A. Intent of Parties

1. Relevant Case Law

One way in which a joint work will arise is when the work has resulted from joint authorship.⁴⁸ Joint authors share the copyright given to their joint work.⁴⁹ To become a joint author, an individual must intend his or her work to eventually be merged with another's work.⁵⁰ Once this intent is duly established, there is no requirement that the joint authors work together in creating their expression. Further, copyright protection may still ensue "even if they are complete strangers to each other."⁵¹ This general proposition remains true so long as each individual speculates that his or her particular work will be combined with another to form a whole.⁵² Additionally, a joint owner of a copyright cannot be liable to a co-owner for copyright infringement.⁵³

An example of this is shown in the case of *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*⁵⁴ In *Marks*, a composer wrote lyrics for a song and sold these lyrics to a song publisher.⁵⁵ This publisher subsequently hired a music composer to produce

48. See 1 NIMMER & NIMMER, *supra* note 28, § 6.01, at 6-3.

49. See 17 U.S.C. § 201(a) (1988). "The authors of a joint work are coowners of copyright in the work." *Id.*

50. See 17 U.S.C. § 101 (1988).

51. See 1 NIMMER & NIMMER, *supra* note 28, § 6.03, at 6-7; see also *Shapiro, Bernstein & Co., v. Jerry Vogel Music Co.*, 161 F.2d 406, 410 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947); *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944); *Words & Data, Inc. v. GTE Common Servs., Inc.*, 765 F. Supp. 570, 575 (W.D. Mo. 1991); *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429 (S.D.N.Y. 1974).

52. See *Weissmann v. Freeman*, 868 F.2d 1313, 1319 (2d Cir.), *cert. denied*, 493 U.S. 883 (1989) ("[A] finding of joint authorship requires that each author intend his or her contribution, at the time that it is created, to become part of a unitary work to which another will make or already has made a contribution.").

53. *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 266 (2d Cir. 1944).

54. *Id.*

55. *Id.*

music for these words.⁵⁶ A copyright was later secured in this musical work, including the lyrics and the music.⁵⁷ The lyric writer and the music composer did not know one another and had not worked together to obtain this finished product.⁵⁸ Each, however, at the time of creating the individual project, intended that each work would be combined with an additional work.⁵⁹

Judge Learned Hand, writing for the United States Court of Appeals for the Second Circuit stated that "it makes no difference whether the authors work in concert, or even whether they know each other; it is enough that they mean their contributions to be complementary in the sense that they are to be embodied in a single work to be performed as such."⁶⁰ Judge Hand explained that although each work could exist separately, if the purpose was to combine the works, then a joint work has been established.⁶¹ Therefore, since the two parties were found to be joint authors, there was no copyright infringement.⁶²

Thirty years later, relying on *Marks*, the United States District Court for the Southern District of New York decided the case of *Donna v. Dodd, Mead & Co.*⁶³ The plaintiff had written the text of

56. *Id.*

57. *Id.* The copyright was secured upon the work as a "musical composition." *Id.*

58. *Id.*

59. *Id.*

60. *Id.* at 267.

61. *Id.* ("[T]heir separate interests will be as inextricably involved, as are the threads out of which they have woven the seamless fabric of the work.").

62. *Id.* at 266. See *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 221 F.2d 569 (2d Cir. 1955). In *Shapiro*, the United States Court of Appeals for the Second Circuit found that since the original author transferred his rights to the music company, the music company's intent was controlling. *Id.* at 570. Thus, even though the original composer had no intention for the music to acquire lyrics, it was sufficient that his assignee had such an intent. *Id.* But see REG. SUPP. REP. 65 (1976). It is important to note that this extension of *Marks* is not accepted by the Copyright Act of 1976. *Id.* The Register Supplement Report states that the definition of "joint work" in 17 U.S.C. § 101 (1988) "carries out the recommendation of the 1961 Report, which took the position that under the present law the courts have broadened the concept of joint authorship beyond its reasonable limits." *Id.*

63. 374 F. Supp. 429 (S.D.N.Y. 1974).

a children's book while the defendant provided illustrative photos for the book.⁶⁴ Thereafter, using virtually the same format of the original book, the defendant and his wife created and published three new books based primarily on the first one.⁶⁵ The plaintiff brought suit against the defendant claiming, among other things, copyright infringement of the original book.⁶⁶ The defendant responded that this was not a valid cause of action because the plaintiff and the defendant were actually joint owners of the copyrighted work.⁶⁷

The court noted that at one time, in order to establish a joint work, it was necessary to find "a common design which existed before the elements of the work were produced."⁶⁸ This requirement, however, has since deteriorated.⁶⁹ Thus, in applying *Marks* and *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*,⁷⁰ the district court in *Donna* found that the original book was in fact a joint work.⁷¹ The defendant may not have had the plaintiff's book in mind when photographing the pictures, however, these pictures were intended from the beginning to be merged with another source and become a joint work.⁷² Based on this reasoning, the court dismissed the plaintiff's claim for copyright infringement.⁷³

64. *Id.*

65. *Id.* at 429-30.

66. *Id.* at 430.

67. *Id.*

68. *Id.* (citing 1 NIMMER & NIMMER, *supra* note 28, § 6.03, at 6-9).

69. *Donna*, 374 F. Supp. at 430. See *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406, 410 (2d Cir. 1946) (stating that just because a composer of music expected one person to write lyrics does not make the song any less a "joint work" when the lyrics are ultimately written by another), *cert. denied*, 331 U.S. 820 (1947); *Marks*, 140 F.2d at 267 (stating that "it makes no difference whether the authors work in concert, or even whether they know each other; it is enough that they mean their contributions to be complementary in the sense that they are to be embodied in a single work to be performed as such").

70. 221 F.2d 569 (2d Cir. 1955).

71. *Donna*, 374 F. Supp. at 430.

72. *Id.*

73. *Id.* at 431.

In *Boggs v. Japp*,⁷⁴ the issue before the United States District Court for the Eastern District of Virginia was whether a writer and an illustrator of a children's cookbook were joint authors.⁷⁵ Although the facts of the case were in dispute, the court determined that the defendant, in preparing a cookbook, asked the plaintiff to illustrate certain pictures and submit handwriting samples.⁷⁶ The defendant, however, decided not to use the plaintiff's illustrations, and used other submissions in their place.⁷⁷ The plaintiff brought suit claiming that she and the defendant were joint authors of the book because she assisted in creating the characters, illustrations, and plot, and that the plot was originally her idea.⁷⁸

The court first explained that the plaintiff was unsuccessful in truthfully setting forth her claims.⁷⁹ Additionally, even if the claims were true, the court found that the plaintiff would still not be considered a joint author.⁸⁰ The plaintiff only had ideas, which are not copyrightable.⁸¹ Moreover, these ideas, according to the evidence presented, were not even used in the book.⁸² The court stated that "[t]here [was] no evidence that the parties ever intended that they be co-authors."⁸³ As a result, the court held that the plaintiff and the defendant were not joint authors.⁸⁴

The United States District Court for the Southern District of Florida found that joint authorship did not exist in the case of *Designer's View, Inc. v. Publix Supermarkets, Inc.*⁸⁵ In this case, plaintiff was in the business of designing and creating stained glass

74. 9 U.S.P.Q.2d 1040 (E.D. Va. 1988).

75. *Id.* at 1041.

76. *Id.* at 1042-43.

77. *Id.* at 1043.

78. *Id.* at 1044.

79. *Id.* at 1043.

80. *Id.* at 1044.

81. *Id.* (citing *Mazer v. Stein*, 347 U.S. 201, 217 (1954)). See 17 U.S.C. § 102(b) (1988). "In no case does copyright protection for an original work of authorship extend to any idea . . . regardless of the form in which it is described, explained, illustrated, or embodied in such work." *Id.*

82. *Boggs*, 9 U.S.P.Q.2d at 1044.

83. *Id.*

84. *Id.* at 1046.

85. 764 F. Supp. 1473, 1477 (S.D. Fla. 1991).

panels.⁸⁶ Defendant discussed with plaintiff the possibility of plaintiff's manufacturing stained glass panels for defendant's store.⁸⁷ Defendant suggested an idea and drew a sketch for plaintiff to use in the process.⁸⁸ The parties agreed on the designs and, soon after, plaintiff's panels were installed.⁸⁹ Plaintiff subsequently applied for and received copyrights for the panels.⁹⁰ Plaintiff and defendant later terminated their employment agreement, and defendant hired a new company essentially to copy plaintiff's panels.⁹¹ Plaintiff then sued defendant for copyright infringement.⁹² As a defense, defendant claimed to be a co-owner of the copyright in the panels due to the sketches and ideas given to the plaintiff.⁹³

The court stated that joint authorship had not been established in the panels.⁹⁴ Specifically, the court noted that "there [was] insufficient evidence to support Defendant['s] contention that the cursory sketch . . . was intended to form an 'inseparable or interdependent' part of the . . . panels or that it constituted anything more than a de minim[i]s contribution."⁹⁵ Additionally, the court did not hear any evidence that the two parties actually collaborated in designing the panels.⁹⁶ Therefore, plaintiff's copyright was valid and defendant had not acquired any rights in it.⁹⁷

86. *Id.* at 1475.

87. *Id.*

88. *Id.*

89. *Id.*

90. *Id.*

91. *Id.* at 1476. Defendant wanted the new company to design panels containing the same subject matter as plaintiff's designs, consisting of the "same medium of painted acrylic on translucent plastic." *Id.*

92. *Id.* The plaintiff subsequently added the new company as a defendant under the same legal theories as those which had been asserted against the original defendant.

93. *Id.* at 1477.

94. *Id.*

95. *Id.*

96. *Id.*

97. *Id.*

2. Intent Analysis

From the foregoing case law, we see very important trends. It is apparent that the intent of the parties at the time of creation may be determinative in a case involving joint authorship. For instance, in the *Marks* case, the court examined the purpose that the creator had in mind while creating the work, and found that if the purpose was to be combined with the work of another, then the intent had been satisfied.⁹⁸ Although this case was decided prior to 1976, the Copyright Act of 1976⁹⁹ clearly stresses the importance of the parties' intent.¹⁰⁰ Since the Act was established, it has been stated that, to form a joint authorship, each author "must intend to contribute to a joint work at the time his or her alleged contribution is made."¹⁰¹

In "The Yellow Pages," the requisite intent would exist for the user as well as for the programmer. The user, most likely, purchased the software with one specific intent in mind - to create an original way to design the yellow pages. In addition, the programmer's original intent was to create a program that would assist a given user in arranging an original format for the yellow pages.

Assuming that such a result is produced, it cannot legitimately be argued that the user did not have the intent to merge her creativity with that of the software. After all, if the user wanted to create an original work, he or she would not have used the software as an aid. Rather, the user would have designed the work alone, without any assistance. The fact that the user voluntarily used the software to help produce a desired result should play a large role in determining the user's intent of joint authorship. Here, the user

98. *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944) (finding joint authorship where parties intended lyrics and music of a song to be "enjoyed and performed together").

99. 17 U.S.C. §§ 101-914 (1988 & Supp. V 1994).

100. 17 U.S.C. § 101 (1988). "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." *Id.* (emphasis added).

101. *See Weissmann v. Freeman*, 868 F.2d 1313, 1318 (2d Cir.) (considering each author's contribution and intent to contribute as criteria when determining joint authorship), *cert. denied*, 493 U.S. 883 (1989).

clearly intended to merge his or her work with the software created by the programmer.

The programmer also possesses the requisite intent for a joint authorship. The programmer encoded a set of instructions with a specific intent in mind - to aid an unknown user, or many users, in designing an original display of the yellow pages. If the programmer was simply seeking to use the program alone, then only the programmer would receive copyright protection, if it was never available for public use. However, the programmer in "The Yellow Pages" actually wrote the program with the intent that it would be released for public use. In other words, the programmer clearly intended the program to be merged with some unforeseen expression of a given user. This intent, therefore, should be controlling.

Many of the cases discussed above are instructive in analyzing the intent of the parties. For instance, in *Marks*, the two authors did not work together, yet joint authorship was found.¹⁰² Likewise, in "The Yellow Pages," the two authors did not work together in producing their completed work. According to the *Marks* court, there is no requirement that the two authors work in concert.¹⁰³ Instead, the *Marks* court noted that intent to create a joint work was necessary, and found this intent in existence since each party at the time of creation, intended his or her own work to be combined with the work of another.¹⁰⁴ Similarly, in *Donna*, the court found joint authorship because at the time certain pictures were taken, they were intended to be combined with another source.¹⁰⁵ Therefore, under the reasoning of *Marks* and *Donna*, "The Yellow Pages" should be considered a joint work, because both the user and the programmer, at the time of creation, intended that his or her

102. *Marks*, 140 F.2d at 267 (finding joint authorship in song where music and lyrics were composed separately).

103. *Id.*

104. *Id.* The court noted that "each [party] knew that his part [of the song] could be used separately; the words as a 'lyric'; the melody as music." However, the court reasoned that this "was not their purpose; the words and the music were to be enjoyed and performed together . . ." *Id.*

105. *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429, 430 (S.D.N.Y. 1974) (stating that although photographs were not taken with specific text in mind, they were intended to become joint work with some text from another source).

creation would be merged with the work of another to produce a unitary whole. Thus, it appears that under both *Marks* and *Donna*, joint authorship in “The Yellow Pages” is clearly established.

The *Boggs* court found that joint authorship did not exist, primarily because the plaintiff had only submitted ideas and nothing more.¹⁰⁶ The court, however, noted that the intent of the parties to become co-authors is the important inquiry.¹⁰⁷ Although there was no evidence to support such intent in *Boggs*,¹⁰⁸ this court would likely find such intent present in “The Yellow Pages.” First, in “The Yellow Pages,” neither party is attempting to obtain a copyright in an idea. Rather, both the user and the programmer have created a fixed, tangible medium of expression. Second, the intent is present because both parties intended that their individual works would later be merged. In addition, each of their works would be meaningless alone.

In *Designer’s View*, the court examined the parties’ intent to establish a joint work, but found that no such intent existed.¹⁰⁹ The defendant merely suggested an idea and submitted a sketch for the plaintiff to use in the work.¹¹⁰ The court found this showing was insufficient to establish the intent needed for joint authorship.¹¹¹ According to the court in *Designer’s View*, the defendant had not proven that his sketch was intended to be merged with plaintiff’s work.¹¹² The *Designer’s View* court would likely find that the intent did exist in “The Yellow Pages” hypothetical. Both parties

106. *Boggs v. Japp*, 9 U.S.P.Q.2d 1040, 1044 (E.D. Va. 1988). See *Baker v. Selden*, 101 U.S. 99, 104-05 (1879) (stating that an idea itself is not copyrightable but expression of the idea is copyrightable).

107. *Boggs*, 9 U.S.P.Q.2d at 1044 (stressing intent to be joint author “since ‘the essence of joint authorship is a joint laboring in furtherance of a preconcerted common design’ . . .”) (citation omitted).

108. *Id.* (finding no evidence of intent to be a co-author where there was no contract or agreement between the parties).

109. *Designer’s View, Inc. v. Publix Supermarkets.*, 764 F. Supp. 1473, 1477 (S.D. Fla. 1991).

110. *Id.*

111. *Id.* (finding “cursory sketch” showed nothing more than “*de minimis*” contribution” to the finished work).

112. *Id.* (finding no co-authorship where sketch was not intended to form an “inseparable or interdependent” part of the complete work).

have enough evidence to show that each intended the individual work to be merged with someone else's unforeseen work. Thus, under *Designer's View* as well, the requisite intent for a joint work would undoubtedly be found in "The Yellow Pages."

B. Contribution of the Parties

1. Professor Nimmer's De Minimis Standard

In his renowned treatise, the late Professor Nimmer¹¹³ stated that in order for joint authorship to ensue, each contribution to the work must be more than de minimis.¹¹⁴ Nimmer defined "de minimis" as "more than a word or a line must be added by one who claims to be a joint author."¹¹⁵ According to Nimmer, if one's contribution is limited to ideas which are incorporated in the resulting work, then this individual should obtain copyright protection.¹¹⁶ Courts, however, have been reluctant to adopt Professor Nimmer's standard.¹¹⁷ In *Erickson v. Trinity Theatre, Inc.*,¹¹⁸ the United States Court of Appeals for the Seventh Circuit stated several reasons why courts are reluctant to follow the standard.¹¹⁹ First of all, the standard is inconsistent with the Copyright Act of 1976 which states that "ideas and concepts standing alone should not

113. Melville B. Nimmer was a Professor of Law at U.C.L.A. The United States Court of Appeals for the Second Circuit has referred to him as "[t]he leading commentator in the field [of copyright law]." *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 705 (2d Cir. 1992).

114. See 1 NIMMER & NIMMER, *supra* note 28, § 6.07.

115. See 1 NIMMER & NIMMER, *supra* note 28, § 6.07.

116. See 1 NIMMER & NIMMER, *supra* note 28, § 6.07.

117. See, e.g., *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1071 (7th Cir. 1994) (requiring a showing that contributions were "independently copyrightable"); *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 521 (9th Cir. 1990) (holding "joint authorship requires each author to make an independently copyrightable contribution"). But see *Community For Creative Non-Violence v. Reid*, 846 F.2d 1485, 1496 (D.C. Cir. 1988) (supporting Nimmer's standard where one qualifies as a joint author even if contribution alone would not be copyrightable).

118. 13 F.3d 1061 (7th Cir. 1994).

119. *Id.* at 1070.

receive protection.”¹²⁰ The Act promotes creativity and therefore, any restriction on an author’s use of suggestions or existing ideas would inhibit creativity.¹²¹ Second, the court found that the concept of contributing an idea expressed in Nimmer’s test is unclear and that the test fails to set forth any helpful guidelines to follow.¹²²

If a court did choose to adopt this standard for authorship, “The Yellow Pages” hypothetical would clearly satisfy this test. Neither contribution is *de minimis*. The programmer wrote a program which is a substantial piece of work. Likewise, the user added certain expressions to the work which would also be considered more than a *de minimis* contribution. Moreover, neither of these contributions is merely an idea, but even if one was, each would still be copyrightable under this standard. Since both contributions are more than *de minimis*, both the user and the programmer would likely be considered “authors.”

2. Professor Goldstein’s Copyrightability Test

According to Professor Goldstein,¹²³ “a contribution will not obtain a co-ownership interest, unless the contribution represents original expression that could stand on its own as the subject matter of copyright.”¹²⁴ Many courts have utilized this rule, in some form, when deciding the issue of joint ownership.¹²⁵ For

120. *Id.*

121. *Id.*

122. *Id.*

123. Professor Paul Goldstein is a Stella W. & Ira S. Lillick Professor at Stanford Law School.

124. 1 PAUL GOLDSTEIN, COPYRIGHT PRINCIPLES, LAW & PRACTICE § 4.2.1.2 (1989).

125. *See Erickson*, 13 F.3d at 1071 (requiring a showing that contributions were “independently copyrightable”); *Childress v. Taylor*, 945 F.2d 500, 507 (2d Cir. 1991) (“It seems more consistent with the spirit of copyright law to oblige all joint authors to make copyrightable contributions, leaving those with non-copyrightable contributions to protect their rights through contract.”); *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 521 (9th Cir. 1990) (holding that “joint authorship requires each author to make an independently copyrightable contribution”); *Meltzer v. Zoller*, 520 F. Supp. 847, 857 (D.N.J. 1981) (holding

example, the *Erickson* court adopted the Goldstein test because it is consistent with the language of the Copyright Act of 1976.¹²⁶ If a court were to apply Goldstein's test, "The Yellow Pages" contributors would certainly meet the authorship standard. Each contributor has created a work, which, standing alone, would be copyrightable.

The Copyright Act of 1976 includes in its definition section the definition of a computer program.¹²⁷ Additionally, under section 102 of the Copyright Act¹²⁸ many courts have found that computer programs are copyrightable subject matter.¹²⁹ For example, in *Apple Computer, Inc. v. Franklin Computer Corp.*,¹³⁰ the court noted that "literary works" need not be restricted to literature, and concluded that a computer program is a literary work which can obtain copyright protection.¹³¹ Therefore, the software alone would be entitled to copyright protection.¹³² The program would likely be deemed "original expression that could stand on its own."¹³³

The user, however, seems to pose a larger problem because if all of the user's expression is merely input into the computer, it is

ideas and sketches were not "fixed expressions of ideas" and therefore, not copyrightable).

126. *Erickson*, 13 F.3d at 1071.

127. 17 U.S.C. § 101 (1988). "A 'computer program' is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result." *Id.*

128. 17 U.S.C. § 102(a) (1988). Section 102(a) provides in pertinent part: "Copyright protection subsists in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device . . ." *Id.*

129. *See, e.g., Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1248 (3d Cir. 1983) (stating that computer programs are copyrightable and are afforded copyright protection); *Wheelan Assocs., Inc. v. Jaslow Dental Lab. Inc.*, 609 F. Supp. 1307, 1320 (E.D. Pa. 1985) (finding a valid copyright in a computer program used in a dental laboratory), *aff'd*, 797 F.2d 1222 (3d Cir. 1986).

130. 714 F.2d 1240 (3d Cir. 1983).

131. *Id.* at 1253-54.

132. *Id.*

133. *See* 1 GOLDSTEIN, *supra* note 124, § 4.2.1.2.

difficult to decipher the fixed tangible expression from that which is not. However, this problem is not unworkable. In order for the program to successfully run, the user must input certain expressions. These expressions, of words or of a language that a computer is able to comprehend, should be independently copyrightable since the user will most likely have to input words to make the software run. These words, including their exact order and sequence, should be entitled to constitute copyright protection.¹³⁴ The user will need to express the words more creatively than, for instance, alphabetical order;¹³⁵ however, very few additional alterations will be necessary to meet the requirements of Goldstein's test.

CONCLUSION

According to case law, statutory interpretations, and commentators, "The Yellow Pages" would constitute a joint work. A court deciding an issue dealing with interactive computing should examine the parties' intent at the time of individual creation of the work, and each party's contribution to the resulting whole. As this Comment suggests, when the intent of the parties demonstrates that an individual work should ultimately merge with the work of another, and the contribution meets the requirements of either Professor Nimmer or Professor Goldstein, then the parties should be afforded copyright protection in the form of a joint work. Thus, both parties would enjoy the protection in a work which they substantially helped to bring into the marketplace.

Michelle Lynn Birnbaum

134. *See, e.g.*, *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 357 (1991).

135. *Id.*

