

The Misapplication of “Mastermind”: A Mutant Species of Work for Hire and the Mystery of Disappearing Copyrights*

Jay Dougherty**

Thank you June and Jane for inviting me and all the staff of the Center for all your help in doing this. And also I feel really honored to be here since Jack Kernochan was my copyright professor. I learned it from him upstairs, so it’s a real pleasure to be bringing it back here to Columbia in his honor.

The title of my talk is “The Misapplication of ‘Mastermind’: A Mutant Species of Work for Hire and the Mystery of Disappearing Copyrights.” Basically, we’re talking about tools for managing complex multi-author works, and the tool that seems to be developing lately in terms of motion pictures, which is a type of complex work, is what the Ninth Circuit tends to call the “mastermind” approach¹ and in the Second Circuit they call the “dominant author.”² I think they’re roughly interchangeable ideas, and I think that the concept is being misused and isn’t necessary. I’m a very experienced motion picture production lawyer and I don’t buy the “Swiss cheese of copyright” argument that Google likes to make and the courts have endorsed, and we’ll get into that a little more as we go along.³

I’m going to skip the authorship basics for the most part and instead I’ll talk a little bit about the history of the idea of mastermind—where does that concept come from, how might it be properly applied, and then how has it been applied in the case of *Aalmuhammed*, *Garcia*, and *Casa Duse*, all in twelve minutes.⁴

* These remarks are adapted from the transcript of a talk that was given on October 2, 2015, at the Kernochan Center Annual Symposium at Columbia Law School.

** Professor of Law; Director, Entertainment & Media Law Institute, Loyola Law School Los Angeles. The author would like to thank Prof. Jane Ginsburg, June Besek, and the staff and students of the Kernochan Center for an innovative program and for the invitation to participate. He would also like to thank Jack Kernochan for his mentorship and friendship, and Rachel Yeong (LLS, 2017) for excellent research assistance.

1. See, e.g., *Aalmuhammed v. Lee*, 202 F.3d 1227, 1235 (9th Cir. 2000) (“Aalmuhammed offered no evidence that he was the ‘inventive or master mind’ of the movie. He was the author of another less widely known documentary about Malcolm X, but was not the master of this one.”).

2. See, e.g., 16 *Casa Duse, LLC v. Merkin*, 791 F.3d 247, 260 (2d Cir. 2015) (“In cases in which none of the multiple-author scenarios specifically identified by the Copyright Act applies, but multiple individuals lay claim to the copyright in a single work, the dispositive inquiry is which of the putative authors is the ‘dominant author.’”).

3. See *Garcia v. Google, Inc.*, 786 F.3d 733, 742 (9th Cir. 2015) (“Garcia’s theory of copyright law would result in the legal morass we warned against in *Aalmuhammed*—splintering a movie into many different ‘works,’ even in the absence of an independent fixation. Simply put, as Google claimed, it ‘make[s] Swiss cheese of copyrights.’”).

4. *Casa Duse*, 791 F.3d at 260; *Garcia v. Google, Inc.*, 786 F.3d 733, 739 (9th Cir. 2015); *Aalmuhammed*, 202 F.3d at 1235.

So I'm skipping some of the basics but I want to start with this concept, which is something I really learned from Jane Ginsburg, which is that you can break down the act of authorship into three components: the initiator (someone who comes up with the idea), the creator (the person that originates the minimally creative expression), and the fixator (who embodies that expression in tangible form). Often those are the same person, but sometimes not, and that's where this concept of "mastermind" comes into play.

The other copyright basic that I'd like to touch on is joint authorship, because that's a fundamental aspect of these complex works. Films are very collaborative and they include many, many types of authorship contributions. Are they a joint work? The definition 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."⁵ Fair enough—it sounds like a film would normally qualify for that. However, the courts have added over the years a bunch of additional requirements, primarily for policy reasons. They're not really found in the statute. Most courts require that each co-author contribute separately copyrightable material and further the putative co-authors have to intend not just to merge their material but to also share authorship, somewhat vague terms. As to films, the Ninth Circuit, as we'll come back to in a moment, applied this "mastermind" idea, that only the mastermind can be a joint work author. Presumably there can be more than one mastermind, or where would the joint work be? What if everyone participates equally and there's no "mastermind"? I think that's a vague, unpredictable standard, and not a workable standard. There are of course other types of rules that can deal with multiple author works.

So where did this idea of "mastermind" come from? It comes from an early English case involving the photograph in the *Nottage* case.⁶ It's a picture of the Australian cricketer team. In 1883, the Queen's Bench was looking at an issue involving that photo. The plaintiffs owned a photography company, and they arranged for one of their photographers to go make that photograph. The plaintiffs, the owners of the company, registered the copyright for the photo and sued an infringer, and the judges had to deal with whether there were problems with that copyright claim. They all agreed that merely having the idea to take the photo of the Cricketers and sending an employee there to take it did not make the employer the author. And one of the justices said: "[I]n my opinion, 'author' involves originating, making, producing, as the inventive or mastermind, the thing which is to be protected, whether it be a drawing, or a painting, or a photograph."⁷ So the actual photographer was the author, not the employer or the person that sent him there. So this deals with the relationship, in a way, between the creator and the fixator. The person that pushed the button on the camera in this case was also the creator. The employer who initiated the project was not.

5. 17 U.S.C. § 101 (defining "work for hire").

6. *Nottage v. Jackson*, 11 Q.B.D. 627 (1883) (U.K.).

7. *Id.*

However, in *this* case, things were slightly different.⁸ This is the immigration of the mastermind concept to the U.S.—that’s a photograph of Oscar Wilde. The *Burrow-Giles* case, which has already been talked about briefly today, is a foundational case about who is the author and whether or not photographs, which were a new technology at the time, could qualify as works of authorship. Many important authorship concepts come from that decision: “he to whom anything owes its origin” is an author under this case;⁹ writings of authors under the Constitution must be “representations of original intellectual conceptions of the author.”¹⁰ Of course, they found that in the case of that posed Oscar Wilde photo, and they cited *Nottage*, which was a somewhat similarly situated case.¹¹ In this case, Sarony did not have his finger on the button on the camera, but he really set up the photograph and created the copyrightable aspects of the photograph as it was viewed at that time. Because the photo was his “intellectual conception,” he was the “mastermind” and the author of material potentially protected by Congress under the Copyright Clause, even though he didn’t personally snap the shutter.

I think that the concept has been properly applied in a case involving a film of the Titanic—that’s the *Lindsay* case.¹² In that case, Lindsay was a documentary filmmaker and he formed a venture to film the Titanic wreck. He was very involved in how that film was going to be shot. He created detailed storyboards, he drew specific camera angles, shooting sequences, and he directed the film, but from up above. He didn’t go down below in a submergible to take the photographs. But he had such a high degree of control over the detailed intensive artistic elements that the film was his original artistic conception, not the camera operator’s.¹³ So the director of the film was the author. They didn’t use the word “mastermind” in that case, but I think that’s an example of how it might be properly used: the person who is actually controlling the origination of expression is the author, as in *Sarony*.

That concept of mastermind subsequently and more recently has been expanded to be an element of the joint work analysis in the *Aalmuhammed* case, which I wrote an article about that is available to you in your materials.¹⁴ In that case, Aalmuhammed contributed what they said was pretty clearly copyrightable stuff to the Malcolm X film, and he sued, claiming to be a co-author of the entire film. The Ninth Circuit had to deal with what does joint authorship require in the context of a film. They could have disposed of the case on already existing judicially-created rules: the lack of intent to share authorship probably would have done it. But they instead said, no, when it comes to a film a co-author has to be the mastermind,

8. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 61 (1884).

9. *Id.* at 57–58.

10. *Id.* at 58.

11. *Id.* at 60.

12. *Lindsay v. Wrecked & Abandoned Vessel R.M.S. Titanic*, 97 Civ. 9248(HB), 1999 WL 816163 (S.D.N.Y. Oct. 12, 1999).

13. *Id.* at *13.

14. F. Jay Dougherty, *Not a Spike Lee Joint? Issues in the Authorship of Motion Pictures under U.S. Copyright Law*, 49 UCLA L. REV. 225 (2001).

someone who controls the making of the film, causes it to come into being, and we don't know who that is, we may never know who that is until the film is done; it might be the producer who raises the money, obviously they're not creating any creative expression as financiers, or the person in whose name the money is raised, maybe the star.¹⁵ I think that unnecessarily expanded and changed the way in which the concept of mastermind was used.

That brings us to *Garcia*, which I'm not going to discuss in any detail. I spoke here at a program earlier this year getting into that.¹⁶ But in this case the "mastermind" concept found its way into determinations of whether someone was an author at all, not necessarily a joint author.¹⁷ You know the background on this case, June just outlined it for you. Miss Garcia was an actor, and the district court rejected her claim. She wanted to get this video off of YouTube because she was getting death threats. She couldn't use right of publicity, although I think my colleague Professor Rothman might be talking a little bit about that later. She couldn't use state claims because of the CDA [the Communications Decency Act],¹⁸ so all she could try to do was to assert a copyright interest. So she asserted that she had a copyright interest not in the film as a whole but in her specific performance to the film. The district court threw her out of court.¹⁹

She appealed to the Ninth Circuit and Judge Kozinski, the chief justice on the Ninth Circuit, led a panel that reversed (with one dissent) that district court decision and found that an actor can in some cases contribute copyrightable work to a film—although it's not really a problem in almost every case because generally in films everyone works for hire.²⁰ Maybe rarely it's a joint work, but even if it isn't, there is a possibility of assignment, and even if there is no assignment then there is an implied license in almost every case, but not one where the actor was defrauded as to what she was agreeing to allow her performance to be used in. So Judge Kozinski enjoined YouTube to take down *Innocence of Muslims*.²¹

This was hugely controversial; pretty much everybody was on Google's side on this, and there was a dissent in that panel. It got appealed up to the Ninth Circuit en banc—I went to the oral argument—and they didn't use the term "mastermind" in that decision, but they reversed the panel decision.²² They said that because an actor isn't normally a joint author, because they are not a mastermind of the film as a whole, then any copyrightable work just disappears, goes away into the film.²³ They said making a valuable and copyrightable contribution is not enough.²⁴ So

15. *Aalmuhammed*, 202 F.3d at 1233.

16. Jay Dougherty, Remarks at the Kernochan Center Spring IP Speaker Series at Columbia Law School: *Garcia and Google: Can An Actor's Performance Support [A Share In] Copyright Ownership?* (Feb. 3, 2015).

17. *Garcia v. Google, Inc.*, 786 F.3d 733, 741 (9th Cir. 2015).

18. 47 U.S.C. § 230

19. *Garcia*, 786 F.3d at 737.

20. *Garcia v. Google, Inc.*, 743 F.3d 1258, 1265 (9th Cir. 2014).

21. *Id.* at 1268.

22. *Garcia v. Google, Inc.*, 766 F.3d 929 (9th Cir. 2014).

23. *Id.* at 933.

24. *See Aalmuhammed*, 202 F.3d at 1232.

they extended this mastermind concept to individual authorship in that case.

That brings us to the Second Circuit, the migration to "mastermind conquers Manhattan," the *Casa Duse* case.²⁵ So you would think a director is an author of a film, right? Here is a description of the director's role from the Director's Guild: "The Director's professional function is unique, and requires his or her participation in all creative phases of the film making process The Director's function is to contribute to all of the creative elements of a film and to participate in molding and integrating them into one cohesive dramatic and aesthetic whole."²⁶ Sounds like an author to me. In fact, the European Community requires that their members have the director as one of the authors of a film.²⁷

The district court below found that the director was not an author of the film in this case, and they said: "When the Second Circuit finds that there is no mutual intent to be co-authors, it holds that whoever was the 'dominant' author is the sole author."²⁸ It cited a bunch of co-authorship cases rather than any individual authorship case because this was a case of first impression to the Second Circuit. Earlier this year, the Second Circuit dealt with the question: "May a contributor of a creative work whose contributions are inseparable from, and integrated into, the work maintain a copyright interest in his or his contributions alone?"²⁹ They found the answer to be no. Everybody agreed it wasn't a joint work and it wasn't a work made for hire.³⁰

There were two parts of this opinion. One was as to the film as a whole, the other was to this raw footage that the director had shot. The court said that as to the film as a whole there is no copyright at all in a non-freestanding contribution—the copyright disappeared.³¹ Their reasoning wasn't very persuasive to me, but they in part cited the Copyright Office's position on the *Garcia* case, the actor case.³² They also endorsed the policy arguments made by Google and endorsed by the Ninth Circuit en banc court.³³ The reasoning is that potentially separate copyright claims would lead to a "morass" of claims "making Swiss cheese of copyrights."³⁴

Frankly, as I said, there are tons of copyrightable pieces of material that are included in any film, and we are quite used to clearing things and getting it done. In this case, this producer should have told the director he couldn't shoot the film unless he signed a little simple piece of paper saying it was a work made for hire,

25. *Casa Duse*, 791 F.3d 247.

26. Directors Guild of America, Basic Agreement, § 7-101 (1990), <http://www.dga.org/Contracts/Creative-Rights/Basic-Agreement-Article-7.aspx> [<https://perma.cc/X6R3-BPXJ>].

27. See, e.g., Council Directive 93/98, P 2, 1993 O.J. (L 290) 9 (EC) ("The principal director of a cinematographic or audiovisual work shall be considered as its author or one of its authors. Member States shall be free to designate other co-authors.").

28. 16 *Casa Duse, LLC v. Merkin*, No. 12 Civ. 3492(RJS), 2013 WL 5510770, at *9 (S.D.N.Y. Sept. 27, 2013).

29. *Casa Duse*, 791 F.3d at 254.

30. *Id.* at 255–56.

31. *Id.* at 257.

32. *Id.* at 258.

33. *Id.*

34. *Id.*

which he is allowed to do.

The court said that originality and fixation are not sufficient for copyright!³⁵ The raw footage was copyrightable, but they said that if multiple authors that contribute to this work don't qualify as one of the multiple-author work categories then the "dispositive inquiry" is who is the "dominant author"?³⁶ In other words, who is the mastermind?³⁷ And they worked that back into this case by saying that, regarding the intent to share authorship prong in connection with joint work authorship disputes, the facts that they look for include the decision-making authority, the billing credit, and agreements with outsiders.³⁸ They applied those facts here to determine who is the "dominant author." The director exercised a significant degree of control over his footage, obviously, but Duse had more, according to the court. They shared credit, but Duse organized the production, made agreement with third parties, and therefore they found Duse was the dominant author and basically Merkin had nothing.³⁹

So where does that leave us? First of all, most of my clients are producers, so this is great for us. It makes it nice and easy. I don't really have to deal with paperwork anymore it looks like—at least for anything that didn't previously exist before the film separately. I don't have to worry about work for hire agreements, et cetera. I think this is outcome-oriented jurisprudence that ignores core copyright concepts, and when someone commissions a creative contribution to a larger work, the mastermind concept creates what I call a mutant species of work for hire, basically based on the right to control test that the Supreme Court rejected in the *CCN* case.⁴⁰ This undermines the careful balance that Congress struck in the 1976 Act in dealing with what kinds of commissioned works could be works made for hire. Thank you.

35. *Id.*

36. *Id.* at 260.

37. *Id.*

38. *Id.*

39. *Id.* at 261.

40. *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 741 (1989).