



published: Journal of Intellectual Property Law and Practice, November 1, 2009

Joint Authorship of Doo-Wop Song Found Based on Disputed 10 per cent Contribution to Lyrics

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Janky v Lake County Convention and Visitors Bureau, Nos 07-2350, 07-2762, and 08-1606, 576 F.3d 356 US Court of Appeals for the Seventh Circuit, 3 August 2009

Abstract

Joint ownership of copyright was found where an author's contributions to a song contributed to its commercial viability.

Legal context

Under US copyright law, '[t]he authors of a joint work are coowners of copyright in the work' (17 USC § 201(a)). Thus, as long as each contribution rises to the level of authorship, each joint owner holds an undivided interest in the joint work regardless of the quality or quantity of their respective contribution, and can each authorize others to use the work. However, the US law, at least in the Seventh Circuit where this case was decided, recognizes that not every comment or suggestion rises to the level of authorship. *Janky v Lake County Convention and Visitors Bureau*, 576 F.3d 356 (7th Cir. 2009) clarifies (in an entertaining opinion) the Seventh Circuit's view as to what type of contribution is necessary for someone to be considered an author in a joint work. This case highlights the perils of filing a copyright application containing information which is later contended to be inaccurate and based on a misunderstanding of the legal implications of such information.

Facts

In the late 1990s, the Lake County Convention and Visitors Bureau for Lake County, Indiana, located southeast of Chicago, Illinois, was interested in commissioning a tune 'singing the county's praises' (576 F.3d at 358).

Cheryl Janky, a member of 'Stormy Weather', an Indiana-based doo-wop group, took up the challenge after Henry Farag, another member of Stormy Weather told the band about the opportunity, suggesting that the band might want to give it a shot. In 1999, Janky wrote the music and lyrics for a tune she called 'Wonders of Indiana' (a.k.a. 'Indiana'). When the song was completed in May 1999, Janky filed a copyright application in which she listed herself as the sole author.

Thereafter, Janky showed the song to Henry Farag. At this point, the issue of collaboration began. As the Seventh Circuit explained:

Although Farag thought it had potential, he recommended revising the lyrics to better suit the Bureau's vision. Pursuant to a conversation with the Bureau's chief executive officer, Farag suggested that the song needed to focus more on Lake County in particular, as opposed to Indiana in general, and include references to the area as

‘Chicago’s neighboring south shore’ and to its ethnic diversity. Janky testified that Farag’s recommendations, which she adopted, accounted for 10 percent of the lyrical content (576 F.3d at 359–60).

In December 1999, Janky filed a second copyright application for the revamped song, listing Farag as a co-author who provided ‘additional lyrics’ and characterizing the effort as a ‘joint work’. She also filed a similar document with the American Society of Composers, Authors and Publishers (ASCAP) stating that Farag held a 10 per cent ‘ownership share’.

The ‘revamped’ song was recorded by Janky, Farag, and the rest of Stormy Weather, into a demo, and then a music video, which was ultimately adopted and used by the Bureau, and is the subject of the present copyright dispute.

Farag issued a non-exclusive licence to the Bureau to use the video and song in return for the cost of production. The band had apparently decided that the publicity (rather than a royalty) would be sufficient payment for use of the song. On 1 December 1999, the Bureau made first use of the song at the same time it opened a new visitor’s centre. It played the music video and sponsored a live performance. In June 2000, Stormy Weather completed production of the song and included it on an album called ‘Doo-It Doo-Wop’. The Bureau purchased 1500 copies of the album, reselling it at the visitor’s centre. The Bureau also made other use of the song.

Janky later alleged that ‘she composed the song and never gave the Bureau permission to use it’ (576 F.3d at 358). Janky ‘testified that she placed Farag’s name on the registration form “as an indication of [her] gratitude ... and to demonstrate that [she] appreciated every little bit of support.” She said she now realizes that the proper way to acknowledge a “de minimis” contribution is by making a notation on the album cover’ (id at 360). In contrast, Farag maintained that ‘the lyrical changes were “significant,” and revisions were also made to the melody’ (id).

Presumably, in recognition of the ‘mistake’ Janky now claims she made in the December 1999 copyright application, on 15 July 2003, she filed a third copyright application for the ‘revamped song’ to correct her ‘mistake’. This third application instead listed herself as the sole author of the music, lyrics, and ‘arrangement performance’. According to Janky, ‘Farag’s license to the Bureau was without effect and the latter’s use of the song illegal’ (576 F.3d at 361). She notified the Bureau that she was the exclusive owner, but the Bureau continued using the tune until Janky commenced the present lawsuit in October 2003. In what the Seventh Circuit characterized as an ‘over-litigated’ case, with ‘unfocused’ appellate briefing, the US district court ultimately awarded partial summary judgment in favour of Janky on the grounds that Janky was the sole owner of the copyright to the tune at issue, based on its findings that Janky and Farag ‘didn’t intend to be co-authors at the time of creation’ and Farag’s contributions were ‘nothing more than “minimal revisions” of a song Janky already composed’ (id. at 358, 361). A jury awarded Janky \$100,000 in damages for the Bureau’s copyright infringement, and the present appeal ensued.

Analysis

The Seventh Circuit provides an entertaining and informative explanation of the criteria to be used in that Circuit for determining whether someone is an author in a ‘joint work’. While the Seventh Circuit also discussed other issues, the present analysis focuses on the main issue on appeal: was Janky the sole author of the copyright work, or was Farag co-author of a ‘joint work’.

Section 101 of the US Copyright Act defines 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 USC § 101. The Seventh Circuit law on co-authors provides that ‘[i]n general, individuals are co-authors of a work only where they (1) intend to create a joint work; and (2) contribute independently copyrightable material’ (citing *Erickson v Trinity Theatre, Inc.*, 13 F.3d 1061, 1068, 1071 (7th Cir. 1994) 576 F.3d at 361).

The Seventh Circuit determines ‘intent’ based on the collaborators’ intent to ‘work together in the creation of a single product’, rather than on whether the collaborators intend to ‘recognize each other as coauthors for purposes of copyright law’ (citing *Erickson*, 13 F.3d at 1068–1069; 576 F.3d at 362). This intent may be evidenced by ‘billing’ or ‘credit’. (citing *Erickson*, 13 F.3d at 1072).

In adopting the ‘independently copyrightable material’ prong of the Seventh Circuit test, the Circuit explicitly rejected a ‘de minimis’ test, as proposed by Professor Nimmer in his treatise, which requires merely ‘more than a de minimis contribution by each author’. Thus, when a putative author contributes merely ‘(i)deas, refinements, and suggestions’, such a contribution is not enough to make the author a joint author under Seventh Circuit jurisprudence (citing *Erickson*, 13 F.3d at 1070; *ibid*).

While the Seventh Circuit has carved out as an exception to the ‘independent copyrightability’ requirement, those works where none of the parts could pass the test of copyrightability due to ‘the nature of the particular creative process’, such as the creation of a comic book, which requires a writer, a penciler, an inker, and a colourist, to form such a work (discussing *Gaiman v McFarlane*, 360 F.3d 644, 658–659; 576 F.3d at 362 n.41 (7th Cir. 2004)), that exception was found to not apply in the present case since Janky was capable of submitting and obtaining, and did actually obtain, a copyright to the original version of the tune, before she ever spoke with Farag about the details of the work.

In its analysis, the Seventh Circuit determined that Janky and Farag intended to create a joint work, despite Janky’s post hoc protestations to the contrary, considering Janky’s initial acknowledgment of Farag’s contribution as a co-author, combined with the ‘considerable control’ that Farag wielded over ‘what the song finally looked like’ (576 F.3d at 362). The Seventh Circuit declined to find that Janky’s affidavit to the contrary was sufficient to create a material fact in dispute on this point.

Likewise on the second prong of the test, the Seventh Circuit found, as a matter of law, that Farag’s contributions went beyond general ‘(i)deas, refinements, and suggestions.’:

They were concrete expressions and thus pass the test of copyrightability where mere ideas fail. *Gaiman*, 360 F.3d at 658. In addition, while Farag’s changes may have accounted for only 10 percent of the lyrics, they were significant. They were important not only to the final sound, but also to its commercial viability. Before Farag became involved, the song celebrated the charm of Indiana as a state; Farag shifted the focus to Lake County. Without Farag’s input, it is unlikely that the Bureau would have embraced the song the way it did (576 F.3d at 363).

Thus, the Seventh Circuit weighed the importance of the comments as more important than their volume in determining separate copyrightability, and concluded that the Bureau, rather than Janky, was entitled to summary judgment.

Despite this finding, the Seventh Circuit did, however, recognize that this was a ‘close case’ and cautioned:

We have observed in the past that published creations are almost always collaborative efforts to some degree—peers make suggestions, editors tweak words, and so forth. *See id.* at 658. Were we to deem every person who had a hand in the process a co-author, ‘copyright would explode.’ *Id.* On the other hand, the very purpose of copyright law is to promote the progress of the arts and sciences, U.S. CONST. art. I, § 8, cl. 8; *Wildlife Express Corp. v Carol Wright Sales, Inc.*, 18 F.3d 502, 507 (7th Cir. 1994), a purpose that is defeated if important contributions are denied copyright protection. Placing a contribution in one hopper or the other is not always an easy task, and the judge here made a commendable effort. In the end, though, this doo-wop ditty is a joint work.

Circuit Judge Ripple dissented from the majority opinion to the extent the majority granted summary judgment in favour of the Bureau. While Judge Ripple agreed that summary judgment in favour of Janky was improperly granted by the district court, he would have found that the case should be remanded for further consideration since the record was insufficient to establish:

1. whether Farag had an intent to become a joint author; and
2. whether Farag's contributions were sufficient to establish separate copyrightability.

Practical Significance

Copyright applications in the USA are deceptively simple forms that many authors believe are easy to fill out. While the questions seem straightforward, the answers are not always so. The failure to appreciate in the first instance the legal implications of the information provided can lead to unintended results. This case serves as a sober reminder to authors of the importance of making sure to consider carefully the respective roles of each participant in the creation of the work, and to record properly those roles in the first instance in their copyright applications, to avoid later disputes over respective rights. Consultation with copyright counsel is strongly recommended.

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