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U.S. Copyright Office  
101 Independence Ave. S.E.  
Washington, D.C. 20559-6000

Re: Gap in Termination Provisions

Dear Copyright Office

I am writing on behalf of the heirs of Maurice Richlin, co-author of the original story for the film *The Pink Panther*.

A recent Ninth Circuit decision against the Richlin heirs (*Richlin v. Metro-Goldwyn-Mayer Pictures, Inc.*, 531 F.3d 962 (9th Cir 2008), already highly criticized in 1-4 *Nimmer on Copyright* § 4.12[B][4] (attached)) has opened a large “black hole” in the protections afforded under the Copyright Act for authors of pre-1978 works and their heirs. We are turning to you with the hope that you can create a legislative fix.

The problem is as follows: under the old copyright law, from colonial times until the 1976 Copyright Act (effective 1978), there were two separate copyright terms. This allowed an author, or his heirs, to profit further from a work that had succeeded in the first copyright term. If the author died during the first term, the right to the renewal period fell to his heirs. See *Stewart v. Abend* (1990), 495 U.S. 207 (heirs of author had renewal term rights for story used for the film *Rear Window*).

Under the 1976 Act, the rule changed somewhat. The new act still provided for renewals of works copyrighted prior to 1978 (17 U.S.C. ¶ 304(a), and also termination of renewal term transfers for works copyrighted before 1978 (17 U.S.C. § 304(c)). It also provided for terminations of transfers made after January 1, 1978 (17 U.S.C. §203). The problem is, **the 1976 Act doesn't say what to do about works authored and transferred prior to 1978, but not yet separately copyrighted prior to 1978.** This is the problem with *The Pink Panther*, and presumably many other literary and musical works.<sup>1</sup>

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<sup>1</sup> Nimmer's new comment warns that the ruling in *Richlin* “represents an upheaval that carries terrible policy implications. Consider the entire music industry. . . . The logic of that decision may frustrate the interests of all those successors to the rights of composers.” 1-4 *Nimmer on Copyright* § 4.12[B][4], page 9.

Maurice Richlin independently authored the *The Pink Panther* story (with Blake Edwards) and then assigned the written story in 1962 to the producer of the film (for which Richlin and Edwards then worked for hire as authors of the script). Although the film was published with a copyright notice, the Ninth Circuit held that the underlying story authored independently by Richlin and Edwards had never been subject to a statutory copyright, because it had never been separately published or registered. Therefore, the Court concluded that Richlin's heirs held no renewal term rights in the story, even though Richlin had died during the first term of the film's copyright.

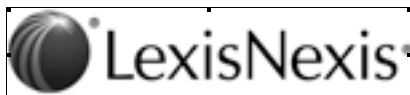
Sadly, under 17 U.S.C. §203 and § 304(c), it appears that the Richlin heirs also have no right to terminate the transfer of the copyright, because the assignment was prior to 1978 and the work was (according to the Ninth Circuit) not subject to statutory copyright until 1978. So the heirs are in an unforeseen limbo between the 1909 and 1976 acts, neither protected by the renewal provisions of the 1909 act, nor the termination provisions of the 1976 act. The Richlin heirs, unlike all other heirs from colonial times to the present, have not been entitled to reap the rewards of the author's great success with *The Pink Panther*. No doubt, if the decision is left to stand, many other authors and their heirs will be similarly disenfranchised.

Naturally I disagree strongly with the Ninth Circuit's decision (and am comforted somewhat that Prof. Nimmer agrees that the decision was wrong), but I believe that the resulting rule in the case should not be allowed to fester uncorrected. It deserves a legislative fix. Congress could not have possibly intended to treat the authors of assigned, but (as of 1978) unpublished, works differently from all other authors living either before or since. Those authors and their heirs deserve the same rights to a renewal period or a termination of transfer of copyright. I hope you can help fix this problem.

I look forward to speaking with your staff further. Further information about the *Richlin* case, including all briefs, can be found at <http://www.bslaw.com/richlin/>

Very truly yours,

E. Randol Schoenberg



5 of 10 DOCUMENTS

Nimmer on Copyright

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CHAPTER 4 Publication

1-4 Nimmer on Copyright § 4.12

#### **§ 4.12 Publication of Derivative Works**

The nature and extent of protectability of derivative works are discussed in another chapter.<sup>n1</sup> This section deals with the issue of whether the publication of a derivative work (*e.g.*, a motion picture) constitutes a publication of the pre-existing work (be it a book, screenplay or other work) upon which the derivative work is based.

##### **[A] The General Rule: Publication of a Derivative Work Constitutes Publication of the Basic Work**

Although neither the current Copyright Act nor its predecessor statutes directly address the issue,<sup>n2</sup> and there is surprisingly little case authority on the question, it would seem that any authorized publication of a derivative work must necessarily also constitute a publication of the pre-existing work upon which it is based.<sup>n3</sup> Because a derivative work by definition to some extent incorporates a copy of the pre-existing work,<sup>n4</sup> publication of the former necessarily constitutes publication of the copied portion of the latter.<sup>n5</sup> Of course, an article that merely describes a pre-existing work but does not incorporate any substantial portion of it is not a derivative work and hence, does not publish the pre-existing work.<sup>n6</sup> Unless the basic work is reproduced (either in original or derivative form) in the published work, it is not published.<sup>n7</sup> If only the broad outlines or other fragmentary portion of the pre-existing work are copied and published in the derivative work, then only to that extent is the pre-existing work published.<sup>n8</sup> The rule that a publication of a derivative work constitutes a publication of the pre-existing work is seen most clearly when the derivative work and the pre-existing work are published in the same medium. Thus, publication of a new or revised edition of a book will likewise constitute a publication of that portion of the earlier book that is incorporated in the new edition.<sup>n9</sup> Therefore, failure to affix a proper copyright notice on the new edition will inject into the public domain such portion of the earlier book as well as the entire new edition.<sup>n10</sup>

The copyright in the pre-existing (or underlying) work is vitiated only if publication itself causes that result. As we have just seen, publication with invalid notice furnishes one example of that phenomenon; publication followed by maximum length of time for copyright to subsist would be another.<sup>n11</sup> Thus, if the new edition (or derivative work) is injected into the public domain for some

## 1-4 Nimmer on Copyright § 4.12

reason other than publication, then the copyright in the underlying work remains unaffected. Works can become forfeit, for example, for reasons as diverse as failure to comply with the manufacturing clauses<sup>12</sup> or *ad interim* requirements of the 1909 Act<sup>13</sup> applicable to the derivative work but not to the underlying work,<sup>14</sup> or failure to renew the copyright in the derivative work.<sup>15</sup> In those circumstances, it is not the act of publication that injects the derivative work into the public domain.<sup>16</sup> Therefore, it is perfectly consistent with the rule that publication of a derivative work constitutes publication of the underlying work embodied therein to maintain that the copyright in the underlying work remains valid in those circumstances.

Is the rule that publication of a derivative work also constitutes publication of the pre-existing work contained therein equally applicable when the pre-existing work is produced in one medium and the derivative work in another? On principle, the answer should be "yes," inasmuch as a pre-existing work is no less copied and published if the derivative work is in a different medium. This conclusion is implicit in the cases that hold that publication of a magazine with improper copyright notice constitutes a divestive publication in a painting<sup>17</sup> or book<sup>18</sup> reproduced in the magazine. Likewise, the phonograph record cases discussed above<sup>19</sup> indicate that publication of a derivative recording equally constitutes publication of the pre-existing musical work that is subject to the recording. The Ninth Circuit held, albeit in a case not involving the issue of publication, that the exhibition of a film "necessarily involves exhibition of parts" of the play upon which the film is based.<sup>20</sup> Without deciding the question, the Second Circuit suggested that "once the scriptwriter obtains the economic benefit of the recording and the broadcast, he has obtained all that his common law copyright was intended to secure for him; thus, it would not be unfair to find that publication of the derivative work divested the [underlying] script of its common law protection."<sup>21</sup> In a somewhat strained application of this principle, the First Circuit held that publication of cards imprinted with a photograph of the plaintiff dressed as a character he created (also containing the character's name, slogan, and symbol) constituted a divesting publication of common law rights in the character *per se*.<sup>22</sup>

**[B] Retreat From and Ultimate Vindication of the General Rule**

**[1] The Early Cases.**

Despite the above considerations,<sup>23</sup> the few cases to expressly discuss the matter created doubt about applicability of the general rule. This subsection discusses those authorities. Moreover, Skone James takes the position under English copyright law that publication of a derivative work does not constitute publication of the basic work.<sup>24</sup> Likewise, Bogsch suggests this same distinction under the Universal Copyright Convention.<sup>25</sup> Whatever the merit of that position in the English and U.C.C. context, it is submitted that such a conclusion is incorrect under the United States Copyright Act. The subsection that follows cements that conclusion.<sup>26</sup>

Turning to the few cases just mentioned, we begin in 1916. In *O'Neill v. General Film Co.* <sup>27</sup> the court held that insofar as *The Count of Monte Cristo* play was included in the authorized and copyrighted motion picture of the same name, to that extent the play was published and common law motion picture rights in the play were lost. This conclusion is consistent with the above analysis except insofar as it limits divestment to motion picture rights rather than all rights. If divestment of common law rights occurred prior to the current Act by reason of publication, it occurred with respect to all media--not merely as to the particular medium in which publication occurred.

## 1-4 Nimmer on Copyright § 4.12

*De Mille Co. v. Casey*,<sup>n28</sup> another case expressly confronting this issue, held that publication of a motion picture did not constitute publication or forfeiture of common law rights in the play upon which the motion picture was based. The court relied heavily upon its conclusion that the owner of the play did not intend a dedication by publication. Yet, as explicated in a subsequent section,<sup>n29</sup> divestive publication does not require an intent to dedicate.

One line of cases suggests that the publication of a photograph of an object does not constitute a publication of the object itself. For instance, in *Rushton v. Vitale*,<sup>n30</sup> the court held that published photographs of the copyrighted work that were devoid of notice did not divest the work itself of copyright protection, as long as the work as sold bore a proper notice. *Rushton* reached this conclusion in erroneous reliance upon a prior case, which quite properly ruled as to the reverse situation, *i.e.*, a copyright in a reproduction of a work of art bearing a proper copyright notice will not be invalid merely because the underlying work of art of which it is a reproduction is itself in the public domain.<sup>n31</sup> Nonetheless, *Rushton* is defensible as a limited publication given that the distribution therein was made to members of the trade.<sup>n32</sup> Another court held that plaintiff's copyright in a fabric design was not lost notwithstanding the publication in a national magazine of photographs of dresses containing such design, although no copyright notice could be seen in such photographs.<sup>n33</sup> The court reasoned that because the plaintiff had sold the fabric from which the dresses were made, plaintiff could no longer control the uses to which such fabric might be put, including the publication of photographs thereof.<sup>n34</sup> It might well be argued to the contrary that sale of the tangible object--the fabric upon which the designs appeared--did not convey to the purchaser the right to make reproductions thereof<sup>n35</sup> and hence, the plaintiff did have the right to control the magazine reproductions, and in fact the plaintiff apparently did consent to such reproductions. Still, the result in this case can probably be defended on the grounds that the magazine's blanket copyright notice served to protect the photographs and the underlying work contained therein.<sup>n36</sup> The conclusion, at least of the foregoing line of cases, is that "publishing two-dimensional pictures does not constitute a divesting publication of three-dimensional objects."<sup>n37</sup> And under any view, if published photographs of a three-dimensional work do not reproduce the copyrightable elements contained in such work, the photographs do not constitute "copies" of the work, and hence, no notice pertaining to the work need appear on the photographs.<sup>n38</sup>

At least one case, *Grove Press, Inc. v. Greenleaf Publishing Co.*,<sup>n39</sup> expressly recognized that publication of a derivative work necessarily constitutes publication of the pre-existing work upon which it is based. But the court apparently reached that result for the purpose of holding that an *infringing* act of publication occurs even if the allegedly infringed work is published only within the context of an otherwise unprotected derivative work.<sup>n40</sup>

In *Classic Film Museum, Inc. v. Warner Bros., Inc.*<sup>n41</sup> the court expressly declined to decide "the still unsettled question of the public dedicatory effect, if any, of the distribution of a motion picture film on common-law copyrights in the materials on which the film is based."<sup>n42</sup> The court nevertheless reached a result consistent<sup>n43</sup> with the conclusion that there is such a dedicatory effect, *i.e.*, that publication of a derivative work does constitute publication of the pre-existing work contained therein.<sup>n44</sup>

[2] **Abend.** In *Stewart v. Abend*,<sup>n45</sup> the Supreme Court majority refuted a proposition advanced by the dissent with the following observations:

## 1-4 Nimmer on Copyright § 4.12

Second, the dissent attempts to undercut the plain meaning of § 7 by looking to its legislative history and the substitution of the term "publication" for "copyright" in the force or validity clause. According to the dissent, that particular alteration in the proposed bill "made clear that it was the publication of the derivative work, not the copyright itself, that was not to 'affect the force or validity of any subsisting copyright.'" Post, at 249. Under the 1909 Act, it was necessary to publish the work with proper notice to obtain copyright. Publication of a work without proper notice automatically sent a work into the public domain. See generally 2 Nimmer § 7.02[C][1]; 17 U.S.C. § 10 (1976 ed.). The language change was suggested only to ensure that the publication of a "new compiled work" without proper notice, including smaller portions that had not been previously published and separately copyrighted, would not result in those sections moving into the public domain. See Note, 44 Brooklyn L. Rev., at 919-920. Had the bill retained the term "copyright," publication alone could have affected the force or validity of the copyright in the pre-existing work. Thus, far from telling us anything about the copyright in the derivative work, as the dissent apparently believes it does, the language change merely reflects the practical operation of the Act.<sup>n46</sup>

Although that statement constituted *dictum* in the context of the matter presented for decision in *Abend*,<sup>n47</sup> some lower courts concluded from it that "[t]he law is clear that the publication of a derivative work does not affect the validity of a copyright in the pre-existing work on which the derivative work is based."<sup>n48</sup> On the other hand, an appellate court<sup>n49</sup> declined to give that *dictum* broad sweep, in a case where plaintiff's brochure containing an architectural drawing entered the public domain on account of a notice defect and defendant subsequently copied that drawing.<sup>n50</sup> In that case, plaintiff's assertion of continuing protection in the underlying architectural plans proved unavailing.<sup>n51</sup> The stage was therefore set for decisive pronouncements from the appellate courts, these many decades later, ratifying or debunking the general rule posited above.<sup>n52</sup>

**[3] The General Rule Prevails.** Against the weight of the district court decisions just noted,<sup>n53</sup> the Central District of California concluded that publication of the motion picture *McLintock!* constituted not only publication of its audiovisual elements (John Wayne's antics *et al.*), but also of its underlying screenplay, which had not been previously published.<sup>n54</sup> Judge Dean Pregerson<sup>n55</sup> interpreted the provision of the 1909 Act about which *Stewart v. Abend* commented<sup>n56</sup> as applying solely to works in statutory copyright, not to previously unpublished works.<sup>n57</sup> Concluding that the above-quoted "solitary sentence in *Stewart* relating to common law rights was not the product of an in-depth analysis of congressional intent,"<sup>n58</sup> the district court followed the general rule that publication of a derivative work constitutes publication of the underlying elements contained therein. Accordingly, it held that publication of *McLintock!* resulted in securing statutory copyright over the unpublished screenplay on which it was based.<sup>n59</sup>

The Ninth Circuit affirmed under the caption of *Batjac Prods. Inc. v. GoodTimes Home Video Corp.*<sup>n60</sup> Engaging in lengthy analysis of the 1909 Act and its legislative history, the court concluded that all statutory invocations of "copyright" in that enactment--such as its § 7, which the *Abend* majority cites<sup>n61</sup>--referred to statutory copyright rather than to common law protection.<sup>n62</sup> It also deferred to long-standing Copyright Office policy, "Where a preexisting unpublished screenplay is embodied in a motion picture, those elements of the screen-

## 1-4 Nimmer on Copyright § 4.12

play disclosed in the motion picture are considered to be published at the same time the motion picture is published."<sup>n63</sup> Notwithstanding the deference due even *dicta* pronounced by the high Court,<sup>n64</sup> *Batjac* accordingly determined the *Abend* statement not to be controlling.<sup>n65</sup>

The complex public policy considerations surrounding the application of § 7 to unpublished works were not discussed by the Court in *Abend*. They lend support to our holding. We are concerned about letting "unpublished" works resurrect copyright protection over derivative works that have already entered the public domain. While statutory copyrights allow for a limited monopoly, common law rights are perpetual. So under the dual system of protection in place under the 1909 Act, if we were to agree with *Batjac*, an author could extend indefinite control over a derivative work through an unpublished pre-existing work.<sup>n66</sup> While this problem has been eliminated by passage of the 1976 Act,<sup>n67</sup> the copyright in any film that has entered into the public domain under the 1909 Act could be resurrected by an unpublished screenplay.<sup>n68</sup>

A few months after *Batjac*, the same issue reached the Second Circuit.<sup>n69</sup> In *Shoptalk, Ltd. v. Concorde-New Horizons Corp.*,<sup>n70</sup> that court reversed one of the district court rulings noted above that had deferred to the *Abend dictum*.<sup>n71</sup> Instead, *Shoptalk* aligned itself with *Batjac*,<sup>n72</sup> holding that the 1960 publication of *The Little Shop of Horrors* movie and its subsequent non-renewal had the same impact as applied to *McLintock!*--"if a previously unpublished screenplay is embodied in a motion picture, so much of the screenplay as is disclosed in the motion picture is published when the motion picture is published."<sup>n73</sup>

**[4] Retreat from That Proposition.** The language just articulated worked to the disadvantage of the screenwriters's heirs in *Batjac*, given the failure to timely renew the motion picture there at issue. In the next case, by contrast, the subject film was timely renewed, leading the screenwriters' heirs to argue that the circumstances worked to their advantage. The Ninth Circuit, however, turned the tables on them, introducing a new element into the jurisprudence.

The facts in *Richlin v. Metro-Goldwyn-Mayer Pictures, Inc.* <sup>n74</sup> were straightforward. In 1962, Maurice Richlin and Blake Edwards co-authored a 14-page Treatment for *The Pink Panther* and assigned it to a studio (Mirisch, predecessor to MGM). Thereafter, the studio hired the pair to produce a screenplay as a work for hire, which eventually gave rise to a ten-picture franchise (and counting), starting with the 1963 release and distribution of the first film, entitled *The Pink Panther*. Richlin died prior to start of that first film's renewal term.<sup>n75</sup> The studio timely renewed the film in its own name. During the renewal term, Richlin's statutory successors claimed entitlement to 50% of the revenue derived from exploitation of the treatment and its derivatives (namely, as many of the films as relied on its elements).<sup>n76</sup>

The successors' argument was mathematical. They concededly owned half of any extant rights in an underlying work *U*, the Treatment co-authored by Richlin. The question is whether admitted publication of a derivative work *D*, the *Pink Panther* movie, constituted publication of *U*. "In *Batjac*, the Ninth Circuit ruled that the publication of a motion picture publishes so much of the underlying screenplay as was disclosed in the motion picture."<sup>n77</sup> As the Second Circuit ruled in aligning its views with *Batjac*, "We find this reasoning persuasive and consonant with the principles approved in our prior cases, to wit, that when the

## 1-4 Nimmer on Copyright § 4.12

author consents to the inclusion of his work in a derivative work, the publication of the derivative work, to the extent that it discloses the original work, also constitutes publication of that underlying work."<sup>78</sup> That reasoning led to *Shoptalk's* conclusion on behalf of the Second Circuit: "We conclude ... that if a previously unpublished screenplay is embodied in a motion picture, so much of the screenplay as is disclosed in the motion picture is published when the motion picture is published." Accordingly, the uncontested publication of *D* constituted publication of all elements of *U* included therein.<sup>79</sup> The Richlin heirs thereby concluded that publication of the *Pink Panther* film, followed by its timely renewal 28 years later, secured their statutory rights in the underlying Treatment.

The Ninth Circuit began by conceding that those "principles carry some theoretical weight in copyright law."<sup>80</sup> Nonetheless, it proceeded to reject them. How it reached that result is curious.

Under *Batjac*, publication of the Motion Picture published those elements of the Treatment incorporated into the Motion Picture, and thus the Motion Picture's federal statutory copyright protection extended to those copyrightable elements of the Treatment that were published as components of the Motion Picture; however, this did not constitute publication of the Treatment "as such"--i.e., as a work standing alone. \*\*\* [I]n *Batjac* we adopted the Register's view that publication of the screenplay, or here, the Treatment, did not publish the Treatment as an independent work, but just those portions incorporated into the published work.<sup>81</sup>

The reference to "as such" is perplexing. The screenplay in *Batjac* was unpublished except insofar as incorporated into a film, exactly as the Treatment in *Richlin* was unpublished except insofar as incorporated into a film. No one has ever doubted that publication of *U* "as such" constitutes publication of *U*. The issue that *Batjac* resolved, and *Shoptalk* followed, is that publication of *D* works *pro tanto* publication of *U*. It follows inexorably that publication of the *Pink Panther* movie worked publication of those elements of the *Pink Panther* Treatment contained in the movie. Of course, that circumstance by itself might not warrant much of a recovery to the Richlin heirs; apportionment would still be required to determine whether the derivation accounted for significant revenues.<sup>82</sup> But *Richlin* withdrew the very basis of *Batjac*, namely that publication of *D* works a *pro tanto* publication of *U*.

To return to the facts of *Batjac*, its screenplay was unpublished at the time that the motion picture *McLintock!* was released. Analytically, there are only three possible consequences that publication of the motion picture could exert upon the incorporated elements of screenplay under the 1909 Act, which then governed:

1. There is no consequence, such that the common law copyright of the screenplay continues unabated;<sup>83</sup>
2. Publication of the film injects the screenplay immediately into the public domain;<sup>84</sup> or



## 1-4 Nimmer on Copyright § 4.12

3. Publication of the film invests the incorporated elements of the screenplay with statutory copyright, with a term computed according to general principles incorporated into the Copyright Act.<sup>n85</sup>

Plaintiff Batjac urged proposition 1. But the Ninth Circuit rejected it. Had the film been published without proper copyright notice in its name, the court would have adopted proposition 2.<sup>n86</sup> But the film bore a proper copyright notice, so the case adopted proposition 3: The screenplay lapsed 28 years after publication of the film,<sup>n87</sup> upon failure to renew the copyright for that film.<sup>n88</sup> The Ninth Circuit noted that a separate district court opinion held that the Register of Copyrights "correctly refused to register the draft *McLintock!* screenplays because the screenplays had secured statutory copyright with the motion picture and had passed into the public domain *when the copyright was not renewed.*"<sup>n89</sup> That district court opinion even addresses in *dictum* the wrinkle later presented in *Richlin*, noting that "the right to seek a renewal term [for the screenplay] would lie with the author's heirs, not with [Batjac and its fellow] Plaintiffs, because Grant, the author of the screenplays, died in 1966, which was prior to the expiration of the initial copyright term."<sup>n90</sup>

Based on those propositions, the Richlin heirs should have won their case.<sup>n91</sup> But the Ninth Circuit ruled to the contrary. It cited a decision by the Copyright Office Board of Appeals, denying the petition by the heirs of John Cassavetes to renew his unpublished screenplay from the motion picture *Husbands*, based on his death before the renewal term commenced for the film.<sup>n92</sup> Nonetheless, an important aspect of that non-precedential determination from the Copyright Office is that the claimant actually submitted two renewal claims for registration, one for the motion picture and a separate one for its incorporated screenplay. The Copyright Office issued the former, in the name of Faces Music, Inc., but denied the latter in the name of Cassavetes' widow and children. It is unclear on the face of the appeal what the relationship was between Faces Music and those individuals; it may be that the only operative effect of the decision was to deny two pieces of paper to the same consortium of individuals, limiting them to one piece of paper (on the theory that that single certificate would suffice for all their needs). Still, to the extent that the Cassavetes heirs had different legal interests than those of Faces Music,<sup>n93</sup> then the considerations canvassed above indicate that the Copyright Office should have issued them a separate renewal for the screenplay.<sup>n94</sup>

But the Ninth Circuit hastened to note that its views arose independently from those expressed by the Copyright Office Board of Appeals.<sup>n95</sup> It reverted in that context to the Supreme Court's case discussed above.<sup>n96</sup>

As *Abend* itself demonstrates, the author of a work at common law must secure a federal copyright for that work for the right to renew to vest in either him or his heirs. The statutory copyright of a motion picture precludes the public from copying or otherwise infringing upon the statutory rights in the motion picture, including its component parts. However, when Mirisch secured federal statutory copyright for the Motion Picture, it did not also secure a federal statutory copyright for the Treatment. Assuming the Treatment is a copyrightable work, Richlin and Edwards simply failed to secure federal copyright for it.<sup>n97</sup>

## 1-4 Nimmer on Copyright § 4.12

It is respectfully submitted that the precise holding of *Batjac*, applied to the current facts, is exactly to the contrary--when Mirisch secured federal statutory copyright for the Motion Picture, it absolutely did secure a federal statutory copyright for those elements of the Treatment incorporated into the Motion Picture.

In fact, further investigation into the pertinent authorities debunks the notion that previous cases, *Abend* included, were premised on publication "as such." Starting with *Batjac*, the publication of the screenplay took place via the derivative work *McLintock!*<sup>n98</sup> and the screenplay's term expired 28 years later upon failure to renew that film. Parallel logic indicates that publication of the Treatment took place via the derivative work *The Pink Panther* and that, upon valid renewal of that film, the Treatment's protection continued past 28 years later for the full copyright term.<sup>n99</sup> Moving to *Abend*, it did not involve a scenario (contrary to the Ninth Circuit's description in *Richlin*) whereby "the author of a work at common law ... secure[d] a federal copyright for that work"<sup>n100</sup> and neither did it involve publication, in *Richlin's* terms, of a work " 'as such'--i.e., as a work standing alone."<sup>n101</sup> The author of the work there at issue, Cornell Woolrich, granted magazine rights in his unpublished story to Popular Publications, Inc. It was that entity (parallel to Mirisch in *Richlin*), not the author, that secured federal copyright protection. It did so not by producing a work standing alone, but instead a collective work consisting of numerous stories.<sup>n102</sup> That publisher "obtained a blanket copyright for the issue of Dime Detective Magazine in which" the story appeared.<sup>n103</sup> The statutory copyright for that collective work published by Popular Publications empowered Woolrich's statutory successors, given his death prior to renewal vesting, to renew his contribution in their own name, regardless of his antecedent grant. Parallel logic indicates that statutory copyright for the derivative work,<sup>n104</sup> *The Pink Panther*, published by Mirisch, should have empowered *Richlin's* heirs, given his death prior to renewal vesting, to renew his contribution in their own name, regardless of his antecedent grant.<sup>n105</sup>

Moving finally to *Shoptalk*, its facts largely mirrored *Batjac's*, with one important difference: The 1959 screenplay, made into a 1960 motion picture, was itself "registered for copyright protection in 1982, pursuant to an application indicating that it was an unpublished work."<sup>n106</sup> In that sense, therefore, the claimant obtained statutory copyright for its work "as such."<sup>n107</sup> But that circumstance did not produce any operative difference. Inasmuch as the film itself was first published on January 5, 1960,<sup>n108</sup> the Second Circuit agreed with the Copyright Office that those "portions of screenplays embodied in the motion picture are published upon publication of the motion picture,"<sup>n109</sup> leading to 28 years of protection, subject to further prolongation of the term given compliance with the formality of timely renewal.<sup>n110</sup> Inasmuch as the subject renewal of the motion picture failed to take place in *Shoptalk* (as in *Batjac*), its underlying screenplay also entered the public domain after the 28th year, insofar as the components of the screenplay were realized on the screen. This case therefore debunks any significance to taking out statutory copyright in an underlying component during its first 28-year term of protection. Instead, what matters is publication--the Second Circuit there ruled that the publication of *D* serves *pro tanto* to publish the common elements contained in *U*.<sup>n111</sup>

In short, *Richlin* reinterprets *Batjac* to stand solely for the proposition that publication of *U* (a work "as such") serves to work the publication of *U*, an empty tautology. *Richlin* retracts the essence of *Batjac* (with which *Shoptalk* agreed): publication of *D* serves to work the publication of those elements of *U* contained therein. It is therefore difficult to know what rule *Richlin* would apply to *U*.

## 1-4 Nimmer on Copyright § 4.12

As previously indicated, the three possible consequences under the 1909 Act that publication of a motion picture could exert upon its screenplay are:

1. No consequence; common law copyright of the screenplay continues unabated;
2. Immediate injection of the screenplay into the public domain; or
3. Investiture of the screenplay's incorporated elements with statutory copyright, subject to mandatory renewal and all the other features of copyright law then extant.

*Batjac* expressly rejected 1 and held in favor of 3. *Richlin* rejects 3, but nothing therein resurrects 1 nor lends any support to 2.<sup>n112</sup> The matter remains unaddressed, but the opinion appears tacitly to support a notion along the lines of:

4. The screenplay falls into a black hole previously unknown in the copyright universe, whereby it ceases to have any existence.<sup>n113</sup>

If that consequence is indeed the result, then *Richlin's* result represents an upheaval that carries terrible policy implications. Consider the entire music industry. As of 1909, sale of sheet music was widespread, meaning that compositions may then have been sold " 'as such'--i.e., as a work standing alone."<sup>n114</sup> But industry practice shifted many decades ago (during the pendency of the 1909 Act), such that a Composer would assign away rights in a song, which ultimately would be sold as one cut on a record album incorporating a dozen other compositions.<sup>n115</sup>

At that time, the standard AGAC agreement<sup>n116</sup> signed by songwriters only granted rights for the first 28 years, expressly retaining renewal interests for the composer. Of course, even when the renewal term may have been assigned away in a non-standard contract, widows and children would routinely obtain reversion of the renewal term to the extent that the songwriter died prior to renewal vesting.<sup>n117</sup> If all else failed, the children and grandchildren could always seek termination of transfer, either 56 or 75 years after the work's initial publication.<sup>n118</sup>

Before *Richlin*, those devices were straightforward. But the logic of that decision may frustrate the interests of all those successors to the rights of composers. For absent the publication of sheet music, they face the same situation that doomed *Richlin's* heirs--the lack of any publication of the work "as such." A record album containing 13 songs, performed by an unrelated band, is every bit as much a derivative work of a particular underlying musical composition as was the Mirisch film *Pink Panther* when compared to the underlying Treatment by the same name. The same reasoning that defeated vindication of rights in the Treatment in *Richlin* may radiate outward to vitiate reversion of renewal rights and termination of transfers with respect to the entire music industry.

*Richlin* creates a conflict within the law of the Ninth Circuit (against *Batjac*) and as compared with the law of sister circuits (*Shoptalk* in the Second Circuit). Only future decisions can smooth out its rough edges.

**[C] Construction of a Building as a Publication of Architectural Plans**

Some earlier cases have held that the construction of a building constitutes a publication of the architectural plans upon which the building is based.<sup>n119</sup> One more recent case, *Smith v. Paul*<sup>n120</sup> took a contrary position, at least where only a limited number of persons, *i.e.*, the guests of the owner, are permitted to view the structure. Two other cases, *Edgar H. Wood Associates, Inc. v. Skene*<sup>n121</sup> and *DeSilva Construction Corp. v. Herrald*<sup>n122</sup> unequivocally asserted that construction of a building, even when exhibited to the public as a model home, cannot constitute a publication of the plans upon which the building is based.<sup>n123</sup> The court in each of these cases reached this conclusion on the grounds that the structure does not constitute a "copy" of the plans. A corollary of this rationale would seem to be that one who constructs a building based upon another's plans cannot be an infringing "copier."<sup>n124</sup> Still another case, *Shanahan v. Macco Construction Co.*<sup>n125</sup> holds to the contrary that the construction and public sale of numerous tract houses constitute a publication so as to divest the common law copyright in the plans upon which the houses were based.<sup>n126</sup> *Shanahan* distinguished *Smith v. Paul* in that the latter involved the building of an individual home for a particular person, so that only a limited publication resulted.

In *Read v. Turner*<sup>n127</sup> the court went somewhat further in holding that the exhibition of a structure constitutes a general publication of the design that the structure embodies if and to the extent that the design is observable by persons viewing the structure. The court held that the floor plan of the structure was published by the construction and open house exhibition of the structure because the floor plan was readily observable in the structure, but suggested that other aspects of the architectural design contained in the plans and specifications might not be thereby published if such other aspects are not observable in the structure.

Several premises, largely unarticulated in the above cases, must be analyzed in connection with this issue. First, is a building a derivative work by reason of its use of an architectural plan? It may be argued that it is not a derivative work because mere inspection of a building may not be sufficient to permit a precise reproduction of the architectural plans upon which the building is based.<sup>n128</sup> Even if it be regarded as a derivative work, should mere public exhibition, even if not limited to invited guests, constitute a publication of either the derivative building or of the basic architectural plans? Mere exhibition occurring on or after January 1, 1978, clearly does not constitute publication.<sup>n129</sup> For reasons indicated above,<sup>n130</sup> it is suggested that even pre-1978, no publication should be held to have occurred, unless members of the public obtained or had the right to obtain a possessory interest in the completed structure. That is, if a building were publicly offered for sale or rent this would constitute a publication of the building--and to the extent it is a derivative work--also of the architectural plans.<sup>n131</sup> If, however a building were never publicly offered for sale or rent, then its mere construction and public exhibition should not be considered to have constituted a publication.<sup>n132</sup>

When Congress accorded protection to buildings under the Architectural Works Copyright Protection Act, effective December 1, 1990,<sup>n133</sup> it "considered, but rejected, amending the Copyright Act to provide a special definition of publication of an architectural work."<sup>n134</sup> Instead, it simply stated that the generally applicable definition of publication governs, without specifying what activity is necessary to publish the structure itself.<sup>n135</sup> Presumably, notwithstanding that a structure, which is attached to the ground, is not susceptible to "dis-

## 1-4 Nimmer on Copyright § 4.12

tribution,"<sup>136</sup> an offer to sell and sale does amount to publication under this view of the current Act.<sup>137</sup> In terms of the question addressed above, the legislative history states that, architectural plans occupying a separate category of protection from architectural works, "publication of plans and drawings is not a publication of an architectural work."<sup>138</sup> The assertion seems dead wrong, notwithstanding that one might subscribe to its converse.<sup>139</sup> Given that the statute itself recognizes that an "architectural work" can be embodied in plans or drawings as much as in a building,<sup>140</sup> one way to publish an architectural work, by definition, would seem to be by publishing the plan in which it is embodied.<sup>141</sup>

Since 1990, given the existence of two distinct categories of protection, and given the potential of infringing a work in another medium,<sup>142</sup> perhaps it has become necessary to rethink the corollary noted above and conclude that, under appropriate circumstances, a building can be an infringing "copy" of and derivative work based upon architectural plans.<sup>143</sup> Nonetheless, given that construction of a building can now give rise to a direct cause of action based on infringement of an "architectural work" and recourse to purported infringement of plans is no longer necessary, it must be admitted that the question has become of much less moment since December 1, 1990.<sup>144</sup>

**Legal Topics:**

For related research and practice materials, see the following legal topics: Copyright Law Collective & Derivative Works Derivative Works Copyright Law Publication Acts Constituting Publication Copyright Law Publication Copyright Act of 1909 Copyright Law Publication Copyright Act of 1976 Copyright Law Subject Matter Architectural Works

**FOOTNOTES:**

(n1)Footnote 1. See Chap. 3 *supra*. It seems clear that publication of a pre-existing work in a collective work (as distinguished from a derivative work, see § 3.02 *supra*) constitutes a publication of such pre-existing work. *Roy Export Co. Establishment v. Columbia Broadcasting Sys., Inc.*, 672 F.2d 1095 (2d Cir.) (Treatise cited) , *cert. denied*, 459 U.S. 826, 103 S. Ct. 60, 74 L. Ed. 2d 63 (1982) . *Roy Export* qualifies this conclusion by holding that the publication of a collective work that is only investive, not also divestive (see § 4.13[C] *infra*), does not constitute either an investive or a divestive publication of the pre-existing works contained in such collective work.

(n2)Footnote 2. The current Act does, however, by implication indicate that the publication of a derivative work constitutes a publication of the pre-existing works contained therein. *Harris Custom Builders, Inc. v. Hoffmeyer*, 92 F.3d 517, 520 (7th Cir. 1996) (Treatise quoted) . This is to be inferred from 17 U.S.C. § 401(b)(2), which provides that the year contained in the notice pertaining to the derivative work "is sufficient" to meet the notice requirements pertaining to previously published pre-existing works. Because a notice is only required upon publication (see § 7.03 *infra*), there would be no need for this provision of sufficiency if the publication of the derivative work did not also constitute a publication of the pre-existing works embodied therein.

(n3)Footnote 3. *Shoptalk, Ltd. v. Concorde-New Horizons Corp.*, 168 F.3d 586, 591 (2d Cir. 1999) , *cert. denied*, 527 U.S. 1038, 119 S. Ct. 2399, 144 L. Ed. 2d 798 (1999) (Treatise quoted) ; *Batjac Prods. Inc. v. GoodTimes Home Video Corp.*, 160 F.3d 1223, 1232 (9th Cir. 1998) , *cert. denied*, 526 U.S. 1158, 119 S. Ct.

## 1-4 Nimmer on Copyright § 4.12

2046, 144 L. Ed. 2d 214 (1999) (Treatise cited) ; Gates Rubber Co. v. Bando Am., Inc., 798 F. Supp. 1499, 1507 (D. Colo. 1992) (Treatise quoted) , *aff'd in part, vacated in part*, 9 F.3d 823 (10th Cir. 1993) ; Grove Press, Inc. v. Greenleaf Publishing Co., 247 F. Supp. 518 (E.D.N.Y. 1965) (Treatise quoted) . See American Greetings Corp. v. Kleinfab Corp., 400 F. Supp. 228 (S.D.N.Y. 1975) .

(n4)Footnote 4. "A 'derivative work' is a work based upon one or more preexisting works ... ." 17 U.S.C. § 101.

(n5)Footnote 5. Maljack Prods. v. UAV Corp., 964 F. Supp. 1416, 1421 (C.D. Cal. 1997) (Treatise quoted) , *aff'd sub nom.* Batjac Prods. Inc. v. GoodTimes Home Video Corp., 160 F.3d 1223 (9th Cir. 1998) , *cert. denied*, 526 U.S. 1158, 119 S. Ct. 2046, 144 L. Ed. 2d 214 (1999) ; Richlin v. Metro-Goldwyn-Mayer Pictures, Inc., 531 F.3d 962, 973 (9th Cir. 2008) , *cert. denied*, \_\_\_ U.S. \_\_\_, 129 S. Ct. 1002, 173 L. Ed. 2d 293 (2009) (Treatise quoted) .

(n6)Footnote 6. Maps Inc. v. Toycraft Corp., 162 F. Supp. 141 (S.D.N.Y. 1958) .

(n7)Footnote 7. Turner v. Robinson, 10 Ir. Ch. 121 (1860), *aff'd*, 10 Ir. Ch. 510 (1860).

(n8)Footnote 8. Siegel v. Warner Bros. Entm't, Inc., 542 F. Supp. 2d 1098, 1125 (C.D. Cal. 2008) (previous four sentences of Treatise quoted); First Am. Artificial Flowers v. Joseph Markovits, Inc., 342 F. Supp. 178 (S.D.N.Y. 1972) (Treatise cited) .

(n9)Footnote 9. Sieff v. Continental Auto Supply, Inc., 39 F. Supp. 683 (S.D. Minn. 1941) .

(n10)Footnote 10. See *id.* (collective work). If the new edition had been published prior to 1978, such injection into the public domain may have occurred instantaneously. See § 7.13[A][2] *infra*. If the publication occurred on or after January 1, 1978, the injection would not be instantaneous, but it might occur at a later date by reason of such publication. See §§ 7.13[A][1], [B] *infra*. The pre-existing work would be injected into the public domain under the above circumstances notwithstanding the provisions of 17 U.S.C. § 103(b): "The copyright in such [compilation or derivative] work is independent of, and does not affect ... the ... subsistence of, any copyright protection in the preexisting material." See Sieff v. Continental Auto Supply, Inc., N. 8 *supra* (construing similar language in § 7 of the 1909 Act). But see the legislative history of § 7 quoted in Rohauer v. Killiam Shows, Inc., 551 F.2d 484, 488-490 (2d Cir.) , *cert. denied*, 431 U.S. 949, 97 S. Ct. 2666, 53 L. Ed. 2d 266 (1977) , and throughout the majority and dissenting opinions of Stewart v. Abend, 495 U.S. 207, 110 S. Ct. 1750, 109 L. Ed. 2d 184 (1990) , overruling Rohauer.

(n11)Footnote 11. See Chap. 9 *infra*. An example is publication even with valid copyright notice in 1922--copyrights in all works published in that year or earlier have lapsed. See § 9.11[B][1] *infra*.

(n12)Footnote 12. See § 7.23[B] *infra*. But cf. § 7.23[E] *infra* .

(n13)Footnote 13. See § 7.23[F] *infra*.

(n14)Footnote 14. Grove Press, Inc. v. Greenleaf Publishing Co., 247 F. Supp. 518 (E.D.N.Y. 1965) .

(n15)Footnote 15. Jim Henson Prods. v. John T. Brady & Assoc., Inc., 867 F. Supp. 175, 184, 186 n.13 (S.D.N.Y. 1994) (Treatise quoted) . See G. Ricordi & Co. v. Paramount Pictures, Inc., 189 F.2d 469 (2d Cir. 1951) , *cert. denied*, 342 U.S. 849, 72 S. Ct. 77, 96 L. Ed. 641 (1951) ; Russell v. Price, 448 F. Supp. 303 (C.D. Cal. 1977) , *aff'd*, 612 F.2d 1123 (9th Cir. 1979) , *cert. denied*, 446

## 1-4 Nimmer on Copyright § 4.12

U.S. 952, 100 S. Ct. 2919, 64 L. Ed. 2d 809 (1980) ; *Filmvideo Releasing Corp. v. Hastings*, 668 F.2d 91 (2d Cir. 1981) . Cf. *Classic Film Museum, Inc. v. Warner Bros., Inc.*, 453 F. Supp. 852 (D. Me. 1978) , *aff'd*, 597 F.2d 13 (1st Cir. 1979) . On the factual distinction between *Russell* and *Classic Film*, which justifies a different result in the latter, see § 3.07[C] *supra*.

(n16)Footnote 16. It may be that an investive publication of a derivative work that does not also constitute a divestive publication (see § 4.13[C] *infra*) constitutes neither an investive nor a divestive publication of the underlying work. See *Roy Export Co. Establishment v. Columbia Broadcasting Sys., Inc.*, 672 F.2d 1095 (2d Cir. 1982) (principle applied to collective works), *cert. denied*, 459 U.S. 826, 103 S. Ct. 60, 74 L. Ed. 2d 63 (1982).

(n17)Footnote 17. See *Mail & Express Co. v. Life Publishing Co.*, 192 F. 899 (2d Cir. 1911) ; *Leigh v. Barnhart*, 96 F. Supp. 194 (D.N.J. 1951) .

(n18)Footnote 18. *Mifflin v. Dutton*, 190 U.S. 265, 23 S. Ct. 771, 47 L. Ed. 1043 (1903) ; see *Holmes v. Hurst*, 174 U.S. 82, 19 S. Ct. 606, 43 L. Ed. 904 (1899) ; *Mifflin v. R. H. White Co.*, 190 U.S. 260, 23 S. Ct. 769, 47 L. Ed. 1040 (1903) .

(n19)Footnote 19. See § 4.05[B][2] *supra*.

(n20)Footnote 20. *Russell v. Price*, 612 F.2d 1123, 1128 (9th Cir. 1979) , *cert. denied*, 446 U.S. 952, 100 S. Ct. 2919, 64 L. Ed. 2d 809 (1980) .

(n21)Footnote 21. *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14, 20 n.3 (2d Cir. 1976) (Treatise cited) . Later, the Second Circuit quoted this language in expressly adopting the general rule. *Shoptalk, Ltd. v. Concorde-New Horizons Corp.*, 168 F.3d 586, 593 (2d Cir. 1999) , *cert. denied*, 527 U.S. 1038, 119 S. Ct. 2399, 144 L. Ed. 2d 798 (1999) . See § 4.12[B][3] *infra*.

(n22)Footnote 22. *Columbia Broadcasting Sys., Inc. v. Decosta*, 377 F.2d 315 (1st Cir. 1967) (regarding publication of the character "Paladin"), *cert. denied*, 389 U.S. 1007, 88 S. Ct. 565, 19 L. Ed. 2d 603 (1967).

(n23)Footnote 23. See § 4.12[A] *supra*.

(n24)Footnote 24. *Copinger and Skone James on the Law of Copyright* at 22 (1958) .

(n25)Footnote 25. Bogsch, *Universal Copyright Convention* at 71 (1964) .

(n26)Footnote 26. See § 4.12[B][3] *infra*.

(n27)Footnote 27. 171 A.D. 854, 157 N.Y.S. 1028 (1st Dep't 1916) .

(n28)Footnote 28. 121 Misc. 78, 201 N.Y.S. 20 (Sup. Ct. N.Y. County 1923) . See also *Beifled v. Dodge Pub. Co.*, 198 F. 658 (S.D.N.Y. 1911) .

(n29)Footnote 29. See § 4.12[D] *infra*.

(n30)Footnote 30. 218 F.2d 434 (2d Cir. 1955) .

(n31)Footnote 31. *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99 (2d Cir. 1951) .

(n32)Footnote 32. See § 4.13[A] *infra*. Cf. *S.C. Johnson & Son, Inc. v. Drop Dead Co.*, 201 F. Supp. 442 (S.D. Cal. 1961) ; *Lin-Brook Builders Hardware v. Gertler*, 352 F.2d 298, 147 U.S.P.Q. 265 (9th Cir. 1965) ; *L & L White Metal Casting Corp. v. Cornell Metal Corp.*, 353 F. Supp. 1170 (E.D.N.Y. 1972) , *aff'd*, 177 U.S.P.Q. 673 (2d Cir. 1973) . See *Hub Floral Corp. v. Royal Brass Corp.*, 454 F.2d 1226 (2d Cir. 1972) (distribution of photograph of copyrighted work in catalog to dealers for purpose of soliciting orders held a limited publication).

## 1-4 Nimmer on Copyright § 4.12

(n33)Footnote 33. *Key West Hand Print Fabrics, Inc. v. Serbin, Inc.*, 244 F. Supp. 287 (S.D. Fla. 1965) . Similarly, in *Irving J. Dorfman Co. v. Borlan Indus., Inc.*, 309 F. Supp. 21 (S.D.N.Y. 1969) , the court expressed the view that the publication of a photograph of copyrighted lace would not divest the copyright therein, notwithstanding the absence of any notice on the photograph.

(n34)Footnote 34. See also *Imperial Homes Corp. v. Lamont*, 458 F.2d 895 (5th Cir. 1972) (distribution of sales promotion brochure containing reproduction of plaintiff's architectural plans held not to divest statutory copyright in such plans, though brochure contained no copyright notice, albeit it did refer to the fact that the plans were protected by copyright). *Imperial* correctly concluded that distribution of the brochure did not constitute an abandonment of copyright (see § 13.06 *infra*), but failed to appreciate that there may be a divestiture of copyright by publication without proper notice even if abandonment is not intended. See § 4.13[D] *infra*. Cf. *Nucor Corp. v. Tennessee Forging Steel Serv., Inc.*, 339 F. Supp. 1305 (W.D. Ark. 1972) , *rev'd*, 476 F.2d 386 (8th Cir. 1973) .

(n35)Footnote 35. See § 10.09 *infra*.

(n36)Footnote 36. See § 7.12[C] *infra*. See also *Hearst Corp. v. Shopping Center Network, Inc.*, 307 F. Supp. 551 (S.D.N.Y. 1969) , which suggests that publication of an animated cartoon motion picture does not constitute a publication of the individual cels or still artwork contained therein, so that a common law copyright action will lie for infringement of such artwork. However, the facts as stated in the opinion leave it unclear whether the artwork did in fact appear in the motion picture and, further, there is no express conclusion that the motion picture had been published, though the court states that it was "in theatrical distribution."

(n37)Footnote 37. *Academy of Motion Picture Arts & Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1452 (9th Cir. 1991) . *Motion Picture Arts* upheld the copyright in the Oscar statuette, relying on *Kamar Int'l, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059 (9th Cir. 1981) . Yet as noted in N. 38 *infra*, *Kamar* is a case in which the photo does *not* replicate the copyrightable features of the sculpture, as contrasted with a photo of the Oscar. Nonetheless, *Motion Picture Arts* follows the trend of the cases cited above.

(n38)Footnote 38. *Kamar Int'l, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059 (9th Cir. 1981) . In *Kamar*, the court found that that which was original in plaintiff's stuffed animals was the "special texture and design," which the court concluded were not conveyed in photographs of the stuffed animals that had been published in catalogues without copyright notice. See § 2.18[H][2] *supra*.

(n39)Footnote 39. 247 F. Supp. 518 (E.D.N.Y. 1965) (Treatise cited) .

(n40)Footnote 40. See § 8.11 *infra*.

(n41)Footnote 41. 453 F. Supp. 852 (D. Me. 1978) , *aff'd*, 597 F.2d 13 (1st Cir. 1979) .

(n42)Footnote 42. 453 F. Supp. at 854 n.1 (Treatise cited) .

(n43)Footnote 43. For the rationale in fact adopted by the *Classic Film* court, see § 3.07[C] *supra*. See also *Roy Export Co. Establishment v. Columbia Broadcasting Sys., Inc.*, 672 F.2d 1095, 1103 n.17 (2d Cir. 1982) ("despite the language of section 7 [of the 1909 Act], a 'divestive' publication by definition affects the validity of an underlying common-law copyright: it extinguishes it."), *cert. denied*, 459 U.S. 826, 103 S. Ct. 60, 74 L. Ed. 2d 63 (1982) .

(n44)Footnote 44. The Ninth Circuit later adopted the Register's interpretation that " *Classic Film* turns upon the impropriety of the moviemakers' use of



## 1-4 Nimmer on Copyright § 4.12

artifice to extend the term limits set forth in the Act for copyrighted works." *Batjac Prods. Inc. v. GoodTimes Home Video Corp.*, 160 F.3d 1223, 1234 (9th Cir. 1998) , *cert. denied*, 526 U.S. 1158, 119 S. Ct. 2046, 144 L. Ed. 2d 214 (1999) .

(n45)Footnote 45. 495 U.S. 207, 110 S. Ct. 1750, 109 L. Ed. 2d 184 (1990) .

(n46)Footnote 46. 495 U.S. at 233 .

(n47)Footnote 47. See § 3.07[A][3] *supra* (discussing holding of that case). Before the circuit court decisions canvassed below (see § 4.12[B][3] *infra*), this treatise concluded the instant discussion as follows: "Because that statement constituted *dictum* in the context of the matter presented for decision in *Abend*, further thought should be given to the wisdom of converting it into a binding holding by the Court." See *Maljack Prods. Inc. v. UAV Corp.*, 964 F. Supp. 1416, 1424 (C.D. Cal. 1997) (Treatise cited) , *aff'd*, 160 F.3d 1223, 1232 n.11 (9th Cir. 1998) (Treatise quoted) , *cert. denied*, 526 U.S. 1158, 119 S. Ct. 2046, 144 L. Ed. 2d 214 (1999) .

(n48)Footnote 48. *Harris Custom Builders, Inc. v. Hoffmeyer*, 874 F. Supp. 899, 902 (N.D. Ill. 1995) ; *Jim Henson Prods. v. John T. Brady & Assocs., Inc.*, 867 F. Supp. 175, 185 (S.D.N.Y. 1994) ; *Shoptalk, Ltd. v. Concorde-New Horizons Corp.*, 897 F. Supp. 144, 146 (S.D.N.Y. 1995) , *vacated*, 168 F.3d 586 (2d Cir. 1999) , *cert. denied*, 527 U.S. 1038, 119 S. Ct. 2399, 144 L. Ed. 2d 798 (1999) .

(n49)Footnote 49. Although the lower court applied the *Abend dictum* to preserve plaintiff's copyright claim, the court of appeals reversed, citing the above discussion for the proposition that publication of a derivative work constitutes publication of the pre-existing material contained therein. *Harris Custom Builders, Inc. v. Hoffmeyer*, 92 F.3d 517, 520 (7th Cir. 1996) (Treatise cited) . See § 4.12[A] N. 2 *supra*.

(n50)Footnote 50. See Chap. 7 *infra*.

(n51)Footnote 51. See § 2.20[B] *supra*, § 4.12[C] *infra*.

(n52)Footnote 52. Taking literally the notion that publication of the derivative work exerts no impact whatsoever on rights in the underlying work, the district court's conclusion in *Hoffmeyer* would be correct. See N. 30.17 *supra* . But the superior reasoning of the Seventh Circuit--that copying a public domain brochure does not create an infringement claim, regardless of what portions of that brochure may have originated from an underlying work--highlights the folly of taking that notion literally.

(n53)Footnote 53. See § 4.12[B][2] *supra*.

(n54)Footnote 54. *Maljack Prods. Inc. v. UAV Corp.*, 964 F. Supp. 1416 (C.D. Cal. 1997) . There were actually two unpublished screenplays at issue, one original and one revised. Inasmuch as the motion picture was registered but not timely renewed, it entered the public domain. See § 9.05[B][1] *infra*. The question arose whether copyright in the screenplay could nonetheless continue.

(n55)Footnote 55. The Supreme Court in *Abend* affirmed the Ninth Circuit's ruling per Circuit Judge Harry Pregerson, that jurist's father. See *Abend v. MCA, Inc.*, 863 F.2d 1465 (9th Cir. 1988) , *aff'd sub nom. Stewart v. Abend*, 495 U.S. 207, 110 S. Ct. 1750, 109 L. Ed. 2d 184 (1990) . See also § 14.06[B][1][b][iii] N. 269 *infra*.

(n56)Footnote 56. See § 4.12[B][2] *supra*.

(n57)Footnote 57. The word "copyright" as used in section 7, the section upon which Plaintiffs' analysis of *Stewart* is premised, refers only to *statutory* copyright. The 1909 Act was very precise when it addressed common law rights,

## 1-4 Nimmer on Copyright § 4.12

which the statute explicitly states are not to be limited or annulled. Therefore, section 7 and the *Stewart* opinion must be read to refer only to a subsisting *statutory* copyright. Section 7 and *Stewart* should not be read to indirectly dictate that publication of a motion picture cannot constitute publication of an underlying screenplay simply because the effect of that finding would be to replace the screenplay's common law protection with statutory protection that Plaintiffs permitted to lapse through non-renewal.

964 F. Supp. at 1423 (emphasis original, citations omitted).

(n58)Footnote 58. *Id.* at 1424 (Treatise cited) . The opinion quotes at length from the Brooklyn Law Review note cited in *Stewart v. Abend*, demonstrating why it supports the instant conclusion rather than the interpretation that plaintiff wished to place on that Supreme Court ruling. *Id.* See § 4.12[B][2] *supra*.

(n59)Footnote 59. Failure to renew the film 28 years later accordingly assigned the screenplay to the public domain. *Id.* at 1425 .

(n60)Footnote 60. 160 F.3d 1223 (9th Cir. 1998) , *cert. denied*, 526 U.S. 1158, 119 S. Ct. 2046, 144 L. Ed. 2d 214 (1999) .

(n61)Footnote 61. See § 4.12[B][2] *supra*.

(n62)Footnote 62. The circuit excavated even more deeply here, concluding that the Congressional testimony upon which the Brooklyn Law Review note relied had nothing to do with the publication of unpublished works in new versions. *Id.* at 1230 . See N. 30.26 *supra* .

(n63)Footnote 63. *Id.* at 1230 , quoting Compendium II, Compendium of Copyright Office Practices 910-04 (1984). Nonetheless, the Register conceded that Office practice under the 1909 Act fell under a predecessor Compendium, which was equivocal--or perhaps even contrary--on the subject point. *Id.*

(n64)Footnote 64. Normally, lower courts should follow even *dictum*. *Pickett v. Prince*, 52 F. Supp. 2d 893, 904 (N.D. Ill. 1999) ("we cannot presume that our Court of Appeals writes merely for intellectual exercise"), *aff'd in part, vacated on other grounds*, 207 F.3d 402 (7th Cir. 2000) . But it bears emphasis that *Abend* did not arise in a posture considering unpublished works or common law copyright. Here, therefore, the contrary conclusion follows under the factors developed by case law for rejecting *dicta*. 160 F.3d at 1232-1233 . See generally Michael C. Dorf, *Dicta and Article III*, 142 U. Penn. L. Rev. 1997 (1994) .

(n65)Footnote 65. 160 F.3d at 1232 (Treatise cited) .

(n66)Footnote 66. At this point, the court cites to the *Classic Film* case discussed in § 4.12[B][2] *supra*. The Ninth Circuit concluded that that First Circuit case powerfully supports its conclusion. *Id.* at 1225 , 1233-1234 .

(n67)Footnote 67. "A derivative work under the 1909 Act need not have the same relationship to the unpublished work as a derivative work has to the unpublished work under the 1976 Act." *Id.* at 1227 n.6 . The court's holding applies primarily to works created under the 1909 Act. As to works created during the pendency of the 1976 Act, to the extent that their duration is gauged by life of the author, the instant holding concerning effect of publication does not affect duration. See § 9.10[A][1] *infra*.

(n68)Footnote 68. *Id.* at 1233 (citation omitted). "Batjac reaped the full reward of copyright protection in its screenplay. Batjac held copyright in both the motion picture and the screenplay and, as a result, was able to fully ex-

## 1-4 Nimmer on Copyright § 4.12

exploit the profit making potential of the screenplay in any manner it chose. We find no indication that Congress intended § 7 to allow authors to maintain perpetual monopolies over their copyrightable works. So we are compelled to find that § 7 does not apply to unpublished works protected by common law copyrights." *Id.*

(n69)Footnote 69. The Register of Copyrights participated in both the Ninth and Second Circuit appeals, successfully arguing in favor of the general rule. See § 4.12[A] *supra*.

(n70)Footnote 70. 168 F.3d 586 (2d Cir. 1999) , *cert. denied*, 527 U.S. 1038, 119 S. Ct. 2399, 144 L. Ed. 2d 798 (1999) .

(n71)Footnote 71. 897 F. Supp. 144 (S.D.N.Y. 1995) . See § 4.12[B][2] *supra*.

(n72)Footnote 72. Milton H. Greene Archives, Inc. v. BPI Communications, Inc., 378 F. Supp. 2d 1189, 1197 n.8 (C.D. Cal. 2005) (Treatise quoted) . The Second Circuit found that case's "reasoning persuasive and consonant with the principles approved in our prior cases ... ." 168 F.3d at 592 .

(n73)Footnote 73. 168 F.3d at 592 . The effect was to consign the screenplay to the public domain.

(n74)Footnote 74. 531 F.3d 962 (9th Cir. 2008) , *cert. denied*, \_\_\_ U.S. \_\_\_, 129 S. Ct. 1002, 173 L. Ed. 2d 293 (2009) .

(n75)Footnote 75. See § 9.05[C] *infra*.

(n76)Footnote 76. 531 F.3d at 966 .

(n77)Footnote 77. *Shoptalk*, 168 F.3d at 592. See § 4.12[B][3] *supra*.

(n78)Footnote 78. 168 F.3d at 592.

(n79)Footnote 79. Recall that Richlin and Edwards wrote the screenplay for *The Pink Panther* as a work for hire. On that basis, no renewal rights would revert to the Richlin heirs, notwithstanding his untimely death, with respect to the screenplay. See § 9.03[D] *infra*. But the pair wrote the antecedent Treatment outside the employment context. It was as to that property that the dispute arose.

(n80)Footnote 80. 531 F.3d at 966 .

(n81)Footnote 81. 531 F.3d at 973 (citations omitted).

(n82)Footnote 82. See § 14.03[D] *infra*. Even if they successfully recovered an appreciable amount from the first *Pink Panther* movie, additional obstacles in the way of apportionment could stand in the way of the heirs' efforts to recover any appreciable sums from the various *Pink Panther* sequels. Many of the sequels credited Richlin and Edwards with creating the characters. 531 F.3d at 965 . But the question would arise whether they did so in the reverted Treatment, or by contrast as employees for hire in the original screenplay; only under the former supposition would Richlin's successors benefit.

(n83)Footnote 83. In that case, its term would be computed based on the author's lives. See § 9.09[A] *infra*. As to the *non-incorporated* aspects of the Treatment, by contrast, *Richlin* acknowledged that they retained their common law copyright protection. 531 F.3d at 970 n.11 (Treatise cited) .

(n84)Footnote 84. On the consequences of unnoticed publications, see § 7.14 *infra*.

## 1-4 Nimmer on Copyright § 4.12

(n85)Footnote 85. See § 9.08 *infra*. *Richlin* likewise noted that federal statutory protection applied to works published with proper notice. 531 F.3d at 971 (Treatise cited) .

(n86)Footnote 86. See § 7.12[C][2] *infra*.

(n87)Footnote 87. "The copyright registration for the motion picture lapsed and *McLintock!* fell into the public domain in 1991 when it was not renewed." 160 F.3d at 1225

(n88)Footnote 88. "On March 28, 1996, the Copyright Office declined to register the portions of the screenplays contained in the motion picture, now in the public domain. It determined that the release of the motion picture published the motion picture and all components of the motion picture, including the screenplay." *Id.* at 1225.

(n89)Footnote 89. *Id.* at 1226 (emphasis added). On the page cited by the Ninth Circuit, District Judge Pregerson noted: "The Register rejected *Batjac*'s applications because the screenplays acquired statutory copyright along with the motion picture in 1963 and then entered the public domain along with the motion picture in 1991." *Maljack Prods., Inc. v. UAV Corp.*, 964 F. Supp. 1416, 1419 (C.D. Cal. 1997) . He later elucidated: Here, *Batjac* published *McClintock!* in 1963 with copyright notice. By publishing the film with notice, *Batjac* secured statutory copyright for all parts of the work not separately copyrighted. This protection extended to all copyrightable components of the work including the screenplays. When *Batjac* failed to renew the motion picture copyright in 1991, all portions of the work covered by the motion picture copyright entered the public domain. Therefore, the Register properly refused to register the screenplays for copyright.

*Id.* at 1425 .

(n90)Footnote 90. *Id.* at 1425 .

(n91)Footnote 91. Note another court's reliance on *Batjac* and this treatise to conclude that, once a corporation "published a portion of the previously unpublished pre-existing material--as was its right as owner of the material at that time--its continued protection resided exclusively under statutory protection in the derivative work itself lest that portion of the pre-existing material ... be injected into the public domain." *Siegel v. Warner Bros. Entm't, Inc.*, 542 F. Supp. 2d 1098, 1125 (C.D. Cal. 2008) .

(n92)Footnote 92. 531 F.3d at 975 .

(n93)Footnote 93. Obviously, their interests were linked, to the extent that they jointly hired one attorney to effectuate renewal of each of their interests. That status alone differentiates the matter from *Richlin*, in which the heirs and MGM were wholly at odds.

(n94)Footnote 94. An additional aspect of the letter issued by the Copyright Office Board of Appeals implicates hyper-technical issues. The film *Husbands* was released in 1970, meaning that its renewal term commenced in 1998. On February 26, 1998, Edwin Komen timely submitted two renewal claims, one for the film and the other for the screenplay. He took the position that the original registration certificate (there was only one) for the motion picture in 1970 secured statutory copyright protection for both components and urged that two renewal certificates should issue. Accordingly, it is possible that, had the issue arisen in the posture of seeking two certificates for the *original* copyright term--one for the film, and the other for its screenplay--rather than for the *renewal* term, a different result may have inured. Thus viewed, the decision

## 1-4 Nimmer on Copyright § 4.12

merely stands for the proposition that, when a single original term certificate is at issue, only one renewal registration certificate may properly pertain. See § 9.05 *infra*.

(n95)Footnote 95. 531 F3d at 975 .

(n96)Footnote 96. See § 4.12[B][2] *supra*.

(n97)Footnote 97. 531 F.3d at 976 .

(n98)Footnote 98. "As holder of the common law rights in the screenplay and motion picture, Batjac chose to exercise its right to first publish in the medium of film." *Batjac*, 160 F.3d at 1235.

(n99)Footnote 99. See § 9.11[B][1] *infra*.

(n100)Footnote 100. Indeed, the Ninth Circuit had previously cited *Abend* for the proposition, "Congress and the courts have noted the usual practice: the author assigns his original and renewal copyright interests shortly after a work has been created." *Marascalco v. Fantasy, Inc.*, 953 F.2d 469, 475 (9th Cir. 1991) .

(n101)Footnote 101. In all the pertinent cases that arose under the 1909 Act-- *Abend*, *Batjac*, *Shoptalk*, right through *Richlin*--the author created a work that, by definition, was unpublished at that juncture and hence protected by common law copyright rather than yet by federal law. See § 2.02 *supra*. The author then assigned rights to a publisher, which was the entity to bring the work to publication and thus obtain statutory copyright protection. See N. 100 *supra*. In none of those cases did the publisher actually choose to publish the author's creation as a stand-alone production.

(n102)Footnote 102. See § 3.02 *supra*.

(n103)Footnote 103. *Abend*, 495 U.S. at 211.

(n104)Footnote 104. Note that, throughout the law of copyright, the effects of derivative works and collective works largely overlap. See Chap. 3 *supra*. See also *Shoptalk*, 168 F.3d at 591 (the "collective works," as used in § 7 of the 1909 Act, "are referred to as 'derivative works' in the treatises and caselaw").

(n105)Footnote 105. Given that the Treatment was a joint work, either *Richlin*'s successors could renew it, based on their 50% interest, or the appropriate party could renew based on *Blake Edwards*' other 50% share. As to that latter share, *Edwards* assigned his interests to *Mirisch* and then survived to renewal vesting, meaning that his grant remained operative during the renewal term. Accordingly, when *MGM* (as successor to *Mirisch*) filed to renew the film, its activities inured to the benefit of both 50% shares. See 531 F.3d at 976 (rejecting this proposition, based on previous conclusion that the Treatment had not been published "as such").

(n106)Footnote 106. *Shoptalk*, 168 F.3d at 587.

(n107)Footnote 107. See § 7.16[A][2][c] *infra*.

(n108)Footnote 108. 168 F.3d at 587.

(n109)Footnote 109. *Id.* at 589.

(n110)Footnote 110. *Id.* at 590.

(n111)Footnote 111. The court's conclusion is "that the Motion Picture at issue here, which was published in 1960 and was based on the Screenplay, published the Screenplay to the extent that the Screenplay was thereby disclosed." *Id.* at 593.

## 1-4 Nimmer on Copyright § 4.12

(n112)Footnote 112. Indeed, the opinion initially relies on this treatise's general proposition: "Because a derivative work by definition to some extent incorporates a copy of the pre-existing work, publication of the former necessarily constitutes publication of the copied portion of the latter." *Id.* at 973 , quoting § 4.12[A] *supra* .

(n113)Footnote 113. It is difficult to reconcile this upshot with the circumstances of the case. Richlin and Edwards wrote the Treatment in April 1962; the next month, they executed a "literary assignment agreement," whereby they transferred to Mirisch all their rights in the Treatment. *Richlin*, 531 F.3d at 965 . "The Assignment further provided that if Mirisch copyrighted the Treatment, Mirisch 'shall enjoy its rights hereunder for the full duration of such copyright or copyrights, including any and all renewals thereof.'" *Id.* As of that date, all parties (including defendant MGM's predecessor) therefore considered the work to be subject to protection. How its subsistence later vanished into the ether is shrouded in mystery.

(n114)Footnote 114. 531 F.3d at 973 .

(n115)Footnote 115. See § 4.05[B][4] *supra*.

(n116)Footnote 116. Reference is to the form contract promulgated by the American Guild of Authors and Composers.

(n117)Footnote 117. See § 9.05[C] *infra*.

(n118)Footnote 118. See Chap. 11 *infra*.

(n119)Footnote 119. *Kurfiss v. Cowherd*, 233 Mo. App. 397, 121 S.W.2d 282 (1938) ; *Wright v. Eisle*, 86 A.D. 356, 83 N.Y.S. 887 (2d Dep't 1903) (in addition to the completed structure, plans were publicly filed, see § 4.10 *supra*.); *Gendell v. Orr*, 13 Phila. 191 (Ct. of Common Pleas 1879).

(n120)Footnote 120. 174 Cal. App. 2d 744, 345 P.2d 546 (1959) .

(n121)Footnote 121. 347 Mass. 351, 197 N.E.2d 886 (1964) (Treatise cited) .

(n122)Footnote 122. 213 F. Supp. 184 (M.D. Fla. 1962) .

(n123)Footnote 123. See *Imperial Homes Corp. v. Lamont*, 458 F.2d 895 (5th Cir. 1972) (by implication); *Donald Frederick Evans & Assocs. v. Continental Homes, Inc.*, 785 F.2d 897, 901 n.7 (11th Cir. 1986) ; *Intown Enters. Inc. v. Barnes*, 721 F. Supp. 1263, 1266 (N.D. Ga. 1989) ; *Ashworth v. Glover*, 156 U.S.P.Q. 219, 20 Utah 2d 85, 433 P.2d 315 (Utah 1967) ; *Wallace v. Helm*, 161 U.S.P.Q. 121 (Cal. Super. Ct. 1969) ; *Krahmer v. Luing*, 182 U.S.P.Q. 494, 127 N.J. Super. 270, 317 A.2d 96 (1974) ; *Seay v. Vialpando*, 567 P.2d 285 (Wyo. 1977) ; *Masterson v. McCroskie*, 194 Colo. 460, 573 P.2d 547 (Colo. 1978) . But see § 13.06 *infra*.

(n124)Footnote 124. The court in *DeSilva* in fact reversed this reasoning, concluding that construction of a building is not a publication because such construction cannot constitute an infringing copy. See § 2.08[D][2] *supra*. In *Wood*, it is not clear from the opinion whether the defendants' infringing conduct consisted of copying of plans, construction of buildings, or both. The fact that the court considered, although it did not in fact issue, an injunction against completion of the structure suggests that it regarded the structure itself as an infringing copy. But cf. *Nucor Corp. v. Tennessee Forging Steel Serv., Inc.*, 476 F.2d 386 (8th Cir. 1973) , which indicates that a structure does not constitute a copy of the plans upon which the structure is based for publication purposes, but nevertheless suggests that an injunction might lie against the unauthorized construction of a structure based upon the plaintiff's plan.

## 1-4 Nimmer on Copyright § 4.12

(n125)Footnote 125. 224 Cal. App. 2d 327, 36 Cal. Rptr. 584 (D.C.A. 1964) .

(n126)Footnote 126. Under this rationale, presumably to the extent that such tract homes bore appropriate copyright notices, statutory copyright would have been acquired under the 1909 Act. See § 2.08[D][2][a] N. 179.3 *supra*. Nonetheless, the very notion of copyright notices on structures is rather peculiar, and falls outside the norm of experience, not to mention copyright jurisprudence. See Chap. 7 *infra*. But cf. Robert R. Jones Assocs., Inc. v. Nino Homes, 686 F. Supp. 160 (E.D. Mich. 1987) , *aff'd in part*, 858 F.2d 274 (6th Cir. 1988) (notice of copyright ownership posted in model homes).

(n127)Footnote 127. 239 Cal. App. 2d 504, 48 Cal. Rptr. 919 (1966) . See also Ballard H.T. Kirk & Assocs. v. Poston, 177 U.S.P.Q. 92, 33 Ohio App. 2d 117, 293 N.E.2d 102 (Ohio Ct. of App. 1972) (construction constitutes publication). *Contra* Nucor Corp. v. Tennessee Forging Steel Serv., Inc., 476 F.2d 386 (8th Cir. 1973) (public exhibition of the structure and general distribution of photographs thereof do not constitute divestive publications of the plans).

(n128)Footnote 128. Cf. Read v. Turner, 239 Cal. App. 2d 504, 48 Cal. Rptr. 919 (1966) . See Smith v. Paul, 174 Cal. App. 2d 744, 345 P. 2d 546 (1959) (N. 32 *supra*); Geo-Physical Maps, Inc. v. Toycraft Corp., 162 F. Supp. 141 (S.D.N.Y. 1958) . However, the fact that a building may not be copyrightable in itself does not preclude it from being characterized as a derivative work. Note the case of sound recordings, which although "writings," if fixed prior to February 15, 1972, are not copyrightable. See § 2.10[B][1] *supra* (noting possibility of such protection for qualifying foreign authors).

(n129)Footnote 129. See § 4.07[A] *supra*.

(n130)Footnote 130. *Id.* See also Nucor Corp. v. Tennessee Forging Steel Serv., Inc., 476 F.2d 386 (8th Cir. 1973) .

(n131)Footnote 131. Under this rationale, the architect of a famous building, attempting to establish that no "publication" of his plans had occurred, argued that "the Louisiana Superdome has never been put on the market for sale to the public." Curtis v. Benson, 959 F. Supp. 348, 351, 352 (E.D. La. 1997) (holding no publication).

(n132)Footnote 132. Nucor Corp. v. Tennessee Forging Steel Serv., Inc., 476 F.2d 386 (8th Cir. 1973) ; Wallace v. Helm, 161 U.S.P.Q. 121 (Cal. Super. Ct. 1969) . The contrary holding in Read v. Turner, 239 Cal. App. 2d 504, 48 Cal. Rptr. 919 (1966) , may be defended on the ground that in California, divestiture of common law copyright in architectural plans occurs (under Civil Code § 983b) when the plans are made "public" rather than when the owner "publishes" the work (as is the case with most other forms of literary property under § 983a). However, the *Wallace* decision, *supra*, held that construction plus private sale did not constitute a publication, and the opinion in *Read* appears to equate the distinctly different terminology in §§ 983a and 983b.

(n133)Footnote 133. See § 2.20[B] *supra*.

(n134)Footnote 134. H.R. Rep. No. 101-735, 101st Cong., 2d Sess. 24 (1990).

(n135)Footnote 135. *Id.*

(n136)Footnote 136. See 17 U.S.C. § 101 (definition of publication). Inasmuch as construction does not amount to "distribution ... to the public" nor to an offering "for purposes of further distribution," it could be argued that construction does not effect publication. See *id.* Moreover, that argument finds support in the fact that the Architectural Works Copyright Protection Act was enacted for the sake of compliance with the Berne Convention, see § 2.20[A] *su-*

## 1-4 Nimmer on Copyright § 4.12

*pra*, which expressly provides that "construction of a work of architecture shall not constitute publication." Berne Convention (Paris text), art. 3(3).

(n137)Footnote 137. Congress clearly contemplated the triggering act of "publication" of structures. H.R. Rep. No. 101-735, 101st Cong., 2d Sess. 24 (1990) (duration of architectural works for hire lasts 75 years following publication).

(n138)Footnote 138. H.R. Rep. No. 101-735, 101st Cong., 2d Sess. 24 n.56 (1990).

(n139)Footnote 139. In other words, publication of a building arguably does *not* constitute publication of the pictorial work embodied in the plans. See § 2.08[D][2][a] *supra*.

(n140)Footnote 140. 17 U.S.C. § 101.

(n141)Footnote 141. See § 4.04 *supra*.

(n142)Footnote 142. See § 2.08[D][2][a] N. 163.4 *supra*.

(n143)Footnote 143. See H.R. Rep. No. 101-735, 101st Cong., 2d Sess. 19 (1990).

(n144)Footnote 144. See § 2.20 *supra*.



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U.S. COURT OF APPEALS

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UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

BRADLEY RICHLIN; LANCE  
RICHLIN; MARK MANNIS; ABIGAIL  
RICHLIN SCHWARTZ,

Plaintiffs - Appellants,

LOUISE RICHLIN; ELYSSA PARTON;  
MICHELLE FORKEL,

Nominal Defendants and  
Involuntary Plaintiffs -  
Appellants,

v.

METRO-GOLDWYN-MAYER  
PICTURES, INC.; GEOFFREY  
PRODUCTIONS, INC.,

Defendants - Appellees.

No. 06-55307

D.C. No. CV-04-09162-DDP

OPINION

Appeal from the United States District Court  
for the Central District of California  
Dean D. Pregerson, District Judge, Presiding

Argued and Submitted October 15, 2007  
Pasadena, California

Before: FERNANDEZ and WARDLAW, Circuit Judges, and COLLINS,\* District Judge.

Opinion by Judge Wardlaw:

Inspector Jacques Clouseau, famously unable to crack the simplest of murder cases, would most certainly be confounded by the case we face. While Inspector Clouseau searched for the answer to the question, “Who did it?”, we must search for the answer to the question, “Who owns it?” In 1962, Maurice Richlin coauthored a story treatment (the “Treatment”)<sup>1</sup> involving the bumbling

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\* The Honorable Raner C. Collins, United States District Judge for the District of Arizona, sitting by designation.

<sup>1</sup> According to expert witness Dr. Drew Casper of the University of Southern California’s School of Cinema-TV, a treatment is a “brief outline, in prose, describing the actions of a movie plot, indicating characters along the way with little or no dialogue; it will run no more than 25 pages, it is the last stage before beginning a screenplay proper and as such, functions as a source for a script.” The Treatment is a fourteen-page mixture of story and staging. For example, the Treatment reads: “Festival that night. Table with Princess, George, Sir Charles, Simone and the Inspector. Checking on car—facts about Le Pouf—Princess sees Secretary and excuses herself. Simone and George dance. George suggests a later rendezvous. He will find a way to get rid of her husband.”

inspector. Later that year, before publication,<sup>2</sup> Richlin assigned all rights in the Treatment—including copyright and the right to renew that copyright—to a corporation that used it to create the smash-hit film, *The Pink Panther* (the “Motion Picture”). The Richlin heirs now claim federal statutory renewal rights in the Treatment and derivative works, including the Motion Picture. They assert that Richlin’s coauthorship of the Treatment makes him a coauthor of the Motion Picture. Alternatively, they contend that, because the Motion Picture secured statutory protection for the portions of the Treatment incorporated into the Motion Picture, and because the copyright in the Motion Picture was renewed for a second term, they are co-owners of the Motion Picture’s renewal copyright and all derivative works thereof. Although the Richlin heirs have developed several

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<sup>2</sup> “Publication” is a term of art in the law of copyright. Publication before the effective date of the current Copyright Act divested an author of his common law copyright rights and injected the work into the public domain free for anyone to use. Publication in accordance with the statutory formalities of the 1909 Act, 17 U.S.C. § 10 (1909), however, both divested the owner of his common law copyright and invested him with federal statutory copyright protection. The rationale for this doctrine is rooted in the United States Constitution, which provides that “[t]he Congress shall have power . . . [t]o promote the progress of science and useful arts, by securing, for limited times to authors and inventors, the exclusive right to their respective writings and discoveries.” U.S. CONST. art. I, § 8, cl. 8. In exchange for securing the exclusive right to exploit his work that federal copyright accords, the author agrees that he will enjoy this monopoly for the limited duration Congress granted in the Copyright Acts, so that the public is the ultimate beneficiary. *See generally* 1 M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT §§ 4.01, 4.03 (2007).

theories that could supply the answer to the question, “Who owns it?”, unlike Inspector Clouseau, they have not quite stumbled upon a theory that favors them. We therefore affirm the district court’s conclusion that the Richlin heirs have no interest in the copyright to the Motion Picture.

## I. BACKGROUND

The material facts are largely undisputed. In April 1962, Maurice Richlin and Blake Edwards coauthored a fourteen-page Treatment initially entitled *The Pink Rajah*, but later renamed *The Pink Panther*. The Treatment served as the basis for the well-known motion picture, *The Pink Panther*, and numerous derivative works. It appears that the Treatment set forth many of the plot elements and characters, including Inspector Clouseau himself, developed into the screenplay and incorporated into the Motion Picture.

Richlin and Edwards entered into an employment agreement dated May 14, 1962 (the “Employment Agreement”) with the Mirisch Corporation of Delaware (“Mirisch”) to write the screenplay for the Motion Picture.<sup>3</sup> They agreed to create the screenplay as a “work made for hire.” Under this contract, Richlin and

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<sup>3</sup> The Richlin heirs contend that the Employment Agreement was executed on June 12, 1962. The precise date of the contract’s execution does not affect our holding.

Edwards combined received \$150,000 for their work on the Treatment and the screenplay.<sup>4</sup>

Later that month, on May 24, 1962, Richlin and Edwards executed a literary assignment agreement (the “Assignment”) whereby they transferred and assigned “forever . . . that certain story (which term shall cover all literary material written by [Richlin and Edwards] in connection therewith including any adaptations, treatments, scenarios, dialogue, scripts and/or screenplays) entitled: ‘Pink Rajah’ also entitled or known as ‘Pink Panther’” in exchange for \$1 “and other good and valuable consideration in hand” paid by Mirisch. Mirisch also received “the right to use [Richlin’s and Edwards’s] name[s] as the author of the literary composition upon which said adaptations, or any of them, are based.” The Assignment further provided that if Mirisch copyrighted the Treatment, Mirisch “shall enjoy its rights

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<sup>4</sup> A letter dated June 28, 1962, confirmed that “the \$150,000 payment for property [the Treatment] and screenplay is divided \$50,000 for property and \$100,000 for screenplay.”

hereunder for the full duration of such copyright or copyrights, including any and all renewals thereof.”<sup>5</sup>

In 1963, *The Pink Panther* was released and distributed in theaters to great acclaim. It was followed by nine movie sequels,<sup>6</sup> many of which gave screen credit to Richlin and Edwards for creating the characters. The original Motion Picture bears a copyright notice of 1963 in the name of Mirisch and G&E Productions. In 1964, the U.S. Copyright Office issued a certificate of registration for the “motion picture” entitled “The Pink Panther” under the Copyright Act of 1909 (“1909 Act”).

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<sup>5</sup> Although Richlin assigned to Mirisch all rights in the unpublished Treatment, an assignment of a statutory renewal copyright, assuming the Treatment became the subject of statutory copyright, would not become effective unless the author/assignor lives to the commencement of the renewal term, which is when the renewal interest vests in the author. *See Stewart v. Abend*, 495 U.S. 207, 220 (1990) (“[I]f the author dies before the commencement of the renewal period, the assignee holds nothing.” (citing *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373, 377 (1960) (“Section 24 [of the 1909 Act] reflects, it seems to us, a consistent policy to treat renewal rights as expectancies until the renewal period arrives.”))). The Richlin heirs’ claim is based on Richlin’s predeceasing the vesting of the renewal interest provided by statutory copyright.

<sup>6</sup> *A Shot in the Dark* (1964); *Inspector Clouseau* (1968); *The Return of the Pink Panther* (1975); *The Pink Panther Strikes Again* (1976); *Revenge of the Pink Panther* (1978); *Trail of the Pink Panther* (1982); *Curse of the Pink Panther* (1983); *Son of the Pink Panther* (1993); and *The Pink Panther* (2006).

The Certificate of Registration identifies the claimant and author as “Mirisch-G&E Productions.” The certificate lists the date of publication as March 18, 1964, but notes that the copyright notice on the Motion Picture bears a date of 1963. The Richlin heirs concede that neither the Treatment nor the screenplay was ever separately published or registered for federal copyright protection.

Richlin died on November 13, 1990. The original term of copyright in the Motion Picture—twenty-eight years from the first date of publication—was set to expire in 1991,<sup>7</sup> but it was renewed that year by the successors-in-interest to Mirisch-G&E Productions, MGM-Pathé Communications Co./Geoffrey Productions Inc. (collectively, “MGM”). A Renewal Certificate issued, which identified MGM as the claimant and “proprietor of copyright in a work made for hire” and the author and original claimant as Mirisch-G&E Productions. None of the Richlin heirs attempted to secure a renewal interest in the Treatment or screenplay, and there is no separate renewal certificate for either.

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<sup>7</sup> Under the 1909 Act, as amended, federal copyright protection was secured “by publication thereof with the notice of copyright required by [§ 19] of this title.” 17 U.S.C. § 10 (1909). There is no dispute that the Motion Picture was released and distributed with proper notice in 1963, although it was not registered with the U.S. Copyright Office until 1964. Because “the copyright secured by [the 1909 Act] . . . endure[d] for twenty-eight years from the date of first publication,” 1991 was the year the original term would expire. *See id.* § 24. The Renewal Registration identifies its effective date as February 13, 1991.

The Richlin heirs filed suit in the United States District Court for the Central District of California seeking declaratory relief and an accounting. They claim a 50 percent renewal interest in the Treatment and all derivative works. During the course of this litigation, the theories undergirding this claim have evolved. The complaint relies on the theory that publication of the derivative work (the Motion Picture) effectuated publication of the underlying work (the Treatment). Under this theory, when MGM renewed the Motion Picture's statutory copyright in 1991, this renewed the copyright in the Treatment on behalf of the Richlin heirs, which gave the Richlin heirs an interest in the Motion Picture's renewal copyright. These principles carry some theoretical weight in copyright law; however, the Richlin heirs failed to renew their statutory copyright, if any, in the Treatment in 1991. That may explain why, by the time the district court granted summary judgment in favor of MGM, the Richlin heirs had abandoned their argument based on a statutory copyright in the Treatment. Instead, they argued that they have a copyright interest in the Motion Picture as coauthors based on Richlin's coauthorship of the Treatment, which was incorporated into the Motion Picture. The district court analyzed the requirements of a "joint work" prepared by coauthors, who under copyright law would each be deemed an owner of the copyright. The court rejected this theory because, under the factors set forth in



*Aalmuhammed v. Lee*, 202 F.3d 1227, 1234 (9th Cir. 2000), Richlin had no control over the Motion Picture, and there was no manifestation of intent—by contract or otherwise—that Richlin and Edwards would be coauthors of the Motion Picture. *See id.* at 1234 (analyzing coauthorship under three factors: control, objective manifestation of intent to be coauthors, and whether the audience appeal of the work can be attributed to all coauthors). Because the coauthorship theory failed, the district court awarded summary judgment in favor of MGM, declining to reach any other issues. The Richlin heirs timely appeal.

## II. JURISDICTION AND STANDARD OF REVIEW

The district court had jurisdiction pursuant to 28 U.S.C. § 1338, which confers subject matter jurisdiction over copyright actions. We have jurisdiction over final judgments of the district courts pursuant to 28 U.S.C. § 1291.

We review a district court’s grant of summary judgment de novo. *Bagdadi v. Nazar*, 84 F.3d 1194, 1197 (9th Cir. 1996). In reviewing the grant of summary judgment, we “must determine, viewing the evidence in the light most favorable to the nonmoving party, whether genuine issues of material fact exist and whether the district court correctly applied the relevant substantive law.” *Id.*

### **III. DISCUSSION**

On appeal, the Richlin heirs maintain their contention that because Richlin and Edwards jointly authored the Treatment, and the Treatment became a critical component of the Motion Picture, Richlin was a co-author of the Motion Picture, and was therefore a co-owner on whose heirs' behalf MGM secured a renewal interest in the Motion Picture's copyright in 1991. Alternatively, the Richlin heirs resort to the theory underlying their complaint. They contend that publication of the Treatment with the Motion Picture secured a statutory copyright for the Treatment, which was renewed on their behalf by MGM when it renewed the Motion Picture's copyright. We address each argument in turn.

#### **A. Coauthorship of the Motion Picture**

To determine whether Richlin had an interest in the Motion Picture's federal statutory copyright, we must consider the question of coauthorship. The Richlin heirs argue that because Richlin coauthored the Treatment, which was a substantial component of the Motion Picture, he is also a coauthor of the Motion Picture. This coauthorship, according to the Richlin heirs, gives them an interest in the Motion Picture's copyright. Under this facially appealing, but legally unsustainable, argument, an interest in the renewal term of copyright and all subsequent motion

pictures and adaptations based on that copyright would revert to the Richlin heirs.<sup>8</sup> See 17 U.S.C. § 201(a) (1976) (“The authors of a joint work are coowners of copyright in the work.”).

We agree with the district court that Richlin and Edwards were not coauthors of the Motion Picture. Richlin and Edwards wrote the Treatment in 1962, and the Motion Picture was copyrighted when published with notice in 1963; therefore, the Richlin heirs’ claim of coauthorship is governed by the 1909 Act. The 1909 Act, however, did not expressly mention or define joint works or coauthorship. Nevertheless, as early as 1915, in *Maurel v. Smith*, Judge Learned Hand applied the universally adopted common law definition of joint authors to the 1909 Act, holding that they “undertake jointly to write a play, agreeing on the general outline and design and sharing the labor of working it out.” 220 F. 195, 199 (S.D.N.Y. 1915) (quoting *Levy v. Rutley*, L.R. 6 C.P. 523 (1871)); see also *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944) (“[I]t 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

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<sup>8</sup> The Richlin heirs’ claim to the renewal copyright in the Motion Picture rests on the rule that an assignment of renewal rights by the author of a copyrighted work does not become effective unless the renewal interest vests in the then-living author. See *Abend*, 495 U.S. at 220.

such.”); LIOR ZEMER, *THE IDEA OF AUTHORSHIP IN COPYRIGHT* 190 n.15 (2007) (“In *Levy v. Rutley*, the earliest recorded case on joint authorship, Byles[,] J[.] found joint authorship to exist although one person had contributed a very small amount of work to the execution.”). Then, in *Picture Music, Inc. v. Bourne, Inc.*, a district court suggested a “statutory revision[] of the copyright law [that] would define a ‘joint work’ as one ‘prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.’” 314 F. Supp. 640, 646 (S.D.N.Y. 1970). This was the precise wording that Congress used to define “joint work” when it enacted the 1976 Act. *See* 17 U.S.C. § 101 (1976). As Professor Nimmer explains, “[t]he 1909 Act did not expressly refer to the doctrine of joint ownership, but its principles, largely unchanged under the current Act, were firmly established by case law, and were applicable to common law as well as statutory copyright.” 1 M. NIMMER & D. NIMMER, *NIMMER ON COPYRIGHT* § 6.01 n.1 (2007). Because the 1976 Act incorporated the well-established case law interpreting the definition of “joint work” under the 1909 Act, we may assess the Richlin heirs’ claim under the more fully developed rubric of the 1976 Act.

Section 101 of the 1976 Act defines “joint work” as “a work prepared by two or more authors with the intention that their contributions be merged into

inseparable or interdependent parts of a unitary whole.” 17 U.S.C. § 101 (1976).

A “joint work” requires each author to make “an independently copyrightable contribution.” *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 521 (9th Cir. 1990). “The authors of a joint work are coowners of copyright in the work.” 17 U.S.C. § 201(a) (1976). Even if a person’s contribution is minor, once he is accorded joint authorship status, he enjoys all benefits of joint authorship. See *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1068 (7th Cir. 1994); *Cnty. for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1498 (D.C. Cir. 1988), *aff’d on other grounds*, 490 U.S. 730 (1989); *Bencich v. Hoffman*, 84 F. Supp. 2d 1053, 1055 (D. Ariz. 2000); 1 NIMMER § 6.08.

In *Aalmuhammed v. Lee*, 202 F.3d 1227, 1234 (9th Cir. 2000), we set forth three criteria for determining whether a work is jointly authored under § 101. First, we determine whether the “putative coauthors ma[de] objective manifestations of a shared intent to be coauthors.” *Id.* A contract evidencing intent to be or not to be coauthors is dispositive. *Id.* Second, we determine whether the alleged author superintended the work by exercising control. *Id.* Control will often be the most important factor. *Id.* Third, we analyze whether “the audience appeal of the work” can be attributed to both authors, and whether “the share of each in its success cannot be appraised.” *Id.* (quotations omitted).

The plain language of § 101 makes clear that Richlin is a coauthor of the Treatment. Viewing the facts in the light most favorable to the Richlin heirs, Richlin and Edwards could have secured statutory copyright for the Treatment before assigning it to Mirisch, as it was a fourteen-page original creative story written jointly by Richlin and Edwards. *See* 17 U.S.C. § 4 (1909) (“The works for which copyright may be secured under this title shall include all the writings of an author.”); 17 U.S.C. § 102 (1976) (“Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . .”); 1 NIMMER §§ 2.04 and 6.01 (articulating standards for “literary works” and “joint works”). Moreover, the Treatment “was prepared by two or more authors,” Richlin and Edwards, who clearly intended that it be “merged into inseparable or interdependent parts of a unitary whole.” 17 U.S.C. § 101 (1976). Indeed, this is what Richlin and Edwards accomplished when they presented the completed Treatment to Mirisch.

But the Treatment is not the appropriate reference point. The Richlin heirs’ claim for declaratory relief and an accounting rests on their argument that, by virtue of his contribution to the Treatment, Richlin is coauthor of the Motion Picture. Thus, the work that must be examined to determine joint authorship is the Motion Picture, not the Treatment. The plain language of § 101 does not shed light

on whether Richlin was a coauthor of the Motion Picture. Applying the *Aalmuhammed* factors to Richlin's involvement in the Motion Picture, however, confirms that Richlin and Edwards were not coauthors of that work.

We must first determine whether “putative coauthors ma[de] objective manifestations of a shared intent to be coauthors.” *Aalmuhammed*, 202 F.3d at 1234. A contract evidencing intent to be or not to be coauthors is dispositive. *Id.* In the absence of a contract, we look to other objective evidence of intent. *Id.* The district court found that the Assignment was contractual evidence of an objective manifestation that the parties did *not* intend to be coauthors. The district court reasoned that the Assignment conveyed forever “that certain story . . . including any adaptations, treatments, scenarios, dialogue and/or screenplays.” Professor Nimmer clarifies that “forever,” when used in conjunction with conveyance of a *copyrighted* work (which the Treatment was not), “should be considered a shorthand for ‘the original and renewal term of copyright, plus any extensions, reversions, resurrections, or other circumstances that prolong the term.’” 3 NIMMER § 10.14[N]. Although the Treatment was not the subject of a federal statutory copyright, we agree with the district court that when Richlin and Edwards conveyed all present and future interests in the Treatment and derivative works to Mirisch, the parties to the contract could not consistently entertain the intent that

Richlin and Edwards would be coauthors of the Motion Picture. Rather, Mirisch was given the right to exploit the Treatment in any way he chose. In any event, no language in the Assignment indicates any intent that Richlin and Edwards were to coauthor the Motion Picture.

In light of the Assignment, the Employment Agreement, and the surrounding circumstances, there were no “objective manifestations of a shared intent to be coauthors.” *Aalmuhammed*, 202 F.3d at 1234. The Assignment conveyed to Mirisch all present and future rights in the Treatment and derivative works, including the common law “copyright.” Neither the Assignment nor the Employment Agreement said anything about Richlin becoming a coauthor of the Motion Picture. None of *The Pink Panther* sequels lists Richlin as coauthor; rather, they simply give him screen credit as the creator of the original story and characters. Both the initial- and renewal-term statutory copyright registrations list Mirisch and its successors-in-interest as authors of the Motion Picture, not Richlin. Furthermore, the Employment Agreement specified that Richlin and Edwards were Mirisch’s “employees,” rendering the screenplay a “work made for hire,” which is



also inconsistent with the view that Richlin coauthored the Motion Picture.<sup>9</sup> See 17 U.S.C. § 26 (1909); *Warren v. Fox Family Worldwide, Inc.*, 328 F.3d 1136, 1140 (9th Cir. 2003) (“[I]f the work is made for hire, ‘the employer or other person for whom the work was prepared is considered the author . . . , and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all the rights in the copyright.’” (quoting 17 U.S.C. § 201(b) (1976))).

The second factor—whether Richlin supervised the Motion Picture by exercising control—favors MGM as well. Richlin did not exercise any supervisory powers over the Motion Picture, a factor that *Aalmuhammed* indicates will often be the most important. *Aalmuhammed*, 202 F.3d at 1234. The Assignment granted to Mirisch “forever . . . the absolute and unqualified right to

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<sup>9</sup> On November 25, 1992, MGM sent a check for \$8,563.62 and a letter to Richlin’s widow, Louise Richlin, stating “[t]his check constitutes payment in full for any rights used in or relating to [*Son of Pink Panther*] that are owned or controlled by Maurice Richlin or by you pursuant to the Writers Guild of America agreement or otherwise.”

Upon first inspection, this would appear to be a clue as to which parties or persons own the renewal interest in the Motion Picture. However, such monies paid are but one more lead into a dead end. In February 1965, Richlin, Edwards, and the Writers Guild of America entered into a settlement agreement with Mirisch resolving a dispute regarding *A Shot in the Dark* and the applicability of sequel payments. The check paid to Louise Richlin in 1992 was issued pursuant to this settlement agreement, which is a contractual matter unrelated to the question of ownership of the renewal copyright interest in the Motion Picture.

use the [Treatment], in whole or in part, in whatever manner said purchaser may desire.” Thus, while Richlin may have had control over the Treatment as originally written, he had no control over how the Treatment was incorporated into the Motion Picture. Moreover, although Richlin and Edwards cowrote the screenplay, the screenplay was a work made for hire pursuant to the Employment Agreement, making Mirisch the author/owner of the screenplay. 17 U.S.C. § 26 (1909); *Warren*, 328 F.3d at 1140. Any control that Richlin may have had over the screenplay does not lend support to his claim that he exercised any control over the creation of the Motion Picture.

We agree with the district court that the third factor, whether “the audience appeal of the work” can be attributed to both authors, and whether “the share of each in its success cannot be appraised,” favors the Richlin heirs, in light of the summary judgment standard. *Aalmuhammed*, 202 F.3d at 1234. As the district court noted, it is nearly impossible to determine how much of the Motion Picture’s audience appeal and success can be attributed to the Treatment. Although the characters that Richlin helped to create formed the basis for the Motion Picture’s success, perhaps it was Peter Sellers’s legendary comedic performance, Henry

Mancini’s memorable score, or Blake Edwards’s award-winning direction<sup>10</sup>—none of which can be attributed to Richlin—that was the main draw. Nevertheless, given that the Motion Picture adopted the characters and original story from the Treatment, and that, absent the Treatment, the Motion Picture likely would not exist, we cannot say the district court erred in finding that this factor favors the Richlin heirs.

Given that the two primary *Aalmuhammed* factors weigh most heavily in favor of Appellees, we hold that Richlin was not a coauthor of the Motion Picture. Therefore, there is no renewal interest in the Motion Picture that might conceivably have vested in the Richlin heirs under a theory of coauthorship.

#### **B. Significance of “Publication” of the Treatment**

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<sup>10</sup> Edwards was nominated for an Academy Award in 1982 for writing *Victor/Victoria*, and received an honorary Academy Award in 2003 “in recognition of his writing, directing and producing an extraordinary body of work for the screen,” such as *The Pink Panther* series and *Breakfast at Tiffany’s*.

At the time the Treatment was incorporated into the Motion Picture,<sup>11</sup> the Treatment was neither published nor the subject of federal statutory copyright. From this predicate, the Richlin heirs weave together a string of copyright truisms culled principally from *Batjac Productions Inc. v. Goodtimes Home Video Corp.*, 160 F.3d 1223 (9th Cir. 1998), *Stewart v. Abend*, 495 U.S. 207 (1990), and *Selznick v. Turner Entertainment Co.*, 990 F. Supp. 1180, 1185 (C.D. Cal. 1997), to theorize that the Treatment achieved statutory copyright protection when the Motion Picture was published with notice in 1963. They further argue that because Richlin predeceased the vesting of the statutory renewal rights in the Treatment, those renewal rights reverted to the Richlin heirs. When MGM renewed the statutory copyright in the Motion Picture, this renewed the Treatment's statutory

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<sup>11</sup>All parties agree, at least for purposes of summary judgment and appeal, that the Treatment was incorporated into the Motion Picture. Those copyrightable elements of the Treatment that were not incorporated into the Motion Picture retained their common law copyright protection because they were not published, and received statutory copyright protection with the enactment of the 1976 Act. *See* 17 U.S.C. § 303(a) (1976); 3 NIMMER § 9.09[A]. The questions of whether any such copyrightable elements that were not incorporated into the Motion Picture exist, and if so, what they might be and whether they constitute a copyrightable “work,” are not before us on this appeal.

copyright on behalf of the Richlin heirs.<sup>12</sup> And, because the Motion Picture incorporated the Treatment, the Richlin heirs are now co-owners of the Motion Picture's copyright.

Our analysis begins with an assessment of exactly what rights Richlin did and did not own when he assigned all rights in the Treatment to Mirisch on May 24, 1962. The original copyright in the Motion Picture is governed by the 1909 Act because the Treatment and the Motion Picture were created before January 1, 1978, when the Copyright Act of 1976 ("1976 Act") became effective. 17 U.S.C. § 304 (1976). The copyright was renewed in 1991, after the effective date of the 1976 Act. Thus, to analyze questions arising from events that occurred before January 1, 1978, such as who is the author of the Treatment, the 1909 Act applies; for events that occurred after that date, such as registration of the renewal copyright, the 1976 Act applies. *See* 1 NIMMER OV-7 ("In determining the corpus of law that governs a particular situation, the guiding principle should be to apply the law in effect when the infringement (or other activity), upon which suit is based, arises.").

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<sup>12</sup> According to the Richlin heirs, because Edwards lived to the renewal term, MGM retained the right to renew the supposed statutory copyright in the Treatment, even though Richlin's interest in the Treatment had reverted to his heirs.

Unlike the 1976 Act, the 1909 Act recognized a distinction between state (or common law) and federal copyright protection. *Batjac*, 160 F.3d at 1226. Unpublished works were protected by state common law or statute, while works published in accordance with the statutory formalities received federal statutory protection. *Id.* State common law protection—which afforded only rights of first publication and transferability of ownership—commenced when the work was created and ended when the work was published. *See* 1 NIMMER § 2.02. Once published, the work would obtain federal statutory protection, as long as it was published with proper notice. 17 U.S.C. §§ 10, 19 (1909). The duration of statutory copyright was twenty-eight years, with the option to renew for another twenty-eight years. *Id.* § 24.

Because the Treatment was not published at the time of the Assignment, Richlin’s and Edwards’s property interest in it is governed by California law at the time of transfer. *Wheaton v. Peters*, 33 U.S. 591, 658 (1834) (“When . . . a common law right is asserted, we must look to the state in which the controversy originated.”). In California, “the basic principles governing ‘common law’ copyright have been codified in Civil Code section 980 et seq.” *Zachary v. W. Publ’g Co.*, 75 Cal. App. 3d 911, 918 (1977). When Richlin and Edwards submitted the Treatment to Mirisch, it was the subject of California state law

(otherwise known as “common law”) copyright protection. As coauthors, in the absence of a contrary agreement, they were joint owners of the Treatment. CAL. CIV. CODE § 981(a) (1949). Pursuant to former California Civil Code § 980 *et seq.*, they had the right “to *exclusively* possess it, use it, and transfer or otherwise dispose of it.” 13 WITKIN SUMMARY OF CAL. LAW (10th ed. 2005) Personal Property, § 46; *see also Carpenter Found. v. Oakes*, 26 Cal. App. 3d 784, 793 (1972).

California common law copyright provided for two key mechanisms to divest the copyright owner of his copyright—publication and transfer. Once the copyright owner published his work, it lost all common law copyright protection.<sup>13</sup> *See Carpenter*, 26 Cal. App. 3d at 793 (“[I]f the owner publishes the composition, it may be used by any person . . . .”); CAL. CIV. CODE § 983(a) (1949). The copyright owner could also transfer his right of first publication before the work was published. CAL. CIV. CODE § 982 (1949); *Loew’s Inc. v. Superior Court*, 18 Cal. 2d 419, 421 (1941). Once the common law copyright is transferred, however, “the transferee becomes the lawful owner, unhindered by the fact that he is not the author.” *Carpenter*, 26 Cal. App. 3d at 794–95.

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<sup>13</sup> If the owner of a common law copyright published the work without complying with federal statutory requirements, it would enter the public domain. *Abend*, 495 U.S. at 233.

It is undisputed that the Treatment was unpublished and not the subject of federal statutory copyright protection when Richlin and Edwards transferred it to Mirisch. The transfer of that state common law right neither invested the Treatment with statutory copyright protection nor divested the work of its common law copyright protection. The significance of the transfer, however, is that Mirisch became the owner of the common law copyright in the Treatment. *See id.* In 1963, Mirisch published the Motion Picture with notice, thus securing federal statutory protection for the Motion Picture.

Acknowledging that the Treatment was unpublished until its copyrightable elements were published by virtue of the release and distribution of the Motion Picture in 1963 as components thereof, the Richlin heirs argue, in misplaced reliance upon our decision in *Batjac*, that the 1991 renewal of the Motion Picture effected a renewal of the unpublished Treatment's—now statutory—copyright. In *Batjac*, James Edward Grant wrote an original screenplay entitled “McLintock!” and almost immediately assigned all rights in the unpublished screenplay to Batjac, who incorporated the screenplay into the motion picture by the same name. *Batjac*, 160 F.3d at 1225. The motion picture was released to the general public and received federal statutory copyright protection in 1963. *Id.* Batjac failed to renew the copyright in the motion picture, which fell into the public domain in



1991. *Id.* After GoodTimes Home Video Corp. (“GoodTimes”) began producing and selling videocassettes of the motion picture, Batjac sought copyright registration for two intermediate drafts of the screenplay, and then brought suit against GoodTimes for copyright infringement. *Id.* Batjac’s suit was brought to a halt when the Copyright Office rejected Batjac’s application to copyright the portions of the screenplay that were incorporated into the motion picture, on the ground that the motion picture—and all of its component parts—had fallen into the public domain. *Id.* On Batjac’s challenge to this ruling, we deferred to the Copyright Office’s interpretation of the 1909 Act and held that the “screenplay was copyrightable and is a component of the motion picture to the extent it was incorporated into the film. As such, it fell into the public domain with the motion picture.” *Id.* at 1235 (citing 17 U.S.C. § 3 (1909) (“The copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted . . . .”)); *see also id.* at 1233 (“[A]n unpublished screenplay protected by common law is published by a motion picture to the extent that it is incorporated.”); *Shoptalk, Ltd. v. Concorde-New Horizons Corp.*, 168 F.3d 586, 591, 592 (2d Cir. 1999) (“We conclude . . . that if a previously unpublished screenplay is embodied in a motion picture, so much of the screenplay as is disclosed in the motion picture is published when the motion picture is

published.”); *Classic Film Museum, Inc. v. Warner Bros., Inc.*, 597 F.2d 13, 14–15 (1st Cir. 1979) (holding that when the statutory copyright to a motion picture fell into the public domain, so too did any common law copyright in the motion picture’s component parts, such as the screenplay); 1 NIMMER § 4.12[A] (“Because a derivative work by definition to some extent incorporates a copy of the pre-existing work, publication of the former necessarily constitutes publication of the copied portion of the latter.”).

Under *Batjac*, publication of the Motion Picture published those elements of the Treatment incorporated into the Motion Picture, *see* 17 U.S.C. § 3 (1909), and thus the Motion Picture’s federal statutory copyright protection extended to those copyrightable elements of the Treatment that were published as components of the Motion Picture; however, this did not constitute publication of the Treatment “as such”—i.e., as a work standing alone. We have held that courts should generally defer to the Register of Copyright’s (“Register”) interpretation of the copyright statutes, as “[t]he Register has the authority to interpret the copyright laws and . . . its interpretations are entitled to judicial deference if reasonable.” *Batjac*, 160 F.3d at 1230 (quoting *Marascalco v. Fantasy, Inc.*, 953 F.2d 469, 473 (9th Cir. 1991)). Accordingly, in *Batjac* we adopted the Register’s view that publication of the screenplay, or here, the Treatment, did not publish the Treatment as an

independent work, but just those portions incorporated into the published work.

We deferred to the Register's reliance on the *Compendium of Copyright Office*

*Practices*, which governed the Register's practices under the 1909 Act. The

*Compendium* provides:

Publication of a portion of a work does not necessarily mean that the work as a whole has been published.

Examples:

(1) Publication of a detailed plot summary of a play does not constitute publication of the play as a whole.

(2) Publication of a movie version of an unpublished story does not constitute publication of the story as such.

*Batjac*, 160 F.3d at 1230 (quoting Compendium I, COMPENDIUM OF COPYRIGHT OFFICE PRACTICES § 3.1.1 IV(a)). The *Compendium* makes clear that, by virtue of the publication of the Motion Picture, the Treatment "as such" did not become the subject of statutory copyright. Rather, only those elements of the Treatment that were incorporated into the Motion Picture were published, and they were statutorily protected as components of the Motion Picture, not as an independent

“work.” Thus, we reject the Richlin heirs’ contention that publication of the Motion Picture with notice invested the Treatment with a statutory copyright.<sup>14</sup>

The Richlin heirs contend that this reading of *Batjac* is inconsistent with the Supreme Court’s decision in *Stewart v. Abend*. There, Cornell Woolrich authored a short story entitled “It Had to Be Murder,” which was published as a collective work with other short stories in Dime Detective Magazine (“Dime Detective”) in 1942. *Abend*, 495 U.S. at 211. Woolrich assigned to Dime Detective only his right to publication, retaining all other rights. *Id.* When the magazine was published, the magazine’s blanket copyright notice secured federal statutory copyright for the separate and independent works it contained, including Woolrich’s story. *Id.* In 1945, Woolrich assigned to a producer the federal statutory right to make a motion picture version of “It Had to Be Murder,” and also agreed to renew the copyright in the story and to assign the same motion picture rights to the producer at the appropriate time. *Id.* at 212. The producer subsequently assigned his rights to Jimmy Stewart and Alfred Hitchcock’s production company, which developed “It Had to Be Murder” into the motion picture *Rear Window*. *Id.* Woolrich died

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<sup>14</sup> Although the copyright in the Motion Picture “protect[ed] all the copyrightable component parts of the work,” 17 U.S.C. § 3 (1909), that is not the same as securing a copyright in those component parts. Richlin and Edwards would have had to publish the Treatment itself with notice to secure a copyright in that “work” under the 1909 Act.

before the renewal term commenced. *Id.* at 213. The executor of Woolrich’s estate then renewed the copyright in the story and assigned it to Abend, who, years later, sued Stewart, Hitchcock, MCA Inc., and Universal Film Exchanges for infringement of the right to distribute *Rear Window* during the story’s renewal term of copyright. *Id.* at 212–13. The Supreme Court held that “if the author dies before the renewal period, then the assignee may continue to use the original work only if the author’s successor transfers the renewal rights to the assignee.” *Id.* at 221; *see also id.* at 219 (“[W]hen an author dies before the renewal period arrives, his executor is entitled to the renewal rights, even though the author previously assigned his renewal rights to another party.”); *id.* at 219–20 (“The right of renewal is contingent. It does not vest until the end [of the original term.]” (quoting 5 LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT, Part K, p. 77 (E. Brylawski & A. Goldman eds. 1976) (statement of Mr. Hale))). Therefore, because Woolrich was not alive at the commencement of the renewal term, the renewal term of copyright did not vest in him, and his prevesting transfer was null and void. Abend, the assignee of the executor of Woolrich’s estate, was the rightful owner of the renewal term of copyright in the story “It Had to Be Murder.” *Id.* at 235–36.

Richlin died in 1990. Had the Treatment become the subject of statutory copyright as a separate and independent work, its renewal term would not

commence until 1991. According to the Richlin heirs, because Richlin, like Woolrich, died before the right to renew the copyright vested, the right to renew the copyright in the Treatment reverted to them.<sup>15</sup> The disconnect in this theory is that, unlike the story “It Had to Be Murder,” an independent work, the Treatment was never the subject of federal copyright protection as an independent work. Because it never was invested with statutory copyright protection, there was no right to renew and, therefore, no renewal right to revert to the Richlin heirs.

Indeed, the Copyright Office has rejected the Richlin heirs’ theory that previously unpublished components of a motion picture receive independent statutory copyright protection by virtue of incorporation into a motion picture that itself becomes the subject of federal statutory copyright protection. In *Husbands*, the Copyright Office Board of Appeals (“BOA”) expressly ruled that an unpublished underlying work that is incorporated into a statutorily copyrighted motion picture does not receive a statutory copyright independent of the motion picture’s copyright. *Husbands*, Copyright Office Board of Appeals Letter, Control No. 10-600-754-2(C), at 6 (May 14, 2002), *available at* [http://www.ipmall.info/hosted\\_resources/CopyrightAppeals](http://www.ipmall.info/hosted_resources/CopyrightAppeals). There, John

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<sup>15</sup> Under this theory, during the supposed first term of copyright, the Richlin heirs would have had no interest because Richlin was free to assign, and did assign, all rights to Mirisch.

Cassavetes authored a screenplay, but did not secure statutory copyright in the work. *Id.* at 1. He transferred “the rights” to Faces Music Inc., which incorporated the screenplay into the motion picture, *Husbands*. The motion picture received federal statutory copyright protection in 1970. *Id.* at 2. In 1998, when it came time to renew the motion picture’s copyright for its second term, Cassavetes’s heirs filed two renewal copyright registrations, one for the screenplay and one for the motion picture. *Id.* at 1. The Copyright Office issued the renewal registration in the motion picture, but denied the application for renewal of copyright in the screenplay. *Id.* The Cassavetes heirs appealed to the BOA, making the identical arguments as the Richlin heirs.

The BOA upheld the Copyright Office’s rejection of the heirs’ application for a renewal copyright interest in the screenplay, reasoning:

The Copyright Office considered a motion picture to be a unified work of authorship for purposes of registration under the 1909 law. The Office’s *Compendium I* (1973) described a motion picture as “ordinarily . . . embod[ying] a large number of contributions, including those of the author of the story, author of the screenplay, director, editor, cameraman, individual producer, etc. These persons are not regarded as the ‘author’ of the film in the copyright sense. *Compendium I* further states that most motion pictures were works made for hire, with the production company’s [sic] being the employer in most cases. The Office’s understanding of motion picture authorship . . . as consisting of contributions or parts, each of which is meant to be joined to other contributions or parts, in order to produce an integrated entity underlies this understanding.

....

The failure of the screenplay author . . . to have reserved via registration the copyright in the unpublished version of the screenplay . . . , thus rendering the screenplay’s copyright for purposes of the public registration record separate and apart from the copyright in the motion picture, means that the Office, viewing the motion picture as an integrated entity, cannot now insert into the public record a claim to renewal rights owned by a party different from the owner of record of the rights in the integrated entity, i.e., in the motion picture as a whole.

*Id.* at 4, 6 (citations omitted).

Even absent the principle of deference to the views of the Copyright Office, we would find the BOA’s analysis persuasive. A motion picture is a work to which many contribute; however, those contributions ultimately merge to create a unitary whole. As one district court explained, “it is impossible to cleave the story, screenplay and musical score of a motion picture film from the film itself.”

*Classic Film Museum, Inc. v. Warner Bros., Inc.*, 453 F. Supp. 852, 855–56 (D. Me. 1978). Though publication of a motion picture with notice secures federal statutory copyright protection for all of its component parts, *see* 17 U.S.C. § 3 (1909), that does not mean that the component parts necessarily each secure an independent federal statutory copyright. The component parts may or may not be copyrightable; they may or may not be the subject of an independent statutory copyright when they are incorporated into the motion picture. As *Abend* itself



demonstrates, the author of a work at common law must secure a federal copyright for that work for the right to renew to vest in either him or his heirs. The statutory copyright of a motion picture precludes the public from copying or otherwise infringing upon the statutory rights in the motion picture, including its component parts. However, when Mirisch secured federal statutory copyright for the Motion Picture, it did not also secure a federal statutory copyright for the Treatment. Assuming the Treatment is a copyrightable work, Richlin and Edwards simply failed to secure federal copyright for it.

The Richlin heirs turn to *Selznick v. Turner Entertainment Co.* to argue that when the original term of copyright in the Motion Picture was renewed, the statutory copyright in the Treatment was also renewed. The entire reading audience by now will know how to resolve this contention: There was no statutory copyright in the Treatment to renew; therefore, renewal of the Motion Picture's copyright did nothing to affect the Treatment's copyright status. In *Selznick*, the plaintiff and defendants were undisputed co-owners of a federal statutory copyright in the classic motion picture *Gone With the Wind*. The defendants filed a renewal copyright registration in their names only, and claimed that this renewal eradicated the plaintiff's interest in the copyright. *Selznick*, 990 F. Supp. at 1186. The district court rejected this argument, ruling that “[i]t is well-established that the co-owner

claiming the renewal takes legal title to the renewal copyright as constructive trustee on behalf of the non-renewing co-owner.” *Id.* (citing *Pye v. Mitchell*, 574 F.2d 476, 480 (9th Cir. 1978)).

Therefore, the Richlin heirs’ reliance on *Selznick* necessarily returns us to their flawed premise that Richlin coauthored the Motion Picture, and thereby became a co-owner of the Motion Picture’s statutory copyright. Unlike in *Selznick*, however, Richlin was not a coauthor of the Motion Picture. Moreover, the Richlin heirs have wholly failed to demonstrate how the Motion Picture’s incorporation of the Treatment invested in them an ownership interest in the Motion Picture’s renewal copyright term. Although the Richlin heirs are correct that, under *Batjac*, publication of the Motion Picture also published those copyrightable elements of the Treatment incorporated into the Motion Picture, it is a nonsequitur to conclude that the Richlin heirs thereby gained a statutory copyright in the Treatment or the Motion Picture. As MGM points out, the only way on these facts for Richlin to be a co-owner of the copyright in the Motion Picture is if he had been a coauthor. Richlin, however, did not coauthor the Motion Picture. Therefore, *Selznick*’s holding that a joint owner who renews a copyright acts as a constructive trustee for the other joint owners is inapposite.

In the end, the Richlin heirs ask us to consider one question: “For what reason should Richlin’s heirs be treated any differently than the heirs of any other author?” The answer is clear: Richlin failed to secure federal statutory copyright protection for the Treatment. Therefore, the Treatment as such was never invested with statutory copyright, and a right to renew the original term of statutory copyright neither vested in Richlin nor reverted to his heirs. Because Richlin neither co-owned nor coauthored the Motion Picture, neither he nor his heirs have any interest in its copyright.

#### **IV. CONCLUSION**

For the foregoing reasons, we affirm the district court’s decision.

**AFFIRMED.**

## **COUNSEL**

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