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# OWNERSHIP IN COMPLEX AUTHORSHIP: A COMPARATIVE STUDY OF JOINT WORKS IN COPYRIGHT LAW

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## 1. Introduction

The rights attached to authorship in joint works follow similar statutory definitions in legislation in many countries, including the jurisdictions chosen for this study, Italy and the United States of America (U.S.A.). Other than the usual differences that can be attributed to language and drafting style which are typical of such distant legal traditions, at first glance the only major difference is a slightly broader definition in the U.S.A.

However, when examining the rights that attach to works by more than one author (subjective complex works), there are a number of factors that must be considered in order to

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determine how the work can be treated in addition to the bare legislative wording.<sup>1</sup> The first is the type of work. Is the work of a singular nature, such as a literary work, or does it comprise of a blend, for example a cinematographic work and a musical work (objective complex works)? The second consideration is whether the work is made up of indistinguishable or of distinguishable contributions, where each contribution can be identified as coming from a particular author. The third consideration is whether the contributions are dependent or independent. One could have a work, such as a cartoon, where the contributions are distinguishable but dependent, or a work where contributions are distinguishable and independent, such as the illustration on the cover of a book. Finally, to consider the intent of the joint authors at the time of the creation of the joint work is sometimes decisive.

In our analysis we find that apart from the nature of the work and intent of the authors, the application of the rules of tenancy in common make a difference to the outcome of allocation of rights, whether these are economic or moral rights. Such a special form of tenancy, which has its basis outside copyright law, largely influences how the very same category of joint work is used in the two jurisdictions analysed in this article, and can inform why, despite similar legislative statements, the category has had remarkably different kinds of outcome in courts on the two sides of the Atlantic.<sup>2</sup>

## ***2. Unified by a different language***

Regarding the similarity in the statutory definitions of the concept of joint works, it must be noted how the adoption of international agreements and the efforts that the World Intellectual Property Organization (WIPO) and the World Trade Organization (WTO) have put into harmonising copyright laws are considerable, but joint works have always been a marginal category. This is confirmed by the fact that the only mention of this category is in the Berne Convention, where no definition of the concept is offered.<sup>3</sup> An alternative explanation of the similarity might flow from the nature of collaborative creations, being homogeneous worldwide, no matter the legal tradition. Such socio-economic explanation undoubtedly welcomes the occurrence of these kinds of “evolutionary convergences” that have been repeatedly identified in the field of legal anthropology.<sup>4</sup>

However, despite the similar statutory definitions, the resulting operative outcomes are completely different. One could ascribe this to the slight variances in the wording of the Acts involved, as witnessed by Art. 10 of the Italian Copyright Act,<sup>5</sup> which requires indistinguishableness, while joint works in the U.S.A. may be constituted also by interdependent parts.<sup>6</sup> However, such argument proves too weak to justify such a discrepancy

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<sup>1</sup> For a broad study on the issue of multiple authorship in Intellectual Property and how this reflects on exclusivity, see: Alexander Peukert, “Individual, Multiple and Collective Ownership of Intellectual Property Rights - Which Impact on Exclusivity?”, in Annette Kur & Vytautas Mizaras (Eds.) “Can one size fit all?” Aldershot, UK and Brookfield, U.S., (Edward Elgar, 2010).

<sup>2</sup> The English translation of Italian is used throughout (translation by Thomas Margoni, unless otherwise noted).

<sup>3</sup> “The provisions of the preceding article shall also apply in the case of a joint authorship [...]” see Art. 7bis Berne Convention for the protection of literary and artistic works of September 9, 1886, as amended.

<sup>4</sup> See Norbert Rouland, “Legal Anthropology”, (The Athlone Press, 1994); Rodolfo Sacco, “Antropologia giuridica. Contributi ad una macrostoria del diritto” (Il Mulino, 2007).

<sup>5</sup> See Art. 10 Italian Copyright Act (“Legge 22 aprile 1941 n. 633 e successive modificazioni - Protezione del diritto d’autore e di altri diritti connessi al suo esercizio”, in G.U. n.166 del 16 luglio 1941) [Italian Copyright Act].

<sup>6</sup> See 17 U.S.C. § 101 (“An Act for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes”, Pub. L. 94-553 - Oct. 19, 1976) [U.S. Copyright Act].

by itself, especially if we consider – as it will be demonstrated *infra* – that the Italian system also gives recognition to interdependent joint works, even though only implicitly, and with some diverging opinions over substantial aspects of consequent ownership rules.

That being said, it is unquestionable that the American model seems to favour the use of the joint works category. The statutory definition is broad, thereby facilitating the work of practitioners and interpreters, and the case law shows many examples of its application. Nonetheless, its overuse – caused by legislative reforms and technological development – demonstrates deficiencies with respect to the new (collaborative) production paradigm.<sup>7</sup>

A better explanation, shown herein, is to be found in joint ownership rules that govern these situations. Tenancy in common, originally drafted for material goods in both systems, operates very differently from one legal system to another. It could be said that while in Italy tenancy in common is based on a “joint administration” rule (*amministrazione congiunta*, where unanimity or qualified majorities are required for most uses), the opposite happens in the U.S.A., where the system operates on a “separate administration” rule (*amministrazione disgiunta*, where each co-author may proceed with every type of use, with few, though important, exceptions). In this article we will observe how these two system paradigms operate, and offer a synthesis capable of supporting a solution that is both fair and efficient.

### **3. The atomisation of property rights**

Art. 10 of the Italian Copyright Act, dealing with *joint works (opere in comunione)*, reads:<sup>8</sup>

- “1. If the work has been created with the indistinguishable and inseparable contributions of a plurality of persons, copyright vests commonly in all co-authors.
2. The undivided parts are presumed of equal value, except where there is a written agreement to the contrary.
3. Provisions on tenancy in common are applicable. Moral rights may be invoked by each co-author and the work may not be published, if unpublished, nor may it be modified or used differently from the first publication without the agreement of all co-authors. Nonetheless, in case of unjustified refusal of one or more co-authors, publication, modification, or new usage of the work may be authorised by the judicial authority, and accordingly used.”

It has been pointed out that “indistinguishable and inseparable contribution of a plurality of persons” requires the “converging intent of authors not only to join for the creation of the work, but also to accept the contraction of one's own personal creativity in favour of the outcome of the collaboration, which [...] tends to become subjective, and thus, the work not being the exclusive child of any co-author, the umbilical cord that binds it to its author is cut.”<sup>9</sup>

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<sup>7</sup> In addition to the example of cinematographic works and animation movies, consider for instance Web2.0, *user generated content*, social media, collaborative platforms such as Wikipedia, computer-generated works and many more. For an early study on these aspects see Margaret Chon, “New wine bursting from old bottles: collaborative Internet art, joint works, and entrepreneurship”, in *Oregon Law Review*, 1996; For a recent analysis on the ownership status of computer-generated works in absence of human intervention, see: Mark Perry & Thomas Margoni, “From music tracks to Google maps: Who owns computer-generated works?”, in *The Computer Law and Security Review – The International Journal of Technology Law and Practice*, 2010, 26.6, 621- 629. Available at: <http://ssrn.com/abstract=1647584>.

<sup>8</sup> See Art. 10 Italian Copyright Act, *supra* note 5.

<sup>9</sup> Vittorio M. De Sanctis, “I Soggetti Del Diritto D’autore”, 2nd ed. 76-77 (Giuffrè, 2005).

In other words, for joint authorship, two requirements need to be met. An objective one, indistinguishableness and inseparableness as explicitly provided in the Act, which is a minimum condition but is not sufficient by itself. Furthermore, there is a subjective condition, that the authors contemplate, or agree, that the joint work is something more than two individual – though inseparable and indistinguishable – pieces struck together. The work is meant to be a single *new* entity that represents something more than the mere sum of the initial contributions, first and foremost in the mind of its authors. With regard to the type of contribution, interpreters agree that the collaborators need to make a creative contribution to be co-authors, since it is not sufficient to give mere suggestions, technical indications, editorial collaboration, and so forth,<sup>10</sup> as a creative and original expression is required by the Act to qualify for protection.<sup>11</sup>

Art. 10 also provides that a work, in order to be considered a collaborative creation, has to be a “simple work”, meaning that it is not admissible for an objective complex work to fit in Art. 10 definition. An objective complex work represents a work where there are many distinguishable contributions, while a subjective complex work is a work where there are many distinguishable authors.<sup>12</sup> However Art. 10 does not cover all of the possible materialisations of collaborative works. The Italian Copyright Act recognizes another category, that of “composite works”, although only implicitly. Unlike collective works and “simple” collaborative creations, the composite works category is not specified in the Act. Nonetheless, in Sec. I and III of subtitle IV, “dramatic-musical works, musical compositions with words, choreographic and pantomimic works”<sup>13</sup> and “cinematographic works”<sup>14</sup> are recognised. As we will see, for these works that are distinguishable (objectively complex), the Act prescribes specific tenancy in common rules.

The composite works category is characterised by the fact that contributions are distinguishable, although not separable. In a musical composition with words, or in a cinematographic work the different parts, such as music, words, soundtrack, and images, each type can be differentiated and has its own characteristics. Nevertheless, they are created to be experienced together as a unitary work. Thus, while one of the prerequisites of Art. 10 is still present (inseparability), the other is manifestly absent (indistinguishability).

Though there is no general provision recognising the whole category, commentators agree that there is no reason to deny the existence and applicability for the category of composite works for types of works other than those listed in Arts. 33 – 37 and 44 – 50, so long as the remaining requirements of the collaborative creation are fulfilled.<sup>15</sup> Thus, when dealing with text and images, as in the case of a comic, it is clear that we are in presence of a composite work, while in the case of a novel accompanied by images that illustrate the text,

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<sup>10</sup> Maurizio Ammendola, *Diritto d'autore* (voce), in “*Digesto delle discipline privatistiche, Sezione commerciale, Vol. IV*” 372-392 (Utet, 1989); Greco P. (1952), “*Collaborazione creativa e comunione dei diritti d'autore*”, in *Dir. Autore*, 1, at 14-16; Eduardo Piola Caselli, *Codice del diritto d'autore - Commentario della nuova legge 22 aprile 1941-XIX, N. 633* at 261-263 (Utet, 1943); Zara Oliva Algardi, “*La tutela dell'opera dell'ingegno e il plagio*” 122 (Cedam, 1978); Tullio Ascarelli, “*Teoria della concorrenza e dei beni immateriali*” 773-774 (Giuffrè, 1960); Ubertazzi L. C. (2003), “*Spunti sulla comunione di diritti d'autore*”, in “*Annali it. dir. Autore*”, at 506, 507-508; Vittorio M. De Sanctis & Mario Fabiani, “*I contratti di diritto d'autore*”, in Antonio Cicu & Francesco Messineo, “*Trattato di diritto civile e commerciale, vol. XXXI*” t. 1, 72 (Giuffrè, 2000).

<sup>11</sup> It must be noted that unlike in the U.S.A. situation, no fixation requirement is needed. Art. 2-1, listing protected subject matters, reads “*literary, dramatic, scientific, didactic, religious works being in written or oral form.*”

<sup>12</sup> Paolo Greco & Paolo Vercellone, “*I diritti sulle opere dell'ingegno*” 97 (Utet, 1974); Maurizio Ammendola, *Diritto d'autore* (voce), in “*digesto delle discipline privatistiche, Sezione commerciale, vol. IV*” 392 (Utet, 1989); De Sanctis, *supra* note 9, at 85.

<sup>13</sup> Sec. I, Arts. 33 to 37 Italian Copyright Act.

<sup>14</sup> Sec. III, Arts. 44 to 50 Italian Copyright Act.

<sup>15</sup> As early as 1948 prof. Greco criticised Art. 10 for its obscure and misleading meaning. See Paolo Greco, “*I Diritti Sui Beni Immateriali*” 222-223 (Giappichelli, 1948).

we are in the presence of two different works that remain autonomous.<sup>16</sup> In the former example, text and images are merged into a unitary work and both will lose their creative message and function if perceived without the other, that is to say, if individually presented, they will be perceived as incomplete. In the latter example, the novel will bear the same creative message even if presented without images. Even though the images may improve the aesthetic appearance of the novel, they will not substantially modify the novel's content or expressive form. The illustrations may also stand alone as artworks. However, in the case of a scientific book, where illustrations are repeatedly used to explain the content (as with a book of anatomical medicine) and are an essential part for the comprehension of the book's message, it could well be that we are dealing with a composite work.<sup>17</sup>

### 3.1 The twists of interlocking prohibitions

One of the most notable consequences of a collaborative work's *status* is the ownership rules applicable to co-authors. In the case of Art. 10, rules of *comunione* (tenancy in common) are to be applied (Arts. 10-1 and 10-3). Italian law provides a detailed description of the rules on tenancy in common in Art. 1100 *et seq* of the Civil Code. Those rules are aimed at covering every type of common tenancy contemplated by law, but it is evident that when drafting this category, non-physical products were not considered.<sup>18</sup> Even though some of the rules on tenancy in common provided by the Civil Code are directly applicable to non-physical goods, others are not. Since non-physical products encompass some specific idiosyncrasies, for example to be non-rival to consumption and non excludable, a generalised application of the rules of tenancy in common from Art. 1100 *et seq* Civil Code becomes problematic. In the case of Italian works of authorship, another layer of complexity is represented by the presence on moral rights.

Art. 10 of the Copyright Act recognises this difficulty by providing an exception for specifically identified activities. To begin with, Art. 10 sets forth a *iuris tantum* presumption of equality of quotes, that is to say, in absence of a written agreement to the contrary, all co-authors own an equal share of the whole (Art. 10-2).<sup>19</sup> Such a provision is a logical consequence of Art. 10, where it provides that only indistinguishable parts may form a joint work.

Secondly, moral rights are apparently exempted from tenancy in common, since each co-author can resort to the courts individually (Art. 10-3). Moral rights are personal rights, and Art. 22 of the Copyright Act defines them as inalienable and not waivable, so this individual ability to avail oneself of a remedy is perfectly consistent with the general framework of such legal system. However, scholars have questioned whether all moral rights can be invoked by each co-author disjunctively, or whether for some of them all the joint authors would need to join action. General principles set forth by the Copyright Act, the Civil Code, and the Constitution in Italy suggest that, besides those rights strictly connected with the honour and reputation of each co-author (the right to authorship and the right to integrity, Art. 20 of the Italian Copyright Act), the defence of the remaining moral rights could be activated only with unanimity of the co-authors. The reason for this distinction lies in the fact

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<sup>16</sup> Paolo Greco & Paolo Vercellone, "I diritti sulle opere dell'ingegno" 250 (Utet, 1974).

<sup>17</sup> *Id.*, at 251.

<sup>18</sup> In title VII of the 3rd book of the civil code, subtitle I (Art. 1100 to 1116) deals with "*comunione in generale*", while subtitle II (Art. 1117 to 1139) deals with the tenancy in common of buildings ("*del condominio negli edifici*").

<sup>19</sup> *Iuris tantum* (comparable to a rebuttable presumption in common law systems) refers to a legal presumption where a contrary proof is admitted, in contrast to a *iuris et de iure* presumption, where no proof to the contrary is possible (comparable to a conclusive or irrebuttable presumption in common law systems). However, in the present case, due to an explicit statutory provision, not every means of proof will be acceptable, as happens for the generality of "simple" presumptions contained in the Act. Here, only a written agreement to the contrary will be accepted to prove the contrary and win the presumption.

that this second class of moral rights (composed by the right to withdrawal under Art. 142 and the right to first unedited publication under Art. 24) is strongly connected with the collaborative creation. Further, their individual activation would significantly influence the concomitant usage by other co-authors, and in some cases, render it impossible.<sup>20</sup>

Accordingly, a general rule of tenancy in common may also be affirmed for moral rights, with the exception of those, whose essence is ontologically connected with the personality, honour, and reputation of the author, namely the right to authorship and the right to integrity.

Regarding economic rights, Arts. 10-3 explicitly states that all uses that were not already approved at the time of the first publication need a unanimous decision of all co-authors. This point represents a major exception to the tenancy in common rules set forth by art. 1100 *et seq* Civil Code, where for all uses defined as “ordinary administration” the authorisation by a majority is deemed sufficient.<sup>21</sup> By combining Arts. 10-3 with the rules *ex* Art. 1100 *et seq* Civil Code, we observe that only those uses already permitted under the first publication, which requires unanimity, may be reauthorized by the majority. To illustrate, two authors out of three, may authorise a new edition of a book, but unanimity will be required for a translation. An important exception must be applied to this rule, namely that in Art. 1108-3 of the Civil Code, requiring unanimity for uses exceeding a nine-year period, which is a mandatory case of “extraordinary administration.”<sup>22</sup> Therefore, if a use, already authorised at the time of first publication, is to be conceded for a period exceeding nine years, then it represents a use of “extraordinary administration” and unanimous deliberation is once again required.<sup>23</sup>

The rationale of Art. 1108-3 holds true for other forms of exploitation such as licensing. In particular, in this latter case, it has to be noted that: (a) only a non-exclusive licence may be authorised without unanimity, as an exclusive licence is a form of usage of the common good that reduces and limits the other tenants in common (thus representing an act of “extraordinary administration”), and (b) the non-exclusive licence cannot exceed a nine year time frame to be authorized by a majority.

### 3.2 Beyond the surface: the composite work category

In the case of composite works and the consequent ownership status, the issue becomes even more intricate. First, since there is only an implicit recognition of the category, there are no legal provisions furnishing a clear and unambiguous regulation. Second, rules applying to

<sup>20</sup> Greco P. (1952), *Collaborazione creativa e comunione dei diritti d'autore*, in *Dir. Autore*, 1, at 24-25; Greco & Vercellone, *supra* note 12, at 224-226; Zara Oliva Algardi, “La tutela dell'opera dell'ingegno e il plagio” 122 (Cedam, 1978); *contra* Maurizio Ammendola, *Diritto d'autore (voce)*, in “*Digesto delle discipline privatistiche, Sezione commerciale, vol. IV*” 393 (Utet, 1989); Gerardo Santini, “I diritti della personalità nel diritto industriale” 50-53 (Cedam, 1959); Tullio Ascarelli, “Teoria della concorrenza e dei beni immateriali” 775 (Giuffrè, 1960). Unanimity for the first publication is not really under debate, since the same art. 10 clearly states that a deliberation of all co-authors is necessary.

<sup>21</sup> Ordinary administration refers to those acts by which individuals tend to conserve the effective substance of the assets, doing nothing more than perceiving the fruits, while through extraordinary administration acts individuals change the economic essence and the legal framework of the assets; see Pietro Trimarchi, “Istituzioni di Diritto Privato” 62-65 (Giuffrè, 2005). This distinction is substantially accepted by copyright scholars; see Vittorio M. De Sanctis & Mario Fabiani, “I contratti di diritto d'autore”, in Antonio Cicu & Francesco Messineo, “*Trattato di diritto civile e commerciale, vol. XXXI*” t. 1, 82 (Giuffrè, 2000).

<sup>22</sup> Art. 1108 of the Civil Code is entitled “Innovations and others acts exceeding ordinary administration” and lists activities that requires qualified majority or, as in the present case, unanimity.

<sup>23</sup> Greco & Vercellone, *supra* note 12, at 228; Maurizio Ammendola, “Diritto d'autore (voce)”, in “*Digesto delle discipline privatistiche, Sezione commerciale, vol. IV*” 392-393 (Utet, 1989).

Sec. I and III, subtitle IV of the Italian Copyright Act are in some aspects strongly subject matter specific. This means that their extensive application is likely to be discarded, or at least very problematic, in all those cases where the type of work changes substantially. Nevertheless, it seems uncontroversial that: (a) the legislator intended to also allow tenancy in common for works *ex Arts. 33 - 37 and 44 - 50*; and more importantly, (b) a general rule of tenancy in common may be envisioned for the whole category of composite works - which is not limited to those works explicitly listed in Sec. IV.

The applicability of tenancy in common may be derived both from the wording used by the Act and from the dominant doctrine.<sup>24</sup> The latter is that the lack of indistinguishableness does not exclude tenancy in common.<sup>25</sup> Although, such an absence justifies a different workability of the rules between tenants in common.<sup>26</sup>

The same Secs. I and III, subtitle IV provide some specific rules on how to calculate the share corresponding to each co-author, in a way proportional to their role and on who is enabled to exercise the economic rights. For instance, Art. 34 establishes that the exercise of economic rights belongs to the author of the musical contribution (34-1) and that she has a duty to account to the other contributors proportional to the value of each share (34-2), and then gives a precise indication on how to calculate the amount of each contribution (34-3 and 34-4).<sup>27</sup> It has to be noted that such rules apply only in cases where the parties have not agreed otherwise.<sup>28</sup>

In the case of cinematographic works, the tenancy in common rules operate loosely, since although co-authors are deemed to be four pre-established subjects,<sup>29</sup> Art. 45-1 of the Italian Copyright Act allocates the exercise of the economic rights to the producer, who is obliged to account to the former.<sup>30</sup> Even so, except for where is an agreement to the contrary, the producer will not be able to perform or display any modification, elaboration, or translation without the consent of all the co-authors.

Turning our attention to point b), namely the applicability of a general rule of tenancy in common for the whole category of composite works - beyond those works explicitly listed in Sec. IV - scholars agree that such applicability is in accordance with the Copyright Act and the general principles of the law.<sup>31</sup> Thus, all those works that are created through a creative

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<sup>24</sup> The Act uses words like "*comunione*" (art. 34) when identifying the holder of the economic rights, and "*coautori*" (art. 44) when dealing with the authorship of cinematographic works.

<sup>25</sup> Paolo Greco, "I diritti sui beni immateriali" 394 (Giappichelli, 1948); Ubertazzi L. C., "Spunti sulla comunione di diritti d'autore", in "Annali it. dir. Autore" 508 (2003).

<sup>26</sup> Maurizio Ammendola, Diritto d'autore (voce), in *Digesto delle discipline privatistiche, Sezione commerciale*, vol. IV at 219 (Utet, 1989).

<sup>27</sup> Art. 34-3 reads: "In lyric works it is established that the value of the musical contribution represents the three quarters ( $\frac{3}{4}$ ) of the whole work"; Art. 34-4 reads: "in operettas, *melologos*, musical compositions with words, ballets and musical ballets, the value of the two contributions is deemed equal."

<sup>28</sup> Art. 33, opening Sec. I, reads: "In the absence of specific agreements among the contributors [...] the rules of the next 3 Arts. shall apply." It must be noted, however, that in cases of tenancy in common originated by an agreement, only the rules set forth by art. 1100 *et seq* civil code apply, excluding the important provisions rising from art. 10 LDA. In particular only economic rights will fall into the tenancy in common, being the moral ones left off; see De Sanctis, *supra* note 9, at 90-91.

<sup>29</sup> Co-authors of the cinematographic work are deemed to be the author of the screenplay, the author of the script, the author of the music, and the artistic director; art. 44 Italian Copyright Act.

<sup>30</sup> Vittorio M. De Sanctis & Mario Fabiani, "I contratti di diritto d'autore", in Antonio Cicu & Francesco Messineo, "Trattato di diritto civile e commerciale, vol. XXXI" t. 1, 71-72 (Giuffrè, 2000).

<sup>31</sup> Paolo Greco, "I diritti sui beni immateriali" 220 (Giappichelli, 1948); Greco P., "Collaborazione creativa e comunione dei diritti d'autore", in "Dir. Autore", 1, 2-4 (1952); Greco & Vercellone, *supra* note 12, at 252; Maurizio Ammendola, "Diritto d'autore (voce)", in "Digesto delle discipline privatistiche, Sezione commerciale, vol. IV" 394 (Utet, 1989); Ubertazzi L. C., "Spunti sulla comunione di diritti d'autore", in "Annali it. dir. Autore", 509 (2003); Vittorio M. De Sanctis & Mario Fabiani, "I contratti di diritto d'autore", in Antonio Cicu & Francesco

collaboration of two or more authors, but where the contributions remain distinguishable yet inseparable since merged into a unitary whole, are governed by the rules of tenancy in common.

The most controversial point here is evidently represented by the suggestion that following Art. 10 of the Italian Copyright Act, contributions need to be indistinguishable. As early as 1952, Professor Greco pointed out how such an interpretation, even if ostensible from a superficial reading of Art. 10, is not consistent with the Act or the general principles of the law.<sup>32</sup> If we were to follow such an interpretation of Art. 10, there would be an unjustified divergent treatment for objective simple and complex collaborative works, when the reason for a tenancy in common rule is rooted not in the objective classification of the contribution, but in a subjective view of collaboration conducing to a multi-authored creative product.<sup>33</sup>

Hence, in spite of those cases specifically regulated by the law (Arts. 33 - 37 and 44 - 50), in cases where we are faced with a collaborative work constituted by distinguishable contributions, a general rule of tenancy in common is deemed applicable, even if there are some differences as to the workability in Art. 10 Italian Copyright Act. Given that the contributions are distinguishable, it would no longer be acceptable to presume an equality of shares through a simple presumption (*iuris tantum*) that, however, may be overcome only through a written agreement to the contrary. Since every contribution is separately perceivable and directly attributable to its author, it seems evident that such a "simple but strong" presumption is no longer justifiable, and that a rule based on proportionality should be applied by judges in all those cases where co-authors successfully prove a different amount in their contributions.<sup>34</sup>

Consequently, in a case of tenancy in common for a composite work, there still remains a presumption of equality of shares, but this presumption does not derive from Art. 10, which is not applicable because of the lack of indistinguishability, but from the general rule of tenancy in common set forth in Art. 1101 of the Italian Civil Code. The most remarkable practical difference, is that such latter presumption may be overcome by any mean of proof, and not only by a written agreement to the contrary, as it is the case for Art. 10 Copyright Act.<sup>35</sup>

Regarding the possibility of co-authors using their contributions separately, once again cases of simple collaborative works (Art. 10 of the Italian Copyright Act) and of composite works must be differentiated. For the former, there is simply no possibility of separate uses since the contributions are indistinguishable. In the case of Art. 10, co-authors cannot use their contributions separately, otherwise, the work would not be indistinguishable. In the case of composite works, such reuse is allowed as a general rule. In fact, since the contributions are distinguishable, they may be used as a part of the unitary work that they have been created for, as well as separately. This characteristic of non-physical property (to be non-rival in consumption) is idiosyncratic and differs totally in the case of material goods.

However, a line must be drawn between composite works specifically typified by the Act (Arts. 33 - 37 and 44 - 50) and those that are not. The Act provides some specific rules, depending on the type of work. For example, Arts. 35 and 36 (musical compositions with words, dramas, choreographic works) state that the author of the literary part of the work may not connect it to another musical, with some specific exceptions connected to the

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Messineo, "Trattato di diritto civile e commerciale, vol. XXXI" t. 1, 70 (Giuffrè, 2000); Eduardo Piola Caselli, "Codice del diritto d'autore - Commentario della nuova legge" 22 aprile 1941-XIX, N. 633 at 261 (Utet, 1943); Tullio Ascarelli, "Teoria della concorrenza e dei beni immateriali" 777 (Giuffrè, 1960); Zara Oliva Algardi, "La tutela dell'opera dell'ingegno e il plagio" 124 (Cedam, 1978).

<sup>32</sup> Greco P., "Collaborazione creativa e comunione dei diritti d'autore", in "Dir. Autore", 1, at 2 (1952).

<sup>33</sup> *Id.*, at 14-18.

<sup>34</sup> Paolo Greco, "I diritti sui beni immateriali" 220 (Giappichelli, 1948). Ubertazzi sustains that in this, as in other similar cases, it should operate a rule of proportionality, deriving this argument from constitutional principles; Ubertazzi L. C., "Spunti sulla comunione di diritti d'autore", in "Annali it. dir. Autore", 511-514 (2003).

<sup>35</sup> Greco, *supra* note 25, at 35; Ubertazzi L. C., "Spunti sulla comunione di diritti d'autore", in "Annali it. dir. Autore", 512 (2003).

passage of time or some sort of contractual non-fulfilment by the composer. In this case, no unfair competition concerns arise, since the reuse is only allowed when the composite work has no commercial value at all, because it has never been completed, or once completed, it has never been performed or displayed to the public, or after first performance or display, it has not been performed or displayed again for a considerable period of time (2 or 10 years, respectively).<sup>36</sup>

Conversely, regarding those composite works that do not receive any explicit regulation, the only limit to the reuse of contributions lies in the economic prejudice that such an autonomous usage may cause to the composite work. Evidently, this may happen if a contribution (suppose a textual contribution) is going to be connected to another contribution (such as images), which is of the same sort of contribution as the original composite work, in a way that the new composite work will economically compete with the original one. The rationale lies in the general rule that may be derived from Art. 1102 of the Civil Code, which prohibits tenants in common to use the common good in a way that forms obstacles or prejudices to the use of the other tenants.<sup>37</sup>

In light of the situation here depicted, it is no surprise that in Italy, both the dominant doctrine and courts prefer the category of collective works for many types of multi-authored works such as multimedia works, on-line course-ware and other similar collaborative efforts, and the reason may find its roots in the complexity of the rules on joint ownership.<sup>38</sup> Such complexity, which as we have seen normally requires unanimity for any use or at least for those that have substantial economic value, and concerns relating to the characteristic of indistinguishableness and the connected uncertainty in the field of composite works, play, consciously or not, an important role in such a preference, as may be witnessed by the relative scarcity of case law on joint works. For all these reasons the Italian approach has favoured the departure from the joint work category - or more correctly, determined the fact that it has never been seriously considered for a generalised usage - and pushed for the use of the category of collective works.

In the next sections of this paper, we will observe how in the U.S.A. works of interdependent contributions are expressly admitted in the joint works category, making things easier for interpreters and commentators. Moreover, tenancy in common rules permit every co-author to use, reuse, and license the whole work, the only limit being a duty to account. Such system of administration of the common good (separate, in contrast to joint) is much more efficient for the economic existence and dissemination of the work. In Italy, a kind of "mutual veto" can be identified, or economically speaking, a manifestation of a "tragedy of *anticommons*": the disagreement that may originate between parties - who are jointly vested with the same property right - with regard to various aspects of the economic life and the circulation of the work (and connected transaction costs) is capable of halting such economic circulation and thus bringing about the "destruction" of the work.<sup>39</sup> In a situation like the one here depicted, it is clear how a solution - unanimity - that on a theoretical level seems to be the most *fair*, proves to be so *inefficient* as to become, practically, *unfair*.<sup>40</sup>

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<sup>36</sup> De Sanctis, *supra* note 9, at 92.

<sup>37</sup> Greco & Vercellone, *supra* note 12, at 252.

<sup>38</sup> It would be interesting to know how the courts would have decided in the case of cinematographic works in absence of a joint works *ex lege* provision, such as the one present in the Italian Copyright Act.

<sup>39</sup> Michael A. Heller, "The tragedy of the *anticommons*: property in the transition from Marx to markets", 111 Harv. L. Rev. 621, (1998).

<sup>40</sup> For an example of a "tragedy of the *anticommons*" caused by Italian tenancy in common rules - though the situation of tenancy in common is coming from *inheritance law* and is applied to tangible property - see Ugo Mattei, *Comparative Law and Economics* 65 (The University of Michigan Press, 1997).

## 4 Creative control or dominant author: towards a Feist+ standard?

The U.S.A. Copyright Act defines a joint work as follows:<sup>41</sup>

A “joint work” is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

Key elements here are the “intent requisite” and the fact that a joint work may be constituted of both inseparable and interdependent contributions. Starting with the latter, it must be noted how not just works composed of inseparable contributions – that is works where contributions, once merged, are no longer recognisable – but also works composed by interdependent parts, fit in this category.

Interdependent contributions have been defined as “contributions that are assembled into a unified whole, rather than being recast and incorporated into the whole”<sup>42</sup> and where “one component of the work is influenced or controlled by the other.”<sup>43</sup> Examples of this kind of joint work include music compositions with lyrics, architectural projects joined with music or video, illustrated poems, and generally all multimedia works. The application ambit of interdependent contributions is to cover works where elements pertaining to different branches of the arts are assembled together in a unitary whole.

The idea that joint works may be made up of interdependent contributions is not problematic in itself, but it becomes an issue when we analyse the ownership consequences of joint authorship; that is, once again, the application of the rules on tenancy in common. However, before proceeding in this direction, the *intent* requirement needs to be addressed.

Intent is present if “each of the authors prepared his or her contribution with the knowledge and intention that it would be merged with the contributions of other authors as inseparable or interdependent parts of a unitary whole.”<sup>44</sup> The touchstone here is the intention, at the time of writing the contribution, that the parts be absorbed or combined into an integrated unit.<sup>45</sup> It is evident, though not necessarily the case, that a shared intent is present in situations where co-authors work together physically and at the same time. Shared intent could also be present when parties are not collaborating at the same time or in the same place or in concert, so long as such intent is present when co-authors create their contribution, which may come into existence at any time, even when one (or some) of the works is already completed, or not yet conceived. That is to say, when a party makes a sole contribution with the intention to merge it with another as to form a unitary whole, then the intent requisite is fulfilled.<sup>46</sup>

In spite of this quite detailed definition, case law shows a long list of different interpretations and variations of this theme. For instance, the nature of such intention (should the author *want* co-authorship and should be *aware of the legal consequences* thereof, or is a mere *intention* toward a unitary result enough?), or the exact moment of its occurrence (at the very beginning of the joint activity, before the work is concluded, or after that), have been and remain highly debated issues in courts and among commentators.<sup>47</sup>

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<sup>41</sup> 17 U.S.C. § 101.

<sup>42</sup> Melville B. Nimmer & David Nimmer, “Nimmer on copyright: a treatise on the law of literary, musical and artistic property and the protection of ideas”, Sec. 6.04, at 6-12 (M. Bender, 1963).

<sup>43</sup> Nancy Perkins Spyke, “The joint work dilemma: The separately copyrightable contribution requirement and co-ownership principles”, 40 J. Copyright Soc’y U.S.A. 463 (1993).

<sup>44</sup> See House Report on Copyright, H.R. Rep. No. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5736.

<sup>45</sup> *Id.*, at 5736-5737.

<sup>46</sup> Nimmer, *supra* note 42, Sec. 6.03, at 6-6 – 6-7; Paul Goldstein, “Copyright: principles, law, and practice” Sec. 4.2.1, at 4:8 (Little, Brown, 1989).

<sup>47</sup> After the 1976 Copyright Act enactment, courts turned their interest over the nature of the

Moreover, courts, in their effort to narrow the applicability of joint works, have created some *ex novo* concepts, such as “dominant author” or “creative control”, without providing precise definitions.<sup>48</sup> Obviously, this attitude does not shed any light onto this already hazy landscape. Scholars have strongly criticised this judicial approach,<sup>49</sup> as most of these concepts are totally unknown to the Copyright Act or its legislative history, and in some cases, are inconsistent with both.<sup>50</sup>

Likewise, it has been sustained that the “Goldstein standard” supports *per se* the same narrowing of results, without all these interpretative problems that originate from the creation of new concepts.<sup>51</sup> The Goldstein standard affirms that in order to be eligible for co-authorship in a joint work, each contribution should be independently copyrightable.<sup>52</sup> This reasoning is rooted in the general principles of the Act that require an activity to be original in order to qualify for copyright protection. Accordingly, it is consistent with the Act to recognize co-authorship exclusively to those co-authors who submit contributions that are autonomously copyrightable. It is not sufficient to provide a “more than *de minimis*” contribution; something that is more than ideas, comments, suggestions or facts, but not yet copyrightable. Additionally, it is required that such a creative effort be expressed in an original form.<sup>53</sup> Such an approach would *per se* considerably limit the applicability of joint

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intent, as LaFrance remarks, *see* Mary LaFrance, “Authorship, dominance and the captive collaborator: preserving the rights of joint authors”, 50 Emory L. J. 193, 214-16 (2001); See also *Childress v. Taylor*, 945 F. 2d 500, 507 (2d Cir. 1991); *Erickson v. Trinity Theater, Inc.*, 13 F.3d 1061 (7th Cir. 1994). But see *contra Words & Data, Inc. v. GTE Communications Services, Inc.*, 765 F. Supp. 570 (W.D.Mo. 1991), where, relying on Nimmer, Judge Burtlett affirms that “each contributor automatically acquires an individual ownership on the entire work” and that “the intent necessary for joint authorship is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit [...]”, *id.*, at 574-575; see also Nimmer (1963), *supra* note 42, Sec. 6.03, at 6-6; House Report, note 44, at 5736. In another decision delivered after the enactment of the 1976 Copyright Act - where a joint work definition is present - the Second Circuit stated that it was no longer acceptable a broad definition of joint work and that an actual collaboration in the creation of the work is necessary, being not acceptable that a joint ownership in a work implies joint authorship in a derivative work thereof, *see Weissmann v. Freeman*, 868 F.2d 1313, 1317-18 (2d Cir. 1989).

<sup>48</sup> “It is only where the dominant author intends to be sharing authorship that joint authorship will result”, *Childress*, 945 F.2d at 508, citing *Fisher v. Klein*, 16 U.S.P.Q.2d. 1795 (S.D.N.Y. 1990). For the “creative control” concept, *see Thomson v. Larson*, 147 F.3d 195, 203 (2d Cir. 1998), where the court elaborates such concepts and gives some guidance on how to interpret them through the “decision making authority” test.

<sup>49</sup> This approach is particularly sustained in the 2d, 7th and 9th Circuits; they are the federal appellate courts that hear the large majority of copyright cases and thus are particularly influential in this field.

<sup>50</sup> *See* Mary LaFrance, “Authorship, dominance and the captive collaborator: preserving the rights of joint authors”, 50 Emory L. J. 193, 224 (2001); referring to the “dominant authorship” as relevant to the joint work analysis in the *Childress* approach.

<sup>51</sup> *Id.*, at 225 - 226.

<sup>52</sup> *See* Paul Goldstein, “Copyright: Principles, Law, and Practice” Sec. 4.2.1, at 4:13 (Little, Brown, 1989). “A collaborative contribution will not produce a joint work, and a contributor will not obtain a co-ownership interest, unless the contribution represents original expression that could stand on its own as the subject matter of copyright. Sec. 101’s definition of a joint work as a work prepared by two or more “authors” implies that the contribution of each must be a copyrightable “work of authorship” within the terms of Sec. 102(a)”; “Further, since any subject matter that does not meet the Copyright Act’s copyrightability standards lies in the public domain, an author is - absent an agreement to the contrary or liability based on some other legal rule - free to use uncopyrightable contributions made by other, and need not share with them any of the proceeds from the work’s exploitation.”

<sup>53</sup> The “more than *de minimis* standard” has been proposed by Professor M. Nimmer, but has never gathered much support in courts. The reason why seems apparent, since if courts are concerned with the reduction of joint works applicability, than a more stringent standard, as the “independent copyrightable” one, is more useful than a standard which allows secondary collaborators to claim joint authorship. *See* Nimmer, *supra* note 42, Sec. 6.07, at 6-21; for an

works. Indeed, courts have accepted and used the Goldstein standard in their decisions, but, consciously or not, deemed it insufficient to solely reduce the applicability.<sup>54</sup>

More recently, in *Aalmuhammed v. Lee*<sup>55</sup> the Ninth Circuit tried to address the issue of joint authorship by elucidating a previous decision's understanding of the "intent-to-share-authorship" requirement. Furthermore, the court introduced a somewhat more original vision of the term "author", a kind of "*more-than-Goldstein*" standard. While stating that Aalmuhammed was not a joint author because neither Lee nor Warner Brothers intended to share authorship with the plaintiff, the court also affirmed that the contribution of Aalmuhammed was "not authorial."

Both components of the holding need clarification. With regard to the intention to share authorship, the Ninth Circuit seemingly goes a little bit further than the Second and Seventh circuit, by affirming that "[...] putative co-authors [have to] make objective manifestations of a shared intent to be co-authors" and that "we [the court] say objective manifestations because, were the mutual intent to be determined by subjective intent, it could become an instrument of fraud, were one co-author to hide from the other an intention to take sole credit for the work."<sup>56</sup>

Likewise, by dealing with the term "author" the Ninth Circuit tells us that there are different kinds of authors and thus different levels of authorship. Whereas in a "normal work" like a mono-authored novel, it is very easy to say who the author is, in the case of joint authorship things change. Following the court's rationale, while originality in such a novel should follow the *Feist*<sup>57</sup> requirement of a modicum of creativity, in a joint work it is not feasible to recognise every (original) contribution as co-authorial, since it would mean sharing ownership among too many individuals. One should think about the situation that would emerge in cases of those subjective (and objective) very complex works, such as motion pictures,<sup>58</sup> or some types of multimedia works, or the case of on-line course-ware or course packages recalled earlier in this paragraph.

The court sustained that when deciding on the authorship of a complex work, the inquiry should go in the direction of the "creative control." Accordingly, the Ninth Circuit - apparently resurrecting the concept of dominant author<sup>59</sup> - affirms that "Aalmuhammed did not at any time have superintendence of the work" or any other form of control, and that he "was not the person who has actually formed the picture by putting the persons in position, and arranging the place", and thus he "lacked control over the work, and absence of control is strong evidence of the absence of co-authorship."<sup>60</sup> The fact that the same court recognizes

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application of this standard see *Words & Data*, 765 F. Supp., supra note 47. According with Prof. Nimmer, "neither the text nor legislative history of the Act supports that conclusion [independent copyrightability]. The definition in the Act adverts to a "work prepared by two or more authors with the intention that their contributions be merged..." That language contains no requirement that each contributes an independently copyrightable component to the joint work. The legislative history similarly elevates intention as the touchstone, without placing any further parsing as to the copyrightable status of each individual component that the parties intend to contribute to the work as a whole"; supra note 42, Sec. 6.07, at 6-22.

<sup>54</sup> See *Childress*, 945 F.2d at 506, where Newman J. addresses the issue, lists uniform case law and indicates that even the Register of Copyright strongly support this view. See *Ashton-Tate Corp. v. Ross*, 916 F.2d 516 (9th Cir. 1990); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990).

<sup>55</sup> *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000).

<sup>56</sup> *Aalmuhammed*, 202 F.3d at 1234.

<sup>57</sup> *Feist Publication, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 111 S. Ct. 1282 (1991).

<sup>58</sup> *Aalmuhammed*, 202 F.3d at 1232.

<sup>59</sup> *Aalmuhammed*, 202 F.3d at 1232.

<sup>60</sup> *Aalmuhammed*, 202 F.3d at 1232-1235. Interestingly, this case deals with a cinematographic work. The text of the decision expressly asks "who should be considered the author of a movie" and then develop a reasoning concerning the subjects involved in the workflow and their tasks (*id.* at 1232). A completely different solution is provided by the Italian Copyright Act where cinematographic works are considered a special category of joint works, where authorship is recognized for the director, the screen play writer, the composer of the soundtrack and the artistic director, while economics rights vest to the producer.

independent copyrightability to Aalmuhammed's contributions, notwithstanding.<sup>61</sup> That is to say, in cases of joint authorship, not just a *more-than-Goldstein*, but apparently, a *more-than-Feist* standard is required. In order to be eligible for co-authorship, the normal standard for copyrightability, as stated in the Act and in all case law, is no longer sufficient.

Even though this holding of the Ninth Circuit certainly has contributed to harmonize some of the more controversial concepts and tests of previous decisions, the result is far from being in accordance with the Copyright Act and the Constitution. LaFrance leaves no doubt:<sup>62</sup>

The relationship test [i.e. the nature of the intent inquiry] has allowed joint work status to be denied even when several collaborators have made substantial copyrightable contributions into a unitary work. This restrictive view of joint authorship goes far beyond what is necessary to distinguish joint works from derivative works, compilations, and collective works, and denies economic rewards to persons whose creative efforts satisfy the constitutional and statutory concepts of authorship.

However, it must be noted that the courts' effort in narrowing the applicability of joint works has not been totally pointless. The amount of creative collaboration that may result in joint works has increased at a rate not even imaginable until few years ago, when the Copyright Act of 1976 came into force. The shift to a digital and networked economy, particularly significant for the "cultural" industries, has substantially changed the typical form of production of the past industrial century. That shift enormously facilitated the chances to share tools, creativity and results. Internet and the World Wide Web are strongly grounded in such a collaborative and interconnected productive system<sup>63</sup> and the latest developments of those technologies, as witnessed by "Web 2.0" and "social media", corroborate this reasoning even further.

Similarly, it is also noteworthy that the Copyright Act of 1976 strongly reduced the applicability of the "work for hire" doctrine. Consequently, those situations that until 1978 vested authorship to employers that had some kind of control over their employees (*i.e.* where an *implied conveyance theory* was found to work), hereinafter have been increasingly addressed through joint authorship.<sup>64</sup> The "reluctance of courts in applying joint work category" too broadly, is probably connected to the consequences in terms of ownership. Where joint authorship is recognised, rules of tenancy in common must be applied.<sup>65</sup>

## 4.1 Infringing one's own copyright?

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<sup>61</sup> *Aalmuhammed*, 202 F.3d at 1232.

<sup>62</sup> LaFrance, *supra* note 47, at 255. Others have spoken about a "uncertain realm of policy", see Lior Zemer, "Is intent to co-author an "uncertain realm of policy"?", 30 Colum. J. L. & Arts 611, (2007).

<sup>63</sup> Manuel Castells, "The information age: economy, society, and culture" (Blackwell Publishers, 1996).

<sup>64</sup> LaFrance, *supra* note 47, at 194-195; see also *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485 (D.C. Cir. 1988).

<sup>65</sup> "[...] court-made law on this point is left undisturbed. Under the bill, as under present law, co-owners of a copyright would be treated generally as tenants in common, with each co-owner having an independent right to use or license the use of a work, subject to a duty of accounting to the other co-owners for any profits"; see House Report, *supra* note 44, at 5736; Nimmer, *supra* note 42, Sec. 6.09, at 6-26; Goldstein, *supra* note 52, Sec. 4.2.2, at 4:20; Harvard Law Review Association, "Accountability among co-owners of statutory copyright", 72 Harv. L. Rev. 1550 (1959); *Noble v. D. Van Nostrand Co.*, 164 A.2d 834 837-38 (N.J. Super. Ct. Ch. Div. 1960); *Crosney v. Edward Small Productions*, 52 F.Supp. 559, 561 (S.D.N.Y. 1942); *Spyke*, *supra* note 38, at 464.

Tenancy in common rules govern the relationship among co-authors of a joint work, except where there is an agreement to the contrary. Consequently, each co-author shares equal ownership of the joint work.<sup>66</sup> This is notwithstanding the fact that an author's contributions to the joint work are deemed qualitatively or quantitatively different.<sup>67</sup> Usually the U.S.A. courts have applied, by analogy, the rules governing tenancy in common in real property.<sup>68</sup>

Applying tenancy in common rules means, for example, that a suit for infringement against one's co-author may not be filed, because "it is not possible to infringe one's own copyright."<sup>69</sup> Therefore, a co-owner may either use the work himself or license such a use to third parties, without the necessity of other co-author's consent, his only obligation being a duty to account to the latter. In real property tenancy in common, each co-tenant may possess, or give others the right to possess, the entire parcel and require each co-tenant to account to the others for their fractional share of any profit earned from the use.<sup>70</sup>

It has been argued that if in the case of a co-author directly using the joint work, he has a conceivable duty to account to other co-authors, in cases of real property, a co-tenant in possession is not liable for the value of his occupancy.<sup>71</sup> However, courts are in accordance with affirming an obligation of accounting to other co-authors, even in cases of direct use.<sup>72</sup> It is noteworthy that, in so affirming, the courts depart from the real property rule and rely on the constructive trust theory.<sup>73</sup> However, in the case of a copyright licence, only a non-exclusive licence may be legally granted in the absence of the other co-author's consent. An exclusive licence is included in the concept of transfer of copyright, thus being subject to a unanimous consent.<sup>74</sup> A co-owner may legally transfer only his interest in the joint work to third parties, while he cannot transfer his co-authors' interest without their consent.<sup>75</sup> Therefore, being an exclusive licence, a *species* of transfer, it may be granted only through unanimity. On the contrary, a non-exclusive licence may be legally granted by only one co-author.<sup>76</sup>

Analogizing from real property joint ownership, an exclusive licence is intended as a form of "destruction" of the copyright in the common good, while a non-exclusive licence is considered to be incapable of destroying it. However, this kind of analogical interpretation is troublesome, at least in some circumstances. For example, if a court holds that such a destruction will be probable even in the case of a non-exclusive licence, it should "not hesitate to invalidate those licences executed by only one joint owner, even before the

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<sup>66</sup> Nimmer, *supra* note 42, Sec. 6.08, at 6-25; Goldstein, *supra* note 52, Sec. 4.2.2, at 4:21; see also *Silverman v. Sunrise Pictures Corp.*, 273 F. 909 (2d Cir. 1921); *Sweet Music, Inc. v. Melrose Music Corp.*, 189 F. Supp. 655 (S.D. Cal. 1960).

<sup>67</sup> Nimmer, *supra* note 42, Sec. 6.08, at 6-25; Goldstein, *supra* note 52, Sec. 4.2.2, at 4:21; *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1489 (D.C. Cir. 1988); *Maurel v. Smith*, 271 Fed. 211 (2d Cir. 1921).

<sup>68</sup> Nimmer points out how such a situation is not to be confused with "joint tenancy", which may eventually apply to the joint work, but only *ex contractu*, not as a normal provision statutorily established; see Nimmer, *supra* note 42, Sec. 6.09, at 6-26.

<sup>69</sup> Nimmer, *supra* note 42, Ssec. 6.10, at 6-27; *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429 (S.D.N.Y. 1974); *Richmond v. Weiner*, 353 F.2d 41 (9th Cir. 1965).

<sup>70</sup> Goldstein, *supra* note 52, Sec. 4.2.2, at 4:20.

<sup>71</sup> The reason seems to lie in the practical problems connected with establishing a price on the imputed value of a co-owner's use. However, such a difficulty does not manifest in cases of copyright; see Goldstein, *supra* note 52, Sec. 4.2.2, at 4:23.

<sup>72</sup> See *Maurel v. Smith*, 271 F. 211, 216 (2d Cir. 1921); *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 73 F. Supp. 165 (S.D.N.Y. 1947).

<sup>73</sup> See Goldstein, *supra* note 52, Sec. 4.2.2, at 4:23.

<sup>74</sup> "A *transfer of ownership* is an assignment, mortgage, exclusive licence, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect, but not including a non-exclusive licence"; see 17 U.S.C. § 101.

<sup>75</sup> Nimmer, *supra* note 42, Sec. 6.11, at 6-32; see also *Crosney v. Edward Small Prods.*, 52 F. Supp. 559 (S.D.N.Y. 1942).

<sup>76</sup> Nimmer, *supra* note 42, Sec. 6.10[A], at 6-28.

exploitation and resulting destruction has occurred.”<sup>77</sup>

Such a tenancy in common regime applies even if the contributions have been very different in terms of quantity or quality. It is legitimate to envisage a situation where a co-author, who contributed in a lesser extent to writing, is lawfully admitted to use this writing or to create a new edition, without the obligation to ask consent from anybody. At the same time, it is conceivable that the author of a short musical composition intended to be attached to a considerably longer sequence of images is permitted to use the whole work, or even just the images, in order to create a new derivative work.<sup>78</sup> It is apparent why some have defined this as the possibility that a co-author “appropriates” the interdependent and separately copyrightable contributions of another.<sup>79</sup>

While in cases of inseparable contributions tenancy in common is probably the most efficient regulatory solution in terms of ownership, in cases of interdependent contributions, it no longer seems to be the case. If the individual contribution of the co-author is separable (in the sense that it is interdependent) from the joint work, and on the top of that, the contribution is independently copyrightable, then the idea that this part of the work should be governed by tenancy in common rules with the relative “appropriation” risk, instead of a “classic” copyright rule, is to be rebutted. Additionally, in light of the above discussion regarding the intent requisite in joint works, the “inherent and unavoidable danger [...] is denial of authorial contributions.”<sup>80</sup> Thus if the purpose is to protect the final work as a whole, then the ownership rules that apply to collective works seem to be more appropriate.<sup>81</sup> In this manner, not only the final collaborative product, but also the individual, autonomously copyrightable, and separable contribution would be protected, and any “appropriation risk” is avoided.

Under an *anticommons* point of view, the north-American situation is not so severe as compared to the Italian one, since the only unanimous deliberation requirement relates to the transfer of the work, a term which includes an exclusive licence. In this system, the economic existence of the good is favoured, sometimes regardless – or even against – the interest of one or more of its authors/owners. Although, the continuous growing of collaborative opportunities, favoured by the networked digital economy, and since 1978, by legislative reform, has recently been at the basis of what has been indicated as the intent of narrowing the joint work applicability by courts. A substantial role in this trend is played by the weight that transfers and exclusive licences have acquired, especially in the digital environment.

The aim of the courts is not totally futile of course, since recognizing too many

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<sup>77</sup> Nimmer, *supra* note 42, Sec. 6.10[A], at 6-29. However it is recognized that the analogy between the destruction of tangible property and the “destruction” of copyright in the sense of an exclusive license “which permits such extensive use of a copyrighted work as to greatly diminish its value”, is not pacific. Such interpretation poses “metaphysical problems” with regard to the possibility that an immaterial good (therefore not rival in consumption) may be destroyed; *id.*, Sec. 6.10[A], at 6-28; see Shapiro, *Bernstein & Co. v. Jerry Vogel Music Co.*, 73 F. Supp. 165 (S.D.N.Y. 1947), affirming such a destruction; denying this possibility *Shapiro v. Fields*, 152 N.Y. Supp. 487 (Sup. Ct. 1915).

<sup>78</sup> In this case, the derivative work would not be jointly owned by the co-authors of the original work. In fact, more generally, the consensus required by the derivative author for using the original work is not to be confused with a case of joint authorship. In a specific case, it has been established that co-authorship in the original work does not entitle co-ownership in the derivative work. Hence, if a co-author creates a derivative work (without being required for any consent), he will be the exclusive author of such a derivative work; see Nimmer, *supra* note 42, Sec. 3.01, at 3-2.

<sup>79</sup> Therese M. Brady, “Manifest intent and copyrightability: the destiny of joint authorship”, 17 *Fordham Urb. L. J.* 257, (1989).

<sup>80</sup> Lior Zemer, “Is intent to co-author an “uncertain realm of policy”?”, 30 *Colum. J. L. & Arts* 611, 613 (2007); see also Paulette S. Fox, “Preserving the collaborative spirit of American theatre: the need for a “joint authorship default rule” in light of the *Rent* decision's unanswered question” 19 *Cardozo Arts & Ent. L.J.* 497, 514-515 (2001).

<sup>81</sup> It is interesting to note how the meanings of “creative control” or “dominant author” are increasingly becoming closer to that of collective works.

authorial contributions in an environment where exclusive licences are a touchstone could bring about an *anticommons* situation similar to the Italian case. Furthermore, a “risk of appropriation” and denial of authorial contributions are real dangers that have been already reported by more than one scholar, especially in the case of interdependent contributions.

Notwithstanding, the way in which courts tried to pursue this purpose is questionable. If recognizing too many authorial contributions is seen as a danger, then the cure proposed by north-American courts so far, seems worse than the sickness that they aim to address. Applying the Goldstein standard, beyond narrowing such applicability, is also a valuable instrument to protect the Public Domain by refusing to give protection to those contributions that are not creative, and thus deserve no protection through copyright. It is noteworthy that some of the cases involving such discussions, have motion picture (cinematographic) works as subject matter, a category for which in Italy there is a special rule: favouring four predetermined types of authors, morally, and the producer, economically. It may not be the fairest solution every time, but at least this rule bears the important characteristic of legal certainty.

## **5. Conclusion**

As a general comparative conclusion regarding the convergence of definitions and the divergence of operative rules, we have identified a fundamental aspect that is omitted in other studies: the ownership regime in the case of a joint authorship. How such ownership operates is often not considered in copyright analysis because it falls outside the traditional realm of copyright law. Both the systems studied herein are linked to the external legal concept of tenancy in common. From the analysis of the workings of the provisions on tenancy in common, which in both jurisdictions were originally meant exclusively for material property, we have reconstructed an original explanation of why the usage of the same category, beside close definitions, has been so different. We described the advantages and disadvantages of such different implementations, and observed how commentators and courts have changed their positions over time in order to adapt to the new trends in the “cultural” industries, in society, in legislation and in the technological development.

In conclusion, we propose a solution in order to limit the dangerous and opposite deviations that many observers have correctly identified in both implementations. Where contributions are distinguishable, the use of tenancy in common rules proves to be fallacious, especially where tenancy in common works on a “disjunctive” basis (U.S.A.). In such a situation, the appropriation risk is evident: the possibility of one contributor using the other's contribution to create a new work of which she will be the exclusive author, without having any requirement to ask permission, being the original a joint work - and one “cannot infringe her own copyright.” On the Italian side, the same action would probably require unanimity, and thus the problem is avoided. However, precisely the exasperation of unanimity rules on the Italian side (with the connected *anticommons* threat) has created an even clearer consequence: a joint work construction is rarely used (apart those cases statutorily defined).

Tenancy in common rules should be used as an “extreme ratio” in all those cases where it is impossible, or too costly, to operate otherwise, namely when and only when contributions are not distinguishable. Nevertheless, in such cases the rules on tenancy in common should be softened in those jurisdictions - such as Italy - where unanimity is required for almost any type of use. A majority rule for the most important uses (moral rights and exclusive licences), is probably the best solution. For minor uses, such as non-exclusive licences, a disjunctive administration would probably favour the blossoming of such category, and should be looked at with favour in all those cases where it does not harm the concomitant use of the other co-tenants. By following these simple policy recommendations, we are confident that a joint work system in copyright law would reward co-authors with an efficient and fair ownership in a common good.