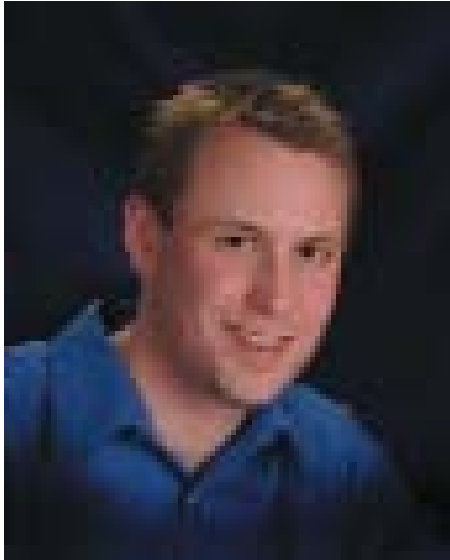


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Readers of my previous columns and articles will recall a concept in copyright law called “work made for hire,” which essentially alters the general rule that the creator of a copyrightable work is automatically the copyright owner. Because planetarium shows are often assembled with pieces from many different creators, sorting out who owns what rights can become complicated, depending on the relationship of the parties engaged in the creation. This quarter’s column brings a look at some of the dynamics of a “work made for hire” relationship.

“Work Made for Hire” Defined

The concept of a “work made for hire” comes directly from the Copyright Act itself, where the relevant portion of the definitions section, 17 U.S.C. § 101, reads:

A “work made for hire” is:

a work prepared by an employee within the scope of his or her employment; or
a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion pic-

ture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

Section 201 of the Copyright Act, the section that deals with copyright ownership, reads:

Works made for hire. In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of [copyright law], and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.

A plain-English reading of these two sections together suggests that copyright in works prepared by an employee, for an employer, within the scope of the employment relationship, vests in the employer. Though it seems relatively straightforward, these two sections have given rise to a substantial amount of litigation, arguing over what constitutes an employment relationship, what constitutes activity within the scope of employment, and a host of other issues.

Works Prepared in an Employment Relationship

The first question frequently raised by the work made for hire (WMFH) doctrine is what constitutes an employment relationship. In 1989 the Supreme Court had the opportunity to set forth specific guidelines for determining when an employer-employee relationship exists, as opposed to an independent contractor relationship, in *Community for Creative Nonviolence v. Reid*, 490 U.S. 730 (1989). Rather than develop new rules for the copyright context, the Court opted to simply apply generally applicable factors used across various fields of law.

In determining whether a party is an employee or independent contractor, courts consider the degree of control that the employer had over the alleged employee, the degree of skill involved in the work, the

source of “instrumentalities and tools” used in the creation of copyrightable work, where the work took place (employer’s workplace or the alleged employee’s own place of business), the nature of payment (regular salary payments versus payment on a per-project basis), the ability of the alleged employee to hire assistants and other staff, and the tax status of the alleged employee.

Even after establishing an employer-employee relationship, copyright only vests in the employer if the work undertaken by the employee falls within the scope of the employment relationship. This analysis is somewhat more straightforward, but still raises issues. Generally, something falls within the scope of the employment relationship if it is of the nature and type of work generally performed by the employee. Although the

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court will look to employers’ job descriptions when determining whether certain work falls within the scope of employment, they are not, by themselves, determinative.

The issue comes up with some frequency in the education community, when teachers prepare instructional materials in which the school or school system later attempts to claim ownership. The prevailing view in such a situation is unless the employer specifically requested the creation of such materials and provides unique resources to the employee to create such materials, the work was not prepared within the scope of employment and copyright will be held by the employee.

Applying these two concepts simultaneously, it is clear that copyright in works prepared by an employee within the scope of an employment relationship with an employer is held by the employer, absent an agreement to the contrary. The corollary, then, is that works prepared by an independent contractor, even at the specific direction of the person or entity commissioning the work, is held by the independent contractor, unless other arrangements are made.

Works Prepared Outside of an Employment Relationship

As established above, works prepared outside of an employment relationship are owned by the creator. This even includes cases when a work is specially commissioned

by someone; unless a specific arrangement is reached regarding the underlying copyright, such rights are owned by the creator, regardless of who paid for the work or the circumstances giving rise to the creation of the work.

In developing the Copyright Act, though, Congress recognized that there are some instances where third-party, non-employee contributions to copyrightable works are so frequent, that it was advisable to allow parties to easily transfer ownership of the copyright from the creator to the commissioning party.

To qualify for WMFH treatment, absent an employment relationship, a work must fall into one of the nine categories set forth in the statute: a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas.

Once it is established that the work qualifies for WMFH treatment, the parties must agree that the work will be treated as a WMFH and that the copyright will vest in the commissioning party. The courts disagree as to the timing of this writing, specifically whether it must be signed before the work is created, but sound legal practice is to include the WMFH provision in the same written document that provides for the working relationship between the parties and have it signed before any work begins.

“Forcing” A Work Made for Hire

It is extremely common for contracts relating to the creation of copyrightable work to include a clause that essentially says everything created under the contract will be considered a work made for hire and copyright will vest in the commissioning party. Unless the work is one of the nine categories set forth in 17 U.S.C. § 101, however, this language will be ineffective.

Put differently, unless the work was prepared within the scope of an employer-employee relationship, or the work at issue falls into one of the nine categories in 17 U.S.C. § 101 and the parties agreed to consider it a work made for hire at the time the contract was entered into, then the work cannot possibly be a work made for hire, even if the parties say so in the contract.

So how can one acquire rights in a work prepared by a third party if it does not qualify for WMFH treatment? The answer is what lawyers often call a “short form assignment,” which essentially amounts to a statement that the creator grants to the commissioning party all of its rights, titles, and interests in the intellectual property that arises as

a result of the creation of a work of authorship.

Strong, well written agreements will include language to cover both potential cases, including both a statement that if the work qualifies as a WMFH, it is to be treated as such, with copyright vesting in the com-

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missioning party, and a statement that if the work does not qualify for WMFH treatment, that the creator transfers and assigns all of its right, title, and interest in the work to the commissioning party.

The Practical Impact

With the legal framework firmly in place, we can consider some situations that appear in a planetarium context on a nearly daily basis.

Perhaps the most clear-cut example is an individual hired by a planetarium to work as a program producer. The copyright to any planetarium shows, programming elements, or related material would be held by the planetarium and not the employee. However, if the employee were to write a manual on planetarium show design, or perhaps contribute to a professional publication such as the *Planetarian* or a regional planetarium society newsletter, such work would likely fall outside the scope of employment, and the employee would own the copyrights.

Where the WMFH doctrine becomes more involved is when a planetarium makes use of third parties to prepare elements that get folded into a unified production. A typical planetarium production might include contributions from outside artists, composers, scriptwriters, and other creative professionals, all of whom retain the rights in their creations unless the contracts say oth-

erwise. Although this fact is unlikely to hinder your own use of the work under your own dome, it may raise significant barriers should you desire to repurpose the production or distribute it to other facilities.

To combat this potential problem, care should be taken to include the appropriate language in agreements with third party service providers. The average planetarium show would likely be considered a “motion picture or other audiovisual work,” thereby qualifying the work to be done by the contractor to be treated a WMFH if the parties opt to do so.

Although circumstances vary widely and the precise language should be drafted by an attorney after reviewing your specific situation, a typical contract for creative services should include a description of the project and recite the fact that the results will be included in a planetarium show which constitutes an “audiovisual work” under § 101 of the Copyright Act. The agreement should further provide that the parties agree the work will be treated as a WMFH and that copyright will vest in the planetarium. As a backup, a short form assignment is also advisable in case it is later held that the work did not qualify for WMFH treatment. ☆

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