

# **Joint Authors: When Are Collaborators in a Musical Work Entitled To Share In The Copyright Of The Work?**

*by*

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A much anticipated celebrity copyright decision was handed down by the Supreme Court of British Columbia in December of 1999. In *Neudorf v. Nettwerk Productions Ltd. et al.*<sup>1</sup> the court had to decide whether Mr. Neudorf was the co-owner of the copyright in four musical works which appeared on phonograph record containing performances by one of the defendants, Sarah McLachlan, a well known Canadian singer and songwriter. This record was commercially released by the defendant record company in September of 1988 under the title **Touch**. It was an important album in launching Ms. McLachlan's career. Mr. Neudorf claimed that he co-authored four songs, namely: "Strange World," "Steaming," "Vox" and "Sad Clown." He also claimed damages for breach of copyright arising out of the defendants' use of these songs.

### ***The Basic Facts***

Mr. Neudorf was a musician, a drummer for a Vancouver band called 54-40. He was an acquaintance of Mr. Jowett, a principal of the defendant Nettwerk. In 1987, Nettwerk offered Ms. McLachlan a \$5,000 recording contract. In September 1987 Ms. McLachlan began work on the **Touch** project in Vancouver. In the fall of 1987, Mr. Jowett invited Mr. Neudorf to come to Vancouver to work on the **Touch** project. The plaintiff accepted the offer in return for his airfare, accommodation and a weekly *per diem*. The preproduction recording set was put up in the back of Nettwerk's offices in the middle of January 1988. Mr. Neudorf and Ms. McLachlan began working together on the **Touch** project. In March of that year, the **Touch** project moved to Limited Vision Recording Studio and the parties' working relationship continued until the end of March when the plaintiff left the **Touch** project. It was during this period of time that the plaintiff claimed to have co-written the songs referred to above with Ms. McLachlan.

### ***The Issues***

Mr. Justice Cohen's 69 page decision provides an exhaustive review of the case law from which he distills the test for joint authorship under the *Copyright Act*.<sup>2</sup> Mr. Justice Cohen concluded that authorship has two basic requirements: originality and expression in a tangible form.<sup>3</sup> Mr. Justice Cohen found that originality is not defined by the Act,

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<sup>1</sup> [1999] B.C.J. No. 2831.

<sup>2</sup> R.S.C. 1985, c. C-42.

<sup>3</sup>*University of London Press Ltd. v. University Tutorial Press Ltd.*[1916] 2 Ch. 601. *Commercial Signs v. General Motors Products of Canada Ltd. et al* [1937] 2 D.L.R. 310 (Ont. C.A.) and *Grignon v. Roussell* (1991), 38 C.P.R. (3d) 4 (F.C.T.D.). In *Grignon*, a case dealing with alleged infringement of copyright in a musical work, the Court decided as follows:

First, no one may claim copyright to an idea; it must have taken material form of some kind if is to be protected by copyright. Secondly, the work created must be original or at least be of innovative nature: No one may copy an existing work...[T]he registration of a work is not necessary to provide copyright protection for its author.

but determined that the word “original” appeared to be well settled by the *University of London Press Ltd.* case. He relied on the *University of London Press* case definition of “originality” to opine that in order for Mr. Neudorf to succeed, he had to prove that the expressions he claimed to have contributed to the songs originated from him and were not copied.

The plaintiff asserted that while he at times suggested an idea to Ms. McLachlan, it was clear from the evidence that he was involved in the actual expression or writing of the ideas as well. Mr. Justice Cohen held that the issue before him was, not whether the plaintiff was “involved in the actual expression or the writing of ideas”; but rather whether the plaintiff himself contributed original expression to the songs. It was only then would he be able to meet the test for joint authorship under the *Copyright Act*.

Mr. Justice Cohen also found that the case law provides that the contribution of joint authors to the work need not be equal. He did find that even though the contribution of one joint author need not be equal to that of the other joint author, the contribution of each joint author must nevertheless be significant or substantial.<sup>4</sup>

Both parties called expert evidence to characterize the contribution that Mr. Neudorf had made to qualify him as a joint author. Mr. Bill Henderson, a very experienced singer, guitarist, songwriter and performer, was called as an expert witness for the defence. He opined that a songwriter’s work comes down to three things: lyrics, melody and chords. He stated that any contribution to a particular performance of a song, whether recorded or live, that did not fall into one of those categories did not amount to song writing. Ms. McLachlan shared Mr. Henderson’s opinion. However, the Court rejected that approach and found that the type of contribution that can support a claim for declaration of co-ownership, copyright and musical work is broader than the definitions given by either Ms. McLachlan or Mr. Henderson.

Mr. Justice Cohen was of the opinion that copying parts of a musical work, other than just the lyrics, melody or chords could constitute the infringement of copyright in a musical work. His view was that a contribution of significant, original expression to parts of a musical work, other than just lyrics, melody and chords, could also give rise to a claim of co-ownership of copyright in a musical work.

He then went on to discuss what elements of co-operation a plaintiff must establish in order to satisfy that that person is a joint author of a musical work. Mr. Justice Cohen

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<sup>4</sup>In the English case of *Godfrey v. Lees* [1995] E.M.L.R. 307 (Ch. D.) the plaintiff worked with a band in composing several musical works and claimed to be the joint author of six songs that appeared in the defendants’ record albums. One of the songs was a 48 bar work and the plaintiff’s contribution to the song consisted of composing 6 bars out of the 48. The Court held as follows:

In my view, the plaintiff’s contribution is sufficient in importance and originality to qualify him as a joint author of the work. The fact that when composing the 6 bar orchestral link, the plaintiff took the basic melodic and harmonic lines from the song does not deprive the plaintiff of a share in the authorship in the work in the form in which I heard it. The link passage is, to my ear, an original and cleverly worked adaptation of the songs.

reviewed the common law definitions of joint authorship and the statutory definitions of joint authorship in Canada, England and the United States. Mr. Justice Cohen expressed the rationale for the intent to co-author policy expressed by the Court in *Childress v. Taylor*<sup>5</sup> to the effect that a person should not be elevated to the status of joint author unless each of the collaborators intended the other to be a joint author of the work. He summarized his opinion as follows:

[T]his standard accommodates the competing demands advancing by persons claiming ownership in a creative work and pays heed to the important warnings stated in *Childress v. Taylor* at page 504, “care must be taken to ensure that true collaborators in the creative process are accorded the perquisites of co-ownership and to guard against the risk that sole author is denied exclusive authorship status simply because another person rendered some form of assistance. Copyright law best serves the interest of creativity when it carefully draws the bound of joint authorship so as to protect the legitimate claims of both sole authors and co-authors”.

He concluded that mutual intent is a prerequisite for finding collaboration. In other words, the intent to co-author is a requirement under section 2 of the *Copyright Act*.

### ***The Test for Joint Authorship***

Mr. Justice Cohen summarized the test for joint authorship, as applied to the facts of the Neudorf case, as follows:

1. Did the plaintiff contribute significant original expression to the songs? If yes, then:
2. Did each of the plaintiffs and Ms. McLachlan intend that their contributions be merged into a unitary whole? If yes:
3. Did each of the plaintiffs and Ms. McLachlan intend the other to be a joint author of the songs?

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<sup>5</sup> 945 F.2d 500 (2d Cor. 1991). In that case the plaintiff play write alleged infringement of copyright in a play she wrote, and the defendant actress claimed to be a joint author of the play. The *Childress* decision was an exhaustive analysis of how copyright law interplays with joint authors. The Court examined the *United States Copyright Act*, its legislative history and the case law before concluding that intent to co-author a musical work is a requirement as part of the test for joint authorship. The Court stated quite clearly that joint authorship did not require an understanding by the co-authors of the legal consequences of their relationship, but that the parties entertain in their minds that the concept of joint authorship. In other words, in absence of a contractual agreement concerning listed authorship, each participant had to intend that all would be identified as co-authors in that although billing and credit was not decisive in all cases, “joint authorship can exist without explicit discussion of this topic by the parties, consideration of the topic helpfully serves to focus the fact finder’s attention on how the parties implicitly regarded their undertaking”.

The Court applied this test in reviewing how each song was developed. For the song “Steamy”, after reviewing the plaintiff’s evidence and Ms. McLachlan’s concession about the plaintiff’s contribution, Mr. Justice Cohen was satisfied that the plaintiff contributed original expression to the verse vocal melody and it was a contribution of significant, original expression. Notwithstanding that the verse vocal melody was not heard in the second part of the song, it was nonetheless an important component of the whole song.

Mr. Justice Cohen also found that Mr. Neudorf had also met the second part of the test in that both he and Ms. McLachlan clearly intended that his contribution to the verse vocal melody would be merged into the song, and that there was shared intent between the parties to merge the plaintiff’s contribution into the song. However, Mr. Justice Cohen found that the plaintiff failed in proving that both he and Ms. McLachlan intended the other to be a joint author. He found as a fact that Ms. McLachlan never thought she was writing songs with the plaintiff, as she was adamant that she did not regard the plaintiff as a co-author of the song. Furthermore, he observed there was no evidence of any conversations between Ms. McLachlan and the plaintiff during the **Touch** project about splitting song-writing credits for the songs.

In applying this test to the balance of the songs, “Vox”, “Strange World” and “Sad Clown”, Mr. Justice Cohen found that the plaintiff failed to prove he had contributed original expression to any of these songs and in the result, no joint authorship, and hence copyright ownership was proven.

Mr. Neudorf also claimed that he made contributions to the songs in the nature of musical composition. He claimed that he collaborated with Ms. McLachlan on an arrangement of songs and thus was entitled to copyright ownership in the arrangement of the songs. After reviewing the authorities, Mr. Justice Cohen concluded they established that in one sense an arrangement refers to a new musical work, which results from the rearrangement of an existing musical work. In this situation, there can be copyright in the rearrangement, independent of the existing musical work. In other words, an arrangement refers to the contribution of original expression to a musical work before it is completed - such as the composition of an instrumental accompaniment or an instrumental passage that links verse and chords. He held that the plaintiff’s contributions to the arrangement of the songs in question did not fall into either category as none of his arrangement contributions were of musical composition. Rather, he likened them to contributions of suggestions or ideas, and therefore, did not meet the tests for joint authorship.

Mr. Neudorf also claimed contributions in the nature of titles to two songs in issue. The defense conceded that the plaintiff contributed the titles to “Sad Clown” and “Vox”. The plaintiff did not claim that in reproducing solely the titles written by him that the defendants had reproduced a substantial part of his copyright. Rather, he claimed that titles “Vox” and “Sad Clown” authored by him formed part of the copyright in those musical works of which he was a co-owner. Mr. Justice Cohen concluded that the plaintiff’s contributions to “Vox” and “Sad Clown” constituted a contribution of original expression but were not a significant or substantial enough contribution to meet the test for joint authorship.

Mr. Justice Cohen need not have used copyright law analysis to dismiss the plaintiff's claim to the titles in those songs. The case law suggests that the correct approach would have been to hold that no person can assert copyright in a single word, name or title. The courts have held that apart from the law as to trade-marks, no one can claim monopoly in the use of a name or word.<sup>6</sup> Thus the only remedy available to the plaintiff to claim rights in the titles of the songs sounds in trade-mark law and not copyright law.

The *Neudorf* decision is not only significant because of the analysis of the test of what a plaintiff has to prove in order to assert joint authorship in a musical work, but also because it further entrenches the view that American cases can be used as a source of guidance in copyright cases.<sup>7</sup> The *Neudorf* case also sets the standard for those parties asserting copyright infringement in cases of joint authorship claims, particularly in cases involving musical works.

Finally, the case illustrates the need for musicians, songwriters, recording companies, and indeed legal practitioners, to turn their minds to issues such as what constitutes significant contribution to a song, intention to jointly collaborate on musical works, and what credit each party will be given when the song is ultimately published. The parties who jointly collaborate on these types of projects are well advised to seek legal advice and enter into written agreements before embarking on collaborations of this nature.

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<sup>6</sup> See *British Columbia v. Mihaljevic* [1989] B.C.J. 956 (BCSC); affd. [1991] B.C.J. 2192 (BCCA). In that case the British Columbia Supreme Court dismissed a counterclaim by the defendant entrepreneur who created designs for t-shirts using the EXPO 86 trade-mark and official mark. The defendant counterclaimed against Expo 86 Corporation and claimed copyright infringement of his designs by the corporation's use of its EXPO 86 trade-mark and official mark. The court dismissed the counterclaim and relied on *Burberrys v. J.C. & Cording Ltd.* (1909), 26 R.P.C. 639 (Ch. Div.); *Exxon Corporation v. Exxon Insurance Consultants International Ltd.*, [1981] 3 All E.R. 241 (C.A.) and *Tavener Rutledge Ltd. v. Trexapalm Ltd.*, [1977] R.P.C. 275 (Ch. Div.). See also *King Features Syndicate v. Lechter* (1950) 10 Fox. Pat. C. 144 (Ex Ct.of Can.) where the defendants use of the word Popeye in association with watches was held not to be an infringement of the Plaintiff's copyright in the title "Popeye", the well known comic strip.

<sup>7</sup> Mr. Justice Cohen was mindful of the caution expressed in *Compo Co v. Bluecrest Music Inc.* (1979), 45 C.P.R. (2d) 1(S.C.C.), which was a case dealing with infringement of copyright in a musical work, where the Court stated that notwithstanding the *United States Copyright Act's* similarities to the *Canadian Copyright Act*, the United States' decisions, even where factual situations were similar, must be scrutinized very carefully because of some fundamental differences in copyright concepts. However, Mr. Justice Cohen noted that the Supreme Court of Canada did not discourage Canadian Courts from examining the U.S. experience.