Whose Song is it Anyway? When are Sound Recordings Used in Audiovisual Works Subject to Termination Rights and When are They Works Made for Hire?

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Whenever I talk to a band…about to sign with a major label, I always end up thinking of them in a particular context. I imagine a trench, about four feet wide and five feet deep, maybe sixty yards long, filled with runny, decaying shit. I imagine these people, some of them good friends, some of them barely acquaintances, at one end of this trench. I also imagine a faceless industry lackey at the other end, holding a fountain pen and a contract waiting to be signed.

Nobody can see what's printed on the contract. It's too far away, and besides, the shit stench is making everybody's eyes water. The lackey shouts to everybody that the first one to swim the trench gets to sign the contract. Everybody dives in the trench and they struggle furiously to get to the other end. Two people arrive simultaneously and begin wrestling furiously, clawing each other and dunking each other under the shit. Eventually, one of them capitulates, and there's only one contestant left. He reaches for the pen, but the Lackey says, "Actually, I think you need a little more development. Swim it again, please. Backstroke."

And he does, of course.

—Steve Albini, music producer, on the music industry

Introduction

In an effort to combat the exploitative nature of many authorship industries, Congress included a termination of transfer provision in the 1976 Copyright Act ("1976 Act" or "Copyright Act") that gives authors a "second bite at the apple." It does so by allowing authors who assign their copyrights to third parties the right to reclaim their copyrights 35 years after the original assignment, regardless of any contrary agreement made at the time of the original assignment. On the other hand, the 1976 Act also benefits industrial copyright holders with the work-made-for-hire provision. This provision states that employers are considered the “authors” of works created by their employees in the course of their employment, and that parties that “specially order or commission” a work pursuant to a written work-made-for-hire
agreement will be considered the “author” of the commissioned work, provided it fits into one of nine statutory categories.\textsuperscript{[5]} Employers and commissioning “authors” own the copyright in works made for hire for 125 years from the date of creation or 95 years from the date of first publication, whichever comes first.\textsuperscript{[6]}

This copyright ownership scenario has caused much consternation and scholarly comment among the music industry and copyright academy because it is unclear whether and when sound recordings can be considered works made for hire.\textsuperscript{[7]} Sound recordings are not listed independently as one of the nine statutory work-made-for-hire categories.\textsuperscript{[8]} Therefore, sound recordings can only be works made for hire if they are created by employees in the course of their employment or if they are specially commissioned for use that somehow fits one of the other nine statutory categories.\textsuperscript{[9]} Nevertheless, most recording contracts state that the recordings created thereunder are works made for hire owned by the commissioning party.\textsuperscript{[10]} In addition, these contracts generally contain a backup clause stating that, if for any reason the works created under the contract are not works made for hire, the artist assigns all right, title, and interest in the works to the commissioning party.\textsuperscript{[11]} Thus, if the work made for hire clause is given effect, then the commissioning party will own the copyright in the recordings for at least 95 years.\textsuperscript{[12]} On the other hand, if the recordings cannot be considered works made for hire, then the assignment clause grants the copyright to the commissioning party for 35 years, at which point the recording artist can reclaim his or her copyright or extract more money from the commissioning party in exchange for continued copyright ownership.\textsuperscript{[13]}

The issue of whether and when sound recordings can be considered works made for hire has been the subject of scholarly commentary\textsuperscript{[14]} as well as a passed and
hastily-repealed statutory amendment, [15] but only a handful of adjudicated cases. [16] Much of the scholarly commentary deals with the issue of whether commissioned sound recordings can be considered works made for hire under the statutory “contribution to a collective work” or “compilation” work-made-for-hire categories. [17] Yet, the only courts to actually conclude that sound recordings can be considered works made for hire did so on the basis that the recordings in question were “specially ordered or commissioned for use as…a part of a motion picture or other audiovisual work.” [18] Although only these two cases have held that sound recordings specially commissioned for use in an audiovisual work can be considered works made for hire, other courts have reached the same conclusion regarding other types of works commissioned for use in audiovisual works. [19] Unfortunately, neither the judicial opinions nor the scholarly articles on this issue give much guidance as to when sound recordings can be considered “specially ordered or commissioned for use…as a part of a motion picture or other audiovisual work.” [20] Yet, the question of whether sound recordings in general can be considered works made for hire and the integrity of the work made for hire provision as a whole depend on what standard is used to determine whether a work is “specially ordered or commissioned for use as…a part of a motion picture or other audiovisual work.”

Part I of this article will describe the termination of transfer provision, the work made for hire provision, the passed and repealed 1999 amendment adding sound recordings as a work made for hire category, and how this statutory framework applies to sound recordings and recording contracts. Part II will describe the scholarly commentary and relevant case law on whether and when sound recordings and other works can be considered works made for hire. Part III of the article argues (A) that courts have correctly held that sound recordings specially commissioned for use in audiovisual
works can be considered works made for hire, (B) that the courts have failed to give much guidance on when a work can be considered “specially ordered or commissioned” for use in an audiovisual work, and (C) that the guidance the courts have provided would undermine the policy behind the work made for hire provision if applied. Part IV argues that, according to the plain language and the policy of the work made for hire provision, sound recordings and other works can only be considered “specially ordered or commissioned for use as…a part of a motion picture or other audiovisual work” when such use is the primary purpose for commissioning the work.

I. THE STATUTORY FRAMEWORK: TERMINATION RIGHTS AND WORKS MADE FOR HIRE

A. The Termination of Transfer Provision

It is often quite difficult to predict the commercial value of a creative work until some time has passed since their original creation. Who could have known at the time Los Del Rio recorded “La Macarena” that it would become a smash hit, or that Michael Jackson’s “Bad” album would sell substantially fewer copies than his record-breaking “Thriller” album? The 1909 Copyright Act (the “1909 Act”) attempted to give authors an opportunity to obtain remuneration for their works after the commercial value of their works could be determined by dividing the life of a copyright into two twenty-eight year terms and only allowing the second term to be secured during the last year of the first term. However, the Supreme Court undermined this paradigm in Fred Fisher Music Co. v. M. Wittmark & Sons by holding that an author could assign his renewal interest in the second term before he had secured it. This holding made it possible for a copyright purchaser with heavy bargaining power to force an
author into assigning his first and second copyright terms at the outset of their relationship, while the commercial value of the authors work was still speculative, thereby eliminating the author’s “second bite at the apple.”

In drafting the 1976 Act, Congress included a termination of transfer provision that ensures that an author’s “second bite at the apple” cannot be given away before the commercial value of the work is known. Section 203 of the 1976 Act states that an author can terminate any transfer of copyright executed after January 1, 1978 during a five-year period beginning thirty-five years after the initial transfer. In contrast to the 1909 Act, as interpreted by the Fred Fisher court, an author can terminate a transfer of copyright during this period regardless of any contrary agreement made at the time of the initial assignment.

In order to terminate a transfer of copyright, the author must give notice to his assignee stating the effective date of the termination at least two, and no more than ten, years prior to the effective termination date. Because the termination provisions apply to copyright transfers executed on or after January 1, 1978, the earliest possible date an author could terminate an assignment of copyright under Section 203 is January 1, 2013. The earliest possible date an author could have sent legally effective notice of termination was January 1, 2003 (assuming copyright was transferred on January 1, 1978). So far, no courts have had occasion to interpret the bounds of § 203 or how it interacts with other sections of the 1976 Act. However, the termination rights granted in § 203 depend on whether the person or persons who created the work are actually considered the legal “authors” of the work.

B. The Work-Made-for-Hire Provision
The work-made-for-hire provision of the 1976 Act provides two instances in which a person or entity can be considered the “author” of a work that is actual created by another person or group of persons. First, an employer is considered the “author” of works “prepared by an employee within the scope of his or her employment.”[30] Thus, when a software programmer employed by Microsoft writes a piece of code to be used in Microsoft software, Microsoft is considered the “author” of the work and owns the copyright in the work from the moment it is fixed in a tangible medium of expression.[31] However, if that same Microsoft-employed programmer writes a fold song decrying his employer as a malevolent, antitrust-violating corporate scourge, then the programmer would be considered the “author” and would own the copyright in the song from the moment it is fixed in a tangible medium, except in the unlikely event that writing such employer-bashing songs is considered within the scope of the programmer’s employment. In Committee for Creative Non-Violence v. Reid, the Supreme Court stated that whether or not a work is “prepared by an employee within the scope of his or her employment” is determined by applying a multi-factor test derived from common law agency principles. [32]

In order for a work that is not prepared by an employee in the course of employment to be considered a work made for hire, it must be:


Also, the parties “must expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.”[34] Notably, sound recordings are not listed as a statutory work made for hire category. [35] However, for a brief period starting in 1999, that was not the case.
C. The 1999 “Technical Amendment” and its Subsequent Removal

Sound recordings were not listed as a statutory work made for hire category in the original 1976 Act. However, in November of 1999, the Intellectual Property and Omnibus Communications Reform Act (the “IPOCRA”) added sound recordings to the list of statutory work-made-for-hire categories.\(^{36}\) This significant shift in the copyright ownership paradigm was introduced by Mitch Glazier,\(^{37}\) former counsel to the House Intellectual Property Subcommittee, who inserted the sound recording language as a “technical amendment” into the Satellite Home Viewer Improvement section of the IPOCRA.\(^{38}\) The IPOCRA was passed by Congress and signed by President Clinton without any hearings on the “technical amendment” adding sound recordings to the list of statutory work-made-for-hire categories.\(^{39}\)

When authors’ groups and others in the music industry learned of the “technical amendment,” it caused quite a stir. Recording artists and trade group spokespeople lobbied to repeal the amendment.\(^{40}\) In response, Representative Howard Coble (R-NC) introduced what became the Works Made for Hire and Copyrights Corrections Act of 2000 (the “WMHCCA”), which was passed in September of 2000.\(^{41}\) However, the WMHCCA did not simply repeal the IPOCRA’s “technical amendment,” but called for the equivalent of a complete legislative do-over by amending 17 U.S.C. § 101 to read:

In determining whether any work is eligible to be considered a work made for hire under paragraph (2), neither the amendment contained in section 1011(d) of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106-113, nor the deletion of the words added by that amendment—

(A) shall be considered or otherwise given any legal significance, or

(B) shall be interpreted to indicate congressional approval or disapproval of, or acquiescence in, any judicial determination, by the courts or the Copyright Office.
Paragraph (2) shall be interpreted as if both section 2(a)(1) of the Work Made for Hire and Copyright Corrections Act of 2000 and section 1011(d) of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106-113, were never enacted, and without regard to any inaction or awareness by the Congress at any time of any judicial determinations.\(^{[42]}\)

Essentially, this language states that, in determining whether a work can be a work made for hire, the courts should treat neither the addition of sound recordings as a work-made-for-hire category in 1999 nor Congress’ subsequent decision in 2000 to remove sound recordings as a work-made-for-hire category as any indication of legislative intent. So, despite the crowing, crying, and conspiracy theories that arose from the 1999 “technical amendment” and the scholarly debate over whether sound recordings created before, during, or after the period covered by the technical amendment can be considered works made for hire, Congress has explicitly declined to clarify the issue, and by so declining, has implied that it has no intention to do so for the time being. Thus, record labels and other parties seeking to prolong their rights in the recordings of popular artists would be best served to argue that such sound recordings fit the work-made-for-hire provision as originally drafted in the 1976 Act.

**D. Why Does it Matter Whether Sound Recordings are Works Made for Hire?**

As mentioned above, there are only two ways a sound recording can be considered a work made for hire: (1) if it is prepared by an employee within the scope of employment, or (2) if it is specially commissioned for use as one of the nine categories of statutory works made for hire and created under a written work-made-for-hire agreement signed by the parties.\(^{[43]}\) Whether or not a sound recording can be considered a work made for hire by virtue of being prepared by an employee in the course of employment will be a case-by-case inquiry hinging on application of the *Reid* factors to the particular relationship at issue.\(^{[44]}\) However, several scholarly articles suggest that the typical relationship between a recording artist and record label does not meet the *Reid* test for employment.\(^{[45]}\) Thus, most sound recordings can only be works made for hire if they are produced under a written work
made for hire agreement and fall into at least one of the nine statutory work made for hire categories.

Recording agreements typically state that the sound recordings created thereunder are works made for hire to be owned by the commissioning party, thus meeting the written work made for hire requirement. However, if sound recordings do not fit into one of the nine statutory work-made-for-hire categories, such a clause is legally insignificant and the artist or artists that actually create the recording will be considered the authors. Thus, most recording agreements also include a backup clause stating that, if the recordings produced thereunder cannot be considered works made for hire, the artists assign all right, title, and interests to the commissioning party. So, if a sound recording fits into one of the nine statutory work-made-for-hire categories, the commissioning party will likely be considered the “author” of the recording and own the copyright for at least 95 years. If a sound recording does not fit into one of the nine statutory work-made-for-hire categories, the artists that actually create the recording will be considered the authors of the work and will be able to reclaim the copyright in the recording 35 years after assigning it to the commissioning party.

While most sound recordings have little value 35 years after their creation, the sound recordings of successful artists such as Bob Dylan, David Bowie, or James Brown represent consistent, lucrative sources of revenue. If the sound recordings of such artists are found not to be works made for hire because they do not fit any statutory work-made-for-hire category, the record labels and other parties that commissioned the recordings will still own the copyrights by assignment. However, they will be forced to renegotiate with the recording artists for a new assignment of copyright or lose their rights to these lucrative sources of revenue when the authors threaten to terminate the original assignment 35 years after it was made. Because the artists have had ample opportunity to learn the actual value of their sound recordings in those 35 years, and because a new assignment of copyright would last until 70
years after the artists’ death, obtaining such a reassignment of copyright would likely cost the commissioning parties a very large amount of money—money that they would not have to spend if the recordings were considered works made for hire.

II. THE CASE LAW AND ACADEMIC COMMENTARY ON SOUND RECORDINGS AND WORKS MADE FOR HIRE

Only four cases have dealt with the issue of whether and when commissioned sound recordings can be considered works made for hire. Of the four, only Greenwich Film Productions, S.A. v. DRG Records, Inc. and Lulirama Ltd. v. Acess Broadcasting Services., Inc held that the sound recordings at issue could be considered works made for hire, and only to the extent that they were specially-commissioned for use in audiovisual works. However, neither the Greenwich or Lulirama courts nor the academic commentary on the issue have provided much guidance as to when a sound recording can be considered “specially ordered or commissioned for use as…a part of a motion picture or other audiovisual work.” Courts that have held other types of works to be “made for hire” on the grounds that they were specially commissioned for use in audiovisual works have also failed to provide much guidance on when a work fits this statutory category.

A. Sound Recordings as Works Made for Hire

Only four cases have dealt with the issue of whether sound recordings can be considered works made for hire under one or more of the nine statutory categories of works made for hire. Of those four, two stated that the sound recordings before it could be considered works made for hire. The United States District Court for the Southern District of New York was the first court to determine the work-made-for-hire status of a sound recording in Greenwich Film Productions, S.A. v. DRG Records, Inc. In an unreported opinion, the court stated that the sound recording and underlying musical composition at issue before it fit into the statutory
“specially ordered or commissioned for use as...a part of a motion picture” category, but that it was not a work made for hire because it was not created under a written work-made-for-hire agreement. In *Lulirama Ltd. v. Axcess Broadcasting Services, Inc.*, the United States Court of Appeals for the Fifth Circuit held that sound recordings specially commissioned for use in audiovisual works could be considered works made for hire, but that purely audio works were not “audiovisual” works, and that a disputed issue of material fact existed as to whether the sound recordings before the court were commissioned for use in purely audio works, audiovisual works, or both. Less than two years after the *Lulirama* decision, the United States District Court for the District of New Jersey held in *Ballas v. Tedesco* that the sound recordings at issue before it did not fit into any of the nine statutory work-made-for-hire categories and the United States District Court for the District of Columbia held that sound recordings do not fit into any statutory work-made-for-hire category in *Staggers v. Real Authentic Sound*. Yet, despite the fact that the only federal courts to state that sound recordings can be considered works made for hire did so on the grounds that the recordings were “specially ordered or commissioned for use as...a part of a motion picture or other audiovisual work,” much of the scholarly commentary on the work made for hire status of sound recordings deals with whether sound recordings can fit into the statutory “contribution to a collective work” or “compilation.” Those scholarly articles that do address whether sound recordings can fit into the statutory “part of a motion picture or other audiovisual work” category of works made for hire give little space to analyzing when sound recordings can fit this category. Furthermore, because of the particular facts of *Greenwich Film* and *Lulirama*, neither court felt compelled to explain when sound recordings can be considered “specially ordered or commissioned for use as...a part of a motion picture or other audiovisual work.”

Greenwich Film is rarely cited by courts or scholars addressing the issue of whether and when sound recordings can be considered works made for hire, probably because it contributes very little analysis to the issue. Nevertheless, it was the first federal court opinion to deal with the issue, though it was never reported. The plaintiff Greenwich Film Productions (“Greenwich”) contracted with composer Vladimir Cosma (“Cosma”) to compose the soundtrack to a film it was producing entitled “Diva.” Greenwich later entered into an agreement with defendant DRG Records (“DRG”) to distribute the sound recordings of the soundtrack. However, upon expiration of the distribution agreement, DRG failed to return the master recordings to Greenwich and continued to copy and distribute the “Diva” recordings. Greenwich filed suit for injunctive relief claiming copyright infringement and DRG moved for summary judgment claiming that Greenwich could not establish copyright ownership. Greenwich claimed that it owned copyright in the soundtrack as a work made for hire and, alternatively, by assignment from Cosma.

Without much analysis, the court held that both “the compositions and soundtracks were clearly commissioned for a motion picture” and thus fit into one of the nine statutory categories of works made for hire. However, because there was no written and signed work-made-for-hire agreement between Greenwich and Cosma, the court held that the works could not be considered works made for hire. Fortunately for Greenwich, the court went on to hold that Cosma had assigned his copyright in the soundtrack to Greenwich, thus making resolution of the work-made-for-hire issue irrelevant to the resolution of the case. Despite the fact that the Greenwich court’s work made for hire analysis was rendered moot, it was the first court to suggest that sound recordings could, under some circumstances, be considered works made for hire. This view would find support in a later case.

2. Lulirama Ltd. v. Axcess Broadcasting Services, Inc.
In *Lulirama*, the Fifth Circuit was asked to review a lower court’s determination of who owned the copyrights in several sound recordings used in radio and television advertisements, otherwise known as “jingles.” In November of 1991, Axcess Broadcasting Services, Inc. (“Axcess”) contracted with Lulirama, Ltd. (“Lulirama”) to have its president, Spencer Michlin, write fifty advertising jingles. This agreement was written up as a one-page billing statement signed by both parties, to which Axcess added handwritten notations specifying that the works were “for hire.” Lulirama and Axcess later entered into a written license agreement giving Axcess the right to use any musical works in which Lulirama or Michlin could “claim ownership or other right, title or interest, whatsoever.”

Although the parties orally extended the original jingle-writing agreement, Lulirama never produced as many jingles as it was required to under the agreement. In December of 1994, Axcess sued Lulirama and Michlin in Texas state court, alleging breach of contract. In October of 1995, Lulirama and Michlin filed a copyright infringement suit against Axcess in federal court, claiming that it “reproduced the jingles, prepared derivative jingles, distributed copies of the jingles, and authorized others to perform the jingles” without authorization from Lulirama, thus violating Lulirama’s copyrights in the jingles. Axcess filed a motion for summary judgment, arguing in part that it owned the copyrights in the jingles as works made for hire. The district court held that Axcess owned the copyrights in the first seven jingles produced, that Lulirama owned the copyrights in the subsequent twenty-nine jingles, but that Axcess had an implied license to use the twenty-nine jingles to which it did not own the copyrights and that it had not exceeded the scope of this license. Lulirama appealed the district court holding that Axcess owned the copyrights in the first seven jingles and had an implied license to use the other twenty-nine jingles.

First, the Fifth Circuit held that the district court used an improper legal standard to determine that Axcess owned the copyrights in the first seven jingles as works made for
hire. The district court held that Lulirama was not an employee of Axcess, and neither party disputed this ruling on appeal, but that the jingles were works made for hire because they were “specially ordered or commissioned for use...as a part of a motion picture or other audiovisual work.” The district court reached this conclusion based on an affidavit from Michlin stating that he was to supply jingles to Axcess and that “Axcess was to sell these songs to its television and radio station clients.” The district court reasoned that “[i]t is best to interpret the broad term “audiovisual” to include both purely visual and purely audio works as well as combined audio and visual works.”

The Fifth Circuit held that interpreting the term “audiovisual” to include both purely audio and purely visual works not only contradicted the explicit definition of “audiovisual works” contained in the Copyright Act, but also contradicted the Supreme Court’s guidance in Reid that “[s]trict adherence to the language and structure of the Act is particularly appropriate.” The Copyright Act defines “audiovisual works” as

Works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.

The Fifth Circuit pointed out that the district court’s “broad” interpretation of this definition to include purely audio works directly conflicted with the requirement that audiovisual works “consist of a series of related images.” The Fifth Circuit went on to state that Congress’ decision to list “motion pictures and other audiovisual works” and “sound recordings” as distinct categories of works entitled to copyright protection recognizes a distinction between purely audio works and audiovisual works.

Yet, it is what the Fifth Circuit wrote next that has the potential to drastically affect the ownership scheme put in place by the termination and work made for hire provisions of the 1976 Act as they relate to sound recordings. Axcess argued that, even if purely audio
works cannot be considered audiovisual works themselves, Michlin’s statement that “Axcess was to sell the jingles to radio and television station clients” shows that the jingles were “specially commissioned for use as…a part of a motion picture or other audiovisual work.”[85] The Fifth Circuit wrote that:

Michlin’s statement does not unambiguously indicate that each jingle that he wrote pursuant to the Jingle Writing Agreement would potentially be used both for television and radio advertising. One could read his statement as indicating that Axcess intended to commission some jingles for use in television advertisements and other jingles for use in radio advertisements. Because the summary judgment evidence does not indicate which of the first seven jingles were commissioned for use as part of a television advertisement, a radio advertisement, or both, a genuine issue of material fact exists as to whether any or all of these jingles were ‘specially ordered or commissioned for use…as a part of a motion picture or other audiovisual work,’ and thus whether they are works made for hire” [citations omitted].[86]

The necessary inference drawn from this paragraph is that sound recordings specially commissioned for use in television or other audiovisual works will be considered works made for hire if created under a written work-made-for-hire agreement. Otherwise, the issue of whether any particular jingle was commissioned by Axcess for use on radio, television, or both would not be a material issue of fact. The only question the Fifth Circuit did not answer was what standard should be used to determine if the jingles were “specially ordered or commissioned” for use in an audiovisual work. However, because the Fifth Circuit went on to hold that Axcess had an implied license to use the Lulirama jingles and did not exceed the scope of that license, the copyright infringement issue was resolved without requiring remand for further proceedings on which jingles were commissioned for use on the radio, television, or both. [87]

Notably, though, the Fifth Circuit did address the issue of when a work can be considered “specially ordered or commissioned for use…as a part of a motion picture or audiovisual work” in a dictum relegated to footnote 6 of the opinion:

Axcess insists that a particular jingle need not have been commissioned only for use in an audiovisual work in order to qualify for work for hire status. Assuming that this is true, it is
clear that, in order for a particular jingle to qualify as a work for hire, Axcess must have commissioned it at least in part for the purpose of making it a part of an audiovisual work. The summary judgment evidence in this case does not establish that at least part of the purpose for Axcess’s commissioning each of the first seven jingles was for use in television advertising. Accordingly, summary judgment in favor of Axcess as to its ownership of the copyrights to the first seven jingles was inappropriate.\[88\]

Although Lulirama was the first case to determine whether sound recordings can be considered works made for hire, this footnote remains the only guidance given by a federal court on when sound recordings can be considered “specially ordered or commissioned for use as…a part of a motion picture or other audiovisual work.” Yet, since the court was simply adopting Axcess’ legal argument for the purpose of showing that it was not material to the resolution of the case, this dictum gives little guidance on what legal standard the Fifth Circuit would have applied to determine whether a sound recording is “specially ordered or commissioned for use as…a part of a motion picture or audiovisual work” in a case in which the outcome is material.

3. Ballas v. Tedesco and Staggers v. Real Authentic Sound

Less than two years after the Lulirama opinion was issued, two district courts held that the sound recordings at issue before them did not fit into any of the nine statutory work made for hire categories.

In Ballas v. Tedesco, the plaintiff Corky Ballas (“Ballas”), a competitive ballroom dancer, entered into an agreement with defendant Genarro Tedesco (“Tedesco”), a music producer, to arrange, produce, mix, and master a CD containing music apparently based on the film “Titanic.”\[89\] After Ballas paid Tedesco a down payment, the parties had various disagreements and the relationship ended. Tedesco thereafter obtained a certificate of copyright registration in the sound recordings included on a CD entitled “Fire Vol. 1,” which included the sound recordings originally prepared for Ballas’ proposed “Titanic Passion” CD. Ballas sued in New Jersey court and obtained an order forcing Tedesco to return the master recordings and to
refrain from marketing any more CDs in exchange for the balance of the payment owed by
Ballas under the original agreement. However, the New Jersey court explicitly stated that it was
unable to determine ownership of any copyrights. [90]

Tedesco moved to remove the case to federal court and sought an order restraining Ballas
from marketing any CDs embodying the disputed sound recordings, claiming that he owned the
copyrights in the sound recordings. Ballas argued, alternatively, that he had rights in the
recordings because he was joint author and because they were works made for hire. [91] After
dismissing Ballas’ joint authorship argument, the court then dismissed Ballas’ work-made-for-
hire argument, holding that Tedesco was not Ballas’ employee and that “the sound recordings are
not a work for hire under [§ 101(2)] because they do not fit within any of the nine enumerated
categories, and because there was no signed written agreement between the parties.” [92] The
court did not offer any explanation of its holding that the recordings at issue did not meet any of
the nine statutory work-made-for-hire categories and did not cite to Lulirama. [93]

In Staggers v. Real Authentic Sound, the musician plaintiff Reginald Staggers
(“Staggers”) sued the record label defendant Real Authentic Sound (“RAS”) for copyright
infringement stemming from its sale of a CD containing eleven songs for which Staggers wrote,
arranged, and performed the music. [94] RAS had hired Harold McLarty (“McLarty”), a music
producer, to rerecord the music from an old album to be used with the original lyrics, and
McLarty hired Staggers to provide the new music. [95] RAS moved for summary judgment,
arguing in part that Staggers created the sound recordings as works made for hire. [96] The court
rejected this argument, stating that “[b]ecause a sound recording does not fit within any of the
nine categories of ‘specially ordered or commissioned’ works, whether it was made for hire
depends on whether Staggers was McLarty’s employee and prepared the sound recording within
the scope of that employment.” [97] For support, the court cited to Lulirama as “finding that
sound recordings are not included within any of the § 101(2) categories” and to *Ballas* as “noting that a sound recording does not fall within § 101(2).”[98]

Interestingly, the court did not limit its holding to the sound recordings at issue before it, but wrote that “a sound recording” does not fit into any of the nine categories of works made for hire,[99] apparently holding that no commissioned sound recordings can be considered works made for hire. It did not give any explanatory analysis for this apparently sweeping declaration and mischaracterized both *Lulirama* and *Ballas* for support.[100] Nevertheless, because *Staggers* does not provide any analysis for its holding that sound recordings do not fit any statutory work made for hire category and *Ballas* limited its language to apply to the specific sound recordings at issue before it, neither is likely to have great precedential value for future courts.

Thus, of the four cases that deal with whether and when sound recordings can be considered works made for hire, only *Greenwich* and *Lulirama* conclude that sound recordings can be considered works made for hire, and only to the extent they are specially commissioned for use in an audiovisual work under a written work-made-for-hire agreement. Yet *Lulirama* fails to give much guidance as to when a sound recording is “specially ordered or commissioned for use as...a part of a motion picture or other audiovisual work” and *Greenwich* gives none at all. Unfortunately, the cases determining whether other types of works commissioned used in audiovisual works can be works made for hire also fail to provide much guidance on when a work fits into this statutory work-made-for-hire category.

**B. Other Works Specially Commissioned for Use in Audiovisual Works**

Although the *Greenwich* and *Lulirama* courts concluded that commissioned sound recordings can be considered works made for hire when specially commissioned for use in audiovisual works, they give little guidance on what standard is applied to determine whether a
sound recording can be considered specially commissioned for use in an audiovisual work. Unfortunately, courts that have held other types of works to be works made for hire based on the fact that they were specially commissioned for use in an audiovisual work have also failed to give much guidance on what standard a work must meet in order to fall into this statutory work-made-for-hire category. In fact, although courts have held that audiovisual works, literary works, and musical compositions created by independent contractors can be considered works made for hire if they are specially-commissioned for use in an audiovisual work, only one of these courts included any language approaching a legal standard for determining when a work can be considered “specially ordered or commissioned for use as...a part of a motion picture or other audiovisual work.”

In Warren v. Fox Family Worldwide, Inc., the United States Court of Appeals for the Ninth Circuit held that musical compositions created by an independent contractor for use in a television program were works made for hire. The plaintiff in Warren, musician Richard Warren, entered into several agreements with Fox’s predecessor in interest (“Fox”) to compose musical works for the television program “Remington Steele.” Warren later brought copyright infringement, accounting, breach of fiduciary duty, and other claims against Fox and a host of other defendants, claiming that they had not paid him his proper share of royalties. Fox moved to dismiss Warren’s complaint for lack of standing because he was not the actual or beneficial owner of the copyright in the musical works created under the agreement, as they were works made for hire. Both the district court and the Ninth Circuit agreed with Fox.

The most contentious issue the court had to deal with was whether the agreements between Warren and Fox’s predecessor satisfied the “written work made for hire agreement signed by the parties” requirement. However, the court also briefly dealt with the compositions’
status as works “specially ordered or commissioned for use…as a part of a motion picture or audiovisual work.” The court wrote in a footnote:

Because the parties are not in an employer-employee relationship, the Copyright Act requires not only that the work be specially commissioned pursuant to a written agreement, but that the work come within one of the enumerated categories listed in 17 U.S.C. § 101(2)…There is no doubt that the works fall into one of these categories because it is undisputed that they are part of an audiovisual work. [citations omitted] [107]

Notably, the language used by the court does not suggest that Fox’s intent or purpose in commissioning the compositions was at all relevant to whether the compositions were “specially ordered or commissioned for use…as a part of a motion picture or audiovisual work.” Rather, the court implies that they can be considered a work made for hire simply “they are part of an audiovisual work.” [108]

If taken at face value, this language would mean that a work created under a written work made for hire agreement, but never intended to be used in an audiovisual work or any other statutory work made for hire category at the time it was commissioned, could become a work made for hire long after being commissioned simply by being included in an audiovisual work at some point in time after its creation. Yet, the court did not need, and probably did not intend, to make such a sweeping pronouncement reaching works never intended for use in audiovisual works because Warren’s contracts with Fox “clearly indicate that [his] composing was to be done for the sole purpose of the ‘Remington Steele’ program.” [109]

III. THE GUIDANCE, LACK OF GUIDANCE, AND MISGUIDANCE PROVIDED BY THE CASE LAW

The courts have consistently held that sound recordings and other works specially commissioned for use in audiovisual works can be considered works made for hire, despite the Ballas and Staggersholdings that sound recordings embodied in purely audio media do not fit
any of the statutory categories of works made for hire. These holdings are supported by the plain language, legislative history, and policy considerations of the 1976 Act. However, the case law has provided little guidance as to when a sound recording can be considered “specially ordered or commissioned” for such in an audiovisual work. What little guidance is given in Lulirama and Warren would lead to results that contradict the policy of the work-made-for-hire provision if applied as a legal standard.

A. Sound Recordings and Other Works “Specially Commissioned” for Use in Audiovisual Works can be Works Made for Hire

Despite the Staggers court’s statement that sound recordings do not fit any statutory work made for hire category, the Lulirama and Greenwich courts unambiguously concluded that independently contracted sound recordings can be considered works made for hire when they are “specially ordered or commissioned for use as...a part of a motion picture or other audiovisual work.” This conclusion is supported by the plain language, legislative history, and policy goals of the 1976 Copyright Act, as well as Warren and other cases holding that other types of independently contracted works can be considered works made for hire if they are specially commissioned for use in audiovisual works.

The Greenwich and Lulirama courts both concluded that independently contracted sound recordings can be considered works made for hire if they are specially commissioned for use in an audiovisual work.\textsuperscript{[110]} Similarly, the Warren court and other courts have held that other types of independently contracted works can be considered works made for hire if they are specially commissioned for use in an audiovisual work.\textsuperscript{[111]} Although the Staggers court broadly proclaimed that sound recordings do not fit any of the statutory work made for hire categories, the Greenwich and Lulirama conclusions are supported by the plain language of the work-made-for-hire provision of the 1976 Act.
Section 101(2) of the 1976 Act states that a work made for hire is “a work specially ordered or commissioned for use...as a part of a motion picture or other audiovisual work...if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.”

An audiovisual work is defined as “a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any...” Because the audio component of an audiovisual work is included in the definition of an audiovisual work, the recorded sounds “accompanying” the series of images that makes up an audiovisual work should be considered “a part of a motion picture or other audiovisual work” given any reasonable definition of the word “part.” Thus, under the plain language of § 101(2), sound recordings used in audiovisual works are eligible for work-made-for-hire status as long as they are “specially ordered for commissioned for” that particular use.

Nothing in the plain text of the work-made-for-hire provision suggests that types of works that are not listed independently as work-made-for-hire categories, such as sound recordings, cannot fall into other categories of works made for hire, such as works commissioned for use in audiovisual works. After all, if that were the case, neither screenplays nor the individual film frames of a motion picture could be considered works made for hire, because neither literary works nor pictorial, graphic, or sculptural works are listed as independent work-made-for-hire categories. In fact, such an interpretation would make it impossible for any commissioned copyrightable work to be considered a work made for hire on the basis that it was commissioned for use as “a part of a motion picture or other audiovisual work,” because all such works inevitably fall into a category of works not independently listed as a work-made-for-hire category. Thus, in addition to the other defects of the Staggers opinion, it should not be followed to the extent it apparently holds that a type of work that is not listed independently as a work made for hire category cannot fall into another, broader category of works made for hire.
Additionally, there is possible definitional argument that sound recordings should not be considered “a part” of an audiovisual work based on the Copyright Act’s definition of “sound recordings”. The Act defines “sound recordings” as “works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects such as disks, tapes, or other phonorecords, in which they are embodied.”[120] Because a “sound recording” does not include “sounds accompanying a motion picture or other audiovisual work,” this definition raises a question as to whether a sound recording can be considered “a part” of an audiovisual work for section 101(2) purposes. However, as mentioned above, the Act states that an “audiovisual work” consists of a series of related images and the sounds accompanying those images, [121] so the sounds accompanying an audiovisual work would appear to be “a part” of that work.

This potential conflict can be avoided by interpreting these two definitions to mean that, when a series of sounds is fixed in a tangible medium without an accompanying series of images, the work constituted by the sounds alone is a “sound recording” and is subject to a “sound recording” copyright. However, when sounds are fixed in a medium containing both sounds and images, such a DVD, that work consisting of images and sounds is an audiovisual work, and the sounds as embodied in that work are “a part” of the audiovisual work.

This would mean that the orchestral performance of a film score originally recorded on 2” reel-to-reel audiotape would constitute a “sound recording” protected by a sound recording copyright. [122] Later, when those same sounds are added to the film for which they were intended, they become “a part” of that film, which is protected by the film’s own distinct copyright as an audiovisual work. [123] This scenario results in two distinct copyrights, one for the “sound recording” apart from any images and one for the “audiovisual work” containing images and sounds, [124] and harmonizes the Copyright Act’s “sound recording” and “audiovisual
work” definitions without the need to contravene the plain language of the work-made-for-hire provision. [125]

Furthermore, the legislative history and policy decisions behind the work-made-for-hire provision support an interpretation that sound recordings can be works made for hire when they are specially commissioned for use in audiovisual works. As Mary LaFrance writes, “Congress spent nearly fifteen years negotiating, drafting, and revising the language in the work-made-for-hire definition. Much of this deliberation focused on which categories of specially commissioned copyrightable works should be eligible for contractually-created work-made-for-hire status.” [126] Although the Copyright Act wasn’t enacted until 1976, contributions to motion pictures were one of four statutory work-made-for-hire categories included in drafts as early as 1965. [127] As the Supreme Court wrote in Reid, Congress selected these categories of works “because they concluded that these commissioned works, although not prepared by employees and thus not covered by the first subsection, nevertheless should be treated as works for hire because they were ordinarily prepared ‘at the instance, direction, and risk of a publisher or producer.’” [128]

The fact that contributions to motion pictures were included so early on as a work-made-for-hire category reflects Congress’ judgment that motion pictures and audiovisual works fit squarely in the middle of the spectrum of works intended to be covered by the work-made-for-hire provision. Certainly, the policy motivations cited by the Supreme Court in Reid are no less powerful for sound recordings commissioned for use in a motion picture than they are for a screenplay or sculpture commissioned for the same purpose. Indeed, film scores are often composed “at the instance direction, and risk” of a film production studio or its representatives. [129] Thus, any interpretation of § 101(2) that would not allow independently contracted sound recordings to be considered works made for hire when they are specially
commissioned for use in an audiovisual work would eat away at a core category of works intended to be covered by the work-made-for-hire provision.

B. Courts Have Given Little Guidance on When a Work Can be Considered “Specially Commissioned” for Use in an Audiovisual Work

Although the cases make clear that sound recordings and other independently contracted works can be considered works made for hire if they are specially commissioned for use in an audiovisual work, due to their procedural and factual nature, they give little guidance on when such works can be considered “specially ordered or commissioned” for use in an audiovisual work. Yet, as it becomes easier, cheaper, and more common for sound recordings to be used in audiovisual works, it will become increasingly necessary to develop a standard for determining if the sound recordings are “specially ordered or commissioned” for such use, and can be considered works made for hire on this basis.

In many of the relevant cases, there was never any dispute as to whether the works in question were “specially ordered or commissioned” for use in an audiovisual work, so there was no analysis needed and no legal standard set forth to determine the issue. In Greenwich, the court stated as fact that the works were commissioned for use in a film soundtrack[^130] and stated as a legal conclusion that this made them eligible to be considered works made for hire.[^131] Similarly, in TMTV, the court stated as fact that the literary works in question were commissioned for use as television scripts,[^132] and stated as a legal conclusion that this made them eligible to be considered works made for hire.[^133] In Warren, the contracts under which the disputed musical compositions were created “clearly indicate that such composing was to be done for the sole purpose of the ‘Remington Steele’ [television] program.”[^134] Not surprisingly, the court held that such works could be considered works made for hire.[^135]
In *Lulirama*, the court did held that a disputed issue of fact existed as to which of the sound recordings in question were “specially ordered or commissioned” for use in an audiovisual work.\[136\] However, the court went on to hold that, regardless of whether the alleged infringer owned copyright in the disputed recordings as works made for hire, the alleged infringer at the very least had an implied license to use the copyrighted sound recordings and had not violated the scope of this license, thus settling the copyright infringement issue.\[137\] Therefore, the court did not need to remand to the district court for further proceedings on the issue of which songs were “specially ordered or commissioned” for use in an audiovisual work and had no reason to set forth a legal standard for the district court to use in making that determination.\[138\]

Because the courts have not needed to provide a specific legal standard for determining when a sound recording can be considered “specially ordered or commissioned” for use in an audiovisual work, it is unclear when commissioned sound recordings that are used in multiple works, including in an audiovisual work, are eligible to be considered works made for hire. This lack of guidance could become problematic in a digital world in which it is easy to take professional sound recordings created at an expense of many thousands of dollars and edit them into the soundtrack of a cheaply created audiovisual work in less time than it takes to read this article (which isn’t *too* long, right?).


Though the case law does not provide much guidance, both *Lulirama* and *Warren* briefly touch on the issue of when a sound recording or musical composition can be considered “specially ordered or commissioned” for use in an audiovisual work. However, while the *Lulirama* court entertained an “at least in part” standard and the *Warren* court appeared to endorse a mere “use” standard, both standards would contravene
the policy behind specifically enumerated categories of commissioned works made for hire. Fortunately, the standards entertained in *Lulirama* and *Warren* are not binding precedent as they were not part of the holding of either case.

1. **Lulirama’s “At Least in Part” Standard**

   As mentioned above, the *Lulirama* court did not set forth a standard for determining when a sound recording is “specially ordered or commissioned” for use in an audiovisual work, but it did briefly entertain in a footnote the appellant’s argument that the recordings at issue could be considered works made for hire if they were commissioned “at least in part” for use in an audiovisual work.\(^{139}\) Such a standard would not have made a difference if applied in *Lulirama* because the summary judgment evidence did not clarify which of the recordings in question were commissioned “at least in part” for radio, television, or both.\(^{140}\) However, if adopted universally, this “at least in part” standard would undermine the policy behind specifically delineated categories in the work made for hire provision.

   If any sound recording that is commissioned “at least in part” for use in an audiovisual work can be considered a work made for hire, then savvy commissioning parties will be able to turn any commissioned work into a work made for hire simply by incorporating the work into a cheaply made audiovisual work, regardless of the commissioning party’s primary intent for commissioning the work and regardless of whether or not the work falls into any other statutory work made for hire category. For example, if Hypothetical Records commissions a recording artist to create a set of professional sound recordings for the purpose of selling the recordings on phonorecords,\(^{141}\) these sound recordings could not independently be considered works made for hire under *Ballas* and *Staggers*.\(^{142}\) But if Hypothetical Records buys a $300 camcorder, shoots a home video of the music producer’s pet fish, then incorporates the every sound recording in ever commissions as the soundtrack to the fish video, then those
commissioned sound recordings would be commissioned “at least in part” for use in an audiovisual work.

This same scenario could be played out for any type of copyrightable work, regardless of whether the work would otherwise fit into a statutory work made for hire category. Parties commissioning a sculpture could make it a work made for hire by videotaping the sculpture. Parties commissioning software code could make the code a work made for hire by videotaping the printed code. This “at least in part” standard would effectively give commissioning parties the ability circumvent the nine specifically delineated categories of works made for hire. As long as the commissioning party intends to include the commissioned work in a cheap home video, in addition to whatever use for which the work is primarily commissioned, then the work would be commissioned “at least in part” for use in an audiovisual work and could be considered a work made for hire.

Fortunately, the “at least in part” standard is not part of the holding of Lulirama. The court merely stated that one of the parties had proposed an “at least in part” standard and that, regardless of whether this standard were correct, the court could not rule on the work-made-for-hire issue because of disputed factual questions. Furthermore, the court did not need to resolve the work-made-for-hire issue to resolve the copyright infringement question because the court held that Axcess had an implied license to use the recordings and did not exceed the scope of that license, regardless of who owned the disputed recordings.

2. Warren’s Mere Use Standard

The standard briefly entertained by the Warren court threatens the integrity of the work-made-for-hire provision even more seriously than the “at least in part” standard proposed in Lulirama. In determining whether the musical compositions before it could be considered works made for hire, the Warren court stated that “[t]here is no doubt that the works fall into one
of [work-made-for-hire] categories because it is undisputed that they are part of an audiovisual work.

This statement suggests that mere use in an audiovisual work is enough for a commissioned work to be considered a work made for hire, regardless of whether the commissioning party intended to use the work in an audiovisual work when it was commissioned. Yet, if applied, this standard would produce absurd results.

Consider the set of sound recordings commissioned by Hypothetical Records for the purpose of selling phonorecords of the recordings. Suppose that, just as before, the music producer uses them as background music in some home movies of his pet fish. But this time he doesn’t do so until twenty years after the recordings are created. Under Warren’s language, the artist that created the recordings would be considered the “author” of the works for the first twenty years, because the recordings would not fit a statutory work-made-for-hire category during that time period, but incorporating the sound recordings in home movies twenty years after their fixation could actually change the legal author of the works from the recording artist to the commissioning party simply because they would become “part of an audiovisual work” at that time.

Fortunately, disregarding the apparent meaning of the language used in Warren would not require any court to overrule or disregard Warren. First of all, the suggestion that a work can become a work made for hire simply by being used in an audiovisual work is not part of the main text of the opinion, but tucked away in a footnote. Second, it is an overly broad statement that was not necessary to resolve the issue before the court, and thus could be construed as dicta. As pointed out by the court, the contracts under which Warren prepared the disputed musical compositions clearly stated that the works were to be used solely for the “Remington Steele” television program. Thus, it is clear that the works at issue were commissioned for use as a part of an audiovisual work, and the court did not need to address whether mere after-the-fact use in an audiovisual work, independent of a specific purpose to use the musical
compositions in an audiovisual work at the time of commissioning, was sufficient to make the compositions works made for hire.

When future courts face the problem of determining whether a sound recording or other work was “specially ordered or commissioned for use as...a part of a motion picture or audiovisual work,” they should eschew the standards entertained in Lulirama and Warren. Application of these standards would undermine the structure of the work-made-for-hire provision by allowing commissioning parties to circumvent the specifically delineated categories of works made for hire simply by intending to create a cheap, ancillary audiovisual work. Furthermore, no court, whether in the Fifth or Ninth Circuits or not, should feel the need to follow the standards presented in Lulirama and Warren because they were not part of those courts’ holdings and went beyond the scope of what was needed to resolve those cases. However, more importantly, a reading of the plain language of the work-made-for-hire provision reveals that the standards entertained in Lulirama and Warren fail to follow the text of the provision because they do not require that “use as...a part of a motion picture or other audiovisual work” be at least the primary purpose for which the work is commissioned.

IV. SOUND RECORDINGS SHOULD ONLY BE CONSIDERED “SPECIALY COMMISSIONED” FOR USE IN AN AUDIOVISUAL WORK IF SUCH USE IS THE PRIMARY INTENDED PURPOSE

The plain language as well as the policy behind the work-made-for-hire provision require that sound recordings only be considered “specially ordered or commissioned” for use in an audiovisual work only if such use is the primary intended purpose for commissioning the recordings. Because the language of the Copyright Act states that an independently contracted work must be “specially” commissioned for use in one of the nine categories to be considered a work made for hire, commissioned sound recordings cannot be considered works made for hire on the incorporation of the recordings into an audiovisual work was a secondary, tertiary, or even
co-equal purpose for commissioning the recording. Furthermore, a “primary purpose” standard provides the best way to protect the integrity of the work made for hire categories as laid out in the Copyright Act without allowing commissioning parties to use audiovisual works as a gimmick to turn all commissioned works into works made for hire.

A. The Plain Language of the Work Made for Hire Provision

The starting point for interpreting the meaning of the Copyright Act is the language employed therein. Breaking down the plain language of the work-made-for-hire provision shows that the primary purpose for commissioning an independently contracted work made for hire must be to use the work in one of the nine statutory categories. First and foremost, a work must be “ordered or commissioned.” The Supreme Court has held that only works created by independent contractors fit into this language. This also means that any work created before the commissioning party orders its creation cannot be considered a work made for hire.

Second, an independently contracted work must not only be “ordered or commissioned,” but must be “ordered or commissioned for use” that fits at least one of the nine statutory work-made-for-hire categories. This elevates the purpose for which the work is commissioned to a necessary element in establishing work-made-for-hire status for commissioned works. The Ninth Circuit’s statement in Warren that musical compositions could be works made for hire “because…they are part of an audiovisual work” fails to recognize that mere inclusion in an audiovisual work is not sufficient to obtain work-made-for-hire status under the plain language of the Copyright Act if the work was not commissioned for such a purpose. Independently contracted works cannot simply be part of an audiovisual work to be considered works made for hire; they must be commissioned for the purpose of being used in an audiovisual work.

Yet, if the work-made-for-hire provision required only that a work be commissioned for use in at least one of the nine statutory categories, it would still leave commissioning parties
ample wiggle room to undermine the integrity of the work-made-for-hire provision. Consider the scenarios mentioned above in which Hypothetical Records commissions a set of sound recordings for the primary purpose of selling phonorecords of the recordings, but also intends to create a cheap, ancillary home video incorporating the recordings. Certainly, the Hypothetical Records is commissioning the works “for use...as a part of a motion picture or other audiovisual work,” even if this use is only an ancillary purpose for commissioning the works. The fact that the primary purpose for commissioning the recordings is for a use that does not fit a statutory work-made-for-hire category does not negate the fact that the recordings are also commissioned for a purpose that does fit a work-made-for-hire category.

However, the work-made-for-hire provision does not merely require that a work be “ordered or commissioned for use” that fits one of the nine categories; it requires that work be “specially ordered or commissioned” for such a use. It is a well-established canon of statutory construction that all language included in a statute should be given effect where possible and not treated as mere surplusage. In this case, it is not only possible to give effect to the requirement that sound recordings and other works be “specially” commissioned for particular purpose, it is necessary to protect the integrity of the work-made-for-hire provision.

In determining the meaning of statutory language, words should be given their common definitions unless otherwise defined in the statute. Neither “special” nor “specially” are defined in the Copyright Act. Among the many common definitions of the term “special” are (1) “primary,” (2) “readily distinguishable from others of the same category,” (3) “made for a particular purpose,” and (4) “confined to a definite field of action.” Distilling these possible definitions results in two possible standards for determining when a sound recording or other work is “specially ordered or commissioned” for use in an audiovisual work. First, a sound recording can be specially commissioned for use in an audiovisual work when such use is the “primary” purpose for commissioning the recording. This
obviously comports with the “primary” definition of the word “special.” Also, when using the sound recording in an audiovisual work is the primary purpose for commissioning the recording, this purpose is “readily distinguishable” and distinct from any other ancillary purpose.

On the other hand, courts could determine that a work can only be considered “specially ordered or commissioned” for use in an audiovisual work if such use is the “sole purpose” for commissioning the work. Such a standard would comport with the definitions of “special” that treat it as a synonym for “unique.” After all, if a work is commissioned primarily for use in an audiovisual work, but the commissioning party also intends to use it in various other works that do not fit any work-made-for-hire category, then the work is not “made for a particular purpose” nor “confined to a definite field of action,” but made for multiple purposes and several fields of action.

Notably, no common definition “specially ordered or commissioned” for use in an audiovisual work would cover a sound recording on the basis that it was commissioned “at least in part” for use in an audiovisual work. In the case of Hypothetical Records, the ancillary intent to use the commissioned sound recordings in a home video is not “primary,” is not “readily distinguishable,” is not the “particular purpose” for which the recordings are commissioned, nor the home video a “definite field of action” to which use of the recordings is “confined.” Thus, in addition to undermining the integrity of the work made for hire provision, the “at least in part” standard entertained in Lulirama fails to follow the plain language of the work made for hire provision.

B. The Policy and Application of the Work Made for Hire Provision Requires a “Primary Purpose” Test Over the “Sole Purpose” Test

Although the plain language of the work-made-for-hire provision would support a “primary purpose” standard or a more strict “sole purpose” standard for determining when a
work is “specially ordered or commissioned” for use in an audiovisual work, only the “primary purpose” standard can effectively carry out the goals of the work-made-for-hire provision. While both the “primary purpose” and “sole purpose” standard would prevent commissioning parties from undermining the structure of the work-made-for-hire provision through incorporation of commissioned works into cheap, ancillary audiovisual works, only the “primary purpose” standard could do so while still reliably allowing works that fall within the core of the “part of a motion picture or other audiovisual work” category to be considered works made for hire.

1. The “Sole Purpose” Standard

As noted above, one reading of the Copyright Act’s requirement that independently contracted sound recordings be “specially ordered or commissioned for use as…a part of a motion picture or other audiovisual work” to be considered works made for hire is that such recordings must be commissioned for the sole purpose of being used in an audiovisual work. This is based on those definitions of the word “special” that treat it as a synonym to the word “unique.” Applying such a “sole purpose” standard would prevent commissioning parties from obtaining work-made-for-hire status for any type of commissioned work through inclusion in a cheap, ancillary audiovisual work. However, such a strict standard would prevent nearly all works that are commissioned for use in an audiovisual work from being considered works made for hire because it is exceedingly rare for such works to be used solely in audiovisual works.

Because Congress spent several years negotiating which categories of independently contracted works should be eligible for work made for hire status and settled on nine distinctly delineated categories of works, it is clear that Congress did not intend all types of works to be eligible for work-made-for-hire status. This follows the *expressio unius est exclusio alterius* canon of statutory construction. However, as mentioned above, if an ancillary or co-equal intent to use a commissioned work in an audiovisual work were enough to
make the work eligible for work-made-for-hire status, commissioning parties could undermine Congress’ intent by making not only sound recordings, but any type of work a “work made for hire” simply by intending to incorporate the commissioned work into a cheap, ancillary audiovisual work. Clearly, requiring that a work be commissioned for the “sole purpose” of using the commissioned work as “a part of a motion picture or other audiovisual work” would eliminate this threat. However, it would also make it nearly impossible for any work to fit the “part of a motion picture or other audiovisual work” category because such works are inevitably used outside the scope of an audiovisual work.

For example, both “audiovisual works” and “motion pictures” are groupings of still images shown in succession. Individual still images from feature films and television programs are often used in posters and other advertisements for the audiovisual works from which they are taken. Under a “sole purpose” standard, the individual frames of a film could not be considered works made for hire if the commissioning studio or filmmaker intends to use the still frames from the audiovisual work in advertising, merchandising, or any other use outside the scope of an audiovisual work.

In the case of sound recordings, neither motion picture nor television soundtracks could be considered “specially commissioned for use as...a part of a motion picture or other audiovisual work” under a “sole purpose” standard if they are released for sale on phonorecords. Because the practice of releasing recordings of film scores and soundtracks for sale on CDs, digital downloads, and other audio-only media is a standard practice for commercial films, hardly any sound recording commissioned for use in an audiovisual work could be considered a work made for hire under a “sole purpose” standard.

In fact, it is questionable whether any work commissioned for use in an audiovisual work could be commissioned for that “sole purpose,” as the work will inevitably exist in a form outside the scope of an audiovisual work. A screenplay will exist in its purely
textual form as a literary work aside from its incorporation into an audiovisual work. Each individual film frame will at some point exist outside its place in a series of images as an independent pictorial or graphic work. A sound recording used in an audiovisual work will at some point exist on audio-only media. In this sense, it may be impossible for any work to be commissioned for the “sole purpose” of being used as “a part of a motion picture or other audiovisual work.”

Thus, the “sole purpose” standard would protect the integrity of the work made for hire provision as a whole by preventing commissioning parties from turning any work into a work made for hire through inclusion in a cheap, ancillary audiovisual work. However, it would only do so at the cost of constricting the “part of a motion picture or other audiovisual work” category so narrowly that it would become irrelevant to all or nearly all works that are commissioned for use in an audiovisual work.

2. The “Primary Purpose” Standard

On the other hand, the “primary purpose” standard would protect the policy behind distinctly delineated work-made-for-hire categories while maintaining the viability of the “part of a motion picture or other audiovisual work” category. Just like the “sole purpose” standard, commissioned sound recordings and that are incorporated into an ancillary audiovisual works solely as an attempt to squeeze the recordings into a statutory work-made-for-category would not be considered works-made-for-hire under a “primary purpose” standard, because using the work in an ancillary audiovisual work would not be the commissioning party’s primary purpose for commissioning the work. Indeed, commissioned sound recordings that are incorporated into audiovisual works for legitimate ancillary purposes, such as advertising the sound recording or the recording artist, would not be considered works made for hire under the primary purpose standard. Yet, the primary purpose standard would maintain the viability of the
“part of a motion picture or other audiovisual work” category for sound recordings and other works that fall within the core of the category.

To return to the example used above, if Hypothetical Records commissions a set of sound recordings at an expense of $50,000 for the primary purpose of selling the recordings on phonorecords, it could not obtain work-made-for-hire status for the recordings simply by incorporating the recordings into a home movie of the music producer’s pet fish. In such a scenario, the primary purpose for investing $50,000 in the recordings would be to realize a profit through CD sales and downloads, not to use the recordings as the soundtrack to a home movie.

Approaching a more common scenario, Hypothetical Records may commission a recording artist to create a set of sound recordings to for the primary purpose of selling phonorecords of the recording, but may also intend to incorporate one or more of the recordings into a music video. Suppose that, after spending $50,000 in the production of the recordings, Hypothetical Records hires Spike Jonze to direct a video of the music producer’s pet fish with one of the commissioned sound recordings as the soundtrack. The video subsequently enters regular television rotation on MTV and VH1 and becomes so popular that Hypothetical Records actually releases the video on DVD and realizes a profit from the DVD sales.

In this scenario, it is still extremely unlikely that the sound recording used in the music video could be considered “specially ordered or commissioned” for use in an audiovisual work under the “primary purpose” standard. First, most recording contracts contain a provision that the record label is not obligated to produce any music videos incorporating the recordings produced thereunder. Second, in the absence of such a contractual clause, the primary purpose for producing any particular sound recording could not be to incorporate the recording in a music video if the decision of which recording to use in the music video is not made until after all the recordings are completed. Third, even if Hypothetical Records knows it will produce a music video for one particular recording, such a purpose would probably be ancillary to the
purpose of selling the recording on phonorecords, and would be at most a co-equal purpose. Thus, it would be quite unlikely that commissioned sound recordings could be considered works made for hire under a primary purpose standard simply through incorporation in a music video. In this sense, the primary purpose standard maintains the policy behind distinctly delineated work-made-for-hire categories by eliminating ancillary or co-equal intent as a basis for conferring work-made-for-hire status on any type of commissioned work.

On the other hand, many sound recordings and other commissioned works used in audiovisual works will be eligible to be considered works made for hire under the “primary purpose” standard. For example, if Hypothetical Pictures were to approach Hypothetical Records for the purpose of producing the theme song for the next Hypothetical film, the resulting sound recording could be considered a work made for hire. First of all, the parties would likely include a contractual provision stating that the commissioned sound recordings are commissioned for use in a motion picture. Regardless of whether such a contractual provision exists, as a factual matter, the primary purpose for commissioning the sound recordings would be to use them as part of a motion picture. Even if Hypothetical Motion Pictures intends to sell phonorecords of the film soundtrack, thus making such use an additional purpose for commissioning the sound recordings, this would not negate the fact that the primary purpose for commissioning the recordings would be to use them “as a part of a motion picture or other audiovisual work.” Thus, where the “sole purpose” standard would not allow most film or television soundtracks to be considered works made for hire, the “primary purpose” standard would.

This analysis holds true for other works commissioned primarily for use in motion pictures and other audiovisual works. While Hypothetical Pictures may intend to use individual film frames in promotional materials for the motion picture for which the frames are produced, the primary purpose for creating the film frames would be to use them as part of a motion
picture. Thus, the individual “stills” could be considered works made for hire. Hypothetical Pictures may also intend to sell print copies of the screenplay it commissions, but the primary purpose for commissioning the screenplay would be to incorporate it as part of a motion picture. Thus, the screenplay could still be considered a work made for hire.

Thus, the “primary purpose” standard for determining whether a work is “specially ordered or commissioned for use as…a part of a motion picture or other audiovisual work” allows sound recordings and other works that fall within the core meaning of this category to be considered works made for hire, whereas the “sole purpose” would prevent nearly all such works from being considered works made for hire. While both standards may fit within the plain text of the work made for hire provision, only the “primary purpose” standard can maintain the policy behind distinctly delineated work-made-for-hire categories without narrowing these categories to the point of irrelevance.

Conclusion

As the case law and the plain language of the work made for hire provision show, sound recordings that are specially commissioned for use in audiovisual works can be considered works made for hire if they are created under a written and signed work made for hire agreement. However, the little guidance the case law has given to date on when a sound recording can be considered “specially ordered or commissioned for use as…a part of a motion picture or other audiovisual work” has not conformed with the plain language or the policy of the work-made-for-hire provision. In order to follow the plain language of the work made for hire provision and protect its policy goals, courts should only consider sound recordings “specially ordered or commissioned for use as…a part of a motion picture or other audiovisual work” when the sound recordings are commissioned for the primary purpose of being used as part of an audiovisual work. Such a standard would allow sound recordings that fall at the core of the work-made-for-hire provision to be considered works made for hire, but would prevent
commissioning parties from undermining the specific work-made-for-hire categories by incorporating sound recordings into cheap, ancillary audiovisual works.


[3] Id.


[5] Id.


[24] Id.


[34] Id.

[35] See id.


[37] Mr. Glazier later secured employment as a lobbyist for the Recording Industry Association of America. *Id.*

[38] Id.

[39] Id.

[40] Id.
See Okamoto, supra, note 17 at 793.

See 17 U.S.C. § 101; See also Strand, supra, note 7 at 12.


See Reid, 490 U.S. 740.

See e.g. Okamoto, supra, note 17 at 801; Frisch & Fortnow, supra, note 7 at 221.

See RONALD FARBER, NEGOTIATING CONTRACTS IN THE ENTERTAINMENT INDUSTRY, form 160-1, para. 9.01 (“Each Master made under this agreement or during its term…will be considered a “work made for hire” for XYZ [the record company]; if any such Master is determine not to be such a “work,” it will be deemed transferred to XYZ by this agreement, together with all rights and title in and to it.”)

See id.


Assuming, of course, that the contracts under which the recordings were created contained a typical assignment clause.


Id. at *2.

128 F.3d at 878-79.

41 F. Supp. 2d 531.

77 F. Supp. 2d 57.

See e.g. Field, supra, note 14 at 174-75; Dunst, supra, note 17 at 23-24; Okamoto, supra, note 17 at 802-811.

See e.g. Rafoth, supra, note 20 at 1041-42; Frisch & Fortnow, supra, note 7 at 223.

In fact, the author has not read any scholarly articles that cite Greenwich Film and only came across it after conducting a particularly oddly-worded Westlaw search. This may be due to the fact that the opinion never uses the words “sound recording,” instead choosing to call the sound recording at issue the “soundtrack” and referring to the underlying musical composition and the sound recording together as “the work.” See 1992 WL 279357, at *2 n.1.

Id. at *1.

Id. at * 1-2.

Id. at *2-3.
[64] Id. at *2.

[65] Id.

[66] Id. at *3.

[67] 128 F.3d at 874-76.

[68] Id. at 874.

[69] Id.

[70] Id. at 874-75.

[71] Id. at 875.

[72] Id.

[73] Id.

[74] Id.

[75] Id. at 875-76.

[76] Id. at 876.

[77] Id. at 876-79.

[78] Id. at 877.

[79] Id. at 877; see also 17 U.S.C. § 101.

[80] 128 F.3d at 877.

[81] Id. at 877-78 (citing Reid, 490 U.S. at 748; 17 U.S.C. § 101).


[83] 128 F.3d at 878.

[84] Id.

[85] 128 F.3d at 878 (emphasis added).

[86] Id. at 878-79.

[87] Id. at 879-84.

[88] Id. at 879 n. 6 (emphasis in original).

[89] 41 F. Supp. 2d 531, 533-34 (1999). For some reason, the Ballas opinion repeatedly refers to the film as “Titantic,” rather than “Titanic,” and to the title of the proposed CD as “Titantic Passion.” For the purposes of this
article, the author assumes the music was actually intended to be based on the film “Titanic,” not some other unfortunately-titled film.

[90] Id. at 534-35.
[91] Id. at 535-539.
[92] Id. at 541.
[93] Id.
[95] Id.
[96] Id. at 62-63.
[97] Id. at 64.
[98] Id.
[99] Id.

[100] The Staggers court described Lulirama as “finding that sound recordings are not included within any of the § 101(2) categories.” Id. However, Lulirama actually held that sound recordings can fit into one of the nine statutory work made for hire categories. 128 F.3d at 878-79; see also supra Part II.A.1. The Staggers court also described Ballas as “noting that a sound recording does not fall within § 101(2),” 77 F. Supp. 2d at 64, but Ballas limited its holding to the specific sound recordings at issue before it, 41 F. Supp. 2d at 541.

[103] Greenwich, supra, n. 18; Warren v. Fox Family Worldwide, Inc., 328 F.3d 1136 (9th Cir. 2003).
[104] 328 F.3d at 1138.
[105] Id.
[106] Id. at 1139.
[107] Id. at 1140 n. 4.
[108] Id. (emphasis added).
[109] Id. at 1142.
[110] See supra, Part II.A.
328 F.3d at 1140 (musical composition commissioned for use in television program); TMTV, Corp. v. Mass Prods., Inc., 395 F.Supp.2d 196, 206 (D.P.R. 2004) (literary work commissioned for use as television script).


Id. at § 101 (emphasis added).

Include a definition of “part” in this footnote.


See supra Part II.A.3.


Id.


LaFrance, supra, note 14 at 384.

Id.

490 U.S. at 746 (citing S. 1006, H.R. 4347, H.R. 5680, H.R. 6835, 89th Cong., 1st Sess. § 101 (1965)).


Id. at *2.


Id. at 206.

328 F.3d 1136, 1142 (9th Cir. 2003).
Interestingly, though, the court did not explicitly reach this conclusion on the grounds that the works were created “for the sole purpose of” being used in an audiovisual work, but simply because they were part of an audiovisual work. \textit{Id.} at 1140 n.4; \textit{see infra}, Part III.C.

\[136\] 128 F.3d 874, 878-79 (5th Cir. 1997).

\[137\] \textit{Id.} at 879-83.

\[138\] \textit{See generally id.}

\[139\] \textit{Id.} at 879 n.6.

\[140\] \textit{Id.}

\[141\] The Copyright Act defines “phonorecords” as “material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” 17 U.S.C. § 101.

\[142\] \textit{See} 41 F. Supp. 2d 531, 541 (D.N.J. 1999); \textit{see also} 77 F. Supp. 2d 57, 64 (D.D.C. 1999).

\[143\] 328 f.3d 1136, 1140 n.4 (9th Cir. 2003) (emphasis added).

\[144\] \textit{Id.}

\[145\] \textit{Id.} at 1142.


\[147\] 17 U.S.C. § 101(2).

\[148\] \textit{Reid}, 490 U.S. 730.

\[149\] 17 U.S.C. § 101(2) (emphasis added).

\[150\] \textit{See} Landgraf v. USI Film Prods., 511 U.S. 244, 294-95 (1994).


\[152\] \textit{See generally} 17 U.S.C. 101.


\[154\] Merriam-Webster’s Collegiate dictionary, 1197 (11th ed. 2003) [hereinafter Merriam-Webster’s]; \textit{see also} Encarta (“distinct, different, unusual, or superior in comparison to others of the same kind”); www.dictionary.com (“distinct among others of a kind”); The Random House Dictionary of the English Language Unabridged, 1831 (2d. ed. 1987) [hereinafter Random House] (“distinguished or different from what is ordinary or usual”).

\[155\] Encarta; \textit{see also} www.dictionary.com (“arranged for a particular occasion or purpose”); Webster’s Third New International Dictionary Unabridged, 2186 (1993) [hereinafter Third New International] (“designed or selected for a

[156] Third New International; see also www.dictionary.com (“having a limited or specific function, application, or scope”); Random House (“pertaining or peculiar to a particular person, thing, instance, etc.”).


[161] The author will refrain from hypothesizing whether Hypothetical Records had to invest any money to obtain such exposure.


[163] Perhaps such cooperation could be part of the settlement of the parties’ inevitable trademark infringement suit.