APPLYING THE DOCTRINE OF WORK FOR HIRE AND JOINT WORKS TO WEBSITE DEVELOPMENT

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This Comment explores how copyrights, specifically the work-for-hire doctrine and joint works, have been modified to fit Internet webpages and websites. Beginning with an overview of the basic technology of webpages, this Comment then outlines the seminal work-for-hire and joint works cases. It then evaluates current cases dealing with copyright in this new form of media, using State v. Kirby, *a New Mexico Supreme Court case decided in the summer of 2007, as a focal point. Finally, this Comment attempts to outline methods that individuals or attorneys can use to protect themselves when dealing with the work-for-hire doctrine and whether a webpage or website should be considered a joint work.*

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INTRODUCTION

Terminology such as "webpage," "domain name," and "the Internet" used to be part of a language reserved for only those that were computer savvy. Eight years into the twenty-first century, the technology these words describe has permeated our everyday lives. As the Internet expands, copyright protection for the content and designs placed on the "information superhighway" become increasingly necessary.

Under § 201(a) of the Copyright Act, an author of a piece of work is also the initial copyright owner.[1] However, the statute also authorizes the shifting of the initial vesting of copyright ownership to an employer or commissioner of the work upon creation.[2] This exception to § 201(a) is known as the work for hire doctrine.[3]

The work for hire doctrine is a flexible standard that has been thoroughly litigated in a myriad of different fields.[4] Nevertheless, because the Internet is arguably an infant in comparison to the other forms of information media, parameters of the work for hire doctrine in this area are barely defined.

This Comment will explore the copyright issues that the web

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[1] 17 U.S.C.A. § 201(a) (West 2005).

[2] 17 U.S.C.A. § 201(a); 17 U.S.C.A § 201(b) (West 2005).

[3] 17 U.S.C.A. § 201(b).

[4] *See, e.g.*, Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730 (1989); Aymes v. Bonelli, 980 F.2d 857 (2d Cir. 1992); Weinstein v. Univ. of Ill., 811 F.2d 1091 (7th Cir. 1987).

development industry is facing. Specifically, the history and current flux of the work for hire and joint works doctrines will be discussed. This Comment will show how websites can fit under the work for hire doctrine due to the doctrine's flexible nature and why it should also be able to satisfy the joint work doctrine. Furthermore, this Comment posits that a distinction between websites and webpages is needed, since simplifying these two separate entities into one could give rise to unreasonable results in copyright ownership. Before tackling the legal issues, Part I will give background information on the technological aspect of websites. Part II will introduce the federal statutory basis for work for hire, while Part III will examine the history and case decisions establishing the work for hire standard. Parts IV and V will discuss the problems involved with copyrighting websites and whether websites can fit under the work for hire doctrine. Part Vi will give advice on how to deal with the current view of work for hire, and Part VII analyzes if, and under what circumstances a website can be a joint work.

I.   A BRIEF EXPLANATION ON THE TECHNOLOGY OF WEBSITES

Generally, a website is comprised of three main components: a webaddress, webpages and a computer, more specifically, a service provider or host.[5] A webaddress, also known as a domain name, allows others who are "online" to locate a website by typing the address into a browser. Webaddresses can come in the form of the direct address of a computer or a registered domain name, an alias that

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[5]   S. IGNACIMUTHU, S.J., BASIC BIOINFORMATICS 17 (2004).

points to a computer's address. A domain name has significant advantages as it provides a memorable, user friendly way of locating a website.[6]

A webpage is computer code used to display content on a website that requires interpretation by a browser. When a browser is directed to an address, the initial webpage, also known as the homepage, is displayed on the user's browser. From the homepage, a user can click on "links," or manipulate the webaddress, to visit other webpages related to the website. Sometimes links can refer a user to another website, which has its own group of webpages.[7]

Finally, a service provider, also known as a host, is where the webpages are stored. A host stores the webpage code and delivers the code to users who request it. By pointing their browsers to an address, users retrieve the code from the host to view it on their own computers. A website can be hosted from any computer, including a personal computer. However, most websites employ a service provider to supply better speed and stability.[8]

The word "website" used in the everyday context broadly describes the interaction of all three components. When one states that a website is "down" or "offline," one can be referring to a multitude of technical problems that can be associated with a website. For example, the homepage could have been changed to reflect maintenance is taking place, so the users visiting the site cannot access the information they seek; the service provider could be experiencing some

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[6] COMM. ON INTERNET NAVIGATION AND THE DOMAIN NAME SYS.: TECHNICAL ALTERNATIVES AND POLICY IMPLICATIONS, SIGNPOSTS IN CYBERSPACE 1-2 (2005).

[7] IGNACIMUTHU, *supra* note 5, at 17.

[8] *Id.* at 18.

technical difficulty either with its hardware (where the webpage code is stored) or network (the transmission of code to users asking for it); or, the domain name has expired and no longer points to the web-pages that a user wants to access.[9]

II.   THE STATUTORY BASIS: THE FEDERAL COPYRIGHT ACT

Important to the discussion at hand is the Copyright Act of 1976, the federal statutes that govern, among other things, copyright ownership and the work for hire doctrine.[10] Section 201(a) states that the author of a work is the initial copyright holder, while § 201(b) of the Copyright Act outlines the work for hire exception.[11]   Section 201(b) states:

> In the case of a work made for hire, the employer or other person for whom the work was prepared is con-sidered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a writ-ten instrument signed by them, owns all of the rights comprised in the copyright.[12]

Read textually, this section shifts the authorship to either the employer or the person who commissioned the work. This shift gives copyright ownership to the employer or commissioner instead of the creator of the work. Section 101 complements § 201 by providing the definition of a work made for hire. Section 101 states, in perti-

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    [9] *See,   e.g.*,   SearchNetworking.com,   What   Is   Offline-Definition, http://searchnetworking.techtarget.com/sDefinition/0,,sid7_gci542056,00.html (last visited Mar. 23, 2009).

    [10] Copyright Act of 1976, 17 U.S.C.A. §§ 101-1332 (West 2005).

    [11] *Id.* § 201(a), (b).

    [12] *Id.* § 201(b).

nent part, that a "work for hire" is:

> (1) a work prepared by an employee within the scope
> of his or her employment; or
> (2) a work specially ordered or commissioned for use
> as a contribution to a collective work, as a part of a
> motion picture or other audiovisual work, as a transla-
> tion, as a supplementary work, as a compilation, as an
> instructional text, as a test, as answer material for a
> test, or as an atlas, if the parties expressly agree in a
> written instrument signed by them that the work shall
> be considered a work made for hire.[13]

The plain text of the definition shows two ways to fall under the work for hire doctrine. One is through the employer-employee relationship in which the employee creates or performs some work within the scope of employment. The other is where there is no employment relationship but the work was 1) specially commissioned for; 2) one of the nine statutorily enumerated works; and 3) expressly agreed to be a work for hire in a signed written instrument. Read together, the two sections should give a good explanation of the work for hire doctrine. However, despite its seeming clarity, the doctrine has been thoroughly litigated with issues such as the employer-employee relationship, and the scope of employment becoming major points of contention in work for hire cases.

III.   THE WORK FOR HIRE STANDARD

Copyright ownership under work for hire has been applied to numerous situations. Each case would apply the relevant statutes and

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[13] *Id.* §101.

the cases preceding it to mold the work for hire doctrine within a particular technology or circumstance. Work for hire has been applied to arts, academia, and even computer programming.[14] This Part will discuss work for hire's rich background and gradual evolution to the current issue of copyright within website development.

A.   Sculpting the Face of Work For Hire: *CCNV v. Reid*

The seminal case dealing with work made for hire is *Community for Creative Non-Violence v. Reid*. *Reid* resolved the copyright ownership of a sculpture between an artist and the organization that hired him.[15] The Community for Creative Non-Violence ("CCNV") contacted James Reid to create a sculpture depicting the "plight of the homeless" for a pageant.[16] Mr. Reid agreed to do so, and the parties established the sculpture "would cost no more than $15,000" excluding Mr. Reid's workmanship, which he donated.[17] The copyright ownership dispute arose between the parties after the creation of the sculpture when both parties wanted control over the sculpture's touring schedule.[18]

Examining § 101(2) of the Copyright Act, the Supreme Court of the United States held that a sculpture did not fall under one of the nine enumerated works,[19] and there was no express written agreement

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[14]   *See, e.g.*, *Reid*, 490 U.S. at 730; *Aymes*, 980 F.2d at 857; *Weinstein*, 811 F.2d at 1091.

[15]   *Reid*, 490 U.S. at 732.

[16]   *Id.* at 733.

[17]   *Id.* at 734.

[18]   *Id.* at 735.

[19]   *See supra* Part II.

the work was to be made for hire.[20] As a result, the Court easily dismissed the applicability of § 101(2). Instead, it focused its reasoning on whether there was an employer-employee relationship that would trigger work for hire under § 101(1).[21] Interpreting Congress' intent, the Court outlined a twelve factor test, grounded in the common law of agency, to determine if Mr. Reid was an employee of CCNV.[22] The Court found that sculpting was a skilled profession, that Mr. Reid used his own tools, controlled his own work time, received payment the way independent contractors were paid, was retained for less than two months, and that CCNV did not pay social security taxes or offer employee benefits to Mr. Reid.[23] These factors weighed heavily in favor of Mr. Reid's status as an independent contractor and not an employee.[24]

To reach its decision, the Supreme Court dismissed three other tests used by the circuit courts to determine if an employer-employee relationship exists.[25] The Court found that CCNV monitored parts of the creation of the sculpture. For example, CCNV took

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[20] *Reid*, 490 U.S. at 738.

[21] *Id.*

[22] *Id.* at 740. The relevant factors are:

> [T]he skill required; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired party; the extent of the hired party's discretion over when and how long to work; the method of payment; the hired party's role in hiring and paying assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is a business; the provision of employee benefits; and the tax treatment of the hired party.

Id. at 751-52.

[23] *Id.* at 752-53.

[24] *Id.* at 752.

[25] *Reid*, 490 U.S. at 742, 743 n.8 (rejecting the "right to control test," "actual control test" and that an employee only refers to a salaried or formal employee).

Mr. Reid around Washington to observe homeless people, suggested he visit a homeless shelter to view suitable models, and insisted that the homeless people depicted in the sculpture use a shopping cart to hold their belongings instead of shopping bags.[26] However, it rejected the argument that CCNV's monitoring actions determined Mr. Reid's status as an employee.[27] Consequently, the Court held that Mr. Reid was an independent contractor.[28] The Supreme Court did not determine whether the sculpture was a joint work as this issue was reserved on remand.[29]

Evident within the *Reid* opinion was the Court's motivation to maintain predictability of copyright ownership by establishing what it believed to be a test that could be applied uniformly.[30] However, due to the extensive list of factors outlined within *Reid*, criticism has arisen regarding the probability of unequal application of such a subjective, complex test.[31] Nevertheless, *Reid* established strong precedent that would be applied to subsequent cases involving different works and circumstances.

B.   Scope of Employment Clarified in Academia Cases

In the academia arena of schools and universities, the focal point of the work for hire doctrine is different. Whereas the *Reid* decision concentrated on whether the creator of a work was an em-

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[26] *Id.* at 734.

[27] *See id.* at 734, 741.

[28] *Id.* at 753.

[29] *Id.*

[30] *See Reid*, 490 U.S. at 740.

[31] Charles D. Ossola, *Recent Developments Relating to Copyright Ownership and Transfer*, 441 PLI/Pat 7, 12-13 (1996).

ployee or an independent contractor, the debate in the school setting focuses on whether employees are working within their scope of employment.[32] Because a teaching position is usually a salaried position and is heavily controlled by the educational institution, teachers are usually unable to deny that they are not employees of a school or university. Nevertheless, *Reid* clearly affected these cases by establishing that the common law of agency was to be used to determine whether an employee was working within the scope of employment.

Disputes between professors and educational institutions decided prior to *Reid* articulated what came to be known as the "teacher exception" to the work for hire doctrine.[33] For example, in *Weinstein v. University of Illinois*, the Seventh Circuit held that a professor's scholarly article was not a work for hire because publishing articles was not a required duty.[34] Similarly, in *Hays v. Sony Corp. of America*,[35] the Seventh Circuit stated that high school teachers who created a word processor manual for class would probably hold the copyright due to the teacher exception.[36]

However, the viability of the teacher exception came into question after *Reid* because the opinion made no mention of the exception.[37] In addition, cases in the academic setting like *Shaul v. Cherry Valley-Springfield Central School District*[38] applied the *Reid*

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[32] *Compare Reid*, 490 U.S. 730, *with Weinstein*, 811 F.2d 1091.

[33] Jeff Todd, *Student Rights in Online Course Materials: Rethinking the Faculty/University Dynamic*, 17 ALB. L.J. SCI. & TECH. 311, 322-23 (2007).

[34] *Weinstein*, 811 F.2d at 1094.

[35] 847 F.2d 412 (7th Cir. 1988), *abrogated by* Cooter & Gell v. Hartmarx Corp., 496 U.S. 384 (1990) (abrogating for other reasons).

[36] *Id.* at 416.

[37] *See generally Reid*, 490 U.S. 730.

[38] 363 F.3d 177 (2d Cir. 2004).

standard while limiting the teacher exception.

In *Cherry Valley*, the Second Circuit held that a high school teacher's tests, quizzes, and homework assignments fell under the work for hire doctrine, and therefore the school was the author and owner of the teaching materials.[39] In determining whether an employee's conduct falls within the scope of employment, the court used a three part test: "(1) [i]t is of the kind of work [an employee] is employed to perform; (2) [i]t occurs substantially within authorized work hours; [and] (3) [i]t is actuated, at least in part, by a purpose to serve the employer."[40] Because preparing testing materials was a regular duty of a school teacher, preparation outside of class was commonplace in the profession. Thus, the tests were created to fulfill the goals of the school. Therefore, the court held that Mr. Shaul was an employee working within his scope of employment when he created the tests and quizzes.[41] Furthermore, the court distinguished the teacher exception in *Weinstein* because the materials were not "explicitly prepared for publication."[42] As a result, the school was the author of the teaching materials under § 201 of the Copyright Act.[43] Similarly, cases like *Genzmer v. Public Health Trust of Miami-Dade County*[44] and *Vanderhurst v. Colorado Mountain College District*[45]

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[39] *Id.* at 185.

[40] *Id.* at 186 (citing RESTATEMENT (SECOND) OF AGENCY § 228 (1958)).

[41] *Id.*

[42] *Id.*

[43] *Cherry Valley*, 363 F.3d at 186.

[44] 219 F. Supp. 2d 1275, 1283 (S.D. Fla. 2002) (holding a post graduate intern working as a physician who wrote a computer program to assist with research did so within the scope of employment).

[45] 16 F. Supp. 2d 1297, 1307 (D. Colo. 1998) (reasoning that a professor's outline was connected to his employment and therefore within the scope of employment).

apply the three prong common law test without mentioning the teacher exception.

Although the teacher exception issue still arises, commentators generally agree that the exception was not preserved in the 1976 Copyright Act.[46]   The Supreme Court of Kansas even questioned whether the narrow teacher exception is already accounted for in the common law scope of employment requirement.[47]   It is relatively clear from the cases decided after *Reid* that the teacher exception holds little, if any, weight.

C.   Ones and Zeros: Work for Hire Applied to Computer Programming

The work for hire test laid out in *Reid* was based on the common law of agency. This method of evaluating work for hire has made the test easily applicable to new forms of media and circumstances. However, as the analysis of each case requires a fact specific inquiry, courts have decided a healthy number of cases involving computer programming.

1.   *Applying the Employer-Employee Test to Programmers*

As in prior work for hire cases, courts dealing with computer programmers had to determine if the creator of the work was an employee or independent contractor. In *Aymes v. Bonelli*, Aymes, a

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[46]   Todd, *supra* note 33, at 323.
[47]   *See* Pittsburg State Univ. v. Kansas. Bd. of Regents, 122 P.3d 336, 346 (Kan. 2005) (citing JoLynn M. Brown & James B. Wadley, *Working Between the Lines of Reid: Teachers, Copyrights, Work-For-Hire and A New Washburn University Policy*, 38 WASHBURN L.J. 385, 432 (1999)).

computer programmer, was held to be an independent contractor. Therefore, Aymes owned the copyright to a computer program he wrote. Similar to *Reid*, Aymes was asked by Island Swimming Sales, Inc. to write a program that maintained records for the corporation—no written agreement was made.[48] Aymes worked on the project at Island's office and the project was monitored and tuned to fit the company's needs.[49] However, Mr. Aymes "enjoyed considerable autonomy" when he worked, did not receive health benefits, and was not treated by Island as an employee in its tax and payroll system.[50] Applying the *Reid* factors to these facts, the court latched onto the fact that Island treated Mr. Aymes like an independent contractor through its failure to provide employee benefits and pay payroll taxes for him.[51] The court then held that Island should not be allowed to re-categorize Mr. Aymes' status to deny him rights to his program.[52] As a result, Mr. Aymes was found to be an independent contractor.[53] However, as the suit was a copyright infringement case, the court remanded to determine if the work could be held as a joint work.[54]

Similarly, in *Graham v. James*[55] the court reasoned that defendant, Larry James, was an independent contractor because "James [wa]s a skilled computer programmer, he was paid no benefits, no payroll taxes were withheld, and his engagement by Graham was pro-

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[48] *Aymes*, 980 F.2d at 859; *see Reid*, 490 U.S. at 738.

[49] *Aymes*, 980 F.2d at 859.

[50] *Id.*

[51] *Id.* at 862-63.

[52] *Id.* at 862.

[53] *Id.* at 864.

[54] *Aymes*, 980 F.2d at 865.

[55] 144 F.3d 229 (2d Cir. 1998).

ject-by-project."[56] Conversely, programmers were found to be employees if the *Reid* factors as applied to the facts of the case produced a different result.[57]

2.   *Scope of Employment of a Programmer*

In addition to the employee/independent contractor analysis, courts have also decided whether programmers were acting within their scope of employment. Although courts have come down on different sides of whether computer programmers were acting within their scope of employment, the standard has produced sound results.[58] An example of how the standard has been applied to computer programmers can be seen in *Avtec Systems, Inc. v. Peiffer*.[59] In *Avtec*, a programmer who developed a program at home, within his field of employment, was nevertheless found to be working outside the scope of employment.[60] The court in *Peiffer* reasoned that Mr. Peiffer's "orbital simulation for satellites" program was work that Mr. Peiffer was hired to perform due to the fact that Avtec was in the business of selling space-related computer services.[61] This satisfied the first prong of the common law scope of employment test. However, the

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[56] *Id.* at 235.

[57] *See* Montgomery v. Alcoa Fujikara, Ltd., No. 99-CV-73350-DT (E.D. Mich. Sept. 29, 2000), 2000 WL 1769526, at *7-8 (holding a programmer who received benefits, was paid and taxed like a salaried employee, maintained an eight-to-five time schedule, and developed a program on company time and equipment was an employee under the *Reid* test).

[58] *Compare* Kelstall-Whitney v. Mahar, No. 89-4684, (E.D. Pa. May 23, 1990), 1990 WL 69013, at *8 (holding a computer programmer was not working within the scope of employment despite receiving some assistance and compensation), *with* Rouse v. Walter & Assoc., L.L.C., 513 F. Supp. 2d 1041, 1057-61 (S.D. Iowa 2007) (deciding that a scientist who developed a program to assist with compiling research results was acting within the scope of employment when writing the program).

[59] No. 94-2364, (4th Cir. 1995 Sept. 13, 1995), 1995 WL 541610.

[60] *Id.* at *4-5.

[61] *Id.* at *1, *4.

court affirmed the lower court's finding that because Mr. Peiffer worked on the program at home and the program was not meant to serve Avtec's interest, that the second and third prongs, respectively, were not satisfied.[62] As a result, Mr. Peiffer was not acting within the scope of employment when he created the orbital simulation program.[63]

D.   Section 101(2) and the Writing Requirement Debate

Section 101(2) of the Copyright Act of 1976 provides a second method to fall under the work for hire doctrine. To fall under this provision, the work must be: 1) specially commissioned for; 2) one of the nine statutorily enumerated works; and 3) expressly agreed to be a work for hire in a signed written instrument.[64] Although many litigated cases involve the absence of a writing between the parties, the cases attempting to fit under § 101(2) have raised an issue as to the meaning of the writing requirement.

Textually, § 101(2)'s meaning is straightforward: to determine the outcome of work for hire under this definition, one would look at the facts provided and attempt to check off each of the three elements required. However, Judge Posner, in *Schiller & Schmidt, Inc., v. Nordisco Corp.*,[65] read a temporal requirement into the third element. *Schmidt* entailed a dispute over photographs taken by Bertel, a photographer for Rybak, when Rybak was employed by

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[62]   *Id.* at *4-5.

[63]   *Id.* at *1.

[64]   *See supra* Part III; 17 U.S.C.A. § 101(2).

[65]   969 F.2d 410 (7th Cir. 1992).

Schiller. Rybak subsequently left the company and created a competing business, using the photographs in his catalogues.[66] Schiller sued for copyright infringement. According to Judge Posner, Bertel could not in any way fit under the classification of an employee of Schiller; therefore, Schiller had to rely on § 101(2) to establish copyright ownership.[67] Although there was no writing to support work for hire between Schiller and Bertel when the photographs were taken, Schiller obtained Bertel's signature on an agreement after litigation had commenced. The agreement stated that Schiller owned the copyright to the photographs and any remaining copyrights would also be assigned to Schiller.[68] Schiller, however, did not sign the agreement.[69] Judge Posner reasoned that this agreement could not satisfy the writing requirement because "signed by them" under the statute meant that both parties had to sign the agreement—which Schiller failed to do.[70] In addition, "the statement also came too late" because work for hire shifts the vesting of copyright ownership to the commissioner and attaches when the work is created.[71] Therefore, a written agreement is required to precede the creation of the work for the purposes of work for hire under § 101(2).[72] Because the writing was created after the photographs were taken, Schiller could not be the copyright owner.[73]

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[66] *Id.* at 411-12.
[67] *Id.* at 412.
[68] *Id.*
[69] *Id.*
[70] *Schmidt*, 969 F.2d at 412.
[71] *Id.*; 17 U.S.C.A. §201(b).
[72] *Schmidt*, 969 F.2d at 413.
[73] *Id.*

The requirement articulated in *Schmidt* was rejected by the Second Circuit three years later in *Playboy Enterprises, Inc., v. Dumas*.[74] In *Dumas*, the court discarded the Seventh Circuit's bright line test in favor of a different temporal requirement.[75] The Second Circuit held that as long as "the parties agree before the creation of the work that it will be a work made for hire," the writing itself need not "be executed before the creation of the work."[76] At issue in *Dumas* were legends on the back of checks that Playboy issued to Mr. Nagel, a graphic artist. The legends contained the work for hire provision and were signed by both parties.[77] However, neither party in the suit "proffered any direct evidence of the intent of the parties before the creation of the works."[78] Nevertheless, the court found that although Nagel's first check could not be evidence of an agreement prior to the creation of the work, his subsequent endorsement of checks could infer a "pre-creation consent to such a relationship."[79] Accordingly, the court found that the writing requirement under § 101(2) could be satisfied and the illustrations could be considered work for hire.[80]

Schmidt and *Dumas* show a split between the two circuits when interpreting the temporal requirement of § 101(2). The only court to weigh in on this split is the United States District Court in the Southern District of Texas. In *Compaq Computer Corp. v. Ergonome*

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[74]   53 F.3d 549 (2d Cir. 1995).

[75]   *Id.* at 559.

[76]   *Id.*

[77]   *Id.* at 552.

[78]   *Id.* at 560.

[79]   *Dumas*, 53 F.3d at 560.

[80]   *Id.*

Inc.,[81] the court chose to follow the Second Circuit's reasoning that a pre-creation agreement is required for a work for hire relationship to occur.[82] In addition, the agreement does not have to be memorialized prior to the creation of the work.[83]

Due to the lack of cases deciding this point, the question remains open as to whether there is a bright line requirement. Yet, what is clear is there is a temporal requirement under § 101(2). The Seventh Circuit's bright line test encompasses the Second Circuit's pre-creation intent requirement because a written agreement cannot exist without the intent to enter into a work for hire relationship. Thus, if there is a written document before the creation of the work, there must be an agreement pre-creation.

In summary, the cases dealing with the writing requirement highlight two key points. First, the intent to partake in a work for hire relationship must precede the creation of the work. Second, both parties must sign the writing memorializing the agreement.[84]

IV.   THE WEBSITE COPYRIGHT PROBLEM

A.   Copyright, Work for Hire, and Website Development

One of the latest disputes over copyright ownership involved a criminal trial for fraud. In *State v. Kirby*,[85] the Supreme Court of New Mexico held that a webpage designer who created and owned

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[81]   210 F. Supp. 2d 839 (S.D. Tex. 2001).

[82]   *Id.* at 843.

[83]   *Id.*

[84]   *See Dumas*, 53 F.3d at 364; *Schmidt*, 969 F.2d at 412.

[85]   161 P.3d 883 (N.M. 2007).

the copyright to the webpages owned the website where the web-
pages were located.[86] Richard Kirby, the defendant, approached
Loren Collett, a website developer operating under a sole proprietor-
ship, to design and develop a website. The defendant agreed to pay
Collett $1,890.00 for Collett's services.[87] However, after the webde-
veloper created and incorporated the webpages into the website, the
defendant did not pay Collett and changed the password on the web-
site to lock the developer out.[88] A written contract between the par-
ties made no explicit agreement pertaining to the website, but it did
discuss copyright ownership of the webpages.[89] The court found that
pursuant to the contract, Collett reserved the copyright of the web-
pages and that "[u]pon payment, [d]efendant would receive a kind of
license to use the website."[90]

The prosecution was required to prove that the "*website* [that
defendant obtained] *belonged to someone other than defendant*" to
convict the defendant of criminal fraud.[91] Consequently, the defen-
dant argued that no reasonable jury could have found that the website
belonged to someone else because he owned the website.[92] The de-
fendant had obtained the domain name, hosting service, and pass-
words which are necessary components to any website.[93]

The Supreme Court of New Mexico rejected Defendant's con-

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[86] *Id.* at 884.
[87] *Id.* at 884-85.
[88] *Id.* at 885.
[89] *Id.* at 886.
[90] *Kirby*, 161 P.3d at 886.
[91] *Id.* at 885 (citing State v. Kirby, No. 24, 845, mem. op. (N.M. Ct. App. May 10, 2005)).
[92] *Id.*
[93] *Id.* at 887.

tentions finding that a website and its webpages are interchangeable terms for the purposes of copyright and ownership. The court pointed to cases where copyright disputes similar to *Kirby* arose and no distinctions were made between webpages and websites.[94] It also reasoned that part of the interchangeable nature of websites and webpages was due to the fact that a website is virtually non-existent without a webpage that "gives it life."[95] Following this reasoning, the court only had to establish who owned the copyright to the webpages to determine ownership of the website. Because the contractual agreement between Kirby and Collett established that copyright of the webpages remained with the webdeveloper, the court held that a reasonable jury could have found that Kirby committed fraud by taking a website he did not own.[96]

Although *Kirby* is a state case, the Supreme Court of New Mexico referred to federal cases and federal statutes to make its decision. The court alluded to the work for hire doctrine in its opinion and applied the rule of law established by *Reid*, §101 and § 201 of the Copyright Act.[97] It found that Collett would have been an independent contractor, and that the written agreement between the parties was an assignment of right, instead of a work for hire.[98] Therefore, Collett's webpages, and the website where the webpages were located,

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[94] *See id.* at 888-89 (citing Janes v. Watson, No. SA-05-CA-0473-XR (W.D. Tex. Aug. 2, 2006), 2006 WL 2322820; Holtzbrinck Publ'g Holdings, L.P. v. Vyne Commc'ns, Inc, No. 97 CIV. 1082 (KTD) (S.D.N.Y. Apr. 26, 2000), 2000 WL 502860).

[95] *Kirby*, 161 P.3d at 887.

[96] *Id.* at 889.

[97] *Id.* at 886 n.1.

[98] *Id.*

were not a work for hire.[99] In addition, the court stated that because
the defendant did not argue that the website was a joint work, it did
not have to address that possibility.[100]

It is unclear what the Supreme Court of New Mexico intended
with its federal work for hire analysis. Section 301 of the Copyright
Act preempts the "general scope of copyright" from being litigated in
state courts, and, therefore, a state court may not decide work for hire
issues.[101] One possibility is that the court made a holding when it did
not have the power to do so. Another more likely possibility is that
the court applied the federal statute as a method of interpreting the
contract between the defendant and Collett.[102]

B.   Importance of the Technical Distinction Between a
Website and a Webpage

Compared to other forms of media, the Internet, websites, and
webpages are still considered a new development. This is evidenced
in *Kirby* and other cases where courts have outlined a basic explana-
tion of the Internet and the website/webpage relationship.[103] The out-
come of *Kirby* seems fair—the defendant's conduct of refusing to pay
someone and then blocking him from taking back the work was egre-

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[99]   *Id.*

[100]   *Kirby*, 161 P.3d at 886 n.1.

[101]   17 U.S.C.A. § 301(a) (West 2005).

[102]   *Kirby* was decided in a state court that does not have the power to expand or reduce
copyrights. However, state courts can decide contracts dealing with copyrights in certain
instances, like assignments of copyrights. It is important to understand the decision was
most likely made on the basis of contract theory and not the federal work for hire statute.
However, the *Kirby* Court used federal principals to help interpret the terms of the contract.
For a more extensive discussion of copyright preemption and § 301, see Trotter Hardy, *Con-
tracts, Copyright and Preemption in a Digital World*, 1 RICH. J.L. & TECH. 2 (1995).

[103]   *See, e.g.*, *Kirby*, 161 P.3d at 885; *Janes*, 2006 WL 2322820; *Holtzbrinck*, 2000 WL
502860.

gious. However, the court goes too far in holding that a copyright holder of webpages placed on a website is the owner of the website itself.

In its technical explanation, the Supreme Court of New Mexico delineated the difference between a webpage and website. Citing *Sublett v. Wallin*,[104] the court explained that a "website consists of any number of webpages" and therefore, a "webpage is an integral part of a website."[105] By adopting this definition, the court places webpages as a subset of a website. Although it is possible that one who owns a subset owns the whole, automatically attributing ownership of an entire set to the owner of a subset is illogical.

After distinguishing a webpage from a website, the court turned around and cited precedent in which other courts discussed websites and webpages as one entity.[106] It then adopted this oversimplified view and affirmed the defendant's conviction on the ground that the webdeveloper owned the website.[107] Instead of coming to this conclusion, the court could have used a different line of reasoning to find that the defendant committed fraud. After all, the defendant was effectively preventing the webdeveloper from reclaiming or accessing the webpages that he owned.

The number of people who use the Internet and computer technology are growing at a rapid pace.[108] As this shift occurs, it will

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[104] 94 P.3d 845 (N.M. Ct. App. 2004).

[105] *Kirby*, 161 P.3d at 885 (citing *Sublett*, 94 P.3d 845).

[106] *Id.* at 887-88 (citing *Janes*, 2006 WL 2322820; *Holtzbrinck*, 2000 WL 502860).

[107] *Id.* at 889.

[108] Growth of users on the Internet has risen 265.6% from 2000 to 2007. Internet World Stats—Internet Usage Statistics, http://internetworldstats.com/stats.htm (last visited Mar. 23, 2009).

be increasingly difficult to find people without a minimal, low-level understanding of the Internet and the different roles played by a website or a webpage. By grouping website and webpage as one, the court ignores the fact that on a technical level, the two are distinct, and that there should be a legal separation with regard to the rights involved.

C.   Interdependency of Webpages, Webaddress, and Service Providers

The *Kirby* Court justifies its holding that a webpage owner is also the owner of the website by explaining that a webpage is the substance that gives a website "life."[109] Although it is true that a website without webpages is of little to no value, if any of the other necessary components of a website were missing, it would also render a website valueless.[110] Minimizing the value of a domain name, the court states that "it is nothing more than an address."[111] However, without an address, a website will be unable to provide its content with ease on the World Wide Web. Users who wish to access a website without a domain name would have to obtain the direct address from the service provider, which is usually a series of forgettable numbers.[112] Without an address, one of the main purposes of a website—convenience—is greatly burdened. Furthermore, the value in a domain name is significant, as evidenced by the protection given by

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[109]   *Kirby*, 161 P.3d at 887.

[110]   *Id.*

[111]   *Id.* (citing STEVEN D. IMPARL, INTERNET LAW: THE COMPLETE GUIDE Part.II.4.1 (2006)).

[112]   *See* SIGNPOSTS IN CYBERSPACE, *supra* note 6, at 19.

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the federal government to domain names through the "Anticyber-squatting" statute.[113]

Similarly, without a commercial service provider, a website's webpages would have to be stored and run from a personal machine. This would tax the bandwidth of most websites causing a dramatic loss of speed—and possibly crashes under a high load.[114] An unreliable and slow website would be, as the *Kirby* Court described, of "little use to any business enterprise."[115] It is not being argued that the owner of the domain name or service provider owns a website. These components, like webpages, are subsets of a website that rely on each other to create a functional website.[116] As a result, basing ownership of a website on ownership of any one of these components is illogical.

D. Websites with User Controlled Webpages

By simplifying websites and webpages as one, the *Kirby* decision also established a dangerous precedent that could give rise to illogical results. The success of websites as sources of cutting edge information stems partly from the level of interactivity and freedom given to users on the Internet. Many websites are set up not to directly disperse information, but instead to spur discussion.[117] This

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[113] *See* Anticybersquatting Consumer Protection Act, 15 U.S.C.A. § 1125 (d) (West 1998 & Supp. 2007) (preventing a person to register and hold highly sought after domain names for the sole purpose of selling them).

[114] *See, e.g.*, Darren Dahl, *Traffic's Up; Website's Down*, INC.COM, Mar. 2008, http://www.inc.com/magazine/20080301/traffics-up-websites-down.html (last visited Mar. 23, 2008).

[115] *Kirby*, 161 P.3d at 887.

[116] *See* IGNACIMUTHU, *supra* note 5, at 17.

[117] For example, many law school professors use "TWEN," a Westlaw teaching tool that

method allows users to read input from other users regarding a topic. To follow this trend of horizontal information sharing, there are numerous websites on the Internet that relinquish control of their individual webpages to users or visitors of the website. For example, websites like *wikipedia.com* and other "wikis" allow users to edit parts of the webpages to contribute information.[118] Similarly, *myspace.com* allows users to upload entire blocks of Cascading Style Sheet ("CSS")[119] code to create their personal webpages within the site.[120] And finally, websites like *geocities.com* provide free hosting where users are given passwords and server space to upload their own webpages in HTML form.[121]

Although most of these websites are protected by terms of use agreements, if a site happens to lack a user agreement or a court finds an agreement unenforceable, it is plausible after *Kirby* that a user or group of users who own the copyright to the individual webpages will be able to take ownership of a website. This would be an unacceptable result as it would threaten companies that allow for more widespread personalized user interaction that is unique to the way the Internet compiles and distributes information.

V. CAN WEBSITES BE WORKS FOR HIRE?

Kirby did not focus much on the application of work for hire

provides an online forum for outside class discussions. *See* The West Education Network, http://lawschool.westlaw.com/twen (last visited Mar. 23, 2009).

[118] *See* Wikipedia, http://www.wikipedia.com (last visited Mar. 23, 2009).

[119] KEITH HARMAN & ALEX KOOHANG, LEARNING OBJECTS: STANDARDS, METADATA, REPOSITORIES, & LCMS 119 (2007).

[120] *See* MySpace, http://www.myspace.com (last visited Mar. 23, 2009).

[121] *See* Yahoo! Geocities, http://geocities.yahoo.com (last visited Sept. 22, 2008); *see also* HARMAN & KOOHANG, *supra* note 119, at 118.

within its analysis. However, the case highlights the importance of understanding the work for hire doctrine and applying the doctrine in appropriate situations. The *Kirby* case found that Collett, the web developer, was an independent contractor under the *Reid* test.[122] Although the court did not specifically analyze the factors involved, the fact that Collett ran a sole proprietorship, did not retain any benefits from Kirby, and was to be compensated in a lump sum at the completion of work made it virtually indisputable that Collett was an independent contractor.[123] Categorized as an independent contractor, Collett owned the copyright to the webpages under § 201(a) of the Copyright Act. On the other hand, if the facts were different and Collett was found to be an employee working within the scope of employment, the websites he created would fall under work for hire.[124]

Not as certain is whether a website can fall under § 101(2). The extent of the *Kirby* Court's analysis under § 101(2) was outlining the three requirements and stating that, "these elements are lacking."[125] Although the court was probably motivated by the fact that the only written agreement between the parties was a contract of assignment, one can only guess which element, or if all of the elements, were lacking.[126]

In the context of a hypothetical web development situation,

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[122] *Kirby*, 161 P.3d at 887 n.1.

[123] *See id.* at 884-85.

[124] *See supra* Part IV.A.

[125] *Id.* at 887 n.1 (stating that in order for § 101(2) to apply, "the parties must expressly agree in a signed written instrument that the work will be work for hire and the work must be commissioned for one of nine uses listed in the Copyright Act").

[126] *See id.* at 886.

element one requiring that the work be specially contracted for would usually not be an issue. This is because the relationship between parties in a web development context usually requires a client to approach a web developer who is then informed as to the scope of the website, and any features that the client would like implemented on the website. Even if the web developer is given artistic freedom, the developer would still have to be given basic facts like the type of website (business or personal), the information to be placed on the website, and a webaddress (depending on whether the client has purchased a domain name), before the developer can begin work on a website. Similarly, element three would not bar a website from being a work for hire as it is up to the parties to produce a written agreement.[127] In addition, the temporal requirement necessitating the parties to agree before the creation of the work should be easily satisfied following the same reasoning as element one.[128]

On the other hand, element two requires that the work be one of the nine specifically enumerated works listed in the statute.[129] Courts have not weighed in on whether a website can fall under one of the nine enumerated works in § 101(2). Because the creation of websites can differ drastically from case to case, each website would have to be analyzed individually to determine if it could fall within the enumerated works. A website could fit within the realm of a

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[127] 17 U.S.C.A. § 101(2).

[128] *See supra* Part IV.D. It is up to the parties to have a pre-creation agreement. The work that is involved is irrelevant for the temporal requirement.

[129] *See* 17 U.S.C.A. § 101(2) (the nine enumerated works are "contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas").

compilation if the website was created as a listing of other sites addressing a topic, or if a website was a hub for a network for spoke sites.[130]   Conversely, if a web developer was employed to create a website that merely focuses on distributing information, it will probably not fit within one of the enumerated works.

VI.   PRECAUTIONS TO TAKE UNDER THE WORK FOR HIRE DOCTRINE

Work for hire's flexible test creates difficulty in predicting whether the doctrine can be applied to the field of web development. However, having the understanding that current copyright laws are not yet fully adapted to this new technology highlights a few precautions that each party can take before entering into a business deal involving the creation of websites.

Why Collett in the *Kirby* case ended up developing the webpages directly on the defendant's system is somewhat of a mystery.[131] Within the industry it is commonplace for developers to first program the pages locally and host the webpage from their machine so that a client can view, test, and request changes be made to the webpage.[132] After the pages are approved, the webdeveloper will then publish the website onto the client's service provider which has a domain name attached to it.[133] Developing a website or webpage in this manner al-

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[130] *See, e.g.*, *Janes*, 2006 WL 2322820, at *12 (dismissing a work for hire claim by acknowledging that a website, where multiple persons were involved in creating components of the site, could be a compilation).

[131] *See Kirby*, 161 P.3d at 885.

[132] *See, e.g.*, Attig v. DRG, Inc., No. Civ.A.04-CV-3740 (E.D. Pa. Mar. 30, 2005), 2005 WL 730681. at *1.

[133] *Id.*

lows developers to have complete control over their own work until everything has been finalized. Although it does not protect a developer from a client that intends from the outset to swindle the programmer, it alleviates the situation where payment is withheld due to a client's belief that the work is unsatisfactory. This method does not give control to the client until the last moment of the business transaction.

It is easy for website managers to believe that they own a website when they have the power to control what is accessible through the domain name or the service provider. However, as seen in *Kirby* and the cases that it cites, courts in some instances have simplified the technological difference between a website and a webpage.[134] As a result, a prudent website manager would not only discuss copyright ownership of the webpages that a developer creates, but also specifically address the ownership of the website as a whole in any contractual agreement. In addition, a website manager must be careful about locking a developer out by changing passwords. What seems to be a mere disrespectful action could result in dire circumstances, as witnessed in *Kirby* where the defendant was convicted of a criminal fraud.[135]

For an attorney drafting contracts to fit under § 101(2), a few issues are not apparent from a textual reading of the statute. First, the written agreement must describe with specificity the exact work being commissioned.[136] In the event that one person is being used for a

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[134] *Kirby*, 161 P.3d at 888-89.
[135] *Id.* at 884.
[136] 17 U.S.C.A. § 101(2).

series of works, separate contracts or clauses specifying each piece of work should be drafted. In the web development context, an attorney should make sure that copyrights with regard to the webpages and the website are specifically discussed to avoid future confusion or possible litigation. Secondly, the agreement to engage in a work for hire relationship must occur before the creation of the work.[137] Although there is a split in the Circuits as to whether an agreement has to be memorialized before the work begins,[138] it would be advisable to follow the stricter rule from the Seventh Circuit and execute the written agreement prior to the creation of the work. This will minimize the risk of litigation regardless of which jurisdiction a client might be in. Until the law pertaining to this issue is more settled, there is no predictability. Employing this method would also protect a client from unnecessary disputes with regard to the temporal requirement as the documentation would serve as solid evidence of a pre-creation agreement if a dispute goes to trial.

Nonetheless, the above method only works if an attorney is given the opportunity to advise a client prior to the creation of the work. Many situations involve works which have already begun, but not yet completed. For example, a company seeking to develop products based on proposals will usually encounter a situation where a prototype or some work has already been completed. To ensure that a client who is seeking to use the work for hire doctrine in this type of situation is protected, it would be prudent to draft a contract clause dealing with copyright in two steps. First, the creator should

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[137] *See Dumas*, 53 F.3d at 559.
[138] *See supra* Part III.D.

assign any and all current copyright to the commissioner of the work; and, second, a separate clause, preferably using the phrase "work for hire," should be included to cover all future work done by the creator. This type of drafting would comply with the temporal requirement of work for hire while ensuring that the commissioner has the copyright.

VII.   THE NEXT BIG CASE: CAN WEBSITES BE A JOINT WORK?

Because cases dealing with copyright and work for hire in the field of computer programming and website development are scarce, the question of whether a website can constitute a joint work has not yet been considered. In addition, the joint work standard depends on the circumstances surrounding the work. Some cases declined to evaluate the joint work standard because the parties never argued the issue, while others remanded the issue back to lower courts.[139]

A.   The Joint Work Standard

Similar to work for hire, the joint work standard is established in §§ 201(a) and 101 of the Copyright Act of 1976. Section 201(a) states that "authors of a joint work are coowners of copyright in the work," while § 101 defines joint work to be "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole."[140] The joint work standard is best illustrated in *Weissmann v. Freeman*.[141] *Weissmann* involved an assistant to a researcher who co-authored a

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[139]   *See Kirby*, 161 P.3d at 887 n.1; *see also Janes*, 2006 WL 2322820 at *10; A*ymes*, 980 F.2d at 865.

[140]   17 U.S.C.A. §§ 101, 201(a).

[141]   868 F.2d 1313 (2d Cir. 1989).

few articles. The assistant produced a derivative work of one of the articles which the researcher used as his own.[142] First, the Court of Appeals for the Second Circuit held that the district court was mistaken in finding that when a derivative work is created, the authorship of the derivative work is automatically the same as the authorship of the original.[143] Instead, each author must have intended to contribute an inseparable part to the whole work and in fact, contributed to the work.[144] Because the court found that the researcher never had the intention to be a co-author of his assistant's derivative work, it reversed the lower court and held that the researcher infringed upon his assistant's copyright interests.[145] The court noted that the intent requirement should not be mistaken to mean that the parties must know who the other contributors will be at the time a contribution is created.[146] As long as a contributor knows his or her work is going to produce a final joint work, the intent requirement is satisfied.[147]

The joint work standard was further explained in *Erickson v. Trinity Theatre, Inc.*[148] The Seventh Circuit held that, in addition to the intent to create an inseparable work, each alleged author's contribution must be independently copyrightable.[149] The court scrutinized two different tests for joint works, the Nimmer-test and the Gold-

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[142] *Id.* at 1315.

[143] *Id.* at 1317.

[144] *Id.* at 1318.

[145] *Id.* at 1327.

[146] *Weissmann*, 868 F.2d at 1319 (citing Edward B. Marks Music Corp. v. Jerry Vogel Music Co., 140 F.2d 266, 267 (2d Cir. 1944) (holding a lyrics writer knew his work would be part of a joint work even though he did not know who would sing or produce the song)).

[147] *Weissmann*, 868 F.2d at 1319 (citing *Marks*, 140 F.2d at 267).

[148] 13 F.3d 1061 (7th Cir. 1994).

[149] *Id.* at 1070-71.

stein-test.[150] Under the Nimmer-test, achieving joint author status re-
quires only that the author make "more than a de minimis contribu-
tion."[151] In contrast, the Goldstein-test requires that each contribution
to the whole be independently copyrightable.[152]

In adopting the Goldstein-test, the court reasoned that Gold-
stein's "copyrightability test str[uck] an appropriate balance in the
domains of both copyright and contract law" because it allows au-
thors to receive suggestions without risking authorship rights.[153] In
addition, contributors who deemed their suggestions to be useful, but
not copyrightable, could protect themselves by contract.[154] Applying
the facts under the Goldstein-test, even though the defendant could
establish that there was intent to be joint authors for one of the plays
that the plaintiff wrote, the suggestions were not copyrightable.[155] As
a result, the preliminary injunction was affirmed because the defen-
dant could not be a joint author, raising the likelihood that plaintiff
would succeed on her infringement claim.[156]

However, a decision by the same circuit ten years later in
Gaiman v. McFarlane,[157] questioned if the Goldstein-test should be
applied in all cases. In *McFarlane*, the Seventh Circuit held that in
cases where the "nature of the particular creative process" makes it so
each person's contribution, standing alone, is not copyrightable, but

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[150] *Id.* at 1069.

[151] *Id.* at 1069-70.

[152] *Id.* at 1070-71.

[153] *Erickson*, 13 F.3d at 1071 (citing Childress v. Taylor, 945 F.2d 500, 507 (2d Cir. 1991)).

[154] *Id.*

[155] *Id.* at 1066.

[156] *Id.* at 1073.

[157] 360 F.3d 644 (7th Cir. 2004).

the end product is copyrightable, each contributor can be considered an author of a joint work.[158] *McFarlane* dealt with the comic book industry where the work is naturally divided into writing, penciling, inking, and coloring. Judge Posner envisioned the situation where each individual contribution to the comic book, would not rise to the level of copyrightability, but the final work would be copyrightable.[159] Reasoning that it would be paradoxical to find that no one owned the copyright to a copyrightable piece of work, the court held that in these situations, each contributor would be a joint author if they intended at the outset to create the joint work.[160] Judge Posner then considered the Nimmer-test, which was rejected in *Erickson*, and applied the test to *McFarlane*.[161] Because Mr. Gaiman was specifically hired as a writer to help develop characters in the *Spawn* comic series, Judge Posner found that the parties set out to create a joint work. In addition, the court found that Mr. Gaiman's contributions to certain comic book characters were not mere suggestions or ideas, even though they would not have been copyrightable standing alone.[162]

Application of the Nimmer-test in the *McFarlane* case poses the question of whether *Erickson* is still good law in the Seventh Circuit. The *McFarlane* decision refused to apply the Goldstein-test, but also did not specifically overrule *Erickson*. Furthermore, the opinion makes note that the Goldstein-test generally produces correct results,

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[158] *Id.* at 658-59.
[159] *Id.* at 659.
[160] *Id.* at 658-59.
[161] *Id.* at 659.
[162] *McFarlane*, 360 F.3d at 661.

but does not account for the case where every partial contribution would not be copyrightable, while the finished product would be.[163] It is possible that the cases are consistent with each other. If the *McFarlane* decision is read narrowly, the Goldstein-test would still be the standard to determine authors in a joint work situation unless the nature of the work makes it so that each contribution would not rise to the level of copyrightability.[164]

B.   Can Websites Fall Under the Joint Work Standard?

For a website to be considered a joint work between a commissioner and a web developer, the parties and website will have to meet the elements articulated by §§ 101 and 102 of the Copyright Act and case law. Specifically, the creators of a website must have the intent to create a piece of inseparable work together. In addition, depending on which test a jurisdiction applies, each contribution must either be individually copyrightable or exceed the threshold of mere suggestion. *Kirby* never decided whether the website was a joint work.[165] Therefore, this section will use the relevant facts in *Kirby* to evaluate if a typical website development relationship will produce a website with joint authors.[166]

1.   *Intent to Create a Joint Work*

For a joint work to exist, the authors involved must have the

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[163]   *Id.* at 658-59.
[164]   *See* Brown v. Flowers, 196 F. App'x 178, 188 n.5 (4th Cir. 2006) (questioning if *McFarlane* should be limited to "mixed media" circumstances).
[165]   *Kirby*, 161 P.3d at 887 n.1.
[166]   *See supra* Part III.D.

intent to create a joint work.[167] In *Kirby*, the defendant purchased the domain name and obtained a service provider. The defendant then approached a webpage designer to create the pages that would be associated with the domain name and host. In this situation, it is reasonable to infer that the parties had the intent to jointly create a website. The defendant would have known that without the content providing webpages, his website would not exist. Similarly, the designer, with the advantage of technical knowledge, would know that his webpages would not be found on the Internet without a domain name or host. Therefore, the defendant and the webdeveloper in *Kirby* would have had the intent to create a website together.

Conversely, another typical website development relationship is where the commissioner asks the web developer not only to design the webpages, but also to obtain all the other necessary components for a website. Intent to create a joint work is less evident in this instance because the webdeveloper would be in control of all the components of a website. The relationship established in this scenario is more likely to be interpreted as intent to purchase or license a website, instead of the intent to create a joint work.

2.   *Work Must be Inseparable*

The second element of joint work is that each contribution must be inseparable from the whole.[168] Webpages and a domain name are easily interchangeable on a technological level because

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[167]   17 U.S.C.A § 101.

[168]   *Id.*

webpages can be placed under any domain name and vice versa.[169] But, when viewed within the context of a website, it can be argued they cannot be separated. Webpages are usually tailored to fit a specific domain name because having a webpage with an arbitrary or misleading domain name is not functional.[170] The consistency of a domain name and its webpages serve the primary functions of a website by making the site memorable and searchable. Thus, a website's domain name, and the webpages created for that particular website, should be considered inseparable contributions to the whole.

### 3.	*Jumping Through the Hoops of* **Goldstein** *and* **Nimmer**

The final requirement for a joint work depends on which test a court chooses to follow. Under the jurisdictions following the Goldstein-test, each individual contribution would have to be copyrightable. Courts have found that webpages are works that are generally afforded copyright protection.[171] On the other hand, domain names are considered uncopyrightable "short phrases" under 37 C.F.R. Section 202.1(a).[172] Even if a commissioner were to argue that he gave the idea and direction for the website, a court applying the Goldstein-test would probably find that the suggestions are not protected by copyright.[173] Therefore, under the Goldstein-test, the

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[169]	*See* IGNACIMUTHU, *supra* note 5, at 17.

[170]	*See* SIGNPOSTS IN CYBERSPACE, *supra* note 6, at 1-2.

[171]	*See, e.g.*, *Kirby*, 161 P.3d 833; Kantemirov v. Goldine, No. C05-01362 HRL (N.D. Cal. June 29, 2005), 2005 WL 1593533.

[172]	37 C.F.R. § 202.1(a) (2007); *see also* Fryer v. Brown, No. C04-5481 FDB (W.D. Wash. July 15, 2005), 2005 WL 1677940, at * 4 (interpreting C.F.R. § 202.1 and holding a domain name not copyrightable).

[173]	Under *Erickson*, suggestions and direction is not enough to rise to the level of copy-

defendant in *Kirby* would not have been considered a joint author of the website because he only contributed suggestions and a domain name.

Website development is analogous to the comic book industry. In the same way a character-writer and an inker are important to a comic book, a domain name and host are highly valued contributions to a website. Yet these components are not independently copyrightable. In spite of this, under the Nimmer-test, a court would probably find each contribution to be above the threshold, and allow a commissioner to be a joint author. Applying the Nimmer-test, the court in *McFarlane* outlined a hypothetical involving two professors who intend to create a joint work:

> Here is a typical case from academe. One professor has brilliant ideas but can't write; another is an excellent writer, but his ideas are commonplace. So they collaborate on an academic article, one contributing the ideas, which are not copyrightable, and the other the prose envelope, and . . . they sign as coauthors. Their intent to be joint owners of the copyright in the article would be plain, and that should be enough to constitute them joint authors . . . .[174]

Website development can involve a situation very similar to that expressed by Judge Posner, where one person has the vision and artistic planning of a website, while the other merely has the technical prowess to write code and carry out that vision. The parties in this instance would work hand-in-hand until the website is completed.

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rightability. *See supra* note 155 and accompanying text.
[174] *McFarlane*, 360 F.3d at 659.

This situation would be one of those paradoxical instances described by Judge Posner, where the Nimmer-test should be applied. If the Nimmer-test is applied to this hypothetical, the planning and vision should be more than a de minima contribution, making it probable that the website would be considered a joint work.[175]

4.   *Websites Should be Considered Joint Work*

As discussed above, websites should easily satisfy the first and second element of joint work. The third element depends on whether a court decides to apply the Nimmer or the Goldstein standard.[176] Judge Posner delivered a strong argument for applying the Nimmer-test in *McFarlane* because of the paradoxical nature of certain industries. Although it is unclear, it seems that Judge Posner is advocating use of the Nimmer-test only in specific situations when the Goldstein-test is unsuitable.[177] If that is the case, the Nimmer-test for the third element should be used for the web development industry. Web development suffers from the same problems that the comic book industry encountered in *McFarlane*. If a commissioner pours energy into visualizing a website and does the "ground work" of obtaining a domain name and a service provider, they have contributed necessary components to a website. However, these necessary portions of a website are not copyrightable. Applying the Goldstein-test strictly would leave the commissioner's valuable contribution unprotected. Unlike the Goldstein-test, the Nimmer-test would produce a

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[175]   *See supra* note 159 and accompanying text.
[176]   *See supra* Part VII.B.1-3.
[177]   *McFarlane*, 360 F.3d at 659 (stating that in the majority of instances, the Goldstein-test yields sound results, but noting the test is flawed in other situations).

more equitable result in the context of website development.

VIII. CONCLUSION

When dealing with new forms of media, technical definitions in the trade should correlate to the legal world. A webpage and a website are two technically distinct entities, and should be treated as such. Although a website consists mainly of webpages, other components like a domain name and server space are necessary pieces that comprise a website. Each component plays an important part in the functionality of a website and sometimes has significant monetary value.[178] The *Kirby* Court decided to group a website and its corresponding webpages because it deemed webpages to be the most important aspect of a website.[179] This simplification produced a sound result in *Kirby*. However, there are a host of problems involved with this line of reasoning.

The industry does not use the term webpage and website interchangeably.[180] A webpage is considered a subset of a website, and the legal world should draw this distinction. It is illogical to assume that the owner of a subset also owns the entire parent set, especially when the other components in the parent set have significant value. Furthermore, the Internet thrives on the wealth of information compiled through many different sources. This has evolved into a world where individual users can make significant contributions to a website through forums, personalized webpages, and other interactive

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[178] *See* SIGNPOSTS IN CYBERSPACE, *supra* note 6, at 1-2.
[179] *Kirby*, 160 P.3d at 887.
[180] *See* IGNACIMUTHU, *supra* note 5, at 17.

methods of information sharing. If owners of webpages also own the website, it is plausible that websites which allow heavy user interaction with unenforceable or invalid terms of use agreements, could eventually be taken over by its users. This is a result that is unreasonable and a hindrance to the unique way the Internet functions.

Apart from the technical distinctions of a webpage and a website, courts are also faced with the application of the work for hire doctrine in the area of web development. There are two ways of falling under the work for hire doctrine of § 201(b). The first is through the work for hire standard articulated in *Reid*.[181] The employer-employee test is a flexible twelve factor test that requires a fact specific inquiry based on whether an employer-employee relationship exists. Although a multi-factored test is difficult to apply, the standard is malleable enough to fit the various forms of media in today's world, and any new types of media that might come in the future. The *Reid* work for hire doctrine can easily be molded to fit the web development industry, and the outcomes depend on the facts. Web developers could work as in-house information technology personnel, which would probably place them under the employee category, or, they could be independent contractors commissioned to produce a single website, where the commissioner has no control over the developers.

The second method requires three elements: (1) the work must be specifically commissioned; (2) there must be a writing, and;

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[181] *See supra* note 15.

(3) the work has to fall under one of the nine enumerated works.[182]
The first two requirements do not act as obstacles for web develop-
ment work to be considered work for hire. However, falling into one
of the nine enumerated works is more difficult. Determination of
what type of work a website is, relies mainly on the content provided
by the webpages. Because webpages can consist of content that
reaches the bounds of imagination, it would be possible for a web-
page to fall under "a contribution to a collective work . . . other audio
visual work [or] . . . a compilation."[183]

Other than work for hire, the joint work doctrine seems like a
better fit for the web development industry. A website could be con-
sidered a joint work under the doctrine because it would be simple to
satisfy the intent and inseparable requirements.[184] In addition, even
though the Goldstein-test would bar a website from being a joint
work, the decision in *McFarlane* to apply the Nimmer-test in select
situations should also apply to the web development industry.

The nature of web development produces situations where a
contributor provides necessary components to a website, like a do-
main name or a host. However, those components by themselves do
not rise to the level of copyrightability. The Nimmer-test in a web
development situation will give protection to the contributor of a
concept and domain name of a website.

Although the work for hire and joint works doctrines require
case-by-case analysis, understanding the nuances of the doctrines is

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[182] *See* 17 U.S.C.A. § 101(2).
[183] *Id.*
[184] *See supra* Part VII.B.1-2.

invaluable to any attorney, businessperson, or author who will encounter copyright issues. Working carefully with the Copyright Act, one should be able to minimize the risk of litigation or future disputes about copyright.