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DOCTRINE OF WORK FOR HIRE- ANALYSIS THROUGH UK, U.S. & INDIAN CASE LAWS- Ishika Agrawal¹**ABSTRACT**

Copyright is an exclusive bundle of rights. It is granted to the actual owner of the work. This article deals with determining ownership and looking into doctrine of work for hire concepts. Any kind of work created by the employee as assigned to him by the employer gives the employer the rights over that work as the owner of that creation. This doctrine first was discovered in courts and later on codified in the statutes. In the 19th century, the copyright was vested at the hands of the author of the work, even if the work was done in due course of employment. At the beginning of the 20th century in 1909, when the federal copyright act was passed this doctrine emerged as an exception to authorship being treated as ownership. It was the era of industrialization and corporate sectors growing rapidly that brought it more into the trend. The problem lies in analyzing who is the author of the work, from the case laws we determine it can be a creator or the employer too. It sounds simple right? Copyright of commissioned works is held by employer and the concept of contract of service and contract for service prevails. But when it comes to reality, apart from statements, the circumstances are different and the problems are real. The Doctrine of Work for Hire is still an emerging concept in the copyright. The disputes vary from case to case, the difference between the contract of service and contract for service may seem minor, but it turns the case upside down. As the analysis made with judicial interpretations of different countries, we see how the doctrine revolves around facts.

INTRODUCTION

Copyright law protects the works of authors and grants them a bundle of exclusive rights. All the concepts discussed under the copyright law revolve around determining the fact that who is the actual owner of the work. In a situation where a sculptor sells his mural for consideration

¹ B.COM.LL.B. III Year at Mody University of Science and Technology

and later on claims his rights when the work deteriorates², would you consider such claims to be justified? A newspaper company published a report written by one of its reporters, who has the right over the report? Likewise, few questions arise when we study the concept of ownership in copyright law. Does ownership mean authorship or are there any exceptions to it?

CONCEPT OF OWNERSHIP & WORK FOR HIRE

In general terms, we consider the author to be the first owner of the work. Law speaks about the first owner as we see in section 17 of The Indian Copyright Act, 1957. With regards to all the subject matters mentioned in the act, the owner shall be the author or the person who employs such person to perform the task. The definition here includes any work that is created by the process of hiring or even said as contract of service. A contract of service is a situation when a person is hired to do a specific job for the employer, the employee is under the direction and command of the employer. Independent Contractors also fall in this category but the amount of control exercised over them is comparatively less, hence they come within contract for service. According to *Halsbury's Laws of England*, a contract of service and contract for service are distinctive in nature. The difference being the degree of independence and control exercised by the employer. The contract of service is the one where the employer exercises direct control and gives all the directions to the employee. Whereas in case of any independent contractor, the degree of control and directions given are much less, hence it is contract for service.³

DOCTRINE OF WORK FOR HIRE

Any kind of work created by the employee as assigned to him by the employer gives the employer the rights over that work as the owner of that creation. The court while deciding such cases keeps three points into consideration:

- Whether the work was of the same kind as assigned to the employee?
- Whether the work was done during the working hours?
- Whether the purpose of the employee was to serve the company?

According to U.S. Copyright law, work made for hire is defined as –

Work made for hire is

- *Any work which is created by the employee in his due course of employment,*

²AmarnathSehgal v. Union of India, 117 (2005) DLT 717, 2005 (30) PTC 253 Del.

³ HALSBURY'S LAWS OF ENGLAND, vol.9, fourth edition, para 860.

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- *If the parties had expressly entered into an agreement for any commissioned work, or for a collective work, it can be anything as such translation, or answer material for a test, a compilation or a supplementary work.*⁴

THE EMERGENCE OF THE DOCTRINE OF WORK FOR HIRE

If we go back into history, we learn about a master-servant relationship. What was that relationship exactly? What were the principles? Master had the sole authority over every creation of his servant. The similarity can be established here in work made for hire, the only difference is the conditions are better presently. This doctrine first was discovered in courts and later on codified in the statutes. In the 19th century, the copyright was vested at the hands of the author of the work, even if the work was done in due course of employment. At the beginning of the 20th century in 1909, when the federal copyright act was passed this doctrine emerged as an exception to authorship being treated as ownership. It was the era of industrialization and corporate sectors growing rapidly that brought it more into the trend.

JUDICIAL INTERPRETATIONS

Judiciary has played a very important role in developing this doctrine of work for hire. Even before it was in books, it was in court. Through many nations, several courts, number of judges, this doctrine has evolved and found a place in the laws.

US CASE LAWS

The first American copyright case deals with an adequate system of reporting. One of the most pressing needs of the American legal community at that time was to develop an adequate reporting system and it was a struggle to find competent reporters. Neither the government nor the courts paid any fee for the reporters, it was upon lawyers to get their reports printed at a minimum amount. Moreover, the reporters were like independent contractors. In the case of *Wheaton v. Peters*⁵, where a reporter was hired to report the dispute between other reporters, Henry Wheaton and Richard Peters. This dispute was between their publishing companies.

Henry Wheaton was the reporter from 1816 to 1827 of supreme court cases and thereafter was Peters. Richard Peters published a book and sold a volume called "*Condensed report of cases in*

⁴ Title 17, U.S. Code S. 101.

⁵ 33 U.S. 591 (1834).

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*the supreme court of united states*⁶ containing all the supreme court decisions till 1827, which also included reporting of Wheaton. Wheaton had sued for copyright infringement, whereas Peters had claimed that no statutory procedure was followed by Wheaton to obtain copyright, therefore, it was void. The court remanded that if efforts were sufficient, he would have a valid copyright, notwithstanding his employment or appointment as a reporter for the court.

In particular, the court stated that “ *no reporter has or can have any copyright in the written opinions delivered by the court; and... the judges thereof cannot confer upon any reporter any such right.* ”⁷The interpretation that can be drawn here is Wheaton could copyright whatever he has added, his own opinions, headnotes, and summary of the decision. He could not simply copyright the judges' own work. Wheaton's copyright was accepted to that extent and the court recognized this as his valuable work. Later, courts explained why the work of judges could not be copyright material- it was because judges were the public servants and the government was the actual owner of the work, this philosophy of work for hire was not given in this case but developed through interpretations.

A work specially ordered or commissioned for use is also covered under the doctrine of work for hire by various statutes. One of the earliest cases of commissioned work was *Atwill v. Ferrett*⁸, it was a theatre case that established a general rule that the writer is the author of the work, and the theatre company confers copyright on the version that has been performed in the theatre.

Before civil war, no court recognised work for hire, it was of belief that simply by virtue of employment, employer doesn't get a copyright at the work of employee. It took cases like *Heine v. Appleton*⁹, where express agreement was mandatory to assign the right to employer. It persuaded court into considering work for hire. An artist named William Heine went to an expedition to japan and china sea commanded by commodore perry. It was funded by U.S. Government. The report of his drawings was to be made to general secretary of the navy, which was to be published by the order of the congress. Later, Heine sought to publish that under his own name which he was not allowed as it was contrary to agreement.

The period of transition could be said as late 19th century, starting from 1860-1900. It is when the courts began to recognise doctrine of work for hire. The employers started emerging as

⁶ Catherine L. Fisk, Authors at Work: The Origin of Work for Hire Doctrine, Yale Journal of Law and Humanities [vol 15:1] 2003, pg 17.

⁷ Wheaton v. Peters, 33 U.S. 591 (1834).

⁸ 2 F. Cas. 195, 2 Blatchf. 39.

⁹ Heine v. Appleton, 11 F. CAS 1031 (C.C.S.D.N.Y. 1857).

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corporates and not individuals. Courts gave collective representation of author's work employed in any organisation. Major role was played by theater cases which were decided in 1860, 1861, 1862.

Another significant decision discussing this ambiguity was in *Yardley v. Houghton Mifflin Co.*,¹⁰ in this case, city of New York had commissioned an artist to paint a mural on the side of a school building. The court held that artist had impliedly given his copyright along with the work. But he still will be called creator and is subject to renewal after 28 years.

With all these cases an uncertain relationship between employer-employee could be obtained, which has been discussed in Eaton Drone's influential 1879 '*Treatise n the law of property in intellectual productions in Great Britain and the United States.*¹¹' Drone was a very influential person that time and the quotes from his book were usually cited in various judgements. He mentioned "...whether a complete legal title to the copyright will vest ab initio in such employer without the necessity of a written assignment, is a point on which the law has not been expressly declared in courts of law."¹²

UK CASES

Heard of Marvel movies? Avengers, Captain America, The X-Men and many more blockbuster comics and movies which were good reads written by Jack Kirby. Jack Kirby's contribution as an artist of these novels fairly says he is an author. He freelanced for Marvel and after his death notices were served to Marvel to recapture the copyrights of deceased father. Marvel in response claimed that they had the copyright as complying with the provisions of The Copyright Act of 1909 and Copyright Act of 1976. Kirby's children filed a certiorari petition in U.S. Supreme Court but they settled before the decision came. The court based their decision on "*Instance and expense test*". This means the employer should be the motivating factor behind creation (instance) and he should pay a certain sum of money (expense). Though it has a troubled history and is routinely misapplied by courts, the instance and expense test generally arrives at the correct outcome and prevents chilling effects on the entertainment industry. Both the acts of 1909 and 1976 are relevant to this case. As the intial is 1909 because this is when

¹⁰ *Yardley v. Houghton Mifflin Co.*, 108 F.2d 28 (2d Cir. 1939).

¹¹ *Supra* 5, pg. 48.

¹² *Supra* 5, pg 49.

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Kirby's works started. However, the 1976 Act controls the heirs' possible termination rights, since the 1976 Act retroactively grants termination rights to authors or heirs whose works are governed by the 1909 Act and were assigned to another party. The ambiguity with context to work for hire which existed in Act of 1909 was cleared by the Act of 1976. It gave copyright in respect of commissioned works to the one who is hiring along with the work. In this case the parties came to a settlement of an undisclosed sum and after which Jack Kirby's name appeared in comics as the co-creator.¹³

As evolved in the case of *Community for Creative Non-Violence v. Reid*¹⁴, in 1985 CCNV contracted with James Earl Reid, a sculptor, to produce a statue dramatizing the plight of the homeless for the annual Christmas "PAGEANT OF PEACE" in Washington, D.C., CCV conceived the idea of statue, entitled "THIRD WORLD AMERICA", as representing a modern nativity scene in which the traditional icons were replaced by a black homeless couple huddled with their baby and shopping cart on a sidewalk steam grate. Both the parties filed for copyright, on which district court granted an injunction relief. On appeal, the Court of Appeals, District Columbia Circuit, said that association do not have any copyright over the work and it would not be considered as work for hire. Section 101(2) declares nine categories and this work fails to be put in any one of them. The sculptor was independent and no written agreement existed to support the claim. Therefore, association could not claim any copyright.¹⁵ If the association had been into an express agreement with the sculptor, they could have been able to support their claims.

Prior to the United States Supreme Court's ruling in *Community for Creative Non-violence v. Reid* in 1989, the Circuits had divided on whether Before the United States Supreme Court's ruling in *Community for Creative Nonviolence v. Reid* in 1989, the Circuits had divided on whether under the 'work for hire' doctrine, independent contractors could be considered "employees." In this case, however, the Court settled the matter by adopting a strict definition of "employee". The 'work for hire' doctrine is now precluded under the Reid test. Many works that, by past criteria, would have classified as work for hire. Commissioning parties effectively lost the authority to classify such work as work for. For the vast majority of job categories, hire. Intellectual property protection is especially important for computer software. For the

¹³ Meredith Annan House, MARVEL V. KIRBY: A CLASH OF COMIC BOOK TITANS IN THE WORK MADE FOR HIRE ARENA, BERKELEY TECHNOLOGY LAW JOURNAL [Vol. 30:835].

¹⁴ *Community for Creative Non-Violence v. Reid*, 270 U.S. App. D.C. 26, 846 F.2d 1485 (1988).

¹⁵ <https://www.tulanelawreview.org/pub/volume64/issue6/community-for-creative-non-violence-v-reid>; 12-04-2022; 7:16 p.m.

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protection of intellectual property, industry almost entirely relies on copyright legislation.

INDIAN CASES

Commissioned work is also covered under work for hire as seen in various English cases. In India, the cases when we see, it exhibits the working of doctrine slightly differently. In *Gee pee films Pvt. Ltd v. PrateekChoudhary& ors.*¹⁶, the plaintiff in an oral agreement had hired the defendants for composing a Bengali music, which were released in his cassettes, the defendants released few of those songs in their own cassettes. The court granted an ex-parte injunction in the favour of plaintiff. Aggrieved by the decision, defendants filed an appeal. Important provisions on which case relied on were section 2(d) which says about author, section 2(uu) says about definition of a producer, section 17, says about first owner of the copyright act. The main issues raised were that whether plaintiff was the actual owner of the work in respect of recordings or whether any infringement was done by the defendants? In the appeal, plaintiff failed to prove a prima facie evidence and therefore the case flipped and went to defendant's favour. The word 'responsibility' in section 2(uu), does not only mean financial responsibility but also consequential responsibility. The necessary legal steps were to be taken by the plaintiff but he failed to do so. Therefore, the fact is clear that if he had been able to prove prima facie evidence, the case was clearly in his favor. As in agreement to the contrary, employer gets copyright on the commissioned works of employee.

Where does the problem lie?

The problem lies in analyzing who is the author of the work, from the case laws we determine it can be a creator or the employer too. It sounds simple right? Copyright of commissioned works is held by employer and the concept of contact of service and contract for service prevails. But when it comes to reality, apart from statements, the circumstances are different and the problems are real.

In a leading case of *IPRS V. ENIL*¹⁷, the matter has been dragged for over a decade, the case was filed by IPRS in 2006 when the violation of copyright was done by ENIL (Mirchi Studio). They have signed the broadcasting of music together in six cities but ENIL broadcasted in three new cities, without procuring the prior permission of IPRS. Therefore, they sought for

¹⁶*Gee pee films Pvt. Ltd v. PrateekChoudhary& ors*, 2002 (24) PTC 392.

¹⁷ *IPRS V. ENIL*, 2011(46) PTC 362 (DEL).

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injunction and damages for the same.

Another suit was filed by IPRS and PPL against CRI Events Private Limited. This private management company had played their music without obtaining prior permission from PPL and IPRS. They sought a) a permanent injunction prohibiting them from making sound recordings of PPL's repertoire available to the public by mechanical devices or other methods, as well as from making literary and/or musical works from IPRS's repertoire available to the public; and (b) damages. Both suits were consolidated by the Delhi High Court, and on January 4, 2021, a judgement was issued that established certain principles-

- If a sound recording has distinct copyright, the sound recording's radio diffusion cannot be a violation of the copyright in the literary work or the copyright in the musical work, which are not transmitted to the public by radio diffusion but are communicated as part of a larger whole having an independent statutory existence.
- Once the Act before 2012 has been interpreted as, the right vested into owner if he has obtained license is absolute, and the author of the work has given consent to it, he cannot claim any infringement. But, if license has not been obtained, no claim could be made.
- • That owners of copyright in literary and musical works do not have the right to sue for infringement if their work is only made available to the public as part of sound recordings that they have approved. Otherwise, they maintain the right to prevent anyone from sharing their work with the public in any way other than through sound recording, as held in the judgment on the application for interim relief in CS(OS) No.1996/2009 [*e. CRI Events case*] and upheld by the Division Bench of the Delhi High Court as well as the Supreme Court in the AdityaPandey case. **Thus, if there is a live performance of songs incorporating the literary and musical works of members of IPRS, even if such songs also have a sound recording, for such live performance, license from IPRS will be necessary.**
- The 2012 amendment does not change the Act's provisions on interpretation, according to which it was held in the cited judgments that communication to the public of underlying literary and musical works as part of a sound recording under authorisation/licence from the owner of the copyright in the sound recording does not require authorisation/permission from the owner of the copyright in the underlying literary and musical works. **As a result, Section 19(10) states that the assignment**

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of copyright in any work to make a sound recording that is not part of a cinematograph film does not affect the author's right to an equal share of royalties and consideration payable for any exploitation of the work in any form., it cannot be assumed that the use of the work as embodied in the sound recording entitles the owner of the copyright to an equal share of the royalties and consideration due for the sound recording. To read it otherwise would render the other requirements otiose, based on the assumption that no permission is necessary from owners of copyright in the underlying works of the sound recording when sending the sound recording under copyright in sound recording authorization. Any interpretation that renders another legislation provision redundant or otiose must be avoided, and the harmonious construction rule must be implemented. **As a result, Section 19(10) must be read as not affecting the right of the author of the underlying works in sound recordings to claim a share of the royalty payable for the use of such works in any form, even if identical to the sound recording, as held by the Single Judge in the interim relief judgement in CS(OS) No.1996/2009.**

- The revision of the Act of 2012, even if applied, does not modify the legal situation as stated in the aforementioned judgements.
- Thus held (i) that in case the defendants wish to perform the sound recordings in public, i.e. play them, a license from PPL is essential; (ii) in case the musical works are to be communicated or performed in the public, independently, through an artist, the licence of IPRS is essential; (iii) in case the defendants wish to hold an event involving performances or communication of works of both kinds to the public, the licence or authorisation of both, PPL and IPRS is essential; and, (iv) of permanent injunction restraining the defendants from acting contrary to the aforesaid directions, and leaving the parties to bear their own costs.

WORK FOR HIRE IN SOFTWARE INDUSTRY

The software business was exempted from the United States' work-for-hire provisions. The 1976 Copyright Act was enacted to protect intellectual property. By 1965, all of the statutory languages for these provisions had been worked out. The software business was essentially non-existent at the time, and as a result, it was unable to safeguard its interests. In general, artists are

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regarded to have fewer negotiating leverage than hiring parties. Unlike regular employees, independent contractors are self-employed. Employees do not have access to collective bargaining as a means of addressing the problem. The commissioning parties are often in a better financial situation. The existing doctrines, this helps compensate for the fact that most work is not available for hire. The theory safeguards creators by prohibiting hiring parties from discriminating against them authoring rights are being negotiated. Almost always, the hiring parties would agree to an assignment of all rights in the finished work. However, as the statutory author of a work, the authors retain the ability to terminate assignments after 35 years. It is important to note that, under section 203(3) of the US Copyright Act, 1976, the grant may be terminated at any time during a five-year period beginning at the end of 35 years from the date of execution of the grant; or, if the grant covers the right of publication of the work, the period begins at the end of 35 years from the date of publication of the work under the grant or whichever comes first: the date of publication of the work under the grant or the end of the award's period of forty years, whichever comes first.

This power of termination allows the creator to renegotiate the contract and, as a result, share in the profit from an unexpectedly successful work. However, in the software sector, this privilege to terminate an assignment is effectively worthless. Software has a relatively short shelf life on the market. The market for the software will very definitely have evaporated by the time a creator has the opportunity to exercise a termination right.

As a result, the theory fails to provide any meaningful protection to innovators in this field.

The software industry is unique, and deserves unique treatment under the doctrine. Computer software differs notably from other copyrightable subject matter. Much of the value of software comes from its utilitarian rather than its aesthetic aspects. This utilitarian nature of software possibly rationalizes a shorter term of protection. Today, more than fifty percent of the of the software market involves customized software transactions with enormous dollar values and extensive negotiations directly with the software developer.¹⁸ Thus, there is a need to modify the work for hire doctrine to account for some of the unique characteristics of the industry. Practically speaking, an industry specific exception in the legislation would be viable. It would build on existing law, with small effect on already recognized copyrights. It may also provide a model for such modifications to serve the unique features of other industries. There is a need for the express law in the field of software Industry relating to the subject matter of work for hire

¹⁸ Joel Rothstein Wolfson, Contract and Copyright are Not at War, 87 CALIFORNIA L. R. 79, (January 1999).
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doctrine. With the continuous development in this industry, the laws are the way to solve disputes which may arise or can even prevent such disputes from arising.

CONCLUSION

The Doctrine of Work for Hire is still an emerging concept in the copyright. The emergence of this concept took place in early 20th century and late 19th century. The law evolved from courts, as the matter relating to one's rights came in the form of disputes in court. The disputes vary from case to case, the difference between the contract of service and contract for service may seem minor, but it turns the case upside down. As the analysis made with judicial interpretations of different countries, we realise that the doctrine of working is more or less same. Indian Copyright law do not expressly say about it, but U.S. Copyright Law explicitly mentions this doctrine. The opinions of various judges are based on the sole purpose of giving ownership rights, economically, and morally. Moral rights of the author are many times a proven base to decide the case in favour of the author as the right of paternity cannot be taken away. Disputes are not only for economic rights as one may assume, but also for moral rights, for the credits. Software Industry is a developing industry in the field of Copyright and the requirement of this doctrine will increase here as the developers are well aware of the facts and circumstances. Software industry works on the hire basis, it seems difficult to protect the interests of the employer and employee at the same time. The precedents and the doctrine of work for hire, prevails in such cases. Assignment is also somewhere covered under the doctrine but it is a whole different concept and not to be misunderstood. Owners get justice and enjoy their right, this is the purpose of this doctrine.

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