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Then, You Had It, Now It's Gone: Interspousal or Community Property Transfer and Termination of an Illusory Ephemeral State Law Right or Interest in Copyright

Llewellyn Joseph Gibbons
University of Toledo College of Law

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Cover Page Footnote

Professor, University of Toledo College of Law. The author would like to thank his colleagues at the University of Toledo College of Law, especially Bruce Kennedy and Kara Bruce, for their comments when this article was still a half-baked idea, the participants in the Franklin Pierce Intellectual Property Law Center (University of New Hampshire) Intellectual Property Scholars Conference for their insightful comments, and, of course, many intellectual property and family law colleagues, who patiently listened to my discussion of this article over coffee, dinner, and drinks: you know who you are so I need do no more than say thank you once again. This article is dedicated to my truly great colleague, friend, mentor, and family law expert, Professor Robin M. Kennedy— thank you and much happiness to you and Cindy in your long postponed and well deserved new career as a retirees.

Then, You Had It, Now, It's Gone: Inter-spousal or Community Property Transfer and Termination of an Illusory Ephemeral State Law Right or Interest in a Copyright

Llewellyn Joseph Gibbons*

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“He laughs best who laughs last.”

—Sir John Vanbrugh (1664-1726)

Often in the case of a marriage where one partner is a creative spouse, the primary marital asset is a body of copyrighted works. In 2013, author-spouses entered the period when they may begin to terminate any putative copyright transfer to the community property estate or terminate other transfers that may be the basis for prenuptial or postnuptial agreements, property settlements, or dissolution decrees in divorce actions. Section 203 of the 1976 Copyright Act provides that an author may unilaterally terminate a transfer of copyright approximately thirty-five years after the initial transfer. In community property states, state law assumes that through the magic of the operation of state law, the author-spouse transfers the copyright that federal law initially vests in the author to the community property (marital) estate. This Article will analyze whether an author-spouse may terminate the transfer of copyright in the context of a domestic relationship. It concludes that in the context of copyright termination, the domestic relationship, and state law, the author-spouse will always be able to nullify the carefully ordered state law presumptions for domestic relations and the possible ensuing dissolution of the marital union.

INTRODUCTION

In the 2002 motion picture *About A Boy*, the protagonist Will Freeman, played by Hugh Grant, lives a life of self-indulgence living off the royalties of a hit song written by his deceased father.¹ This Article will shift the plot of *About a Boy* to focus on the rights of a spouse to income from a copyrighted work created during a marriage. In our hypothetical plot revision, the protagonist Will Freeman's parents get divorced. The sole or most valuable asset is still the copyright in the song. The topic of this Article is: "What would be Freeman's mother's copyright interest in the song?"² Under the two cases that have addressed this issue in community property states, she would be entitled to at least one-half of the economic interests in the copyright, if not actually entitled to co-ownership with both economic and management rights over the copyright.³ In the case of Freeman's song, this would at first blush be at least a fair, if not generous, property settlement.

However, federal Copyright law adds a confounding variable to whatever rights state domestic relations law may grant to a spouse (or a divorced spouse). Federal law provides that the author may terminate a transfer of a copyright approximately thirty-five years after the initial transfer.⁴ Although two courts have addressed the spouse's rights to a property interest in a

¹ Brian Warner, *Is It Really Possible To Retire Off Royalties From One Hit Song?*, Celebrity Net Worth (March 1, 2013), available at <http://www.celebritynetworth.com/articles/entertainment-articles/is-it-really-possible-to-retire-off-royalties-from-one-hit-song>. This article also gives numerous examples of the revenues derived by a songwriter from a single song.

² Actually, the question is more complicated. In the movie, Freeman lives in London, England, so whatever rights the spouse may have would be governed by the United Kingdom's copyright law for the works in the UK, and by United States law for works in the United States. See generally Patricia Scahill, Note and Comment, *U.S. Copyright Law and Its Extraterritorial Application: Subafilms, Ltd v. GM-Pathe Communications*, 19 MD. J. INT'L L. & TRADE 293 (1995), available at <http://digitalcommons.law.umaryland.edu/cgi/viewcontent.cgi?article=1448&context=mjil>.

³ See *infra* Part I.A-B (*In re Marriage of Worth*, 241 Cal. Rptr. 135 (Cal. Ct. App. 1987); *Rodrigue v. Rodrigue*, 55 F. Supp. 2d 534 (E.D. La. 1999), *rev'd on other grounds*, 218 F.3d 432 (5th Cir. 2000)).

⁴ 17 U.S.C. § 203(a)(3) (2012).

copyright,⁵ no court has yet addressed a spouse's interest in preventing the author-spouse from exercising the copyright termination right. There are at least two scenarios where an author-spouse may use his or her rights as an author in a manner that a divorced spouse (or domestic relations court) may find abusive. First, an author-spouse could refuse to terminate an unrenumerative transfer of copyright in order to punish a spouse (by denying that spouse larger potential royalties in the future). Second, an author-spouse could end the divorced spouse's economic or property interest in the copyright by terminating the community property transfer in a community property state or by terminating rights granted under prenuptial, antenuptial, settlement agreements, or court orders. Surprisingly, the three major treatises on copyright law have yet to opine on this timely topic.⁶ Therefore, this Article will attempt to lay the groundwork for further scholarship in this area.

As of 2013, the questions surrounding the exercise of termination of transfer rights under Copyright law are important because the 1976 Copyright Act provides that an author may terminate a grant of a transfer of the United States copyright right approximately thirty-five years after the initial transfer.⁷ Authors have finally reached the window in which they may begin to exercise their termination of transfer rights. Therefore, these disputes are becoming ripe for the purposes of judicial review. Although outside the domestic relations context, some current examples of the potential problems created by the termination of transfer rights involve iconic comic book characters: Superman, Spiderman, Iron Man, the Incredible Hulk, Thor, and the Fantastic Four.⁸ These are examples of iconic comic book characters that

⁵ See *In re Marriage of Worth*, 241 Cal. Rptr. 135; *Rodrigue v. Rodrigue*, 218 F.3d 432.

⁶ See generally PAUL GOLDSTEIN, *GOLDSTEIN ON COPYRIGHT* (3d ed, 2005); MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* (1989); WILLIAM F. PATRY, *PATRY ON COPYRIGHT* (2012).

⁷ 17 U.S.C. § 203(b); 7 WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 25:74 (2012); see also 17 U.S.C. § 304 (2012) (permitting the termination of rights in copyright extension terms).

⁸ See Vincent James Scipor, Comment, *The Amazing Spider-man: Trapped in the Tangled Web of the Termination Provisions*, 2011 WIS. L. REV. 67, 68 n.1, 99 (2011).

are potentially worth billions of dollars to the heirs of their creators and will remain valuable into the foreseeable future.⁹ Termination of copyright transfers may also be a significant issue in the commercial software context.¹⁰ The dilemma of the modern software industry is that it came of age under a then-indeterminate brand new copyright regime, and now it faces the reality of the termination of copyright transfers on dates certain. A little over a decade ago during the period of time leading up to the millennial “Y2K” crisis, the software industry and its clients learned to their mutual chagrin that modern computer programs were built on up to forty-year-old legacy backbones.¹¹ Today, modern software may still contain thirty-five-year-old copyrighted code that is subject to the termination of transfer of the copyright grant. Thus, in order to continue to use the software, the current proprietor may have to unravel and remove copyrighted legacy software routines at significant expense or to come to a new agreement with the current owner of the copyright termination right.¹²

⁹ See generally Mike Mintz, *Top 5 Comic Book Lawsuits*, MARTINDALE-HUBBELL, (July 22, 2010), <http://blog.martindale.com/top-5-comic-book-lawsuits-in-honor-of-comic-con>.

¹⁰ Cf. Jon L. Phelps, *Copyleft Termination: Will the Termination Provision of the Copyright Act of 1976 Undermine the Free Software Foundation’s General Public License?*, 50 JURIMETRICS J. 261, 269–73 (2010) (discussing termination of copyright transfer in the FOSS context, but the legal principles apply with equal force to the commercial software industry). Whether 17 U.S.C. § 117’s fair use provisions would be of significant assistance to the commercial entity whose copyright has been terminated is an open question. *Id.* at 269–73.

¹¹ See William Evan & Mark Manion, *MINDING THE MACHINES: PREVENTING TECHNOLOGICAL DISASTERS* 76 (2002) (measuring the cost of fixing Y2K at \$400–\$600 billion). Much of the Y2K fix consisted of patches to overcome problems relating to the date rather than the removal and creation of new software elements. *Id.* at 73–76.

¹² For example, much of the Internet and World Wide Web is dependent on software that is commonly considered to be in the public domain (or under global royalty free licenses) because the authors did not assert a copyright—perhaps for idealistic reasons, ignorance, or they did not realize the commercial value of what they created. See, e.g., *NCSA Mosaic*, GOVERNINGWITHCODE.ORG, http://www.governingwithcode.org/case_studies/pdf/NCSA_mosaic.pdf (last visited Jan. 21, 2014). However, national laws in Berne Convention countries automatically granted the software author copyright protection—regardless of the desires or intent of the authors. However, there may be laches, acquiescence, express or implied non-exclusive licenses available to current users as defenses so as to create a de facto quasi-public domain for current and historic uses of these works. This is no longer true now that the author (or the author’s statutory heirs)

The problems facing the creative and commercial copyright industries are further compounded in light of the unsettled state of Copyright law immediately after the enactment of the 1976 Copyright Act.¹³ While many followers of the software industry remember the 1990s as their golden years, many important software giants were founded in the 1970s—shortly before or after the 1976 Copyright Act was passed into law.¹⁴ The 1970s and 1980s saw the founding of major software or Internet companies, for example: Foxconn (1974), Microsoft (1975), Apple (1976), 3COM (1979), Oracle (1979), Logitech (1981), Compaq (1982), Electronic Arts (1982), Adobe (1982), etc.¹⁵ Among the commercially significant copyright issues that were debated during this period were the appropriate standard for determining a work-for-hire,¹⁶ and whether computer software was copyrightable subject matter.¹⁷ Although in 1980, Congress amended the 1976 Copyright Act in response to the National Commission on New Technological Uses of Copyrighted Works (CONTU) report to “make it explicit that computer programs, to the extent that they embody an author’s original creation, are proper subject matter for copyright” and “to ensure that rightful possessors of copies of

have a termination of copyright transfer right, these rights may be recaptured. Equitable defenses to copyright infringement may not be available. Courts sitting in equity will probably hold that if statutorily an author can terminate a positive grant of a transfer of copyright despite any express agreement to the contrary then the prudential principles behind equitable defenses suggest that equitable defenses should also yield to statutory Copyright law. *Cf. Lego A/S v. Best-Lock Const. Toys, Inc.*, 874 F. Supp. 2d 75, 90–92 (D. Conn. 2012) (equitable doctrine of laches does not trump statute of limitations).

¹³ See, e.g., Dale P. Olson, *Copyright and Fair Use: Implications of Nation Enterprises for Higher Education*, 12 J.C. & U.L. 489, 497 (1986) (originality); James B. Wadley & JoLynn M. Brown, *Working Between the Lines of Reid: Teachers, Copyrights, Work-For-Hire and a New Washburn University Policy*, 38 WASHBURN L.J. 385, 428–29 (1999) (teacher exception); Vivian F. Wang, *Sale Or License? UMG v. Augusto, Vernor v. Autodesk, And The First Sale Doctrine*, 19 TEX. INTELL. PROP. L.J. 1, 2 (2010).

¹⁴ See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 459 n.3 (1983).

¹⁵ *Computer History for 1960 - 1980*, COMPUTER HOPE, <http://www.computerhope.com/history/196080.htm> (last visited Oct. 28, 2013).

¹⁶ See *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 736 n.2, 738–39 (1989).

¹⁷ See *Whelan Assoc., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1241–42 (3rd Cir. 1986) *cert. denied*, 479 U.S. 1031 (1987).

computer programs may use or adapt these copies for their use.”¹⁸ The scope of copyright protection in a computer program continued to be hotly contested over subsequent years.¹⁹ Also, the legal question regarding the definition of employee for the purposes of creating a work-for-hire is important because if a copyrighted work is a work-for-hire, then the copyright vests in the employer, and there is no termination of transfer right.²⁰ The definition of employee for the purposes of determining whether copyrighted work was a work-for-hire was not authoritatively resolved until 1989, eleven years after the effective date of the 1976 Copyright Act.²¹ So for a critical period of eleven years in the evolution of the Internet and the maturation of the software industry, copyright law was unclear. There were four competing definitions of employee used in different circuits. Curiously, the Ninth Circuit, the home of much of the software industry, did not opine on the work-for-hire definition of employee until 1989 and then it erroneously held that only formal salaried employees are employees under the work-for-hire provisions of the 1976 Copyright Act.²² So, the Ninth Circuit, as well as the rest of the United States, with the exception of the Fifth Circuit and D.C. Circuit (whose interpretation eventually prevailed), was at best indeterminate or affirmatively wrong.²³ Consequently, it would be unsurprising to find that some commercial software entities tied their intellectual property rights in software on uncertain legal moorings based on the circuit law then in effect.²⁴

¹⁸ *Jaslow Dental Lab.*, 797 F.2d at 1241 (quoting National Commission on New Technological Uses of Copyrighted Works, Final Report 1, (1978)).

¹⁹ *See, e.g., Computer Assocs., Int'l v. Altai*, 982 F.2d 693 (2d Cir. 1992); *Lotus Dev. Corp. v. Paperback Software Intern.*, 740 F.Supp. 37 (D. Mass. 1990).

²⁰ *Cnty. for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1490 n.7 (1988).

²¹ *See Cnty. for Creative Non-Violence v. Reid*, 490 U.S. at 736 n.2, 738–39 (describing four different tests used by the regional circuit courts to determine whether a work is a work-made-for-hire under the 1976 Copyright Act).

²² *See Dumas v. Gommerman*, 865 F.2d 1093, 1102 (9th Cir. 1989), *rejected by Cnty. for Creative Non-Violence v. Reid*, 490 U.S. at 742 n.8 (1989).

²³ *See Cnty. for Creative-Non Violence v. Reid*, 490 U.S. at 739.

²⁴ *See, e.g., Ian DeBernardo, Updates in Science and Technology Law – Software*, 1 B.U. J. SCI. & TECH. L. 11, 41 (1995) (assuming the *Altai* decision “will undoubtedly cause software companies to reevaluate their use of copyright protection”); Jack M. Haynes, *Computer Software: Intellectual Property Protection in the United States and*

That assumes that the legal niceties of Copyright law were never seriously considered in the early days of the software industry or in the entertainment industry. Even by the early 1990s after the courts established the essential contours of the 1976 Copyright Act, the lackadaisical attitudes of software and entertainment companies towards copyright niceties arguably continued to persist well into this most recent 35-year period.²⁵ This attitude is typified in *Effects Associates, Inc. v. Cohen* where the Ninth Circuit noted:

Cohen suggests that section 204's writing requirement does not apply to this situation, advancing an argument that might be summarized, tongue in cheek, as: Moviemakers do lunch, not contracts. Cohen concedes that "[i]n the best of all possible legal worlds" parties would obey the writing requirement, but contends that moviemakers are too absorbed in developing "joint creative endeavors" to "focus upon the legal niceties of copyright licenses."²⁶

Consequently, the current creative content industries, and especially those companies with a significant dependency on legacy software or immediate post-1976 Copyright Act works, may be surviving on the inertia of the author, non-exclusive licenses granted through conduct, and possible infringement claims that may be barred by the statute of limitations or equitable doctrines such as laches, or acquiescence. The ability to terminate the transfer of an interest in copyright may motivate authors to recapture lost value and for those already so motivated, free them from any equitable defenses to copyright infringement that may have developed over the passing decades. Companies and business models that are based on doubtful legal rights to use copyrighted

Japan, 13 J. MARSHALL J. COMPUTER & INFO. L. 245, 257 (1995) (recognizing that contemporary software vendors are advised to protect their software by utilizing a multi-tiered strategy involving copyright coupled with licensing and trade secrets).

²⁵ See, e.g., *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555 (9th Cir. 1990); *Rouse v. Walter & Assocs., L.L.C.*, 513 F. Supp. 2d 1041, 1055–56 (S.D. Iowa 2007); *BPI Sys., Inc. v. Leith*, 532 F. Supp. 208, 211 (W.D. Tex. 1981).

²⁶ *Effects Assocs. Inc. v. Cohen*, 908 F.2d at 556–57.

works may be cast into chaos if the current possessors of the right to terminate copyright transfers elect to exercise them.

This Article will review the two cases involving post-dissolution ownership of a copyright to works created during the marriage to set the stage for its analysis of whether, under Copyright law, an author-spouse may terminate the putative transfer to the community property estate by operation of state law.²⁷ The Article will then consider whether an author may terminate a transfer by voluntary agreement in a prenuptial, antenuptial, or settlement agreement, or terminate a transfer that takes place involuntarily through a court order.²⁸ Under § 203(a) of the Copyright Act, transfers by operation of state law or through voluntary contract-like agreements should be terminable by the author spouse or the author-spouse's statutory heirs. However, state courts may attempt to frustrate an author's (or statutory heirs') attempt to terminate a copyright transfer through their contempt-of-court powers, but such contempt orders should be preempted by federal law. Accordingly, whatever plans laid by mice, men, or the states, the author-spouse will always enjoy the last laugh and the right to terminate the copyright transfer. If this is not the copyright policy result that Congress sought to achieve then Congress must change the default rules. By either enacting a new Copyright law so that it expressly grants greater deference to state law or state courts in domestic relations matters or by creating an independent federal balance of copyright interests expressly weighing domestic relations and state family law interests in an author's exercise termination of copyright, Congress may fulfill its constitutional duty to promote the "Progress of Science and the useful Arts"²⁹ and the public policy goals of respecting the states' domestic relations law and their obligation to regulate domestic relations law.

²⁷ See *infra* Part I.A-B.

²⁸ See *infra* Part II.

²⁹ U.S. CONST. art. I, § 8, cl. 8.

I. COPYRIGHT AS A COMMUNITY OR MARITAL PROPERTY RIGHT

First, it is not clear that an interest in a federally granted copyright should be transferable through the operation of state law.³⁰ In two highly contentious divorce cases in community property states, courts have found that, through operation of state law, the copyrights to works created during marriage vested in the marital estate in the form of community property and were subject to division upon dissolution of the marriage.³¹ The intersection of copyright and state domestic relations law is further confounded by the status of termination rights in copyrighted works in equitable distribution states and the unclear answers to the copyright-property questions presented by peripatetic married couples that accumulate quasi-community property that must also be considered in the course of a dissolution proceeding.³² However, as noted by one commentator:

In recent years, all state courts [including those in equitable distribution jurisdictions] that have addressed the issue have either assumed or explicitly held that copyrights, and the royalties therefrom, are marital (or community) property to the extent that the copyrighted work or profits therefrom were generated by spousal labor during marriage[.]³³

³⁰ See Alice Haemmerli, *Take It, It's Mine: Illicit Transfers of Copyright by Operation of Law*, 63 WASH. & LEE L. REV. 1011, 1043–44 (2006); Scott M. Martin & Peter W. Smith, *The Unconstitutionality of State Motion Picture Film Lien Laws (or How Spike Lee Almost Lost It)*, 39 AM. U. L. REV. 59, 91–92 (1989); see also 3-10 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 10.04 (1989) (“By its terms Section 201(e) is not limited to acts by governmental bodies and officials. It includes acts of seizure, etc., by any ‘organization’ as well. It is, moreover, not limited to such acts by foreign governments, officials, and organizations.”); 2 PATRY, *supra* note 7, § 4:76 (“Any involuntary transfer should be void under the plain language of section 201(e) . . .”).

³¹ *In re Marriage of Worth*, 241 Cal. Rptr. 135, 136 (Cal. Ct. App. 1987); *Rodrigue v. Rodrigue*, 55 F. Supp. 2d 534 (E.D. La. 1999), *rev'd on other grounds*, 218 F.3d 432 (5th Cir. 2000).

³² See Llewellyn Joseph Gibbons, *Love's Labor's Lost: Marry for Love, Copyright Work Made-For-Hire, and Alienate at Your Leisure*, 101 KY. L.J. 113, 134–35 (2012-2013).

³³ 2 MATTHEW BENDER & CO., VALUATION AND DISTRIBUTION OF MARITAL PROPERTY §23.07 (1998).

These judicial holdings are highly contested in the law review literature;³⁴ but generally, leading copyright commentators accept these cases as articulating the correct federal law of copyright.³⁵

In re Marriage of Worth and *Rodrigue v. Rodrigue* are the two leading, and possibly only, cases under the 1976 Copyright Act involving a dispute between spouses over the ownership of a copyright in a community property jurisdiction. These cases are not especially instructive as to the legal mechanics, procedures, or processes by which copyright transfer takes place; nor do they address the point in time of the initial transfer of copyright—other than to find that by operation of state law that a transfer did take place at some point during the marital relationship. Each case reached a similar result. However, each case arrived at its result through a different theory or process of state law.³⁶ These cases are useful only in that both cases found that a process of state law transferred some right associated with the author's copyright from the author which transformed it to community property, and that they serve as a convenient starting point to determine when the initial transfer of copyright takes place in a community property state.

A. *In re Marriage of Worth*

In re Marriage of Worth presented the first opportunity for either a state or federal court to opine on the ownership of a copyright, under the 1976 Copyright Act, of a work created during

³⁴ See, e.g., Dane S. Ciolino, *How Copyrights Became Community Property (Sort of): Through the Rodrigue v. Rodrigue Looking Glass*, 47 LOY. L. REV. 631, 632 (2001) (describing the court as “constructing a curious new regime[,]” which was a resolution that neither party argued in the briefs before the court of appeals); Francis M. Nevins, Jr., *To Split or Not to Split: Judicial Divisibility of the Copyright Interests of Authors and Others*, 40 FAM. L.Q. 499, 517 (2006) (depicting the *Rodrigue* appeals court as “boldly innovative and diabolically clever[.]”).

³⁵ See PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 5.1 (3d ed. 2005); NIMMER, *supra* note 30, § 6A.03; 2 PATRY, *supra* note 7, § 5:116.

³⁶ Compare *Rodrigue v. Rodrigue*, 318 F.3d 432, 435 with *Worth*, 241 Cal. Rptr. at 138 (the court in *Marriage of Worth* considered a copyright created during a marriage as a divisible community asset while the court in *Rodrigue* reasoned that the economic benefits of the copyrighted work, as opposed to the copyright itself, belong to the community).

the marriage in a community property state (California).³⁷ Prior to the decision in *Worth*, the parties had already agreed to allocate their respective interests in the royalties resulting from the copyrighted works created during the marriage.³⁸ The author-spouse then commenced a copyright infringement action against the producers of the “Trivial Pursuit” board game.³⁹ The divorced-spouse sought an order for one-half of the proceeds, if any, from the copyright infringement action.⁴⁰ The *Worth* court had to reconcile California’s community property law principle that all property acquired during a marriage is community property with § 201(a) of the 1976 Copyright Act’s provision “vesting initial” ownership of the copyright in the individual author(s).⁴¹ California’s community property law assumes a partnership model and that each spouse makes an equal contribution to the marriage and shares equally in the wealth accumulated during marriage.⁴² Copyright law on the other hand reflects constitutional and statutory policy determinations that if *authors* are granted a limited period of exclusivity to exploit the market for the copyrighted work, this economic incentive will promote the “Progress of Arts and Sciences” by encouraging *authors* to be more productive and to disseminate their works to the public.⁴³ Without affirmative action by Congress, the federal goals of encouraging authors and the state goals of stability and harmony in family life, while not necessarily inconsistent, may in fact be irreconcilable.

³⁷ *Worth*, 241 Cal. Rptr. at 136–37. California has a *sui generis* statutory law of community property. See WILLIAM BASSETT, BASSETT ON CALIFORNIA COMMUNITY PROPERTY LAW § 1:4 (2011 ed.).

³⁸ *Worth*, 241 Cal. Rptr. at 136.

³⁹ *Id.* at 135.

⁴⁰ See *Worth v. Selchow & Righter Co.*, 827 F.2d 569 (9th Cir. 1987); *Worth*, 241 Cal. Rptr. at 135 n.1.

⁴¹ *Worth*, 241 Cal. Rptr. at 136–37.

⁴² *Id.* at 136.

⁴³ See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (the limited monopoly conferred by the Copyright Act “is intended to motivate creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired”); see also *New York Times Co. v. Tasini*, 533 U.S. 519–20 (2001) (Stevens, J., dissenting).

First, the *Worth* court considered the “vests initially” provision of § 201(a) of the 1976 Copyright Act in conjunction with § 201(d)(1), which provides that copyright ownership may transfer by operation of (California) state law.⁴⁴ The *Worth* court concluded that California’s community property laws *simultaneously* with the federal 1976 Copyright Act vesting the author-spouse with the copyright transferred a legal interest in that copyright to the non-author spouse in the form of community property.⁴⁵ Having concluded that federal copyright law permitted the transfer of a copyright by operation of state law from the author to the community property estate, the *Worth* court then had to consider whether a copyright was the type of property that could be assigned through California state community property law.⁴⁶

California law excludes some intangible assets such as a professional license in allocating community property; because, community property only exists prior to the dissolution of the marriage.⁴⁷ The *Worth* court distinguished a professional license to practice law, medicine, or a skilled-trade acquired during marriage from a copyright to a work created during the marriage by holding that “[a] copyright has a present value based upon the ascertainable value of the underlying artistic work. Its value normally would not depend on the [post-marital] efforts of the authoring spouse but rather on the tangible benefits directly or indirectly associated with the literary product.”⁴⁸ As a matter of common sense, ordinary experience and the facts in the *Worth* case themselves demonstrate that this conclusion regarding the future value of a copyright not depending on the efforts of the author-spouse is clearly wrong.⁴⁹ However, the *Worth* court succinctly

⁴⁴ See *Worth*, 241 Cal. Rptr. at 136–38.

⁴⁵ See *id.* at 139; see also *Rodrigue v. Rodrigue*, 55 F. Supp. 2d 534, 537 n.2 (E.D. La. 1999) (“The only reported case [*Worth*] on this subject concluded, with little analysis, that the Copyright Act does not preempt community property law.”).

⁴⁶ *Worth*, 241 Cal. Rptr. at 139.

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ For example, in *Worth*, at dispute was a share of the damages as a result of a copyright infringement action. This damage award would be a clear result of the post-dissolution efforts of the author-spouse. *Id.*; see also *Roddenberry v. Roddenberry*, 51 Cal. Rptr. 2d 907 (Cal. Ct. App. 1996) (involving a dispute over the profits resulting from

found that the copyright had been transferred to the community property estate, and it halved all incidents of the copyright without adequately considering whether federal copyrights are a *sui generis* species of claims to economic revenues separate from the management rights. The court also failed to consider whether copyright interests were susceptible to judicial cleavage without damaging the delicate policy balance struck by Congress weighing the author's incentive to create and disseminate works against the public's need for access and use of copyrighted works through clear property rights in the work.

B. Rodrigue v. Rodrigue

In *Rodrigue v. Rodrigue*, the federal courts interpreted copyright ownership for the first time in the context of a state domestic relations dispute.⁵⁰ The district court in *Rodrigue* was unable to harmonize the conflict between state community property law and federal law and held that federal law preempted Louisiana's state community property law purporting to transfer the copyright from the author-spouse.⁵¹ However, the United States Court of Appeals for the Sixth Circuit claimed to achieve some measure of harmonization between state and federal law; and it found that there was no federal preemption of Louisiana state community property law.⁵² On appeal, the *Rodrigue* court interpreted the text of § 201(a) of the 1976 Copyright Act to only convey the exclusive right to the § 106 copyright "rights" to the author without vesting the corresponding economic rights in the author.⁵³ Under this strained interpretation, only the 1976 Copyright Act's § 106 enumeration of exclusive rights of

21 years of post-dissolution efforts by the author-spouse to revive Star Trek and ultimately to create the Start Trek franchise).

⁵⁰ See *Rodrigue v. Rodrigue (Rodrigue I)*, 55 F. Supp 2d 534, 540–46 (E.D. La. 1999) (finding federal preemption of Louisiana community property law), *rev'd on other grounds*, 218 F.3d 432, 439 (5th Cir. 2000) (straining to construe Louisiana community property law as consistent with the Copyright Act).

⁵¹ *Rodrigue v. Rodrigue (Rodrigue II)*, 218 F.3d at 547.

⁵² *Id.* at 435.

⁵³ *Id.* at 435–36. These property law principles may be *sui generis* to Louisiana as a civil code jurisdiction and severely limit *Rodrigue II* as persuasive authority in the Fifth Circuit much less nationally. See also Nivens, *supra* note 34, at 517–18.

reproduction, adaptation, publication, public performance, and public display were initially vested in the author.⁵⁴ The *Rodrigue* court then carefully noted that § 106 does not use the term “owner” or “ownership” nor does it refer to the concomitant economic rights of copyright ownership.⁵⁵ Although citing *Worth* on the issue of the copyright right vesting in the author, the *Rodrigue* court then departed from the *Worth* court in its legal analysis and found that the author-spouse was the sole author and the other spouse was not a co-author under Copyright law.⁵⁶

The *Rodrigue* court avoided the thorny practical issue of title and co-ownership created by the *Worth* court by recognizing that Congress vested title in the author-spouse.⁵⁷ The *Rodrigue* court then *sua sponte* used principles of Louisiana property law and divided the author’s copyright into functional property rights such as the “(1) *usus*-the right to use or possess,” “(2) *abusus*-the right to abuse or alienate,” and “(3) *fructus*-the right to the fruits.”⁵⁸ Under this novel interpretation of Louisiana state law, the author-spouse individually owned the legal rights associated with the *usus* and *abusus* of the copyright while the economic rights associated with the *fructus* of the copyright were either owned jointly-by-the-spouses or jointly-owned through the marital estate by operation of Louisiana state domestic relations law.⁵⁹ This novel division of personal intangible property rights did not clearly map a Copyright law, common law, or even a civil law understanding of property law.⁶⁰

These two cases, although buttressed by the [endorsement](#) authors of well-known treatises, have been the subject of stinging academic commentary, and therefore, may not be a solid

⁵⁴ *Rodrigue II*, 218 F.3d at 435–36.

⁵⁵ *Id.*; see also *Quality King Distr., Inc. v. L’anza Research Intern., Inc.*, 523 U.S. 135, 141 (1998) (limiting copyright owners exclusive rights); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 432–33 (1984) (providing that a copyright owner’s rights are not absolute).

⁵⁶ *Rodrigue II*, 218 F.3d at 438 n.26; see also *id.* at 436 n.16.

⁵⁷ *Id.* at 441.

⁵⁸ *Id.* at 436–37; see Ciolino, *supra* note 34, at 632.

⁵⁹ *Rodrigue II*, 218 F.3d at 437; see Ciolino, *supra* note 34, at 647.

⁶⁰ See generally Ciolino, *supra* note 34 (detailing an unworkable regime of dismembered copyright ownership).

foundation on which to presume either that federal law does not preempt a transfer of copyright by operation of state law or that other states would permit under state law a transfer of a copyright.⁶¹ However, assuming that the two courts deciding the issue of ownership to the copyright of a work created during the marriage in a community property state are correct, then there is still an unresolved issue as to when the transfer takes place; the author-spouse's post-dissolution right to terminate under copyright law the copyright transfer to the marital estate; or to terminate copyright transfers created in prenuptial, postnuptial, settlement agreements, or even those established by court decrees.

II. TERMINATION OF TRANSFER RIGHTS

The termination of transfer of a copyright must place during a window of time approximately thirty-five years after the initial transfer.⁶² There are at least three possible points at which a copyright may be initially transferred in the marital context—automatic transfer by law, by a court order or judgment, or by voluntary agreement by the author as part of a prenuptial, postnuptial agreement, or as part of a voluntary property settlement at the time of dissolution.

Some courts and scholars consider a transfer of ownership of a copyright in a community property state to the marital community to be a transfer by operation of law.⁶³ Accordingly, one must examine state law to determine when the transfer takes place.⁶⁴ In

⁶¹ See, e.g., J. Wesley Cochran, *It Takes Two to Tango!: Problems With Community Property Ownership of Copyrights and Patents in Texas*, 58 BAYLOR L. REV. 407, 441–45 (2006); Debora Polacheck, *The 'Un-Worth-y' Decision: The Characterization of a Copyright as Community Property*, 17 HASTINGS COMM. & ENT. L.J. 601, 616–20 (1995).

⁶² 17 U.S.C. § 203(a)(3) (2012).

⁶³ There are three ways to obtain a transfer of copyright ownership: through a writing; by operation of state law; or through bankruptcy proceedings. Here, absent a writing, the transfer must be through operation of state law. See, e.g., *In re Marriage of Worth*, 241 Cal. Rptr. 135, 139 (1987).

⁶⁴ See 17 U.S.C. § 203(a)(3) (2012) (“Termination of the grant may be effected at any time during a period of five years beginning at the end of thirty-five 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 thirty-five years from the date of publication of the work

the context of community property law, it is not clear when the transfer originally took place. If under state law the non-author spouse accrued an “operation by law transfer” upon the creation of a work during marriage, then that would start the thirty-five year period.⁶⁵ However, if the transfer does not take place until the entry of the court order allocating the spouse’s interest in the copyright, then that would be the starting point to determine when the thirty-five year period commenced.⁶⁶ When the clock starts is critical because it determines the start of the period during which the non-author spouse has rights in the copyright—assuming that the author-spouse could terminate an intra-spousal transfer under federal law. If the transfer takes place upon the creation of the work, the transfer rights to a work done in the first year of a thirty-five year marriage may be terminable with at least two years’ notice.⁶⁷ While if state law transferred the copyrights upon dissolution of the marriage, the non-author spouse would enjoy at least thirty-five years of post-dissolution benefits resulting from a work that was created at any point during the marriage.⁶⁸ However, if the transfer takes place when the work was created during the marriage, the non-author spouse in theory may receive a period substantially less than 35 years—in fact as few as two years.⁶⁹ The author-spouse’s (or the author’s statutory heirs’) ability to exercise termination of transfer rights with at least two, but no more than ten, years’ notice, places the non-author-spouse in a precarious economic position vis-à-vis the author spouse, especially if the only significant assets are “old” copyrighted

under the grant or at the end of forty years from the date of execution of the grant, whichever term ends earlier.”).

⁶⁵ *See id.*

⁶⁶ *See id.*

⁶⁷ *See id.* § 203(3)–(4)(A)

⁶⁸ The author uses the term “benefits” advisedly because other than a consensus that the non-author-spouse has some claim on the copyright by operation of state domestic relations law, the scope of that claim is unclear. *See supra* Part I.A–B.

⁶⁹ *See* 17 U.S.C. § 203(A)(4)(a) (“The notice shall state the effective date of the termination, which shall fall within the five-year period specified by clause (3) of this subsection, and the notice shall be served not less than two or more than ten years before that date.”).

works, such as the hypothetical involving the song in *About a Boy*, created during marriage.⁷⁰

A. *The Termination of Transfer Rights Clock Starts: At Creation*

Probably the better interpretation of when the transfer occurs under community property law is that in a community property state, the transfer to the community takes place upon the fixation of the copyrighted work during marriage.⁷¹ Copyright law clearly provides that the copyright subsists upon fixation,⁷² and general principles of state community property law provide that

Community property is defined nearly uniformly in all community property states. A typical definition is: ‘property acquired after marriage by either the husband, the wife, or both.’ All property acquired during the marriage is presumed to be community property. The presumption is not generally overcome by the fact that record title to the property is in the name of one spouse alone. Mere expectancies and other interests which do not

⁷⁰ See Warner, *supra* note 1.

⁷¹ See 17 U.S.C. § 102 (defining the term “fixed”); *cf.* 17 U.S.C. 302(c) (the copyright in a work made for hire expires 120 years after creation). The author is aware of only one other area of law where there is a similar automatic transfer of property rights and that example takes place upon the filing of the bankruptcy petition. See 11 U.S.C. §541(a). It is clear that copyrights are transferred to the bankruptcy estate. See *U.S. v. Inslaw, Inc.*, 932 F.2d 1467, 1471 (D.C. Cir. 1991). Further, this transfer is more than a mere equitable fiction for the administrative convenience of administering the bankruptcy estate. See *Bromley v. Fleet Bank*, 659 N.Y.S.2d 83, 83 (N.Y. App. Div. 1997). “The trustee of the estate of the bankrupt is vested with title to all of the bankrupt’s property as of the date of the filing of the petition, including rights and choses in action existing at that time.” *Id. Arguendo*, if the bankruptcy estate acquires its interest in the copyright directly from the author that starts the period from which the termination of transfer rights occurs rather than at the point where the bankruptcy estate granted the copyrights to the new owner or licensee unless there is some principle in bankruptcy law that permits the tolling of the period of time a depreciable asset spends in the bankruptcy estate.

⁷² See *New York Times Co., Inc. v. Tasini*, 533 U.S. 483, 493 (2001).

constitute “property” cannot constitute community property.⁷³

So, because the property right in the copyright vests immediately upon fixation, the legal rights, if any, are immediately transferred to the marital estate.⁷⁴

This understanding of community property is consistent with the court’s holding in *Worth*. The *Worth* court noted:

Moreover, the Act expressly provides for the transfer of a copyright by contract, will “or by operation of law” (§ 201(d)(1)). Consequently, notwithstanding that the copyright “vests *initially*” in the authoring spouse (§ 201(a)), the copyright is *automatically transferred to both spouses by operation of the California law of community property*.⁷⁵

Accordingly, the copyright transfer by operation of California’s community property law took place automatically upon the fixation of the work; because, under Copyright law, fixation is the point of time at which the author first obtained a federally recognized copyright interest in the work by operation of the 1976 Copyright Act.⁷⁶

This simultaneous transfer of property rule appears to be black letter law in other community property jurisdictions.⁷⁷

⁷³ Gerald B. Treacy, 802-2nd T.M. (BNA), Community Property: General Considerations at II.D.2.

⁷⁴ See 17 U.S.C. § 102(a); *In re Marriage of Worth*, 241 Cal. Rptr. 135, 137 (Cal. Ct. App. 1987).

⁷⁵ *Worth*, 241 Cal. Rptr. at 137 (emphasis added).

⁷⁶ See Timothy K. Armstrong, *Shrinking the Commons: Termination of Copyright Licenses and Transfers for the Benefit of the Public*, 47 HARV. J. ON LEGIS. 359, 398–99 (2010); see also J.T. WESTERMEIER, LEE J. PLAVE & JAMES J. HALPERT, DOCUMENTING E-COMMERCE TRANSACTIONS § 1:11 (“Since copyright rights vest automatically in the author by operation of law from the moment of creation and fixation in tangible media, the author of the materials has a copyright in and to the materials without regard to whether copyright rights were sought and irrespective of whether the materials include a copyright notice.”).

⁷⁷ See *Salenius v. Salenius*, 654 A.2d 426, 429 (Me. 1995); *Drake v. Drake*, 725 A.2d 717, 721 n.5 (Pa. 1999); *Hursey v. Hursey*, 326 S.E.2d 178, 181 (S.C. Ct. App. 1985); cf.

The basic concept of community property is easily expressed: all property acquired by the spouses during the marriage belongs not to either spouse individually but to a third entity, the marital community. Because legal title to community property lies with the community and not with either spouse individually, community's ownership interest is not a mere future expectancy which vests upon divorce; it is an immediate and real legal title interest. Thus, classification of an asset as community property has important consequences during the marriage for both the parties and their creditors. When the community is dissolved by either divorce or death, property owned by the community is divided between the parties.⁷⁸

In fact, this automatic transfer of property rights by state law of property acquired during the marriage is one of the salient differences between a community property jurisdiction and an equitable distribution system also known as a common system or title system.⁷⁹ In the community property state, the marital estate holds all marital property jointly.⁸⁰ In an equitable distribution state, legal title may remain in the name of each spouse, and at the time of marital dissolution, the court then allocates property rights under some equitable scheme.⁸¹ So, in an equitable distribution state, if there was going to be a transfer of a copyright by operation of law, it would be done by the court only as part of allocating the property rights of the marital partners at the time of marital dissolution.

UNIF. MARITAL PROP. ACT § 4(b), 9A U.L.A. 141 (1983) ("All property of spouses is presumed to be marital property.").

⁷⁸ BRETT R. TURNER, 1 EQUITABLE DISTRIBUTION OF PROPERTY § 2:5 (3d ed. 2005).

⁷⁹ *Drake*, 725 A.2d at 721 n.4.

⁸⁰ *See, e.g.*, Cal. Fam. Code §§ 2550–56 (West 2004).

⁸¹ *See, e.g.*, 750 Ill. Comp. Stat. Ann. 5/504 (West 2012); Conn. Gen. Stat. Ann. §§ 46b81, 46b-82 (West 2012)

1. The Trophy Spouse Dilemma

Under the court's holding in *Worth*, the copyright transfer takes place by operation of state law immediately upon creation and fixation.⁸² This could lead to a ludicrous result in community property states.⁸³ For example, a long suffering spouse of many years finds that the transfer of the copyrighted work to the marital estate may be terminated before, upon, or after the divorce so that the brand new trophy spouse may enjoy the fruits of the copyright for many years to come. While this interpretation of the 1976 Copyright Act may have unfortunate consequences for the spouse during the creation of the work, it is a more principled interpretation of the Act. The alternative interpretation is to assume the copyright exists in the ether of state community property law to be characterized and transferred only when the marital parties agree in writing or a court so orders and that order—possibly many years after the creation of the work—constitutes a transfer under § 203(a) of the 1976 Copyright Act. The court order would then be the act constituting the transfer by operation of law, for the purposes of determining the start of the statutory period that commences the measure of time for the exercise of the author spouse's termination of transfer rights.

This holds true unless the *Worth* court is correct that works created during marriage are actually joint works under the 1976 Copyright Act.⁸⁴ There is scant support for this proposition. The *Worth* court assumed without any analysis that both California law and the 1976 Copyright Act by operation of state law, under the provisions addressing transfer of a copyright, could make a spouse a joint-author. This holding in *Worth* presents one more copyright conundrum. The 1976 Copyright Act contains a statutory definition of joint work that is inconsistent with California law as interpreted by the court in *Worth*. The Act defines a "joint work" as "a work prepared by two or more authors with the intention that

⁸² See *In re Marriage of Worth*, 241 Cal. Rptr. 135, 137 (Cal. Ct. App. 1987).

⁸³ The author assumes solely for the purposes of this example (as do the states as a matter of state domestic relations policy) that as a matter of copyright policy the non-author spouse at the time the work was created has a greater claim on the economic fruits of the copyright than does a post-fixation claim of the new(er) spouse.

⁸⁴ Of course, the *Worth* court could have just written the opinion inartfully.

their contributions be merged into inseparable or interdependent parts of a unitary whole.”⁸⁵ The *Worth* court created a legal fiction under state law that the divorced spouse was a co-author or the author of a joint work. However, under the 1976 Copyright Act, there are specific statutory provisions for the authors of joint-works to exercise their collective termination of transfer rights.⁸⁶ More importantly, one joint-author cannot terminate the copyright ownership rights of another joint-author.⁸⁷ Assuming that the holding in *Worth* is correct in its interpretation of the 1976 Copyright Act, then it presciently, fortuitously, or serendipitously, solved the vexing dilemma that is the focus of this article. Unluckily, while § 201(d)(1) of the Act permits the transfer of any of an author’s copyright rights, § 201(d)(1) limits this to the author’s exclusive rights under § 106.⁸⁸ Section 201(d)(1) does not appear to include granting a state or state court, through the operation of the state, the right to reject the statutory definition of a joint-work and to create new forms of authorship.

However, if the answer is not found in state law, then one must examine the 1976 Copyright Act for an answer. To determine whether someone is a joint-author, absent an express written agreement, courts look to the conduct of the putative joint-authors to find intent, and the burden of proof is on the party claiming to be a co-author.⁸⁹ Absent a presumption that living in a community property state is evidence of intent to make a spouse a co-author, many, if not all, non-author spouses will be unable to carry this burden by demonstrating an objective manifestation that the two individuals (a married couple) intended to create a joint-work. The courts often focus on the question of the dominant author’s intent to create a joint-work, in this case, the author-spouse.⁹⁰ The case law is consistent that each putative author must make an

⁸⁵ 17 U.S.C. § 101 (2012).

⁸⁶ *See id.* § 203(a)(1); HOWARD B. ABRAMS, 2 THE LAW OF COPYRIGHT § 12:21 (2012).

⁸⁷ *Cf.* 17 U.S.C. § 203(a)(1) (2012) (“[T]ermination of the grant may be effected by a majority of the authors who executed it”).

⁸⁸ *Compare* 17 U.S.C. § 201(d)(1) *with* 17 U.S.C. § 106 (referencing § 106’s listing of exclusive rights in a copyright to reproduce, create derivative works, distribute, perform and display the work).

⁸⁹ *See Thomson v. Larson*, 147 F.3d 195, 200–02 (2d Cir. 1998).

⁹⁰ *See Childress v. Taylor*, 945 F.2d 500, 508 (2d Cir. 1991).

independently copyrightable contribution to the joint work.⁹¹ Often, the non-author spouse's assistance to the author-spouse is rejected as adequate evidence of joint-authorship by the courts, for example, if they provide assistance in editing or research assistance, even if these contributions may have been independently copyrightable.⁹² So, most spouses, absent some evidence of a creative collaboration, are unlikely to meet the statutory definition of the author of a joint-work. Consequently, even if California community property law does view each spouse as a joint-author, the federal termination of transfer right will belong only to the spouse who is considered the author under the 1976 Copyright Act.

2. The Liar Paradox Dilemma

The Liar Paradox is a statement that contains an inherent contradiction, for example, "this sentence is false."⁹³ The intersection of the federal termination of copyright rights and state community property law results in an inherent contradiction, or is at least analogous to the metaphor of a dog chasing its own tail. The following example demonstrates the silliness of state domestic relations law in this area, especially in a community property state. If the parties are still married and under federal law the author-spouse effected a termination of the copyright transfer to the community property estate, the copyright is then automatically and simultaneously re-vested in the community property estate by operation of state law. Once the property right returns to the author spouse, state law automatically vests an interest in that right in the community.⁹⁴ This would lead to an absurd result.⁹⁵ This would

⁹¹ See, e.g., *Janky v. Lake Cnty. Convention and Visitors Bureau*, 576 F.3d 356, 362 (7th Cir. 2009), *cert. denied*, 559 U.S. 992 (2010); *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231 (9th Cir. 2000). *But see* *Gaiman v. McFarlane*, 360 F.3d 644, 660–61 (7th Cir. 2004); *Childress v. Taylor*, 945 F.2d at 506 (noting a split among the leading commentators and copyright treatises).

⁹² See *Childress v. Taylor*, 945 F.2d at 507.

⁹³ See Stuart Banner, *Please Don't Read the Title*, 50 OHIO ST. L.J. 243, 245 n.9 (1989) (detailing the history of the Liar Paradox from ancient times to modern philosophy).

⁹⁴ This example may fail solely because copyright law requires any initial transfer from the author to be voluntary, and there is an assumption that the act of marriage makes an operation of law community property transfer a voluntary transfer. In this

completely frustrate Congress's stated public policy goal behind the termination of transfer right—the right of “safeguarding authors against unremunerative transfers . . . because of the unequal bargaining position of authors, resulting in part from the impossibility of determining a work's value until it has been exploited.”⁹⁶ Any interpretation of state domestic-relations law that returns the terminated copyright transfer to the marital estate raises serious questions of federal preemption. Congress vested in the author the absolute right to terminate that transfer of the copyright, and state law effectively, at least during the marriage in a community property state, precludes the author from terminating an operation-of-law transfer to the marital community by automatically retransferring the terminated right independently of the author's intent to the marital community. Such a law would render federal law nugatory.⁹⁷

As with the Liar Paradox, there are elegant solutions to the inherent contradictions. Another reading of the 1976 Copyright Act may accomplish Congress's intent to protect authors. Section 201(e) of the Act permits the voluntary transfer of copyright to the marital community in a community property state.⁹⁸ However, the penumbras of the termination right under § 203 of the 1976 Copyright Act do not permit an involuntary transfer of a copyright

hypothetical, even the most fervent proponents of marriage as the voluntary act to support a transfer, would find it difficult to find this operation of law transfer a voluntary act. One could also argue that the voluntary scope of 17 U.S.C. § 201(e) would not apply to a subsequent transfer of a terminated right since the language of the statute uses the phrase “has not previously been transferred voluntarily by that individual author.” These are interesting issues outside the scope of this Article. But, it would seem that any involuntary transfer of a terminated copyright would severely weaken the termination right and be inconsistent with Congress' grant of the right which was to replace the new copyright estate granted during the renewal period under the Copyright Act of 1909.

⁹⁵ See, e.g., *Nixon v. Mo. Mun. League*, 541 U.S. 125, 138 (2004) (“Court will not construe a statute in a manner that leads to absurd or futile results.”).

⁹⁶ H.R. REP. NO. 94-1476, at 124 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5740, 1976 WL 14045.

⁹⁷ See *Nixon v. Mo. Mun. League*, 541 U.S. at 138 (2004) (“Court will not construe a statute in a manner that leads to absurd or futile results.”); see also *Crosby v. Nat'l Foreign Trade Council*, 530 U.S. 363, 372 (2000) (“state law is naturally preempted to the extent of any conflict with a federal statute”).

⁹⁸ See 17 U.S.C. § 201(e); *infra* Part III.B.

by operation of state law to revert the terminated copyright to the marital estate. While this would give effect to Congress's purpose behind § 203, the protection of authors from bad copyright deals,⁹⁹ nothing exists in the legislative history or in the text of the Copyright Act that requires these two provisions to be read together in order to accomplish some overarching Congressional purpose.¹⁰⁰ Section 201 provides the process by which copyright ownership may be conveyed and § 203 provides for a statutory process to terminate that transfer right. Once the copyright transfer has been effectively terminated, § 203 returns it to the author's "bundle of sticks" to be transferred once again in a manner consistent with § 201, voluntarily in a time, place, and manner of the author's choosing.

3. Never Said Never (Again)

One way to look at the copyright transfer by operation of law in a community property jurisdiction is that the initial transfer is the only initial transfer and all other divisions of the copyright are traceable back to that one initial transfer at the creation of the work to the marital estate. If this is correct, then creation of the work commences the termination clock. This would be a nightmare for all non-marital copyright transferees for whom the duration of the transfer rights would then be dependent on when the work was created during the marriage rather than the date the transfer takes place to that transferee. Alternatively, the initial transfer could be considered as taking place at the moment of creation to the marital community; however, any second or subsequent transfer at the moment of dissolution is a separate and independent act that would start a new termination of the transfer clock. This latter position may be commended as one that promotes the equity in the property division at divorce, but it does not appear to be consistent with the modern understanding of community property and marital dissolution. Dissolution is merely the allocation of property rights that are already vested in the marital community and not the

⁹⁹ H.R. REP. NO. 94-1476, at 124-25 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5740.

¹⁰⁰ *Id.* at 124-28 (lacking any requirement that two provisions be read together).

creation of new non-marital property. Nor would this answer the conundrum of termination of copyright transfers during the marriage or at any other point prior to the court order.¹⁰¹

III. AUTHOR'S TRANSFER OF COPYRIGHT

The most problematic question regarding an author's termination of transfer in the domestic relations context is whether a transfer of a copyright by operation of law to the marital estate as community property is a transfer that an author may terminate under § 203(a) of the 1976 Copyright Act. Under § 203(a), an author may only terminate a grant that the author has executed.¹⁰² This question requires some consideration of whether a transfer to the community property estate is one by operation of law that it is subject to termination by the author. A downstream-related issue is that even if the copyrights are vested in the community property estate through operation of law, can the copyright rights subsequently then granted by the community property estate be terminated by exercise of the termination of the author's transfer rights? Finally, this Section will address the copyright termination status of copyright interests that were conveyed through prenuptial, postnuptial, property settlement agreements, or court orders.

¹⁰¹ The courts have not considered the effect of inter-spousal transfers of copyrights by operation of law in equitable distribution jurisdictions. In jurisdictions where spouses own the copyrights as separate property, there is the potential that, either voluntarily or involuntarily, the individually owned copyright may implicitly or explicitly become part of the property settlement. If the author-spouse voluntarily agrees to the use of the copyright as an asset in the dissolution, then the transfer should take place at the effective date of the agreement under the same principles that would govern any other contractual copyright transfer. The more interesting and under-theorized question that raises fascinating preemption issues is the de facto or implicit use of an author's copyright to off-set some other property claim in the divorce. If the right truly does belong solely to the author and is granted for constitutional copyright policy reasons rather than mere economic compensation, then using the copyright termination as a factor in allocating other marital property rights or assets may raise the specter of federal preemption. However other than to flag these issues as worthy of further study, they are outside the scope of this Article.

¹⁰² 17 U.S.C. § 203(a)(1) (2012).

A. *By Prenuptial, Postnuptial, or Settlement Agreements*

Perhaps the easiest question presented in this Section is the author-spouse's ability to terminate a transfer that is executed as part of a prenuptial, postnuptial, or settlement agreement. A prenuptial, postnuptial, or settlement agreement is merely a contract of conveyance like any other assignment of copyright ownership or a grant of a lesser right such as a non-exclusive license. There does not appear to be any provision in the 1976 Copyright Act or its legislative history to indicate that the termination right should be treated differently depending on the motivation or the contractual consideration underlying the transfer.¹⁰³ Terminating a prenuptial, postnuptial, or settlement agreement may become more problematic as the agreement may ultimately be merged into the divorce decree or other judicial order.¹⁰⁴ Divorce law recognizes a difference between contracts regarding divorce settlements as a private contract, and a divorce settlement agreement that has become integrated into an order of the court.¹⁰⁵ However if the prenuptial, postnuptial, or settlement agreement has not become part of a court order, it remains merely a contract executed by the author and the transferred copyright is subject to termination by the author.

As a practical matter, if the jurisdiction followed the model established by the court in *Worth*, then either spouse is capable of transferring the copyright.¹⁰⁶ However, as strange as it may seem to anyone versed in Copyright law, one would also suppose that Copyright law's provisions regarding the termination of joint works of authorship would apply—unless the federal courts intervened and limited the statutory term *author* to mean only the creator of the original work.¹⁰⁷ Answering the conundrum of

¹⁰³ *But see* 17 U.S.C. § 205(d) (resolving conflicting transfers).

¹⁰⁴ *See, e.g.,* *Molak v. Molak*, 639 A.2d 57, 58 (R.I. 1994) (“A property-settlement agreement that is not merged into a final divorce decree retains the characteristics of an independent contract.”).

¹⁰⁵ *See, e.g., id.*; *Baker v. Baker*, 13 Cal. Rptr. 772, 773–75 (2d Dist. 1961); *Jenkins v. Jenkins*, 71 Pa. D. & C.4th 205, 222 (C.P. 2004).

¹⁰⁶ *See supra* Part I.A.

¹⁰⁷ In theory, a grant under California law by the non-author spouse would not be a grant executed by the author since it is one by operation of law. The author is using the

putting the *Worth* decision into practice and the complexities of exercising these termination rights are well outside the scope of this Article. For example, if the non-author-spouse is also deemed to be a legal author for the purposes of the termination of transfer rights then the termination of transfer rights for works of joint-authorship is meaningless at least in this specific context.

In the case of a grant executed by two or more authors of a joint work, termination of the grant may be effected by a majority of the authors who executed it; if any of such authors is dead, the termination interest of any such author may be exercised as a unit [by the widow(er), children, or grandchildren who] are entitled to exercise a total of more than one-half of that author's interest.¹⁰⁸

In order to exercise termination of transfer rights, it would take both spouses. If one spouse is deceased, it would take *per stirpes* a block of 51% of the author's copyright interest to exercise the deceased spouse's rights. It would be simpler for the author-spouse to terminate a transfer to the marital estate and then terminate all transfers that flow from ownership rights of the non-author-spouse. If this is not an option, then the statutory language that defines "joint-work" under the 1976 Copyright Act should be ignored and this anomalous situation should be treated by analogy as a joint-work with application of the termination of a transfer in a joint-work.

Unlike the holding in *Worth*, the decision in *Rodrigue* more closely fits the classic pattern in termination cases. As discussed earlier, in *Rodrigue* the court gave ownership and control of the § 106 rights to the author-spouse.¹⁰⁹ Since all interests in copyrights subject to termination will derive from a grant of rights executed by the author-spouse, the author spouse may terminate them. However, the *Rodrigue II* court suggested that the author-spouse

term jurisdiction rather than state because these disputes could potentially arise in Puerto Rico or the relevant marital relationship for non-U.S. authors or works could be from a foreign country.

¹⁰⁸ 17 U.S.C. § 203(a)(1).

¹⁰⁹ See *supra* Part I.B.

had an independent state law duty to manage the copyright estate in a prudent manner.¹¹⁰ Further, the question of the status of the economic rights and whether they may be terminated separately from the § 106 grant of exclusive rights to the copyright owner is left unresolved. The purpose of the termination of transfer rights is to permit the author, and the author's statutory heirs, to recapture any residual economic value in the work. If the economic right granted by the court in *Rodrigue* is analogous to a pension or an investment, then the spouse's claim should survive even after the author purports to terminate the transfer. However, if the spouse's claim is merely that of any other assignee, then the spouse's economic rights are also subject to termination along with the § 106 exclusive rights. Assuming that the *Rodrigue* court's analysis is correct, the non-author-spouse's continued claim would be a question of state law unless the 1976 Copyright Act's termination of copyright transfer provisions and clear congressional intent would preempt a state law claim to economic rights post-termination.¹¹¹

B. By Operation of Law

Under the 1976 Copyright Act, authors may terminate copyright transfers that they executed.¹¹² Copyrights may be transferred either by conveyance or by operation of law.¹¹³ The 1976 Copyright Act does not expressly address terminating copyright transfers that take place by operation of law.¹¹⁴ The

¹¹⁰ See *Rodrigue v. Rodrigue (Rodrigue II)*, 218 F.3d 432, 442 (5th Cir. 2000).

¹¹¹ See *Orson, Inc. v. Miramax Film Corp.*, 189 F.3d 377, 382–83 (3d Cir. 1999), *cert. denied*, 529 U.S. 1012 (2000).

¹¹² 17 U.S.C. § 203(a). Section 203(a) provides that:

In the case of any work other than a work made for hire, the exclusive or nonexclusive grant of a transfer or license of copyright or of any right under a copyright, executed by the author on or after January 1, 1978, otherwise than by will, is subject to termination under the following conditions

¹¹³ 17 U.S.C. § 201(d). Section 201(d) provides that “[t]he ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.”

¹¹⁴ Curiously, neither do the leading treatise authors. See generally GOLDSTEIN, *supra* note 35; NIMMER, *supra* note 30; PATRY, *supra* note 7.

language of § 203(a) states “the exclusive or nonexclusive grant of a transfer or license of copyright or of any right under a copyright, executed by the author . . . otherwise than by will, is subject to termination under the following condition”¹¹⁵ It is not clear whether a transfer by operation of law is subsumed under the phrase “executed by the author” for the purposes of a copyright termination of transfer. When interpreting the 1976 Copyright Act, courts start with the plain and ordinary meaning of the statutory text.¹¹⁶ If the statutory text is ambiguous then courts will resort to extrinsic tools of statutory interpretation such as legislative history in order to divine Congress’s intent.¹¹⁷

In general, there are two points at which a copyright may be transferred. First, the initial transfer from the author-creator and second, the transfer of an ownership interest by a subsequent owner deriving his or her rights in the copyright from a grant by the author. The author’s right to an initial voluntary transfer appears to be almost inviolable. Section 201(e) of the 1976 Copyright Act provides that:

When an individual author’s ownership of a copyright, or of any of the exclusive rights under a copyright, has not previously been transferred voluntarily by that individual author, no action by any governmental body or other official or organization purporting to seize, expropriate, transfer, or exercise rights of ownership with respect to the copyright, or any of the exclusive rights under a copyright, shall be given effect under this title, except as provided under title 11.

Consequently, with the sole exception of those copyright interests transferred as part of an involuntary bankruptcy proceeding,¹¹⁸ initially all copyright rights must be derived directly from the author and must be transferred voluntarily. Section 201(d)(1) and § 204(a) provide for a transfer of copyright “by

¹¹⁵ 17 U.S.C. § 203(a).

¹¹⁶ *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 739 (1989).

¹¹⁷ *Id.* at 743.

¹¹⁸ 17 U.S.C. § 201(e).

operation of law.”¹¹⁹ However, operation of law has been so far “limited to judicial actions such as bankruptcy actions, mortgage foreclosures, IRS liens, and divorce decrees.”¹²⁰ This interpretation is clearly consistent with the limited number of situations such as bankruptcy (expressly allowed under §201(e)), lien and mortgage foreclosures, bequests, consent judgments, and “perhaps community property law or marital divisions” have the necessary overt acts by the author in order for a court to sometimes find an implicit consent to the transfer of a copyright by operation of law.¹²¹ The involuntary initial transfer of the copyright would be permissible solely through involuntary bankruptcy proceedings.¹²² In this case, there would be a clear date when the copyright entered the bankruptcy estate and was then sold or transferred to meet the claims of the author-spouse’s debtors. Considering the purposes behind the termination of transfer right, there appears to be no reason why a transfer through a bankruptcy proceeding cannot be terminated under the usual provisions of § 203(a) of the 1976 Copyright Act approximately 35 years after the initial transfer. Also, a prior voluntary transfer of a copyright that is now part of a bankruptcy estate and is otherwise eligible for termination of the initial transfer could also be terminated under the provisions of § 203(a) because the bankruptcy code does not trump the 1976 Copyright Act.¹²³

Courts often look to patent law by analogy in copyright cases.¹²⁴ However, Patent law is readily distinguishable from Copyright law when considering probate transfers because state probate law, rather than a specific provision in federal Patent law, determines subsequent patent ownership.¹²⁵ More importantly, the

¹¹⁹ 17 U.S.C. §§ 201(d)(1) (citing “any means of conveyance or by operation of law” and also including the applicable laws of intestate succession), 204(a) (invalidating, under specific circumstances, a transfer of copyright unless by operation of law).

¹²⁰ See 2 PATRY, *supra* note 6, § 5:138 n.2.

¹²¹ See *id.* at § 5:116.

¹²² 17 U.S.C. § 201(e).

¹²³ 17 U.S.C. § 203(a).

¹²⁴ See, e.g., *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

¹²⁵ See *Akazawa v. New Link Techs. Int’l, Inc.*, 520 F.3d 1354, 1356–57 (Fed. Cir. 2008).

1952 Patent Act does not contain a provision analogous to the Copyright Act's formalities and limitations on transfers of owner right ownership, including "by operation of law,"¹²⁶ nor has Congress seen fit to change this in the Leahy-Smith America Invents Act ("AIA"), the most recent major revision of U.S. Patent law.¹²⁷ The closest analogous provision in Patent law is 35 U.S.C. § 154(a)(1) which provides that "[e]very patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention . . ." ¹²⁸ The case law in the Federal Circuit regarding assignments of patents by operation of law, have largely focused on various forms of post-mortem succession to the patent rights.¹²⁹ To the limited degree that Patent law is useful in interpreting the 1976 Copyright Act, express assignment provisions under 35 U.S.C. § 261 are not exclusive and Patent law only though judicial gloss recognizes "by operation of law" as an alternative method of conveying a patent and one that is not covered by the express patent law requirement of a writing.¹³⁰

Recognizing the ambiguous nature of the statutory language of the 1976 Copyright Act, this Article will assume that, other than in the case of bankruptcy, any initial transfer of copyright ownership by an author must be voluntary and because it was voluntary, it was a de facto transfer executed by the author, and such a transfer is eligible for the author-spouse to terminate it by operation of law. This Article will continue with its analysis of termination of transfer rights in the domestic relations context, under this assumption. However, if the author may not terminate a transfer by operation of law, this would limit the author's potential rights solely to subsequent transfers by the marital community or to prenuptial, postnuptial, or settlement agreements. Even more

¹²⁶ See *Sky Techs. LLC v. SAP AG*, 576 F.3d 1374, 1379–80 (Fed. Cir. 2009).

¹²⁷ Leahy-Smith America Invents Act, 35 U.S.C. § 261 (2012).

¹²⁸ 35 U.S.C. § 154(a)(1) (2012).

¹²⁹ See, e.g., *Akazawa*, 520 F.3d at 1356; *H.M. Stickle v. Heublein, Inc.*, 716 F.2d 1550 (Fed. Cir. 1983). But see *Sky Techs.*, 576 F.3d. at 1381 (noting state foreclosure and by operation of law assignment of a patent).

¹³⁰ See *Shoshana Lavinghouse, Survey, Sky Technologies, LLC v. Sap AG*, 576 F.3d 1374 (Fed. Cir. 2009), 14 INTELL. PROP. L. BULL. 85, 86 (2009).

narrowly, the author may not be able to terminate subsequent transfers by the marital estate either because, in theory, in a community property state such as California, the author-spouse was not executing these documents in his or her capacity as author. Rather, the author executed the transfer in his or her capacity as a representative of the marital estate because the author no longer owned the copyright, but it became instead the property of the marital estate under state law. The logic is that if an author cannot terminate upstream transfers, then the author also could not be able to terminate downstream transfers of an interest in a copyright. Such an interpretation of Copyright law or state law would severely burden any exercise of the author's termination of transfer right and, in effect, neuter the author's exercise of the right in community property states that may follow the court's holding in *Worth*.

C. *Judicial Decrees*

Prenuptial, postnuptial, and marital property settlement agreements are merely ordinary contracts unless merged into a decree of divorce. "They are treated by courts in the same manner as ordinary contracts, governed by contract law, and subject to the principles of contract law."¹³¹ The nature of these agreements changes when they are merged into a divorce decree, from one of ordinary contract to an order of the court having the force of law.¹³² Regardless of what a state court may decree as part of the property settlement in a marital dissolution proceeding allocating interests in the copyright, Congress has vested *solely* in the author-spouse, his or her widow(er), and his or her children, the ultimate right to terminate a copyright transfer.¹³³ One of the rights of an author under copyright law is the right to terminate the transfer of

¹³¹ See 41 AM. JUR. 2D *Husband and Wife* §§ 89, 101 (2012) (citing *Rider v. Rider*, 669 N.E.2d 160 (Ind. 1996); *In re Marriage of Conner*, 713 N.E.2d 883 (Ind. Ct. App. 1999); *In re Marriage of Van Regenmorter*, 587 N.W.2d 493 (Iowa Ct. App. 1998); *Holz v. Holz*, 2004 PA Super 181, 850 A.2d 751 (2004)); see also UNIF. PREMARITAL AGREEMENT ACT § 9, 9C U.L.A. 53 (2001).

¹³² See James T. Tucker, Annotation, *Family Court Jurisdiction to Hear Contract Claims*, 46 A.L.R. 5th 735 §§ 8–9 (1997).

¹³³ 17 U.S.C. § 203(a)(2).

copyright ownership, including lesser non-ownership rights such as a non-exclusive license.¹³⁴ Importantly, for this analysis of preemption, “[t]ermination of the grant may be effected notwithstanding any agreement to the contrary, including an agreement to make a will or to make any future grant.”¹³⁵ If the author-spouse, through the voluntary act of marriage (or domiciling) in a community property state, is presumed to have granted an interest in the copyright through the operation of state law, then the author-spouse may terminate that transfer under 17 U.S.C. § 203 with not less than two and nor more than five years’ notice, approximately thirty-five years after the initial transfer.¹³⁶ Further, if the copyright term is extended, Congress has so far provided additional opportunities to terminate the transfer in the extended copyright term.¹³⁷

A related section of the 1976 Copyright Act, § 203(b)(5) at first blush may superficially limit the application of § 203(a)(5). Section 203(b)(5) provides that “[t]ermination of a grant under this section affects only those rights covered by the grants that arise under this title, and in no way affects rights arising under any other Federal, State, or foreign laws.”¹³⁸ Yet, the legislative history clearly states:

Nothing contained in this section or elsewhere in this legislation is intended to extend any license or transfer made for a period of less than thirty-five years. Likewise nothing in this section or legislation is intended to change the existing state of the law of contracts concerning the circumstances in which an author may terminate a license, transfer or assignment. Section 203(b)(6) provides that unless

¹³⁴ 17 U.S.C. § 203(a).

¹³⁵ *Id.* § 203(a)(5); *see also id.* § 304(c)(5) (pre-1978 works). *See generally* 7 PATRY, *supra* note 7, § 25:74 & nn.5–6

¹³⁶ Of course, if state law, Copyright law, or the agreement permits it then the rights may be terminated prior to the thirty-five year period. *See* *Walsh v. Rusk*, 172 F.3d 481, 483 (7th Cir.); *cf.* *Korman v. HBC Florida, Inc.* 182 F.3d 1291, 1295 (11th Cir. 1999). *But see* *Rano v. Sipa Press, Inc.*, 987 F.2d 580, 585 (9th Cir. 1993).

¹³⁷ *See* 17 U.S.C. § 304(d); 3 PATRY, *supra* note 8, § 7:62.

¹³⁸ 17 U.S.C. § 203(b)(5).

and until termination is effected under this section, the grant, ‘if it does not provide otherwise,’ continues for the term of copyright. The quoted language means that the agreement does not provide for a term of less than thirty-five years.¹³⁹

So, § 203(b)(5) would not provide for an independent state law exception in the case of marital dissolution proceedings or community property states to the author’s termination rights.

D. Marriage Equality

Under the 1976 Copyright Act, the question of who is an eligible widow(er) is determined in reference to state law. Section 101 of the Act defines an author’s “widow” or “widower” as the “author’s surviving spouse under the law of the author’s domicile at the time of his or her death, whether or not the spouse has later remarried.”¹⁴⁰ The progress of marriage equality has added one more conundrum to the dubious policy of Congress permitting state law to define federal rights. A copyright is a federal right, and arguably under the ambit of the *United States v. Windsor* ruling.¹⁴¹ Prior to *Windsor*, as a matter of federal law Congress expressly excluded a same-sex partner from being a statutory heir for the exercise of Copyright law’s termination of transfer rights, even if the same-sex couple was legally married under the laws of their state.¹⁴² The Supreme Court has since held that Congress’s definition of a marriage as only that between a man and a woman was unconstitutional.¹⁴³ By defining marriage according to the laws of the state where the couple is domiciled at the time of death, Copyright law’s definition of a widow/widower inadvertently adds another confounding variable to the termination of transfer rights conundrum. Arguably, unless the courts or Congress acts, in the case of a same-sex couple married in one state legally, but who are domiciled in a state with a so-called Defense Of Marriage Act statute or equivalent state constitutional provision, at the time of

¹³⁹ S. REP. NO. 94-473, at 18–19 (1975).

¹⁴⁰ 17 U.S.C. § 101.

¹⁴¹ 133 S. Ct. 2675 (2013).

¹⁴² 1 U.S.C. § 7 (2012).

¹⁴³ *Windsor*, 133 S. Ct. at 2680.

the author's death, the same-sex surviving spouse will not enjoy the rights of a widow(er) under the Copyright Act (and the author's eligible statutory heirs would enjoy these rights).

E. International Complexities

Termination of copyright transfer rights under § 203(a) of the 1975 Copyright Act are not limited to United States authors or United States works.¹⁴⁴ Rather, U.S. Copyright law applies to all works protected by copyright in the United States regardless of their copyright status or ownership in their country of origin. Copyright law is territorial so foreign authors and the authors of non-U.S. works may terminate copyright transfers of rights to exploit works in the United States. Whatever rights an author or copyright owner may enjoy under Copyright law are solely based on the domestic law of the jurisdiction in which the author or copyright owner is asserting copyrights.¹⁴⁵ The complexities that are discussed above apply in equal or greater force when the work is not a United States work under the Berne Convention or the author is not a United State author. One may speculate that a U.S. court would find a voluntary transfer of the U.S. copyright by operation of the foreign law when a marriage takes place or during residence in a foreign country with laws and analogous conditions to those in U.S. community property states and results in a voluntary transfer of copyright to the marital estate under the laws of the foreign country.¹⁴⁶ So that even if the law of the jurisdiction in which the author lived—or other jurisdiction where there was a copyright transfer—did not provide for a termination of transfer right, the author could terminate copyright transfers in the United States.¹⁴⁷ Presumably such a transfer of rights in the United States

¹⁴⁴ See *id.* (defining “United States work”). The definition of widow or widower is consistent with this interpretation. The definition is not tied to a state or even the United States.

¹⁴⁵ See Berne Convention for the Protection of Literary and Artistic Works art. 5(3), Sept. 9, 1886, as revised at Paris on July 24, 1971 and amended in 1979, S. Treaty Doc. No. 99-27 (1986) [hereinafter BERNE CONVENTION]; *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1167 (9th Cir. 1996). See generally 7 PATRY, *supra* note 7, § 25:18.

¹⁴⁶ If this was not true then § 201(e) of the 1976 Copyright Act, addressing Involuntary Transfers, is totally redundant.

¹⁴⁷ See 7 PATRY, *supra* note 7, § 25:74 (discussing copyright reversion rights).

may be terminated under the same terms and conditions discussed in this Article.¹⁴⁸ And of course, the converse is equally true. Section 203(a) does not permit the termination of a transfer of foreign (non-US) rights by either as U.S. author, the non-U.S. author of a U.S. work, or a foreign author of a non-U.S. work.¹⁴⁹

IV. STATE LAW BASED INTERESTS IN TERMINATION OF TRANSFER RIGHTS

Having tied up the bundle of sticks relating to the marital community's interest under state law in the copyrighted works created during the marriage, there remains the question of whether state law could purport to grant any interest in the termination right itself.¹⁵⁰ Solely for the sake of this discussion, this Article will assume that federal law would not preempt any state law or judicial decree attempting to transfer the termination of transfer right from the author or the author's statutory heirs or to limit the

¹⁴⁸ See generally BERNE CONVENTION, *supra* note 145, art. 5(1) ("Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention."); *id.* art. 5(3) ("Protection in the country of origin is governed by domestic law. However, when the author is not a national of the country of origin of the work for which he is protected under this Convention, he shall enjoy in that country the same rights as national authors."); Agreement on Trade-Related Aspects of Intellectual Property Rights art. 3, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299; 33 I.L.M. 1197 (1994) ("Each Member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property . . .").

¹⁴⁹ 17 U.S.C. § 203(b)(5) (2012) ("[I]n no way affects rights under . . . foreign laws"); see also 7 PATRY, *supra* note 7, § 25:74. Of course, this is the flip side of the community property copyright conundrum when U.S. state law transfers an interest in a copyrighted work, but the domestic laws of the foreign country does not recognize that transfer. As a practical matter during the marriage, this point is moot in the U.S. because under state community property law, the income from the foreign exploitation of the copyright is community property. It may also be a moot point because community property is the most prevalent form of marital property ownership globally so that the community property interest in the copyright under foreign laws may be similar to the community property interests in U.S. community property states.

¹⁵⁰ Ivan Hoffman, *Are Copyrights Community Property?*, <http://www.ivanhoffman.com/cp.html> (last visited Sept. 24, 2013).

author's exercise of the termination right. This would then lead to the question of the legal status of the termination right as a form of property right under state law. In community property states, there are two major categories of property rights under which the copyright termination right could fall. It could be characterized as either an "expectancy" or as a "contingent interest" in property.¹⁵¹ There do not appear to be any copyright cases directly on point. The 1909 Copyright Act's roughly analogous provision (to the 1976 Copyright Act's termination of copyright transfer provision) which provided the author with a renewal period in which a new copyright estate was created and was not burdened by prior grants of copyright, unless the author survived into the renewal period, is a useful place to start. Under the 1909 Copyright Act, the courts described the "property" interests in the renewal right as a mere expectancy.¹⁵² However, while the federal courts consistently described the 1909 Act's renewal right as an "expectancy," it is clear from the operational language used in opinions that the actual legal interests in copyright renewal rights were, in substance, contingent property rights under state law, so the renewal rights in the second copyright term were vested in the marital community under state law.¹⁵³

The most analogous body of law to a termination of transfer right is probably found outside intellectual property law and in the line of cases considering state law rights to federal pension benefits in community property states because pension benefits, like termination of copyrights, have an inherent period before the right is vested; and because Congress has established by statute eligible classes of claimants in the case of some beneficiaries for pension benefits, like termination of transfer rights. In the case of *In re Marriage of Brown*, the California Supreme Court considered

¹⁵¹ See *In re Marriage of Brown*, 544 P.2d 561, 562–63 (Cal. 1976); *Shill v. Shill*, 115 Idaho 115, 124 (1988); *Copeland v. Copeland*, 91 N.M. 409, 411 (1978); *Ewing v. Ewing*, 739 S.W.2d 470, 472–73 (Tex. App. 1987).

¹⁵² See David Nimmer, *Copyright Ownership by the Marital Community: Evaluating Worth*, 36 UCLA L. REV. 383, 391–92 (1988) (citing *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373 (1960); *Tobias v. Joy Music, Inc.*, 204 F. Supp. 556 (S.D.N.Y. 1962); *Rose v. Bourne, Inc.*, 176 F. Supp. 605 (S.D.N.Y. 1959), *aff'd*, 279 F.2d 79 (2d Cir.)).

¹⁵³ See Nimmer, *supra* note 152.

whether a spouse was entitled to a share of a pension in which the pension rights had not yet vested.¹⁵⁴ The *Brown* court had to distinguish between an expectancy in which the marital community had no rights (and was therefore the sole property of one spouse) and a contingent interest in community property (a property interest that the spouses owned in common):

The term expectancy describes the interest of a person who merely foresees that he might receive a future beneficence, such as the interest of an heir apparent or of a beneficiary designated by a living insured who has a right to change the beneficiary. As these examples demonstrate, the defining characteristic of an expectancy is that its holder has no enforceable right to his beneficence.¹⁵⁵

The court would later opine that if there is a contractual right to be named the beneficiary of a policy, then the beneficiary no longer has a mere expectancy but rather a property right.¹⁵⁶ This would suggest that under California law, not only was the right to the copyright transferred by operation of law, but also the right to the termination of that transfer—or perhaps at least the economic value of the termination right—was also transferred by operation of state law assuming, *arguendo*, federal law would permit such a transfer.

However, any state-law based property claim by a non-author spouse (except as the surviving widow or widower) to *exercise* the termination of transfer right as a contingent interest should be clearly and expressly preempted. The two cases finding that state community property law was not preempted were able to do so with dexterous readings of the 1976 Copyright Act. However, even these two cases acknowledged that if there was a conflict between state domestic relations law and federal copyright law, federal law would control.¹⁵⁷ Unlike the status of copyright

¹⁵⁴ *Brown*, 544 P.2d at 563.

¹⁵⁵ *Id.* at 565 (internal citations and footnote omitted); *see also* Nimmer, *supra* note 152, at 391–92.

¹⁵⁶ *Brown*, 544 P.2d at 566.

¹⁵⁷ *See, e.g., In re Marriage of Worth*, 241 Cal. Rptr. 135, 139–40 (Cal. Ct. App. 1987).

ownership in community property states, in the case of termination of transfer rights, Congress has not been silent. Congress has clearly and unambiguously granted the copyright transfer termination rights to the author and the author's statutory heirs, specifically the author's widow(er) and children.¹⁵⁸ The specific scope of this express grant of rights does not appear to leave open a principled opportunity for the courts to provide additional protections to a divorced spouse through the operation of state domestic relations law or the state's characterization of the termination of transfer right as a contingent interest that is a property right of the marital community under state law. Rather, the termination right is solely a right for the author or the author's statutory heirs.¹⁵⁹

V. STATE COURT CONTEMPT POWER AND FEDERAL PREEMPTION

Although a state court may not directly have the power to stop the termination of a copyright transfer or even reverse a termination of transfer, a state court may attempt to order the author or the author's statutory heirs not to exercise the author's termination right; to transfer for the benefits of the termination to a divorced spouse; or to impose on the author or subsequent transferees some form of constructive trust for the benefit of the non-author-spouse.¹⁶⁰ State courts, through contempt proceedings, have attempted to force recipients of federal benefits to comply with state court orders transferring federal rights that the state court could not directly transfer.¹⁶¹

Contempt power has been uniformly held to be necessary to the protection of the court from insults and oppressions while in the ordinary course of its duties, *and* to enable it to enforce its judgments and

¹⁵⁸ 17 U.S.C. § 203(a) (2013).

¹⁵⁹ See *Hisquierdo v. Hisquierdo*, 439 U.S. 572, 583 (1979).

¹⁶⁰ See H.A.W., Annotation, *Jurisdiction of state court to enforce or control performance by Federal officer or employee of duties imposed upon him by a Federal statute*, 138 A.L.R. 1200 (1942).

¹⁶¹ See, e.g., *Rose v. Rose*, 481 U.S. 619, 621–22 (1987).

orders necessary to the due administration of law and the protection of the rights of suitor.¹⁶²

Therefore, courts have used their contempt powers to enforce judicial orders of all types, and a court's use of its contempt powers in a civil domestic relations matter is not uncommon.¹⁶³

But, the scope of judicial orders and the powers of state court judges are limited by the Supremacy Clause of the Constitution;¹⁶⁴ so the state court's ability to enforce a decree dividing marital assets is limited under federal preemption principles. The scope of a court's contempt power is not unlimited. A court may only use its contempt power to enforce a legally cognizable right.¹⁶⁵ So, if the underlying law (or court order) is invalid under the Constitution or by constitutionally based principles of preemption, then author or the person(s) possessing the termination of transfer rights disobeying the order is not in contempt of court. This Section will analyze whether a state court could interfere with an author's exercise of his or her unfettered right to terminate a copyright transfer, if the exercise of such a termination right contrary to a court order in a domestic relations case is legally contemptuous or whether federal law would preempt the enforcement of such an order.

Section 203(a) is not part of the 1976 Copyright Act's express preemption scheme.¹⁶⁶ However, even without an express federal

¹⁶² *Young v. United States ex rel. Vuitton et Fils S.A.*, 481 U.S. 787, 798 (1987) (quoting *Bessette v. W.B. Conkey Co.*, 194 U.S. 324, 333 (1904) (emphasis supplied by the Court in the original) (internal quotation marks omitted)).

¹⁶³ *See, e.g., Chambers v. NASCO, Inc.*, 501 U.S. 32, 44 (1991) (recognizing the power of contempt is "inherent in all courts").

¹⁶⁴ U.S. CONST. art. VI, cl. 2.

¹⁶⁵ *See, e.g., Young*, 481 U.S. at 800.

¹⁶⁶ *See* 17 U.S.C. § 301 (2012) ("[A]ll legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State."). There is a strong argument that state limitations on an author's ability to recapture § 103 or § 106 rights may be comparable granting equivalent rights, and thus expressly preempted.

law preempting state laws, courts may find that a state law is preempted, if either the state law conflicts with federal law or if Congress intended federal law to occupy the field and to displace all state regulation.¹⁶⁷ In conflict or field preemption cases, federal law preempts state law if either it is impossible to comply with both state and federal law or if the state law frustrates “the accomplishment and execution of the full purposes and objectives of Congress.”¹⁶⁸ If the conflict is in an area that is usually subject to state regulation, then federal courts will not preempt the challenged state law unless “[it] was the clear and manifest purpose of Congress” to preempt state regulation.¹⁶⁹ Moreover, courts use a canon of statutory construction—that is, courts should ordinarily prefer a plausible interpretation of state or federal law that avoids preempting state law.¹⁷⁰

Section 203(a) potentially falls within the ambit of a state family-property law conflict; therefore, the conflict must “do ‘major damage’ to ‘clear and substantial’ federal interests before the Supremacy Clause will demand that state law be overridden.”¹⁷¹ However, this is by no means an insurmountable standard. In almost all of recent community property cases, the Court has held that federal law preempted the challenged state laws.¹⁷² This practical lesson from recent Supreme Court cases suggests the Court actually gives little practical deference to state court decisions and state laws concerning family law regarding the allocation of federal rights or benefits.¹⁷³

¹⁶⁷ See *Crosby v. National Foreign Trade Council*, 530 U.S. 363, 372–73 (2000).

¹⁶⁸ *Id.* (quoting *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)).

¹⁶⁹ *Altria Group, Inc. v. Good*, 555 U.S. 70, 77 (2008) (quoting *Rice v. Santa Fe Elevator Corp.*, 331 U.S. 218, 230 (1947)).

¹⁷⁰ *Altria Group*, 555 U.S. at 77.

¹⁷¹ *Hisquierdo v. Hisquierdo*, 439 U.S. 572, 581 (1979) (quoting *United States v. Yazell*, 382 U.S. 341, 352 (1966)).

¹⁷² *Hisquierdo*, 439 U.S. at 582 (“[O]n at least four prior occasions this Court has found it necessary to forestall such an injury to federal rights by state law based on community property concepts.”). *Hisquierdo* became the fifth such case; *Ridgway v. Ridgway*, 454 U.S. 46 (1981), the sixth case; and *Egelhoff v. Egelhoff ex rel. Breiner*, 532 U.S. 141 (2001), the seventh case. *But see* *Rose v. Rose*, 481 U.S. 619 (1987).

¹⁷³ See *Gibbons*, *supra* note 32, at 139 n.156 (citing *Egelhoff*, 532 U.S. at 156–61 (Breyer, J., dissenting); *McCarty v. McCarty*, 453 U.S. 210, 236 (1981) (Rehnquist, J., dissenting); *Hisquierdo*, 439 U.S. at 591 (Stewart, J., dissenting)).

The starting place for any preemption analysis of a federal statute is the language of the statute and the intent of Congress.¹⁷⁴ The relevant operational language of § 203(a) provides:

(a) Conditions for Termination. — In the case of any work other than a work made for hire, the exclusive or nonexclusive grant of a transfer or license of copyright or of any right under a copyright, executed by the author on or after January 1, 1978, otherwise than by will, is subject to termination under the following conditions:

(1) In the case of a grant executed by one author, termination of the grant may be effected by that author or, if the author is dead, by the person or persons who, under clause (2) of this subsection, own and are entitled to exercise a total of more than one-half of that author's termination interest. [The rights in clause (2) are vested in the widow(er), surviving children, grandchildren, and in the event that these statutory heirs are not still living, the executor, personal representative, or trustee may exercise the author's termination rights.]¹⁷⁵

[. . .]

(5) Termination of the grant may be effected notwithstanding any agreement to the contrary, including an agreement to make a will or to make any future grant.¹⁷⁶

Courts also look to the intent and purpose of the legislation.¹⁷⁷ The legislative history behind § 203(a) is clear; it is to permit authors to recapture unrenumerative transfers and to provide for the economic security of the spouse, children, and grandchildren of the author.¹⁷⁸ One may assume that Congress wished to privilege

¹⁷⁴ See *Medtronic, Inc. v. Lohr*, 518 U.S. 470, 484–85 (1996).

¹⁷⁵ 17 U.S.C. § 203(a)(1)–(2) (2012).

¹⁷⁶ *Id.* § 203(a)(5).

¹⁷⁷ See, e.g., *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 743–44 (1989) (looking at the legislative history of the Copyright Act).

¹⁷⁸ H.R. REP. NO. 94-1476, at 124–25 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5740.

the author first so as to promote the creation of new works and then reward the natural objects of the author's bounty, the spouse and progeny. However, it is not clear that Congress ever explicitly considered competing spouses. Children from any relationship are clearly protected at least insofar as they survive the author, but only the lawful spouse, at the author's death, is entitled to be a statutory heir under the 1976 Copyright Act.¹⁷⁹ One may assume from this limitation as to who may claim rights from the author that Congress as a matter of policy granted a statutory preference to the last in time spouse over the earlier divorced spouse. Perhaps, there is an unstated assumption that promoting a harmonious current marital relationship is more conducive to the "Progress of Science and the Useful Arts" than a more equitable allocation of economic interests in the copyright.

CONCLUSION

Whatever rights to a copyright the divorced spouse may claim under state law, federal law is clear that the termination right may be exercised only by the author, the author's widow, the author's statutory heirs under the 1976 Copyright Act, or, if there are no surviving statutory heirs, the author's executor of the author's estate¹⁸⁰ by providing the transferee with appropriate notice complying with the Copyright Act's statutory formalities.¹⁸¹ The author's ability to exercise termination of transfer rights presents numerous problems in the allocating of copyrights (and other assets) in a divorce proceeding. First, regardless of the status of the copyright under state law as marital property, whatever state courts order as part of a divorce proceeding, or even if the divorce settlement is *voluntary*, the author-spouse has an unwaivable federal right to terminate the transfer of the copyright.¹⁸² Second, regardless of the intent of the author-spouse or the courts, if the

¹⁷⁹ 17 U.S.C. § 203(a)(2).

¹⁸⁰ *Id.*

¹⁸¹ *Id.* § 203(a)(4). *But see In re Marriage of Larson*, No. B192070, 2008 WL 223722 (Cal. Ct. App. Jan. 29, 2008).

¹⁸² *See* 17 U.S.C. § 203(a)(5); *N & D E Co., Inc. v. Gustings*, Civ. A. No. 90-4445, 1992 WL 77581, at *4 (E.D. La. Apr. 9, 1992).

author does not survive into the period in which he or she may elect to terminate the transfer, the termination right statutorily vests in the author's then-widow(er) and children (*per stirpes*) and not in the divorced spouse.¹⁸³ Under Copyright law, it is the widow(er) or children who may exercise these rights.¹⁸⁴ State laws seem to preclude a divorced spouse from the privileges of widow(er)hood.¹⁸⁵ The divorced spouse may not exercise the termination of transfer rights nor prevent the statutory heirs from exercising their termination of transfer rights. Therefore, even if by operation of law, a copyright becomes part of the community property estate, it will remain there only at the sufferance of the author-spouse or the author's statutory heirs, and a state court's ability to manage the copyright assets, as part of the divorce proceeding is extremely limited.¹⁸⁶ Consequently, this is an area of the 1976 Copyright Act that is ripe for the Congress or the federal courts to establish uniform law before the state courts or legislatures in exercise of their traditional powers to regulate domestic relations act to create a further non-uniform body of Copyright law in the context of domestic relations.¹⁸⁷

¹⁸³ See *Broadcast Music, Inc. v. Roger Miller Music, Inc.*, 396 F.3d 762, 771 (6th Cir. 2005); *Troutman v. Estate of Troutman*, 937 N.E.2d 173, 177 (Ohio App. 2010).

¹⁸⁴ 17 U.S.C. § 203(a)(2).

¹⁸⁵ See, e.g., *In re McCarthy's Estate*, 73 P.2d 910 (Cal. App. 1937); *Opdahl v. Johnson*, 28 N.E.2d 308 (Ill. App. 1940); *In re Chomsky's Estate*, 101 N.Y.S.2d 60 (Sur. 1950); see also 2 ABRAMS, *supra* note 86, § 12:21; Nevins, *supra* note 30, at 510–12.

¹⁸⁶ See *supra* Part III.B–C.

¹⁸⁷ Cf. *Gunn v. Minton*, 133 S.Ct. 1059 (2013)