

Case Comment: Martin v Kogan

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Case Comment: *Martin v Kogan* [2017] EWHC 2927 (IPEC)
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Abstract

Discusses the case of *Martin v Kogan* [2017] EWHC 2927 (IPEC) and the new consolidated tests for joint authorship of copyright works set out by Hacon J. Provides a summary of the new quantitative and qualitative tests with special consideration of the ultimate arbiter limb. Analysis of the new definition of substantial for the purposes of establishing joint authorship. Examines what the new tests mean for the creative industries and practitioners working with companies in that field.

Introduction

Martin v Kogan provides clarity and certainty on the law regarding joint authorship. As Intellectual Property rights cover increasingly complicated works with multiple contributors and authors such as screenplays and software, it is important that the law can clearly establish who is a joint author and how creators can prevent a contributor from becoming a joint author. Current caselaw is spread over a wide number of cases which are not entirely consistent. This case provided an opportunity to set out a clear, modern test for joint authorship and to reassess existing caselaw and provide clarification or new tests as appropriate. Finally, it also allowed for discussion of the timing of claims in relation to unconscionability, representation by silence and the raising of estoppel as a defence. Although not intellectual property notions they are vital elements of cases such as these.

N.B. While the case does raise some issues relating to the law of evidence, especially in regards witness recall, they will not be discussed here. All references in this text to sections are to sections in the Copyright, Designs and Patents Act 1988.

Case Facts

Mr Nicholas Martin (the Claimant) wrote a screenplay for a film produced as *Florence Foster Jenkins* between March 2012 and May 2015. Mr Martin was a professional writer and had produced screenplays for television. Ms Julia Kogan (the Defendant) was an international opera singer with a well-established career. She had also written and produced some music documentaries.

Until October 2014, Ms Kogan was the domestic partner of Mr Martin. In April 2014, the relationship broke down acrimoniously and she began to make a series of claims about her contribution to the screenplay and demanding a share of the income from the screenplay. Ms Kogan argued that she had made a significant contribution to the writing of the screenplay. This contribution was based on her specialist knowledge of the subject matter (an opera singer) which she alleged was used verbatim in the work and her contribution of certain technical terminology and language to the work of Mr Martin.

This amounted to a claim that she was the joint author. She argued that as joint author of the work, she was entitled to damages as a result of Mr Martin's sale of the screenplay to finance and production companies. Mr Martin disputed this and sought a declaration that he was the sole author. He adduced as evidence, texts which indicated that she deemed him the writer

and asked him to ‘protect his rights as author’ against other potential joint authors from the United States. He did not dispute the statements made by Ms Kogan, except that she did not actually write any of the screenplay, however he argued that her contribution was not sufficient to amount to joint authorship. Ms Kogan counterclaimed seeking a declaration that she was joint author and joined the finance and production companies as Part 20 Defendants, claiming that they had infringed her copyright in the screenplay.

Mr Martin’s Case

Mr Martin’s case was simply that Ms Kogan had not made any significant contributions to the screenplay in dispute. Later, counsel for Mr Martin argued that since each draft of a screenplay was an individual copyright, the final version of the screenplay had, as agreed by both parties, been written solely by Mr Martin with no involvement by Ms Kogan and therefore the declaration should be granted.

In the alternative, it was argued that the contributions made by Ms Kogan were subject to the final judgement of Mr Martin (as ‘ultimate arbiter’) and therefore could not grant Ms Kogan the status of joint author under the existing caselaw.

Ms Kogan’s Case

Ms Kogan’s case was that she had made both separate and distinct contributions to the screenplay but also that she had written a large part jointly with Mr Martin. These contributions included textual and non-textual contributions. During the trial, her counsel amended this to argue that her contribution was to an earlier draft of the screenplay. The use of this earlier draft in the creation of the final screenplay amounted to her substantial contribution to the final draft and therefore she was a joint author. She also argued that she had consented to this use and that this consent might also make her a collaborator.

Counsel for Ms Kogan also advanced a new test to determine sufficiency in cases involving use of existing copyright materials. The legal basis for this test can be found in the decisions in *Infopaq*¹ and *SAS Institute*². Which held that only original intellectual creations were capable of being protected by copyright. Also that unauthorised use of copyright works in the creation of a new work would qualify it as a substantial use for the purposes of the CPDA. Therefore, in these cases, the author of the copied work would be held to be a joint author of the new infringing work as the infringing material would be deemed by the Courts as a sufficient contribution.

The Law on Joint Authorship

Section 10(1) of the CDPA 1988 sets out two requirements for joint authorship. The first requires that there is a collaboration between more than one author. The second is that the work of each author is not distinct and separate. Hacon J uses the illustration of a literary compilation as a work that would fail the second test. He also held that there was an implied third limb of the s.10(1) test, that of sufficient contribution. This was defined as a ‘[contribution of] a significant part of the skill and labour protected by the copyright’.

¹ *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569.

² *SAS Institute Inc v World Programming Ltd* [2013] EWCA Civ 1482.

The main case on collaboration is *Levy v Rutley*.³ The court ruled that co-operation between joint authors is required which amounts to a ‘common design’. Both must contribute to the main substance of the work not just supply mere alterations, suggestions or comments.

The caselaw on sufficient contribution is more complex. The basic rule from *Tate v Thomas*⁴ is that a contribution must be capable of protection under copyright in its own right. The contribution must also actually have a presence in the work. In *Wiseman v George Weidenfeld & Nicholson Ltd* it was held that advice and criticism was not a sufficient contribution even when made by a specialist in the type of work in question and without which the work may not have been possible.⁵ Additionally, in *Fylde Microsystems Ltd v Key Radio Systems Ltd* this was extended to specialist technical assistance without which the work would have been impossible.⁶

The case of *Robin Ray v Classic FM plc* clarified the existing caselaw by holding that the test should be to determine direct responsibility for the content of the work.⁷ It was not sufficient to suggest ideas, the work must be a shared responsibility. However, this did not amount to an insistence that the work was directly written by the author, so-called ‘penmanship’, thus a scribe would not be a joint author. This was illustrated in *Brighton v Jones*.⁸

This is extended by the decision in *Cala Homes (South) Ltd v Alfred McAlpine Homes East Ltd*. There, the mere act of fixation was not determinative in assigning joint authorship.⁹

In considering the types of contributions made to a copyright work, Hacon J determined that the significance of the contribution depended on the type of skill employed in making that contribution. ‘Skill’ in this context refers to the intellectual creativity of an author within the meaning of *Infopaq*.¹⁰

The learned judge went on to distinguish between primary skills and secondary skills required to create a copyright work. In his analysis, Mr Justice Hacon ruled that where the contribution has occurred by way of a primary skill, then, the test of joint authorship is whether the contribution constitutes a substantial part of the whole, with substantiality being tested both qualitatively and quantitatively. When it comes to contributions occurring through the use of secondary skills, the caselaw suggests that it is more difficult to establish joint authorship. But, that may be due to evidential reasons and/or because it can be difficult to establish that the contribution relied on is the product of relevant secondary skills and thus protected by copyright law.

³ (1871) LR 6 C.P. In this case it was argued that the addition of one scene and some minor changes to a play were sufficient to give the claimant joint authorship.

⁴ [1921] 1 Ch 503.

⁵ [1985] FSR 525.

⁶ [1998] FSR 449.

⁷ [1998] FSR 622.

⁸ [2004] EWHC 1157 (Ch). Here, a claimant who both suggested and implemented improvements and amendments was not held to be a joint author because all such changes had to be approved by the author of the work.

⁹ [1995] FSR 818. This case focused on the work of specialist draftsmen who took orders from a designer who alone could not have produced the work. The court held that the designer was a joint author of the work as it was his skill and design which was expressed in the work.

¹⁰ *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-6569.

Hacon J then summarised the key points of the law on joint authorship which he applied to this case;¹¹

- Joint authors must be collaborators working to a common design.
- These contributions must be distinct from one another.
- Contributions not forming part of the work are irrelevant.
- All contributions are equal and do not depend on the skill involved.
- Contributions must be a substantial part of the work.
- If a contribution is individually protected by copyright, then its unauthorised use will make it substantial.
- The test of substantiality involves both a quantitative and a qualitative test.
- Contributions by suggestion e.g. editing or criticism will not make the contributor a joint author if he or she does not have ultimate editorial control.
- However, ultimate editorial control is not decisive in considering joint authorship.
- If joint authorship is proven, then the court may apportion the copyright.

The normal burden of proof falls on the party claiming joint authorship.¹² s.104 means that the named authors of a copyright work will be presumed to be the authors or joint authors unless the contrary is proven.

The Judgement

Hacon J looked at three types of contributions that had been claimed by Ms Kogan. She relied on six sets of scenes from the screenplay to demonstrate these. In some cases she asserted that she had created the scenario¹³ while in others that she had written the scenes¹⁴ while in two others she claimed to have provided extensive musical jargon and vocal notes.¹⁵ Hacon J first examined whether Ms Kogan had directly written any part of the final screenplay. He noted that Ms Kogan's claims had varied as the dispute had progressed. These claims varied from authorship of some dialogue involving musical terminology and language to joint authorship of the entire work with large elements allegedly written by her alone.

However, she provided little evidence for these claims. While the judge accepted that Ms Kogan had made sole contributions to the technical terms and musical language in the dialogue of the screenplay, he described these as 'suggestions'. He did, however, also accept that she had made 'non-textual' contributions as claimed in three of the examples given.¹⁶ Mr Martin, though, was found to be the ultimate arbiter and decided which of her ideas were used in the

¹¹ *Martin v Kogan* para 54.

¹² The standard of proof will be the normal civil standard.

¹³ The '*Lily Pons and the Bell Song*' scene. Ms Kogan did not claim to have written the scene but to have developed the ideas and specific musical choices in it.

¹⁴ Ms Kogan claimed to have written large parts of '*McMoon's audition*', '*The rehearsal scene*' and '*Scene in the lift*' especially referencing the use of specific and correct musical terminology in these scenes.

¹⁵ Ms Kogan claimed that she had made these contributions to various '*Additional Rehearsal scenes*' and also '*Melotone Records scenes*'

¹⁶ These were found to be the '*Lily Pons and the Bell Song*', '*McMoon's audition*' (musical choices only) and the '*Melotone Records scenes*'.

final screenplay. The judge examined some evidence in support of a collaboration between the two in the remainder of the work but dismissed them as lacking sufficient detail or intent.¹⁷

The judge then considered the evidence that Mr Martin was the sole author. He highlighted nine points which demonstrated this. Firstly, Mr Martin was an established screenwriter while Ms Kogan only had limited experience as an author. Secondly, Mr Martin had rejected an earlier offer by Ms Kogan to write a screenplay together. Thirdly, Mr Martin was the ultimate arbiter (see above). Fourthly, contemporary emails only illustrate Ms Kogan providing proof-reading corrections and comments. Points Five to Eight relate to comments made by Ms Kogan which clearly confirms Mr Martin's position as author and make no comparative claims about her own position.¹⁸ Finally, the last point involves Ms Kogan's lack of claim over Mr Martin's registration of the work in the United States as the sole author.

Considering all the above facts, Hacon J found that these contributions never amounted to a substantial enough contribution to qualify her as a joint author of the screenplay. This would have been true even if made as part of a formal collaboration. Mr Martin was held to be the sole author.

The production and finance companies for the film were entered as Part 20 defendants by Ms Kogan on the basis that they had infringed her copyright in the screenplay. They put forward defences of acquiescence and estoppel. They relied on her failure to raise objections to Mr Martin's registration of the screenplay with the Writers Guild of America and/or his sale of the screenplay to themselves or their subsequent development of the film. This amounted to acquiescence. Additionally, they claimed that her silence amounted to a representation on which they had made detrimental reliance by financing the film. The test for this was whether it was now unconscionable for Ms Kogan to insist on her claim as per Lord Neuberger in *Fisher v Brooker*.¹⁹ Hacon J held that her lack of early objections meant that it would have been unconscionable for her to seek to prevent the distribution of the film, however, he also held that due to his first finding he could not consider whether her claim to joint authorship was itself unconscionable as it would have depended on the facts.

Conclusions

Martin v Kogan is now the key case on joint authorship in copyright. It has consolidated the existing diverse caselaw into a set of simple tests. This case has provided further clarity on what will be considered 'substantial' for the purposes of s.10(1). It provides for two tests, one of a quantitative standard, that the contribution forms a large part of the whole work but also of a qualitative standard, that the work is more than mere suggestion or proofreading and actually represents a collaborative approach to the substance of the work.

One limb of this test is the 'ultimate arbiter' test. This will not be determinative of joint authorship but is strongly indicative. While each case will still be largely decided on its individual facts, where a party fulfils this test it will be difficult to prove they are not a joint

¹⁷ These emails did suggest that Mr Martin and Ms Kogan had worked together but were affectionate in tone and the judge clearly saw them as part of the then relationship rather than as part of a real collaboration.

¹⁸ These comments include an entry from Ms Kogan's own diary and three sets of email in which she urges Mr Martin to protect his interests as the author of the screenplay from third parties. Interestingly one of these includes a warning about individuals who may go on to claim a share of the authorship.

¹⁹ [2009] UKHL 41

author. This has largely settled the issues caused by the differing approaches taken to penmanship and technical skill in earlier caselaw. The new *Infopaq* test for substantiality provides unknowing joint authors with a simpler way of claiming joint authorship where infringement of an existing copyright has taken place. However, this still needs further examination by the courts before its use to claimants can be assessed.

Consequences

This case has important consequences for both the creative industries and practitioners working for clients in this area. While proofreading, criticism and even technical assistance have been determined as irrelevant to establishing joint authorship this case has caused significant potential legal concerns during the creative process, in cases where a contributor may make only a limited quantitative contribution but that contribution is not edited and becomes a significant part of the work. In such a case, the contributor may be able to seek a pro rata apportionment of the copyright.

Therefore authors will have to enforce total editorial control over their work or risk allowing a contributor to make and claim a substantial contribution. This may be especially concerning for independent authors, where an editor may insist on having ultimate arbiter rights and make significant additions thereby enabling a claim of joint authorship either for himself or the publisher. Another potential concern for publishers using authors acting as independent contractors, or where employees retain copyright, are cases where a work may be written by subordinates but published under the name of a superior. In such cases, if there is inadequate control or overuse of such subordinates without any new contractual clauses governing copyright, this might give rise to claims of joint authorship.

Ultimately, this case will encourage authors to exercise greater control over their works and, where collaboration is essential, to deal with joint authorship issues through contractual clauses either by making the collaborator an employee and thus surrendering their claim, or alternatively, by insisting on the grant of an option for the assignment of any rights accrued for a pre-determined fee.