



Nine Ways to Avoid Copyright Termination Part 2



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This is Part II of a two-part article on copyright termination rights. Part I, published in the Spring 2012 issue of NEW MATTER, discussed the history of, procedures, and effects of exercising the termination right. Part II discusses nine strategies for copyright grantees and licensees to consider in order to avoid termination of their copyright rights.

CERTAIN RISKS ARISE WHEN ENTERING into agreements with authors for rights to content. Here are actions grantees and licensees can take to possibly avoid an author's ability to terminate their rights.

POSSIBLE WAYS FOR GRANTEES AND LICENSEES TO AVOID TERMINATION OF COPYRIGHT GRANTS

The Termination Right Does Not Apply to Works-for-Hire

An important exception to the termination right is works-made-for-hire: copyright rights in such works cannot be terminated.⁴⁵ Where an author creates a work within the scope of his or her employment or the work otherwise meets the statutory requirements of a "work-made-for-hire," the author is not permitted to terminate the prior grant. This is because "the copyright in such a creation never belonged to the artist in the first instance to grant; instead, it belonged at the outset to the party that commissioned the work."⁴⁶

A person or entity that acquires and uses works created by others can eliminate the risk of a later termination by limiting acquired works to those created on a work-made-for-hire basis.⁴⁷

The most ready example of a "work-made-for-hire" is a work prepared by an employee in the scope of employment.⁴⁸ A company can avoid the risk of termination by having its creative works prepared by employees in the course of their employment. Another way to eliminate this risk is to first hire, as an employee, anyone asked to create a work.

The Copyright Act defines some additional categories of works-for-hire. These include a work the parties agree expressly in writing is made for-hire that is either specially ordered or commissioned for use as a contribution to a collective work, or as part of either a motion picture or other audiovisual work, as a translation, a supplementary work,⁴⁹ a compilation, an instructional text,⁵⁰ a test, answer material for a test, or as an atlas.⁵¹

A company in publishing, film production, or other business can eliminate the risk of future termination for works in these categories by making sure the following requirements are satisfied: (a) the work is specially ordered or specially commissioned, (b) it is a contribution to a collective work, (c) the parties agree in writing that the work is "made-for-hire;" and (d) the collective work is in one of the statutory categories for which work-made-for-hire status may apply.

The work-for-hire exception also impacts recipients of previously transferred or licensed copyrights. They may seek to estab-



lish that the copyright which the author or heirs now seek to terminate was created on a work-for-hire basis, and therefore is not subject to termination.

Over time, the test for whether a work is “for-hire” has changed. For works created since January 1, 1978, the Supreme Court held that “a work for hire can arise through one of two mutually exclusive means, one for employees and one for independent contractors.”⁵² The determination whether a work was created in the scope of an employment refers to “the conventional relation of employer and employee.”⁵³ To determine if that relationship exists, the court looks to the “general common law of agency.”⁵⁴ Otherwise, independent contractor status applies and the work can be “for-hire” only if the parties expressly agree in writing and the work is in one of the Section 101(2) categories.

For works created before 1978, “for-hire” status is governed by the 1909 Act. Under that Act, works-for-hire include those created by employees in a traditional employer-employee relationship. But a different, “instance and expense” test applies to determine if a work created by an independent contractor was made “for-hire.”⁵⁵ Under this formulation, whenever one person engages another to create a work, “the presumption arises that the mutual intent of the parties is that the title to the copyright shall be in the person at whose *instance and expense* the work is done.”⁵⁶

A licensee or grantee that wishes to avoid termination of the license or grant may do so by establishing that the grant or license was superfluous because the work was made “for-hire” (under the 1909 Act test for works created before 1978; or the 1976 Act test for works created after its effective date, January 1, 1978).

In assessing whether a work was made for-hire, courts do not rely on recitals by the parties in their agreement. Rather, courts will look to the actual circumstances in which the work was created. In *Marvel Characters, Inc. v. Simon*⁵⁷ the parties settled prior litigation with an agreement, made long after creation of the work at issue (*Captain America* comics), stipulating that it had been created for-hire.⁵⁸ The settlement included a transfer and assignment by the author of his interest in the works.⁵⁹

Subsequent to that transfer, the 1976 Act established a new termination right. In 1999, the author, recognizing this opportunity to reclaim his copyright in the work, acted to terminate the prior transfer.⁶⁰ He claimed to have created the works independently, not as an employee or creator of a work-for-hire. In the litigation that followed, the district court ruled that the author’s acknowledgement in the Settlement Agreement that he created the works “for-hire” prevented him from claiming otherwise.⁶¹ On appeal, the Second Circuit Court of Appeals reversed.

The 1976 Act protects an author from waiving the termination right by providing that “termination of the grant may be effected notwithstanding any agreement to the contrary.”⁶² The Second Circuit held that “an agreement made after a work’s creation stipu-

lating that the work was created as a work for hire constitutes an ‘agreement to the contrary’” which can be disavowed.⁶³ To determine if a work was for-hire or not, requires focus “on the actual relationship between the parties, rather than the language of their agreements.”⁶⁴

Settle Dispute with Factual Stipulation and Findings

The *Marvel* court refused to rely on a subsequent settlement agreement to establish work-for-hire status. But the court did not prohibit using settlements to establish such status, and described how a settlement can do so. “If parties intend to preclude future litigation regarding authorship by settling their claims, they need only comply with the requirements of collateral estoppel by filing a detailed stipulation of settlement, complete with sufficient factual findings on authorship, with the court.”⁶⁵

This suggests another way for grantees and licensees to avoid potential terminations. Some relationships will, for any number of reasons, devolve into litigation. Most litigation results in mutually agreed settlements. Licensees and grantees may follow the *Marvel* court’s guidance by including a detailed stipulation in the settlement with factual findings on authorship, so as to preclude future litigation on the subject.

The Termination Right Does Not Apply to Derivative Works

“A derivative work prepared under authority of the grant before its termination may continue to be utilized under the terms of the grant after its termination.”⁶⁶ Thus, a grantee or licensee that creates its own derivative work before the author or heirs terminate the grant⁶⁷ may continue to exercise all the granted rights with regard to that derivative work. Therefore derivative works present an opportunity for a licensee or grantee to reduce the impact of the termination right.

A derivative work is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is also a “derivative work.”⁶⁸

In *Mills Music, Inc. v. Snyder*, the Supreme Court considered the derivative works exception as to a popular song, *Who’s Sorry Now*. Mills was the assignee of the copyright for the song. He issued numerous licenses to record companies to reproduce the song. The record companies prepared numerous versions, each of which was independently copyrightable.⁶⁹ The record companies paid royalties to Mills, who turned over 50% of the royalties to the song’s author, Snyder.

Snyder’s widow and son elected to terminate the earlier assignment to Mills, and in essence demanded to receive 100% of all



future royalties from the derivative works. The Supreme Court rejected this effort, holding that the consequences of termination do not apply to derivative works within the termination right's derivative works exception.⁷⁰ The court held that owners could continue to exploit their derivative works during the remaining term of the copyright, under previously negotiated terms.⁷¹ Despite termination, Mills could continue to exploit and retain 50% of the royalties from derivative works created pursuant to the now-terminated assignment.⁷²

That being the case, a grantee or licensee may wish to create derivative works during the term of the grant or license, secure in the knowledge that there is a privilege to continue using such works regardless of the exercise of the termination right.

Enter into a New Agreement with the Author or Heirs

Another way to avoid termination of rights is to enter into a new grant or license, including a mutual termination of the prior instrument. This occurred when John Steinbeck's heirs sought to terminate the author's 1938 grant of copyright licenses to a publisher.⁷³

Steinbeck had granted a publisher the "sole and exclusive right to publish" what became some of his most famous works: *Grapes of Wrath*, *Of Mice & Men*, and *Tortilla Flat*, among others. Steinbeck's will gave his interest in the copyrights to his wife. Several years after Steinbeck died, his widow and the publisher entered into a new agreement, adding some books, enlarging annual advances, and increasing the royalties. The new agreement said it canceled and superseded the previous agreement.⁷⁴

After Steinbeck's widow died, Steinbeck's surviving son and grandson sought to terminate the 1938 grants. In litigation that followed, the Second Circuit Court of Appeals ruled the agreement entered into with Steinbeck's widow "terminated and superseded the 1938 agreement."⁷⁵ Therefore, "the [prior] grant of rights no longer existed."⁷⁶ This "eliminated the right to terminate the grants contained in the 1938 Agreement."⁷⁷

The Second Circuit rejected the heirs' argument that the widow's agreement was an "agreement to the contrary," which, the heirs argued, should not be permitted to interfere with exercise of the termination right. The court distinguished the *Marvel Characters* decision as having only rejected "attempts to re-characterize existing grants of copyright so as to eliminate the right to terminate,"⁷⁸ and noted that no such attempt was made in this case.⁷⁹ The court noted that parties to a transfer or license retain the right to voluntarily agree to terminate an existing grant and negotiate a new one.⁸⁰

Thus, a licensee or grantee of copyright rights seeking to avoid termination may negotiate a new agreement, making sure to expressly cancel and terminate the prior grant or license, so that the grant or license is embodied entirely in the new instrument. Any termination rights then pertain to and need to be timed in relation to the new agreement.

Walt Disney Productions demonstrated the merit of this approach. In 1961 Disney became a licensee of merchandising and motion picture rights in Winnie-the-Pooh. "In 1983, faced with the possibility that [the author's heir] might seek to terminate the rights... Disney proposed that the parties renegotiate the rights." The parties signed a new agreement which revoked prior agreements, re-granted previously granted rights, and increased payments to the licensor.⁸¹ Later, the surviving heir sought to terminate the original grant. In litigation that followed, the district court and Ninth Circuit agreed the prior grants had already been terminated by the parties' 1983 agreement, which therefore remained in effect.⁸²

Holders of a Majority of Terminated Interest Agree Not to Terminate

In some circumstances, the termination right of a deceased author may be divided among multiple heirs. These can be a combination of the author's surviving children (and, in some cases, grandchildren) or a combination of children and a surviving spouse.⁸³ Termination of the grant may be effected by a combination of those persons who own and are entitled to exercise collectively more than one-half of the author's termination interest.⁸⁴

Stated differently, in situations where multiple persons inherited the author's termination right, the exercise of the termination right requires action by a majority-in-interest of the holders of the right. Conversely, holders of a majority of an author's termination interest might agree not to join in exercising a termination right. This would have the effect of eliminating that termination right.⁸⁵

Potentially, a copyright grantee or licensee dealing with individual holders of a share of the termination right might test whether lawful consideration, given to induce one or more individuals not to join in exercising a termination right, could withstand a challenge as being an "agreement to the contrary." Such an agreement may withstand the challenge because it is not an agreement not to terminate (only a majority could exercise such agreement), but rather is an agreement by each individual, not to join with others in exercising such a right.

Obtain Copyright Rights by Will

Copyright ownership may be transferred by will.⁸⁶ Transfers made by will are not subject to the Act's termination provisions.⁸⁷ Where possible, acquirers of copyright interests may wish to persuade an author to bequeath their interest by will. However, so long as the author is living, this approach does not provide certainty that termination can be avoided. A living author can revoke or modify his or her will.⁸⁸ And an agreement to make a will is, by statute, an "agreement to the contrary" that can be terminated.⁸⁹ However, if the copyright interest is given by will to the grantee or licensee at the author's death, that transfer will not be subject to termination.



Obtain Rights Beyond U.S. Borders or Under Foreign or Other Law

Exercise of the termination right ends only rights that arise under U.S. copyright law. The Act confirms that termination reverts to the author or heirs “all rights under this title,”⁹⁰ and termination of a grant “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”⁹¹

This was addressed by the court in *Siegel v. Warner Bros. Entertainment, Inc.*⁹² Heirs of Superman’s creator exercised the termination right as to an earlier world-wide grant of rights.⁹³ The court held that the termination was effective, but not as to the grantee’s profits earned from foreign publications:

Section 304(c)(6)(E) to the 1976 Act provides that “[t]ermination of a grant under this subsection affects only those rights covered by the grant that arise under this title [Title 17 of the United States Code, governing copyrights], and in no way affects rights arising under any other Federal, State, or foreign laws.

[The] statutory text could not be any clearer.... Congress expressly limited the reach of what was gained by the terminating party through exercise of the termination right; specifically, the terminating party only recaptured the domestic rights (that is, the rights arising under title 17 to the United States Code) of the grant to the copyright in question. Left expressly intact and undisturbed were any of the rights the original grantee or its successors in interest had gained over the years from the copyright through other sources of law, notably the right to exploit the work abroad that would be governed by the copyright laws of foreign nations....⁹⁴

The court went on to quote Nimmer for the proposition that “a grant of copyright ‘throughout the world’ is terminable only with respect to uses within the geographic limits of the United States,”⁹⁵ and it quoted Patry, stating that “where a U.S. author conveys worldwide rights and terminates under either section, grants in all other countries remain valid according to their terms or provisions in other countries’ laws.”⁹⁶ The *Siegel* court therefore held that termination affected only the domestic portion of the author’s world-wide grant in *Superman* and was not effective as to the remainder of the grant. That is, exploitation of the work abroad was governed under foreign copyright laws. The grantees retained the unfettered right to exploit the works, and retain profits therefrom, in foreign nations.⁹⁷

Establish that Work Fits Into a Statutory Gap In the Termination Right

The Copyright Office identified a statutory hole in the 1976 Act’s two termination provisions. The termination rights of sections

304(c) and 304(d) of the Act apply only to works already existing on January 1, 1978. Section 203 permits termination of grants where the author assigns his or her rights on or after January 1, 1978. The Copyright Office identified a gap where a work was created after January 1, 1978 but the author assigned rights to the work *before* that date.⁹⁸

In these circumstances, it is unclear whether the termination provisions apply.⁹⁹ Sections 304(c) and 304(d) do not apply because they require an existing copyright on January 1, 1978, which does not exist for a work created after that date. But applicability of Section 203 is not clear because it requires the grant to have been *executed on or after January 1, 1978*.

The Copyright Office adopted the view that such works (assigned pre-January 1, 1978 and created after January 1, 1978) should be terminable under Section 203.¹⁰⁰ But the Copyright Office’s analysis also concedes that “rule making is not a substitute for statutory clarification.” Their publication adds that recordation of a termination notice “does not mean that it is otherwise sufficient under the law;” and is “without prejudice to any party claiming that the legal and formal requirements for issuing a valid notice has been met.”¹⁰¹ Therefore, for works within the statutory gap—assigned pre January 1, 1978 and created after January 1, 1978—publishers, studios, and other licensees and grantees may test the claim that no termination rights exist under the current statutory framework.

Other Grounds to Defeat Attempted Termination

Because of the relatively few cases to date concerning termination under the 1976 Act, numerous other circumstances, strategies, and scenarios are likely to develop. For example, there are many ways that attempted termination and notice given to grantees/licensees could be defective, and therefore ineffective. These could include noncompliance with any of the various requirements for a termination notice, such as failure to list all works to be terminated,¹⁰² failure to serve the notice within the permitted time frame,¹⁰³ or failure to serve the right party with the notice.¹⁰⁴

In addition, any number of the other requirements in the regulations for termination might not be satisfied. For example, the notice may not be signed, or may not be signed by the required number/proportion of owners of the termination interest or by agents who are “duly authorized.” These defects could provide avenues for grantees/licensees to contest the validity of any purported termination notice.

CONCLUSION

Congress enacted termination rights in the Copyright Act of 1976 to let authors reclaim valuable rights after their grantees and licensees developed those rights into valuable properties. Still, the statute—by both design and in some respects by possible Congressional oversight¹⁰⁵—provides exceptions and steps publishers, studios, and other copyright grantees can pursue to protect their investments in the use, development, production, and distribution of



copyrighted content, and to limit the termination rights of authors' and their heirs. ◀◀

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Endnotes

45. 17 U.S.C. §§ 203(a), 304(c), and 304(d).
46. *Siegel v. Warner Bros. Entertainment, Inc.*, 658 F. Supp. 2d 1036, 1056 (C.D. Cal. 2009).
47. In these circumstances, the author cannot terminate the grant of the copyright, "such a grant being merely a superfluous act that did not alter the preexisting ownership rights to that copyright." *Siegel*, *supra* note 2.
48. 17 U.S.C. § 101.
49. A "supplementary work" is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwards, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes. 17 U.S.C. § 101.
50. An "instructional text" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities. 17 U.S.C. § 101.
51. 17 U.S.C. § 101.
52. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 743, 747-748 (1989).
53. *Id.* at 740.
54. *Id.* at 740, 751. Under the common law of agency, the test for whether a hired party is an employee is determining "the hiring party's right to control the manner and means by which the product is accomplished." Factors relevant to this inquiry include skill required, source of tools used, location where work is performed, duration of parties' relationship, whether the hiring party has the right to assign additional project to the hired party, extent of hired party's discretion over when and how long to work, method of payment, hired party's role in hiring and paying assistants, whether the work is part of the hiring party's regular business, whether the hiring party is in business, employee benefits, and tax treatment of the hired party. No single factor is determinative.
55. *Lin-Brook Builders Hardware v. Gertler*, 352 F.2d 298, 300 (9th Cir. 1965); *Siegel v. Time Warner*, 496 F. Supp. 2d 1111, 1135-1144 (2007) (dispute relating to rights to Superboy).
56. *Id.* (cited in *Siegel v. Warner Bros. Entertainment, Inc.*, 658 F. Supp. 2d 1036, 1057-1058 (C.D. Cal. 2000) (italics added)).
57. *Marvel Characters, Inc. v. Simon*, 310 F.3d 280 (2d Cir. 2002).
58. *Id.* at 282, 283.
59. *Id.* at 284.
60. *Id.*
61. *Id.* at 285.
62. 17 U.S.C. §§ 203(a)(5) and 304(c)(5).
63. *Marvel Characters, Inc.*, *supra* note 13, at 290, 292.
64. *Id.* at 291.
65. *Id.*
66. 17 U.S.C. §§ 203(b)(1) and 304(c)(6)(A).
67. *Id.* The privilege to continue using derivative works "does not extend to the preparation after the termination of other derivative works based upon the copyrighted work covered by the terminated grant."
68. 17 USC § 101.
69. *Mills Music, Inc. v. Snyder*, 469 U.S. 153, 158 (1985).
70. *Id.* at 164.
71. *Id.* at 173. To the same effect, *see also*, *Woods v. Bourne*, 60 F.3d 978, 986 (2d Cir. 1995).
72. *Id.* at 176.
73. *Penguin Group (USA), Inc. v. Steinbeck*, 537 F.3d 193 (2d Cir. 2008).
74. *Id.* at 196.
75. *Id.* at 200, 202.
76. *Id.* at 203.
77. *Id.* at 202.
78. *Id.* at 201.
79. *Id.*
80. *Id.* (quoting H.R. Rep. No. 94-1476 at 127 (1976) U.S. Cong. Code & Admin. News at 57432-44).
81. *Milne ex rel. Coyne v. Stephen Slesinger, Inc.*, 430 F.3d 1036, 1040-1041 (9th Cir. 2005).
82. *Id.* at 1048.
83. If there is no surviving spouse, then surviving children, and surviving children of a deceased child, own the termination interest. If there is also a surviving spouse, he or she owns one-half the termination interest and the surviving children/grandchildren own the other half. The rights of children and grandchildren are divided among them and exercised on a *per stirpes* basis. If there is only a surviving spouse and no surviving children/grandchildren, the surviving spouse owns the whole termination interest. 17 U.S.C. §§ 203(a)(2) and 304(c)(2).

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Sales, Inc. v. Sultana Crackers, Inc., 683 F. Supp. 899, 911-12 (E.D.N.Y. 1988).

29. Lanham Act § 35, 15 U.S.C. § 1117; *see also* Lanham Act § 32, 15 U.S.C. § 1114 (regarding “infringement” of a registered mark).
30. This statutory language was added to Section 35(a) in 1989. Previously, the language of Section 35 was limited to violations of a registered trademark, but “the courts with increased frequency [were] disregarding this limitation.” S. Rep. No. 100-515, at 39 (1988), *as reprinted in* 1988 U.S.C.C.A.N. 5577, 5601-2.
31. 15 U.S.C. § 1117(a) (in addition to defendant’s profits and plaintiff’s damages, this subsection also identifies costs and attorneys’ fees as being recoverable). As previously noted, no distinction will be made between profits and damages for purposes of discussing monetary remedies.
32. *See Mosely v. Victoria’s Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (“Traditional trademark infringement law is a part of the broader law of unfair competition.” (citation omitted)); *see also Dial-A-Mattress v. Mattress Madness*, 841 F. Supp. 1339, 1347 (E.D.N.Y. 1994) (“Even if defendants were to prevail in their efforts to cancel plaintiff’s registration, the ‘Dial-A-Mattress’ mark would still be entitled to protection as an inherently distinctive mark.”).
33. MCCARTHY, *supra* note 13, § 19.144 (citations omitted).
34. *Id.*
35. *Coach, Inc. v. Asia Pac. Trading Co.*, 676 F. Supp. 2d 914 (C.D. Cal. 2009).
36. *Id.* at 925.
37. *Id.*; *cf. Howard Stores Corp. v. Howard Clothing, Inc.*, 311 F. Supp. 704, 705 (N.D. Ga. 1970) (no damages awarded because there was no infringing activity during the later accounting period).
38. *Coach, supra* note 20, at 924.
39. *Id.* at 925 (“Plaintiffs’ recovery of profits or damages under § 1125(a) is limited to that period after which Defendant had ‘actual notice’ of Plaintiffs’ registration.”).
40. *Id.* at 924–25 (citing 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19.144 (4th Ed. 2009)); *see also GTFM, Inc. v. Solid Clothing, Inc.*, 215 F. Supp. 2d 273, 306 (S.D.N.Y. 2002) (no damages could be recovered after the mark was registered unless there was statutory notice or actual notice to the defendant.).
41. *Coach, supra* note 20, at 924.
42. Lanham Act § 7, 15 U.S.C. § 1057; *see also Burger King of Florida, Inc. v. Hoots*, 403 F.2d 904, 908 (7th Cir. 1968) (a federal registrant will have the right to use the mark throughout the country, except for the local area where another user had actually used the mark prior to the registration).
43. Lanham Act § 22, 15 U.S.C. § 1072.
44. Lanham Act § 42, 15 U.S.C. § 1124.
45. Lanham Act § 35(a), 15 U.S.C. § 1117(a); *see also Synergistic Int’l, LLC v. Korman*, 470 F.3d 162, 174 (4th Cir. 2006) (noting that “the Lanham Act gives little guidance on the equitable principles to be applied by a court in making an award of damages”).
84. 17 U.S.C. §§ 203(a)(1); 304(c)(1).
85. *See Penguin Group (USA), Inc. v. Steinbeck*, 537 F.3d 193, 202 (2d Cir. 2008).
86. 17 U.S.C. § 201(d)(1).
87. 17 U.S.C. §§ 203(a) and 304(c); *Broadcast Music, Inc. v. Roger Miller Music, Inc.*, 396 F.3d 762, 775; *Venegas-Hernandez v. Peer*, 283 F. Supp. 2d 491, 504 (D.P.R. 2003) (“If there has been a will, the copyright renewal transfers by testament, and the statutory class does not receive the termination rights.”); *cf. Larry Spier, Inc. v. Bourne Co.*, 953 F.2d 774, 777 (2d Cir. 1992) (exclusion from termination provision of transfers by will did not apply because author assigned interest in copyrights prior to execution of will; author did not have any right under copyright when he executed his will).
88. *See, e.g., Estate of Straisinger*, 247 Cal. App. 2d 574, 582 (1967); *Trotter v. Trotter*, 490 So.2d 827, 832 (Miss. 1986) (“breach of contract not to revoke a will... is not grounds for contesting the will pertaining to the contract.”).
89. 17 U.S.C. §§ 203(a)(5) and 304(c)(5).
90. 17 U.S.C. § 203(b) and 304(c)(6).
91. 17 U.S.C. §§ 203(b)(5) and 304(c)(6)(E).
92. *Siegel v. Warner Bros. Entertainment, Inc.*, 542 F. Supp. 2d 1098, 1140-1143 (C.D. Cal. 2008).
93. *Id.* at 1107.
94. *Id.* at 1140 (bracketed text as in original).
95. *Id.* (quoting 3 Nimmer on Copyright § 11.02[B][2] at 11-19).
96. *Id.* (quoting 7 Patry on Copyright § 25:74.).
97. *Id.* at 1142.
98. *Analysis of Gap Grants Under the Termination Provisions of Title 17*, U.S. Copyright Office, December 7, 2010, page 2.
99. *Id.* at 2.
100. The Copyright Office analysis is that transfer that predates the copyrighted work cannot be effective until the work and copyright are created and come into existence. *Id.* at 3.
101. *Id.* at 3.
102. *Burroughs v. Metro-Goldwyn-Mayer*, 683 F.2d 610, at 618 (2d Cir. 1982) (termination notice was not effective as to works not listed in the notice).
103. *Id.* at 617, 620 (notice served *before* effective date of act, found by lower court to have been premature).
104. *Id.* at 618 (possible defect for failure to serve MGM).
105. *See* Section 5(H) of this article.

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