A Jog Through the Juniper: A Translator's Unhappy Excursion into the Copyright Thicket

By Anne Milano Appel and Carol J. Marshall

n bel ginepraio!"

Giovanni wrote in one of the last e-mails we traded before we finally stopped communicating altogether and fell into a hostile, wounded silence. *"Ginepraio"* is one of those fine Italian words that have both a literal and a figurative meaning. Multitasking on a linguistic level. Taken literally, it refers to a juniper thicket, a dense growth of evergreen shrubs which is characteristically thick, prickly, and impenetrable. Figuratively speaking, it signifies a "fix." A fine predicament. A tight spot. Take your pick. Any way you look at it, not a pleasant place to be. By the time Giovanni used the term to express his exasperation with our situation, we had been through a lengthy exchange in which each of us grew increasingly frustrated and more and more irritated with one another. An electronic altercation which I think took both of us by surprise. How did it start? Innocently enough and with the best intentions.

Setting Off on an Innocent Ramble

A year ago, Giovanni found me through my website and contacted me about translating a novel he had written. Since he was living in a remote part of Italy, I felt I should be very realistic (read: painfully truthful) about the possibility of him ever being able to get his novel published in the U.S. market, but he was determined to break onto the American scene. We finally got down to talking about my rates. I told him about a few of my usual terms and conditions, namely my specifications regarding methods of payment, and the fact that I required my name to appear on the work in its published form. We went on along this path and he took his time deliberating. Finally, he came to a decision and announced that he was ready to embark on his "American adventure." I sent an e-mail back recapitulating what we had already discussed in terms of fees and conditions, and that was it. Deed done. Die cast. Innocents that we were, we were off on what, at first, promised to be an uneventful journey.

Months went by as I completed two other books I was working on at the time. Once the translation process began, Giovanni and I kept in touch. He

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was always available to answer questions and provide clarification on points that were unclear to me. The translation was delivered in due time, and payment made promptly (or as promptly as possible considering the vagaries of international bank transfers). I turned to my next project, while Giovanni carefully read the translation. He knows English fairly well, but it still took a while for him to read and evaluate the work. Months later, he declared himself quite satisfied and started talking about publishing. It was only then that we each, in our own way, became aware of the prickly foliage that seemed to have somehow sprung up all around us. We had inadvertently entered the thicket of copyright law. Getting out again would not be that easy.

Trapped in the Thicket

Giovanni wanted to begin sending the translation around to publishers. Would it be safe to do so? The translation had not been copyrighted. Ah, the "c" word! When he asked me if it was standard practice in the U.S. for the author of the original work to register the copyright, we were off and running, each of us conducting our own research on the issue of copyright.

My first response was that the situation between the two of us was a little different, in that in my previous experience, it was the publisher who registered the copyright in the name of the translator. The translator, in turn, assigned the rights to the publisher until the book went out of print (or until the other agreed-upon terms occurred). I sent him a clause from a recent contract of mine with a publisher stating pretty much the same thing. Since, in our case, there was no publisher involved (at least not yet), I proposed the following: I would allow him to register the copyright in my name while ceding the rights back to him so as not to hinder his efforts to attract a publisher. I suggested assigning the rights to him until such time as the book was declared out of print, or for a period of 10 years if it was never published.

Giovanni wrote back that he had also looked into the matter, that there was "a way" of registering the work without resorting to a written document ceding the rights, and that he would be the owner of the copyright. With typical Italian *"ambiguità,"* he was not clear about what this "way of registering the work without a written document" might be. I asked him for an explanation, stating that I was fairly sure there had to be some formal agreement in order to transfer the rights from me to him.

Giovanni's next e-mail contained an attachment: Form TX, which the Library of Congress (LOC) Copyright Office requires in order to register a copyright. He had filled out the form

listing himself as the claimant and checking the box that indicated the translation was a "work made for hire." Moreover, he told me that in order to effect a transfer of copyright, it was necessary to go through the LOC, and that a *"scrittura privata,"* a formal agreement between the two of us, was not sufficient.

At this point, it was all too obvious to me that our innocent ramble had lead us into a tangle, and that we might not be able to find a clear path out of there.

I called for reinforcements.

The Lawyer's Perspective

Anne's predicament reminded me that all authors, including translators, should have a basic awareness of certain important aspects of U.S. copyright law. Anne mentioned that her situation with Giovanni was unusual, in that she was dealing with an individual writer, not a publisher. When it comes to knowing your rights, however, I don't think it really matters whether you are dealing with an individual or a corporation. Knowing as much as you can about your legal rights is always better than knowing less. Although an author may not be in the greatest bargaining position when it comes to negotiating with a publisher, since he may be willing to sign away whatever rights the publisher demands in order to get the book published, it seems to me that any individual should be clearly aware of his rights, even if he ultimately decides to contract them away to achieve other goals. A publisher might surprise you by agreeing to some other arrangement, and it never hurts to ask for what you want.

An Aerial View

Here, then, are a few things you should know about U.S. copyright law. This brief overview is by no means a complete discussion of this complex area of the law. I urge you to consult with your own attorney about any issue mentioned here, especially as concerns your own particular situation. Intellectual property rights can be economically and emotionally valuable to their owners. The consequences of a haphazard and ill-informed approach to copyright protection can be costly. If you are concerned about the expense associated with legal services, your lawyer may direct you to many fine publications, websites, and arts organizations where you can begin to educate yourself about your legal rights with your lawyer's guidance. The following will start you off with an aerial view of that juniper thicket in which Anne and Giovanni found themselves:

- The United States Copyright Act protects "original works of authorship fixed in any tangible medium of expression." It does not protect disembodied ideas.

- A copyright is actually a bundle of individual rights, such as the right to reproduce the work, the right to perform the work, and so forth.

- The entire bundle of rights or any one right from an author's bundle of copyrights can be transferred to another. An author may even grant another person permission to use one of his rights in a nonexclusive or limited way if he does not want to fully transfer that right.

- The right to create a derivative work is one of the bundle of rights, or any one right, held by the original author. Therefore, permission of the underlying author is required to create a derivative work.

- A "derivative work" is the term the Copyright Act gives to a work based on one or more pre-existing works.

- A translation is a derivative work. This is clearly stated in the Copyright Act.

- The creation of a derivative work (here, the translation), if that work satisfies the requirement of originality and is not itself an infringing work, will result in a separate copyright.

- Because of the nature of translation, every sizeable translation is entitled to its own copyright.

- The copyright in any derivative work covers only those elements original to the derivative work. In translation, because the underlying work is pervasive in the derivative work, and the original matter cannot be easily separated from the pre-existing matter, this can be a tricky principle to apply.

- A transfer of copyright ownership (not including nonexclusive licenses), other than by operation of law, whether by the original author to the translator or by the translator back to original author or publisher, requires a writing signed by the owner of the copyright for the transfer to have validity under copyright law.

- If the contract between the original author and translator specifies that the derivative work is a work-for-hire in exchange for a fee, the original author owns the copyright in the translation.

- Otherwise, absent a writing to the contrary, the translator owns

the copyright in what is original to the translation.

- Where the translator owns the copyright, rights extend only to the translation and not to the original work.

- Just as copyrights in original works have a lifespan, so do transfers. The law provides that the transferor can terminate the rights of the transferee after a specified period of time.

Armed with this information, Anne attempted to forge with Giovanni the tools with which they might hack their way out of the thicket.

The Translator's Tale Continued

Equipped with information I had not had at the outset, I took several days to deliberate before writing back to Giovanni. Citing from the appropriate sources, I told him that my understanding of the material I had read indicated that a translation is a "derivative work," that the "author" of the "derivative work" is the creator of the translation (me), and that he was the author of the original work, but not of the "derivative work" (the translation). I also pointed out that my translation of his novel was not a "work made for hire," since we had not executed a signed agreement specifically defining it as such, nor had either of us ever mentioned the term. If such an agreement had been executed, Giovanni, not I, would be considered the author of the translation. Clearly, I would never have agreed to such a condition had we discussed it. I concluded that since the translation was not a "work made for hire," I, as its author, should register the copyright in my name.

In an effort to salvage what appeared to be a rapidly degenerating situation, I admitted that in researching the issue of copyright, I had learned a great deal that I did not know before, and that perhaps there was something we could both learn from the experience. I reiterated to Giovanni that I did not want to get in his way or complicate his attempts to get the translation published, and proposed the following course of action. I would register the copyright in my name as the author of the translation, and that at the same time we would execute an agreement whereby I would transfer to him all the copyrights for the translation to enable its eventual publication.

No Way Out?

It was at this point that Giovanni came out with the exclamation *"E' davvero un bel ginepraio!"* While admitting that he might have made a mistake, and that I was the author of the translation and had the right to call myself such, he wanted me to give his name as the "Claimant" of the copyright and to state "Transfer" as the reason for it, implying that there had been a prior agreement between us. He also mentioned my ceding the copyrights to him *"definitivamente,"* that is, for good. I replied that I was prepared to go ahead and register the copyright in my name, but that I would not claim that there had been a "Transfer" when, in fact, there had been no prior accord between us. Instead, I sent him a draft M.O.A. (Memorandum of Agreement) that would assign the rights from me to him, explaining that he should feel free to modify the proposed conditions.

Giovanni's next communication stated again that a private agreement would not be sufficient to effect a transfer of copyright. He suggested we contact the LOC on this point. I repeated that the Copyright Office of the LOC did not effect transfers, but only recorded them. I referred him to Circular 1 which states:

> Transfers of copyright are normally made by contract. The Copyright Office does not have any forms for such transfers. The law does provide for the recordation in the Copyright Office of transfers of copyright ownership. Although recordation is not required to make a valid transfer between the parties, it does provide certain legal advantages and may be required to validate the transfer as against third parties.

Deeper into the Dark Wood

In Giovanni's final e-mail, it was clear that all prior attempts to extricate ourselves from the juniper thicket had failed: the copse was apparently impenetrable and held us fast. Sent in duplicate from two different e-mail addresses and signed with both a first and last name, the letter was strewn with angry exclamation points and numerous phrases in capital letters (known as shouting in e-mail parlance). In it, Giovanni stated that it was only right that he should be the owner of the copyright since he had paid for the translation, alleged that I was playing games with him, accused me of "concealing" the issue of copyright from the beginning, and charged me with being "unprofessional" and not the lovely person he had thought I was.

I was stunned. The tone of the e-mail was chilling. How had we ended up in this Dantean *"selva oscura,"* this dark place? Did Giovanni really see himself as the injured party, innocently caught up and manipulated

by the "*americana*?" Or had he been playing games himself, counting on my ingenuousness? If he had been angling to obtain the copyright from the beginning, perhaps he never mentioned it in an attempt to avoid confrontation through obfuscation. Such speculation was pointless, however. The more important question was this: What had I learned from the situation that might help me (and you, my colleagues) steer clear of such juniper thickets in the future?

The Lawyer's Summation

I'm not certain how or when Anne and Giovanni will emerge from their juniper prison. Clearly, the most important lesson to be learned from their ramble into what quickly became a dark and unfriendly place, is that it is easier to map a clear path through any thicket from a vantage point above and beyond it all.

A Better Map

A clearly written contract between the original author and the translator can provide a detailed map and well-defined path. Indeed, with enough foresight, the parties can plan their own detour around any potential pitfalls.

A few things to keep in mind:

- The rights and obligations of the author of the underlying work and the author of the translation may best be determined by a clearly written contract between them.

- No matter what your personal feelings might be about lawyers, think about consulting one before the fact, rather than after. The task of drafting a contract which clearly expresses the intentions of the parties and covers all the important points should ideally be handled by a legal professional.

- If it is the intention of the parties that the translator own the copyright in the translation, the agreement should specify what use the original author may make of the translation, if any. Because the translation and the original work are so inextricably entwined, the contract should also spell out in detail the translator's rights.

- A potential publisher will probably expect to see a clear chain of ownership of the rights in which it has interest and may seek to establish, among other things: that the pre-existing work was original and fixed in tangible form, and that the author of the underlying work truly owned the copyright to the original work; that he had the right to transfer all or a portion of his rights to others; that no previous transfers of the subject right occurred; and that the transfer of the right to create a derivative work to the translator was clear and exclusive (or, that it was documented as a work-for-hire).

- While not absolutely necessary, it would be wise to follow formalities: original signatures on real paper rather than electronic contracts (although the law now covers that possibility), notarized transfer documents, and Copyright Office registrations and records of transfers. At the very least, creating a clear record puts third parties on notice.

- Other legal requirements and conflict of law issues may come into play where citizens of different nations or U.S. states are involved (contract law and statutory writing requirements, for instance, may differ from state to state). There may also be issues with regard to jurisdiction and venue should a problem arise between parties in different locations. Parties may be able to agree up front to such things as choice of law, proper jurisdiction, appropriate venue, and alternative dispute resolution procedures (such as mediation) to reduce the likelihood of additional hassles should they come into conflict in the future over the subject matter of their written contract.

The joint objective of the parties should be to clearly document a fair, legal, and workable arrangement at the outset. Each deal is different, involving parties with unique motivations and agendas. That is why the written contract is important...to avoid misunderstandings, lawsuits, bruised egos, economic losses...all lurking in that juniper thicket and ready to ensnare some unsuspecting author or translator.

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