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The Ninth Circuit may have recognized that an actor has an independent copyright interest in her performance in order to achieve a desired result based on record that was sympathetic to the plaintiff. But, the authors argue and provide general practice pointers going forward, in doing so the appeals court may have upended well-established tenets of copyright law.

Garcia v. Google: Implications of the Ninth Circuit's Proposal That Actors Have Independent Copyrights in Their Own Performances



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On Feb. 26, the U.S. Court of Appeals for the Ninth Circuit granted an actress's request for a preliminary injunction requiring Google, Inc. to take down from YouTube.com an anti-Islamic film in which she appeared. The 2-1 opinion in *Garcia v. Google, Inc.*, No. 12-57302, 2014 BL 51739, 109 U.S.P.Q.2d 1799 (9th Cir. Feb. 26, 2014) (87 PTCJ 929, 2/28/14), authored by Chief Judge Alex Kozinski, has rapidly garnered a great deal of attention (87 PTCJ 995, 3/7/14), insofar as it sharply deviates from Ninth Circuit precedent, and appears to have been "reverse engineered" to reach a desired result—albeit for the noble purpose of attempting to protect the plaintiff against the threats and harassment that she claims to have suffered since the film appeared online.

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Of particular note—and the primary focus of this article—is the court's novel recognition of an *independent* copyright interest that actors and actresses have in their own performances, separate and apart from the copyrights in the underlying script or the film itself. Although the precedential value of the opinion remains to be seen, this facet of the case is of particular importance to content creators and providers because the court's sweeping language could be seized upon by many individual performers seeking to expand their

control over the use of not only their own performances in collaborative works, but also the collaborative works themselves.

I. Background

Plaintiff Cindy Lee Garcia alleged that she was cast by a film writer and producer (also defendants in the action, but who did not answer the complaint and were not the subject of the preliminary injunction motion at issue) to perform a minor role in an Arabian adventure film entitled ''Desert Warrior.'' Garcia was given the four pages of the script in which her character was to appear, and was paid $500 for three-and-a-half days of filming. However, Garcia's performance—much to her surprise—was modified and ultimately used in an approximately five-second clip in an anti-Islamic film entitled ''Innocence of Muslims,'' which was broadcast via YouTube. The film spurred protests, including the issuance of a fatwa by an Egyptian cleric calling for the killing of everyone involved in the film. After purportedly receiving death threats, Garcia requested that Google take down the film from YouTube pursuant to the takedown provisions of the Digital Millennium Copyright Act. Google refused.

Garcia brought suit in the Central District of California for, among other claims, direct and secondary copyright infringement.[1] On Nov. 30, 2012, the court denied Garcia's motion for a preliminary injunction in a short, three-page opinion.[2] After pointing out that Garcia did not appear to establish a likelihood of irreparable harm because of a five month delay in seeking preliminary relief, the court noted that Garcia did not claim to be either the sole author or a joint author of the film. Rather, Garcia was contending that she owned the copyright in her performance in the film, and, the court reasoned ''[e]ven if this copyright interest were cognizable and proven''—a question that the district court did not address—''Garcia necessarily (if impliedly) would have granted the Film's author a license to distribute her performance as a contribution incorporated into the indivisible whole of the Film.''[3]

II. The Ninth Circuit Majority Opinion

On appeal, the Ninth Circuit addressed Garcia's claim to an independent copyright in her own performance, presenting what the court framed as the ''rarely litigated question'' as to ''[w]hether an individual who makes an independently copyrightable contribution to a joint work can retain a copyright interest in that contribution.''[4] The court opted not to address the issue of whether an actor must ''personally fix his work in a tangible medium'' to be considered the author of their independently copyrightable work because it was not raised by the parties, but invited the parties to ''raise it in the district court on remand.''[5] Instead, the court emphasized the important creative role that an actor plays in making dialogue written by others come to life, even citing to Constantin Stanislavski's famous treatise on method acting, ''An Actor Prepares.''[6] Accordingly, the court reasoned, even though Garcia did not write the words she spoke in the film, her performance evinced the requisite minimal creativity to be copyrightable.[7]

The majority devoted the remainder of its opinion to explaining why the filmmakers lacked authorization to use Garcia's copyrightable performance in the manner that they did. First, Garcia's work was not a ''work made for hire'' because she was not an ''employee'' of the filmmakers and did not sign any agreement with the filmmakers containing a work for hire provision.[8] Second, Garcia could not have granted the film's creators an implied license to use her copyrightable performance in the anti-Islamic film, because whatever license she granted to use her performance could not have extended to a film that ''differs so radically from anything Garcia could have imagined when she was cast.''[9] The court did, however, recognize that licenses to utilize an actor's performance should be construed fairly broadly so as to avoid giving the actor ''de facto authorial control over the film,''[10] and suggested that a filmmaker could only exceed the bounds of that implied license in ''extraordinarily rare'' situations.[11]

Finally, the court pointed out that Garcia was suffering irreparable harm from the ''ongoing infringement'' because she was continuing to receive death threats.[12] Noting Garcia's ''unwitting and unwilling inclusion'' in the film, the court explained that the case is ''troubling'' and granted the preliminary injunction against Google.[13]

The Ninth Circuit Dissent

In a lengthy dissent, Circuit Judge N. Randy Smith asserted that the majority erred in granting the preliminary injunction requiring Google to remove the film from YouTube.

With respect to Garcia's copyright interest, Judge Smith concluded that Garcia could not have an independently protectable interest in her performance for three reasons. First, an ''acting performance'' does not constitute a copyrightable ''work'' under the Copyright Act. In this regard, Section 101 of the Copyright Act distinguishes between works and the acting out of those works by: (1) not listing ''acting performances'' – as opposed to ''motion pictures'' – as an example of copyrightable ''works;'' and (2) defining ''perform a 'work' '' to specifically include ''to recite, render, play, dance, or act it.''[14] Second, Garcia is not an ''author'' under the Copyright Act and pursuant to Ninth Circuit judicial precedent because she did not superintend or ''master mind'' the work,[15] nor did she actually '' 'create[ ] the work' '' or '' 'translat[e] an idea into a fixed, tangible

[1] Garcia also brought claims for fraud, unfair business practices, libel, and intentional infliction of emotional distress. These state law claims, however, were not the basis for her preliminary injunction motion.

[2] CV12-08315-MWF (VBKx) (C.D. Cal. Nov. 30, 2012), at 3.

[3] *Id*. at 3.

[4] 109 U.S.P.Q.2d at 1801.

[5] *Id.* at 1801 n.4.

[6] *Id*. at 1801.

[7] *Id*.

[8] *Id*. at 1803.

[9] *Id.* at 1804.

[10] *Id*.

[11] *Id*.

[12] *Id.*

[13] *Id.* at 1805.

[14] *Id.* at 1807 (citing 17 U.S.C. § 101).

[15] *Id*. (quoting *AalMuhammed v. Lee*, 202 F.3d 1227, 1234 53 U.S.P.Q.2d 1661 (9th Cir. 2000)).

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expression entitled to copyright protection.' ''[16] Rather, Garcia's brief appearance and acting out of others' ideas was insufficient to make her an author of the entire film or of her own performance. Finally, Garcia's acting performance is ''too personal to be fixed.''[17] Elaborating on precedent, the dissent contended that individual ''singing'' or ''acting'' as part of a collaborative work that has many ''moving parts'' is not independently ''fixed,'' but is only ''fixed'' as part of the greater work—i.e., the musical recording or the audiovisual work like a movie.[18]

III. The Troubling Real-World Implications of the Ninth Circuit's Reasoning

The majority's expansive conception of copyright law as providing rights to an actor in their individual performances—independent from the script, direction or fixation of that performance in a filmed scene—is not only a divergence from copyright law jurisprudence, but also could have extremely wide-reaching implications for the media and entertainment industry. If any performer who participates in the creation of a copyrightable work, no matter how minor their role may be, can obtain an independent copyright in their individual performance solely by virtue of contributing some modicum of creativity and originality to their craft, virtually all television shows or films would by default consist of work owned by dozens, if not hundreds, of putative copyright owners of discrete portions of those shows or films.

Complex works could become infinitely divisible into small, competing copyright interests. Just as an actor could seek to protect their own performance in a movie, an individual violin player could seek to protect their own playing when their orchestra performs a musical work; an individual model could seek to protect their posture during a photo shoot; a dancer could seek to protect their own movements in a choreographical work; an individual builder could protect their own bricklaying in an architectural work (although one would hope for safety's sake that they would not exercise much creativity beyond the engineer's specifications). These are, of course, somewhat extreme examples. Nevertheless, this exercise in *reductio ad absurdum* reflects the troubling implications of the Ninth Circuit's reasoning.

Needless to say, such a construct would be incredibly cumbersome (if not absurd), and ignores the practical realities of creating collaborative works, particularly in entertainment media. The Ninth Circuit seems to recognize this but believes that the notion of a ''broadly construed'' implied license to use an actor's performance largely solves the issue, even in the absence of an express license. Yet this answer is not particularly satisfying. First, the implied license construct invites opportunistic litigation; notwithstanding Judge Kozinski's warning against actors ''leverag[ing] their individual contributions into de facto authorial control over the film,'' courts will no doubt be faced with myriad performers flooding the courts with claims that the way that their particular performances were manipulated by filmmakers and other content creators was outside the scope of their implied license. Second, the majority's approach to determining whether a performance is outside the scope of an implied license amounts to little more than ''I know it when I see it;'' asking simply whether ''the film differs so radically from'' an actor's expectations is not a particularly meaningful guide for future jurisprudence.

Best Practices for Content Creators

Ultimately, it is difficult to tell what precedential value this case will have. There may well be en banc review and/or a petition for *certiorari*.[19] Even without reversal, the extraordinary factual circumstances of the case and the centrality of a person's health and safety (truly unusual for a copyright case) may render the opinion a compelling candidate for *sui generis* treatment both within and without the Ninth Circuit. But the language and reasoning of the majority opinion has for the moment created a significant risk for content creators—including, for example, television and film production companies and studios—that may not always pay attention to copyright issues related to individual performers in their works.

Accordingly, content creators should consider the following ''best practices'' when securing the services of creative performers to avoid unwittingly using a performance beyond the scope of any ''implied license'':

- Enter into written contracts with all performers, no matter how minor the role or creative contribution may be.

- Contracts with performers should specifically address copyright ownership, providing that the performers' work—to the extent deemed copyrightable—constitutes ''work made for hire.'' In the alternative, the agreement should state that any copyright ownership in the performance held by the performer is being expressly assigned. From a content owner's perspective, the former is preferable because, unlike work that has been assigned, ''work made for hire'' is not subject to any termination rights.[20]

- Contracts with performers should include language expressly providing the content owner with the right to use a performance—including derivative works of that performance (e.g., outtakes, still photographs, etc.)—for any and all purposes.

- Relatedly, contracts should provide that performers expressly disclaim any ''moral rights'' that may sub-

[16] *Id*. (quoting *Comty. For Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989)).

[17] *Id.* at 1810.

[18] *Id.* at 1810-11. Judge Smith further asserts that the majority should have afforded the district court greater deference with respect to irreparable harm. *Id.* at 1811.

[19] On Feb. 28, the Ninth Circuit refused to grant Google's motion for an emergency stay, but modified the Order to state that it did not preclude the posting or display of any version of the film that did not include Garcia's performance. No. 12-57302 (9th Cir.), Dkt. 45. On March 6, Ninth Circuit Judge Sidney R. Thomas requested a vote to rehear en banc the denial of the stay of the Order, independent of any petitions for rehearing that Google may request. *Id*. Dkt. 46. That request was denied March 14 (*Id*. Dkt. 64), but on March 12 Google filed its own petition for en banc review. *Id.* Dkt. 57.

[20] *See* 17 U.S.C. § 203. Under the Copyright Act, assignments of copyright can be terminated by authors 35 years after the assignment.

sist in their creative performances throughout the world, and that content creators may exercise complete creative control over how to utilize that performance.

■ Contracts should also note that the final creative work may vary substantially from scripts, treatments, or other underlying works on which the final product is based.

Conclusion

The majority in *Garcia* sought to achieve what it viewed as the morally ''right result,'' but copyright law was an ill-suited vehicle to achieve that goal. In reverse engineering its decision to attempt to protect the plaintiff, the Ninth Circuit majority did not pay proper attention to how its reasoning would so sharply diverge from fundamental copyright principles and established jurisprudence. Upsetting a copyright framework that has adapted to decades of common practices in the entertainment industry will lead to a great deal of confusion—and inevitably increased litigation.

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