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# GARCIA V. GOOGLE: AUTHORSHIP IN COPYRIGHT

Diana C. Obradovich<sup>†</sup>

While so many people contribute creatively to a film, only a small portion can legally claim a copyright in their work, and an even smaller portion can claim a copyright in the finished film. If every single actor, director, and set designer had an independent copyright in his or her contribution to a film, the film industry could be left in disarray. By default, each film would be made up of dozens, if not hundreds, of copyright owners.<sup>1</sup> And each individual copyright owner could halt distribution of an entire film, no matter how small of role he or she plays in creating the final work.

This Note focuses on the implications of the Ninth Circuit's recent decision in *Garcia v. Google*, and in particular which contributors to an integrated work can claim copyright in that work. While *Garcia*, and a Second Circuit opinion that relies on it, expand copyright ownership jurisprudence to new factual situations, the decisions do not substantially change copyright ownership doctrine.<sup>2</sup> In *Garcia v. Google*, the Ninth Circuit held that an actress who appeared for only five seconds in a film had no copyright interest in her performance within the film.<sup>3</sup> The Second Circuit quickly followed *Garcia* in *16 Casa Duse v. Merkin*,<sup>4</sup> finding that a director could not claim a copyright in his direction separate and apart from the film itself.<sup>5</sup>

Part I of this Note reviews copyright jurisprudence and introduces case law relevant to copyright ownership. Part II discusses the *Garcia v. Google*

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1. Anthony Dreyer et al., *Garcia v. Google: Implications of the Ninth Circuit's Proposal That Actors Have Independent Copyrights in Their Own Performances*, BLOOMBERG L. (Apr. 9, 2014), <http://www.bna.com/garcia-google-implications-n17179889476> [<https://perma.cc/X6X8-7F5E>].

2. The *Garcia v. Google* decision also had a strong impact on (and spawned controversy over) First Amendment implications of granting or denying the preliminary injunction, but this Note will not address those implications.

3. *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. 2015) (en banc).

4. 791 F.3d 247 (2d Cir. 2015). *16 Casa Duse, LLC v. Merkin* was released on June 29, 2015. The *Garcia* opinion was released on May 18, 2015.

5. *Casa Duse*, 791 F.3d at 254.

decision, as well as the Second Circuit's *16 Casa Duse v. Merkin* decision, which relied heavily on *Garcia*. In Part III, this Note examines the effects of these recent decisions on copyright ownership jurisprudence. Finally, Part IV examines the practical implications of these decisions on the entertainment industry.

## I. COPYRIGHT OWNERSHIP JURISPRUDENCE BEFORE *GARCIA*

Copyright protection originated as a right granted in the United States Constitution, which Congress codified in the Copyright Act.<sup>6</sup> Since then, Congress has amended the Copyright Act numerous times to account for changing technologies and the novel opportunities and challenges they pose to authors.<sup>7</sup> In particular, the movie industry has had its own impact on copyright law as it exists today.

### A. HISTORY AND DEVELOPMENT OF COPYRIGHT

The United States Constitution grants Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>8</sup> Under that grant of power, Congress implemented the Copyright Act of 1790.<sup>9</sup> At that time, the Act granted copyright protection to only maps, charts, and books printed in the United States.<sup>10</sup> Authors were accorded the “sole right and liberty of printing, reprinting, publishing and vending” of their works for a period of fourteen years, with the ability to renew for another fourteen years.<sup>11</sup>

The first key revision to the Copyright Act came in 1831, when Congress extended the term of copyright protection to twenty-eight years, with the opportunity to renew that protection for another fourteen years.<sup>12</sup> Between 1831 and 1865, Congress added musical compositions,<sup>13</sup> dramatic

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6. Act of May 31, 1790, ch. 15, 1 Stat. 124.

7. See 1-OV MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT (2015).

8. U.S. CONST. art. I, § 8, cl. 8.

9. Act of May 31, 1790, ch. 15, 1 Stat. 124. For a history of the beginnings of copyright law in the United States, see SIVA VAIDHYANATHAN, COPYRIGHTS AND COPYWRONGS: THE RISE OF INTELLECTUAL PROPERTY AND HOW IT THREATENS CREATIVITY 43–47 (2001).

10. Act of May 31, 1790, ch. 15, 1 Stat. 124.

11. *Id.*

12. Copyright Act of 1831, 4 Stat. 436.

13. *Id.*

compositions,<sup>14</sup> and photographs and their negatives<sup>15</sup> to the list of copyrightable materials. In 1870, the Copyright Act redefined “writings” to include “any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts.”<sup>16</sup>

The Copyright Act received a major overhaul in 1909. This time Congress chose not to specifically define what constituted a copyrightable work; instead it stated that all “writings of an author” are copyrightable works.<sup>17</sup> Congress did include a list of “classes” of acceptable copyrightable works, but this list did not “limit the subject-matter of copyright.”<sup>18</sup> Congress also further extended the term of copyright protection to twenty-eight years, with the opportunity to renew for another twenty-eight years.<sup>19</sup>

#### B. THE COPYRIGHT ACT OF 1976

The 1976 Act is the most recent revision to the Copyright Act, governing all works created on or after January 1, 1978.<sup>20</sup> This revision updated the scope and subject matter of copyrightable works, fair use and other defenses to copyright infringement, and copyright notice requirements.<sup>21</sup> Congress also extended the term of copyright protection to the life of the author plus fifty years, or seventy-five years after creation for a work-for-hire.<sup>22</sup> A later amendment extended protection for an additional twenty years.<sup>23</sup>

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14. Act of Aug. 18, 1856, 11 Stat. 139.

15. Act of Mar. 3, 1865, 13 Stat. 540.

16. Act of July 8, 1870, § 86, 16 Stat. 212.

17. Copyright Act of 1909, § 4, 35 Stat. 1075.

18. *Id.* at § 5.

19. *Id.* at § 23.

20. 17 U.S.C. § 302 (2012); *see also* VAIDHYANATHAN, *supra* note 9, at 25 (“All works created since 1978 fell under the 1976 revision [of the Copyright Act].”). Works created before January 1, 1978 but still protected as of January 1, 1978 follow the terms set out in 17 U.S.C. § 304 (2012).

21. 17 U.S.C. § 107.

22. 17 U.S.C. § 302 (1994).

23. In 1998, the Sonny Bono Copyright Term Extension Act extended the term of copyright protection by another twenty years. Under this extension, copyright protection under the 1976 Act exists for the life of the author plus seventy years. However, if the author is a corporation, copyright protection exists for either ninety-five years from the date of publication or 120 years from the date of creation, whichever is shorter. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998).

Under the 1976 Act, “[c]opyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression.”<sup>24</sup> Thus, to obtain copyright protection a work must satisfy three requirements: the work must be (1) original, (2) a work of authorship, and (3) fixed. The first major change to note is that Congress broadened the scope of copyrightable works to include all “works of authorship,” not just “writings.”<sup>25</sup> Although the Act does not define “works of authorship,”<sup>26</sup> it does include a list of categories that Congress deemed “works of authorship.”<sup>27</sup> The categories include “literary works,” “musical works, including any accompanying words,” “dramatic works, including any accompanying music,” “pantomimes and choreographic works,” “pictorial, graphic, and sculptural works,” “motion pictures and other audiovisual works,” “sound recordings,” and “architectural works.”<sup>28</sup> This list, however, is not exhaustive.<sup>29</sup> Even with a broad scope of copyrightable works, “not every piece of writing is subject to protection under copyright.”<sup>30</sup>

Congress also no longer requires registration with the Copyright Office to obtain copyright protection under the 1976 Act.<sup>31</sup> Copyright protection is instead established at the moment of creation.<sup>32</sup> However, copyright registration is required for an author to pursue an infringement action.<sup>33</sup>

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24. 17 U.S.C. § 102(a) (2012).

25. *See id.*

26. H.R. REP. NO. 94-1476, at 51 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659 (“The phrase ‘original works of authorship,’ . . . [wa]s purposely left undefined” with the intent “to incorporate without change the standard of originality established by the courts under the present copyright statute.”). Congress intended to leave the term undefined in order to accommodate the constantly changing technological developments in our society that lead to “new forms of creative expression that have never existed before. . . . Authors are continually finding new ways of expressing themselves, but it is impossible to foresee the forms that these new expressive methods will take.” However, subject matter is not unlimited under this undefined term. *Id.*

27. *See* 17 U.S.C. §§ 102(a)(1)–(8).

28. *Id.*

29. *See id.* (“include, but are not limited to”).

30. Daniel Miranda Facó, Copyright Extension and the Motion Picture Industry – The Rationality Behind the Bono Act (1999) (unpublished manuscript), [http://hottopos.com/harvard3/daniel.htm#\\_ftnref16](http://hottopos.com/harvard3/daniel.htm#_ftnref16) [<https://perma.cc/8TS7-7C69>].

31. U.S. COPYRIGHT OFFICE, COPYRIGHT NOTICE, CIRCULAR 3, at 1 (Feb. 2013).

32. 17 U.S.C. § 302(a) (2012) (“Copyright in a work . . . subsists from its creation.”); *see* VAIDHYANATHAN, *supra* note 9, at 24 (“[A] work is protected . . . as soon as it is fixed in a tangible medium of expression.”).

33. 17 U.S.C. § 411 (2012); VAIDHYANATHAN, *supra* note 9, at 25.

### 1. Originality

Copyright protection requires originality.<sup>34</sup> However, under *Feist Publications, Inc. v. Rural Telephone Service Co.*, a work easily satisfies that requirement: it need only be an independent creation that exhibits a mere “modicum of creativity.”<sup>35</sup> A work is generally considered original unless its “creative spark is utterly lacking or so trivial as to be virtually nonexistent.”<sup>36</sup> In *Feist*, the Court also rejected the “sweat of the brow” doctrine, requiring more than just hard work in creating something in order to get copyright protection.<sup>37</sup>

### 2. Work of Authorship

Copyright “vests initially in the author or authors of the work.”<sup>38</sup> Thus, not only must an author be identified, but the work must fall under the appropriate subject matter of copyright to qualify as a “work of authorship.”<sup>39</sup> Under early copyright doctrine, the author was merely the work’s creator.<sup>40</sup> However, as copyright doctrine has evolved, the work-for-hire doctrine and concepts of joint authorship have complicated the notions of authorship.<sup>41</sup>

The leading case on authorship is *Burrow-Giles Lithographic Co. v. Sarony*,<sup>42</sup> where the Supreme Court considered whether a photographer owned the copyright in his photograph of Oscar Wilde.<sup>43</sup> The Supreme Court held that the photographer owned the copyright, as he was the “author.”<sup>44</sup> In making this determination, the Court found that an author is the person who “superintended” the work—the “master mind” of the

34. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

35. *Id.* at 345–46 (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01[A], [B] (1990)).

36. *Id.* at 359 (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.08[C][1] (1990)).

37. *Id.* at 359–60 (rejecting the “sweat of the brow” doctrine from *Jeweler’s Circular Publishing Co. v. Keystone Publ’g Co.*, 281 F. 83, 88 (2d Cir. 1922)); see 1 NIMMER & NIMMER, *supra* note 7, at § 3.04.

38. 17 U.S.C. § 201(a) (2012).

39. See *id.* at § 102(a).

40. *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

41. See *infra* Section I.B.2.a).

42. 11 U.S. 53 (1884).

43. *Id.* at 56.

44. *Id.* at 61.

piece.<sup>45</sup> It is the author “who really represents, creates, or gives effect to the idea, fancy, or imagination.”<sup>46</sup>

a) “Work Made for Hire” Doctrine

Although the author of a work will frequently be the creator of the work, like the photographer in *Burrow Giles*, there are times when someone *other than* the work’s creator is considered the “author” for purposes of federal copyright law. This can occur under the “work made for hire” doctrine (a.k.a. work-for-hire doctrine), where “the employer or other person for whom the work was prepared is considered the author.”<sup>47</sup> This doctrine applies if a work is created within the scope of employment or if a work is specifically commissioned as a work made for hire.<sup>48</sup> In the latter context, a “work made for hire” is “a work specially ordered or commissioned for use” in one of a limited number of specified works “if the parties expressly agree in a written instrument signed by [both parties].”<sup>49</sup> Motion pictures are included among the limited list of works.<sup>50</sup> Thus, unless an express written agreement states otherwise, employers own “all of the rights comprised in the copyright,”<sup>51</sup> making the term “author” simply a term of art.<sup>52</sup>

b) Joint Works and Joint Authorship

Because a film consists of numerous contributions by many different “authors,” it is typically considered a “joint work.”<sup>53</sup> Under the 1976 Act, a “joint work” is “a work prepared by two or more authors with the *intention* that their contributions be merged into inseparable or interdependent parts

45. *Id.*

46. *Id.*

47. 17 U.S.C. § 201(b) (2012).

48. The work-for-hire doctrine only applies to a narrow list of works: a contribution to a collective work, a part of a motion picture or other audiovisual work, a translation, a supplementary work, a compilation, an instructional text, a test, answer materials for a test, or an atlas. 17 U.S.C. § 101 (2012); *see* 1 NIMMER & NIMMER, *supra* note 7, at § 5.03.

49. 17 U.S.C. § 101.

50. 17 U.S.C. § 101. Legislative history shows that “movie tycoons” pushed Congress to include motion pictures in this part of the provision. MICHAEL C. DONALDSON & LISA A. CALLIF, CLEARANCE & COPYRIGHT 166 (4th ed. 2014).

51. 17 U.S.C. § 201(b).

52. Catherine L. Fisk, *Authors at Work: The Origins of the Work-for-Hire Doctrine*, 15 YALE J. L. & HUMAN. 1, 5 (2003).

53. 1 NIMMER & NIMMER, *supra* note 7, at § 6.05; *see also* Makoa Kawabata, *Building Character: How to Grant Actors Limited Copyright Protection for Performances Without Creating a New Species of Copyrighted Work*, 16 TEX. REV. ENT. & SPORTS L. 1, 15 (2014).

of a unitary whole.”<sup>54</sup> Not all contributors to a joint work, however, are considered “joint authors.”<sup>55</sup>

If an individual claims joint authorship, courts in different circuits analyze the facts under differing, yet similar, tests. For example, the Second Circuit follows the test set forth under *Childress v. Taylor*, where each party’s contribution must be independently copyrightable and the parties must intend to be joint authors at the time of creation.<sup>56</sup> The Ninth Circuit, on the other hand, has an added requirement that each party be an “author” within the meaning of the Copyright Act.<sup>57</sup> This means that each party must “superintend[] the work by exercising control” while demonstrating an “objective manifestation[] of a shared intent to be coauthors.”<sup>58</sup> The primary focus under both of these tests, however, is the intent of the parties to be joint authors.

Congress has provided some guidance by noting that “a work is ‘joint’ if the authors collaborated with each other, or if each of the authors prepared his or her contribution with the knowledge and intention that it would be merged with the contributions of other authors as ‘inseparable or interdependent parts of a unitary whole.’”<sup>59</sup> The emphasis here is on the intent of the parties: At the time the work was created, did the parties intend for their contributions to be “absorbed or combined into an integrated unit”?<sup>60</sup>

### c) Copyrightable Work

Moreover, the work created must be a “work of authorship.”<sup>61</sup> As discussed above, Congress purposely left the term “work of authorship” undefined, thus leaving for the courts to answer the question of whether the author had produced something copyrightable.<sup>62</sup> In the film context, many

54. 17 U.S.C. § 101 (emphasis added).

55. See *Aalmuhammed v. Lee*, 202 F.3d 1227, 1233 (9th Cir. 2000) (“[C]ontribution of independently copyrightable material to a work intended to be an inseparable whole will not suffice to establish authorship of a joint work.”).

56. *Childress v. Taylor*, 945 F.2d 500 (2d Cir. 1991).

57. *Aalmuhammed*, 202 F.3d at 1232.

58. *Id.* at 1234 (internal quotations omitted).

59. H.R. REP. NO. 94-1476, at 120 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5756.

60. Seth F. Gorman, *Who Owns the Movies? Joint Authorship under the Copyright Act of 1976 after Childress v. Taylor and Thomson v. Larson*, 7 UCLA ENT. L. REV. 1, 4–5 (1999).

61. 17 U.S.C. § 102 (2012).

62. See R. Anthony Reese, *Copyrightable Subject Matter in the “Next Great Copyright Act,”* 29 BERKELEY TECH. L.J. 1489, 1500–02 (2014) (discussing how “things that have not traditionally been thought of as copyrightable works” could constitute a “work of authorship” “even if the creation does not fall within one of the statute’s expressly enumerated categories of protected works”); Trotter Hardy, *The Copyrightability of New*



people contribute to a motion picture, but “those contributions ultimately merge to create a unitary whole.”<sup>63</sup> Therefore, copyright protects the “totality of the contributions . . . as a complete work and not a single performance taken out of the context of the whole.”<sup>64</sup> Further, because “a motion picture would normally be a joint rather than collective work with respect to those authors who actually work on the film” and contributors to the production of a film generally hold the status of “employees for hire,” the question of authorship or coownership rarely arises.<sup>65</sup> As discussed by the *Burrow-Giles* Court, not every “copyrightable contribution to a motion picture” can be a “work” that is “separately copyrightable from the motion picture itself, any more than Oscar Wilde’s ‘substantial copyrightable creative contribution’ of appearing in a photograph or the lithographer’s similarly copyrightable efforts were ‘works’ separate from the photograph itself.”<sup>66</sup>

### 3. Fixation

Finally, in order to gain copyright protection, a work must be fixed “by or under the authority of the author.”<sup>67</sup> While the “act of fixation is not what makes someone an author,”<sup>68</sup> a work is not entitled to copyright protection unless the work is fixed in a “tangible medium of expression.”<sup>69</sup>

## C. DEVELOPMENT OF THE AUTHORSHIP DOCTRINE IN THE FILM INDUSTRY

The film industry has had an impact on the development of the authorship doctrine due to the fact that many individuals are involved in the making of a film.

Under the Copyright Act, “motion pictures” are defined as “audiovisual works consisting of a series of related images which, when shown in

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*Works of Authorship: “XML Schemas” as an Example*, 38 HOUS. L. REV. 855, 860 (2001) (discussing how courts struggle to find copyrightability in new technologies such as software).

63. *Richlin v. Metro-Goldwyn-Mayer Pictures, Inc.*, 531 F.3d 962, 975 (9th Cir. 2008).

64. Brief of Volunteer Lawyers for the Arts, Inc. as Amici Curiae in Support of Defendants-Appellees at 7, *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014) (No. 12-57302).

65. H.R. REP. NO. 94-1476, at 120 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659.

66. *Kawabata*, *supra* note 53, at 15 (discussing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 61 (1884)).

67. 17 U.S.C. § 101 (2012).

68. Russ VerSteeg, *Defining “Author” For Purposes of Copyright*, 45 AM. U. L. REV. 1323, 1336 (1996).

69. 17 U.S.C. § 102(a).

succession, impart an impression of motion.”<sup>70</sup> Because motion pictures are generally a collaborative effort, with many individuals contributing various creative efforts,<sup>71</sup> they are typically deemed “joint works.”<sup>72</sup>

In the absence of correctly worded written agreements defining the issue, the number of people involved in creating a motion picture can make authorship a “difficult question.”<sup>73</sup> This problem is typically solved through the “work-for-hire provisions of § 101 and the assignment provisions of § 204.”<sup>74</sup> While the work-for-hire provision initially emerged in the 1909 Act (for the benefit of employers) “to aid the publishers of encyclopedias and periodicals,”<sup>75</sup> the effects of the provision became “much more powerful in other industries,” including the film industry.<sup>76</sup> The issue of authorship or co-authorship rarely arises because contributors to the production of a film generally hold the status of “employee for hire.”<sup>77</sup>

Contributions to a motion picture “ultimately merge to create a unitary whole.”<sup>78</sup> Therefore, the intent to collaborate and merge with others results in an intent to create an inseparable unitary work. Furthermore, “a performer’s appearance in a motion picture is not a discrete or separate motion picture incorporated into the motion picture.”<sup>79</sup> It is generally impossible to remove just one actor’s contribution from a scene because the actor speaks the words of the script, wears the costume designed by the costume designer, is heard because of the sound technician, and gives a performance under the direction of the director.

## II. THE NINTH AND SECOND CIRCUIT DECISIONS

*Garcia v. Google* was the first case to question whether a contributor to an integrated work has an independent copyright in his or her contribution when that contribution was intended to merge with other contributions into

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70. 17 U.S.C. § 101.

71. See Gorman, *supra* note 60, at 4.

72. H.R. REP. NO. 94-1476, at 120 (1976); accord S. REP. NO. 94-473, at 103–04 (1975) (including “motion pictures” as an example of joint works under the statute).

73. See Gorman, *supra* note 60, at 4.

74. *Id.*

75. VAIDHYANATHAN, *supra* note 9, at 102.

76. *Id.*

77. H.R. REP. NO. 94-1476, at 121 (1976) (“The presumption [sic] that initial ownership rights vest in the employer for hire is well established in American copyright law.”); VAIDHYANATHAN, *supra* note 9, at 102 (noting that contributors to a film “whom could philosophically claim ‘authorship’ . . . regularly sign away control of their work to a studio”).

78. *Richlin v. Metro-Goldwyn-Mayer Pictures, Inc.*, 531 F.3d 962, 975 (9th Cir. 2008).

79. *Kawabata*, *supra* note 53, at 14 (citation omitted).

an inseparable whole. In this case, the Ninth Circuit ultimately held that an actress did not have a copyright in her five-second performance within a film. Shortly after the release of the *Garcia* opinion, the Second Circuit followed *Garcia* in finding that a director did not have a separate copyright in his direction of a film.<sup>80</sup>

#### A. THE NINTH CIRCUIT: *GARCIA V. GOOGLE*

*Garcia v. Google* spent over fifteen months in the Ninth Circuit in order to determine whether an actress, in her five-second performance within a film, can have an independent copyright in her own performance, separate and apart from the film itself. Initially, a Ninth Circuit panel found that *Garcia*, the actress whose performance was at issue, likely did have a copyright interest in her performance.<sup>81</sup> The decision sparked a flood of criticism from the legal community as well as content producers and providers.<sup>82</sup> This holding was, however, reversed by an en banc panel, leading that same community to find copyright law restored.<sup>83</sup>

80. 16 Casa Duse v. Merkin, 791 F.3d 247 (2d Cir. 2015).

81. *Garcia v. Google, Inc.*, 766 F.3d 929, 940 (9th Cir. 2014).

82. See, e.g., Venkat Balasubramani, *In Its "Innocence of Muslims" Ruling, the Ninth Circuit is Guilty of Judicial Activism—Garcia v. Google*, TECH. & MKTG. L. BLOG (Feb. 27, 2014), <http://blog.ericgoldman.org/archives/2014/02/in-its-innocence-of-muslims-ruling-the-ninth-circuit-is-guilty-of-judicial-activism-garcia-v-google.htm> [https://perma.cc/Z29Q-2GYU]; Mike Masnick, *Horrorific Appeals Court Ruling Says Actress Has Copyright Interest in 'Innocence of Muslims,' Orders YouTube to Delete Every Copy*, TECHDIRT (Feb. 26, 2014), <https://www.techdirt.com/articles/20140226/12103626359/horrific-appeals-court-ruling-says-actress-has-copyright-interest-innocence-muslims-orders-youtube-to-delete-every-copy.shtml> [https://perma.cc/4GZV-TYVT]; Anandashankar Mazumdar, *Commenters Criticize Garcia Ruling on Constitutional and Practical Concerns*, BLOOMBERG BNA (Mar. 5, 2014), <http://www.bna.com/commenters-criticize-garcia-n17179882601> [https://perma.cc/JK79-3P3X]; Corynne McSherry, *Bad Facts, Really Bad Law: Court Orders Google to Censor Controversial Video Based on Spurious Copyright Claim*, ELEC. FRONTIER FOUND. (Feb. 26, 2014), <https://www.eff.org/deeplinks/2014/02/bad-facts-really-bad-law-court-orders-google-censor-controversial-video-based> [https://perma.cc/33WB-N4WM]; Jesse Woo, *Garcia v. Google: Copyright Is Not Always the Answer*, WASH. LAWYERS FOR THE ARTS BLOG (Apr. 18, 2014), <http://thewla.org/garcia-v-google-copyright-is-not-always-the-answer> [https://perma.cc/8BTA-G2TQ].

83. See David Kluff, *"Hollywood Circuit" Court Issues En Banc Decision in Garcia v. Google: No Copyright Protection for Fleeting Dramatic Performance*, TRADEMARK & COPYRIGHT L. BLOG (May 18, 2015), <http://www.trademarkandcopyrightlawblog.com/2015/05/hollywood-circuit-court-issues-en-banc-decision-in-garcia-v-google-no-protection-for-fleeting-dramatic-performance> [https://perma.cc/H6PT-6W57] (“reaffirm[ing] a more traditional view of film authorship for copyright purposes”).

### 1. Background

This case began in July 2011, when Cindy Lee Garcia (“Garcia”) auditioned for and landed a minor role in a low-budget film entitled *Desert Warrior*.<sup>84</sup> Garcia, along with the rest of the cast, believed that *Desert Warrior* was going to be an “action-adventure thriller set in ancient Arabia.”<sup>85</sup> Garcia was given only the four pages of the script in which her character appeared.<sup>86</sup> Filming her scene took three and a half days,<sup>87</sup> for which she was paid a total of \$500.<sup>88</sup> However, nothing ever came of *Desert Warrior*.<sup>89</sup> Instead, Garcia later encountered her scene on YouTube as part of an anti-Islamic film entitled *Innocence of Muslims*, which depicted the Prophet Mohammed as “a murderer, pedophile, and homosexual.”<sup>90</sup> Mark Basseley Youseff,<sup>91</sup> the writer-producer of the film, used the footage he shot for *Desert Warrior* and transformed it to create an extremely controversial “trailer” lasting thirteen minutes and fifty-one seconds.<sup>92</sup> Specifically, Youseff partially dubbed Garcia’s short performance.<sup>93</sup> Where she once asked, “Is George crazy? Our daughter is but a child,” her character now appeared to ask, “Is your Mohammed a child molester?”<sup>94</sup>

The film spurred “protests that generated worldwide news coverage.”<sup>95</sup> The Obama administration even mentioned the film as a “possible cause for

84. *Garcia v. Google, Inc.*, 786 F.3d 733, 737 (9th Cir. 2015) (en banc).

85. *Id.*

86. *Garcia v. Google, Inc.*, 766 F.3d 929, 932 (9th Cir. 2014).

87. *Id.*

88. *Garcia*, 786 F.3d at 737. There was disputed evidence regarding whether Garcia signed a release, releasing her rights in the film. Youssef brought forward a signed document, but Garcia claimed that the signature on the release was forged. This fact was never addressed at this stage of the proceedings. Instead, it was assumed that no such release was signed. *Garcia*, 766 F.3d at 936 n.5 (“Neither party claim[ed] that Garcia signed a work for hire agreement.”).

89. *Garcia*, 786 F.3d at 737.

90. *Id.*

91. Mark Basseley Youssef also goes by other names, including Nakoula Basseley Nakoula and Sam Bacile. *Garcia v. Google, Inc.*, 743 F.3d 1258, 1261 (9th Cir. 2014).

92. *Garcia*, 786 F.3d at 737. The film at issue is continuously referred to as a “trailer” although there is no evidence that a longer feature was ever made, or intended to be made.

93. *Id.*

94. *Id.*

95. *Garcia*, 743 F.3d at 1262; see also *Fatwa Issued Against ‘Innocence of Muslims’ Film Producer*, TELEGRAPH (Sept. 18, 2012), <http://www.telegraph.co.uk/news/worldnews/middleeast/lebanon/9549664/Fatwa-issued-against-Innocence-of-Muslims-film-producer.html> [<https://perma.cc/2B55-Z7QG>] (“Nasrallah, whose Lebanese movement is blacklisted in the United States as a terrorist group, has called for a week of protests across the country over the film, describing it as the ‘worst attack ever on Islam.’”).

the 2012 attack on the U.S. Consulate in Benghazi, Libya.”<sup>96</sup> After being aired in Egypt, an Egyptian cleric issued a fatwa against any person involved in making the film.<sup>97</sup> The order triggered a stream of death threats against Garcia’s life.<sup>98</sup> Fearing for her life, Garcia took multiple security precautions, including moving her home and business.<sup>99</sup> She also filed a total of five takedown notices under the Digital Millennium Copyright Act (DMCA), requesting that Google remove the film from YouTube.<sup>100</sup> Google denied each and every request.<sup>101</sup>

Garcia initially filed multiple tort claims in Los Angeles Superior Court on September 19, 2012 against the filmmaker, Youssef, and Google including invasion of privacy, false light, intentional infliction of emotional distress, and right of publicity violations.<sup>102</sup> However, Garcia ultimately voluntarily dismissed these claims after the state court determined that Garcia had “not shown a likelihood of success on the merits.”<sup>103</sup> On September 26, 2012, one day after her voluntary dismissal, Garcia filed suit against Google and Youssef in the United States District Court for the Central District of California, alleging copyright infringement.<sup>104</sup> While Garcia did not claim copyright ownership in the entire film, she alleged that

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96. Mark Litwak, *Do Your Actors Own Your Film?*, ENTMT L. RES. (Mar. 1, 2014), <http://www.marklitwak.com/blog/do-your-actors-own-your-film> [<https://perma.cc/3MFN-AMLW>]; see *Garcia*, 786 F.3d at 737–38; Amicus Curiae Brief by News Organizations in Support of Google’s Petition for Rehearing En Banc at 3, *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014) (No. 12-57302).

97. *Garcia*, 786 F.3d at 738.

98. *Id.* Garcia allegedly received thousands of death threats as a result of her connection to the film. Brief of Appellant-Petitioner in Response to Sua Sponte Briefing Order Re: Stay at 22, *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014) (No. 12-57302).

99. *Garcia v. Google, Inc.*, 766 F.3d 929, 938 (9th Cir. 2014).

100. *Garcia*, 786 F.3d at 738. The original panel decision stated that Garcia filed eight takedown notices under the DMCA. *Garcia v. Google, Inc.*, 743 F.3d 1258, 1262 (9th Cir. 2014). Garcia’s brief stated that she filed twelve takedown notices. Brief of Appellant-Petitioner in Response to Sua Sponte Briefing Order Re: Stay at 8, *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014) (No. 12-57302).

101. *Garcia*, 786 F.3d at 738. In at least one instance, Google denied Garcia’s requests on First Amendment freedom of speech grounds. Brief of Appellant-Petitioner in Response to Sua Sponte Briefing Order Re: Stay at 8, *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014) (No. 12-57302) (“Eric Schmidt, Google’s chairman responded to requests to remove the video: ‘We believe the answer to bad speech is more speech . . . it will stay up.’”).

102. *Garcia*, 786 F.3d at 738.

103. *Id.*

104. *Id.* Garcia also “revived her state law claims against Youssef for fraud, unfair business practices, libel, and intentional infliction of emotional distress” in federal court. *Id.*

her performance was independently copyrightable and that she retained an interest in that copyright.<sup>105</sup>

## 2. *District Court Opinion*

The present action commenced when Garcia “moved for a temporary restraining order and for an order to show cause on a preliminary injunction”<sup>106</sup> in district court, “claiming that the posting of the video infringed her copyright in her performance.”<sup>107</sup> Although “Garcia sued under a slew of legal theories,” she moved for the preliminary injunction on only the copyright claim.<sup>108</sup>

The district court denied Garcia’s motion for a preliminary injunction,<sup>109</sup> finding that she did not satisfy the four-factor *Winter* test.<sup>110</sup> The injunction was “subject to heightened scrutiny” because it “require[d] affirmative conduct by Defendants.”<sup>111</sup> First, the court found an insufficient showing of irreparable harm because Garcia delayed in bringing the action.<sup>112</sup> She did not file her motion until five months after the film was uploaded to YouTube.<sup>113</sup> Second, Garcia did not demonstrate that she was likely to succeed on the merits of her claim. Since the film, not an actor’s individual performance, is generally considered the “work,”<sup>114</sup> and since Garcia did not claim to be a joint author of the film,<sup>115</sup> it was unlikely the law would favor her argument of copyright infringement.<sup>116</sup> Because the first two *Winter* factors weighed against Garcia, the court did not analyze the facts under the final two factors.<sup>117</sup>

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105. *See* Litwak, *supra* note 96.

106. *Garcia*, 786 F.3d at 739.

107. *Garcia*, 766 F.3d at 932.

108. *Garcia*, 786 F.3d at 739.

109. *Garcia v. Nakoula*, 2:12-cv-08315-MWF-VBK, 2012 BL 334702, \*1 (C.D. Cal. Nov. 30, 2012).

110. *Id.*; *see* *Winter v. Nat’l Res. Def. Council*, 555 U.S. 7, 24 (2008). “A plaintiff seeking a preliminary injunction must show that: (1) she is likely to succeed on the merits, (2) she is likely to suffer irreparable harm in the absence of preliminary relief, (3) the balance of equities tips in her favor, and (4) an injunction is in the public interest.” *Farris v. Seabrook*, 677 F.3d 858, 864 (9th Cir. 2012) (citing *Winter*, 555 U.S. at 20).

111. *Garcia*, 2012 BL 334702, at \*1.

112. *Id.*

113. *Id.*

114. *Id.* at \*1–2.

115. *Id.* at \*2.

116. *Id.*

117. *Id.*

### 3. Ninth Circuit Opinion

Garcia appealed to the Ninth Circuit and a split panel reversed the district court's decision, finding that the district court abused its discretion in denying the preliminary injunction.<sup>118</sup> The court stated that it would “err on the side of life”<sup>119</sup> and require Google to remove *Innocence of Muslims* from YouTube immediately.<sup>120</sup>

In granting the preliminary injunction, the majority found that an individual contribution to an integrated work could be independently copyrightable.<sup>121</sup> Thus, Garcia, as the author of her performance, likely retained a copyright interest in her performance, “even when the work ha[d] been contributed to a joint work.”<sup>122</sup> This is a rarely litigated issue because the “vast majority of films are covered by contract, the work-for-hire doctrine, or implied licenses.”<sup>123</sup>

The court held that Garcia was likely to succeed on the merits of her claim because her performance was “sufficiently creative to be protectable,” and it was fixed.<sup>124</sup> Although her contributions were minor, they were not *de minimis*.<sup>125</sup> The court focused on the actor's process, stating that “an actor does far more than speak words on a page; he must ‘live his part inwardly, and then . . . give to his experience an external embodiment.’”<sup>126</sup> Thus, the actor is sufficiently creative through the use of his or her body language, facial expressions, and reactions.<sup>127</sup>

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118. *Garcia v. Google, Inc.*, 743 F.3d 1258, 1269 (9th Cir. 2014).

119. *Id.* at 1268.

120. *Id.* at 1269. Google was actually sent a secret order twenty-four hours before the official order was submitted to ensure that the video would be taken down before the public knew that it was being forced to be taken down. That way, people would not be able to copy the video before it could be officially removed from YouTube. *Garcia v. Google, Inc.*, 786 F.3d 733, 739 (9th Cir. 2015) (en banc). “The panel later amended the order to allow YouTube to post any version of the film that did not include Garcia's performance.” *Id.*

121. *Garcia*, 743 F.3d at 1263.

122. Paul M. Azzi, *Two Wrongs Don't Make a Copyright: The Dangerous Implication of Granting a Copyright in Performance Per Se*, 83 U. CIN. L. REV. 529, 543 (2014) (citing *Garcia*, 743 F.3d at 1263).

123. *Garcia*, 743 F.3d at 1265 (citing F. Jay Dougherty, *Not a Spike Lee Joint? Issues in the Authority of Motion Pictures under U.S. Copyright Law*, 49 UCLA L. REV. 225, 327–33 (2001)).

124. *Garcia*, 743 F.3d at 1263.

125. *Id.* at 1265.

126. *Id.* at 1263 (quoting CONSTANTIN STANISLAVSKI, AN ACTOR PREPARES 15, 219 (Elizabeth Reynolds Hapgood trans., 1936)).

127. *Id.*

The court also addressed the nature of derivative works.<sup>128</sup> Since “an actor’s performance is based on a script,” the performance would be considered a “derivative of the script.”<sup>129</sup> However, Garcia did not infringe on the script because, “by hiring Garcia, giving her the script and turning a camera on her, Youssef implicitly granted her a license to perform his screenplay.”<sup>130</sup>

The court found that the case did not fall under the work-for-hire doctrine because Garcia was not an employee of Youssef and she did not sign a written work-for-hire agreement.<sup>131</sup> Garcia could not be categorized as a “conventional” employee because she was hired for only a very small role, where she was only required to be on set for three and one-half days of filming, and she did not receive any “traditional employment benefits.”<sup>132</sup> Therefore, any copyright in Garcia’s performance did not vest with Youssef.<sup>133</sup>

The majority conceded that Garcia granted Youssef an implied license to use her performance but explained that Youssef exceeded the scope of that license by using her performance in a film that “differ[ed] so radically from anything Garcia could have imagined.”<sup>134</sup> While these kinds of implied licenses are construed broadly, they are not unlimited.<sup>135</sup> Here, Youssef lied to Garcia about the kind of film he intended to make so that she would agree to participate.<sup>136</sup> If she, or likely any other actor, knew what was going to become of her performance, she never would have agreed to participate in the first place.

Even though Garcia did not seek a preliminary injunction until a few months after the video was uploaded to YouTube, the court found that she “took legal action as soon as . . . there was a ‘need for speedy action.’”<sup>137</sup> Garcia made a showing of “real and immediate harm” through evidence of death threats and the security precautions she had to undertake as soon as the fatwa was issued.<sup>138</sup> Removing the film from YouTube would curb the

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128. *Id.* at 1264.

129. *Id.*

130. *Id.*

131. *Id.* at 1265.

132. *Id.* (citing *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 751–52 (1989)).

133. *Id.*

134. *Id.* at 1266–67. The court did note, however, that the situations in which a filmmaker exceeds the scope of an actor’s implied license are “extraordinarily rare.” *Id.*

135. *Id.* at 1266 (citing *Oddo v. Ries*, 743 F.2d 630, 634 (9th Cir. 1984)).

136. *Id.* at 1267.

137. *Id.*

138. *Id.*



threats by helping to disassociate her from the film.<sup>139</sup> Although the court appeared strong in its assertion, it ended its inquiry by stating that “[t]o the extent the irreparable harm inquiry is at all a *close question*, we think it best to err on the side of life.”<sup>140</sup>

Finally, the court chose to address the final two *Winter* factors not addressed by the district court: the balance of the equities and public interest.<sup>141</sup> The court found that the balance of the equities “clearly favor[ed]” Garcia because she “demonstrated a likelihood of success on her claim” and Google’s prior restraint of speech argument failed.<sup>142</sup> A First Amendment claim cannot protect copyright infringement.<sup>143</sup> As for the public interest, the court found it “tip[ped] in Garcia’s direction.”<sup>144</sup>

Judge Norman Randy Smith wrote the dissent, observing that the district court did not abuse its discretion in denying Garcia’s request for a preliminary injunction.<sup>145</sup> Garcia was not likely to succeed on the merits of her copyright claim because “(1) her acting performance is not a work, (2) she is not an author, and (3) her acting performance is too personal to be fixed.”<sup>146</sup>

#### 4. *Amended Ninth Circuit Opinion*

Many groups and corporations soon filed amicus briefs, which led the panel to issue an amended opinion on July 11, 2014, four months after its original opinion was released.<sup>147</sup> The court did not change its final decision but merely supplemented the opinion with a couple of extra paragraphs to address some arguments and criticisms raised by the amici.<sup>148</sup>

First, the majority addressed an argument raised by the dissent: that “Garcia’s interest in her acting performance may best be analyzed as a joint

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139. *Id.* at 1268.

140. *Id.* (emphasis added).

141. *Id.* at 1268–69.

142. *Id.*

143. *Id.* at 1268.

144. *Id.* at 1269.

145. *Id.* at 1269–70.

146. *Id.* at 1270.

147. *Garcia v. Google, Inc.*, 766 F.3d 929 (9th Cir. 2014). It is rare for a court to amend an opinion in this way. Alison Frankel, *Kozinski Amends Opinion in 9th Circuit ‘Innocence’ Case v. Google*, REUTERS (July 15, 2015), <http://blogs.reuters.com/alison-frankel/2014/07/15/kozinski-amends-opinion-in-9th-circuit-innocence-case-v-google> [<https://perma.cc/4UAX-JB29>]. Here, the majority panel merely added two paragraphs to its original opinion. The minor additions did not change or affect the court’s holding.

148. Frankel, *supra* note 147.

work with Youssef.”<sup>149</sup> Here, the majority focused on the intent of the parties and added that there was “no basis for finding a joint intent” in the creation of the work because “Garcia expressly disclaim[ed] such intent and there is no evidence that Youssef intended to create a joint work.”<sup>150</sup>

In response to other criticisms, the majority noted Garcia’s denial from the United States Copyright Office after she attempted to “register a copyright in her performance.”<sup>151</sup> The majority, however, refused to address the contents of the Copyright Office’s letter because the case was not an appeal of the denial of registration.<sup>152</sup> Thus, the “Copyright Office’s refusal to register d[id]n’t ‘preclude[] a determination’ that Garcia’s performance ‘[wa]s indeed copyrightable.’”<sup>153</sup> Finally, the majority added that Google was not precluded from raising certain defenses before the district court, including a fair use defense.<sup>154</sup> It did not address those defenses here because Google did not raise them on appeal.<sup>155</sup>

##### 5. *En Banc Opinion*

After the Ninth Circuit filed the amended opinion, Google filed a motion for rehearing en banc, which was ultimately granted on November 12, 2014.<sup>156</sup> A total of thirteen amicus briefs were filed with the court, and the motion was heard on December 15, 2014.<sup>157</sup> After reviewing the district court’s denial of Garcia’s motion for preliminary injunction, the en banc panel reversed the amended panel decision, finding that the district court did not abuse its discretion in denying Garcia’s request for a preliminary injunction.<sup>158</sup>

Using the four-factor *Winter* test, the court agreed that Garcia had not met her burden on even the first factor: “likelihood of success on the merits.”<sup>159</sup> Her burden was “doubly demanding” in seeking a mandatory injunction and Garcia needed to show “that the law and facts *clearly favor*

149. *Garcia*, 766 F.3d at 933.

150. *Id.*

151. *Id.* at 935.

152. *Id.*

153. *Id.* (quoting *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346, 347 (D.C. Cir. 1991)).

154. *Id.* at 936, 939.

155. *Id.*

156. *Garcia v. Google, Inc.*, 771 F.3d 647 (9th Cir. 2014) (order granting motion for rehearing en banc).

157. *Garcia v. Google, Inc.*, 786 F.3d 733, 739 n.3 (9th Cir. 2015) (en banc).

158. *Id.* at 739.

159. *Id.* The court additionally addressed the irreparable harm issue, but because Garcia did not prevail on either of these first two *Winter* factors, the court did not address the final two *Winter* factors – the balance of the equities and public interest.

her position, not simply that she [wa]s likely to succeed.”<sup>160</sup> Garcia did not meet that high burden.<sup>161</sup> While the en banc court was sympathetic to Garcia’s situation, it emphasized that “a weak copyright claim cannot justify censorship in the guise of authorship.”<sup>162</sup>

In analyzing the copyright question, the court found that Garcia’s performance was not a copyrightable work.<sup>163</sup> The court credited the Copyright Office’s opinion and its rejection of Garcia’s request for registration.<sup>164</sup> Moreover, the court turned to *Aalmuhammed v. Lee*<sup>165</sup> for guidance.<sup>166</sup> In *Aalmuhammed*, the Ninth Circuit began its analysis of joint authorship by defining the term “work.”<sup>167</sup> Because so many individuals may qualify as an “author” of an integrated work, especially a film, there must be something more to the analysis than merely whether the individual “made a substantial creative contribution.”<sup>168</sup> Proceeding with this theory of copyright law would “make Swiss cheese of copyrights.”<sup>169</sup> Thus, the only qualifying work can be the film itself.<sup>170</sup>

The court noted that even though Hollywood is generally governed by contracts and the work-for-hire doctrine, “low-budget films rarely use licenses,” and even if they do, they are not necessarily “panacea.”<sup>171</sup> Still, the district court’s finding that Garcia granted Youssef an implied license to use her performance was not “clearly erroneous.”<sup>172</sup> However, even this finding does not clear up the copyright issue because even with licensing there can be disputes over such things as the scope of the terms of the license or termination of transfers.<sup>173</sup>

Further, Garcia did not “fix” her acting performance as required under the Copyright Act.<sup>174</sup> First, Garcia did not personally fix her performance; Youssef and his crew did that.<sup>175</sup> Second, Garcia did not authorize the

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160. *Id.* (emphasis in original).

161. *Id.*

162. *Id.* at 736.

163. *Id.* at 741. Thus, the district court did not err in its copyright analysis. *Id.* at 744.

164. *Id.* at 741.

165. 202 F.3d 1227 (9th Cir. 2000).

166. *Garcia*, 786 F.3d at 742.

167. *Id.*

168. *Id.* (quoting *Aalmuhammed*, 202 F.3d at 1233).

169. *Id.*

170. *Id.*

171. *Id.* at 743.

172. *Id.* at 743 n.12.

173. *Id.* at 743.

174. *Id.*; see 17 U.S.C. § 101 (2012).

175. *Garcia*, 786 F.3d at 744.

fixation of her performance.<sup>176</sup> Although she agreed to be filmed, she did not agree to the ultimate rendition of the film and her role in it.<sup>177</sup> Therefore, the court held she could not argue that her performance was “fixed by or under [her] authority.”<sup>178</sup>

Turning to the irreparable harm prong of the *Winter* test, the court found that Garcia did not make a “clear showing” of irreparable harm.<sup>179</sup> First, the harms Garcia faced from the film did not stem from copyright law.<sup>180</sup> She sought the preliminary injunction because the film harmed her personally.<sup>181</sup> Moreover, Garcia did not file this action until months after the film was released on YouTube.<sup>182</sup> Instead, the court suggested that privacy laws, and not copyright law, may provide Garcia with the appropriate remedies for the harms she has suffered.<sup>183</sup>

Finally, the court chose not to address the balance of equities and public interest prongs of the *Winter* test since Garcia’s copyright claim was “doubtful,” and she did not make a showing of irreparable harm.<sup>184</sup> Thus, because Garcia could not satisfy the *Winter* factors, “[t]he takedown order was unwarranted and incorrect as a matter of law.”<sup>185</sup> Moreover, the takedown censored and suppressed speech.<sup>186</sup>

As the sole dissenter, Judge Kozinski did not veer from his original panel decision and reasoning.<sup>187</sup> According to him, “Garcia’s dramatic performance met all of the requirements for copyright protection” and by denying Garcia a copyright in her performance, the majority “makes a total mess of copyright law, right here in the Hollywood Circuit.”<sup>188</sup> Judge Kozinski focused on the fact that actors provide “some minimal degree of creativity” in their performance.<sup>189</sup> Judge Kozinski further argued that a

176. *Id.*

177. *Id.*

178. *Id.*

179. *Id.* at 746.

180. *Id.* (“Garcia’s harms are too attenuated from the purpose of copyright.”).

181. *Id.* at 745.

182. *Id.* at 746.

183. *Id.* at 745. The United States does not recognize a “right to be forgotten” or “moral rights” in motion pictures. *Id.* at 745–46.

184. *Id.* at 746.

185. *Id.* at 747.

186. *Id.*

187. *Id.* at 749 (Kozinski, J., dissenting).

188. *Id.* at 749.

189. *Id.* at 751. Judge Kozinski simply assumes that Garcia’s performance is a copyrightable work without providing any reasoning. He merely states that her performance was sufficiently original and ultimately fixed.

work becomes “fixed” at the moment it is captured on film by the camera.<sup>190</sup> Thus, as soon as Garcia’s five-second performance was captured on film, it was sufficiently fixed as a “work.”<sup>191</sup> Simply by being an actor in the film, Garcia authorized the fixation.<sup>192</sup>

Following the release of the en banc opinion, Garcia chose not to seek an appeal to the United States Supreme Court. She formally ended the case on June 26, 2015 by “filing a stipulated motion to dismiss the case.”<sup>193</sup>

#### B. THE SECOND CIRCUIT: *16 CASA DUSE V. MERKIN*

That same year, the Second Circuit expanded the holding of *Garcia v. Google* in *16 Casa Duse v. Merkin*.<sup>194</sup> Following the reasoning in *Garcia*, the Second Circuit held that the director of a film did not have copyright protection of his direction in a film, separate and apart from the film itself.

##### 1. Background

16 Casa Duse was a production company owned and operated by Robert Krakovski.<sup>195</sup> In September 2010, Krakovski purchased the rights to a screenplay entitled *Heads Up* from its author, with the intent of making it into a short film also called *Heads Up*.<sup>196</sup> Krakovski subsequently asked Alex Merkin to direct the short film, and he agreed.<sup>197</sup> After securing Merkin as the director, Krakovski began “assembl[ing]” a cast and crew.<sup>198</sup> While Merkin made some recommendations as to who to hire, Krakovski made the ultimate decisions.<sup>199</sup> Each member of the cast and crew, except for Merkin, signed an “Independent Contractor [ ] Agreement” with 16 Casa Duse, explicitly stating that their contributions were works made for hire.<sup>200</sup> The agreement further stated that 16 Casa Duse “would retain ‘complete

190. *Id.* Following this argument, Judge Kozinski stated that each scene in a film is a copyrightable work. *Id.* at 750.

191. *Id.* at 751.

192. *Id.* Judge Kozinski relied on an international treaty, and not U.S. law, to make this determination. The Beijing Treaty on Audiovisual Performances provides “performers” with the “exclusive right of authorizing . . . the fixation of their unfixed performances.” *Id.*

193. Bill Donahue, *Actress Ends High-Profile ‘Muslims’ Case Against Google*, LAW360 (June 29, 2015), <http://www.law360.com/articles/673778/actress-ends-high-profile-muslims-case-against-google> [<https://perma.cc/D2PF-7S8Q>].

194. *16 Casa Duse LLC v. Merkin*, 791 F.3d 247 (2d Cir. 2015).

195. *Id.* at 251.

196. *Id.*

197. *Id.*

198. *Id.*

199. *Id.*

200. *Id.*

control’ of the film’s production and ‘own all of the results and proceeds of [the cast and crew’s] services in connection with the [film] . . . including . . . copyright.’”<sup>201</sup>

Krakovski tried to get Merkin to sign the work-for-hire agreement multiple times throughout the planning, production, and post-production process, but Merkin never did.<sup>202</sup> However, even without a completed work-for-hire agreement, production began on the short film with Merkin serving as director.<sup>203</sup> After filming was completed, Krakovski gave Merkin a hard drive of the raw footage of the film to edit, despite the fact that an agreement had still not been signed.<sup>204</sup> The parties did, however, enter into a “Media Agreement,” “under which Merkin would edit but not license, sell, or copy the footage for any purpose without the permission of [16] Casa Duse.”<sup>205</sup>

Krakovski and Merkin continued to negotiate the terms of the Media Agreement as well as the work-for-hire agreement.<sup>206</sup> Unfortunately, these negotiations ultimately collapsed and Merkin refused to return the hard drive of raw footage of *Heads Up*.<sup>207</sup> In January 2012, unbeknownst to Krakovski, Merkin registered the raw footage of *Heads Up* for copyright with the U.S. Copyright Office, asserting he was the sole author of the raw footage.<sup>208</sup>

Krakovski later scheduled a special screening at the New York Film Academy (NYFA) on April 18, 2012, with a reception to follow.<sup>209</sup> Krakovski paid a non-refundable deposit of \$1,956.58 for the event.<sup>210</sup> The screening, however, was cancelled after NYFA received a cease-and-desist order from Merkin.<sup>211</sup>

## 2. *District Court Opinion*

Krakovski filed a claim on behalf of 16 Casa Duse in the Southern District of New York<sup>212</sup> first “seeking, *inter alia*, a temporary restraining

201. *Id.*

202. *Id.*

203. *Id.*

204. *Id.* at 251–52.

205. *Id.* at 252.

206. *Id.*

207. *Id.*

208. *Id.* at 252–53.

209. *Id.* at 253.

210. *Id.*

211. *Id.* It was disputed whether it was Merkin or Merkin’s attorney who contacted NYFA with the cease-and-desist order. *Id.*

212. *Id.* at 250.

order and injunction enjoining Merkin from interfering with its use of the film.”<sup>213</sup> The district court granted the restraining order and later issued a preliminary injunction.<sup>214</sup> 16 Casa Duse’s amended complaint alleged that it had not infringed, that Merkin did not own a copyright interest in the film, and that Merkin’s copyright registration was invalid.<sup>215</sup> Moreover, 16 Casa Duse alleged other breach of contract claims, tortious interference with business relations, and conversion.<sup>216</sup> The district court granted the plaintiff’s motion for summary judgment on his copyright and state law claims.<sup>217</sup>

### 3. *Second Circuit Opinion*

The Second Circuit affirmed the district court, holding that a contributor to a creative work whose contribution is inseparable from, and integrated into, a work does not maintain a copyright interest in his or her contribution alone.<sup>218</sup> As such, Merkin’s claims that he held a copyright interest in his creative contributions to the film and that he had copyright ownership in the raw film footage failed.<sup>219</sup>

#### a) *A Director Does Not Have an Independent Copyright in His Direction*

The court held that a contribution to a creative work, although not de minimis, with the intent of becoming inseparable from and integrated into a work, is not eligible for separate copyright protection because the contribution does not “fall within the subject matter of copyright.”<sup>220</sup>

The court began by analyzing the relevant provisions of the Copyright Act in order to define the term “works of authorship.”<sup>221</sup> First, the court noted that the Copyright Act lists types of copyrightable works, including “motion pictures.”<sup>222</sup> However, while motion pictures are “expected to contain contributions from multiple individuals,” the Act does not list the “constituent parts” of a motion picture as a copyrightable work.<sup>223</sup> Nor does

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213. *Id.* at 253.

214. *Id.*

215. *Id.*

216. *Id.*

217. *Id.*

218. *Id.* at 254.

219. *Id.* at 255.

220. *Id.* at 256.

221. *Id.*

222. *Id.*

223. *Id.* at 257.

it list the constituent parts of any other integrated work.<sup>224</sup> This exclusion “suggests that non-freestanding contributions to works of authorship are not ordinarily themselves works of authorship.”<sup>225</sup>

Further, the court looked to the Copyright Act’s definition of a “joint work” for guidance.<sup>226</sup> The definition of joint work “suggests that such inseparable contributions are not themselves ‘works of authorship.’”<sup>227</sup> The fact that collective works are copyrightable “only when such contributions constitute ‘separate and independent’ works” further implies that inseparable contributions are not.<sup>228</sup> The “separate and independent” requirement “indicates that inseparable contributions integrated into a single work cannot separately obtain [copyright] protection.”<sup>229</sup>

The court also drew support from the legislative history of the Copyright Act.<sup>230</sup> The House Report stated that a motion picture was generally considered a “joint rather than a collective work with respect to those authors who actually work on the film.”<sup>231</sup> It also noted that the question of authorship rarely comes up because those who work on a film are typically “employees for hire.”<sup>232</sup> It is only those authors who “clearly” create a work of “separate and independent” authorship who can retain a copyright interest in their contribution separate and apart from the integrated work.<sup>233</sup>

Finally, the court agreed with the Ninth Circuit’s en banc opinion in *Garcia v. Google*.<sup>234</sup> While each contributor makes an original artistic expression, and the contribution is “arguably fixed in the medium of film footage,” that is not “alone sufficient.”<sup>235</sup> The contribution itself must be a “work of authorship.”<sup>236</sup> Allowing each contributor to claim a separate copyright in his or her contribution would be impractical, especially in a film where a large number of people make artistic contributions.<sup>237</sup> It would hinder the production of new films, for any contributor could request an

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224. *Id.*

225. *Id.*

226. *Id.*

227. *Id.*

228. *Id.* (citing 17 U.S.C. § 101 (2012)).

229. *Id.*

230. *Id.*

231. *Id.* (quoting H.R. REP. NO. 94-1476, at 120 (1976)).

232. *Id.*

233. *Id.*

234. *Id.* at 258.

235. *Id.*

236. *Id.*

237. *Id.*



injunction. The court doubted that Congress aimed to fill films with “thousands of standalone copyrights,” a plainly absurd result.<sup>238</sup>

The Second Circuit reasoned that various contributors *could* “achieve copyright protection for their creative efforts” as sole or joint authors of a film, or of their independent contribution as long as that contribution is a freestanding, independent work.<sup>239</sup> However, in this case, the court stated that a director’s contribution “is not *itself* a ‘work of authorship’ subject to its own copyright protection.”<sup>240</sup> Essentially, a director could attempt to claim sole or joint authorship of a film, but cannot claim a separate copyright interest in the direction alone.<sup>241</sup>

b) Merkin Is Not the Author of the Raw Footage of the Film<sup>242</sup>

The parties agreed that Merkin was neither a “joint author” nor a “co-author” of the film.<sup>243</sup> Moreover, Merkin’s services were not a “work made for hire” since Merkin was not an employee of 16 Casa Duse and never signed a written work-for-hire agreement for his work on the film.<sup>244</sup> Instead, Merkin claimed sole copyright ownership in the raw footage of the film.<sup>245</sup>

The court disagreed with Merkin and determined that 16 Casa Duse was the dominant author of the film based on “factual indicia of ownership and authorship” relevant to the joint-author inquiry.<sup>246</sup> Merkin did not rise to the level of “author” because the producer had the most control over the project—from initiating the project to executing all agreements with cast, crew, and third parties.<sup>247</sup> While Merkin had a significant amount of control as to the direction and creative elements of the film, the producer had the final say.<sup>248</sup>

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238. *Id.* at 259.

239. *Id.* at 258–59.

240. *Id.* at 259.

241. *See id.* at 258–59.

242. This part of the Second Circuit decision is not directly related to *Garcia v. Google*, as *Garcia* never claimed sole or even joint authorship of *Innocence of Muslims*. However, this is an interesting finding, as a director has a strong argument for authorship of a film.

243. *Id.* at 255.

244. *Id.* at 256.

245. *Id.* at 259. Merkin claimed copyright in the raw footage because it reflected his creative vision. *Id.*

246. *Id.* at 260 (quoting *Thomson v. Larson*, 147 F.3d 195, 202 (2d Cir. 1998)).

247. *Id.*

248. *Id.*

### III. THE EFFECTS OF THESE DECISIONS ON COPYRIGHT OWNERSHIP JURISPRUDENCE

Although *Garcia* added something new to copyright law, its holding, along with the *Casa Duse* decision, is consistent with current copyright doctrine. This new case law formally describes limits of copyright authorship within an integrated work. Neither case, however, creates any sweeping precedent, as both courts were careful to limit their holdings to the particular facts presented. The Ninth Circuit explains that actors cannot claim an independent copyright in their performances in motion pictures and the Second Circuit explains that directors cannot claim such a copyright in their direction. Both of these creative contributions just do not fall within the subject matter of copyright under the Copyright Act.

Even though this question of first impression under copyright law articulated new copyright precedent, it falls squarely within existing copyright doctrine and current Hollywood norms. The reasoning behind both circuits' decisions works within the statutory language of the Copyright Act. Neither *Garcia* nor *Casa Duse* read a new type of "work of authorship" into the statute.<sup>249</sup> Although the list of copyrightable works provided by the Act is not exhaustive, it explicitly lists "motion pictures" as a work of authorship. It does not, however, list a performance within a film or anything strikingly similar. As the Second Circuit noted, motion pictures have been around for a long time, but in all of that time, the Act was never amended to add "constituent parts" of a motion picture as a separately protectable work.<sup>250</sup>

Of course, even though the *Garcia* and *Casa Duse* courts do not discuss them, there are circumstances in which a contributor to an integrated work might have a copyright in his or her own contribution, or in the entire work.<sup>251</sup> First, a creator may have a copyright interest in his or her separate contribution if that contribution is also a "separate and independent" work.<sup>252</sup> Of course, this assumes that there is no written agreement stating otherwise. In this type of situation, a contributor typically creates a work that later becomes part of an integrated work. These works are "conceived and independently fixed by their contributors prior to their incorporation

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249. See 17 U.S.C. § 102(a) (2012).

250. See *Casa Duse*, 791 F.3d at 257.

251. See *Garcia v. Google, Inc.*, 786 F.3d 733, 739 (9th Cir. 2015) (en banc); *Casa Duse*, 791 F.3d at 258–59.

252. See 17 U.S.C. § 201(c) (2012).

into the film.”<sup>253</sup> Thus, these original works of authorship secure copyright protection at the moment they are fixed.<sup>254</sup> These types of works must then have clearance to be used in an integrated work, or else their use could be infringing. For example, many motion pictures include songs written and performed long before the film was created or even imagined. Those songs’ authors hold separate copyrights, even though the songs were later integrated into the larger works.

Alternatively, if the contribution can stand alone from the integrated work, then its creator can claim separate copyright protection. The contribution could have been created during the filmmaking process with the sole intent of it being integrated into the film. However, as long as the contribution can stand on its own as a “work,” as defined by the Copyright Act, it is likely entitled to separate copyright protection.<sup>255</sup>

Second, a creative contributor may be able to claim sole or joint authorship of the entire integrated work. When there are multiple contributors to a single work, more than one may maintain copyright ownership in the work as joint authors. While joint authorship allows more than one individual to claim copyright, the determinative question is whether the contributors intended their contributions to be part of an inseparable whole at the time of creation.<sup>256</sup> The intent, along with the extent of the contributors’ creative contributions, will determine whether they have a valid claim to joint authorship.

However, if the parties do not agree to joint authorship (proving lack of intent of joint authorship), then there can only be a single author to the integrated work. While a written agreement is not necessary to prove intent, there must at least be implied intent of joint authorship.<sup>257</sup> Although sole authorship of an integrated work, such as a film, is generally settled by contract, in the absence of a formal agreement, sole authorship is determined by the factual circumstances, by looking at who is the “dominant

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253. Brief of Amici Curiae Professors of Intellectual Property Law in Support of Google, Inc. and YouTube, LLC at 5, *Garcia v. Google*, 743 F.3d 1258 (9th Cir. 2014) (No. 12-57302).

254. *See id.*

255. A work must be (1) original, (2) a “work of authorship,” and (3) “fixed in any tangible medium of expression.” 17 U.S.C. § 102(a) (2012).

256. *See* 17 U.S.C. § 101 (“joint work”).

257. *See* F. Jay Dougherty, *Not a Spike Lee Joint? Issues in the Authorship of Motion Pictures Under U.S. Copyright Law*, 49 UCLA L. REV. 225, 257 (2001).

author.”<sup>258</sup> Here, the court looks to the individual’s decision-making authority and relative control over the work, billing and credits, and how agreements are executed with third parties.<sup>259</sup> In the Ninth Circuit, the court looks to who “superintended” the work.<sup>260</sup> In that analysis, control seems to be the most important factor.<sup>261</sup>

#### IV. THE PRACTICAL RESULT OF THESE DECISIONS ON THE ENTERTAINMENT INDUSTRY

Although the decisions in *Garcia* and *Casa Duse* do not change much in terms of the practices of the entertainment industry, they do reinforce the importance of obtaining a written agreement for copyright interests in advance of filming. As the *Garcia* court pointed out, “[t]he reality is that contracts and the work-made-for-hire doctrine govern much of the big-budget Hollywood performance and production world.”<sup>262</sup> Therefore, the outcomes of *Garcia* and *Casa Duse* will not likely affect the big players and major Hollywood studios because those entities are already so careful to protect themselves from contributors’ copyright claims with well-executed contracts.<sup>263</sup>

However, films can be made without a full contracting scheme, making it possible for another *Garcia* issue to arise again. In this day and age, it is easy for anyone to pick up a camera (or a smartphone) and start filming. Also, the number of low-budget films and shorts by aspiring filmmakers continually grows. These videos can then be posted instantaneously to online platforms, such as YouTube, for the entire world to see. Typically, these low-budget projects do not have licenses, and if contracts are executed,

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258. See *16 Casa Duse LLC v. Merkin*, 791 F.3d 247, 260 (2d Cir. 2015); *Childress v. Taylor*, 945 F.2d 500, 508 (2d Cir. 1991) (introducing the concept of the “dominant author”).

259. See *Thomson v. Larson*, 147 F.3d 195, 202–04 (2d Cir. 1998) (addressing factors relevant to the dominant-author inquiry); see also *Aalmuhammed v. Lee*, 202 F.3d 1227, 1234 (9th Cir. 2000) (Ninth Circuit analysis of the *Thomson* factors).

260. *Aalmuhammed*, 202 F.3d at 1234 (finding that the individual who is the “master mind” of the work, who “creates, or gives effect to the idea,” is the one who superintended the work).

261. *Id.*

262. *Garcia v. Google, Inc.*, 786 F.3d 733, 743 (9th Cir. 2015) (en banc); see 1 NIMMER & NIMMER, *supra* note 7, § 6.07[B][2].

263. However, if the *Garcia* en banc court had affirmed the Ninth Circuit panel decision holding that *Garcia* could hold an individual copyright in her contribution, then some of those contracts might not have been able to ensure copyright ownership to the contracted “author.” Many issues could have been raised, including the termination of transfers of individuals who had made a creative contribution to the film. This result could have caused an upheaval in the industry. See 17 U.S.C. § 203(a)(3) (2012).

they are not necessarily as “all-encompassing” as those drafted by major movie studios.<sup>264</sup>

Moreover, even without the recommended contracts, “courts have looked to implied licenses.”<sup>265</sup> The decisions appear to follow what is already considered practice in the industry. Thus, it seems that the only reason the *Garcia* and *Casa Duse* suits were possible was because typical contracts were not executed. The “legal niceties” of contracts, work-for-hire agreements, and implied licenses “do not necessarily dictate whether something is protected by copyright, and licensing has its limitations.”<sup>266</sup>

While the *Garcia* and *Casa Duse* decisions may imply that contracts are no longer needed to ensure a particular individual’s copyright in an integrated work, that is not necessarily the case. *Garcia* has actually been viewed as a reminder of the importance of “obtaining a valid assignment of an actress’s copyright interest in her performance.”<sup>267</sup> Any individual intending to secure a copyright in a film or other integrated work must be sure they have a signed work-for-hire agreement that explicitly signs away any and all contributors’ potential copyright interests, or that individual risks contributors making copyright claims.

For example, ideal contract language to include in an actor’s agreement, ensuring that the producer of the work retains all copyright interest, would state: “Producer shall own all rights of every kind in the results and proceeds of Actor’s services hereunder. Producer shall have the unlimited right throughout the universe and in perpetuity to exhibit the Motion Picture in all media, now or hereafter known. Actor’s services are a work for hire.”<sup>268</sup> The agreement needs to explicitly specify that the producer owns any and all copyright interests that an actor, or any creative contributor, may acquire during the production process.

Moreover, the agreement could specify that the job is a work made for hire by stating: “All results and proceeds of Performer’s services, including, without limitation, all literary and musical material, designs and inventions of Performer shall be deemed to be a work made for hire for Producer within the meaning of the copyright laws of the United States” and “Producer shall be the sole and exclusive owner for all purposes.”<sup>269</sup>

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264. *Garcia*, 786 F.3d at 743.

265. *Id.* (citing *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 558–59 (9th Cir. 1990)).

266. *Id.*

267. DONALDSON & CALLIF, *supra* note 50, at 260.

268. *Id.*

269. 5 NIMMER & NIMMER, *supra* note 7, at § 23.06[E][1].

The bottom line is to make sure everyone involved in a production signs a proper agreement before production begins.<sup>270</sup> Even though not every contributor to the integrated work has a valid claim to a copyright interest, it is better to preemptively settle the issue by contract than risk spending a lot of money in legal fees to determine the issue later.

## V. CONCLUSION

The Ninth and Second Circuits, which are considered this nation's entertainment circuits, have stated that an individual contributing to one aspect of a film does not necessarily hold a separate copyright in that contribution. Although this issue had not arisen previously, it has become an important question in this day and age. Now, it is much easier to make a film because costs are lower, and recording technology is more widely available. Therefore, aspiring and new filmmakers are more likely to not execute the work-for-hire agreements that major motion picture studios have carefully crafted.

*Garcia v. Google* started a fresh discussion in the courts and among copyright experts regarding authorship of contributors to an integrated work. The Ninth Circuit resolved this issue by applying the language of the federal copyright statute and copyright jurisprudence. This solution appears to be a promising course, especially with the Second Circuit following suit. However, it is likely that this issue will again come before the courts.

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270. See 16 Casa Duse, LLC v. Merkin, 791 F.3d 247, 255–61 (2d Cir. 2015).

