Copyright in a Global Information Economy

Chapter 3 Supplement:
At the end of Chapter 3, consider the following case as a review of topics covered in both Chapters 2 & 3.

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

MCKEOWN, J.: . . . In July 2011, Cindy Lee Garcia responded to a casting call for a film titled *Desert Warrior,* an action-adventure thriller set in ancient Arabia. Garcia was cast in a cameo role, for which she earned $500. She received and reviewed a few pages of script. Acting under a professional director hired to oversee production, Garcia spoke two sentences: "Is George crazy? Our daughter is but a child?" Her role was to deliver those lines and to "seem[ ] concerned."

Garcia later discovered that writer-director Mark Basseley Youssef (a.k.a. Nakoula Basseley Nakoula or Sam Bacile) had a different film in mind: an anti-Islam polemic renamed *Innocence of Muslims.* The film, featuring a crude production, depicts the Prophet Mohammed as, among other things, a murderer, pedophile, and homosexual. Film producers dubbed over Garcia's lines and replaced them with a voice asking, "Is your Mohammed a child molester?" Garcia appears on screen for only five seconds.

Almost a year after the casting call, in June 2012, Youssef uploaded a 13–minute–and–51–second trailer of *Innocence of Muslims* to YouTube, the video-sharing website owned by Google, Inc., which boasts a global audience of more than one billion visitors per month. After it was translated into Arabic, the film fomented outrage across the Middle East, and media reports linked it to numerous violent protests. The film also has been a subject of political controversy over its purported connection to the September 11, 2012, attack on the United States Consulate in Benghazi, Libya.

Shortly after the Benghazi attack, an Egyptian cleric issued a fatwa against anyone associated with *Innocence of Muslims,* calling upon the "Muslim Youth in America[ ] and Europe" to "kill the director, the producer[,] and the actors and everyone who helped and promoted this film." Garcia received multiple death threats.

Legal wrangling ensued. . . . Garcia also sent Google five takedown notices under the Digital Millennium Copyright Act, 17 U.S.C. § 512, claiming that YouTube's broadcast of *Innocence of Muslims* infringed her copyright in her "audio-visual dramatic performance." Google declined to remove the film. . . .

. . . [Garcia] filed suit in the United States District Court for the Central District of California and again named Google and Youssef as codefendants. Garcia alleged copyright infringement against both defendants . . . .

Garcia then moved for a temporary restraining order and for an order to show cause on a preliminary injunction . . . . She sought to bar Google from hosting *Innocence of Muslims* on YouTube or any other Google-run website.

On November 30, 2012, the district court denied Garcia's motion for a preliminary injunction. . . .

A divided panel of our court reversed. . . .

We granted rehearing en banc.

ANALYSIS

I. THE DISTRICT COURT'S DECISION . . .

A. COPYRIGHT

The central question is whether the law and facts clearly favor Garcia's claim to a copyright in her five-second acting performance as it appears in *Innocence of Muslims.* The answer is no. This conclusion does not mean that a plaintiff like Garcia is without options or that she couldn't have sought an injunction against different parties or on other legal theories, like the right of publicity and defamation.[5]

Under the Copyright Act, "[c]opyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . [including] motion pictures." 17 U.S.C. § 102(a). That fixation must be done "by or under the authority of the author." 17 U.S.C. § 101. Benchmarked against this statutory standard, the law does not clearly favor Garcia's position.

The statute purposefully left "works of authorship" undefined to provide for some flexibility. *See* 1 Nimmer on Copyright § 2.03. Nevertheless, several other provisions provide useful guidance. An audiovisual work is one that consists of "a series of related images which are intrinsically intended to be shown" by machines or other electronic equipment, plus "accompanying sounds." 17 U.S.C. § 101. In turn, a "motion picture" is an "audiovisual work [ ] consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any." *Id.* These two definitions embody the work here: *Innocence of Muslims* is an audiovisual work that is categorized as a motion picture and is derivative of the script. Garcia is the author of none of this and makes no copyright claim to the film or to the script.[6] Instead, Garcia claims that her five-second performance itself merits copyright protection.

In the face of this statutory scheme, it comes as no surprise that during this

[5] Down the road, Garcia also may have a contract claim. She recalls signing some kind of document, though she cannot find a copy. We take no position on this claim. Nor do we consider whether Garcia's performance was a work made for hire. *See* 17 U.S.C. § 101 (defining "work made for hire" as work "prepared by an employee within the scope of his or her employment" or, where both parties sign a written agreement, a work "specially ordered or commissioned ... as a part of a motion picture ..."); *see also* § 201(b) (in case of work made for hire, the employer or person for whom the work is prepared is the author, subject to express agreement otherwise). In district court proceedings, the parties disputed whether Garcia signed a work-made-for-hire agreement, and the issue is not before us on appeal.

[6] In another odd twist, one of Garcia's primary objections rests on the words falsely attributed to her via dubbing. But she cannot claim copyright in words she neither authored nor spoke. That leaves Garcia with a legitimate and serious beef, though not one that can be vindicated under the rubric of copyright.

litigation, the Copyright Office found that Garcia's performance was not a copyrightable work when it rejected her copyright application. The Copyright Office explained that its "longstanding practices do not allow a copyright claim by an individual actor or actress in his or her performance contained within a motion picture." Thus, "[f]or copyright registration purposes, a motion picture is a single integrated work. . . . Assuming Ms. Garcia's contribution was limited to her acting performance, we cannot register her performance apart from the motion picture."

We credit this expert opinion of the Copyright Office—the office charged with administration and enforcement of the copyright laws and registration. The Copyright Office's well-reasoned position "reflects a 'body of experience and informed judgment to which courts and litigants may properly resort for guidance.'" *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 286 n. 5 (3d Cir. 2004) (en banc) (Alito, J.).[8]

In analyzing whether the law clearly favors Garcia, *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir.2000), provides a useful foundation. There, we examined the meaning of "work" as the first step in analyzing joint authorship of the movie *Malcolm X*. The Copyright Act provides that when a work is "prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary *whole*," the work becomes a "joint work" with two or more authors. 17 U.S.C. § 101 (emphasis added). Garcia unequivocally disclaims joint authorship of the film.

In *Aalmuhammed*, we concluded that defining a "work" based upon "some minimal level of creativity or originality . . . would be too broad and indeterminate to be useful." 202 F.3d at 1233. Our animating concern was that this definition of "work" would fragment copyright protection for the unitary film *Malcolm X* into many little pieces:

> So many people might qualify as an "author" if the question were limited to whether they made a substantial creative contribution that that test would not distinguish one from another. Everyone from the producer and director to casting director, costumer, hairstylist, and "best boy" gets listed in the movie credits because all of their creative contributions really do matter.

Id.

Garcia's theory of copyright law would result in the legal morass we warned against in *Aalmuhammed*—splintering a movie into many different "works," even in the absence of an independent fixation. Simply put, as Google claimed, it "make[s] Swiss cheese of copyrights."

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[8] The dissent's suggestion that this case is somehow governed by the Beijing Treaty on Audiovisual Performances is misplaced. *See* Dissent at 38–39. At present, the treaty is aspirational at best. It has yet to take effect because only six countries have ratified or acceded to the treaty—well short of the thirty it needs to enter into force. *See* World Intellectual Property Organization, *Summary of the Beijing Treaty on Audiovisual Performances (2012), available at* www.wipo. int/treaties/en/ip/beijing/summary_beijing.html (last visited May 13, 2015). Although the United States signed the treaty in 2012, it has not been ratified by the U.S. Senate. Article II, Section 2 of the Constitution requires the concurrence of a two-thirds majority of that body. The dissent's reference to the fact sheet from the Patent and Trademark Office, which unlike the Copyright Office lacks legal authority to interpret and administer the Copyright Act, is similarly inapposite. *See* Dissent at 751.

Take, for example, films with a large cast—the proverbial "cast of thousands"—such as *Ben–Hur* or *Lord of the Rings.* The silent epic *Ben–Hur* advertised a cast of 125,000 people. In the *Lord of the Rings* trilogy, 20,000 extras tramped around Middle–Earth alongside Frodo Baggins (played by Elijah Wood). Treating every acting performance as an independent work would not only be a logistical and financial nightmare, it would turn cast of thousands into a new mantra: copyright of thousands.

The dissent spins speculative hypotheticals about copyright protection for book chapters, movie outtakes, baseball games, and Jimi Hendrix concerts. This hyperbole sounds a false alarm. Substituting moral outrage and colorful language for legal analysis, the dissent mixes and matches copyright concepts such as collective works, derivative works, the requirement of fixation, and sound recordings. The statutory definitions and their application counsel precision, not convolution. *See, e.g.*, 17 U.S.C. §§ 101, 103, 114, 201. The citation to *Effects Associates, Inc. v. Cohen,* 908 F.2d 555 (9th Cir. 1990) (Kozinski, J.), is particularly puzzling. There, neither party disputed the plaintiff's copyright, and the plaintiff independently fixed the special-effects footage and licensed it to the filmmakers.

The reality is that contracts and the work-made-for-hire doctrine govern much of the big-budget Hollywood performance and production world. Absent these formalities, courts have looked to implied licenses. *See Effects Assocs.*, 908 F.2d at 559–60. Indeed, the district court found that Garcia granted Youssef just such an implied license to incorporate her performance into the film.[12] But these legal niceties do not necessarily dictate whether something is protected by copyright, and licensing has its limitations. As filmmakers warn, low-budget films rarely use licenses. Even if filmmakers diligently obtain licenses for everyone on set, the contracts are not a panacea. Third-party content distributors, like YouTube and Netflix, won't have easy access to the licenses; litigants may dispute their terms and scope; and actors and other content contributors can terminate licenses after thirty five years. *See* 17 U.S.C. § 203(a)(3). Untangling the complex, difficult-to-access, and often phantom chain of title to tens, hundreds, or even thousands of standalone copyrights is a task that could tie the distribution chain in knots. And filming group scenes like a public parade, or the 1963 March on Washington, would pose a huge burden if each of the thousands of marchers could claim an independent copyright.

Garcia's copyright claim faces yet another statutory barrier: She never fixed her acting performance in a tangible medium, as required by 17 U.S.C. § 101 ("A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, *by or under the authority of the author,* is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.") (emphasis added). According to the Supreme Court, "the

[12] Any copyright claim aside, the district court found that Garcia granted Youssef a non-exclusive implied license to use her performance in the film. Although Garcia asked Youssef about *Desert Warrior* 's content, she in no way conditioned the use of her performance on Youssef's representations. On this record, we cannot disturb the district court's finding as clearly erroneous.

author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection." *Cmty. for Creative Non–Violence v. Reid*, 490 U.S. 730, 737 (1989). Garcia did nothing of the sort.[13]

For better or for worse, Youssef and his crew "fixed" Garcia's performance in the tangible medium, whether in physical film or in digital form. However one might characterize Garcia's performance, she played no role in fixation. On top of this, Garcia claims that she never agreed to the film's ultimate rendition or how she was portrayed in *Innocence of Muslims*, so she can hardly argue that the film or her cameo in it was fixed "by or under [her] authority." 17 U.S.C. § 101.

In sum, the district court committed no error in its copyright analysis. Issuance of the mandatory preliminary injunction requires more than a possible or fairly debatable claim; it requires a showing that the law "clearly favor [s]" Garcia. *See Stanley*, 13 F.3d at 1320. Because neither the Copyright Act nor the Copyright Office's interpretation supports Garcia's claim, this is a hurdle she cannot clear. . . . .

Kozinski, J., dissenting:

Garcia's dramatic performance met all of the requirements for copyright protection: It was copyrightable subject matter, it was original and it was fixed at the moment it was recorded. So what happened to the copyright? At times, the majority says that Garcia's performance was not copyrightable at all. And at other times, it seems to say that Garcia just didn't do enough to gain a copyright in the scene. Either way, the majority is wrong and makes a total mess of copyright law, right here in the Hollywood Circuit. In its haste to take internet service providers off the hook for infringement, the court today robs performers and other creative talent of rights Congress gave them. I won't be a party to it.

I

Youssef handed Garcia a script. Garcia performed it. Youssef recorded Garcia's performance on video and saved the clip. Until today, I understood that the rights in such a performance are determined according to elementary copyright principles: An "original work[ ] of authorship," 17 U.S.C. § 102(a), requires only copyrightable subject matter and a "minimal degree of creativity." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.,* 499 U.S. 340, 345 (1991). The work is "fixed" when it is "sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." 17 U.S.C. § 101. And at that moment, the "author or authors of the work" instantly and automatically acquire a copyright interest in it. 17 U.S.C. § 201(a). This isn't exactly String Theory; more like Copyright 101.

[13] The Copyright Office draws a distinction between acting performances like Garcia's, which are intended to be an inseparable part of an integrated film, and standalone works that are separately fixed and incorporated into a film. We in no way foreclose copyright protection for the latter—any "discrete work in itself that is later incorporated into a motion picture," as the Copyright Office put it. *See Effects Assocs.*, 908 F.2d at 558–59 (recognizing independent copyrightability of special effects footage incorporated into film).

Garcia's performance met these minimal requirements; the majority doesn't contend otherwise. The majority nevertheless holds that Garcia's performance isn't a "work," apparently because it was created during the production of a later-assembled film, *Innocence of Muslims.* But if you say something is not a work, it means that it isn't copyrightable by anyone. Under the majority's definition of "work," no one (not even Youssef) can claim a copyright in any part of Garcia's performance, even though it was recorded several months before *Innocence of Muslims* was assembled. Instead, *Innocence of Muslims*—the ultimate film—is the only thing that can be a "work." If this is what my colleagues are saying, they are casting doubt on the copyrightability of vast swaths of material created during production of a film or other composite work.

The implications are daunting. If Garcia's scene is not a work, then every take of every scene of, say, *Lord of the Rings* is not a work, and thus not protected by copyright, unless and until the clips become part of the final movie. If some dastardly crew member were to run off with a copy of the Battle of Morannon, the dastard would be free to display it for profit until it was made part of the final movie. And, of course, the take-outs, the alternative scenes, the special effects never used, all of those things would be fair game because none of these things would be "works" under the majority's definition. And what about a draft chapter of a novel? Is there no copyright in the draft chapter unless it gets included in the published book? Or if part of the draft gets included, is there no copyright in the rest of it?

This is a remarkable proposition, for which the majority provides remarkably little authority. *Aalmuhammed v. Lee,* 202 F.3d 1227 (9th Cir. 2000), the only case that the majority cites, says just the opposite. In *Aalmuhammed,* we considered a claim by a contributor to the movie *Malcolm X* that he was a joint author of the entire movie. *Id.* at 1230. Everyone in *Aalmuhammed* agreed that the relevant "work" was *Malcolm X.* The only question was whether the contributor was a joint author of *that* work. We went out of our way to emphasize that joint authorship of a movie is a "different question" from whether a contribution to the movie can be a "work" under section 102(a). *Id.* at 1233. And we clearly stated that a contribution to a movie *can* be copyrightable (and thus can be a "work"). *Id.* at 1232.

The majority's newfangled definition of "work" is directly contrary to a quarter-century-old precedent that has never been questioned, *Effects Associates, Inc. v. Cohen,* 908 F.2d 555 (9th Cir. 1990). There, we held that a company that created special effects footage during film production retained a copyright interest in the footage even though it became part of the film. *Id.* at 556–58. The majority tries to distinguish *Effects Associates* by arguing that the footage there was a "standalone work[ ] that [was] separately fixed and incorporated into a film." Maj Op. 744 n. 13. But Garcia's performance was also "separately fixed and incorporated into" *Innocence of Muslims.* Why then are the seven shots "featuring great gobs of alien yogurt oozing out of a defunct factory" interspersed in *The Stuff,* 908 F.2d at 559, any more a "standalone work" than Garcia's performance? Youssef wasn't required to use any part of Garcia's performance in the film; he could have sold the video clip to someone else. The clip might not have had much commercial

value, but neither did the special effects scenes in *Effects Associates.* Nothing in the Copyright Act says that special effects scenes are "works" entitled to copyright protection but other scenes are not. And what about scenes that have actors *and* special effects? Are those scenes entitled to copyright protection (as in *Effects Associates*), or are they denied copyright protection like Garcia's scene?

II

A. The majority also seems to hold that Garcia is not entitled to copyright protection because she is not an author of the recorded scene. According to the majority, Garcia can't be an author of her own scene because she "played no role in [her performance's] fixation." Maj. Op. 744.

But a performer need not operate the recording equipment to be an author of his own performance. Without Garcia's performance, all that existed was a script. To convert the script into a video, there needed to be both an actor physically performing it and filmmakers recording the performance. Both kinds of activities can result in copyrightable expression. Garcia's performance had at least "some minimal degree of creativity" apart from the script and Youssef's direction. *See Feist,* 499 U.S. at 345. One's "[p]ersonality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something which is one man's alone." *Bleistein v. Donaldson Lithographing Co.,* 188 U.S. 239, 250 (1903). To dispute this is to claim that *Gone With the Wind* would be the same movie if Rhett Butler were played by Peter Lorre.

Actors usually sign away their rights when contracting to do a movie, but Garcia didn't and she wasn't Youssef's employee. I'd therefore find that Garcia acquired a copyright in her performance the moment it was fixed. When dealing with material created during production of a film or other composite work, the absence of a contract always complicates things. Without a contract the parties are left with whatever rights the copyright law gives them. It's not our job to take away from performers rights Congress gave them. Did Jimi Hendrix acquire no copyright in the recordings of his concerts because he didn't run the recorder in addition to playing the guitar? Garcia may not be as talented as Hendrix—who is?—but she's no less entitled to the protections of the Copyright Act.

B. While the Copyright Office claims that its "longstanding practices" don't recognize Garcia's copyright interest, it doesn't seem that the Register of Copyrights got the memo. The Register was a member of the U.S. delegation that signed the Beijing Treaty on Audiovisual Performances. *See* U.S. Copyright Office, *Annual Report of the Register of Copyrights* 8 (2012). The Treaty would recognize Garcia's rights in her performance. It provides that "performers" have the "exclusive right of authorizing . . . the fixation of their unfixed performances," and "reproduction of their performances fixed in audiovisual fixations, in any manner or form." World Intellectual Property Organization, *Beijing Treaty on Audiovisual Performances,* Art. 6(ii), 7 (2012).

The Patent Office, which led the delegation, states that U.S. law is "generally

compatible" with the Treaty, as "actors and musicians are considered to be 'authors' of their performances providing them with copyright rights." U.S. Patent & Trademark Office, *Background and Summary of the 2012 WIPO Audiovisual Performances Treaty* 2 (2012). Although the Copyright Office hasn't issued a statement of compatibility, it's hard to believe that it would sign on if it believed that the Treaty's key provisions are inconsistent with U.S. copyright law. . . .

III

The harm the majority fears would result from recognizing performers' copyright claims in their fixed, original expression is overstated. The vast majority of copyright claims by performers in their contributions are defeated by a contract and the work for hire doctrine. *See* 1 *Nimmer on Copyright* § 6.07 [B][2] at 6–28 to 6–29; 2 William F. Patry, *Patry on Copyright* § 5:17 (2010). And most of the performers that fall through the cracks would be found to have given an implied license to the film's producers to use the contribution in the ultimate film. *See Effects Associates,* 908 F.2d at 558. Very few performers would be left to sue at all, and the ones that remain would have to find suing worth their while. . . .

. . . [U]nder our copyright law, the creators of original, copyrightable material *automatically* acquire a copyright interest in the material as soon as it is fixed. There's no exception for material created during production of a film or other composite work. When modern works, such as films or plays, are produced, contributors will often create separate, copyrightable works as part of the process. Our copyright law says that the copyright interests in this material vest initially with its creators, who will then have leverage to obtain compensation by contract. The answer to the "Swiss cheese" bugbear isn't for courts to limit who can acquire copyrights in order to make life simpler for producers and internet service providers. It's for the parties to allocate their rights by contract. *See Effects Associates,* 908 F.2d at 557. Google makes oodles of dollars by enabling its users to upload almost any video without pre-screening for potential copyright infringement. Google's business model, like that of the database owners in *Tasini,* assumes the risk that a user's upload infringes someone else's copyright, and that it may have to take corrective action if a copyright holder comes forward.

The majority credits the doomsday claims at the expense of property rights that Congress created. Its new standard artificially shrinks authorial rights by holding that a performer must personally record his creative expression in order to retain any copyright interest in it, speculating that a contrary rule might curb filmmaking and burden the internet. But [the initial appellate panel] injunction has been in place for over a year; reports of the internet's demise have been greatly exaggerated. For the reasons stated here and in the majority opinion in *Garcia v. Google, Inc.,* 766 F.3d 929, 933–36 (9th Cir.2014), I conclude that Garcia's copyright claim is likely to succeed. . . .