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## Appellate court rules actress owns independent performance copyright

**C**indy Lee Garcia did not see this storm coming. In 2011, the struggling actress answered a casting call and took a bit part in a movie titled "Desert Warrior." The producer, Mark Basseley Youssef, told her it was an adventure film set in ancient Arabia. She earned \$500 for her efforts for a few days of filming.

Now she is the target of an Islamic fatwa and is earnestly trying to clear her name from a film that turned out to be very different from the one in which she was cast. The result of her efforts is one of the most intriguing and controversial copyright decisions since Congress passed the first copyright act in 1790. The film industry is apoplectic over the ruling in *Garcia v. Google Inc.* (9th Cir. 2014) written by Chief 9th U.S. Circuit Court of Appeals Judge Alex Kozinski.

The "Desert Warrior" story was a ruse. Instead, Youssef used Garcia's brief performance in an anti-Islamic film titled "Innocence of Muslims." It is a vile, amateurish film that portrays Mohammed as a sexual deviant and a barbarian. Garcia's lines were dubbed over so that she appears to be asking "Is your Mohammed a child molester?"

The 14-minute movie appeared on YouTube in 2012 and caused protest around the world. This is the movie that reportedly incited the attack on the U.S. consulate in Benghazi, Libya, in which Ambassador Christopher Stevens and three others were killed.

When Garcia first saw the film on YouTube, she was appalled by the blasphemous content. There had been no mention of Mohammed during the filming and no references to either

religious or sexual content.

Soon after the video hit the Internet, Garcia began receiving death threats.

Under copyright law, websites such as YouTube that allow users to upload videos can avoid liability for hosting infringing materials if they remove the material upon receiving a "takedown notice" from the copyright owner. Garcia sent five takedown notices to Google (which owns YouTube), but Google refused to remove "Innocence of Muslims," forcing Garcia to seek relief in court.

She filed suit against Google, claiming that she owns a copyright in her dramatic performance. She argued that her copyright is independent of the copyright in the entire film which she clearly does not own. The U.S. District Court denied her request for a preliminary injunction, and she appealed.

The 9th U.S. Circuit Court of Appeals reversed, finding that Garcia is likely to succeed on the merits of her copyright claim and that she faces irreparable

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harm if an injunction is not entered.

Never has a copyright case been so action-packed — fraud, deception, blasphemy, death threats and censorship. However, these are but grains of desert sand compared to the concerns this case is generating in the copyright community about the legal issue: Whether an actor's performance can give rise to a copyright apart from the copyright in the motion picture.

In more than 200 years of

### INSIDE IP LAW

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copyright jurisprudence, no case has ever addressed this issue. To copyright lawyers, Kozinski's ruling is tantamount to the discovery of a new life form, though it remains unclear whether it is a benign creature or a hideous monster.

There are good reasons why this issue has never been raised before. In any commercial film production, it is customary for everyone contributing any creative element to the film to sign a work-made-for-hire agreement, vesting copyright ownership in the production company. Even absent such an agreement, an actor who appears in a movie would normally be deemed to have given the producer an implied license to use the performance.

Without an agreement or an implied license, producers would find themselves potentially at the mercy of every actor, editor and special effects wizard who claims to have made a creative contri-

bution to a film — a point of immense concern to the motion picture industry.

But neither of those situations was present in this bizarre case. There was no work-made-for-hire agreement. And, due to Youssef's fraudulent representations, Garcia cannot be said to have given implied consent to the use of her performance in "Innocence of Muslims."

In deciding this novel issue, Kozinski reverted to fundamental principles of copyright. The Copyright Act states that "Copyright protection subsists ... in original works of authorship fixed in any tangible medium of expression ..."

Since the parties did not raise the issue of fixation, Kozinski simply assumed the fixation element was met through the fixation of the film as a whole, dodging the issue of whether an actor must personally fix the work. Nor did the judge directly address whether a performance is a "work of authorship."

In response to Google's argument that Garcia had no authorial input because Youssef wrote the script and managed the production, Kozinski noted that an actor does more than just speak words on a page. Quoting the pre-eminent Russian theater director Constantin Stanislavski, Kozinski wrote that an actor "must live his part inwardly, and then ... give his experience an external embodiment." This includes body language, facial expressions and reactions to other actors.

A performance by a good actor undoubtedly involves "authorship," and in most cases it will be sufficiently creative to meet the low threshold of being "original." It remains to be seen whether it is a "work" independent of the motion picture of which it is an element.

The dissenting opinion argued that language in the Copyright Act differentiates a work from the performance of the work. The U.S. Copyright Office agrees and has recently refused to register Garcia's claim.

Despite the criticism that academics and bloggers have leveled at the opinion (e.g., respected blogger and IP law professor Eric Goldman wrote "it would take me days to make a complete list of what's wrong with this opinion"), it would not

be outlandish to consider an actor's performance to be a work of authorship, and that if it is fixed and has a sufficient degree of creativity, it is copyrightable.

Yes, this is something novel to copyright law, but it is not completely outside the realm of copyright subject matter. Concerns have been raised about actors flooding the courts with copyright claims, football players claiming copyright in their post-touchdown dances (per Jon Healy in the Los Angeles Times)

and that the ruling will create an "impenetrable thicket of copyright."

However, the parade of horrors, though fun to think about, is largely theoretical. As Kozinski pointed out, contract practices will make it rare that actors will actually own copyrights in their performances. But even where there is no contract, copyright law has plenty of doctrines and rules with which to separate the sheep from the goats.

The fair use doctrine, the de minimis doctrine, the registration requirement and the idea/expression doctrine, among others, provide courts with plenty of leeway to exercise judicial common sense.

Kozinski was simply exercising common sense within the reasonable confines of copyright law in granting Garcia's injunction. After all, as he correctly noted, "death is an irremediable and unfathomable harm, and bodily injury is not far behind."