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Ninth Circuit Court of Appeals: Actor May Not Enjoin Film Under Copyright Law – Performance Not Copyrightable

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

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In Garcia v. Google, Inc., 786 F.3d 733, 737 (9th Cir. 2015), the Ninth Circuit, sitting en banc, reversed a three-judge panel's decision by holding that an actor with merely a bit part in a film does not have a sufficient copyright interest to support a mandatory injunction suppressing the performance, even though, without the actor's permission, the filmmaker edited and dubbed her innocuous portrayal into a blasphemous one that prompted religious extremists to issue death threats against the actor. Although the court refrained from ruling that no mere actor has a copyright interest in a motion picture, noting throughout the opinion that Garcia's performance was only "five seconds" long, the decision may significantly hamper future Hollywood plaintiffs from asserting rights under copyright in a performance or other contribution in a motion picture, large or small.

In 2011, actor Cindy Lee Garcia auditioned for and received a role in a film she was told would be "an action-adventure thriller set in ancient Arabia" entitled *Desert Warrior*. *Id*. at 737. She had two lines in the script as written: "Is George crazy?" and "Our daughter is but a child." Id. She shot the scene and earned $500. She claims she did not sign a work-made-for-hire agreement under Section 201(b) of the Copyright Act, which provides that as long as the statutory requirements for work-made-for-hire status

are met, the person for whom the work is prepared shall be the owner of the copyright. 15 U.S.C. § 201(b).

Unbeknownst to her, the director, Defendant Mark Basseley Youssef, edited together an entirely different film, "an anti-Islam polemic renamed *Innocence of Muslims*." *Id*. Garcia learned of the revision soon after Youssef posted to YouTube in June 2012 a nearly 14-minute movie "trailer" for his film. *Id*. The trailer portrayed the Prophet Mohammed as a murderous, greedy pedophile. Garcia had five seconds of screen time and a single line, dubbed as "Is your Mohammed a child molester?" *Id*. The video went viral, was later translated into Arabic, and caused a firestorm—purportedly triggering violent protests overseas and a fatwa to all young Western Muslims to kill those associated with the production. The fatwa explicitly included the actors. Garcia and her family received death threats.

Garcia made multiple demands of Google, YouTube's owner, including several formal requests under the Digital Millennium Copyright Act, 17 U.S.C. § 512, to remove the video. Google refused to comply. Next, Garcia sued Google and those involved in the film in California state court based on various tort theories, but voluntarily dismissed the action after her motion for a temporary restraining order was denied. She then brought a federal action alleging copyright infringement and a host of tortious claims, moving—on the copyright claim only—for a temporary restraining order and a preliminary injunction.

The district court denied the preliminary injunction motion. Garcia had been unable to convince the court that any harm would result from allowing the film to remain on YouTube, given that it had already been publicly accessible for five months. Moreover, the court believed that, even if she had a copyright interest in the performance, Garcia had granted an implied license to the filmmaker to incorporate it into his film.

A three-judge panel of the Court of Appeals for the Ninth Circuit reversed, ordering Google to remove the video from YouTube. The panel later amended the order to permit Google to display any version of the film that excluded Garcia. The panel held that Garcia owned the copyright in her five-second performance, had not granted an implied license to Youssef, and had established irreparable harm based on the threats she had received.

Upon *en banc* review, however, the Ninth Circuit disagreed, vacating the panel's decision and affirming the district court's decision in favor of Google. It began by emphasizing the particularly high burden plaintiffs face when seeking preliminary injunctions, especially those such as Garcia who demand affirmative action, *i.e.*, requiring Google to remove the video at issue, detect subsequent postings, and take down all of them.

The court began with the initial (and threshold) prong of the preliminary injunction analysis, namely, whether Garcia is likely to succeed on the merits, and concluded that Garcia could not show likelihood of success because she did not have a protectable copyright interest. The Copyright Act specifies that "'[c]opyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . [including] motion pictures," and "[t]hat fixation must be done "by or under the authority of the author." *Id*. at 741 (quoting 17 U.S.C. §§ 101 & 102(a)). The court deemed the video protectable as an audiovisual work. However, because Garcia, a mere performer, was not responsible for the fixation of the film, she could not be an author. This result was presumably because Garcia was neither the cameraman, cinematographer, writer, director, nor producer. But, in addition, due to the unusual circumstances in this case, Garcia had even less of a role or authorization in the fixation of the final product, since the story, scene and even lines she spoke were changed without her knowledge and in a manner that she outright rejected (albeit after the fact).

The court rejected also the notion that Garcia's performance itself was protectable. In coming to this conclusion, the court first weighed heavily the U.S. Copyright Office's rejection of Garcia's copyright application in her performance. The Copyright Office had determined 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." *Id*. The court "credit[ed] this expert opinion . . . [and] well-reasoned position." *Id*.

The court also relied heavily on its prior holding in *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000) (discussing copyright interest of contributors to film *Malcolm X*), namely, that the mere contribution of "some minimal level of creativity or originality" was insufficient to give rise to copyright ownership in a larger collaborative work. The court explained, "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." Garcia, 786 F.3d at 742. "Simply put, as Google claimed, it 'make[s] Swiss cheese of copyrights.'" *Id*. Imagining the effects of Garcia's claim in the

context of large, epic films, the court noted that "[t]reating 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." *Id*. at 743. The court emphasized the importance of limiting contributors' rights under copyright in a film, even though "contracts and the work-made-for-hire doctrine" frequently control the rights of cast and crew members. Licenses have many legal and practical limitations, the court observed, which ought not to bring the motion picture industry to its knees. On these bases, the court held that Garcia lacked a strong copyright claim and, thus, was not likely to succeed on the merits.

Nevertheless, the Court proceeded to weigh the second prong of the preliminary injunction analysis, namely whether there was irreparable harm, "because the grave danger Garcia claims cannot be discounted and permeates the entire lawsuit." *Id*. at 744. Fully acknowledging the substantial evidence of harm that Garcia put forward, including death threats against her and her loved ones and harm to her career, the court distinguished these from harms relevant to a copyright claim, *i.e.*, "harm to her legal interests as an author." By comparing the purpose of copyright law with tort law (even referencing foreign laws based on moral rights and the nascent right to be forgotten), the court concluded that "Garcia's harms are too attenuated from the purpose of copyright" to constitute the required showing of irreparable harm in this context. *Id*. at 746. Notably, however, the court allowed for the possibility that, in the case of "a strong copyright claim, a court could consider collateral consequences as part of its irreparable harm analysis and remedy." *Id*. at 746 (emphasis added).

In sum, the court opined:

The mandatory injunction censored and suppressed a politically significant film—based upon a dubious and unprecedented theory of copyright. In so doing, the panel deprived the public of the ability to view firsthand, and judge for themselves, a film at the center of an international uproar.

Id. at 747. Moreover, the court registered its disfavor of the "uneasy role of film editor" that the second order put upon Google by permitting display of versions of the film that excised Garcia's performance.

Finally, before closing with sympathetic language acknowledging Garcia's plight, the court held: "Prior restraints pose the most serious and the least tolerable infringement on First Amendment rights, and Garcia cannot overcome the historical and heavy presumption against such restraints with a thin copyright claim in a five-second performance. *Id*. (internal quotation marks and citations omitted).

The opinion now controls throughout the "Hollywood Circuit," *id*. at 749 (dissent by Kozinski, J.), and has already been explicitly accepted and expanded upon by the Second Circuit where the plaintiff's contribution was far more significant, see 16 *Casa Duse, LLC v. Merkin*, 791 F.3d 247 (2d Cir. 2015). In 16 Casa Duse, the court held that a film director did not possess his own copyright interest in his contribution to a motion picture. Id. at 254.

These cases are helpful to the film industry generally and its consumers, by reducing the likelihood that a movie studio will be hamstrung by a disgruntled actor or crew member. Nevertheless, the flat denial of a protectable copyright interest in such important artistic contributions as an actor's performance or a director's work merely because these are integrated and inseparable raises concerns and may be marshalled by others seeking to limit the copyright interests of contributors in entirely different mediums.

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