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Garcia v. Google *and a "Related Rights" Alternative to Copyright in Acting Performances*

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A recent Ninth Circuit case, *Garcia v. Google*, held that an actor can maintain a copyright interest in her acting performance in a film—independent of the copyright held by the filmmaker—and that this copyright can sometimes be sufficiently powerful to allow the actor to prevent public dissemination of the film.[1] The decision has been widely criticized for its interpretation of the Copyright Act, its First Amendment implications, and its potential economic impact on the film and television industries.[2] But few have considered the point that "related rights"—an alternative form of intellectual property distinct from copyright and designed to protect performances and recordings—could provide a more effective way of balancing the many interests at stake in cases like *Garcia*. Related rights protection for acting performances is not currently available in the United States, although it is widely recognized under international law and in the laws of many European countries. This means that, under American law, acting performances must either be governed by conventional copyright law or receive no IP protection at all. By adding related rights protection to American law, Congress could stake out a middle ground between these two extremes and thus prevent quagmires like *Garcia* from emerging in the future.

I. *GARCIA V. GOOGLE*

When Cindy Lee Garcia was paid $500 to act in Mark Basseley Youssef's film *Desert Warrior*, she thought she was appearing in a low-budget action movie set in the Middle East.[3] Little did she know that Youssef had other

1. Garcia v. Google, Inc., 743 F.3d 1258 (9th Cir. 2014), *amended by* Garcia v. Google, Inc., No. 12-57302, 2014 WL 3377343 (9th Cir. July 11, 2014).

2. *See, e.g.*, discussion *infra* notes 19-25.

3. *Garcia*, 2014 WL 3377743, at *1; Nancy Dillon, *Cindy Lee Garcia, Actress in "*Innocence of Muslims*," Is Ecstatic Court Has Ordered YouTube to Take Islam Mocking Video Down*, N.Y.

2. *See, e.g.*, discussion *infra* notes 19-25.

3. *Garcia*, 2014 WL 3377743, at *1; Nancy Dillon, *Cindy Lee Garcia, Actress in "*Innocence of Muslims*," Is Ecstatic Court Has Ordered YouTube to Take Islam Mocking Video Down*, N.Y.

plans; *Desert Warrior* was never completed and Youssef instead used Garcia's short performance in the infamous *Innocence of Muslims* YouTube video. That fourteen-minute film, which includes an offensive depiction of the Prophet Muhammad's life, sparked violent protests throughout much of the Muslim world in 2012. Although Garcia's partially dubbed performance only appeared in the film for several seconds, she received numerous death threats.[4] After Google refused to remove the video, Garcia sought an order forcing Google to take it down, advancing the theory that *Innocence of Muslims* infringed her copyright in her performance. The U.S. District Court for the Central District of California refused to grant Garcia a temporary injunction, and the case was appealed to the Ninth Circuit.[5]

In February 2014, the Ninth Circuit issued a highly controversial opinion[6]—later amended slightly in July 2014—reversing the district court.[7] The Ninth Circuit found that Garcia "likely has an independent [copyright] interest in her performance," that she never relinquished her rights in this performance to Youssef, and that an injunction was warranted.[8] Chief Judge Kozinski, writing for a divided panel, focused on the question of whether Garcia's performance in the film evinced the "minimal degree of creativity"[9] necessary for copyright protection. The U.S. Copyright Act protects all "original works of authorship fixed in any tangible medium of expression,"[10] including, but not limited to, a set of enumerated categories (such as literary works, visual arts, and the like) that does not include acting performances.[11] When considering works that fall outside the categories explicitly listed in the Copyright Act, courts often inquire into whether a work is sufficiently creative

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DAILY NEWS, Feb. 27, 2014, http://www.nydailynews.com/news/national/actress-ecstatic-muslim-mocking-video-youtube-article-1.1704410.

4. *Id*.

5. *Garcia*, 2014 WL 3377743, at *1.

6. For discussions of the controversial aspects of the Ninth Circuit's holding, see sources *infra* notes 19-25.

7. *Garcia*, 2014 WL 3377743, at *7.

8. *Id* at *2. While the amended opinion softened some of the panel's claims—for example, allowing for the possibility that the district court could find, on remand, that Garcia does not have a copyright in her performance—it left intact the basic holding and interpretation of copyright law. *See infra* note 25. For a useful analysis of the changes made in the amended opinion, see Alison Frankel, *Kozinski Amends Opinion in 9th Circuit 'Innocence' Case v. Google*, REUTERS, July 15, 2014, http://blogs.reuters.com/alison-frankel/2014/07/15/kozinski-amends-opinion-in-9th-circuit-innocence-case-v-google [http://perma.cc/K78G-2N9X]

9. *Garcia*, 2014 WL 3377343, at *3 (quoting *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991)).

10. 17 U.S.C. § 102 (2012).

11. *Id*.

to warrant protection.[12] The Ninth Circuit panel, guided by the Supreme Court case Feist Publications, Inc. v. Rural Telephone Service Co.[13] *and a set of treatises,*[14] *found that Garcia's performance had met this burden and was therefore protected by copyright.*[15]

The facts presented in *Garcia* are highly unusual; courts rarely have the opportunity to address the issue of whether film actors maintain independent copyright interests in their performances. Most actors sign contracts that treat all contributions to a film as works made for hire, thereby ensuring that the film's producers hold the only copyright in the final product.[16] In cases where the work-for-hire doctrine does not apply, courts have found that choosing to contribute to a film generally creates an implied nonexclusive license under which film producers may use the contribution—such as acting, special effects, or sound editing—as they see fit.[17] In *Garcia*, the Ninth Circuit addressed these points, finding that neither the work-for-hire doctrine nor an implied license barred Garcia from asserting a copyright claim, primarily because of Youssef's fraudulent misrepresentation of the nature of the film.[18]

Even though the facts of *Garcia* seem fairly sui generis, the Ninth Circuit's decision has galvanized scholars, activists, and members of the entertainment industry, many of whom have condemned the holding. The court's finding that Garcia likely has a copyright interest in her performance, and that this interest is powerful enough to force Google to remove *Innocence of Muslims* from the Internet, has been criticized in particular for its First Amendment implications.[19] While Chief Judge Kozinski cursorily stated that the "First

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12. *See, e.g.*, CDN Inc. v. Kapes, 197 F.3d 1256 (9th Cir. 1999) (holding that prices listed in a wholesale coin price guide evinced a high enough degree of originality to be covered by copyright law).

13. Feist, 499 U.S. at 345 (holding that, when it comes to copyright protection, the "requisite level of creativity is extremely low; even a slight amount will suffice," though not so low as to allow the compiler of a phonebook to assert a copyright in the phonebook).

14. *Garcia*, 2014 WL 3377343, at *2 (citing CONSTANTIN STANISLAVSKI, *AN ACTOR PREPARES* 15, 219 (Elizabeth Reynolds Hapgood trans., 1936) and SANFORD MEISNER & DENNIS LONGWELL, *SANFORD MEISNER ON ACTING* 178 (1987) for the proposition that acting involves significant personal creativity and is not simply the recitation of words written by someone else).

15. *Id*. at *2.

16. 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, 228, 306 (2001).

17. *See, e.g.*, Effects Assocs., Inc. v. Cohen, 908 F.2d 555 (9th Cir. 1990); *see also* 3 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 10.03[A][7] (2006) (explaining the general practices of the film industry when it comes to IP).

18. *Garcia*, 2014 WL 3377343.

19. *See, e.g.*, Brief of Amici Curiae Electronic Frontier Foundation et al., Garcia v. Google, Inc.,, No. 12-57302, 2014 WL 3377343 (9th Cir. 2014) (No. 12-57302); Steven Seidenberg, *Copyright Ruling in US May Impair Free Speech*, INTELL. PROP. WATCH, (April 14, 2014,

Amendment doesn't protect copyright infringement,"[20] commentators—echoing a point made by Google in some of its briefing[21]—have pointed out that allowing Garcia to force Google to remove the entire film, including non-infringing content, seems akin to allowing a prior restraint on (non-infringing) speech.[22] Others have argued that the decision will cause significant (and expensive) legal problems for makers and distributors of films, TV shows, and documentaries.[23] Some have also questioned the Ninth Circuit's broad interpretation of U.S. copyright law. Most notably, Judge N. Randy Smith, writing in dissent, argued forcefully that Garcia's performance was not covered by the Copyright Act because Garcia's acting performance was not a "work" under the Act's definitions, did not evince the requisite level of creativity for Garcia to be considered an "author," and was not "fixed" under the meaning of the Act.[24] The U.S. Copyright Office seems to share this skepticism, as it recently denied Garcia's request to formally register her copyright, claiming that "longstanding practices do not allow a copyright claim by an individual actor or actress in his or her performance contained within a motion picture."[25]

2:40 PM), http://digitalcommons.law.scu.edu/cgi/viewcontent.cgi?article=1697&context=historical [http://perma.cc/B83Q-A3W7].

20. *Garcia*, 2014 WL 3377343, at *8.

21. *See* Google Inc. and YouTube LLC's Brief in Response to Suggestion of Rehearing En Banc at 18-19, Garcia v. Google, Inc., 2014 WL 3377343 (9th Cir. 2014) (No. 12-57302).

22. *See, e.g.*, Rebecca Tushnet, *My Long, Sad* Garcia v. Google *Post*, REBECCA TUSHNET'S 43(B)LOG (Mar. 17, 2014, 8:28 AM), http://tushnet.blogspot.com/2014/03/my-long-sad-garcia-v-google-post.html [http://perma.cc/FRW6-FDK2].

23. *See, e.g.*, Brief of Amicus Curiae International Documentary Association, Film Independent, Fredrik Gertten, and Morgan Spurlock in Support of Google, Inc. and YouTube, LLC's Petition for Rehearing En Banc or, Alternatively, Rehearing, Garcia v. Google, Inc., 2014 WL 3377343 (9th Cir. 2014) (No. 12-57302); Brief of Amicus Curiae Netflix, Inc., Garcia v. Google, Inc., 2014 WL 3377343 (9th Cir. 2014) (No. 12-57302).

24. *Garcia*, 2014 WL 3377343, at *9-14 (Smith, J., dissenting). Judge Smith also argued that even if Garcia's performance was copyrightable, she was in an employer-employee relationship that made her performance a work for hire. *Id* at *14-15.

25. Letter from Robert J. Kasunic, U.S. Copyright Office, to M. Chris Armenta (March 6, 2014); *see* Google Inc. and YouTube LLC's Brief in Response to Suggestion of Rehearing En Banc at Addendum 46-48, Garcia v. Google, Inc., 2014 WL 3377343 (9th Cir. 2014) (No. 12-57302), https://www.eff.org/files/2014/03/26/12-57302_supp_brief_google_yt.pdf [http://perma.cc/ZYD9-L9QQ]. This decision, though not binding, seems to have led the Ninth Circuit to issue a revised opinion that, while still maintaining the holding of the earlier decision, granted the district court more discretion to find on remand that Garcia may in fact not have a copyright in her performance. *Garcia*, 2014 WL 3377343 at *4 ("Nothing we say today precludes the district court from concluding that Garcia doesn't have a copyrightable interest, or that Google prevails on any of its defenses. We note, for example, that after we first issued our opinion, the United States Copyright Office sent Garcia a letter denying her request to register a copyright in her performance.").

II. A "RELATED RIGHTS" ALTERNATIVE

Despite the many serious concerns that the *Garcia* opinion has raised, the criticism has largely failed to offer any alternative remedy for the harms that Garcia suffered. In addressing the questions posed in the case, Judge Kozinski seemed trapped between a rock and a hard place. Denying Garcia any IP protection would have left her with no recourse—no means by which to prevent Youssef from misusing her performance. But the only source of protection seemingly available to the court was copyright, which provided Garcia with a set of tools that was far too powerful: powerful enough, in fact, to completely prevent the public dissemination of the film.

Yet there may actually be a middle ground between full copyright in acting performances and no protection at all. International IP law has long recognized "related rights" or "neighboring rights": intellectual property rights in forms of expression distinct from the more conventional objects of copyright law (like novels, films, visual art, or musical compositions) that provide rights-holders with protection similar to copyright, though often with greater limitations.[26] Related rights generally cover forms of expression that involve performing or recording existing fixed (and usually copyright-eligible) works, such as screenplays or musical scores.[27] Indeed, the categories of related rights currently recognized under international law include performances, sound recordings (also known as "phonograms"), broadcasts, databases, and more.[28] While the most widely ratified treaty on copyright, the Berne Convention,[29] does not cover related rights, a set of additional treaties have been crafted that provide related rights protection. Of these, the most important is the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations;[30] this treaty dictates the minimum level of protection that states must grant performers (defined as "actors, singers, musicians, dancers, and other persons who . . . otherwise perform literary or artistic works"[31]), producers of sound recordings, and broadcasters.[32] To

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26. PAUL EDWARD GELLER & LIONEL BENTLY, INTERNATIONAL COPYRIGHT LAW AND PRACTICE, Introduction § 2(2)(a)(ii) (2013).

27. *Id*. Geller and Bently note that "[i]n much of the world, there is the tacit premise that these media productions [i.e. performances and recordings] more often than not lack the creativity necessary to be protected by copyright." *Id.*

28. *Id*.

29. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, http://www.wipo.int/treaties/en/text.jsp?file_id=283698.

30. International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, Oct. 26, 1961, http://www.wipo.int/treaties/en/text.jsp?file_id=289757 [hereinafter Rome Convention].

31. *Id*. art. 3(a).

implement the Rome Convention and later related rights treaties, many countries have created explicit statutory provisions, separate from the provisions that govern copyright, to protect these groups.[33] Such statutes often provide protection that is less stringent than copyright.[34]

Right now, related rights are not sufficiently recognized under American law to provide Garcia with any rights in her performance. The United States has never signed the Rome Convention. Thanks to pressure from the music industry,[35] it has signed several later treaties that grant related rights protection to audio performers and producers of sound recordings, but these conventions do not protect audiovisual performers, like actors. Specifically, the United States has signed the TRIPS agreement, which protects audio performers and producers,[36] and the World Intellectual Property Organization (WIPO) Performances and Phonograms Treaty, which does the same.[37] The United States complies with these treaties through the Copyright Act, which grants full copyright protection to sound recordings,[38] as well as through some provisions of the Digital Millennium Copyright Act (DMCA).[39] Unlike many European countries, American law does not use the language of "related" or "neighboring" rights in implementing its treaty obligations; it instead covers rights in sound recordings under the umbrella of conventional copyright law[40] (though, as some commentators have pointed out, the Copyright Act in effect adopts a related rights approach by adding some limitations to copyright

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32. *Id*. arts. 5-7.

33. *See infra* notes 34, 43.

34. For example, British copyright law provides a term of life of the author plus seventy years for creative works, but when it comes to recordings and performances, provides only a flat term of fifty years from the date of the recording or performance. *See* GELLER & BENTLY, *supra* note 26, U.K. § 3; *see also* Dougherty, *supra* note 16, at 300, 305 ("[C]opyright is a more extensive bundle of rights than the performer's right."); *see generally* GELLER & BENTLY, *supra* note 26, Introduction, § 4 [1](c)(ii) (explaining differences between neighboring rights and copyright).

35. Pamela Samuelson, *WIPO Panel Principal Paper: The U.S. Digital Agenda at WIPO*, 37 VA. J. INT'L L. 369, 371 (1997).

36. Agreement on Trade-Related Aspects of Intellectual Property Rights, art. 14, Apr. 15, 1994, http://www.wto.org/english/tratop_e/trips_e/t_agmo_e.htm [http://perma.cc/NF4B-PBG3] [hereinafter TRIPS Agreement].

37. WIPO Performances and Phonograms Treaty, Dec. 20, 1996, http://www.wipo.int/treaties/en/text.jsp?file_id=295578 [http://perma.cc/NN4P-RSLX].

38. 17 U.S.C. §§ 102(a)(7), 114 (2012).

39. Digital Millennium Copyright Act, Pub. L. No. 105–304, § 102, 112 Stat. 2860 (1998).

40. *See, e.g.*, 17 U.S.C. §§ 102(a)(7), 114 (2012) (treating sound recordings as a subject of copyright law).

protection in sound recordings that do not apply to other subjects of copyright law).[41]

Changing American law to distinguish more explicitly related rights from copyright and to provide statutory recognition of related rights in audiovisual (that is, acting) performances could help solve the problem posed in *Garcia*. The concept of related rights is useful because it stakes out a compromise between applying the rigidities of copyright law to performances and providing no IP protection at all. In recognizing related rights, legal systems acknowledge that genuine human creativity goes into acting a script or performing a music composition, but also that this creativity is different in kind and in degree from the creativity that goes into creating the fixed, author-driven works, like literature and visual art, that are the more obvious objects of copyright protection.[42] France and Germany, for example, use a related rights framework to exclude performers from full copyright protection, instead providing them with a more limited set of moral and economic rights.[43] German law even creates a special categorical rule that once a performer has contracted with a producer to participate in a film, he is presumed to have transferred most of his rights in that performance to the producer even in "case[s] of doubt."[44]

These examples demonstrate that related rights protection need not rise to the full level of copyright and can be tailored to concerns such as those posed in *Garcia* — concerns that include preventing "the numerous creative contributions that make up a film [from] quickly becom[ing] entangled in an impenetrable thicket of copyright."[45] In crafting related rights legislation, Congress might follow this model. Indeed, one scholar has suggested that only damages, and not injunctive relief, should be available for actors asserting IP claims in their performances[46] — an approach that would prevent actors like Garcia from using IP law to prevent the dissemination of an entire film.

In practical terms, it would be helpful if the United States signed the Rome Convention, which explicitly provides related rights protection to performers and would establish a framework for changing American law to provide related

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41. 17 U.S.C. § 114 (2012); *see* Daniel Gervais, *Garcia v Google*, TRIPS AGREEMENT BLOG, March 1, 2014, http://www.tripsagreement.net [http://perma.cc/D99Q-HSNJ] (calling this a "related right-like" right for sound recordings); *see also* GELLER & BENTLEY, *supra* note 26, Introduction § 2(2)(a)(ii).

42. *See supra* note 27.

43. ANDRÉ LUCAS ET AL., 1-FRA INTERNATIONAL COPYRIGHT LAW AND PRACTICE, § 9(1)(a); ADOLF DIETZ, 1-GER INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 9 (1)(a); *see also supra* note 34 (describing U.K. law).

44. Urheberrechtsgesetz [UrhG] [Copyright Act], Sept. 9, 1965, Bundesgesetzblatt [BGBI], art. 92(a) (Ger.); *see also* DIETZ, *supra* note 44, § 9 (1)(a).

45. *Garcia*, 2014 WL 3377343, at *4; *see also* Dougherty, *supra* note 16, at 328.

46. Dougherty, *supra* note 16, at 320-23.

rights, rather than copyright, protection to acting performances.[47] However, absent implementing legislation, signing the Rome Convention alone would not do much to solve the *Garcia* problem.[48] The United States recently signed a different related rights instrument, the Beijing Treaty on Audiovisual Performances, which is designed to provide IP protection for audiovisual performances.[49] However, Beijing is not necessarily a step in the right direction. Many have argued that the treaty—which provides minimum standards of protection significantly more stringent than those of the Rome Convention[50]—is overprotective of performances and would abolish the distinction between related rights and copyright, forcing signatories to essentially provide full copyright protection to performances.[51] Furthermore, Beijing will not enter into force until it has been ratified by thirty signatory states, and so far only two countries have ratified it.

Even absent implementing legislation that clearly establishes related rights protection in United States law, however, signing the Rome Convention might still prove useful in preventing outcomes like *Garcia*. As in many copyright cases, the core of the problem presented in *Garcia* was one of statutory interpretation. Chief Judge Kozinski, guided by *Feist*, found that an acting performance could be considered a "work" under an interpretation of the Copyright Act.[52] If the United States were to sign the Rome Convention, this step might be seen as signaling its acknowledgment of the international IP norm that acting performances are outside the scope of copyright and instead a

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47. Rome Convention, *supra* note 30, art. 7. It should be noted that Rome provides that related rights protection ceases "once a performer has consented to the incorporation of his performance in a visual or audio–visual fixation," i.e. a film. *Id.* art. 19. However, this provision would probably be irrelevant in a situation like *Garcia*, where the court found that no true consent had been obtained. *See Garcia* 2014 WL 3377343, at *8.

48. Rome provides only minimum standards designed to guide member states. The treaty is also silent on the question of what remedy is appropriate for violations. *See* Rome Convention, *supra* note 30.

49. Beijing Treaty on Audiovisual Performances, Preamble, June 24, 2012, http://www.wipo.int/treaties/en/text.jsp?file_id=295837 [http://perma.cc/ST8Y-2R6S].

50. For example, the minimum term of protection for performances is twenty years from fixation under Rome and fifty years from fixation under Beijing. *See also Beijing Treaty: Helping Audiovisual Performers –Background Brief*, WIPO, http://www.wipo.int/pressroom/en/briefs/beijing_treaty.html [http://perma.cc/UD75-8QGD] (explaining that Beijing is designed to "update" the Rome Convention).

51. Steven Seidenberg, *"Innocence of Muslims" Creates Copyright Controversy in US*, INTELL. PROP. WATCH, Mar. 31, 2014, http://digitalcommons.law.scu.edu/cgi/viewcontent.cgi?article=1685&context=historical [http://perma.cc/M97-MHU5]; Carolina Rossini et al., *Beijing Treaty on Audiovisual Performances: We Need to Read the Fine Print*, ELEC. FRONTIER FOUND., July 24, 2012, https://www.eff.org/deeplinks/2012/07/beijing-treaty-audiovisual-performances [http://perma.cc/YWX4-F9EX].

52. *See supra* notes 8–14 and accompanying text.

matter for related rights protection. Under the *Charming Betsy* canon of statutory interpretation,[53] which advises courts to interpret U.S. statutes in ways that do not conflict with international law or international agreements ratified by the U.S. government,[54] such a signal might be sufficient to create a presumption against reading acting performances into the Copyright Act.[55] If recognized, such a presumption could prevent future courts from reaching holdings like *Garcia* — though this is not a necessary result.

The international instruments that establish related rights in performances do not offer an easy fix to the problem posed in *Garcia v. Google*. But between the options of full copyright in acting performances or no protection at all, related rights, as a concept, offers a promising avenue for negotiating among the concerns of actors like Garcia, the economic interests of the entertainment industry, and the free speech rights of the general public.

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53. *See* Murray v. Schooner Charming Betsy, 6 U.S. (2 Cranch) 64 (1804).

54. While the scope of the *Charming Betsy* cannon is still widely debated, some scholars have argued that even non-self-executing treaties (like the WIPO related rights treaties) should be given interpretive force. *See, e.g.*, Rebecca Crootof, Note, *Judicious Influence: Non-Self-Executing Treaties and the* Charming Betsy *Canon*, 120 YALE L.J. 1784, 1787 (2011).

55. *But cf.* Brief of Amici Curiae Law Professors and Scholars in Support of Respondents, Am. Broad. Co. v. Aereo, Inc., 134 S. Ct. 2498 (2014) (No. 13-461), http://infojustice.org/wp-content/uploads/2014/04/13-461_bsac_Law-Professors-and-Scholars.pdf [http://perma.cc/FR94-672K] (arguing that using international IP treaties to inform interpretation of U.S. copyright law, via *Charming Betsy*, would run counter to congressional intent).