New 9th Circuit Decision Highlights the Importance of Obtaining Performance Releases

Legal Alert
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It's true. Getting a release for an actor's contribution to a movie, a musician's contribution to a recording, a developer's contribution to software, or the like can seem like a pain. Just another hoop your lawyer says you must jump through in order to be "legal". But does it really matter? Is it really necessary?

The answer is yes, yes, yes and the importance of the release was underscored by the 9th Circuit's ruling on Wednesday (Feb 26) in *Garcia v. Google*, Inc., 12-57302, a case brought by Cindy Lee Garcia, an actress whose performance for one film was used in an entirely different one ("Innocence of Muslims") and posted to YouTube. Ms. Garcia alleged an independent copyright interest in the film and sought to compel Google to takedown the video via 17 USC 512, sending Google eight take down notices to remove the video from YouTube. When Google refused, Ms. Garcia sought injunctive relief, which was denied by the district court on the grounds that she was unlikely to succeed on her copyright claim. The 9th circuit disagreed and, on February 19, 2014 ordered Google to remove all copies of the video from YouTube and any other platforms within its control within 24 hours. It also imposed a gag order on the parties, prohibiting them from discussing it until the opinion in the case issues.

Ok, so far it's just a take-down case. But, wait. There's more. How is it that Ms. Garcia could assert an interest sufficient to trigger a take down in the first place? Under what theory did she obtain a copyright interest in the film? Her performance was only a few minutes in length, covering only four pages of the script in which her character appeared. And her performance was based on (and thus a derivative of) a script written by someone else.

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Here's the thing: Ms. Garcia didn't clam a copyright interest in the entire film; just in her performance, and she did not sign a release giving the rights to that performance to the producer. And, that's key. In what some commentators and Google have called "stunning" and "shocking", Chief Judge Alex Kozinski, reversed the lower court's decision, addressing Ms. Garcia's copyright interest in the video:

Just because Garcia isn't a joint author of "Innocence of Muslims" doesn't mean she doesn't have a copyright interest in her own performance within the film. . . . Whether an individual who makes an independently copyrightable contribution to a joint work can retain a copyright interest in that contribution is a rarely litigated question. But nothing in the Copyright Act suggests that a copyright interest in a creative contribution to a work simply disappears because the contributor doesn't qualify as a joint author of the entire work. Where, as here, the artistic contribution is fixed, the key question remains whether it's sufficiently creative to be protectable.

In doing so, Judge Kozinski held that while Ms. Garcia's contribution may have minimal, it was protectable and she did not transfer her interest to the producer by written agreement or via work for hire.

An actor's performance, when fixed, is copyrightable if it evinces "some minimal degree of creativity . . . 'no matter how crude, humble or obvious' it might be." . . . That is true whether the actor speaks, is dubbed over or, like Buster Keaton, performs without any words at all. . . . It's clear that Garcia's performance meets these minimum requirements.

And, while Ms. Garcia certainly gave the producer an implied license to use her performance in the original film for which she performed and was paid, that license did not extend so far as to permit use of her performance in an entirely different work.

Any such license must be construed broadly. If the scope of an implied license was exceeded merely because a film didn't meet the ex ante expectation of an actor, that license would be virtually meaningless. . . . A narrow, easily exceeded license could allow an actor to force the film's author to re-edit the film—in violation of the author's exclusive right to prepare derivative works. . . . Or the actor could prevent the film's author from exercising his exclusive right to show the work to the public. . . . In other words, unless these types of implied licenses are construed very broadly, actors could leverage their individual contributions into de facto authorial control over the film.

Nevertheless, even a broad implied license isn't unlimited. . . . Garcia was told she'd be acting in an adventure film set in ancient Arabia. Were she now to complain that the film has a different title, that its historical depictions are inaccurate, that her scene is poorly edited or that the quality of the film isn't as she'd imagined, she wouldn't have a viable claim that her implied license had been exceeded. But the license Garcia granted Youssef wasn't so broad as to

cover the use of her performance in any project. Here, the problem isn't that "Innocence of Muslims" is not an Arabian adventure movie: It's that the film isn't intended to entertain at all. The film differs so radically from anything Garcia could have imagined when she was cast that it can't possibly be authorized by any implied license she granted Youssef.

Regardless of where this case ends up, it illustrates a couple of important points. First, get a release and make sure it covers not only publicity rights (the right to use the contributor's name, image, likeness, etc.), but copyright as well, and is broad enough to cover all uses of the contribution. Second, if you are on the receiving end of a take down notice, you need to make an extensive inquiry into the rights of the parties involved. Based on this case, this would appear to include confirming that every participant and contributor to a work has signed a release.

If you have questions about copyright or any other intellectual property, artist rights, licensing, or privacy issues, contact Scott Warner at sgwarner@gsblaw.com (206-816-1319) or Claire Hawkins at chawkins@gsblaw.com (206-816-1301).