

## cyberlaw: the brave new e-world



By Anne F. Downey

### Does an actress own the copyright in her five-second movie performance?

On December 15, 2014, the Ninth Circuit Court of Appeals heard arguments en banc in the case of *Garcia v. Google, Inc.*, Case Number 12-57302. The case raises fascinating issues regarding whether an actress who appeared for five seconds in a movie trailer can force Google to take down the trailer from YouTube based on the actress' alleged copyright in her performance.

Mark B. Youssef a/k/a Nakoula B. Nakoula, a man with many pseudonyms and a criminal record, wrote a screenplay for a film called "Desert Warrior," which was supposed to be an Arabian Desert adventure film. Among the various actors and actresses hired to appear in the film, which was shot in August 2011, Cindy Lee Garcia was paid \$500 to play the role of a wife and mother. The full-length movie, poorly written and amateurish, was shown once to an audience of less than 10 people in a theater on Hollywood Boulevard in June 2012.

A month later, a 14-minute trailer for the film was posted on YouTube under the title "The Innocence of Muslims." The film, highly edited from the "Desert Warrior" screenplay, portrayed Mohammed as a murderer and pedophile. The character played by Cindy Lee Garcia appears to say "Is your Mohammed a child molester?" – words that she claims to have never spoken.

The original trailer attracted little attention, but then an Arabic-language version was posted to YouTube in September 2012. An Islamic TV program in Egypt showed scenes from the trailer, and the trailer went viral. Really viral. Globally viral. Movie protests sprang up in over 20 countries, including Egypt, Yemen, Nigeria, Iran, Jordan, Malaysia, Tunisia and Morocco. Violent protests resulted in deaths and the destruction of property. For Garcia's role in the movie trailer, she received death threats, and an Egyptian cleric issued a fatwa against her. President Obama urged Google to take down the video, but Google refused.

During the protests, a group of approximately 130 cast and crew members who worked on "Desert Warrior" stated in an email to CNN that they were grossly misled about the film's intent and purpose. On September 27, 2012, Nakoula was arrested for violating parole and was subsequently sentenced to one year in federal prison. The day before his arrest, Cindy Lee Garcia filed a lawsuit in the U.S. District Court for the Central District of California alleging that Nakoula, Google and its affiliate, YouTube, infringed her copyright in her performance in the movie (which had been edited down to five seconds). She also alleged fraud, libel, unfair business practices and intentional infliction of emotional distress. Garcia's complaint stated that she had filed a copyright application for her performance in the movie. She further alleged that she had repeatedly transmitted Digital Millennium Copyright Act takedown notices to YouTube demanding that the movie trailer be taken down because it infringed on her copyright.

YouTube and Google refused to take down the trailer but did block it in Libya, Saudi Arabia, Indonesia and Egypt. A YouTube user in the U.S. searching for the video today will find a message from YouTube stating "This video is no longer available due to a copyright claim by an actress over her five-second appearance in the video. A U.S. court has ordered Google to remove the video. We strongly disagree with this copyright ruling and will fight it. Sorry about that."

Garcia alleged that the contract she signed with Nakoula (she cannot find her copy) did not include any transfer or release of her rights in her performance. Moreover, even if there were a transfer or release of rights, it was based on fraud. Nakoula alleged in his answer that Garcia did in fact transfer her rights in the film and that he has simply exercised his rights under

the First Amendment.

On October 17, 2012, Judge Michael Fitzgerald

denied Garcia's motion for a temporary restraining order, and on November 30, 2012 he likewise denied her motion for a preliminary injunction. *Garcia v. Google*, No. 2:12-cv-08315-MWFVBK, injunction denied (C.D.Cal. Nov. 30, 2012). Garcia appealed the denial of the preliminary injunction to the Ninth Circuit. A three-judge panel at the Ninth Circuit reversed on February 19, 2014 and granted Garcia a preliminary injunction. The court ordered Google to take down all copies of the film within 24 hours but a week later, the court modified the order to allow Google to post versions that excluded plaintiff's performance. *Garcia v. Google*, 743 F.3d 1258 (9th Cir. 2014), amended by 766 F.3d 929 (9th Cir. July 11, 2014).

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Google sought a rehearing en banc, but it was denied on March 14, 2014. However, after much outcry over the Ninth Circuit decision, the Ninth Circuit decided on November 12, 2014 to allow a rehearing en banc. The case was argued on December 15, 2014 before a panel of 11 judges. As of press time, we were awaiting the court's decision.

Many amicus briefs were filed prior to the December 15 hearing. Among the entities submitting amicus briefs were a coalition of newspapers (including the Los Angeles Times and New York Times), the ACLU, Electronic Frontier Foundation, Netflix, the California Broadcasters Association, a coalition of Internet businesses (including ebay, Facebook, Pinterest and Yahoo!), and many law professors. Amicus briefs supporting Garcia's position were submitted by the Screen Actors Guild and the American Federation of Musicians.

When the Ninth Circuit handed down the February 2014 decision granting Garcia a preliminary injunction, the court was essentially saying that an actress can maintain a copyright interest in her performance, independent of the filmmaker's copyright, and that the actress can use her copyright to prevent public dissemination of the film. Judge Alex Kozinski, writing the majority opinion, was joined by Judge Ronald Gould. Judge N. Randy Smith wrote a dissenting opinion.

The majority believed that Garcia demonstrated some amount of creativity (a prerequisite to copyright protection), despite the fact that her five-second performance was based on a script written by someone else, directed by someone else, filmed by someone else, and her words were overdubbed. Kozinski wrote that Garcia's creativity may include her "body language, facial expression and reactions to other actors and elements of a scene." The majority found that Garcia had an independent copyright ownership, rather than being a joint author (in which case the filmmaker – as the other joint author – could have exploited the work without her permission). The majority believed that Garcia's oral or implied consent to Nakoula to use her copyright was voided by his misrepresentations. In addition, the majority ruled that Garcia was not an employee, which would have automatically rendered her performance a work for hire, even though – as one commentator has noted – the film industry and the IRS generally view actors as employees and therefore movie producers hire actors from loan-out corporations so that the actors can be classified as independent contractors.

In the dissent, Judge Smith wrote that plaintiff did not establish a likelihood that she had a copyrightable interest in her acting performance, nor did she clearly show that the performance was not a work made for hire. Moreover, Smith opined that the district court did not abuse its discretion in ruling that a balancing of the equities tipped in defendants' favor, especially given the public interest involved.

The February 2014 decision has been widely criticized for its interpretation of the First Amendment and the Copyright Act, as well as for the far-reaching impact on the television and film industries. If the Ninth Circuit sides with Garcia, it is anticipated that YouTube and other online companies will be besieged with takedown notices.

Garcia's lawyer told the court at the en banc hearing that every actor in battle scenes in "The Lord of the Rings" has a copyright claim, as do the oarsmen rowing the lifeboats in "Titanic." Google's attorney argued that this view would fragment copyright into a thousand possible claims, saying that "there is zero precedent that a work can be splintered and fragmented. It will cause untold mischief."

The U.S. Copyright Office, for its part, denied Garcia's copyright application, stating that "long-standing practices do not allow a copyright claim by an individual actor or actress in his or her performance contained within a motion picture."

The Ninth Circuit ruling is expected sometime in 2015. Copyright lawyers, the film industry and online companies will be anxious to hear of the court's decision.

Meanwhile, the takeaway lesson for business lawyers is to make sure filmmaker clients and other business clients obtain valid signed releases in writing that clearly convey the alleged rights of actors and other independent contractors. [B]



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