

2016

One Strike, You're Out: Garcia v. Google and the Problems of Copyright on YouTube

Anthony P. D'Elia

Follow this and additional works at: https://scholarship.shu.edu/student_scholarship



Part of the [Law Commons](#)

Recommended Citation

D'Elia, Anthony P., "One Strike, You're Out: Garcia v. Google and the Problems of Copyright on YouTube" (2016). *Law School Student Scholarship*. 831.

https://scholarship.shu.edu/student_scholarship/831

One Strike, You're Out:
Garcia v. Google and the Problems of Copyright on YouTube

Anthony P. D'Elia
Seton Hall University School of Law
Current Topics In Internet Law AWR

TABLE OF CONTENTS

Table of Contents.....	1
Table of Authorities.....	2
Abstract.....	5
I. Introduction.....	6
An Overview of Copyright Law and the DMCA.....	6
The Intersection of OCILLA and YouTube.....	10
II. <i>Garcia v. Google 1</i>	13
Factual Background/Procedural History.....	13
Majority Opinion.....	15
Dissent.....	19
Reaction to the Decision.....	24
III. <i>Garcia v. Google 2</i>	26
Intervening Facts.....	26
Majority, Concurring, and Dissenting Opinions.....	28
Reception of the Decision.....	31
IV. Subsequent Jurisprudence and Analysis.....	32
V. Conclusion.....	36

Table of Authorities

Cases

Aalmuhammed v. Lee, 202 F.3d 1227, 1233 (9th Cir. 2000)

Garcia v. Google, Inc., 743 F.3d 1258 (9th Cir. 2014) (GARCIA 1)

Garcia v. Google, Inc., 786 F.3d 733 (9th Cir. 2015) (GARCIA 2)

16 Casa Duse, LLC v. Merkin, 791 F.3d 247 (2nd Cir. 2015)

Statutes

17 U.S.C. 101

17 U.S.C. 102(a)

17 U.S.C. 512

Secondary Sources

Clark D. Asay, *Ex Post Incentives in Garcia v. Google and Beyond*, Stanford Law Review, 67 Stan. L. Rev. Online 37 (August 20, 2014). <http://www.stanfordlawreview.org/online/ex-post-incentives-and-ip-in-garcia-v-google-and-beyond>.

Executive Summary – Digital Millennium Copyright Act, U.S. Copyright Office, (October 15, 2015). http://www.copyright.gov/reports/studies/dmca/dmca_executive.html.

Lewis R. Clayton, *Controversial Film Tests Limits of Copyright Law*, The National Law Journal (July 13, 2015). <http://www.nationallawjournal.com/id=1202731869833/Controversial-Film-Tests-Limits-of-Copyright-Law?slreturn=20150822165954>.

Eriq Gardner, *Actors Guild Gets Behind Copyrights For Some Performers*, The Hollywood Reporter (December 8, 2014). <http://www.hollywoodreporter.com/thr-esq/actors-guild-gets-behind-copyrights-754973>.

Eriq Gardner, *Netflix Asks Appellate Court to Reconsider ‘Innocence of Muslims’ Ruling*, The Hollywood Reporter (April 15, 2014). <http://www.hollywoodreporter.com/thr-esq/netflix-asks-appellate-court-reconsider-696226>.

Eric Goldman & Venkat Balasubramani *Brief of Amici Curiae Internet Law Professors in the Garcia v. Google Case*, Santa Clara University Legal Studies (November 25, 2014). http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2539165.

Wendy J. Gordon, *The Core of Copyright: Authors, Not Publishers*, Houston Law Review (November 30, 2014). <http://www.houstonlawreview.org/wp-content/uploads/2015/01/6-Gordon.pdf>.

Eric Kain, *YouTube Responds to ContentID Crackdown, Plot Thickens*, Forbes (December 17, 2013). <http://www.forbes.com/sites/erikkain/2013/12/17/youtube-responds-to-content-id-crackdown-plot-thickens/>.

Michael Loney, *Garcia v. Google Reversal Warmly Received (Except by Judge Kozinski)*, Managing Intellectual Property - The Global IP Resource (May 20, 2015). <http://www.managingip.com/Blog/3455424/Garcia-v-Google-reversal-warmly-received-except-by-Judge-Kozinski.html>.

Corynne McSherry, *Finally! Victory for Free Speech in Garcia v. Google*, Electronic Frontier Foundation (May 18, 2015). <https://www.eff.org/deeplinks/2015/05/finally-victory-free-speech-garcia-v-google>.

Art Neill & Sherwin Siy, *Brief of Amici Curiae Electronic Frontier Foundation, et al. in Support of Defendant-Appellees*, American Civil Liberties Union (November 25, 2014). https://www.aclu.org/sites/default/files/field_document/garcia_v_google_amicus_11.25.14.pdf.

Online Copyright Infringement Limited Liability Act (OCILLA), The Anti-Abuse Project, (October 15, 2015). <http://www.anti-abuse.org/online-copyright-infringement-liability-limitation-act-ocilla/>.

Ben Sisario, *YouTube 'Dancing Baby' Copyright Ruling Sets Fair Use Guideline*, The New York Times (September 14, 2015). http://www.nytimes.com/2015/09/15/business/media/youtube-dancing-baby-copyright-ruling-sets-fair-use-guideline.html?_r=1.

Jacob M. Victor, *Garcia v. Google and a "Related Rights" Alternative to Copyright in Acting Performances*, The Yale Law Journal (October 14, 2014). <http://www.yalelawjournal.org/forum/garcia-v-google>.

YouTube, *Copyright on YouTube*, YouTube Help (September 22, 2015). <https://www.youtube.com/yt/copyright/>.

YouTube, *Copyright Strike Basics*, YouTube Help (2015). <https://support.google.com/youtube/answer/2814000>.

YouTube, *How ContentID Works*, YouTube Help (2015), <https://support.google.com/youtube/answer/2797370>

YouTube, *What Is A ContentID Claim?*, YouTube Help (2015). <https://support.google.com/youtube/answer/6013276>.

YouTube, *What Is Fair Use?*, YouTube Copyright Center (September 22, 2015).
<https://www.youtube.com/yt/copyright/fair-use.html>.

ABSTRACT

The passage of the Digital Millennium Copyright Act and the Online Copyright Infringement Limited Liability Act engendered a monumental shift in the way copyright law is applied by copyright holders. Where once copyright law was intended as a shield to protect against infringing uses, the unilateral reporting and removal provisions contained within these statutes have incentivized copyright holders to use the law as a sword, flagging potentially infringing uses for removal first and asking questions about fair use later. The ability of copyright holders to obtain the removal of online content with little or not review from the online service providers, including YouTube, has even inspired some who have no copyright interest in a given piece of content to boldly issue takedown notices without consideration for what the law says. Cindy Lee Garcia, the plaintiff in *Garcia v. Google*, was once such party, claiming a copyright interest in a five-second, overdubbed performance found within a hideous anti-Islamic propaganda video that she was tricked into appearing in. The Ninth Circuit's original decision, granting Garcia her copyright and allowing her the ability to have the content taken down, generated an unprecedented negative response from the legal community, causing the Ninth Circuit to re-hear the case en banc and reverse its original decision. This paper intends to provide background on the takedown provisions of the Digital Millennium Copyright Act, summarize the two Ninth Circuit *Garcia* opinions, and analyze both the reaction to them and their impact on copyright moving forward.

I. INTRODUCTION

An Overview of Copyright and the DMCA

As a threshold concept, something is not copyrightable unless it is a “work of authorship” that is “fixed in a tangible means of expression.” 17 U.S.C. 102(a). The Ninth Circuit has defined “author” as a “person to whom [a] work owes its origin and who superintended the whole work.” *Aalmuhammed v. Lee*, 202 F.3d 1227, 1233 (9th Cir. 2000).

The statute considers a work “fixed in a tangible means of expression” when,

Its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is “fixed” for purposes of this title if a fixation of the work is being made simultaneously with its transmission.

17 U.S.C. 101. For decades, the fixation requirement was satisfied by publication (in the case of written works) or recording (in the case of music, film, or works of spoken word). The ubiquity of the Internet, specifically the rise of video sharing websites such as YouTube, has created an entirely new avenue for content creators to fix their works in a tangible means of expression. Along with this new freedom, however, has come an entirely new set of challenges in the realm of copyright. The ability of anyone, anywhere to record and upload audio/visual content to websites such as YouTube has been both creatively liberating and, increasingly, legally frustrating.

To keep up with the advancement of digital media and the advent of the Internet, Congress implemented reforms to United States copyright law in 1998.¹ In addition, Congress hoped to better fulfill the United States’ treaty obligations under the World

¹ *Executive Summary – Digital Millennium Copyright Act*, U.S. Copyright Office, (October 15, 2015). http://www.copyright.gov/reports/studies/dmca/dmca_executive.html

Intellection Property Organization (WIPO) Copyright Treaty of 1996. *Id.* 112 Stat. 2860, or the “Digital Millennium Copyright Act” (DMCA), was the result of this effort, a comprehensive series of additions and amendments to the Copyright Act of 1976 that has been the subject of much debate in the seventeen years since its passage. In order to help the United States better comply with the WIPO treaty, the DMCA enacted safeguards “against circumvention of technological protection measures employed by copyright owners to protect their works, and against the removal or alteration of copyright management information.” *Id.* In drafting the DMCA, Congress also made the determination,

To promote electronic commerce and the distribution of digital works by providing copyright owners with legal tools to prevent widespread piracy was tempered with concern for maintaining the integrity of the statutory limitations on the exclusive rights of copyright owners.

Id. This Congressional determination was made law through the Online Copyright Infringement Liability Limitation Act (OCILLA), a portion of the DMCA encoded at 17 U.S.C. 512, that was passed in order to provide “a safe harbor to online service providers (OSPs, including internet service providers) that promptly take down content if someone alleges it infringes their copyrights.”² Under OCILLA, copyright holders may approach OSPs and notify them of any improper use of the copyright holders’ intellectual property (IP) being hosted by the OSPs’ service. *Id.* Once notified, the OSP then removes or blocks access to the allegedly infringing content and, in exchange, receives a number of legal benefits. The benefits to OSPs include:

Protection from liability to [their] customers as a result of a decision to remove [infringing] material . . . Clear procedures for removing [infringing material] and restoring material [eventually found to be non-infringing] . . . [and] a safe

² *Online Copyright Infringement Limited Liability Act (OCILLA)*, The Anti-Abuse Project, (October 15, 2015). <http://www.anti-abuse.org/online-copyright-infringement-liability-limitation-act-ocilla/>.

harbor against copyright infringement claims, similar to the protection against non-intellectual property infringement liability provided by Section 230 the Communications Decency Act (CDA).

Id. The exchange was intended to provide immunity from liability to innocent OSPs whose services are used by copyright infringers to host infringing content.

Notice under OCILLA has a number of requirements before it is deemed adequate under the statute. In order to effectively put an OSP on notice, a written communication must be delivered to one of the OSP's designated agents that meets a number of criteria. 17 U.S.C. 512(c)(3)(A). First, the owner of the allegedly infringed content must sign the communication. *Id.* Second, the copyrighted work or works allegedly infringed on the given website must be identified. *Id.* Third, the allegedly infringing content must be identified, along with "information reasonably sufficient to permit the service provider to locate the material." *Id.* Fourth, the notice must provide contact information for the complaining party. *Id.* Fifth, the notice must contain "a statement that the complaining party has a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law." *Id.* Finally, there must be a statement that the information contained in the notice is accurate and, "under penalty of perjury," that the party issuing the complaint is permitted to act on behalf of the allegedly infringed content's owner. *Id.*

Once a valid notification has been received, the OSP may take down the allegedly infringing content and thus be immune from liability for,

Monetary relief, or, except as provided in subsection (j), for injunctive or other equitable relief, for infringement of copyright by reason of the storage at the direction of a user of material that resides on a system or network controlled or operated by or for the service provider.

Id. In order to fully qualify for the safe harbor, the OSP must also, upon obtaining notice, act "expeditiously to remove, or disable access to, the material." *Id.*

One of the possible remedies provided to copyright owners under OCILLA is that of an injunction. *Id.* OCILLA injunctions are subject to a number of limitations. *Id.* at (j). An injunction may be granted under OCILLA with respect to an OSP only in one of three possible forms:

(i) An order restraining the service provider from providing access to infringing material or activity residing at a particular online site on the provider's system or network[;] **(ii)** An order restraining the service provider from providing access to a subscriber or account holder of the service provider's system or network who is engaging in infringing activity and is identified in the order, by terminating the accounts of the subscriber or account holder that are specified in the order[; or,] **(iii)** Such other injunctive relief as the court may consider necessary to prevent or restrain infringement of copyrighted material specified in the order of the court at a particular online location, if such relief is the least burdensome to the service provider among the forms of relief comparably effective for that purpose.

Id. In addition, injunctions may be granted only if they pass the four-part test for injunctive relief contained in the statute. *Id.* at (k). These considerations include: the burden on the OSP; the magnitude of the harm to the copyright holder in the absence of an injunction; the feasibility, effectiveness, and ability to not interfere with non-infringing material of an injunction; and whether any less-burdensome means than an injunction exist to remedy the infringement. *Id.*

OCILLA has caused the most tension as copyright law has been applied to the evolving media landscape of the Internet in the present day. Nowhere has this tension been more readily apparent, however, than on YouTube, where the power of having a voice and a platform from which to express it has spawned a new breed of entertainers, among whom are otherwise regular people who may not be entirely well-versed in copyright law. This lack of sophistication on the part of newly-created authors on the internet has led to a system

in which copyright owners have a great deal of power and the OSPs have little incentive to resist their influence.

The Intersection of Copyright/OCILLA and YouTube

OCILLA's notice and removal provisions have sparked the creation of what YouTube has called its "ContentID" system.³ "ContentID" is a system by which YouTube flags videos uploaded by users that may contain material that is copyrighted by someone else. *Id.* Every video uploaded to YouTube gets scanned against a database of files submitted to YouTube by copyright holders.⁴ Once a video has been flagged by the system as containing copyrighted material, YouTube sends notice to the owner of the copyright. *Id.* YouTube then sends a notice to the creator of the video in question informing him or her that there may be copyrighted material in the video and that the copyright holder may take further action. *Id.* The copyright owner can choose to monetize the flagged video by running ads on it, track the video's viewership statistics, mute any audio that contains copyright material, or even block the video from being viewed in specific locations or worldwide. *Id.*

When the copyright holder chooses to block access to a video containing copyrighted material, the creator of the video receives a "copyright strike."⁵ YouTube applies a copyright strike to the creator of a video when that the owner of a valid copyright has sent YouTube a legal request, in accordance with 17 U.S.C. 512(c)(3)(A), providing notice of infringing content in the video being hosted on the site. *Id.* Once the formal notice has been received,

³ YouTube, *What Is A ContentID Claim?*, YouTube Help (2015).

<https://support.google.com/youtube/answer/6013276>.

⁴ YouTube, *How ContentID Works*, YouTube Help (2015),

<https://support.google.com/youtube/answer/2797370>

⁵ YouTube, *Copyright Strike Basics*, YouTube Help (2015).

<https://support.google.com/youtube/answer/2814000>.

YouTube has almost no choice but to remove the content; failure to do so would result in the removal of the safeguards provided by OCILLA to OSPs. *Id.* The creators of allegedly infringing content have only three options when it comes to resolving copyright strikes, which include: completing a YouTube-designed course in copyright, and receiving no additional strikes for six months; contacting the copyright holder and requesting a retraction of their copyright claim; or submitting a counter-notification that the video was either misidentified as infringing or qualifies for fair use protections. *Id.*

“Fair Use” is the concept that allows the copyrighted content to be used without the permission of the copyright holder provided that the content meets a four-part test.⁶ The first consideration is the “purpose and character of the use, including whether such use is of commercial nature or is for nonprofit educational purposes.” *Id.* For the first factor, courts typically consider whether the new work is “transformative” by adding new expression or meaning to the original work. *Id.* Commercial use of copyrighted material goes against a finding of fair use, although it is possible to monetize an allegedly infringing use and still receive fair use protections. *Id.* The second consideration is the nature of the copyright work being drawn from; if the copyright work is one of fiction, for example, it may be harder to receive fair use protections than if the copyright work were one of fact. *Id.* The third consideration is the amount of the copyrighted work used in the allegedly infringing work, with a finding of fair use being less likely the more of the original work has been used. *Id.* The final consideration is the effect of the allegedly infringing use on the market for the

⁶ YouTube, *What is Fair Use?*, YouTube Copyright Center (October 15, 2015).
<https://www.youtube.com/yt/copyright/fair-use.html#yt-copyright-four-factors>.

original work. *Id.* If the new work, for example, takes profits away from the original work, fair use is less likely to apply. *Id.*

Most of the controversy regarding ContentID has sprung from the potential for abuse by copyright holders present in a system where works of expression may be suppressed or removed unilaterally without a process for appeal in place until after the suppression or removal occurs.⁷ One context where this issue has come up quite frequently, for example, has been the realm of video game media; users on YouTube who create videos of themselves playing video games and providing commentary (referred to as “Let’s Play videos”) have become targets of the companies that own the video game IP. *Id.* While some video game companies have expressed support for the YouTube community and disappointment with YouTube’s system, the ContentID program has been abused by other companies both as a way to prevent monetization of this fair use content and as a way of silencing harsh critics of bad games. *Id.*

Criticism and commentary has become an essential part of the world’s economy where entertainment is concerned. Consumers of entertainment media in all of its forms (books, video games, television, music, film, etc.) can latch on to their favorite reviewers and consult their reviews before purchasing a product. The ContentID system as it currently stands allows the owners of IP to get videos removed from YouTube without filing for an injunction just by sending a formal communication to YouTube claiming that their IP is being infringed on. *Id.* The chilling effect such a system could have on free speech is obvious. As

⁷ Eric Kain, *YouTube Responds to ContentID Crackdown, Plot Thickens*, Forbes (December 17, 2013). <http://www.forbes.com/sites/erikkain/2013/12/17/youtube-responds-to-content-id-crackdown-plot-thickens/>.

mentioned above, the system even allows IP owners to divert monetization away from the YouTube user who created the video, having the money sent to the IP owner instead. *Id.*

YouTube's implementation of the ContentID system has almost no basis in the actual copyright law itself. *Id.* The main reason why the system is in place is because YouTube receives a cut of the money made from advertisement attached to every monetized video hosted on the service. *Id.* If the owner of a copyright issues a formal takedown notice under the DMCA, then YouTube has to remove the video entirely and, as a result, take no cut of the money it makes. *Id.* By allowing the copyright holder to instead submit a claim under ContentID, the video can stay up only with the money going to YouTube and the copyright holder rather than the people who actually made the video in question. *Id.*

While these issues with ContentID and DMCA takedown notices would seem to have little to do with an anti-Islam propaganda film, and the people who were tricked into appearing in it, the problems of ContentID claims and DMCA/OCILLA takedowns are an ever-present concern to free speech on the internet, specifically on YouTube. A new front in the battle for free Internet speech opened up three years ago, when a man named Mark Basseley Youssef decided to create one of the most offensive short films of all time with the help of a group of unwitting actors and crew. One member of the film's cast, Cindy Lee Garcia, attempted to send a takedown notice to YouTube based on her supposed copyright interest in her performance. The resulting Ninth Circuit appellate case became almost as infamous as the video itself, at least in the realm of copyright law.

II. Garcia v. Google 1

Factual Background/Procedural History

Mark Basseley Youssef (also known as “Nakoula Basseley Nakoula” and “Sam Bacile”) sent out a casting call for what he claimed to be a period action film set in the Middle East called “Desert Warrior”. *Garcia v. Google, Inc.*, 743 F.3d 1258, 1261 (9th Cir. 2014). One of the actors who answered the call was Cindy Lee Garcia. *Id.* Garcia signed up to be paid \$500 for three and a half days of shooting; she was to appear in a very minor role, receiving only four script pages on which she had any dialogue in the entire film. *Id.* Rather than actually finish the “Desert Warrior” film, Youssef took the footage he shot with Garcia and the other actors and dubbed over their voices with new dialogue that consisted almost entirely of anti-Islamic language. *Id.* In one of her brief scenes, for example, Garcia’s character appeared to be asking someone, “Is your Muhammad a child molester?” *Id.*

Once the actual film, re-titled as “Innocence of Muslims,” began making its way around the world, it eventually reached Egypt. *Id.* at 1262. The film’s anti-Islam sentiments led to riots; an Egyptian Muslim cleric even called for the deaths of all who were involved in the making of the film. *Id.* Ms. Garcia began receiving personal death threats shortly thereafter. *Id.* In response to the death threats, Garcia began asking Google, the owners of YouTube, to take the video down. *Id.* Garcia sent in eight DMCA takedown notices to Google, all of which were met with resistance. *Id.* When Garcia provided substantive explanations for why the video should have been taken down, Google still resisted. *Id.* In response, Garcia filed for a temporary restraining order, claiming that Google’s hosting of the video on YouTube infringed her copyright in her performance in the film. *Id.*

The district court in California treated the case as one for a preliminary injunction. *Id.* In denying Garcia’s application, the district court reasoned that,

Garcia had delayed in bringing the action, had failed to demonstrate “that the requested preliminary relief would prevent any alleged harm” and was

unlikely to succeed on the merits because she'd granted Youssef an implied license to use her performance in the film.

Id. In response to her failure in the district court, Garcia appealed the decision to the Ninth Circuit. *Id.*

Majority Opinion

The Ninth Circuit analyzed the denial of Garcia's preliminary injunction under a four-factor test. *Id.* The factors are: "a plaintiff's likely success on the merits, the likelihood that irreparable harm will result if an injunction doesn't issue, the balance of equities and the public interest." *Id.* (citing *Winter v. Natural Res. Def. Council*, 555 U.S. 7, 20 (2008)). The district court found against Garcia on the first two of these factors and, as a result, did not consider the second two. *Id.* Stated plainly, the main issue for Garcia is that she had to prove "not only that she likely has an independent interest in her performance but that Youssef doesn't own any such interest as a work for hire and that he doesn't have an implied license to use her performance." *Id.*

The prevailing opinion on copyright interest in film is that films are joint works, the end result of the efforts put in by a number of different people who may all be considered "authors" of some portion of the end product." *Id.* at 1262-63 (citing *Nimmer On Copyright*, Section 6.05 at 6-14 (1990)). Garcia argued in front of the Ninth Circuit that she did not qualify as a joint author of "Innocence of Muslims" and that she never intended her performance to become part of the film as a "joint work." *Id.* at 1263. Judge Kozinski, writing for the Ninth Circuit majority, reasoned that even in the absence of a joint author situation, so long as the individual's contribution to the film is both fixed and "sufficiently creative," then there could still be a copyright interest in the contribution. *Id.*

Despite Google's argument that Youssef wrote all the words Garcia spoke managed the entire production, and even eventually replaced all of Garcia's spoken performance with dubbed dialogue, Judge Kozinski appeared convinced of the notion that "an actor does far more than speak words on a page; he must 'live his part inwardly, and then . . . give to his experience an external embodiment.'" *Id.* (citing Constantin Stanislavski, *An Actor Prepares* 15, 219 (Elizabeth Reynolds Hapgood trans., 1936).

In breaking from years of copyright law in the realm of film authorship and film copyright ownership, Judge Kozinski's opinion would essentially separate the individual contributions made by each actor and crew member to the film, providing them all a copyright interest in that contribution. *Id.* at 1264. Kozinski's opinion even twists the language of Ninth Circuit copyright precedent into supporting this notion by quoting the statement, "'authorship is required under the statutory definition of a joint work, and . . . authorship is not the same thing as making a valuable and copyrightable contribution.'" *Id.* (citing *Aalmuhammed*, 202 F.3d at 1232). The opinion incorrectly analogizes the question of film authorship with "the author of a single poem" not necessarily becoming "a co-author of the anthology in which the poem is published." *Id.* at 1265. Such an analogy does not apply because a poem is still separable from an anthology and can stand on its own, whereas the contributions to a film combine to make the film what it is; the whole matters more than the sum of its parts.

Once satisfied that Garcia's performance was both fixed and sufficiently creative to create a copyright interest, the majority opinion next focused on Google's "Work For Hire" argument. *Id.* Under the Work For Hire Doctrine, "the rights to Garcia's performance vested in Youssef if Garcia was Youssef's employee and acted in her employment capacity or was an

independent contractor who transferred her interests in writing.” *Id.* (citing *Cnty. For Creative Non-Violence v. Reid*, 490 U.S. 730, 751 (1989)). Film productions have presented a unique problem when it comes to how one qualifies as an employee; since actors and crew members are contracted to work on that single production alone, the lines between traditional employment and independent contracting can become blurred. *Id.* As a way of solving this problem, written agreements transferring all authorship rights to the owners of the film in question (usually the film studio) are obtained before production begins. *Id.* Such as was not the case with “Innocence of Muslims.” *Id.*

In the absence of a written agreement, the majority opinion rejected the notion that Garcia was an employee because Youssef controlled every aspect of the production, including the scenes in which Garcia appeared, and because Youssef was in the business of making films at the time. *Id.* In making this rejection, the majority opinion merely dismissed the notion of possible employment by claiming that there was no evidence in the record to support the claim that Youssef controlled every aspect of the production or that he was in the business of making films. *Id.* at 1265-66.

The majority opinion next considered whether there existed an implied license between Garcia and Youssef giving Youssef the right to use Garcia’s performance to make “Innocence of Muslims.” *Id.* Google argued that Garcia gave Youssef an implied license to use her performance and the majority opinion agreed, holding that Garcia gave her performance at Youssef’s request and handed it over to him, intending that he copy and distribute it. *Id.* In addition, the majority acknowledged that “without an implied license, the performance for which [Garcia] was paid would be unusable.” *Id.* Even in spite of the finding that there was an implied license, and the additional concession that such licenses must be construed

broadly so that an actor cannot derail a film's release because it did not "meet [the actor's] ex ante expectation," the majority still found that the use of Garcia's performance in the present case went to far beyond the license. *Id.* According to the majority,

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.

Id. at 1266-67. Not only was "Innocence of Muslims" not an adventure film set in ancient Arabia, it wasn't "intended to entertain at all." *Id.* at 1267. The fact that Youssef had to lie to Garcia to obtain her participation, the majority reasoned, was proof that he had exceeded the license in making "Innocence of Muslims." *Id.*

Turning to the irreparable harm argument, the majority broke with the district court in its assessment that Garcia's failure to bring her lawsuit immediately upon learning the true nature of the film disproves her need for quick action, the hallmark of any granted preliminary injunction. *Id.* Instead, the majority cited the nexus between the harm being caused (the numerous death threats Garcia was receiving) and the conduct she sought to enjoin (the copyright infringement). *Id.* at 1268. Since Youssef made "Innocence of Muslims" by infringing on Garcia's supposed copyright in her performance, the majority chose to "err on the side of life" and weigh this factor of the preliminary injunction test in Garcia's favor. *Id.*

Finally, the majority considered the balance of the equities and the public interest together during the final paragraphs of the opinion. *Id.* The balance of the equities was easy for the majority to dismiss in Garcia's favor because Youssef was fraudulent in his purpose and because Google did not focus on the balance of the equities in their response. *Id.* Instead,

Google focused on the public interest in leaving the video on YouTube, claiming that a preliminary injunction against the video constitutes “unconstitutional prior restraint of speech;” the majority countered by claiming that, because it has found Garcia had a copyright interest in the performance, the Constitution does not protect against copyright infringement. *Id.*

In the end, the majority opinion in *Garcia 1* ultimately ordered the case was to be reversed and remanded to the district court for further proceedings. *Id.* at 1269.

Dissent

The dissent in *Garcia 1*, written by Judge Smith, immediately criticized the majority opinion by questioning its categorization of the injunction as preliminary rather than mandatory. *Id.* “Rather than asking to maintain the status quo pending litigation, Garcia demands Google immediately remove a film from YouTube,” the dissent argued, and as such the injunction must be given a high degree of scrutiny considering the Ninth Circuit disfavors mandatory injunctions. *Id.* In fact, under Ninth Circuit precedent, mandatory injunctions should only be issued if the “facts and law *clearly favor* the moving party.” *Id.* (citing *Stanley v. Univ. of Southern California*, 13 F.3d 1313, 1319-20 (1994)). The dissent therefore argued that “the majority may only reverse if it were illogical or implausible . . . for the district court to conclude that the law and facts did not *clearly favor* Garcia.” *Id.* at 1269-1270 (citing *United States v. Hinkson*, 585 F.3d 1247, 1263-64 (9th Cir. 2009)).

Turning to the four *Winter* Factors, the dissent first discussed Garcia’s copyright interest, or lack thereof, in her performance. *Id.* at 1270. Rather than categorize the acting performance as its own separate and copyrightable work, the dissent instead argued that a

performance actually resembles a “procedure” or “process” by which an original work (the script) is performed. *Id.* The film itself was the “work,” according to the dissent. *Id.* at 1271.

In addition, the dissent questioned Garcia’s authorship over the film. *Id.* To accomplish this, the dissent compared Garcia’s contributions to “Innocence of Muslims” with the contributions of Aalmuhammed to the film *Malcolm X* in the *Aalmuhammed* case. *Id.* The court in that case concluded that Aalmuhammed,

“(1) Did not at any time have superintendence of the work,” (2) “was not the person ‘who . . . actually formed the picture by putting the persons in position, and arranging the place,” (3) could not “benefit” the work “in the slightest unless [the director] chose to accept [his recommendations],” and (4) made “valuable contributions to the movie,” but that alone was “not enough for co-authorship of a joint work.”

Id. at 1272 (citing *Aalmuhammed v. Lee*, 202 F.3d 1227, 1235 (9th Cir. 2000)). Garcia’s contributions to “Innocence of Muslims,” in comparison were even less than Aalmuhammed’s, who was at least an expert on Malcolm X and Islam and provided creative consultation for *Malcolm X*’s actors. *Id.* Garcia conceded that she held no creative control over the script (which was provided by Youssef) or her performance (which was directed by Youssef). *Id.* While a work may have joint authors, those authors must have (1) intended their contributions be merged into inseparable or interdependent parts of a unitary whole; and (2) exercised meaningful creative control over the work. *Aalmuhammed*, 202 F.3d at 1234. As a result of Garcia’s minimal contributions to the final film, the dissent finds it illogical that Congress could have intended copyright law to apply in this scenario. *Id.* at 1272-73.

As to fixation, the dissent pointed to three cases that, when combined, help to disprove Garcia’s claim. *Id.* In the first case, Bette Midler sued Ford for misappropriating her voice; Ford had properly licensed one of Midler’s songs for use in a commercial but had hired

someone to imitate her voice rather than use the original recording. *Id.* (citing *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988)). Despite ultimately ruling in favor of Ford, the *Midler* court still held that, while Midler's voice was not copyrightable, the entirety of the song was. *Id.* In the second case, Sony prevailed in a copyright preemption claim where they properly licensed a song for use in a commercial but only used a portion of the actual song; because Sony did not hire someone to imitate the original singer's voice, they won the case. *Id.* (citing *Laws v. Sony Music Entertainment*, 448 F.3d 1134, 1141 (9th Cir. 2006)). In the third case, the Defendants illegally copied, reproduced, and counterfeited copyright pornographic DVDs before selling sold the copies to third parties; the Ninth Circuit ruled in favor of the original producers of the DVDs, holding they had a copyright interest in the DVDs. *Jules Jordan Video, Inc. v. 144942 Canada, Inc.*, 617 F.3d 1146-1153 (9th Cir. 2010). "Combined, these cases show that, just as the *singing* of a song is not copyrightable, while the entire song recording is copyrightable, the *acting* in a movie is not copyrightable, while the movie recording is copyrightable." *Garcia*, 743 F.3d at 1274. The comparison of an actor's performance in a film to a singer's performance in a recorded piece of music is an apt one, as a singer and actor are both parts of a larger group of people that come together to create a finished product. *Id.* at 1274-75.

Having defeated Garcia's copyright interest argument, the dissent next turned to the Work For Hire Doctrine. *Id.* The dissent placed a good deal of weight on the Work For Hire Doctrine analysis, mainly because "in the United States most contributions to a motion picture are created as works made for hire." *Id.* at 1275 (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, 238 (2001)). According to the undisputed record,

Garcia conceded in her complaint and affidavit that Youssef "managed all aspects of production," controlling both the manner and means of making the film, including the scenes featuring Garcia . . . Youssef provided the instrumentalities and tools, dictated the filming location, decided when and how long Garcia worked, and was engaged in the business of film making at the time. Additionally, Garcia did not hire or pay assistants.

Garcia, 743 F.3d at 1275. The dissent also distinguished the *Garcia* facts from those found in *Reid* by explaining that, in *Reid*, a sculptor was hired to create a sculpture for a non-profit organization that only had control over the specifications of the sculpture. *Id.* at 1275-76 (*citing Reid*, 490 U.S. at 752). The sculptor himself had control over all the other relevant factors in the Work for Hire Doctrine analysis and, as a result, the *Reid* Court ruled in favor of the sculptor. *Id.* at 1276 (*citing Reid*, 490 U.S. at 752). Here, Garcia had no control over any aspect of her performance or over the film itself and, thus, was clearly an employee under the Work For Hire Doctrine. Therefore, " the employer or other person for whom the work was prepared is considered the author for purposes of this title. . . ." 17 U.S.C. § 201(b).

Following its Work for Hire discussion, the dissent next discussed the presence of irreparable harm. *Garcia*, 743 F.3d at 1276. The majority held that the district court abused its discretion by finding that Garcia's five-month delay in bringing suit was fatal to her irreparable harm argument. *Id.* The dissent, instead, looked past the threats to Garcia's life and instead separated them from the legal rights that Garcia's case is supposedly about protecting. *Id.* "Were Garcia really trying to protect her purported copyright interest in her acting performance, one would expect her to have brought this action immediately after learning of the alleged infringing behavior." *Id.* The only relevant harm for the irreparable harm analysis, according to the dissent, is the one that occurs to the legal interests of the parties; framing the issue that way, the dissent held that Garcia "failed to explain her delay in terms of harm to her alleged copyright interest." *Id.* Further, an aspect of irreparable harm

in Garcia's situation was whether or not preventing future viewings of the video on YouTube would prevent future harm. *Id.* As Garcia admitted she had already gone public about her condemnation of the video, there was really nothing further she could do since bring the video down from YouTube would not prevent the people who had copied it to other sites from viewing it. *Id.*

Separating the balance of the equities from the public interest, the dissent first discussed how the balancing did not favor Garcia. *Id.* at 1277. Even if Garcia did have a protectable copyright interest in her performance, the loss of her preliminary injunction motion would mean she is "only faced with *potential* infringement of her *potential* copyright interest *pending* a final disposition of this lawsuit." *Id.* Further, if Garcia truly valued her performance as much as her lawsuit would suggest, the dissent questioned why she did not have a contract with Youssef outlining her rights. *Id.* "The facts evidence that she acted for three days and was paid \$500 dollars," meaning her performance was not worth much effort and, thus, neither is any potential copyright interest in it. *Id.* In addition, the dissent rejected the majority's discussion of Youssef in the balance of the equities because Youssef was not a party to the court proceedings and Google was not a party to any transaction with Youssef. *Id.* The dissent ultimately weighed the balance of the equities in favor of Google. *Id.*

Concerning the public interest, the dissent believe strongly in the idea that the public's interest in a strong First Amendment is one of the most important concerns in any legal action implicating free speech. *Id.* However, the dissent did concede that the First Amendment does not protect copyright infringement, although with the caveat that "if Google was actually infringing Garcia's copyright" it would not be protected. *Id.* Since Google was not infringing any actual copyright owned by Garcia, the public interest in favor of

protecting free speech by not taking the video down until after litigation should have won out in the end. *Id.* at 1277-78. Unfortunately, the majority did not agree and, as a result, a fierce backlash to such an unprecedented opinion began building around the country.

Reaction to the Decision

The negative reaction to the *Garcia* decision was almost immediate. Those who criticized the opinion following its issuance could be categorized mainly into at least one of three categories:

Some [argued] that the court erred in so ruling because Garcia's performance [did] not actually satisfy the Copyright Act's requirements; others [suggested] the court's analysis [was] wrong because it [failed] to properly take into account important legislative and constitutional protections of free expression; and yet others [contended] the result [was] mistaken because of its likely practical effects on certain business models.⁸

In addition to the common complaints, another concept arose from the *Garcia* case concerning how Garcia was using copyright law to achieve goals for which it was not intended. *Id.* Garcia "latched on to copyright as a means of removing the film [from YouTube] once other options [for preventing people from seeing it] were deemed less than ideal." *Id.*

Scholars and other members of the legal community were not the only ones coming out against the original decision in *Garcia*.⁹ Netflix, the giant streaming video service, added its voice to the chorus of parties urging the Ninth Circuit to hold a rehearing en banc in the *Garcia* matter. *Id.* One apt comparison offered by Netflix was their questioning whether a bit

⁸ Clark D. Asay, *Ex Post Incentives in Garcia v. Google and Beyond*, Stanford Law Review, 67 Stan. L. Rev. Online 37 (August 20, 2014). <http://www.stanfordlawreview.org/online/ex-post-incentives-and-ip-in-garcia-v-google-and-beyond>.

⁹ Eriq Gardner, *Netflix Asks Appellate Court to Reconsider 'Innocence of Muslims' Ruling*, The Hollywood Reporter (April 15, 2014). <http://www.hollywoodreporter.com/thr-esq/netflix-asks-appellate-court-reconsider-696226>.

actor in *Gone With The Wind* could have enjoined the distribution of that classic film because he or she did not appreciate her performance appearing in a “Yankee propaganda” film. *Id.* Netflix has no ability, it argued, “to determine whether licensing niceties have been observed for each of the tens of thousands of works it distributes, and no easy way to assess or defend against a claim if they have not.” *Id.*

There were some in the immediate aftermath of the first *Garcia* decision who felt that the ruling’s impact would be minimal because contracts can be drawn up and signed that remove the kind of interest *Garcia* attempted to assert in the absence of a contract. *Id.* In response, however, opponents of the *Garcia* holding pointed out that if a potential copyright claim has “even a hint of legitimacy,” whether or not it is actually valid, “service providers will err on the side of caution by removing works in the face of a takedown demand in the interest of gaining safe harbor from copyright liability.” *Id.* This notion once again returns to the consequences of systems such as YouTube’s ContentID; despite YouTube and Google fighting for free speech in *Garcia*, nobody can accurately predict how they would have behaved after having lost that fight. As system such as ContentID is the perfect framework for an OSP to easily remove content that may or may not actually be infringing on a copyright. Netflix argued,

By creating a new species of copyright, and empowering essentially any performer in a motion picture or television program to both sue downstream distributors and enjoin any use of her performance of which she does not approve, the panel majority risks wreaking havoc with established copyright and business rules on which all third party distributors, including Netflix, depend.

Id. Content distributors such as YouTube and Netflix are simply not equipped to parse through each individual claim and, thus, would likely find it easier to acquiesce than fight.

The implications of *Garcia* extended beyond the content providers themselves as well. Both NPR and *The Washington Post* argued that the subjects of unflattering news coverage could, in effect, exercise a kind of veto power over broadcast, or public officials could claim copyright in their prepared remarks and request video of a poor speaking performance be taken down. *Id.* Documentary filmmakers, including *Supersize Me* director Morgan Spurlock, also expressed concern about the subjects of their filmed interviews figuring out a way to work the *Garcia* holding in their favor. *Id.* All told, the objecting parties included such heavyweight corporations as “Facebook, eBay, Gawker, Twitter, Yahoo, IAC/InterActiveCorp, Tumblr, [and] Kickstarter” among others. *Id.*

III. *Garcia v. Google 2*

Intervening Facts

The parties urging a rehearing eventually won out and the Ninth Circuit agreed to reconsider the *Garcia* holding.¹⁰ Not all parties with an interest in the case came out against the initial *Garcia* decision, however; one of the main proponents of the ruling was SAG-AFTRA, the guild of film and television actors. *Id.* After the Ninth Circuit announced the rehearing, SAG-AFTRA submitted its own amicus brief complete with references to famous actors who, according to the guild, did bring originality to their performances. *Id.* According to SAG-AFTRA, opponents of the original decision have argued that an actor is nothing more the “a puppet” that reads lines from a script the way the director tells them to. *Id.* In reality, the guild argued, actors bring immense originality to their roles, even in roles that have been portrayed numerous times by other actors. *Id.* Pointing to the character of Batman, the guild

¹⁰ Eriq Gardner, *Actors Guild Gets Behind Copyrights For Some Performers*, *The Hollywood Reporter* (December 8, 2014), <http://www.hollywoodreporter.com/thr-esq/actors-guild-gets-behind-copyrights-754973>.

argued that each of the actors to have played the character brought something unique to it, such that no two portrayals have ever been the same. *Id.* In addition, the guild mentioned the late Heath Ledger's performance as the Joker, including how the actor maintained in an interview before his death that director Christopher Nolan had given him "free rein" to discover the character over the course of a month. *Id.*

In any event, even though some copyright scholars, such as the famous David Nimmer, argued that there may actually be a copyright interest in an actor's performance, they still felt that Garcia's particular performance fell well short of whatever mark defines the minimum requirements needed to obtain it. *Id.* In response, the guild argued that any performance, no matter how small, consists of the actor's original expression and even pointed to one of the great brief performances in film history: Robert Duvall's speech about the smell of napalm from *Apocalypse Now*. *Id.* Finally, the guild admitted that most major studios are signatories to collective bargaining agreements that expressly limit the rights contributors to films may have; while such agreements do not affect independent filmmakers such as Youssef, the guild felt that in certain situations it is proper to award copyright interests to an actor for his or her performance. *Id.* Garcia's case, according to the guild, was one of those instances. *Id.*

Nevertheless, the Ninth Circuit set about conducting an en banc rehearing of the *Garcia* decision and the majority came out with quite a different holding the second time through. *Garcia v. Google, Inc.*, 786 F.3d 733, 747 (9th Cir. 2015) (*Garcia* 2).

Majority, Concurring, and Dissenting Opinions

Surprising few, the Ninth Circuit's rehearing was essentially an excuse to completely reverse the holding of the original *Garcia* opinion. *Id.* at 747. Judge McKeown's opinion

essentially echoed the sentiments of Judge Smith's dissent in the original *Garcia* decision, outlining them once again, point-by-point and in detail. *Id.* at 733-47. Without repeating the entirety of the preceding section, certain new additions to each argument bear analysis. Concerning the copyright claim, Judge McKeown brought up the Copyright Office and how it had rejected Garcia's application to copyright her performance. *Id.* at 741. The Office added that it continued to support that traditional notion that a film is "a single integrated work" and that Garcia's performance is no severable from that work; absent any contribution to the film other than her very brief performance, Garcia has no copyright interest in the film. *Id.* at 742. In addition, to hold that Garcia had a copyright interest in her brief performance could also open the doors to film's with enormous casts of extras (including *Ben-Hur* or *The Lord of the Rings*) to have to negotiate the copyright interests of each extra prior to filming. *Id.* at 742-43. Such an outcome would not be practical for the film industry.

As to irreparable harm, the injuries claimed by Garcia (the threats to her life and her fear of those threats) do not have anything to do with her copyright interests; the irreparable harm question concerns harm to copyright interests alone, specifically the "value and marketability" of the work or works at issue. *Id.* at 744-45. In *Bollea v. Gawker Media, LLC*, former professional wrestler Hulk Hogan sought an injunction against a website that had posted a sex tape of himself with a mistress online, citing copyright issues. 913 F.Supp.2d 1325, 1327 (M.D. Fla. 2012). In *Bollea*, as in *Garcia*, "the only evidence in the record reflecting harm . . . relates to harm . . . personally . . . due to the . . . nature of the Video's content . . . not . . . irreparable harm in the context of copyright infringement." *Garcia 2*, 786 F.3d at 745 (citing *Bollea*, 913 F.Supp.2d at 1329). Finally, again echoing the lack of urgency in Garcia's

filing as detrimental to her claim for irreparable harm, the opinion held against her. *Garcia 2*, 786 F.3d at 746.

The opinion after rehearing also included a concurrence from Judge Watford. *Id.* at 747. Interestingly, Judge Watford did not seem to agree that Garcia does not possess a copyright interest in her short performance during “Innocence of Muslims.” *Id.* at 749. In fact, the sole reason why Judge Watford concurred in the ultimate judgment was that the district court did not abuse its discretion in concluding that, on this record, Garcia failed to satisfy the irreparable harm” analysis. *Id.* Judge Watford had a different take on the reasoning behind Garcia’s failure to meet the irreparable harm standard, however, arguing:

The sad but unfortunate truth is that the threat posed to Garcia by issuance of the fatwa will remain whether *The Innocence of Muslims* is available on YouTube or not. Garcia is subject to the fatwa because of her role in making the film, not because the film is available on YouTube. The film will undoubtedly remain accessible on the Internet for all who wish to see it even if YouTube no longer hosts it. Bottom line: Garcia's requested injunction won't change anything about the content of the film or the part, however limited, she played in its making.

Id. at 748. Even though Garcia’s actual role in the making of the film was misunderstood by many in the Islamic community, and even though Garcia had taken several steps to ensure that her true feelings on Islam were know to the world, the threats to her life did not cease. *Id.* As a result, enjoining the video from appearing n YouTube would not result in a remedy to the harm Garcia had been facing and, thus, she failed the irreparable harm analysis. *Id.*

Judge Kozinski, likely defending his radical position in the original *Garcia* opinion so as not to appear completely wrong, wrote the dissent in *Garcia 2*. *Id.* at 749. The crux of Judge Kozinski’s argument was that the alleged harms that would be suffered by film studios were overstated, as were the potential harm to those internet companies that host the content online. *Id.* at 749-53. Judge Kozinski appeared to be advocating for the separability of every

scene in every film ever made, an outcome that would cause untold havoc in the world of film. *Id.* at 750 (“If Garcia's scene is not a work, then every take of every scene of, say, *Lord of the Rings* is not a work, and thus not protected by copyright, unless and until the clips become part of the final movie”).

In addition, the dissent tried to draw a distinction between “joint authorship of a movie” and “whether a contribution to a movie can be a ‘work.’” *Id.* The dissent hoped to categorize every individual contribution to a film as its own copyrightable “work” that would allow its creator to exercise some control over the contribution. *Id.* According to the dissent, the fact that Garcia did not sign away her copyright interests to Youssef before recording the film meant that she obtained rights to her performance the moment it was fixed on film. *Id.* at 751. Such an interpretation of the facts neglects to consider the fact that such an assignment of rights does not need to be obtained in writing to occur, something the dissent even uses in support of its own contentions later in the opinion. *Id.* at 751-52. (“The harm the majority fears would result from recognizing performers' copyright claims in their fixed, original expression is overstated. The vast majority of copyright claims by performers in their contributions are defeated by a contract and the work for hire doctrine . . . And most of the performers that fall through the cracks would be found to have given an implied license to the film's producers to use the contribution in the ultimate film.”).

It appears clear that both the majority in *Garcia 1* and the dissent in *Garcia 2* saw a person in need of some assistance, any assistance that could be given, and wanted to aid her. Such a proposition, while noble, does not take into account the numerous consequences of action focused in the realm of copyright law. The new majority opinion remedied a fracture

in the foundation of copyright in film and on the internet that could have led to a collapse of epic proportions.

Reception to the Rehearing

As opposed to *Garcia 1*'s reception, the reception to *Garcia 2* has been largely one of relief and positivity.¹¹ As the vast majority of *Garcia 1*'s critics felt that the decision constituted a prior restraint of free speech on the internet, it is not difficult to understand why the reaction to *Garcia 2* was so largely positive. *Id.* Despite the controversial views and language contained within Youssef's film, views and language that is quite repugnant in truth, most observers felt that the remedies of copyright law should not be used to censor the film from YouTube.¹²

Not all of those who supported the ultimate ruling by the Ninth Circuit on rehearing had praise for the court itself, however; many were quick to voice their frustration that the rehearing decision took over a year after the original opinion's publication to come out. *Id.* As the opinion in *Garcia 1* was harmful to the First Amendment, critics of the Ninth Circuit felt that they had abandoned the right to unrestrained free speech for over year while they waited to correct their mistake. *Id.* In the end, however, it appeared as though only Judge Kozinski himself was left defending the *Garcia 1* opinion, while proponents of free speech on the internet breathed a sigh of relief. *Id.* Even though the opinion following the rehearing was only issued in May of 2015, the better law of the *Garcia 2* opinion has already had the

¹¹ Corynne McSherry, *Finally! Victory for Free Speech in Garcia v. Google*, Electronic Frontier Foundation (May 18, 2015). <https://www.eff.org/deeplinks/2015/05/finally-victory-free-speech-garcia-v-google>.

¹² Michael Loney, *Garcia v. Google Reversal Warmly Received (Except by Judge Kozinski)*, Managing Intellectual Property - The Global IP Resource (May 20, 2015). <http://www.managingip.com/Blog/3455424/Garcia-v-Google-reversal-warmly-received-except-by-Judge-Kozinski.html>.

opportunity to affect another Federal Circuit and its jurisprudence. *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247 (2nd Cir. 2015).

IV. Subsequent Jurisprudence and Analysis

In *16 Casa Duse*, a film production company in New York (“Casa Duse”) purchased the rights to a screenplay called *Heads Up* with the intention of making it into a short film. *Casa Duse*, 791 F.3d at 251. Krakovski, the owner of Casa Duse, approached Merkin to direct the film; Merkin agreed and the two settled on a fee of \$1,500 for Merkin’s services. *Id.* Krakovski proceeded to hire a cast and crew for the film, with all the hiring subject to Krakovski final say despite some minor input from Merkin. *Id.* Each cast and crew member other than Merkin entered into a “work-for-hire” agreement with Casa Duse that assigned all copyright interest in the film to Casa Duse. *Id.* Krakovski sent a copy of a similar agreement, called the “Director Employment Agreement,” to Merkin, who acknowledge receipt and added that he needed further time for review. *Id.* Merkin never executed the agreement and production began anyway, with Merkin performing his duties as director over the course of a three-day shoot. *Id.* When production concluded, Krakovski gave a hard drive containing the raw footage from the shoot to Merkin in the hopes that Merkin would edit the footage. *Id.* To effectuate this purpose, the parties entered into a “Media Agreement,” “under which Merkin would edit but not license, sell, or copy the footage for any purpose without the permission of Casa Duse.” *Id.* at 252. After negotiations for a final employment agreement fell through, Merkin sent Krakovski an email claiming total ownership of the raw footage and forbidding Krakovski from using it in any capacity. *Id.* Merkin also threatened to call all film festivals to which *Heads Up* was being sent and telling them that he did not consent to its screening. *Id.* Merkin even went so far as to register for a copyright on the film with the Copyright Office,

claiming himself as the sole owner. *Id.* In March 2012, Krakovski submitted *Heads Up* to film festivals and organized a screening for the New York Film Academy (NYFA); Merkin sent a cease-and-desist notice to the NYFA in response. *Id.* at 253. Casa Duse missed out on submission deadlines for four festivals as a result of the dispute, in addition to losing all the money it had invested in the NYFA screening. *Id.*

Much like in *Garcia v. Google*, the district court in *Casa Duse* found that Merkin could not copyright his creative contributions to the film and did not possess any copyright interest in the final product. *Id.* at 255. On appeal, the parties agreed that Merkin was not a “joint author” of *Heads Up*, nor were his contributions of the “work-for-hire” nature. *Id.* The main dispute thus arose over whether Merkin could copyright his individual contributions to the films. *Id.* Echoing the discussion found in *Garcia 1* dissent and the *Garcia 2* majority, the Second Circuit explained that the Copyright Act lists works such as motion pictures and music recordings as eligible for copyright protection, however,

The [Copyright] Act lists none of the constituent parts of any of these kinds of works as “works of authorship.” This uniform absence of explicit protection suggests that non-freestanding contributions to works of authorship are not ordinarily themselves works of authorship.

Id. at 257. Further, the Act’s language mandating that individual contributions to works such as films be “separate and independent” in order to be copyrightable on their own “indicates that inseparable contributions integrated into a single work cannot separately obtain such protection.” *Id.*

After mentioning the tumultuous procedural history of *Garcia*, the Second Circuit immediately agreed with the *Garcia 2* majority in holding that,

Filmmaking is a collaborative process typically involving artistic contributions from large numbers of people, including—in addition to producers, directors, and screenwriters—actors, designers, cinematographers, camera operators,

and a host of skilled technical contributors. If copyright subsisted separately in each of their contributions to the completed film, the copyright in the film itself, which is recognized by statute as a work of authorship, could be undermined by any number of individual claims.

Id. at 258. Of course, the Second Circuit also cautioned that a director *can* hold a copyright interest in a film, provided he or she a sole or joint author of the film itself. *Id.* In addition, the opinion mentions that authors of “freestanding works” that are then included in a film, such as a “dance performance or a song,” can retain copyright interest in those contributions. *Id.* at 259. Finally, as in *Garcia 2*, the Second Circuit majority mentioned the policy argument that “a conclusion other than [this one] would grant contributors like Merkin greater rights than joint authors, who . . . have no right to interfere with a co-author's use of the copyrighted work.” *Id.*

The *Casa Duse* opinion served to bolster the contention that the *Garcia 1* decision was wrongly decided and went against public policy concerning both copyright law and the freedom of speech itself. The relative swiftness of the *Casa Duse* opinion, practically on the heels of the *Garcia 2* opinion, also illustrates that the *Garcia 2* opinion was one that other Circuits had been paying close attention to. It appeared as though, in the wake of *Garcia 2*, that copyright on the internet had received a major and lasting victory. The legal community's relief after the *Garcia 2* decision may have been premature, however, as the another Ninth Circuit case is setting up to have important ramifications in the realm of copyright.

In 2007, a mother in Pennsylvania uploaded to YouTube a video of her baby dancing to the song “Let's Go Crazy” by Prince.¹³ Prince's publishers objected to the video being

¹³ Ben Sisario, *YouTube 'Dancing Baby' Copyright Ruling Sets Fair Use Guideline*, The New York Times (September 14, 2015).

hosted online and, in an act of defiance, the mother filed a lawsuit; the case has languished in limbo for eight years since. *Id.* In a decision that cleared the way for the case to finally go to trial, the Ninth Circuit held “that copyright holders must consider fair use before asking services like YouTube to remove videos that include material they control.” *Id.* This ruling has enormous implications for copyright on the internet, specifically on YouTube considering the site’s ContentID system, but also for any site that can be affected by a DMCA takedown notice. *Id.* As with *Garcia*, the case appears to be dividing supporters one more, with,

The Motion Picture Association of America and the R.I.A.A. both [supporting] Universal, which argued that fair use should be considered an “affirmative defense” only when part of an infringement suit. On the other side of the issue, Google, Twitter and Tumblr rallied behind Ms. Lenz [and her fair use/burden-shifting argument.]

Id. By placing such an emphasis on justifying DMCA takedowns against content that may constitute fair use, the Ninth Circuit has dealt a serious blow to the DMCA’s structure; only the outcome of the so-called “Dancing Baby Case” will hold the answer to how serious the blow actually is.

V. Conclusion

The original *Garcia v. Google* opinion, and its subsequent rehearing, generated a good deal of controversy while also highlighting the just how overlooked the interplay between copyright law and freedom of speech truly is. Since the rise of video hosting websites such as YouTube, the protections afforded to copyright holders under the DMCA have been used more often as a sword than as a shield. The original holding in the *Garcia* case would have

<http://www.nytimes.com/2015/09/15/business/media/youtube-dancing-baby-copyright-ruling-sets-fair-use-guideline.html? r=1>.

only sharpened that blade by providing many more people than Congress ever intended with the ability to issue takedown notices to videos for which they contributed even the most minimal of creative content. Even though the *Garcia* rehearing corrected the original opinion's grave mistake, the fight for an acceptable balance between copyright law and free speech on the Internet has continued and will continue for years to come. Thankfully, it appears as though the courts with the most to say in these matters have started to see things in a way that provides hope for the conflict going forward.