

Hold on Five Seconds: The Ninth Circuit Rethinks the Boundaries of Copyright Protection in *Garcia v. Google, Inc.*

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I. OVERVIEW

Cindy Lee Garcia agreed to perform in a film called *Desert Warrior* in July of 2011.¹ Garcia’s small role required her to speak two sentences: “Is George crazy? Our daughter is but a child?”² Contrary to Garcia’s expectations of what the film was to become, Mark Basseley Youssef, the film’s writer and director, produced an anti-Islamic creation called *Innocence of Muslims*.³ Youssef “dubbed over Garcia’s lines,” replacing them with “Is your Mohammed a child molester?”⁴ In June 2012, Youssef published a trailer for *Innocence of Muslims* to YouTube, the popular video-sharing website owned by Google.⁵ Upon its translation into Arabic, the film sparked protests across the Middle East, allegedly contributed to the September 11, 2012 attack on the United States Consulate in Benghazi, Libya, and incited an Egyptian cleric to issue a fatwa against anyone associated with the film.⁶ As a result of her role in the film, Garcia received multiple death threats.⁷

Garcia filed her first suit against Google, Youssef, and some of the film’s production assistants in Los Angeles Superior Court on September 19, 2012.⁸ Her claim alleged the defendants committed various torts, and the court failed to grant Garcia’s motion for a temporary restraining order for lack of likelihood of success on the merits.⁹ Garcia dismissed her state claim on September 25, 2012 and filed suit in federal court the next day.¹⁰ In her federal case, Garcia alleged copyright infringement and

1. *Garcia v. Google, Inc.*, 786 F.3d 733, 737 (9th Cir. 2015).
2. *Id.*
3. *Id.* Garcia believed her role was part of an ancient Arabian-themed action film. *Id.*
4. *Id.*
5. *Id.*
6. *Id.* at 738.
7. *Id.*
8. *Id.*
9. *Id.*
10. *Id.*

named Google and Youssef as codefendants.¹¹ Garcia also revived her tort claims against Youssef in state court.¹² In the federal district court, Garcia sought a preliminary injunction on the copyright claim in order to prevent Google from publishing *Innocence of Muslims* on any of its websites.¹³ The district court denied Garcia's motion, asserting (1) that Garcia failed to show the relief requested would avert the harm alleged; (2) Garcia did not establish a likelihood of success on the merits for the copyright claim; and (3) even if Garcia did have a copyright on her performance, she granted the movie makers an implied license to use her performance in the film.¹⁴ On appeal, the United States Court of Appeals for the Ninth Circuit reversed the district court's ruling in a divided decision.¹⁵ The panel initially ordered Google to take down all copies of *Innocence of Muslims* from its websites, but the panel later amended the order to grant YouTube the right to upload versions of the film that did not include Garcia's role.¹⁶ However, on rehearing en banc, the Ninth Circuit held that Garcia was not likely to win on her copyright claim and that Garcia failed to show she would suffer irreparable harm in the absence of a preliminary injunction. *Garcia v. Google, Inc.*, 786 F.3d 733, 739, 747 (9th Cir. 2015).

II. BACKGROUND

Because preliminary injunctions are considered to be extraordinary remedies, they are "never awarded as of right."¹⁷ Courts are charged with the difficult task of "balanc[ing] the competing claims of injury and consider the effect of granting or withholding of the requested relief."¹⁸ Furthermore, because the effects of preliminary injunctions often reach beyond the parties to the dispute, "courts of equity should pay particular regard for the public consequences in employing the extraordinary remedy of injunction."¹⁹ Due to the severe restrictions imposed by preliminary injunctions, courts employ a four-factor test in determining whether to grant a plaintiff the injunction.²⁰ The plaintiff must show

11. *Id.*

12. *Id.*

13. *Id.*

14. *Id.*

15. *Id.*

16. *Id.* at 738-39.

17. *Winter v. Nat. Res. Def. Council, Inc.*, 555 U.S. 7, 24 (2008).

18. *Id.* (quoting *Amoco Prod. Co. v. Village of Gambell, Arkansas*, 480 U.S. 531, 542 (1987)).

19. *Id.* (quoting *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 312 (1982)).

20. *Id.* at 20.

(1) “that he is likely to succeed on the merits,” (2) “that he is likely to suffer irreparable harm in the absence of preliminary relief,” (3) “that the balance of equities tips in his favor,” and (4) “that an injunction is in the public interest.”²¹

If a plaintiff fails to show likely success on the merits, the court is not obligated to consider the remaining three factors.²² Thus, likelihood of success on the merits is the most important *Winter* factor.²³ In this case, likelihood of success on the merits hinges on the plaintiff’s copyright claim. It is important to note that the constitutional purpose of copyrighting is to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”²⁴ The purpose is to allow authors of works to disseminate their creations without fear of competitors swooping in and laying claim to their property.²⁵

Copyright protection extends to “original works of authorship fixed in any tangible medium of expression” and “[w]orks of authorship include . . . motion pictures and other audiovisual works.”²⁶ In order for a work to qualify for copyright protection, it must be “independently created by the author” and illustrate “some minimal degree of creativity.”²⁷ The “author” is the “party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.”²⁸ There are, however, provisions for “work for hire” agreements. If the work is for hire, “the employer or other person for whom the work was prepared is considered the author’ and owns the copyright, unless there is a written agreement to the contrary.”²⁹

With regard to the meaning of “work” in the context of joint authorship, the Ninth Circuit provides guidance in *Aalmuhammed v. Lee*.³⁰ There, the court held that the creative contributions of the plaintiff

21. *Id.*

22. *Garcia v. Google, Inc.*, 786 F.3d 733, 740 (9th Cir. 2015) (quoting *Ass’n des Eleveurs de Canards et d’Oies du Que. v. Harris*, 729 F.3d 937, 944 (9th Cir. 2013)).

23. *Id.* at 740 (citing *Aamer v. Obama*, 762 F.3d 1023, 1038 (D.C. Cir. 2014)).

24. *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1137 (9th Cir. 2006) (quoting U.S. CONST. art. I, § 8, cl. 8).

25. *Id.* at 1137.

26. 17 U.S.C. § 102 (2012). “A work is ‘fixed’ in a tangible medium 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.” *Id.* § 101.

27. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

28. *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989).

29. *Id.* (quoting 17 U.S.C. § 201(b) (1982)).

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

for portions of the movie *Malcolm X* were insufficient to establish that the plaintiff was a coauthor of the film.³¹ The court determined that although the plaintiff's contributions were of great creative value to the film, the fact that he never had any meaningful control over the film and that he never signed any manifestation of coauthorship illustrates that neither party intended for the plaintiff to be a coauthor.³²

While in *Aalmuhammed* the court was tasked with determining the plaintiff's authority to claim coauthorship of a film, *Effects Associates v. Cohen* addresses a party's rights to copyrighted material under a work made for hire scenario.³³ In *Effects Associates*, a film director hired the plaintiff (Effects) to create special effects footage to supplement the action sequences in his film.³⁴ The director was unhappy with Effects' work and refused to pay the company, all while continuing to use the footage that Effects created.³⁵ In general, "Absent an express transfer of ownership, a contributor who is not an employee retains ownership of his copyright."³⁶ However, the Ninth Circuit found that Effects performed the work for the director with the intent that the work would be incorporated into the film and distributed.³⁷ Thus, Effects granted the director an implied license to use the special effects footage in the film.³⁸

The second *Winter* factor, a showing that irreparable harm is likely to occur in the absence of relief, is quite nuanced when applied to copyright infringement. The longstanding Ninth Circuit rule that a finding of likelihood of success on the merits in a copyright infringement case raises the presumption of irreparable harm, is no longer in effect.³⁹ Therefore, in the context of copyright infringement cases, the requirement that the plaintiff show a likelihood of irreparable harm in the absence of an injunction must stand on its own.⁴⁰

It is important to note, as the court did in *Salinger v. Colting*, that there must be a causal connection between the underlying claim and the irreparable harm the moving party is seeking to prevent through the

31. *Id.* at 1233; *see also* *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 61 (1884) ("[The author is] the person who has superintended the arrangement, who has actually formed the picture by putting the persons in position, and [who has] arrang[ed] the place where the people are to be.").

32. *Aalmuhammed*, 202 F.3d at 1235.

33. *Effects Assocs. v. Cohen*, 908 F.2d 555 (9th Cir. 1990).

34. *Id.* at 556.

35. *Id.*

36. *Id.* at 558.

37. *Id.*

38. *Id.* at 559.

39. *Perfect 10, Inc. v. Google, Inc.*, 653 F.3d 976, 981 (9th Cir. 2011).

40. *Id.*

injunction.⁴¹ In *Salinger*, the court determined that a knock-off sequel to *The Catcher in the Rye* infringed upon author J.D. Salinger's copyright of the work, and the absence of an injunction would cause irreparable harm to his estate.⁴² "The relevant harm is the harm that . . . occurs to the parties' legal interests," namely, Salinger's estate's interest in his copyrighted material.⁴³ Here, there is a causal connection between the underlying claim, copyright infringement, and the irreparable harm suffered. If the court did not grant the injunction to Salinger's estate, the harm suffered could be "characterized as irreparable in light of possible market confusion."⁴⁴

In contrast to *Salinger*, *Bollea v. Gawker Media, LLC* is a prime example of a plaintiff failing to show a causal connection between the underlying claim and the irreparable harm to be prevented. In *Bollea* the plaintiff, Terry Bollea (a.k.a. Hulk Hogan), sued Gawker Media to enjoin it from publishing a sex tape in which he appears.⁴⁵ Bollea's claim is predicated on copyright infringement.⁴⁶ Although the court determined Bollea's prospects for success on the copyright claim were very low, they addressed his allegation of irreparable harm nonetheless.⁴⁷ The court determined that Bollea's evidence as it related to harm was harm suffered by Bollea on a personal level, not in the context of copyright infringement.⁴⁸ Copyright law is not intended to "coddle artistic vanity or to protect secrecy."⁴⁹ Rather, it is to protect the author's commercial interest in the material so that it may be disseminated freely.⁵⁰ While in the absence of a preliminary injunction Bollea would undoubtedly be viewed in an embarrassing and poor light, he "cannot legitimately claim that he is concerned with protecting the financial worth of the Video."⁵¹

Similar to *Bollea*, in *Perfect 10, Inc. v. Google, Inc.*, the Ninth Circuit determined there was no causal connection between the harm incurred by Perfect 10 and Google's operation of its search engine.⁵² In that case, Perfect 10 alleged that Google committed copyright

41. *Salinger v. Colting*, 607 F.3d 68, 81 (2d Cir. 2010).

42. *Id.* at 70-71, 83.

43. *Id.* at 81.

44. *Id.* (citation omitted).

45. *Bollea v. Gawker Media, LLC*, 913 F. Supp. 2d 1325, 1326-27 (M.D. Fla. 2012).

46. *Id.*

47. *Id.* at 1329.

48. *Id.*

49. *Id.* (quoting *New Era Publ'ns Int'l, ApS v. Henry Holt & Co.*, 695 F. Supp. 1493, 1526 (S.D.N.Y. 1988)).

50. *Id.* at 1329-30.

51. *Id.* at 1330.

52. *Perfect 10, Inc. v. Google*, 653 F.3d 976, 981-82 (9th Cir. 2011).

infringement on its photographs by making the photos viewable through Google's search engine.⁵³ The court determined that Perfect 10 would not suffer irreparable harm in the absence of an injunction for several reasons.⁵⁴ First, Perfect 10's dire financial situation was not directly attributable to Google's infringement.⁵⁵ There was no evidence that Perfect 10 had ever been in "sound financial shape."⁵⁶ Additionally, Perfect 10's images were also available through other search engines.⁵⁷ Therefore, the court concluded that there was no causal connection between Perfect 10's decline in revenues and Google's use of its images.⁵⁸

III. COURT'S DECISION

In the noted case, the Ninth Circuit followed the groundwork laid out in *Winter*, *Aalmuhammed*, and *Effects Associates* to analyze a motion for preliminary injunction in the context of copyright infringement.⁵⁹ The court first determined the appropriate standard of review for the case was to review for abuse of discretion.⁶⁰ Because the court's review was deferential, they would not reverse the district court's decision unless the court "clearly err[ed] in its factual determinations."⁶¹ Next, the court determined that Garcia's burden was higher than that of an ordinary *Winter* test because Garcia was seeking a mandatory injunction.⁶² As such, Garcia must have shown that the "law and facts *clearly favor[ed]* her position, not simply that she [was] likely to succeed."⁶³ Garcia requested a mandatory injunction because it would require Google to take action to remove, and keep removing, *Innocence of Muslims* from YouTube and other Google run video hosting sites.⁶⁴

With regard to the copyright claim, the court first established through statutory definitions that *Innocence of Muslims* was "an audiovisual work that is categorized as a motion picture and is derivative of the script."⁶⁵ In determining whether Garcia's five second performance was copyrightable, the court defers to the Copyright

53. *Id.* at 978.

54. *Id.* at 980.

55. *Id.* at 981-82.

56. *Id.* at 981.

57. *Id.* at 982.

58. *Id.*

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

60. *Id.* at 739.

61. *Id.*

62. *Id.* at 740.

63. *Id.*

64. *Id.*

65. *Id.* at 741.

Office.⁶⁶ In response to Garcia's copyright application, the Copyright Office stated 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."⁶⁷ The Copyright Office then went on to say that because Garcia's contribution to the film was "limited to her acting performance," the office could not grant her a copyright separate from the film.⁶⁸

Aside from the Copyright Office's opinion on Garcia's ability to copyright her performance, the court examined *Aalmuhammed*. The court noted that, unlike the plaintiff in *Aalmuhammed*, Garcia repudiated any notion of joint authorship in the film.⁶⁹ Additionally, the court showed concern for the possibility that treating every acting performance as its own independent copyrightable work would undermine the entire purpose of copyrighting material, which is to provide authors commercial safeguards so that their works may be disseminated freely.⁷⁰ For example, the court argued that if Garcia succeeded in her copyright claim, large-scale movies in the future that cast thousands of extras would be forced to contend with thousands of copyright claims from actors alleging infringement of their minute contributions to the film.⁷¹

The court distinguishes the case at hand from *Effects Associates*. Unlike *Effects*, Garcia did not have a copyright on her performance.⁷² While *Effects* sought to enjoin Cohen from using its copyrighted material in his film, the court determined that *Effects* issued Cohen an implied license for the material because they gave Cohen the footage with the intent that it be incorporated into the film and distributed.⁷³

The court also noted that Garcia's copyright claim failed to satisfy 17 U.S.C. § 101, requiring the artist to fix their performance "in a tangible medium of expression."⁷⁴ Youssef, not Garcia, fixed Garcia's performance in the film.⁷⁵ Additionally, Garcia argued she never approved of her portrayal in the film.⁷⁶ Therefore, the court made the determination that she could not argue her role was "fixed 'by or under

66. *Id.*

67. *Id.* (internal quotation marks omitted).

68. *Id.*

69. *Id.* at 742.

70. *Id.* at 742-43.

71. *Id.* at 743.

72. *Id.*

73. *Effects Assocs. v. Cohen*, 908 F.2d 555, 558-59 (9th Cir. 1990).

74. *Garcia*, 786 F.3d at 743-44.

75. *Id.* at 744.

76. *Id.*

[her] authority” as required by 17 U.S.C. § 101.⁷⁷ In sum, the court found that because the Copyright Office denied her application and she did not fix her performance in a tangible medium, Garcia’s role in *Innocence of Muslims* was not separately copyrightable from the film.

Even though the court affirmed based solely on the copyright issue, the court addressed the irreparable harm issue because the “grave danger Garcia claim[ed could not] be discounted.”⁷⁸ Because Garcia’s motion for a preliminary injunction stemmed from copyright law, her irreparable harm to be prevented must also have stemmed from copyright law.⁷⁹ Garcia’s harm, the court determined, failed this test.⁸⁰ Garcia claimed her injuries were “damage to her reputation, unfair[,] forced promotion of a hateful Film, and death.”⁸¹ The court noted the severity of Garcia’s claims, but likened them to the protection of privacy, not copyright infringement.⁸² The court drew similarities between Garcia’s claims and those in *Bollea*.⁸³ Like Bollea, Garcia may look to privacy laws to remedy her situation. The harm suffered by both Bollea and Garcia was personal and had no weight in the context of copyright infringement.⁸⁴

For good measure, the court pointed out that Garcia delayed several months in filing for an injunction.⁸⁵ The court affirmed the district court’s reasoning that Garcia’s prolonged period of waiting to file a motion for a preliminary injunction undermined her claim of irreparable harm.⁸⁶

Judge Watford concurred in the opinion solely on the grounds that the court was obligated to follow the Ninth Circuit’s prior holding in *Perfect 10* that the harm alleged be causally connected to the underlying claim.⁸⁷

Judge Kozinski, on the other hand, dissented and stated that Garcia’s performance was copyrightable and that Garcia made an ample showing of irreparable harm.⁸⁸ Kozinski first argued that Garcia’s performance met the “minimal degree of creativity” established in *Feist Publishing*.⁸⁹

77. *Id.*

78. *Id.* (quoting 17 U.S.C. § 101 (2012)).

79. *Id.*

80. *Id.* at 746.

81. *Id.* at 745 (alteration in original).

82. *Id.*

83. *Id.*

84. *Id.*

85. *Id.* at 746.

86. *Id.*

87. *Id.* at 749.

88. *Id.* at 753.

89. *Id.* at 749.

Kozinski offered a public policy argument that if Garcia's performance is not considered copyrighted until it is fixed in the final version of *Innocence of Muslims*, book chapters and other movie scenes are also vulnerable to theft and public display until the final version of the work is complete.⁹⁰

IV. ANALYSIS

The majority opinion in this case appears to be consistent with the jurisprudence on record. Specifically, in their assessment of Garcia's likelihood of success on the merits of her copyright claim, the majority correctly gave deference to the Copyright Office and skillfully applied *Aalmuhammed* and *Effects Associates*. The court's policy of giving considerable deference to the Copyright Office in cases of copyright infringement seems fairly intuitive. It allows the court an opportunity to punt on a case where they may not be very well equipped to provide an educated ruling. Conversely, this policy affords the Copyright Office the opportunity to provide further input on one of their prior responses to an application and to clarify any confusion that may have resulted from one of its determinations. This policy seems to be a win for both the courts and the Copyright Office. Additionally, the court's application of *Aalmuhammed* was correct. Garcia did not seek to become a joint author in the film.⁹¹ In contrast, Garcia's entire claim revolved around distancing herself as much as possible from *Innocence of Muslims*, but she still wished to gain authorship of the role she played. As the court pointed out, division of a film into many separate "works" will expose films with large casts to countless copyright vulnerabilities.⁹² The smallest performance with a "minimal level of creativity" would be sufficient to warrant copyright protection.⁹³ Furthering their argument based on *Aalmuhammed*, the majority was correct in distinguishing Garcia's case from *Effects Associates*. While *Effects Associates* hinged on the fact that Effects had a copyright on their special effects footage and granted an implied license to Cohen to use the footage, Garcia has no copyright.⁹⁴ Therefore, Youssef does not need a license from Garcia to use her performance in his film. As such, the majority's determination on the issue of Garcia's copyright claim was sound in logic and left no

90. *Id.* at 750.

91. *Id.* at 742.

92. *Id.* at 742-43.

93. *Id.* at 742.

94. *Id.* at 741; 908 F.2d 555, 558-59 (9th Cir. 1990).

foreseeable vulnerabilities to future copyright claims to be partitioned from an existing work.

The majority's sound legal reasoning extends to its analysis of Garcia's claim of irreparable harm, particularly through its skillful application of the *Perfect 10* and *Bollea* cases. The majority correctly pointed out that there must be some causal connection between the underlying claim and the harm alleged.⁹⁵ Like *Bollea*, Garcia's underlying claim was for copyright infringement.⁹⁶ Therefore, Garcia's alleged harm must be a derivative of her copyright being infringed upon (i.e., her commercial interests are harmed). However, again like *Bollea*, Garcia's alleged harm was personal.⁹⁷ Her "emotional distress, the destruction of her career and reputation," and death threats had nothing to do with Garcia's commercial interests in her role in *Innocence of Muslims*.⁹⁸ Even if Garcia's claim of harm was related in some way to her underlying claim, the fact that she waited to file for an injunction until the film was translated into Arabic still mitigates the perception that actual harm would come to Garcia. However, given the facts of the case, Garcia may still have an opportunity to obtain an injunction based on an underlying tort claim. For example, Garcia may have an excellent right to privacy case as established in *Midler v. Ford Motor Co.*⁹⁹ There, the court determined that a person's likeness is not protected by federal copyright law if the use of their likeness "serves no such function but merely exploits the individual portrayed."¹⁰⁰ Garcia can argue that her performance in *Innocence of Muslims* exploited her right to privacy, but, again, she will have a difficult time arguing that her performance was protected by copyright. Therefore, the majority's legal reasoning is sound in determining whether Garcia's harm had a causal connection to the underlying copyright claim.

Garrett Fultz*

95. *Garcia*, 786 F.3d at 748; *Perfect 10, Inc. v. Google, Inc.*, 653 F.3d 976, 982 (9th Cir. 2011).

96. *Bollea v. Gawker Media, LLC*, 913 F. Supp. 2d 1325, 1329 (M.D. Fla. 2012).

97. *See id.* at 1330.

98. *Garcia*, 786 F.3d at 745.

99. 849 F.2d 460 (9th Cir. 1988) (establishing that imitation can be copyright infringement when a person's attribute that is being limited is unique).

100. *Id.* at 462 (quoting Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1596 (1979)).

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