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# Fixated on *Garcia*

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Two Federal courts, one in California and the other in New York, recently decided cases involving the question of whether, in the absence of a contract or work-for-hire agreement, a contributor to a film may receive a separate copyright interest in his or her respective contribution, such that he or she might enjoin the exploitation of the film. The two courts yielded drastically different results: In *16 Casa Duse, LLC v. Merkin*<sup>1</sup> (*Merkin*), the court held that a director's contributions received no copyright protection, while in *Garcia v. Google, Inc.*<sup>2</sup> (*Garcia*), an extra's five second appearance was held to be worthy of such protection.

In this article, we argue that the New York district court decision was correct, but that the Ninth Circuit's decision was incorrect possibly because the appellate court avoided addressing the issue of "fixation." This appellate decision from a court sitting in California may have a disastrous impact on the motion picture industry. We also address the Ninth Circuit's apparent intention to enjoin the release of an offensive motion picture, by creating bad law.

## Shared Facts

In both *Merkin* and *Garcia*, the owner of a screenplay hired cast and crew with the intent to produce a motion picture based on the screenplay, or a derivative work. In both cases, every member of the cast and crew signed a work-for-hire agreement, with two exceptions: Neither the director in *Merkin*, nor the extra in *Garcia* signed one. Both individuals claimed a right to enjoin the use of the film, claiming an exclusive copyright interest in their respective contributions.

## I. Motion Pictures as Joint Works

First, the courts disagreed about the impact of considering a motion picture as a "joint work," which the Copyright Act defines as "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole."<sup>3</sup> Both courts agreed that a motion picture may be a joint work, with multiple authors. Yet in *Merkin*, the court held that the only time this will arise in motion pictures is in the case of joint *authorship*, where each author retains 100% interest in the motion picture work.<sup>4</sup> In *Garcia* on the other hand, the court held that a motion picture may be a joint work consisting of multiple authors even where there is no joint authorship.<sup>5</sup>

### a) *Merkin's* Analysis

Recognizing that a motion picture "work may have more than one author," the *Merkin* court held that whether the director's contribution rose to the level of "joint authorship" was the only question at hand. The answer to that

question would determine whether he had *any* exclusive interest in the motion picture.<sup>6</sup> *Merkin* employed the Second Circuit's two-prong test addressing joint authorship, stating that the director must prove that first, he and the producer made independently copyrightable contributions to the work; and second, that both authors fully intended to be co-authors.<sup>7</sup> *Merkin* held that while the director made an independently copyrightable contribution to the motion picture, having "identified specific camera angles, lighting schemes and focal points," there was nevertheless no evidence on the record to establish that the parties *intended* to be joint authors. Without intent, and thus without joint authorship, *Merkin* held that whoever was the "dominant" author was the sole author in the motion picture work.<sup>8</sup> While multiple authors may exist in a motion picture, ownership over *any* part of the motion picture in the absence of joint authorship, resides only in one author, the dominant author.

### b) *Garcia's* Analysis

The *Garcia* court employed the Ninth Circuit's comparable "intent" test, and quickly held that the actor did not, in fact, qualify as a joint author, since she did not intend to be a joint author nor for her contributions to be part of a joint work.<sup>9</sup> Nevertheless, and contrary to *Merkin's* above conclusion, the court held that "just because *Garcia* isn't a joint author of "Innocence of Muslims" doesn't mean she doesn't have a copyright interest in her own performance within the film."<sup>10</sup>

*Garcia's* assertion that a motion picture is thus always a joint work where multiple authors are involved led the court to inquire as to instances where an author, whose contribution does not rise to the level of joint *authorship*, may still claim a copyright interest in his or her respective contribution.

## II. "...An Independent Copyright Interest"

*Garcia* used the language of 17 U.S.C. § 102(c)—that copyright protection "subsists in original works of authorship fixed in any tangible medium..."—to bolster the assertion that "nothing in the Copyright Act suggests that a copyright interest in a creative contribution to a work simply disappears because the contributor doesn't qualify as a joint author of the entire work."<sup>11</sup> The director in *Merkin* also claimed that absent joint authorship, he still had a separate copyright interest in his contributions, and as such, both courts addressed the elements of copyrightability discussed below. The *Garcia* court, though, overlooked the important element of fixation to support the actor's copyright. On the other hand, the *Merkin* court correctly addressed the issue of fixation. *Garcia's* error, we argue, leads to much uncertainty for the motion picture industry.

### a) Originality

First, the *Garcia* court discussed how an actor's performance is copyrightable if it evinces "some minimal degree of creativity," which is true whether the actor "speaks" or is "dubbed over."<sup>12</sup> While the producer in *Garcia* wrote the dialogue the actor spoke, managed all aspects of the production, and later dubbed over a portion of her scene, the court nonetheless found that the actor's performance satisfied that minimum threshold of creativity.<sup>13</sup>

In *Merkin*, the court found the director's contributions to be sufficiently creative but held that he had no copyright interest because of a defect in the other elements.<sup>14</sup>

### b) Work of Authorship

After finding sufficient originality in the actor's performance, the *Garcia* court then pointed to examples of authorship in individual copyrightable contributions that nevertheless did not rise to the level of *joint* authorship. For example, an author of a single poem in an anthology remains an author in that poem, but not a joint author in the anthology.<sup>15</sup> Yet, as the dissent pointed out, the actor conceded that she had no creative control over the script or her performance and thus was not an *author* of anything sufficiently creative since an "author is the [wo]man who really represents, creates, or gives effect to the idea, fancy, or imagination."<sup>16</sup>

In *Merkin*, the court, too, did not object to a finding of a work of authorship in the director's creative contributions. In fact, *Merkin's* discussion of how work-for-hire (WFH) agreements assign authorship provided useful guidance in revealing that an actor's contributions may rise to the level of an original "work of authorship," such that a separate copyright interest in the performance of a screenplay *may* exist.<sup>17</sup>

A "work made for hire" is, *inter alia*, "a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audio-visual work...if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire."<sup>18</sup> By its definition, an author's contribution in a WFH may indeed be a "work." What the WFH agreement does is memorialize the fact that the "employer for hire" is aggregating the works of authorship of the "employees for hire" as a contribution to the "employer's" work, which the "employer for hire" will own entirely. As *Merkin* notes, the WFH provisions in 17 U.S.C. § 201 are "an exception to the rule that copyrights belong in the first instance only to creators," or authors. In WFH situations, "the creator never has a copyright; what the creator has is a claim of authorship, and the WFH agreement assigns that claim to a third party."<sup>19</sup>

It seems then that both *Merkin* and *Garcia* agree that in the absence of a WFH agreement, and in the absence of a joint authorship in a work (lack of identical intent), there may exist a separate original work of authorship by a contributor to a motion picture.

The reason *Merkin* nevertheless finds no copyright interest in the director's work of authorship and the heart of why *Garcia's* analysis was incomplete rests in the last element: fixation.

### c) Fixation

The *Garcia* court satisfied the requirement of "fixation" by merely recognizing the fact that the actor's performance was ultimately fixed, and quietly sidestepped the question of whether "who does the fixing" matters.<sup>20</sup>

On the other hand, in responding to the director's claim of a separate copyright in his directing services, the *Merkin* court places emphasis on the director's fundamental misunderstanding of § 102(c)'s "fixation" element.<sup>21</sup> While *Merkin* found the director's contributions to be a sufficiently creative work of authorship, it is the expression of those contributions "fixed in a tangible medium" that receives copyright protection, and the tangible medium of the director's expression was the film itself, and only that film received copyright protection.<sup>22</sup> "[T]here is no separate copyright for the film's direction, production, or cinematography."<sup>23</sup>

## III. Conclusion

### a) Copyright

If there is no WFH agreement, or there is no joint authorship, then the question of whether an individual's creative contribution in a motion picture rises to the level of an original work of authorship, creating a separate copyright interest, may be determined by who owns, controls, and does the fixation. Where the producer of a motion picture controls the fixation of a contributor's original work of authorship, that contributor's work will *not* rise to the level of copyright protection. If the contributor does the fixing, he or she *may* have a copyright claim. In the alternative, an author whose ideas are never fixed may still be an author, but only where there is intent to be joint authors and each author's contributions are sufficiently intertwined and interdependent in the whole work, once completed. As such, only in those situations of joint authorship or where the contributor controls the fixation of his or her original work of authorship will a joint work in a motion picture arise.

As the *Merkin* court recognized that the producer owned, controlled, and created the fixation of a motion picture as a derivative work of his screenplay, the only relevant question was answered in Part I, above: A contributor's work is never separable *when the producer does the fixing*. As such, ownership of any part of a motion picture work that the producer fixes in a tangible medium of expression is either solely or jointly owned.

Since *Garcia* sidestepped the issue of whether fixation mattered, the court was free to hold that the actor, in the absence of being a joint author, may, in fact, have a separable copyrightable interest by satisfying the basic elements of copyright creation. Yet even under *Garcia's* detached analysis of whether an actor had a separate copyright

interest from the motion picture, neither the actor nor the director should retain a copyright interest in that which he or she did not fix. The *Garcia* court dismisses the purpose of WFH agreements in motion pictures—that they aggregate works of authorship that a producer fixes—and instead holds that since there was no employee status, it is permissible to proceed with a straightforward copyright analysis and gloss over the fixation element.

## b) Public Policy

The *Garcia* decision may have been seeking a way to enjoin distribution of what it felt was an offensive motion picture. According to *Wikipedia*, as of April 29, 2014:

*Innocence of Muslims* is the title attributed to a controversial anti-Islamic movie “trailer” that was written and produced by Nakoula Basseley Nakoula. Two versions of the 14-minute video were initially uploaded to YouTube in July 2012, under the titles *The Real Life of Muhammad* and *Muhammad Movie Trailer*. Videos dubbed in the Arabic language were uploaded during early September 2012. Anti-Islamic content had been added in post production by dubbing, without the actors’ knowledge.

What was perceived as denigrating of the prophet Muhammad caused demonstrations and violent protests against the video to break out on September 11 in Egypt and spread to other Arab and Muslim nations and to some western countries. The protests have led to hundreds of injuries and over 50 deaths. Fatwas have been issued against the video’s participants and a Pakistani minister has offered a bounty for the killing of the producer Nakoula. The film has sparked debates about freedom of speech and Internet censorship.<sup>24</sup>

We want to think that the Ninth Circuit was fashioning a remedy to achieve a result, in particular the removal of this video from YouTube, which was what the appellate court ordered on February 26, 2014. While we agree with the result, the means to that end might have been more direct. In particular, Ms. Garcia was told she would be appearing in a film entitled “Desert Warrior,” which was described to her as a “historical desert adventure film” with no indication that anti-Islamic material would be added in post production. Surely, the district court and the appellate court could fashion the same remedy around breach of contract or fraud in the formation of Garcia’s contract, rendering her consent void, and equitable remedies available. Relying on a myopic view of copyright law, as the Ninth Circuit did here, will lead to disastrous results in the motion picture, television, web and other audio-visual industries.

## Endnotes

1. *16 Casa Duse, LLC v. Merkin*, 2013 WL 5510770 (S.D.N.Y., 2013).
2. *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014).
3. 17 U.S.C. § 101.
4. *Merkin* at 8.
5. *Garcia* at 1263 (relying on *Nimmer on Copyright* § 6.05).
6. *Merkin* at 8.
7. *Merkin* at 8 (citing *Thomson v. Larson*, 147 F.3d 195, 200 (2d Cir. 1998)).
8. *Id.* at 9.
9. *Garcia* at 1263 (citing *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231–36 (9th Cir. 2000)).
10. *Id.*
11. *Garcia* at 1263.
12. *Id.*
13. See *Garcia* at 1275 (dissent).
14. *Merkin* at 9.
15. *Garcia* at 1264.
16. *Garcia* at 1274 (citing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (U.S. 1884)).
17. *Merkin* at 11.
18. 17 U.S.C. § 101 (emphasis added).
19. *Merkin* at 11.
20. *Garcia* at 1263, FN 4 (“Neither party raised the issue of whether the author of a dramatic performance must personally fix his work in a tangible medium. Because the question is not properly before us, we do not decide it. The parties are free to raise it in the district court on remand.”). We suggest that if the issue of copyrightability was before the *Garcia* court, the panel had authority to address all the elements of copyrightability, including fixation, and its refusal to address the issue was error.
21. *Merkin* at 10.
22. *Id.* (emphasis added).
23. *Id.*
24. [http://en.wikipedia.org/wiki/Innocence\\_of\\_Muslims](http://en.wikipedia.org/wiki/Innocence_of_Muslims).

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