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## Article

### Actors as Authors in American Copyright Law

JUSTIN HUGHES

*Among the many kinds of works eligible for copyright protection, audiovisual works are arguably the most complex, involving screenwriters, directors, actors, cinematographers, producers, set designers, costume designers, lighting technicians, etc. Some countries expressly recognize which categories of these contributors are entitled to legal protection, but American copyright law does not. Because the complex relationships among these creative professionals are usually governed by contract, there is relatively little case law on issues of authorship in audiovisual works. This is especially true on the question of dramatic performers as authors of audiovisual works.*

*This Article provides the first in-depth exploration of whether, when, and how actors are authors under American copyright law. After describing how case law, government views, and scholarly commentary support the conclusion that actors are authors, the Article analyzes the strange—and strangely inconclusive—2015 Garcia v. Google litigation. The Article then uses some simple thought experiments to establish how dramatic performers generally meet both the Constitutional and statutory standard for “authorship.” Finally, the Article reviews the various filters that prevent actors-as-authors legal struggles and how, when all else fails, we can consider actors as joint authors of the audiovisual works embodying their dramatic performances.*

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# Actors as Authors in American Copyright Law

JUSTIN HUGHES \*

## INTRODUCTION

There are many familiar, deep-seated disagreements in intellectual property law—for example, varied points of view on exhaustion of rights, the scope of patentable subject matter in the United States, or whether the right of distribution in American copyright law encompasses “making available.”<sup>1</sup> But occasionally, there are places in the intellectual property landscape that hold unexpected—and unexplored—uncertainty. The protection of dramatic performances under American copyright law seems to be one of those areas. What one commentator noted in 2001 remains true today: “There is little case law or statutory authority as to the position of performers as authors of an audiovisual work under U.S. law.”<sup>2</sup> The question is simple: under American copyright law can an *actor* be an *author* of the audiovisual works in which he or she performs?

Reviewing the few points of law and commentary on the question and placing American copyright in the larger framework of international intellectual property norms, this Article reasons that actors must be “authors” under American copyright law—any other conclusion would be counter to basic principles of American copyright law.

Part I of this Article reviews the framework of international legal norms in which American copyright law exists, setting out how actors may be “authors” as international copyright law understands that concept. Part II then takes up the glimmers of law and commentary that address whether and how dramatic performances attract copyright protection under American copyright law. This evidence has been limited, but has consistently pointed toward the conclusion that actors can be authors under American copyright law. Part II also explores what happened on the actors-as-authors question

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<sup>1</sup> U.S. COPYRIGHT OFF., *THE MAKING AVAILABLE RIGHT IN THE UNITED STATES I* (2016).

<sup>2</sup> 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, 300 (2001).

in the 2015 *Garcia v. Google* decision, a litigation tale more of fraud and fatwas than clear conclusions on copyright law. With *Garcia v. Google* properly understood, Part III returns to the basic question and explores whether and how dramatic performances attract copyright protection through hypotheticals and views of the acting community. After a brief review of the legal and customary filters that keep parties from litigating the actor-as-author question, Part IV offers a discussion of joint authorship doctrine as it should apply to actors in audiovisual works.

## I. THE INTERNATIONAL CONTEXT FOR ANALYSIS OF AMERICAN COPYRIGHT LAW

American copyright law sits in the broader context of the international copyright system and the international legal norms in intellectual property to which the United States has agreed to be bound. Among the many international treaties in intellectual property, three pertain to the rights of dramatic performers in their performances.

### A. *The Open-Ended Framework of the Berne Convention*

The Berne Convention for the Protection of Literary and Artistic Works<sup>3</sup> has been the central pillar of the international copyright system since at least 1988, when the United States finally ratified the Convention and effectively ended competition between Berne and the Universal Copyright Convention administered by UNESCO.<sup>4</sup> Films were first included in Berne during the 1908 Berlin revision of the Convention, when it was agreed that cinematographic works were to be treated as “literary or artistic works when by the arrangement of the stage effects or by the combination of the incidents represented, the author shall have given to the work a personal and original character.”<sup>5</sup> The position of audiovisual works in the Berne Convention was strengthened in 1967 with the addition of Article 14*bis* which provides that:

(1) Without prejudice to the copyright in any work which may have been adapted or reproduced, a cinematographic work

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<sup>3</sup> Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as revised at Paris on July 24, 1971 and amended in 1979, S. TREATY DOC. No. 99-27 (1986), 1161 U.N.T.S. 30 [hereinafter Berne Convention].

<sup>4</sup> For background, see Leonard D. Duboff, et al., *Out of UNESCO and into Berne: Has United States Participation in the Berne Convention for International Copyright Protection Become Essential?*, 4 CARDOZO ARTS & ENT. L.J. 203, 213 (1985). See also Orrin G. Hatch, *Better Late than Never: Implementation of the 1886 Berne Convention*, 22 CORNELL INT'L L.J. 171, 176 (1989).

<sup>5</sup> Convention Creating an International Union for the Protection of Literary and Artistic Works, signed at Berlin, November 13, 1908, Art. 14, as reprinted in Library of Congress, Report of the Delegate of the United States to the International Convention for the Revision of the Berne Copyright Convention Held at Berlin, Germany, October 14 to November 14, 1908, Copyright Office Bulletin, No. 13 at 21 (1908) [hereinafter 1908 BERNE REVISION OF BERNE].

shall be protected as an original work. The owner of copyright in a cinematographic work shall enjoy the same rights as the author of an original work, including the rights referred to in the preceding Article.

(2)(a) Ownership of copyright in a cinematographic work shall be a matter for legislation in the country where protection is claimed.<sup>6</sup>

Article 14*bis* further provides a limited mechanism to consolidate the rights of different contributors to an audiovisual work by providing that “in the absence of any contrary or special stipulation” a contributor may not object to the reproduction, distribution, public performance, or other exploitation of the work.<sup>7</sup> Article 14*bis* exempts from this mandatory presumptive consolidation of economic rights the “principal director” as well as the “authors of scenarios, dialogues and musical works created for the making of the cinematographic work.”<sup>8</sup>

These elements suggest that the negotiators may have envisioned the film director as the principal author, i.e. the originality is recognized in the “*arrangement* of the stage effects” and “the combination of the incidents represented” (although the former phrase could be interpreted other ways).<sup>9</sup> By 1967 a film’s screenwriter and the composer of the soundtrack (the latter not existing in 1908) seemed to have been placed on par or potential par with the director. No mention is made of dramatic performers, meaning that if dramatic performers are authors of cinematographic works, they would be subject to the Article 14*bis*(2)(b) presumptive consolidation of economic rights.

Many jurisdictions also designate potential types of authors of audiovisual works. For example, France’s Intellectual Property Code presumes that authors of an audiovisual work include the director, the author of the script, the author of any adaptation, any separate author(s) of dialogue, and composers of musical compositions created especially for the film.<sup>10</sup>

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<sup>6</sup> Berne Convention, *supra* note 3, at art. 14*bis*.

<sup>7</sup> *Id.* at art. 14*bis*(2)(b) (“[I]n the countries of the [Berne] Union which, by legislation, include among the owners of copyright in a cinematographic work authors who have brought contributions to the making of the work, such authors, if they have undertaken to bring such contributions, may not, in the absence of any contrary or special stipulation, object to the reproduction, distribution, public performance, communication to the public by wire, broadcasting or any other communication to the public, or to the subtitling or dubbing of texts, of the work.”).

<sup>8</sup> *See id.* at art. 14*bis*(3) (noting that a Berne Convention country is still permitted to have a presumption of consolidation of economic rights from these types of authors).

<sup>9</sup> 1908 BERNE REVISION OF BERNE, *supra* note 5. The French original for “stage effects” is “mise en scène,” a far richer concept than carried by the English words.

<sup>10</sup> CODE DE LA PROPRIÉTÉ INTELLECTUELLE [C.I.P.] [INTELLECTUAL PROPERTY CODE] art. L113-7 (Fr.), available at <https://www.legifrance.gouv.fr/content/location/1742>.

German and Mexican law have similar provisions.<sup>11</sup> China's Copyright Law of 2010 stipulates that ownership of a cinematographic work belongs to the "the producer of the work" but then specifies that the authors of a cinematographic work are its "scriptwriter, director, cameraman, lyricist, composer, and other authors,"<sup>12</sup> presumably ensuring that those individuals enjoy the moral rights associated with the work under Chinese law.<sup>13</sup>

But the fact that neither the Berne Convention nor these other jurisdictions mention actors as authors has little bearing on the question for American copyright law. Indeed, the closest thing to an official commentary on Berne Article 14*bis* recognizes that actors may be among the authors of a cinematographic work. The 1978 World Intellectual Property Organization (WIPO) *Guide to the Berne Convention for the Protection and Literary and Artistic Works*<sup>14</sup> says that Article 14*bis* intends to draw a distinction between the "principal director" along with contributors to a cinematographic work "whose works (scenarios, scripts, music) can enjoy an existence other than in the film itself" versus all other contributors to whom the presumption applies.<sup>15</sup> The 1978 *WIPO Guide* describes those other contributors as "assistant producers and directors, those responsible for decor, costumiers, cameramen and cutters, and *also to the actors, to the extent that some countries treat them as co-authors of the film.*"<sup>16</sup>

The 1978 *WIPO Guide* is worded this way because most national laws protecting dramatic performers do so through separate "neighboring rights."<sup>17</sup> Simply put, these countries acknowledge the creative contribution

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<sup>11</sup> Gesetz über Urheberrecht und verwandte Schutzrechte [Urheberrechtsgesetz] [UrhG] [Copyright Act], Sept. 9, 1965, BGBl I at art. 65 (Ger.), [https://www.gesetze-im-internet.de/englisch\\_urhg/englisch\\_urhg.html#p0688](https://www.gesetze-im-internet.de/englisch_urhg/englisch_urhg.html#p0688) (providing that in the case of jointly authored works, "[c]opyright in cinematographic works and works produced in a manner similar to cinematographic works expires 70 years after the death of the last surviving of the following person: the principle film director, the author of the screenplay, the author of the dialogues, the composer of music specifically composed for use in the cinematographic work in question."); Ley Federal del Derecho de Autor [LDFA], art. 97, Diario Oficial de la Federación [DOF] 24-12-1996 (Mex.) [hereinafter LDFA], available at <http://www.wipo.int/edocs/lexdocs/laws/en/mx/mx003en.pdf>.

<sup>12</sup> Copyright Law of the People's Republic of China, (promulgated by Standing Committee of the National People's Congress on Amending Copyright Law, Sept. 7, 1990, effective June 1, 1991) [hereinafter 2010 Copyright Law of China], art. 15, available at <http://www.wipo.int/edocs/lexdocs/laws/en/cn/cn031en.pdf>.

<sup>13</sup> See *id.* at art. 10 (establishing rights of attribution and integrity); Seagull Haiyan Song, *China's Copyright Protection for Audio-Visual Works – Comparison with Europe and the U.S.*, 46 INT'L REV. INTELL. PROP. & COMPETITION L. 410, 410–13 (2015) (comparing the Chinese, European, and United States models of copyright protection for films).

<sup>14</sup> Claude Masouyé, GUIDE TO THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS (PARIS ACT, 1971), [WIPO] (1978), [http://www.wipo.int/edocs/pubdocs/en/copyright/615/wipo\\_pub\\_615.pdf](http://www.wipo.int/edocs/pubdocs/en/copyright/615/wipo_pub_615.pdf) [hereinafter Masouyé].

<sup>15</sup> Masouyé, *supra* note 14, ¶ 14*bis*14 at 89.

<sup>16</sup> *Id.* ¶ 14*bis*15 at 89 (emphasis added).

<sup>17</sup> *E.g.*, LDFA, *supra* note 11, at arts. 116–22; 2010 Copyright Law of China, *supra* note 12, at art.

of dramatic performers with a different form of intellectual property rights. In contrast, Canadian law provides a good example of a country that—per the *WIPO Guide*—expressly provides *copyright* to audiovisual performers for their performances. Section 2 of the Copyright Act of Canada defines a “performer’s performance” in a way that includes performance of a “dramatic work” and a “recitation or reading of a literary work”—even when the underlying works are out of copyright.<sup>18</sup> The Section 2 definition also includes “an improvisation of a dramatic work . . . whether or not the improvised work is based on a pre-existing work.”<sup>19</sup> Among the provisions extending copyright to “performer’s performances,” Section 15(2) restricts some rights stemming from audiovisual performances to those performances that “take place in Canada or in a Rome Convention country” while section 15(2.1) restricts other rights to performances that “take place in Canada.”<sup>20</sup> But these elaborate provisions—and the narrower scope of audiovisual performers’ copyright—reflect Canada’s current international obligation under the Rome Convention and not a basic questioning of the notion that actors’ dramatic performances may be protected under copyright.

#### B. *From the 1961 Rome Convention to the 2012 Beijing Treaty*

Separate from the Berne Convention, there are two multilateral treaties directly bearing on dramatic performers’ rights: the 1961 Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations<sup>21</sup> and the 2012 Beijing Treaty on Audiovisual Performances. Besides the Copyright Office’s *Compendium* (discussed below), perhaps the greatest foray into the question of actors’ copyright taken by executive and legislative branch officials has been the role of the United States in negotiating the latter of these two instruments.<sup>22</sup>

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<sup>18</sup> Copyright Act, R.S.C. 1985, c C-42 (Can.) last amended June 19, 2017.

<sup>19</sup> *Id.*

<sup>20</sup> *See id.* § 15 (providing that although musical performer’s performances in “sound recordings” receive wider protection, the Section 2 definition of sound recordings “excludes any soundtrack of a cinematographic work where it accompanies the cinematographic work”). The Association of Canadian Television and Radio Actors (ACTRA) takes the position that Canadian audiovisual performers are not adequately protected. *See Intellectual Property Rights for Performers*, ACTRA, <http://www.actra.ca/wp-content/uploads/Intellectual-Property-Protection-Background-1.pdf> (last visited Sept. 8, 2018) (“Currently, only Canadian audio performers are protected under the Copyright Act, leaving audiovisual performers’ moral and economic rights vulnerable to exploitation.”).

<sup>21</sup> International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, Oct. 26, 1961, 496 U.N.T.S. 43 [hereinafter Rome Convention].

<sup>22</sup> The author was a member of the U.S. delegation to the 2000 diplomatic conference discussed here and head of the U.S. delegation to the 2012 diplomatic conference discussed; he was also chairman of “Main Committee II” of the 2000 diplomatic conference. For confirming the discussion in these pages, my thanks to Jukka Liedes, Shira Perlmutter, and Robert L. Stoll. Jukka Liedes is a Finnish government official who served as Chairman of “Main Committee 1” of both the 1996 and 2000 diplomatic conferences. Email from Jukka Liedes to author (July 22, 2018) (on file with author). Shira Perlmutter

While the Berne Convention leaves open the possibility that actors might be joint authors of a film under a national copyright law, the 1961 Rome Convention was the first multilateral treaty to obligate contracting parties to provide dramatic performers with copyright-like rights.<sup>23</sup> Article 7 of the Rome Convention gives performers, including actors, rights to control fixation and broadcasting of their performances as well as certain reproductions of their fixed performances.<sup>24</sup> But the Rome Convention then provides—in an article specifically directed at “Performers’ Rights in Films”—that “once a performer has consented to the incorporation of his performance in a visual or audio-visual fixation, Article 7 shall have no further application.”<sup>25</sup> This provision, which has been transposed into many national laws, has been criticized for substantially weakening whatever protection the Rome Convention might have established. Although there are over ninety countries that are contracting parties of the Rome Convention, three of the most important audiovisual production countries—China, India, and the United States—are not.<sup>26</sup>

After the completion of the WTO agreements<sup>27</sup> in the early 1990s, negotiations started on extensive revision of the Berne and Rome Conventions to cover emerging digital and network issues. Some elements of this ambitious agenda<sup>28</sup> came to fruition in the WIPO Copyright Treaty

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also participated in all three of the diplomatic conferences described here: in 1996 as head of the U.S. Copyright Office’s Office of Policy and International Affairs; in 2000 as a representative of the International Federation of the Phonographic Industries (IFPI); and in 2012 as head of the USPTO’s Office of Policy and International Affairs. Email from Shira Perlmutter, Chief Policy Officer & Dir. for Int’l Affairs, U.S. Patent & Trademark Office, to author (July 10, 2018) (on file with author). Robert Stoll was head Office of Legislative and International Affairs, U.S. Patent & Trademark Office, at the time of the 2000 diplomatic conference. Email from Robert Stoll to author (Mar. 16, 2018) (on file with author).

<sup>23</sup> Rome Convention, *supra* note 21, at art. 7.

<sup>24</sup> *Id.* at art. 7.

<sup>25</sup> *Id.* at art. 19.

<sup>26</sup> See *WIPO-Administered Treaties*, WIPO [http://www.wipo.int/treaties/en/ShowResults.jsp?treaty\\_id=17](http://www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=17) (last visited Sept. 8, 2018) (noting that India was an original signatory of the convention, but never ratified it). Other countries that are not bound by the Rome Convention include Bangladesh, Botswana, Cambodia, Cuba, Egypt, Iran, Kenya, Morocco, Mali, Myanmar, Namibia, New Zealand, Pakistan, Senegal, Singapore, South Africa, and Thailand. *Id.*

<sup>27</sup> The WTO agreements include the TRIPS Agreement. See Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299 [hereinafter TRIPS Agreement], available at [https://www.wto.org/english/tratop\\_e/trips\\_e/ta\\_docs\\_e/anex1\\_e.pdf](https://www.wto.org/english/tratop_e/trips_e/ta_docs_e/anex1_e.pdf).

<sup>28</sup> By August 1996, the WIPO’s Committee on Experts presented “Basic Proposals” for three new substantive treaties:

1. ‘Treaty on Certain Questions Concerning the Protection of Literary and Artistic Works’,
2. ‘Treaty for the Protection of the Rights of Performers and Producers of Phonograms’,
3. ‘Treaty on Intellectual Property in Respect of Databases’.

(WCT) and the WIPO Phonograms and Performances Treaty (WPPT), both of which were finalized at a diplomatic conference in December 1996.<sup>29</sup> The WCT established new international legal norms for copyright concerning: (a) separate, exclusive rights of distribution and communication,<sup>30</sup> (b) obligations on the protection of “rights management information”;<sup>31</sup> and (c) obligations vis-à-vis “technological measures” that copyright owners may use in connection with the exclusive copyright rights.<sup>32</sup> The WPPT provides largely parallel developments for the rights of musical performers and phonogram producers, while also giving musical performers a right of fixation against unauthorized recordings.<sup>33</sup>

The 1996 Diplomatic Conference left two major agenda items unresolved: (a) the extra copyright protection of collections of information; and (b) the rights of audiovisual performers. The first of these, proposed by the European Union,<sup>34</sup> was left by the wayside in part because opposition

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Diplomatic Conference on Certain Copyright and Neighboring Rights Questions, *Basic Proposal for the Substantive Provisions of the Treaty for the Protection of the Rights of Performers and Producers of Phonograms to be Considered by the Diplomatic Conference*, ¶ 15, at 4, WIPO Doc. No. CRNR/DC/5 (Aug. 30, 1996), available at [http://www.wipo.int/edocs/mdocs/diplconf/en/cmr\\_dc/cmr\\_dc\\_5.pdf](http://www.wipo.int/edocs/mdocs/diplconf/en/cmr_dc/cmr_dc_5.pdf); see also Diplomatic Conference on Certain Copyright and Neighboring Rights Questions, *Basic Proposal for the Substantive Provisions of the Treaty on Certain Questions Concerning the Protection of Literary and Artistic Works to be Considered by the Diplomatic Conference*, ¶15, at 4, WIPO Doc. CRNR/DC/4 (Aug. 30, 1996), available at [www.wipo.int/edocs/mdocs/diplconf/en/cmr\\_dc/cmr\\_dc\\_4.pdf](http://www.wipo.int/edocs/mdocs/diplconf/en/cmr_dc/cmr_dc_4.pdf) (proposing the same three treaties).

<sup>29</sup> WIPO, WIPO Copyright Treaty (WCT), Dec. 20, 1996 [hereinafter WCT], available at [http://www.wipo.int/edocs/lexdocs/treaties/en/wct/trt\\_wct\\_001en.pdf](http://www.wipo.int/edocs/lexdocs/treaties/en/wct/trt_wct_001en.pdf); WIPO, WIPO Performances and Phonograms Treaty, Dec. 20, 1996 [hereinafter WPPT], available at [http://www.wipo.int/edocs/lexdocs/treaties/en/wppt/trt\\_wppt\\_001en.pdf](http://www.wipo.int/edocs/lexdocs/treaties/en/wppt/trt_wppt_001en.pdf). Both were adopted by the WIPO Diplomatic Conference on Certain Copyright and Neighboring Rights Questions in Geneva, on December 20, 1996.

<sup>30</sup> WCT, *supra* note 29, arts. 6, 8. Article 6 of the WCT is captioned “Right of Distribution” and establishes a general “exclusive right of authorizing the making available to the public of the original and copies” of works. *Id.* at art. 6. Article 8 of the WCT is captioned “Right of Communication to the Public” and establishes that authors shall enjoy an “exclusive right of authorizing any communication to the public of their works, by wire or wireless means, including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them.” *Id.* at art. 8. This last phrase is intended to describe generally Internet distribution and delivery, but the interconnection of the two Articles is clear in that Article 8 equates a “making available to the public” via wire or wireless means as a “communication to the public.” *Id.*; see also WPPT, *supra* note 29, at arts. 8, 10 (providing rights that parallel those in the WCT).

<sup>31</sup> WCT, *supra* note 29, at art. 12.

<sup>32</sup> *Id.* at art. 11.

<sup>33</sup> WPPT, *supra* note 29, at art. 6(ii).

<sup>34</sup> The European Union had promulgated a directive establishing sui generis protection of the investment in collections of information. Directive 96/9, of the European Parliament and of the Council of 11 March 1996 on the Legal Protection of Databases, 1996 O.J. (L 077) 20, ¶¶ 20–28.

from the scientific and library communities<sup>35</sup> made it impossible for the United States to move forward on the topic.<sup>36</sup>

In contrast, there was sustained interest in—if not agreement about—the protection of audiovisual performers.<sup>37</sup> The 1996 Diplomatic Conference had been unable to include audiovisual performers in the WPPT because the American motion picture industry was concerned about both moral rights for actors and guaranteeing international recognition of contractual agreements that transfer actors' economic rights to film producers.<sup>38</sup> But

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<sup>35</sup> For samples of the criticism of the Database Directive during that period, see J.H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51 (1997).

<sup>36</sup> But for several years after, Congress entertained proposals for domestic laws providing sui generis protection of non-creative databases under the Commerce Clause. See Justin Hughes, *How Extra-Copyright Protection of Databases Can be Constitutional*, 28 U. DAYTON L. REV. 159, 167–68 (2003) (describing American attempts to establish similar protections during the second half of the 1990s). Eventually that debate died out, partly because commercial business models based on distribution of databases have largely been replaced by commercial business models based on information retrieval services. When was the last time you saw a printed airline schedule booklet, used a newspaper's movie listings to determine what film you would see, or found a phone number with White Pages printed on paper?

<sup>37</sup> Seth Greenstein's daily reports from the 1996 Diplomatic Conference provide some insight. See, e.g., Seth Greenstein, *Day Four -- Officers Selected, Opening Statements*, WAYBACKMACHINE (Dec. 5, 1996), [http://web.archive.org/web/19970301065434/http://hrrc.org:80/wr\\_12-5.html](http://web.archive.org/web/19970301065434/http://hrrc.org:80/wr_12-5.html). (“[I]n the opening statement, [t]he representative from Ireland spoke generally on behalf of the European Union countries. He promoted a high level of protection also for audiovisual performers and producers . . . .”); Seth Greenstein, *Day Seven -- The AudioVisual Debate, and What's Fair is Fair Use*, WAYBACKMACHINE (Dec. 10, 1996), [http://web.archive.org/web/19970301065341/http://hrrc.org:80/wr\\_12-10.html](http://web.archive.org/web/19970301065341/http://hrrc.org:80/wr_12-10.html) (detailing how the US delegation was showing willingness to accept economic rights if transfers of rights were recognized); Seth Greenstein, *Day Nine -- Champagne and Broken Glass*, WAYBACKMACHINE (Dec. 12, 1996), [http://web.archive.org/web/19970301065319/http://hrrc.org:80/wr\\_12-12.html](http://web.archive.org/web/19970301065319/http://hrrc.org:80/wr_12-12.html) (“[T]he success of this treaty is threatened more by traditional disputes between the copyright and authors' right systems -- should performers in audiovisual works obtain the same rights as producers? Would the United States have to increase the limited scope of its performance right for sound recordings?”); Seth Greenstein, *Day Ten (and Eleven) -- Public Optimism, Private Meetings*, WAYBACKMACHINE (Dec. 13–14, 1996), [http://web.archive.org/web/19970301065301/http://hrrc.org:80/wr\\_12-13.html](http://web.archive.org/web/19970301065301/http://hrrc.org:80/wr_12-13.html) (“The EC and United States had dedicated a good part of the day, and discussions into the evening, to the resolution of the audiovisual dispute concerning performers' and producers' rights in audiovisual works.”); Seth Greenstein, *The Final Day -- Two Treaties for WIPO, and One More for the Road*, WAYBACKMACHINE (Dec. 20, 1996), [http://web.archive.org/web/19970301065207/http://hrrc.org:80/wr\\_12-20.html](http://web.archive.org/web/19970301065207/http://hrrc.org:80/wr_12-20.html) (writing that the 1996 diplomatic conference ended with adoption of “the recommendation and resolution regarding a new conference on audiovisual works and regarding future work on database protection”).

<sup>38</sup> As characterized by one commentator, “[a]lthough the U.S. and European delegations were allied on almost all other intellectual property issues at the diplomatic conference, they were bitterly divided on a proposal to universalize European norms about rights of performers of audiovisual works which the U.S. motion picture industry regarded as an anathema. After the Europeans finally agreed to put off to another day the debate over international rights for audiovisual performers, the [WPPT] could be finalized.” Pamela Samuelson, *The U.S. Digital Agenda at WIPO*, 37 VA. J. INT'L L. 369, 371–72 (1997) (footnotes omitted). Only a few years before, the film producers had a bitter legislative fight in Washington with film directors over moral rights. See David A. Honicky, *Film Labelling as a Cure for Colorization [and Other Alterations]: A Band-Aid for a Hatchet Job*, 12 CARDOZO ARTS & ENT. L.J. 409, 425, 427–28 (1994) (describing the fight between Congress and film producers over the 1992 proposed Film Disclosure Act).

even when the Diplomatic Conference reached an impasse on these issues, the United States did not take the position that American actors *lacked* rights under existing U.S. law.

Gaining international recognition of actors' rights was important to the unions representing American actors, the Screen Actors Guild and the American Federation of Television and Radio Actors. Because the audiovisual producers must engage in intermittent collective bargaining with these unions, the film studios decided to support the actors' position, as long as the "transfer of rights" issue could be addressed successfully and any moral rights provision would permit normal film editing and marketing practices. This allowed the United States to engage fully in the audiovisual performance discussions that continued after 1996 in WIPO's Standing Committee on Copyright and Related Rights.<sup>39</sup> Successive American administrations negotiated on the *assumption* that American copyright law provided the possibility that an actor could be an author of an audiovisual work, such that no additional rights would need to be added to the copyright system. This was similar to how the assumption that a musician could be an author of a sound recording under American law undergirded American willingness to negotiate and enter the WPPT.

The audiovisual negotiations intensified in the late 1990s<sup>40</sup> and seemed to bring WIPO closer to the finish line—close enough to convene another

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<sup>39</sup> This included making a complete treaty proposal in late 1999. See WIPO Standing Committee on Copyright and Related Rights, Third Session, *Agenda Item 4: Protection of Audiovisual Performances: Submission of the United States of America*, at 2, WIPO Doc. No. SCCR/3/7 (Nov. 3, 1999), [http://www.wipo.int/edocs/mdocs/copyright/en/sccr\\_3/sccr\\_3\\_7.pdf](http://www.wipo.int/edocs/mdocs/copyright/en/sccr_3/sccr_3_7.pdf) (announcing that the United States would subsequently support further advancement of audiovisual performers' rights).

<sup>40</sup> See, e.g., Standing Committee on Copyright and Related Rights, First Session, *Agenda Item 5: Protection of Audiovisual Performances: Submission Received from Member States of WIPO by September 30, 1998*, at 2, WIPO Doc. No. SCCR/1/4 (Oct. 1, 1998), available at [http://www.wipo.int/edocs/mdocs/copyright/en/sccr\\_1/sccr\\_1\\_4.pdf](http://www.wipo.int/edocs/mdocs/copyright/en/sccr_1/sccr_1_4.pdf) (documenting proposals from Japan and the United States, along with a report from Latin American countries); WIPO Standing Committee on Copyright and Related Rights, First Session, *Agenda Item 5: Protection of Audiovisual Performances: Submission of Canada*, at 2, WIPO Doc. No. SCCR/1/8 (Nov. 12, 1998), available at [http://www.wipo.int/edocs/mdocs/copyright/en/sccr\\_1/sccr\\_1\\_8.pdf](http://www.wipo.int/edocs/mdocs/copyright/en/sccr_1/sccr_1_8.pdf) (noting Canada's objections to legislation that would allow for a deemed or presumed transfer of rights); WIPO Standing Committee on Copyright and Related Rights, Second Session, *Agenda Item 4: Protection of Audiovisual Performances: Comparative Table of Proposals Received by February 28, 1999*, at 2, WIPO Doc. No. SCCR/2/4, available at [http://www.wipo.int/edocs/mdocs/copyright/en/sccr\\_2/sccr\\_2\\_4.pdf](http://www.wipo.int/edocs/mdocs/copyright/en/sccr_2/sccr_2_4.pdf) (detailing proposals by 15 African countries, Canada, the European Union, and Korea); WIPO Standing Committee on Copyright and Related Rights, Third Session, *Agenda Item 4: Protection of Audiovisual Performances: Additional Proposal of Japan Concerning Moral Rights*, at 2, WIPO Doc. No. SCCR/3/8 (Nov. 10, 1999) (footnote omitted), available at [http://www.wipo.int/edocs/mdocs/copyright/en/sccr\\_3/sccr\\_3\\_8.pdf](http://www.wipo.int/edocs/mdocs/copyright/en/sccr_3/sccr_3_8.pdf) (documenting a proposal from Japan on the moral rights of performers); WIPO Standing Committee on Copyright and Related Rights, Third Session, *Agenda Item 4: Protection of Audiovisual Performances: Submission of Canada*, at 2, WIPO Doc. No. SCCR/3/9 (Nov. 11, 1999) (footnote omitted), available at [http://www.wipo.int/edocs/mdocs/copyright/en/sccr\\_3/sccr\\_3\\_9.pdf](http://www.wipo.int/edocs/mdocs/copyright/en/sccr_3/sccr_3_9.pdf) (presenting a proposal from Canada for uniform rules for recognizing the transfer of rights).

diplomatic conference in December 2000 dedicated exclusively to audiovisual performances. This 2000 “dipcon” found a formula to overcome film producers’ concerns over possible moral rights claims via an agreed statement that “modifications of a performance that are made in the normal course of exploitation of the performance, such as editing, compression, dubbing, or formatting, in existing or new media or formats” would not be considered violations of the new moral rights provision.<sup>41</sup> In international law, such agreed statements should be given a central role in the interpretation of any ambiguities in a treaty’s provisions.<sup>42</sup>

Yet while overcoming film producers’ hesitation about moral rights, the 2000 Diplomatic Conference was unable to craft legal norms that would apply comfortably to both continental European and American film production systems, especially to give security to contractual transfers of economic rights from actors to film producers. This “consolidation of rights” issue caused the meeting to end in a stalemate: the United States, supported by India, insisted on a “transfer of rights” provision that would ensure major film producers could distribute their films globally while the European Union opposed all proposals for such a provision.<sup>43</sup>

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<sup>41</sup> WIPO, Beijing Treaty on Audiovisual Performances, June 24, 2012, at n. 5 [hereinafter Beijing Treaty] (“For the purposes of this Treaty and without prejudice to any other treaty, it is understood that, considering the nature of audiovisual fixations and their production and distribution, modifications of a performance that are made in the normal course of exploitation of the performance, such as editing, compression, dubbing, or formatting, in existing or new media or formats, and that are made in the course of a use authorized by the performer, would not in themselves amount to modifications within the meaning of Article 5(1)(ii). Rights under Article 5(1)(ii) are concerned only with changes that are objectively prejudicial to the performer’s reputation in a substantial way. It is also understood that the mere use of new or changed technology or media, as such, does not amount to modification within the meaning of Article 5(1)(ii).”). All elements in the 2012 Beijing Treaty, with the exception of Article 12, were completed in 2000. *The Beijing Treaty on Audiovisual Performances – An EIFL Briefing for Libraries*, EIFL (June 2013), <http://www.eifl.net/resources/beijing-treaty-audiovisual-performances-eifl-briefing-libraries>.

<sup>42</sup> Under the Vienna Convention on the Law of Treaties, such an “agreed statement” almost certainly constitutes an “agreement relating to the treaty which was made between all the parties in connection with the conclusion of the treaty” which is part of the context used for primary interpretation of any treaty provision. Vienna Convention on the Law of Treaties, May 23, 1969, 1155 U.N.T.S. 331, art. 31(2)(a) at 340.

<sup>43</sup> U.S. PATENT & TRADEMARK OFF., BACKGROUND AND SUMMARY OF THE 2012 WIPO AUDIOVISUAL PERFORMANCES TREATY, at 1 (2012) [hereinafter Obama Administration, *Background and Summary of Beijing*], available at [https://www.uspto.gov/sites/default/files/news/WIPO\\_AVP\\_TREATY\\_FACT\\_SHEET.pdf](https://www.uspto.gov/sites/default/files/news/WIPO_AVP_TREATY_FACT_SHEET.pdf) (“The U.S., supported by India, insisted on a ‘transfer of rights’ provision that major film producers felt was needed to ensure their ability to distribute films globally; the European Union opposed all proposals for such a provision.”); The Beijing Treaty on Audiovisual Performances, Done at Beijing on June 24, 2012, February 10, 2016, S. Treaty Doc. No. 114-8, V–VI [hereinafter *2016 Transmittal Letter*] (“Countries narrowed the gaps at a diplomatic conference in 2000, but deadlocked over the issue of how performers could transfer to producers, by contract or otherwise, their exclusive rights regarding the uses of their performances.”); see also Deming Liu, *The Beijing Treaty on Audiovisual Performances (2012)*, in *WORLD COPYRIGHT LAW 25.03* (Trevor Cook ed., 4th ed. 2015) (describing how Article 12 on transfer

Following this inconclusive conclusion—so inconclusive that the diplomatic conference was adjourned, not closed—everyone involved in the negotiations understood that until there was a consensus on transfer of rights, the treaty could not be completed. For the next decade, further discussions were effectively *pro forma*.<sup>44</sup> In 2010–2011, those negotiations were taken up again by the Obama Administration and the prior impasse was broken with compromise language initially drafted by India, Mexico, and the United States, which was then supported by the European Union, Brazil, and Nigeria.<sup>45</sup> Based on that language, the WIPO members convened a diplomatic conference in Beijing<sup>46</sup> and completed what is now known as the Beijing Treaty on Audiovisual Performances.<sup>47</sup>

The Beijing Treaty establishes for dramatic performers the same rights to their performances in audiovisual works that musicians have to their performances in sound recordings under the 1996 WPPT, ratified by the United States in 1998. A 2012 Administration document<sup>48</sup> described the government’s view of the compatibility of the treaty with current U.S. law as follows:

- Under U.S. law, actors and musicians are considered to be “authors” of their performances, providing them with copyright rights.
- Just as the rights established in U.S. law already provide the protection for musical performers mandated by the

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of rights “was agreed by consensus at the 22nd Session of the SCCR held in 2011, enshrining a compromise designed to obtain the agreement of all concerned.”)

<sup>44</sup> Obama Administration, *Background and Summary of Beijing*, *supra* note 43, at 1 (“For the next decade, the incomplete AVP languished on the agenda of WIPO’s Standing Committee on Copyright and Related Rights (SCCR).”).

<sup>45</sup> *Id.* at 2 (“The United States, Mexico, and India delegations achieved compromise language, working closely with the delegations of other major film-producing jurisdictions, particularly the EU, Brazil, and Nigeria.”); Liu, *supra* note 43, at 25.03.

<sup>46</sup> Obama Administration, *Background and Summary of Beijing*, *supra* note 43, at 2; *see also* David Kappos, *A Milestone In Protecting Creative Content Around the World*, DIR.’S FORUM: A BLOG FROM USPTO’S LEADERSHIP (June 26, 2012), [https://www.uspto.gov/blog/director/entry/a\\_milestone\\_in\\_protecting\\_creative](https://www.uspto.gov/blog/director/entry/a_milestone_in_protecting_creative) (“A breakthrough to the stalemate occurred in 2010, when . . . [w]ith substantial input from the Screen Actors Guild (SAG), the Motion Picture Association of America (MPAA), and the American Federation of Television and Radio Artists (AFTRA), the United States submitted a proposal, and then worked with other delegations that had submitted proposals (Mexico, India) as well as with delegations from other major film-producing jurisdictions (particularly the European Union, Brazil and Nigeria) to find compromise language.”).

<sup>47</sup> Beijing Treaty, *supra* note 41.

<sup>48</sup> Obama Administration, *Background and Summary of Beijing*, *supra* note 43. Judges in the Ninth Circuit characterized this document as a “USPTO” document when in fact the text was approved by an inter-agency process that included the State Department, the U.S. Trade Representative (USTR), the Institute of Museums and Libraries, and the U.S. Copyright Office. In this sense, it is more accurately characterized as an Administration document. The author of this Article was also the principal author of the Administration document, reflecting the consensus views of the agencies above.

WPPT, U.S. law is already generally compatible with the Beijing Treaty provisions.

- Nonetheless, implementation of the Beijing Treaty may require some technical amendments of the Copyright Act, in particular the Title 17 reference to existing international copyright obligations, or “points of attachment” for parties to this treaty under U.S. law.
- If the negotiations are successful, then subject to authorization by the Secretary of State and the Administration, the Beijing Treaty—like the WCT and WPPT—would be submitted for the advice and consent of the Senate.<sup>49</sup>

While this 2012 Administration document refers to “technical amendments,” a full implementation of the Beijing Treaty would require express acknowledgement of *one* new right for actors: a right to prevent the fixation of their performances.<sup>50</sup> This right was established for musicians in the 1990s in § 1101 of Title 17.<sup>51</sup> The right was subsequently upheld in a series of litigation testing its constitutionality.<sup>52</sup> Whether or not extension of this “right of fixation” to dramatic actors counts as a “technical amendment,” it could be achieved through simple amendment of § 1101 and 18 U.S.C. § 2319A.<sup>53</sup> And that is exactly what the Administration proposed in February 2016 when it sent the Beijing Treaty to the U.S. Senate for ratification.

Consistent with the view that American copyright law already offers actors the possibility of being “authors,” the transmittal package from the State Department to the Senate states that only “[n]arrow changes in U.S. law will be needed for the United States to implement certain provisions of the treaty,”<sup>54</sup> and “[f]or the most part, existing U.S. law, principally the

<sup>49</sup> Obama Administration, *Background and Summary of Beijing*, *supra* note 43, at 2.

<sup>50</sup> Compare *id.* (“Nonetheless, implementation of the AVP may require some technical amendments of the Copyright Act, in particular where Title 17 refers to existing international copyright obligations (‘points of attachment’ for parties to this treaty under U.S. law).”), with Beijing Treaty, *supra* note 41, at art. 7 (footnote omitted) (“Performers shall enjoy the exclusive right of authorizing the direct or indirect reproduction of their performances fixed in audiovisual fixations, in any manner or form.”).

<sup>51</sup> 17 U.S.C. § 1101 (2012).

<sup>52</sup> See *United States v. Moghadam*, 175 F.3d 1269, 1271 (11th Cir. 1999), *cert. denied*, 529 U.S. 1036 (2000) (upholding the criminal provision against bootlegging, § 2319A, as an exercise of Commerce Clause power); *United States v. Martignon*, 492 F.3d 140, 152 (2d Cir. 2007) (upholding the criminal provision against bootlegging on the grounds that it is not a copyright law and there was “no need to examine whether it violates limits of the Copyright Clause.”); *KISS Catalog, Ltd. v. Passport Int’l Prods.*, 405 F. Supp. 2d 1169, 1171 (C.D. Cal. 2005) (upholding § 1101 as a constitutional exercise of Congress’ authority under the Commerce Clause).

<sup>53</sup> Justin Hughes, *Understanding (and Fixing) the Right of Fixation in Copyright Law*, 62 J. COPYRIGHT SOC’Y U.S.A. 385, 388 (2015) [hereinafter Hughes, *Right of Fixation*].

<sup>54</sup> 2016 *Transmittal Letter*, *supra* note 43, at III.

Copyright Act, would enable the United States to implement the obligations of the Beijing Treaty.”<sup>55</sup> The transmittal also states the Beijing Treaty:

[F]ills a gap in the international copyright system by extending to such performers the type of protections previously accorded to authors and to performers and producers of sound recordings, pursuant to existing international agreements to which the United States is a party. The Treaty's framework is consistent with existing U.S. standards[.]<sup>56</sup>

All of these statements *could* be interpreted as vague bureaucratese, but the only statutory changes proposed by the Obama Administration were changes to lists of treaties mentioned in Title 17<sup>57</sup> and an amendment of § 1101 to give actors a right of fixation enforced by a civil cause of action. The proposed amendment would do this by deleting the limiting words “music” and “musical” from § 1101 and adding “images” to § 1101 along with a § 101 definition.<sup>58</sup> The only reasonable interpretation of the fact that no other changes were proposed is that the consensus view of the experts in the government was that actors already can be authors under the Copyright Act—the same view as we will see is found in the Copyright Office’s *Compendium*.

## II. AMBIGUITY IN AMERICAN COPYRIGHT LAW

### A. *The Copyright Office Compendium’s View*

Lacking the clear statutory mandate of Canadian copyright law, what evidence is there that American copyright law treats actors as authors? Among statements from the executive and legislative branches,<sup>59</sup> perhaps

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<sup>55</sup> *Id.* at VIII.

<sup>56</sup> *Id.* at V.

<sup>57</sup> Beijing Treaty Implementation Act of 2016, 114th Cong. (2016) *available at* <https://www.uspto.gov/sites/default/files/documents/Beijing-treaty-package.pdf> (as transmitted from Under Secretary of Commerce Michelle Lee to President of the Senate Joseph Biden, Feb. 26, 2016).

<sup>58</sup> *Id.* at 2.

<sup>59</sup> Housed in the Library of Congress, the question of whether the U.S. Copyright Office is an Article I or Article II entity has been litigated inconclusively. *Compare* *Eltra Corp. v. Ringer*, 579 F.2d 294, 301 (4th Cir. 1978) (finding Register of Copyrights to be executive branch officer), *with* *United States v. Brooks*, 945 F. Supp. 830, 834 (E.D. Pa. 1996) (finding that the Copyright Office is not in the executive branch). In practice, the Copyright Office is only partially integrated into the executive branch’s copyright policy apparatus. *See also* Graeme B. Dinwoodie, *The Development and Incorporation of International Norms in the Formation of Copyright Law*, 62 OHIO ST. L.J. 733, 764 (2001) (describing Copyright Office as “strictly part of the legislative branch”); Andy Gass, *Considering Copyright Rulemaking: The Constitutional Question*, 27 BERKELEY TECH. L.J. 1047, 1047 (2012); Justin Hughes, *Making Copyright Policy in Washington*, THE HILL (Jan. 23, 2015, 12:00 PM), <http://thehill.com/blogs/congress-blog/the-administration/230449-making-copyright-policy-in-washington>.

the most explicit is the *Compendium of U.S. Copyright Office Practice*, which unequivocally recognizes the dramatic performance of actors as a basis for authorship in an audiovisual work.<sup>60</sup> Section 808.4 of the *Compendium* identifies ten “Elements of Motion Picture Authorship” in the following order: production, direction, cinematography, performance, animation, screenplay or script, works that precede a screenplay or script, editing, musical score, and soundtrack.<sup>61</sup> The *Compendium* then defines performance: “Performance refers to the acting, speaking, singing, or dancing in a motion picture.”<sup>62</sup> And the *Compendium* makes clear that “motion pictures” encompasses all audiovisual works.<sup>63</sup>

In other words, the *Compendium* recognizes that dramatic performances are protectable expression that is a basis for authorship in audiovisual works. That is not the same thing as saying that dramatic performances are protectable works, although under some circumstances—as explored in Part III—that might be the case. Oddly, in the *Garcia v. Google* litigation, the courts discussed and debated a letter from the Copyright Office and a fact sheet from the Obama Administration, but there was *complete* silence vis-à-vis the Copyright Office’s most comprehensive and authoritative statement of what is protected by copyright in American law,<sup>64</sup> despite the fact that at least two amici briefs<sup>65</sup>—one discussed by the bench and counsel at oral argument<sup>66</sup>—pointed the judges to the *Compendium*.

## B. *Views from the Bench*

Opinions from the bench addressing copyright in dramatic performances have been rare and sporadic,<sup>67</sup> but glimmers in the case law show courts considering dramatic performances to be original expression providing a

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<sup>60</sup> U.S. COPYRIGHT OFF., COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 307 (3d ed. 2014) (rev. Sept. 29, 2017) [hereinafter COMPENDIUM].

<sup>61</sup> *Id.* at § 808.4.

<sup>62</sup> *Id.* at § 808.4(D).

<sup>63</sup> *Id.* at § 808.5 (“Motion pictures include movies of all genres . . . [and] television programs and commercials (e.g., comedy, drama, reality, news, advertisements), music and educational videos, and short videos posted online.”).

<sup>64</sup> *Garcia v. Google, Inc.*, 786 F.3d 733, 751–52 (9th Cir. 2015) (en banc) (Kozinski, J., dissenting) (*Garcia III*).

<sup>65</sup> Brief for Screen Actors Guild-American Federation of Television and Radio Artists et al. as Amici Curiae Supporting Appellant, *Garcia III*, 786 F.3d 733 (No. 12-57302); Brief for Professors Shyamkrishna Balganes, Justin Hughes, Peter Menell, & David Nimmer as Amici Curiae Supporting Neither Party, *Garcia III*, 786 F.3d 733 (No. 12-57302) [hereinafter Balganes et al. Brief].

<sup>66</sup> Oral Argument at 49:30, *Garcia III*, 786 F.3d 733 (No. 12-57302), [https://www.ca9.uscourts.gov/media/view\\_video.php?pk\\_vid=0000006884](https://www.ca9.uscourts.gov/media/view_video.php?pk_vid=0000006884) (discussing Balganes et al. Brief).

<sup>67</sup> See Jacob M. Victor, *Garcia v. Google and a “Related Rights” Alternative to Copyright in Acting Performances*, 124 YALE L.J.F. 80, 82 (2014) (“[C]ourts rarely have the opportunity to address the issue of whether film actors maintain independent copyright interests in their performances.”).

basis for authorship. Such comments have occurred in dicta or in holdings that could be read in alternative ways, mainly in disputes in which a state law claim brought by the plaintiff is precluded by a dramatic performance being in the realm of federal copyright.

An early example—and one that is understandably criticized—is the Seventh Circuit’s 1986 decision in *Baltimore Orioles, Inc. v. Major League Baseball Players’ Association*.<sup>68</sup> In that case, the players’ association claimed that live telecasts of major league baseball (MLB) games violated the players’ individual rights of publicity.<sup>69</sup> Both the district court and the appellate panel concluded that MLB ownership of the copyright in the baseball telecasts preempted any right of publicity claims under state law.<sup>70</sup>

Copyright experts would agree with the conclusion of the *Baltimore Orioles* court that the telecasts were copyrighted works based on the originality of the camera people and director, as well as the simultaneous fixation of the telecasts.<sup>71</sup> But in an extended footnote, the appellate court went on to conclude that the players’ performances while playing baseball had sufficient originality to be protected by copyright once fixed in a tangible medium:

The Players argue that their performances are not copyrightable works because they lack sufficient artistic merit. We disagree. Only a modicum of creativity is required for a work to be copyrightable . . . . A recording of a performance generally includes creative contributions by both the director and other individuals responsible for recording the performance and by the performers whose performance is captured . . . . Judged by the above standard, the Players’ performances possess the modest creativity required for copyrightability.<sup>72</sup>

Further in the opinion, the appellate panel doubled down on this footnote analysis. The Players’ Association argued that by asserting publicity rights in their performances, “the works in which they assert rights are not fixed in tangible form, their rights of publicity in their performances are not subject

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<sup>68</sup> *Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663 (7th Cir. 1986).

<sup>69</sup> *Id.* at 681.

<sup>70</sup> *Id.* at 676.

<sup>71</sup> *Id.* at 668–69 (quoting H.R. REP. NO. 94-1476, at 52 (1985), as reprinted in 1976 U.S.C.C.A.N. 5659, 5665) (“When a football game is being covered by four television cameras, with a director guiding the activities of the four cameramen and choosing which of their electronic images are sent to the public and in which order, there is little doubt that what the cameramen and the director are doing constitutes ‘authorship.’”); *id.* at 669 n.7 (“[T]he Players agree that the cameramen and director contribute creative labor to the telecasts.”).

<sup>72</sup> *Id.* at 669, n.7.

to preemption.”<sup>73</sup> The panel met this head-on with reasoning that can be interpreted as saying that an individual athlete’s performances would be protected under copyright:

The Players’ performances are embodied in a copy, viz, the videotape of the telecast, from which the performances can be perceived, reproduced, and otherwise communicated indefinitely. Hence, their performances are fixed in tangible form, and any property rights in the performances that are equivalent to any of the rights encompassed in a copyright are preempted.<sup>74</sup>

This conclusion as to the copyrightability of sports performances may be problematic, principally on the grounds that playing a game is not “expressive” in the sense that the concept is used in copyright doctrine<sup>75</sup>—the appellate court was itself aware of this issue.<sup>76</sup> But that wrinkle would disappear if “Players” in this passage is read as *theatrical* players, not *sports* players.

Of course, the fact that federal copyright preempts state law protection of *X* does not mean that federal copyright protects *X*. But the *Baltimore Orioles* panel and a subsequent Central District of California decision concluded that “[o]nce a performance is reduced to tangible form, there is no distinction between the performance and the recording of the performance for purposes of preemption under § 301(a).”<sup>77</sup> This warrants some parsing.

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<sup>73</sup> *Id.* at 675.

<sup>74</sup> *Id.*

<sup>75</sup> See, e.g., Nat’l Basketball Ass’n v. Motorola, Inc., 105 F.3d 841, 846 (2d Cir. 1997) (“[B]asketball games do not fall within the subject matter of federal copyright protection because they do not constitute ‘original works of authorship’ under 17 U.S.C. § 102(a).”). But Paul Goldstein has defended the possibility of copyright in the movements of sports players. See *infra* notes 184–87 and accompanying text. The *Baltimore Orioles* panel’s approach can also be criticized on the grounds that they reasoned that the performances have great commercial value and, citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), that courts “should not gainsay the copyrightability of a work possessing great commercial value simply because the work’s aesthetic or educational value is not readily apparent to a person trained in the law.” *Baltimore Orioles*, 805 F.2d at 669 n.7. Not everyone is happy with that thread drawn from *Bleistein*. See, e.g., Barton Beebe, Bleistein, *the Problem of Aesthetic Progress, and the Making of American Copyright Law*, 117 COLUM. L. REV. 319 (2017) (reasoning that Holmes used “personality” as the threshold for originality and—regrettably—commercial value as the threshold for “progress”).

<sup>76</sup> The court reiterated that its conclusion on the copyrightability of the telecasts and, therefore, the preemption of the right of publicity claim, would hold regardless of originality in the athletic performances. *Baltimore Orioles*, 805 F.2d at 676 (“Regardless of the creativity of the Players’ performances, the works in which they assert rights are copyrightable works which come within the scope of § 301(a) because of the creative contributions of the individuals responsible for recording the Players’ performances.”).

<sup>77</sup> *Baltimore Orioles*, 805 F.2d at 675; *Trenton v. Infinity Broad. Corp.*, 865 F. Supp. 1416, 1424 (C.D. Cal. 1994).

The “recording of a performance” would normally be considered a “work.” And to the degree that the recording of the performance captures other things—costumes, sets, lighting, camera angles, and equipment choices—there would be a distinction between a “recording of the performance” and the recorded performance. But if we could eliminate those other things—as discussed in Part III.A—it actually might be the case that there would be little or “no distinction between the performance and the recording of the performance.”

Two more preemption cases went further in this direction of finding that a performance, once recorded, can be a copyrightable work. In a 1996 California state court case, *Fleet v. CBS, Inc.*,<sup>78</sup> the court considered a compensation dispute between producers of the film *White Dragon* and some of the film’s actors. Because there was no question that CBS owned the copyright in *White Dragon*, the plaintiffs alleged that CBS “did not have permission to utilize their names, pictures, or likenesses in conjunction with any exploitation of the film.”<sup>79</sup>

The court concluded that section 301 of the Copyright Act preempted the plaintiffs’ right of publicity claims.<sup>80</sup> While agreeing that California’s Civil Code section 3344 was “intended to protect rights which cannot be copyrighted,”<sup>81</sup> the court concluded that the actors’ claim “crumbles in the face of one obvious fact: their individual performances in the film *White Dragon* were copyrightable.”<sup>82</sup> Squarely answering the actors-as-authors issue, the court concluded that once the “performances were put on film, they became ‘dramatic work[s]’ [that were] ‘fixed in [a] tangible medium of expression’”<sup>83</sup> and that upon fixation, “the performances came within the scope or subject matter of copyright law protection.”<sup>84</sup> Strictly speaking, this reasoning was not necessary to the preemption outcome. The court could have concluded that the right of publicity claims were simply preempted because the claims sought “only to prevent CBS from reproducing and distributing” the copyrighted film.<sup>85</sup> But the reasoning that “performances,” once fixed, became “dramatic works” was certainly what CBS had vigorously argued.<sup>86</sup>

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<sup>78</sup> 58 Cal. Rptr. 2d 645, 647 (Cal. Ct. App. 1996).

<sup>79</sup> *Id.* CBS released the film anyway and included a picture of one of the plaintiffs “on the packaging and [in] advertising materials.” *Id.*

<sup>80</sup> *Id.* at 649.

<sup>81</sup> *Id.* at 650.

<sup>82</sup> *Id.*

<sup>83</sup> *Id.* (quoting 17 U.S.C. § 102(a)).

<sup>84</sup> *Id.*

<sup>85</sup> *Id.*

<sup>86</sup> Brief for Respondent at 7, *Fleet v. CBS, Inc.*, 50 Cal. Rptr. 2d 645 (1996) (No. BC 092926) (“[T]he performances in the Motion Picture . . . are works of authorship subject to copyright.”); *see also id.* at 10 (“[T]he subject matters of appellants’ claims (their performance in a Motion Picture) are ‘works of authorship’ fixed in a ‘tangible medium . . . .’”); *id.* at 13–14 (“All commentators and case authority

Following *Fleet v. CBS, Inc.*, a Ninth Circuit panel reached a similar outcome in a similar fact pattern, but with less definitive language. In the 2010 *Jules Jordan Video, Inc. v. 144942 Canada, Inc.*<sup>87</sup> litigation, pornographic actor Jules Jordan and his one-man company brought an action against parties who were clearly pirating Jordan's adult films. A jury found for Jordan on both copyright infringement and right of publicity claims,<sup>88</sup> but the court granted the defendants' motion for directed verdict on the grounds that the plaintiff lacked standing to bring the copyright claims.<sup>89</sup> This left the plaintiff with the successful California right of publicity claim, and the defendants then appealed on the grounds that the right of publicity claim was preempted by federal copyright law.<sup>90</sup>

Jordan's state right of public claim was based on misappropriation of his name, his "persona," and his "dramatic performance."<sup>91</sup> The court concluded that the claimed misappropriation of Jordan's name and persona were "based entirely on the misappropriation of the DVDs and [Jordan's] performance therein,"<sup>92</sup> reducing the right of publicity claim to a claim of misappropriated dramatic performance. As to preemption by federal copyright, the panel reasoned:

Whether a claim is preempted under Section 301 does not turn on what rights the alleged infringer possesses, but on whether the rights asserted by the plaintiff are equivalent to any of the exclusive rights within the general scope of the copyright. *The question is whether the rights are works of authorship fixed in a tangible medium of expression and come within the subject matter of the Copyright Act.* If a plaintiff asserts a claim that is the equivalent of a claim for infringement of a copyrightable work, that claim is preempted . . . .<sup>93</sup>

On this basis, the panel concluded that Jordan's right of publicity claims were preempted.<sup>94</sup> Strictly speaking, the *Jules Jordan* court only concluded

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agree that an actors' performance in a film has the requisite degree of artistic creativity to be a work protected by copyright law.").

<sup>87</sup> 617 F.3d 1146, 1149–50 (9th Cir. 2010).

<sup>88</sup> *Id.* at 1151.

<sup>89</sup> *Id.* at 1152 ("The court granted defendants' motion, concluding that because Gasper was employed by JJV the motion picture[s] were works for hire under 17 U.S.C. § 101 and that JJV was the author, leaving Gasper without standing. The court also concluded that because the copyright registration in Gasper's name was invalid, JJV had no standing.").

<sup>90</sup> *Id.*

<sup>91</sup> *Id.* at 1153.

<sup>92</sup> *Id.*; see also *id.* at 1154 ("[T]hroughout the litigation Gasper has claimed that the factual basis of his right of publicity claim was the unauthorized reproduction of his performance on the DVDs.").

<sup>93</sup> *Id.* at 1154–55 (emphasis added).

<sup>94</sup> *Id.* at 1155. While finding that the California right of publicity was preempted, the appellate court reinstated the jury's copyright infringement judgment against the defendants. *Id.* at 1160.

that the rights Jordan asserted under California law over his recorded performances were “equivalent to the rights contained in 17 U.S.C. § 106, which articulates the exclusive rights of copyright holders.”<sup>95</sup> This is not precisely the *Fleet* court holding that when dramatic “performances were put on film, they became ‘dramatic work[s]’ ‘fixed in [a] tangible medium of expression.’”<sup>96</sup> But it seems close.

Finally, two additional federal court decisions before the *Garcia v. Google* litigation merit discussion. In the 2007 *Richlin v. Metro-Goldwyn-Mayer*<sup>97</sup> case, a Ninth Circuit panel was faced with the claim that joint authorship in a movie treatment gave rise to joint authorship in the resulting film. Pushing back against this claim, the panel expressly gave the lead actor’s acting—“Peter Sellers’s legendary comedic performance”—as an example of a legitimate basis for joint authorship on par with the film director.<sup>98</sup>

The same year as *Richlin*, the federal district court in Puerto Rico considered a copycat television show dispute between two television stations, *TMTV Corp. v. Pegasus Broadcasting*.<sup>99</sup> From 1997 to 1999, TMTV produced and broadcasted a show called “20 Pisos de Historia.”<sup>100</sup> A year after “20 Pisos” went off the air, a competitor station began airing a weekly sitcom called “El Condominio.”<sup>101</sup> Many of the actors appearing in “El Condominio” had played the same or similar characters in “20 Pisos.”<sup>102</sup> When a dispute arose between the television stations, these “El Condominio” actors sued TMTV “for declaratory judgment of ownership over the copyrights to the characters they portray in that series,”<sup>103</sup> while TMTV counterclaimed on the basis that it owned “20 Pisos” and the characters therein.<sup>104</sup>

Against the actors’ claim that they, not TMTV, owned the characters created in “20 Pisos,” TMTV argued “that the actors cannot hold the copyright to the characters, because they did not write the scripts in which [the characters] appear.”<sup>105</sup> The district court denied TMTV summary

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<sup>95</sup> *Id.* at 1153 (emphasis added) (quoting *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1138 (9th Cir. 2006)).

<sup>96</sup> *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 650 (Cal. Ct. App. 1996).

<sup>97</sup> 531 F.3d 962, 964 (9th Cir. 2007).

<sup>98</sup> *See id.* at 970 (explaining the potential bases for co-authorship in the *Pink Panther* film were “Peter Sellers’s legendary comedic performance, Henry Mancini’s memorable score, or Blake Edwards’s award-winning direction”).

<sup>99</sup> *TMTV Corp. v. Pegasus Broad. of San Juan*, 490 F. Supp. 2d 228, 230 (D.P.R. 2007).

<sup>100</sup> *Id.* “20 Pisos” means “20 floors”—as in a tall apartment building—while “de Historia” could be a play on words, meaning both “of history” and “of stories.”

<sup>101</sup> *Id.*

<sup>102</sup> *Id.*

<sup>103</sup> *Id.*

<sup>104</sup> *Id.*

<sup>105</sup> *Id.* at 236.

judgment on this basis “because it is evident from the record that the actors portrayed the characters in an audiovisual media, which permits a reasonable inference that the actors’ contribution to the characters rendered them authors.”<sup>106</sup> A reasonable reading of this passage is that the court viewed the final characters—as seen in the recorded television shows—as a composite of what had been written in the script and original expression contributed by the actors in the course of their recorded performances.

Along with the Copyright Office *Compendium*, this case law was largely ignored by the various opinions that issued in the *Garcia v. Google* litigation, a fact pattern incredible by even the standards of Hollywood.

### C. *The Strange and Strained Saga of Garcia v. Google*

In bare-bone form, Cindy Lee Garcia was a struggling actor who believed that she had been hired to perform in a low-budget film tentatively entitled *Desert Warrior*. Film projects often change titles and scripts after casts are hired, but Mark Basseley Youssef, the producer who hired Garcia for the film, may never have intended to make the work he represented to the cast and crew.<sup>107</sup> What we know for sure is that Youssef used Garcia’s short performance—with at least partial dubbing over her voice—in *Innocence of Muslims*, a bizarre extended trailer that appeared on YouTube in the summer of 2012.<sup>108</sup> The fourteen-minute video seemed designed to offend Muslims<sup>109</sup> and Garcia’s very brief appearance in the video garnered her multiple death threats, some based on a *fatwa* that all involved should die.<sup>110</sup>

Garcia sought a preliminary injunction to have the video taken down from YouTube,<sup>111</sup> with her lawyer seeming to claim a copyright in Garcia’s

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<sup>106</sup> *Id.*

<sup>107</sup> See *Garcia v. Google, Inc.*, 766 F.3d 929, 940 (9th Cir. 2014), *dissolved by*, 786 F.3d 733 (9th Cir. 2015) (en banc) (“This is a troubling case. Garcia was duped into providing an artistic performance that was used in a way she never could have foreseen. Her unwitting and unwilling inclusion in ‘Innocence of Muslims’ led to serious threats against her life.”).

<sup>108</sup> See Brooks Barnes, *YouTube Wrongly Forced to Remove Anti-Muslim Movie Trailer*, *Appeals Court Rules*, N.Y. TIMES (May 18, 2015), <https://www.nytimes.com/2015/05/19/business/media/youtube-wrongly-forced-to-remove-anti-muslim-movie-trailer-appeals-court-rules.html> (describing the film and Garcia’s role).

<sup>109</sup> See *id.* (noting the film’s depiction of the Prophet Muhammad “as a bloodthirsty thug”).

<sup>110</sup> See Andrew Blankstein & Ned Parker, *Police Probe Threats, Fatwa Against ‘Innocence of Muslims’ Actors*, L.A. TIMES: L.A. NOW (Sept. 21, 2012, 7:17 AM), <http://latimesblogs.latimes.com/lanow/2012/09/police-probe-threats-fatwa-against-innocence-of-muslims-actors.html> (describing the fatwa issued by an Egyptian cleric against all associated with the film); Jane C. Ginsburg, *Actors as Authors?*, MEDIA INST. (Dec. 1, 2014), <http://www.mediainstitute.org/IPI/2014/120114.php> (“For her unwitting participation, Garcia received death threats and sought without success to have the film removed from YouTube.”).

<sup>111</sup> *Garcia v. Nakoula*, No. CV 12-08315-MWF, 2012 WL 12878355, at \*1 (C.D. Cal. Nov. 30, 2012), *aff’d sub nom. en banc*, *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. 2015). Garcia initially

performance.<sup>112</sup> This posture was clearly a matter of litigation strategy. First, Garcia could not credibly argue that she was the sole author of the entire video. Second, the legal conclusion that she was a joint author of the video would mean that any other joint author could authorize distribution of the video—as Youssef did—and Garcia would only be entitled to a financial accounting.<sup>113</sup> A claim of joint authorship would not only fail to lead to the relief she wanted, it also would have been inconsistent with Garcia’s allegation that she had been duped into participating in the video. In other words, how could she contend that she had the *intention* to be a joint author of a work in circumstances in which she alleged to have been defrauded as to the nature of the work?

Given this dilemma, Garcia’s counsel “argue[d] only that she owns the copyright in her performance within the Film.”<sup>114</sup> The district court was unconvinced that Garcia had a likelihood of success on the merits,<sup>115</sup> and in November 2012, the court declined to grant Garcia a temporary injunction.<sup>116</sup> From there, the case moved to the Ninth Circuit.<sup>117</sup>

In February 2014, a divided Ninth Circuit panel reversed the district court, issuing a slightly amended opinion a few months later. Writing for the majority, Chief Judge Kozinski found that Garcia “likely has an independent [copyright] interest in her performance,”<sup>118</sup> that she had not transferred or licensed those rights to Youssef, and that an injunction was warranted. Garcia’s allegations that she had been defrauded as to the nature of the video/film was a keystone of this reasoning. Because of Youssef’s fraudulent misrepresentation as to the nature of the film, Garcia could not have impliedly licensed use of her performance,<sup>119</sup> and there was neither an employment situation nor a signed writing on which to base a conclusion that her performance was a work-for-hire.<sup>120</sup>

Judge N.R. Smith dissented from Kozinski’s ruling, reasoning that “Garcia does not clearly have a copyright interest in her acting performance,

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requested a temporary restraining order (TRO) against YouTube, that request was denied, and the TRO “[a]pplication was construed as a motion for a preliminary injunction.” *Id.*

<sup>112</sup> *Garcia*, 2012 WL 12878355, at \*2.

<sup>113</sup> *Id.*

<sup>114</sup> *Id.* (“Garcia does not argue that she is the sole author of the Film, nor does she argue that the Film was a joint work of which she was a co-author.”).

<sup>115</sup> *Id.* at \*1 (“Nor has Garcia established a likelihood of success on the merits. Even assuming both that Garcia’s individual performance in the Film is copyrightable and that she has not released this copyright interest, the nature of this copyright interest is not clear.”).

<sup>116</sup> *Id.*

<sup>117</sup> *Garcia v. Google, Inc.*, 766 F.3d 929 (9th Cir. 2014), *dissolved by*, 786 F.3d 733 (9th Cir. 2015) (en banc).

<sup>118</sup> *Id.* at 933. But oddly by injunctive relief standards, Judge Kozinski recognized that Garcia’s claim was “fairly debatable.” *Id.* at 935.

<sup>119</sup> *Id.* at 937–38.

<sup>120</sup> *Id.* at 936–37.

because (1) her acting performance is not a work, (2) she is not an author, and (3) her acting performance is too personal to be fixed.”<sup>121</sup> It is worth considering these points in reverse order.

Judge Smith seems to have gotten the notion that an “acting performance is too personal to be fixed” from a misreading of the Ninth Circuit’s 1988 case *Midler v. Ford Motor Co.*<sup>122</sup> In that litigation, Ford had obtained a license to use the musical composition “Do You Want to Dance” in a commercial. When Bette Midler rebuffed Ford’s offer to do the commercial, Ford “studiously acquire[d] the services of a sound-alike and instruct[ed] her to imitate . . . Midler’s voice.”<sup>123</sup> The Ninth Circuit concluded that Midler’s California law “sound-alike” claim was not preempted by federal copyright law, offering that “[a] voice is not copyrightable. The sounds are not ‘fixed.’ What is put forward . . . here is more personal than any work of authorship.”<sup>124</sup> Judge Smith misunderstood this statement, morphing it into the conclusion that “Ninth Circuit precedent dictates that a vocalist’s singing of the song is not copyrightable.”<sup>125</sup> The dissent then applied that misunderstanding of *Midler* to *Garcia*, concluding that “one actress’s individual acting performance in the movie, like a vocalist singing a song, ‘is more personal than any work of authorship.’ As a result, it is not fixed.”<sup>126</sup>

This profoundly misunderstands the *Midler* case because Bette Midler was *not* suing on a particular fixation of her singing—that is, any particular sound recording. Midler could not bring such a suit under the Copyright Act because under § 114, the derivative work right in sound recordings “is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality.”<sup>127</sup> In other words, the statute bars a “sound-alike” claim based on a copyrighted sound recording. Instead, Midler claimed that her vocal characteristics and style had been slavishly copied in a violation

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<sup>121</sup> *Id.* at 941 (Smith, J., dissenting).

<sup>122</sup> 849 F.2d 460 (9th Cir. 1988).

<sup>123</sup> *Id.* at 463.

<sup>124</sup> *Id.*

<sup>125</sup> *Garcia*, 766 F.3d at 945 (Smith, J., dissenting) (citing *Midler*, 849 F.2d at 462).

<sup>126</sup> *Id.* (citation omitted). Of course, the idea that something is “too personal” to be a work of authorship is arguably at odds with Justice Holmes’ equation of personal expression with original expression. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903) (“Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man’s alone. That something he may copyright unless there is a restriction in the words of the act.”). While courts have not questioned Holmes’ statement, scholars have pondered its meaning. See Beebe, *supra* note 75, at 330 (reasoning that Holmes used “personality” as the threshold for originality driven by an “everyman”—distinctively American romanticism); Justin Hughes, *The Photographer’s Copyright—Photograph as Art, Photograph as Database*, 25 HARV. J.L. & TECH. 339, 369 (2012) (discussing Justice Holmes’s use of “personality” as both a synonym and source of originality).

<sup>127</sup> 17 U.S.C. § 114(b) (2012).

of her common law right of publicity. The case does not hold that “a vocalist’s singing of [a] song is not copyrightable” because Midler was not suing on the basis of any fixed sound recording.<sup>128</sup> Indeed, a vocalist’s singing of a song *is* copyrightable, even if there is no instrumental accompaniment, no sound engineering, and no post-production. Cindy Garcia was suing on reproduction of *her own* performance, not a “look-alike” or “act-alike.” While Judge Smith’s peculiar analysis did not survive in the *en banc* decision, it may have influenced the *en banc* majority’s own distorted statements on fixation, described below.

The dissent’s second critique of Garcia’s claim was simply that she was “not an author.”<sup>129</sup> This assertion was based on the Ninth Circuit’s 2000 *Aalmuhammed v. Lee*<sup>130</sup> decision and its framework for distinguishing joint authors from other contributors. In *Aalmuhammed*, a Ninth Circuit panel denied joint authorship to a consultant on the film *Malcolm X* who had “suggested extensive script revisions,” principally “to ensure the religious and historical accuracy and authenticity of scenes depicting Malcolm X’s religious conversion and pilgrimage to Mecca.”<sup>131</sup> Judge Smith cited a series of *Aalmuhammed* indicia to establish that Garcia could not be an author: (a) an author is “the originator or the person who causes something to come into being”;<sup>132</sup> (b) an author is the “person with creative control”;<sup>133</sup> (c) an author is “he to whom anything owes its origin”;<sup>134</sup> and (d) “an author might also be ‘the invent[or] or master mind’ who ‘creates or gives effect to the idea.’”<sup>135</sup> Part IV will address the problems with *Aalmuhammed*. Suffice here to say that by some of these tests, an actor will be an author—the actor is certainly the performing artist that “causes something to come into being” and the actor certainly “give[s] effect to the idea[s]” of the scriptwriter and the director. These notions are explored further in Part III.B. In a footnote, Judge Smith seems to recognize that Garcia might be a joint author with Youssef,<sup>136</sup> suggesting that the dissent was really using these tests to argue that Garcia could not be the *exclusive* author of anything, a required basis for her claimed injunctive relief.

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<sup>128</sup> *Midler*, 849 F.2d at 462.

<sup>129</sup> *Garcia*, 766 F.3d at 941 (Smith, J., dissenting).

<sup>130</sup> *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000).

<sup>131</sup> *Id.* at 1230.

<sup>132</sup> *Garcia*, 766 F.3d at 942 (Smith, J., dissenting) (quoting *Aalmuhammed*, 202 F.3d at 1232).

<sup>133</sup> *Id.*

<sup>134</sup> *Id.* (quoting *Aalmuhammed*, 202 F.3d at 1233).

<sup>135</sup> *Id.* (quoting *Aalmuhammed*, 202 F.3d at 1234).

<sup>136</sup> *Id.* at 942 n.3 (“Garcia’s interest in her acting performance may best be analyzed as a joint work with Youssef, considering she relied on Youssef’s script, equipment, and direction.”); *see also id.* (citing 17 U.S.C. § 101) (defining “joint work” 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”).

Finally, there is Judge Smith's first concern about Garcia's claim: that "her acting performance [was] not a work" and that "[t]o be protected, Garcia's acting performance must be a 'work.'"<sup>137</sup> This is a legitimate issue and arguably the most vexing problem in the *Garcia* litigation, but again the analysis quickly went off the doctrinal rails. After reciting § 102(b), which bars copyright protection of ideas, processes, methods of operation, and discoveries,<sup>138</sup> the dissent reasoned that an acting performance resembles the "procedure" or "process" by which "an original work" is performed. Therefore, "[i]n no case does copyright protection" extend to an acting performance, "regardless of the form in which it is described, illustrated, or embodied in" the original work.<sup>139</sup>

It is not clear what it means to say that a dramatic or musical performance would "resemble" a "procedure" or "process," except as a misunderstanding of these latter two terms. What would it mean to say that Nina Simone's recorded performance and David Bowie's separate recorded performance of the musical composition *Wild is the Wind* were each a "procedure" or "process"? A "procedure" or "process" of that musical composition? If we could make any sense of this view, it would likely undermine copyright protection of sound recordings. There was thankfully no trace of this bizarre characterization of performances<sup>140</sup> in the subsequent *en banc* ruling.

Doctrinal missteps aside, we could describe the disagreement between Judge Kozinski and Judge Smith as David Nimmer does: "The flash-point between the majority and dissent focused on whether the plaintiff could show copyright ownership."<sup>141</sup> To refine this, the plaintiff needed to show *exclusive* ownership of something protected by copyright. As the subjects of protection in American copyright law are "works of authorship," we are inevitably drawn to the question of whether a dramatic performance could be a "work" under Title 17. If not, how could there be a protectable interest *controlled exclusively by the plaintiff*? Concerning these questions, Jane Ginsburg has noted that Judge Kozinski's opinion stood "for the proposition

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<sup>137</sup> *Id.* at 941.

<sup>138</sup> 17 U.S.C. § 102(b) (2012) ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.").

<sup>139</sup> *Garcia*, 766 F.3d at 942 (Smith, J., dissenting) (citation omitted).

<sup>140</sup> 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.12(B)(2) (2018) [hereinafter NIMMER & NIMMER] ("[Such a] construction does violence to the structure of the [Copyright] Act. Congress expressly disallowed protection for various productions, such as *methods of operation* and *ideas*. Those matters stand poles apart from *performances*, which constitute the essence of works that Congress expressly embraced within the realm of copyright . . .").

<sup>141</sup> David Nimmer, *Innocence of Copyright: An Inquiry into the Public Interest*, 63 J. COPYRIGHT SOC'Y U.S.A. 367, 396 (2016).

that audiovisual performances could be the subject matter of individual copyrights owned by the individual actor.<sup>142</sup>

Criticism of Judge Kozinski's opinion was fast and furious, particularly from those who generally oppose recognition of copyright rights.<sup>143</sup> A petition for re-hearing *en banc* was filed and granted on November 12, 2014.<sup>144</sup> The case was reargued in December 2014 before eleven of the twenty-two active judges on the Ninth Circuit,<sup>145</sup> with an *en banc* decision issued the following May.

Writing for the *en banc* majority, Judge McKeown concluded that the law and facts did not favor "Garcia's claim to a copyright in her five-second acting performance as it appears in *Innocence of Muslims*."<sup>146</sup> Later, in the discussion of the standards for injunctive relief, the majority opinion describes Garcia's claims as "based upon a dubious and unprecedented theory of copyright."<sup>147</sup> McKeown's opinion for the majority gives us some distinct and separate reasons for these conclusions.

First, while the *Garcia en banc* opinion did not repeat Judge Smith's "acting performance is too personal to be fixed" argument, it did offer its

<sup>142</sup> Ginsburg, *supra* note 110.

<sup>143</sup> See, e.g., Steven Seidenberg, *Copyright Ruling in US May Impair Free Speech*, INTELL. PROP. WATCH (Apr. 14, 2014, 2:40 PM), <http://digitalcommons.law.scu.edu/historical/689/> ("[T]he ruling significantly alters US law in a manner that will greatly restrict free speech."); Mike Masnick, *Horrific Appeals Court Ruling Says Actress Has Copyright Interest In 'Innocence Of Muslims,' Orders YouTube To Delete Every Copy*, TECHDIRT (Feb. 26, 2014, 12:29 PM), <https://www.techdirt.com/articles/20140226/12103626359/horrific-appeals-court-ruling-says-actress-has-copyright-interest-innocence-muslims-orders-youtube-to-delete-every-copy.shtml> ("Almost everything about Kozinski's ruling here is troubling. The copyright interpretation just seems very far out of bounds with just about everything having to do with copyright law."); Venkat Balasubramani, *In Its 'Innocence of Muslims' Ruling, the Ninth Circuit is Guilty of Judicial Activism—Garcia v. Google*, TECH. & MKTG. L. BLOG (Feb. 27, 2014), <http://blog.ericgoldman.org/archives/2014/02/in-its-innocence-of-muslims-ruling-the-ninth-circuit-is-guilty-of-judicial-activism-garcia-v-google.htm> ("This starts to look . . . like a variation on the heckler's veto. It's certainly not very speech friendly to take an expansive view of copyright in connection with takedown requests that are prompted by threats of violence."); Corynne McSherry, *Bad Facts, Really Bad Law: Court Orders Google to Censor Controversial Video Based on Spurious Copyright Claim*, ELEC. FRONTIER FOUND. (Feb. 26, 2014), <https://www.eff.org/deeplinks/2014/02/bad-facts-really-bad-law-court-orders-google-censor-controversial-video-based> ("We're hard-pressed to think of a better example of copyright maximalism trumping free speech.").

<sup>144</sup> *Garcia v. Google, Inc.*, 771 F.3d 647, 647 (9th Cir. 2014).

<sup>145</sup> The *en banc* case was heard by Sidney R. Thomas, Chief Judge, and Judges Alex Kozinski, M. Margaret McKeown, Marsha S. Berzon, Johnnie B. Rawlinson, Richard R. Clifton, Consuelo M. Callahan, N. Randy Smith, Mary H. Murguia, Morgan Christen and Paul J. Watford. As of August 2018, there were 22 active judges on the Ninth Circuit, one of whom has been appointed by President Trump. *Active Judges of the United States Court of Appeals for the Ninth Circuit*, U.S. CTS. FOR NINTH CIR., [https://www.ca9.uscourts.gov/content/view\\_active\\_senior\\_judges.php](https://www.ca9.uscourts.gov/content/view_active_senior_judges.php) (last visited Sept. 22, 2018). Judge Kozinski resigned from the court in late 2017 and by April 2018 Judge Clifton had taken senior status, so that in late 2014, the court would have had slightly more than the present twenty-two active judges.

<sup>146</sup> *Garcia v. Google, Inc.*, 786 F.3d 733, 740 (9th Cir. 2015).

<sup>147</sup> *Id.* at 747.

own troubling analysis of the “fixation” issue. Judge McKeown reasoned that Garcia “never fixed her acting performance in a tangible medium of expression” because “[f]or better or for worse, Youssef and his crew ‘fixed’ Garcia’s performance in the tangible medium, whether in physical film or in digital form. However one might characterize Garcia’s performance, she played no role in fixation.”<sup>148</sup>

This portion of the opinion is worth discussion because it could easily be misconstrued by district courts and novice practitioners. Film directors also do not *themselves* fix their work; neither do the legal persons we call film studios. Fixation is literally done by camerapersons and cinematographers. A rapper who freestyles before a videographer he hired does not fail the fixation requirement because the rapper is busy rapping. The same holds true for any musician in a recording studio where the sound engineer behind the glass wall is controlling the recording equipment. Case law—none of it cited by the *Garcia III* decision—makes it abundantly clear that all this is done “by or under the authority of the author” as long as the person doing the recording is not interfering with the original expression of the director, performing artist, map designer, or chief programmer.<sup>149</sup>

Garcia knew her performance was being recorded and intended her performance to be recorded—which is the same as Diana Krall in a music studio recording *When I Look in Your Eyes* or Guillermo del Toro directing cinematographer Dan Laustsen to capture the shots he wants in *The Shape of Water*. We could salvage Judge McKeown’s comments here *if* we treat her conclusion as dependent on the fact that Garcia had been defrauded—Garcia never agreed to the fixation and the fixation could not be “under her authority.”

Judge McKeown added this point to the analysis,<sup>150</sup> but she clearly seemed to think that Garcia’s failure to meet the fixation requirement did not

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<sup>148</sup> *Id.* at 743–44.

<sup>149</sup> *Lindsay v. Wrecked & Abandoned Vessel R.M.S. Titanic*, No. 97 Civ. 9248 (HB), 1999 WL 816163, at \*5 (S.D.N.Y. Oct. 13, 1999) (“The fact that Lindsay did not literally perform the filming, i.e. by diving to the wreck and operating the cameras, will not defeat his claims of having ‘authored’ the illuminated footage.”); *Andrien v. S. Ocean Cty. Chamber of Commerce*, 927 F.2d 132, 134 (3d Cir. 1991); *Lakedreams v. Taylor*, 932 F.2d 1103, 1108 (5th Cir. 1991) (noting that authors may be entitled to copyright protection even if they do not “perform with their own hands the mechanical tasks of putting the material into the form distributed to the public”). *See also Medforms, Inc. v. Healthcare Mgmt. Sol’s, Inc.*, 290 F.3d 98, 108 (2d Cir. 2002) (noting that the programmer’s work was insufficiently original for authorship where he was told “specifically what to do and how to do it”); *JCW Invs., Inc. v. Novelty, Inc.*, 289 F. Supp. 2d 1023, 1032 (N.D. Ill. 2003), *aff’d*, 482 F.3d 910 (7th Cir. 2007); *Kyjen Co. v. Vo-Toys*, 223 F. Supp. 2d 1065, 1068–69 (C.D. Cal. 2002) (explaining that parties that translated sketches into toys are not co-authors); Hughes, *Right of Fixation*, *supra* note 53, at 415 (2015) (stating that the 1976 Act fixation requirement was preceded by a publication requirement in 1909, which definitely meant publication by third parties).

<sup>150</sup> *Garcia*, 786 F.3d at 744 (“On top of this, Garcia claims that she never agreed to the film’s ultimate rendition or how she was portrayed in *Innocence of Muslims*, so she can hardly argue that the film or her cameo in it was fixed ‘by or under [her] authority.’”).

depend on fraud.<sup>151</sup> Yet in a sensible copyright analysis, absent fraud or a similar exigent circumstance, when a performer agrees to have her performance recorded—whether she is a singer, dancer, or actor—we should consider that the fixation is made *under her authority*. In short, this part of the *en banc* majority opinion helped inspire Judge Watford to note, in concurrence, that “much of what the majority says about copyright law may be wrong.”<sup>152</sup>

The majority was on firmer ground in its discussion of the problematic determination of what a “work” would be for Garcia to succeed in her claim. On this question, the *Garcia en banc* majority opinion relies on a March 6, 2014 letter from the U.S. Copyright Office that “found that Garcia’s performance was not a copyrightable work.”<sup>153</sup> This is a fair characterization of the letter’s conclusions. Not surprisingly, the Copyright Office had said that “for copyright registration purposes, a motion picture is a single integrated work”<sup>154</sup> and that, assuming Garcia’s contribution was “limited to her acting performance,”<sup>155</sup> the office could not “register her performance apart from the motion picture.”<sup>156</sup>

That letter had also stated that “an actor . . . in a motion picture is either a joint author in the entire work or, as most often is the case, is not an author at all by virtue of a work made for hire agreement”; that “an actor’s . . . performance in the making of a motion picture is an integrated part of the resulting work, the motion picture as a whole”; and that “[i]f her contribution

<sup>151</sup> *Id.* The clause “[o]n top of this” indicates that the lack of fixation conclusion does not turn on Garcia “never agree[ing] to the film’s ultimate rendition or how she was portrayed.” *Id.* The opinion states elsewhere that it was not clearly erroneous for the district court to conclude Garcia impliedly licensed the use of the fixation (and, so, implicitly that Garcia agreed to the fixation itself). *Id.* at 743 n.12 (“[T]he district court found that Garcia granted Youssef a non-exclusive implied license to use her performance in the film. Although Garcia asked Youssef about *Desert Warrior*’s content, she in no way conditioned the use of her performance on Youssef’s representations. On this record, we cannot disturb the district court’s finding as clearly erroneous.”).

<sup>152</sup> *Id.* at 747 (Watford, J., concurring). Not surprisingly, others have discussed the weirdly wrong discussion of fixation in the *Garcia en banc* majority opinion. See Randal Picker, *Garcia v. Google (Again): Fixing Copyright?*, MEDIA INST. (June 5, 2015), <https://www.mediainstitute.org/2015/06/05/garcia-v-google-again-fixing-copyright/> (describing the *Garcia III* majority discussion of fixation as a “quagmire” and concluding “Garcia . . . only participated in the creation of a brief film clip . . . [T]he work associated with that clip would be fixed under Garcia’s authority.”); Sarah Howes, *Creative Equity: A Practical Approach to the Actor’s Copyright*, 42 MITCHELL HAMLINE L. REV. 70, 83 (2016) (criticizing the *Garcia III* interpretation of the “fixation” requirement).

<sup>153</sup> *Garcia III*, 786 F.3d at 752 (describing the Letter from Robert J. Kasunic, Associate Register of Copyrights & Dir. of Registration Policy & Practices, U.S. Copyright Office, to M. Cris Armenta, Counsel to Cindy Garcia (Mar. 6, 2014) [hereinafter Kasunic Letter]).

<sup>154</sup> *Id.* at 741 (quoting the Kasunic Letter). The Kasunic Letter was itself quoting Letter from Laura Lee Fischer, Chief of the Performing Arts Div. of the Registration Program at the U.S. Copyright Office, to M. Cris Armenta, Counsel to Cindy Garcia (Dec. 18, 2012).

<sup>155</sup> *Id.*

<sup>156</sup> *Id.*

was not as a work made for hire, she may assert a claim in joint authorship in the motion picture, but not sole authorship of her performance in a portion of the work.”<sup>157</sup> In short, the 2014 Copyright Office letter is consistent with the *Compendium* in assuming that an actor’s dramatic performance *can be original expression protectable by copyright once it is fixed in a tangible medium of expression*. Indeed, in oral argument, counsel for Google had agreed to that proposition,<sup>158</sup> arguing instead that “[t]here is no precedent, zero, for the idea that this, a five second performance is itself a separate copyrightable work.”<sup>159</sup> The problem for Garcia was that her original expression was inextricably intermingled with the expressive work of others—it never had an independent existence as its own work.

But in the *Garcia* majority opinion this sensible problem of what constitutes a “work” often seems mixed with—and overshadowed by—fear of an unmanageable system of copyright claims: “Garcia’s theory of copyright law would result in the legal morass we warned against in *Aalmuhammed*—splintering a movie into many different ‘works,’ even in the absence of an independent fixation. Simply put, as Google claimed, it ‘make[s] Swiss cheese of copyrights.’”<sup>160</sup> Recounting films with large casts of extras, the court warned that “[t]reating every acting performance as an independent work would not only be a logistical and financial nightmare, it would turn cast of thousands into . . . copyright of thousands.”<sup>161</sup> This fear of “cherry-picking” copyrights was also on display when the court cautioned that Garcia’s theory “would enable any contributor from a costume designer down to an extra or best boy to claim copyright in random bits and pieces of a unitary motion picture without satisfying the requirements of the Copyright Act.”<sup>162</sup> Part IV will further consider this problem.

But on the issue of where and how to draw the line on a “work,” the *Garcia* decision does point to something worth exploring. The court’s driving concern was about “splintering a movie into many different ‘works,’ even in the absence of an independent fixation.”<sup>163</sup> It is that last concept—“independent fixation” that deserves our attention.<sup>164</sup> As the court properly noted, in *Effects Associates v. Cohen*, the disputed special-effects footage had been “independently fixed” and no one disputed the plaintiff’s copyright

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<sup>157</sup> *Id.* at 752 (quoting the Kasunic Letter).

<sup>158</sup> Oral argument at 25:30, *Garcia III*, [https://www.ca9.uscourts.gov/media/view\\_video.php?pk\\_vid=0000006884](https://www.ca9.uscourts.gov/media/view_video.php?pk_vid=0000006884) (“The [AVP] treaty simply says performances can be copyrightable; we don’t disagree with that . . .”); *id.* at 25:37 (“We agree that a performer could have a copyrightable interest in a film. It is normally as a joint author.”).

<sup>159</sup> *Id.* at 24:55.

<sup>160</sup> *Garcia III*, 786 F.3d at 742.

<sup>161</sup> *Id.* at 743.

<sup>162</sup> *Id.* at 737.

<sup>163</sup> *Id.* at 742.

<sup>164</sup> *Id.*

over that footage.<sup>165</sup> The same is true of musical compositions and sound recordings used in film soundtracks as well as paintings, prints, sculptures, models, backdrops, and copyrightable costumes that appear on screen. As for the hairstylists mentioned in *Aalmuhammed*, hair styles are akin to tattoos<sup>166</sup>—they do have an independent existence, and with enough hair spray, are definitely fixed.<sup>167</sup> In short, films are already compendiums of independently fixed original expression and our intuitions and copyright metaphysics are comfortable understanding those things as “works.” Echoing the Copyright Office letter, the *Garcia en banc* majority correctly emphasized that “[w]e in no way foreclose copyright protection” for “standalone works that are separately fixed and incorporated into a film.”<sup>168</sup>

This raises one more issue in the case: instead of Garcia’s claim being over her *performance*, she could have more credibly claimed copyright in the particular take of her scene that was used in the *Innocence of Muslims*. Assuming Youssef did his filming in a fairly normal way, he, Garcia, and the film crew would have shot Garcia’s scene separately from others. At that moment, if all other production on *Innocence of Muslims* had stopped, no one would question that there was a bona fide copyright in the audiovisual scenes shot. At that moment, the filmed scene was a “standalone work that [was] separately fixed” as it awaited being “incorporated into a film . . . .”<sup>169</sup>

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<sup>165</sup> See *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 556 (9th Cir. 1990) (noting that enhancement of a film through special-effects required compensation to Effects Associates, the owner of the copyright).

<sup>166</sup> Warner Brothers quickly settled a lawsuit over its unauthorized reproduction and use in the film *Hangover II* of a tattoo by tattoo artist Victor Witmill. Verified Complaint for Injunctive & Other Relief, *Whitmill v. Warner Bros. Entertainment*, 4:11-cv-00752 (D. Mo. April 28, 2011). See also Noam Cohen, *On Tyson’s Face, It’s Art. On Film, a Legal Issue*, N.Y. TIMES (May 20, 2011), <https://www.nytimes.com/2011/05/21/business/media/21tattoo.html>; Matthew Belloni, *Warner Bros. Settles ‘Hangover II’ Tattoo Lawsuit*, HOLLYWOOD REPORTER (June 20, 2011, 1:39 PM), <https://www.hollywoodreporter.com/thr-esq/warner-bros-settles-hangover-ii-203377>.

<sup>167</sup> It would be hard to deny that some hairdos are sculptural works. See, for example, the “Martian Girl” or “Martian Madame” in *MARS ATTACKS!* (Warner Bros. 1996). *Mars Attacks! - Martian Girl*, YOUTUBE (June 7, 2007), <https://www.youtube.com/watch?v=XDAaTzccCik>.

<sup>168</sup> *Garcia III*, 786 F.3d at 744 n.13 (“The Copyright Office draws a distinction between acting performances like Garcia’s, which are intended to be an inseparable part of an integrated film, and standalone works that are separately fixed and incorporated into a film. We in no way foreclose copyright protection for the latter—any ‘discrete work in itself that is later incorporated into a motion picture,’ as the Copyright Office put it.”).

<sup>169</sup> In fact, this was the conclusion reached by the court regarding “raw footage” in *16 Casa Duse v. Merkin*, 791 F.3d 247, 259 (2d Cir. 2015). The appellate panel readily (and correctly) acknowledged that this raw film footage had its own copyright. *Id.* (citations omitted) (“[T]he film footage is subject to copyright protection. An original motion picture is surely a ‘work of authorship’ in which copyright protection ‘subsists’ under the Copyright Act. And ‘where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time.’ The unedited film footage at issue in this case seems to us to be an early version of the finished product, constituting the film ‘as of that time.’ Because ‘the Copyright Act [ ] affords protection to each work at the moment of its creation,’ copyright subsists even in such an unfinished work.”).

Of course, this would not have helped Garcia because Youssef and perhaps others would also have a claim of joint authorship to *that scene*. But we can imagine recorded dramatic scenes in which the sole original expression comes from the dramatic performance—in those cases, copyright in the recorded *scene* comes very close to being just a fixed *performance*. Part III.A will explore this further.

It is worth adding that if you believe that while there might have been a copyright in Garcia’s scene as a “standalone work[] that [was] separately fixed,”<sup>170</sup> but that copyright disappeared when the scene was integrated into the film, then by the same reasoning, does the copyright in all the individual “cells” painted for a classic animation like *Fantasia* (1940), *Spirited Away* (2001), or *The Iron Giant* (1999) disappear when the cells are integrated into the final film?

A few years out, the impact of the *en banc Garcia* decision on the question of actors-as-authors has been muted. For example, one copyright newsletter led off its discussion of the case saying “[a]n en banc panel of the Ninth Circuit affirmed the denial of injunctive relief because Garcia has no copyright in her acting performance,”<sup>171</sup> but then still advised that “performers may sometimes be joint authors of the entire work.”<sup>172</sup> There have certainly been some arguable decisions bolstered by language from *Garcia*, the most dramatic being the Second Circuit’s extraordinary conclusion in *16 Casa Duse v. Merkin* that the principal director of a film was not an author of that film.<sup>173</sup> Otherwise, courts seem to recognize both the unusual fact pattern of *Garcia* and the limited precedential value of its analysis.<sup>174</sup> To date, it looks like Judge Watford was correct that on these questions of copyright law, the court would have been better off “leaving the task of crafting broad new rules for a case in which it is actually necessary to do so.”<sup>175</sup>

But one lesson from the litigation bears repeating. In *Garcia v. Google*, one of the arguments that Google initially raised in its defense was that an actor’s performance could never rise to the level of authorship because the

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<sup>170</sup> *Garcia III*, 786 F.3d at 750 (alteration in original).

<sup>171</sup> Copyright Law Journal, Volume XXIX, No. 5 (Neil Boorstyn, ed.) (Sept.–Oct. 2015) at 52.

<sup>172</sup> *Id.* at 54.

<sup>173</sup> *16 Casa Duse*, 791 F.3d at 264.

<sup>174</sup> See, e.g., *Mallon v. Mitchell*, 224 F. Supp. 3d 97, 103 (D. Mass. 2016) (“Dr. Mallon cites [*Garcia III*] for its assertion that treating each iteration or edit of a complicated work as a separate copyrightable work would ‘make Swiss cheese of copyrights.’ This court appreciates the concerns raised in *Garcia*, but does not read those concerns to mean that the cheese can never be divided. Here, it is sliced into two logical portions.”); see also *Blizzard Entm’t, Inc. v. Lilith Games (Shanghai) Co. Ltd.*, No. 3:15-cv-04084-CRB, 2017 WL 2118342, at \*10 n.27 (N.D. Cal. May 16, 2017) (“*Garcia [III]* held an actress did not have a copyright interest in a five-second acting performance that was incorporated into a film . . . [and that] [a]lthough the case concerned a fleeting acting performance, *Garcia [III]*’s holding arguably denies copyright protection to any ‘inseparable contribution[] integrated into a single work.’”).

<sup>175</sup> *Garcia III*, 786 F.3d at 748 (Watford J., concurring).

actor works under a film director and “the creator of a work at another’s direction, without contributing intellectual modification, is not an author.”<sup>176</sup>

Early on, Google expressly argued that Garcia could not be an author because she “had no creative control over the script or her performance[.]”<sup>177</sup> in short, a theory that *dramatic performers are puppets on strings*.<sup>178</sup>

By the end of the litigation, this argument had disappeared: the Copyright Office letter, Google counsel in oral argument, and the *Garcia en banc* opinions (majority and dissent) all agreed that dramatic performances *can be original expression that make actors eligible to be authors of the works in which those performances are integrated*. The few commentators who have interpreted *Garcia III* as a complete repudiation of copyright interests in dramatic performances<sup>179</sup> are simply wrong.

#### D. *Views from the Ivory Tower*

Demonstrating that the interest of courts does impact the work of scholars<sup>180</sup> there has been relatively little scholarly commentary on the question of actors as authors. In the *Fleet v. CBS* litigation, CBS’s appellate brief claimed that “[a]ll commentators and case authority agree that an actors’ performance in a film has the requisite degree of artistic creativity to be a work protected by copyright law.”<sup>181</sup> But the supporting footnote to this claim referred to one passage in McCarthy’s right of publicity treatise and nothing more.<sup>182</sup>

The footnote citing McCarthy’s treatise states that “performance[s] from a script like a performance of a stage play from a script, are works of authorship under copyright law[.]” contrasting those with uncopyrightable

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<sup>176</sup> Google Inc. and YouTube, LLC’s Brief in Response to Suggestion of Rehearing En Banc at 29, *Garcia*, 786 F.3d 733 (9th Cir. 2015) (No. 12-57302) [hereinafter Brief in Response to Suggestion] (citation omitted); see also *Garcia v. Google, Inc.*, 766 F.3d 929, 934 (9th Cir. 2014), *dissolved by*, 786 F.3d 733 (9th Cir. 2015) (en banc) (“Google argues that Garcia didn’t make a protectible contribution to the film because Youssef wrote the dialogue she spoke, managed all aspects of the production and later dubbed over a portion of her scene.”).

<sup>177</sup> Brief in Response to Suggestion, *supra* note 176, at 28 (citation omitted).

<sup>178</sup> The phrase comes from an amici brief in the case jointly authored by the author. Balganeshe et al. Brief, *supra* note 65, at 7.

<sup>179</sup> See, e.g. Howes, *supra* note 152, at 76 (“[The] Ninth Circuit en banc panel said actors have no copyright interest in the films they make.”).

<sup>180</sup> The reverse may not be true. Adam Liptak, *When Rendering Decisions, Judges Are Finding Law Reviews Irrelevant*, N.Y. TIMES (Mar. 19, 2007), <http://www.nytimes.com/2007/03/19/us/19bar.html>; see also Richard A. Posner, *Against the Law Reviews*, LEGAL AFF. (Nov./Dec. 2004), [http://www.legalaffairs.org/issues/November-December-2004/review\\_posner\\_novdec04.msp](http://www.legalaffairs.org/issues/November-December-2004/review_posner_novdec04.msp) (describing law reviews as “a world where inexperienced editors make articles about the wrong topics worse”).

<sup>181</sup> Respondents’ Opening Brief at \*13–14, *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (Cal. Ct. App. July 1, 1996).

<sup>182</sup> *Id.* at n.21 (citing J. T. MCCARTHY, THE RIGHTS OF PUBLICITY, 11-77 to 11-78 (1995)).

athletic performances.<sup>183</sup> In his treatise on copyright law, Paul Goldstein believes “[a]t bottom, the question of copyright in sports events is the question whether copyright can attach to fixed but unscripted postures and movements.”<sup>184</sup> Formulated that way, Goldstein concludes that “the better result . . . is to hold that the movements of players on the field, if original, constitute copyrightable expression.”<sup>185</sup> Goldstein is certainly right that we would consider the unscripted postures and movements of a dancer or a performance artist to be copyrightable, but there is still disagreement on whether an athlete who runs to catch a ball lodged deep into right field is “expressing.”

David Nimmer agrees that “Congress intended to include within the realm of protectable subject matter innumerable performances of many sorts,”<sup>186</sup> but, in the shadow of the *Garcia* decision, he also concludes that “it makes no sense to invoke an additional category of protection, namely *performance*.”<sup>187</sup> For Nimmer, “performances should not be written out of the firmament as legitimate components of copyrightable expression,” but “performances should be recognized as subject to copyright only as part of a separate categor[y] of protection, such as motion pictures or sound recordings.”<sup>188</sup> Nimmer concludes that the *en banc* majority in *Garcia* correctly “recognized a performance as being an element of works potentially subject to copyright protection, but not as a stand-alone category that itself deserves recognition.”<sup>189</sup>

All in all, there is very little separating these perspectives. If there is a contrast between Nimmer’s position and that in the Goldstein and McCarthy treatises, it seems to stem from not imagining the simplest case of all: one where the *only* protectable expression in an audiovisual work is the *dramatic performance*. Part III.A presents a thought experiment of this sort. In such a case, copyright protection of the audiovisual work essentially boils down to copyright protection of the dramatic performance, just as copyright protection of a sound recording that has not been subject to sound engineering essentially boils down to copyright protection of the musical performance.

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<sup>183</sup> *Id.* (internal quotation marks omitted) (“[B]y comparison, ‘a live prize fight, baseball game, horse race or Olympic competition’ are unpredictable and not performed from a script, and thus are not copyrightable; baseball players’ performance and performance of a human cannon ball are events that do not have the requisite degree of creativity to be protected under copyright[.]”).

<sup>184</sup> PAUL GOLDSTEIN, *GOLDSTEIN ON COPYRIGHT* § 2.12.1, at 2:142 (3d ed. 2018).

<sup>185</sup> *Id.*

<sup>186</sup> NIMMER ON COPYRIGHT § 2.12(B)(2), at 2-174.1 (2018).

<sup>187</sup> *Id.*

<sup>188</sup> *Id.* at § 2.12(B)(4), at 2-181.

<sup>189</sup> *Id.* at § 2.12(B)(3), at 2-178.

### III. A STRAIGHTFORWARD ORIGINALITY ANALYSIS

In 1998, Judi Dench won the Academy Award for Best Supporting Actress for her eight-minute performance as Queen Elizabeth I in *Shakespeare in Love*.<sup>190</sup> Twenty-two years earlier—in 1966—Beatrice Straight won the Oscar for Best Supporting Actress for an even shorter (six-minute) performance in *Network*.<sup>191</sup> In 2009, Viola Davis was nominated in the same category for a stunning single scene in the film *Doubt*.<sup>192</sup> By one of Google’s early theories in the *Garcia* litigation, these performances cannot be “original expression” because the actor worked “at another’s direction, without contributing intellectual modification.”<sup>193</sup> This “puppets-on-strings” theory of dramatic acting should strike the copyright-conversant reader as wildly contrary to American copyright law’s fundamental principles.

Despite the occasional *sturm und drang* about “Romantic” authorship from legal scholars, American law has historically been characterized by a very low originality threshold for copyright protection.<sup>194</sup> In 1991, a unanimous Supreme Court in *Feist* reminded us that the requisite level of creativity for original expression is “extremely low; even a slight amount will suffice.”<sup>195</sup> But at the other end of the twentieth century, Justice Holmes has already given us the formulation that should govern whether dramatic

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<sup>190</sup> Adam B. Vary, *Should Judi Dench Keep Her ‘Shakespeare in Love’ Oscar?*, ENT. WKLY. (Dec. 29, 2008 12:00 PM), <http://ew.com/article/2008/12/29/recall-98spactr/>.

<sup>191</sup> *Id.*

<sup>192</sup> Kate Kellaway, *Mother Superior*, GUARDIAN (Jan. 3, 2009), <http://www.theguardian.com/film/2009/jan/04/doubt-viola-davis> (“Davis is only on screen for 11 minutes but to watch her is to understand an entire life. It is an [a]bject lesson in what an actor can convey in a short space of time. She seems to carry her family history in her face: the violence at home and her unswerving love for her child. And she looks dowdily embattled but unassailable in her shabby fawn overcoat . . . . It is no surprise that she has already been nominated for a Golden Globe as best supporting actress and is tipped to win an Oscar.”); Rudie Obias, *12 Actors Who Earned Oscar Nods for Less Than 20 Minutes of Screen Time*, MENTAL FLOSS (Jan. 16, 2016), <http://mentalfloss.com/article/73865/12-actors-who-earned-oscar-nods-less-20-minutes-screen-time> (“[E]stimates range from five to eight minutes, but Davis made the most of every second, decimating the screen as the mother of a young boy who may or may not have been molested. She managed to hold her own opposite Meryl Streep (who earned a Best Actress nod for the role) and competed against her *Doubt* co-star Amy Adams for Best Supporting Actress in 2009.”).

<sup>193</sup> Brief in Response to Suggestion, *supra* note 176, at 29 (citation omitted).

<sup>194</sup> See, e.g., Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of Authorship*, 41 DUKE L.J. 455 (1991); James Boyle, *A Theory of Law and Information: Copyright, Spleens, Blackmail and Insider Trading*, 80 CAL. L. REV. 1413, 1527 (1992) (“The values of romantic authorship seem to seep—consciously or unconsciously—into economic analysis. And because in most conflicts the paradigm of authorship tends to fit one side better than the other, this romantic grounding provides economic analysis with at least the illusion of certainty. Authors tend to win.”). For an analysis and response to some of the claims made about the pervasiveness of the “Romantic author” idea, see generally Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81 (1998).

<sup>195</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

performances can be copyrightable original expression: “Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man’s alone. That something he may copyright unless there is a restriction in the words of the act.”<sup>196</sup>

When Holmes wrote these words, we were just crossing the technological frontier into a world in which dramatic performances could be fixed in a tangible medium of expression—the Lumiere Brothers and Thomas Edison had debuted their respective “moving pictures” technologies only a few years before. Now that the fixation of dramatic performances is a familiar element of life, any “puppet-on-strings” view of acting necessarily says that while Holmes may have thought *handwriting* was an act of individual expression that could attract copyright protection (and we have no case law disagreeing), dramatic acting is not.

This is not to deny that *some* dramatic performances may be so *de minimis* that they do not cross a minimal threshold for the *amount* of original expression.<sup>197</sup> Nor is this to deny that some “acting” may be so mechanical or robotic as to lack original expression. But our general presumption should be that a dramatic performance is the personal, original expression of the actor, so when the performance is fixed in a tangible medium it is a proper subject of copyright protection.

Does this simple formulation get us into the problem that seemed to vex so many in *Garcia v. Google*? Does it make a “performance” into a “work”? No—or, not necessarily. And when it does, that should not be troubling. The problem is best explored with thought experiments that will hopefully increase our confidence about dramatic performances as copyrightable original expression.

#### A. *Some Thought Experiments*

As inspiring as the “The Star-Spangled Banner” is, when it comes to odes to a nation and all it might represent, “America the Beautiful” is a near-perfect song. As a musical composition, “America the Beautiful” has an unusual history. The melody was composed by Samuel A. Ward as a hymn

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<sup>196</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903).

<sup>197</sup> As Benjamin Kaplan wrote in his classic exposition on copyright: “[T]o make the copyright turnstile revolve, the author should have to deposit more than a penny in the box.” BENJAMIN KAPLAN, *AN UNHURRIED VIEW OF COPYRIGHT* 46 (1967); *see also* COMPENDIUM, *supra* note 60, at § 313.4(C) (noting single words and short textual phrases are not copyrightable), § 802.5(B) (“[S]hort musical phrases are not copyrightable because they lack a sufficient amount of authorship.”), and § 803.5(B) (“Short sound recordings may lack a sufficient amount of authorship to be copyrightable.”); Justin Hughes, *Size Matters (or Should) in Copyright Law*, 74 *FORDHAM L. REV.* 575, 577 (2005) (explaining that generally “American courts have denied blatant claims that very small pieces of copyrightable material merit independent protection.”)

in 1882; that hymn was not published until a decade later in 1892.<sup>198</sup> The lyrics were composed by Katherine Lee Bates as a poem entitled “Pike’s Peak” and first published in 1895.<sup>199</sup> The two were first combined and published as “America the Beautiful” in 1910, seven years after Ward’s death.<sup>200</sup> From all these dates, the musical composition is obviously in the public domain.

Among the hundreds of millions of people who have sung “America the Beautiful” at one time or another, some have authorized that their performances be fixed in tangible mediums of expression. These sound recordings of “America the Beautiful” include renditions by Jim Brickman, Mariah Carey, Aretha Franklin, Whitney Houston, Royce Montgomery, Mickey Newbury, Elvis Presley, Charlie Rich, and the Mormon Tabernacle Choir.<sup>201</sup> My personal favorites are Ray Charles’ many gorgeous recordings of the song. These sound recordings are all the more stunning because the *visual* tableau of Bates’ lyrics is brought to life by an artist who had been blind since the age of seven.

Among the different occasions when Charles performed “America the Beautiful” (and it was recorded with his authorization) Charles had different accompaniments, ranging from a handful of gospel singers to a full orchestra with French horns and violins. But let’s consider a sound recording in which he sings solo, plays the piano, and is accompanied only by a snare drum keeping time. Let’s also stipulate that the recording is done with minimal sound engineering.

Does Ray Charles’ performance on that sound recording—fixed with his authorization in a tangible medium of expression—embody sufficient originality to be protected by copyright? Is it “original expression” that crosses the “modicum of creativity” frontier? These are intended as rhetorical questions: a reader who thinks the answer is “no” will not be interested in the rest of this article.

By eliminating all accompaniment but the snare drum and minimizing sound engineering, almost any originality or creativity we believe is in this sound recording *is from* Ray Charles. In these circumstances, there is no question that Congress intended that the performing artist could obtain a copyright in the sound recording and such copyright would, in effect, be a copyright in the performance. The House Report accompanying the 1976 Act recognizes that there will be cases where the record producer’s contribution is so minimal that the performance is the only copyrightable

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<sup>198</sup> LYNN SHERR, AMERICA THE BEAUTIFUL 48–52 (2001).

<sup>199</sup> *Id.* at 56.

<sup>200</sup> *Id.* at 59.

<sup>201</sup> A quick search of “America the Beautiful” on YouTube will provide recordings of the song by a myriad of artists, including those listed above. YOUTUBE, [https://www.youtube.com/results?search\\_query=america+the+beautiful](https://www.youtube.com/results?search_query=america+the+beautiful) (last visited Jan. 2, 2019).

element in the work, and there may be cases—for example, recordings of birdcalls, sounds of racing cars, etc.—where only the record producer’s contribution is copyrightable.<sup>202</sup>

It would be hard to have clearer legislative history than this: the House Report says that protectable elements of a sound recording include the contribution “of the performers whose performance is captured”<sup>203</sup> and that there will be “cases where . . . the performance is the only copyrightable element in the work.”<sup>204</sup> It is hard to avoid the conclusion that in these situations, Congress recognized that *de facto* the recorded performance would be the protected work. And we should keep in mind that according to the legislative history, “sound recordings” include non-musical performances like “[a]n actor’s recorded recitation of a poem”<sup>205</sup> or “a theatrical company’s recorded performance of a comedy.”<sup>206</sup>

Now we move from the audio recording of an actor’s recitation of a poem to the realm of audiovisual works. Imagine that an admired actor—Morgan Freeman, Ian McKellen, or J.K. Simmons<sup>207</sup>—does a Shakespearean soliloquy, i.e. a public domain work that is central to the Anglo-American repertoire in the same way that “America the Beautiful” is central to the American songbook. Let’s stipulate that the actor performs the soliloquy on an absolutely plain set—or in front of a “green screen”<sup>208</sup> which the actor himself set up—with simple lighting and in front of a camera<sup>209</sup> on a tripod. Let’s further stipulate that the actor himself activates the video camera on the tripod. In other words, we are minimizing any other creative inputs the same as we did with Ray Charles’ solo rendition of “America the Beautiful.”

<sup>202</sup> Copyright Act of 1976, H.R. 94-1476, 94th Cong. at 56 (1976), available at [https://www.copyright.gov/history/law/clrev\\_94-1476.pdf](https://www.copyright.gov/history/law/clrev_94-1476.pdf)

<sup>203</sup> *Id.*

<sup>204</sup> *Id.*

<sup>205</sup> GOLDSTEIN, *supra* note 184, §2.13, at 2:148.

<sup>206</sup> *Id.*

<sup>207</sup> Insert your own favored performer here. My extended list would include Viola Davis, Armie Hammer, Michael Peña, Chris Pine, Tilda Swinton, etc.

<sup>208</sup> “Chromakeying” is setting up a consistent, single color backdrop, typically bright green (for television) or blue (for feature films) and “keying” out that color so it does not register in the recording device; this allows one to substitute any background one wishes (or no background at all). Chuck Peters, *How Does Green Screen Work?*, VIDEOMAKER (Dec. 25, 2013), <https://www.videomaker.com/article/c10/17026-how-does-green-screen-work>.

<sup>209</sup> It might even be simply an iPhone. The indie film TANGERINE (Magnolia Pictures 2015) was shot entirely on an iPhone 5S. Nigel M. Smith, *Tangerine Is a Big Deal, Not Just Because It Was Shot on an iPhone*, GUARDIAN (July 10, 2015, 4:49 PM), <https://www.theguardian.com/film/2015/jul/10/tangerine-film-iphone-buddy-comedy-transgender-prostitutes>; Ramin Setoodeh, *Sundance Premieres Sophisticated ‘Tangerine,’ Shot on iPhone 5s*, VARIETY (Jan. 23, 2015, 6:52 PM), <http://variety.com/2015/film/news/sundance-premieres-sophisticated-tangerine-shot-on-iphone-5s-1201413692/>.

It is not hard to imagine that a recorded performance of a soliloquy from *Hamlet* or *Macbeth* would be dramatic and impressive if done this way by an accomplished actor. And it is not hard to imagine that each actor would perform it in a substantially different way: indeed, that is the originality/creativity we would experience in their respective performances. If Justice Holmes was correct that “[p]ersonality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man’s alone,”<sup>210</sup> then it is very hard to see how dramatic performances would *not* be a legitimate basis for copyright protection: the personal expression of a dramatic performance is “something [a person] may copyright unless there is a restriction in the words of the act.”<sup>211</sup> And there are no such restrictions in the Copyright Act.

As Jane Ginsburg has noted, “[i]f the performer of sounds produces the ‘copyrightable elements’ comprised within a sound recording, it is hard to see why the performer of both sounds and physical gestures does not supply ‘copyrightable elements’ in an audiovisual work.”<sup>212</sup> But the reason for working through the subject this way is that normally, as Ginsburg observes, “separating an actor’s performance from the rest of the film seems an artificial exercise.”<sup>213</sup> Imagining an actor’s performance as separate from an audiovisual work seems quite artificial compared to *hearing* an Aretha Franklin or David Bowie sound recording as Aretha Franklin or David Bowie, even though we know that those sound recordings typically involved other musicians, backup singers, sound engineers, technicians and producers. We can feel that we are hearing a *single musician* even when we know that, as Robert Brauneis says, our sound recordings are not “transparent recordings of real-time performances,”<sup>214</sup> but “carefully constructed fictional audio experiences.”<sup>215</sup> The same does not hold for our audiovisual experiences—hence the need for a reductionist thought experiment that eliminates the other potential sources of original expression.

Staying with that thought experiment, would anyone say that the § 102 “audiovisual work” that is a recording of the actor’s performance does *not* have a copyright because it didn’t have a traditional director, cinematographer, or set designer? Would we say that this audiovisual work does *not* have a copyright because the “script” was in the public domain? Clearly not: this minimalist audiovisual work of an actor performing a public

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<sup>210</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903).

<sup>211</sup> *Id.*

<sup>212</sup> Ginsburg, *supra* note 110.

<sup>213</sup> *Id.*

<sup>214</sup> Robert Brauneis, *Musical Work Copyright for the Era of Digital Sound Technology: Looking Beyond Composition and Performance*, 17 TUL. J. TECH. & INTELL. PROP. 1, 24–25 (2014).

<sup>215</sup> *Id.* at 18. For an example, in 2017, long-time Bowie collaborator Tony Visconti released a remixed/remastered—and quite different sounding—version of Bowie’s 1979 *Lodger*. DAVID BOWIE, *LODGER* (Tony Visconti Mix 2017).

domain work *is* capable of having copyright protection solely on the basis that the actor's performance has that magical, but egalitarian "modicum of creativity."

At this juncture, we should change the public domain script into an original, copyrighted script. Does the new presence of the screenwriter's original expression eliminate any original expression from the dramatic performer? It is hard to imagine the theory on which this happens. In fact, that is the nature of copyright in "cover" sound recordings when a musician performs a musical composition composed by someone else. Meshell Ndegeocello's copyright in her 2018 sound recording of "Sometimes It Snows in April"<sup>216</sup> is as secure as her copyright in her 1993 sound recording of "If That's Your Boyfriend (He Wasn't Last Night),"<sup>217</sup> although Prince composed the former while Ndegeocello composed the latter.

If we add a cinematographer and a lighting director to our minimalist audiovisual work, the right questions are *if* and *how* are these roles different in terms of *original expressive contribution* from what a sound engineer or a "mixer" add to a sound recording? We do not think that because Elvis Presley had the legendary sound engineer Bill Porter work on the sound recording of "Return to Sender" that Presley's original expression in the sound recording is compromised.<sup>218</sup>

One role we have not yet added is the "director"—and one could argue whether or not music "producers" are a standard counterpart in the world of sound recordings. A film or television director "is the person primarily responsible for supervising the creation of a film or television program"<sup>219</sup> and "the chief on-set decision maker"<sup>220</sup> whose "function is to contribute to all of the creative elements of a film and to participate in molding and integrating them into one cohesive dramatic and aesthetic whole."<sup>221</sup> Now the question we asked before might have some traction: does the presence of a director for the audiovisual work *eliminate* any original expression from the actor? Google's puppets-on-strings view of dramatic performances early in the *Garcia* litigation said "yes."

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<sup>216</sup> MESHHELL NDEGEOCELLO, *Sometimes it Snows in April*, on VENTRILOQUISM (Naïve 2018).

<sup>217</sup> MESHHELL NDEGEOCELLO, *If That's Your Boyfriend (He Wasn't Last Night)*, on PLANTATION LULLABIES (Maverick Records 1993).

<sup>218</sup> Larry Blakely, *Bill Porter: Engineering Elvis*, MIX, Aug./Sept. 1982, at 38, available at [https://s3.amazonaws.com/nb-mixonline/files/bill\\_porter\\_small.pdf](https://s3.amazonaws.com/nb-mixonline/files/bill_porter_small.pdf).

<sup>219</sup> MARK LITWAK, *DEALMAKING IN THE FILM & TELEVISION INDUSTRY: FROM NEGOTIATIONS TO FINAL CONTRACTS* 146 (4th ed. 2016).

<sup>220</sup> DINA APPLETON AND DANIEL YANKELEVITS, *HOLLYWOOD DEALMAKING: NEGOTIATING TALENT AGREEMENTS FOR FILM, TV AND NEW MEDIA* 107 (2010).

<sup>221</sup> DIRECTORS GUILD OF AMERICA, *Basic Agreement of 2014* § 7-101, <https://www.dga.org/Contracts/Creative-Rights/Basic-Agreement-Article-7.aspx> (last visited Sept. 23, 2018).

Of course, there are audiovisual works in which the dramatic performances *are* puppets on strings—the marionettes in *Team America: World Police* (2004),<sup>222</sup> directed by Trey Parker, and the 1960s *Thunderbirds* television series that directly inspired it.<sup>223</sup> We can imagine a not too distant future in which the marionettes are replaced by programmable androids: when the director doesn't get exactly the effect she wants, she can have the androids reprogrammed to deliver just the right wink of an eye, just the right curl to a smile, just the right stride across the room. More likely—and we are partially there now<sup>224</sup>—the director can employ digital avatars, i.e. CGI “actors.” In all these examples, the director might have substantially *more* control over the final outcomes, the final original expression as a whole.

But no director has complete control over *human* actors, whether they are acting in front of the camera, only lending their voices to CGI-created cartoon characters, or merely operating marionettes. And as we will see, within the realm of what a director can theoretically control, many directors cede substantial leeway to actors.

#### B. *Views Within the Acting Community*

Certainly, the acting community seems to *believe* that actors engage in a creative process, using the same terminology to describe what they do as writers and painters use to describe what they do. A classic text on acting, Uta Hagen's *A Challenge for the Actor*, speaks of an actor as someone with a “need to express”<sup>225</sup> and “a passion for self-expression,”<sup>226</sup> someone who is intent “to produce a work of art”<sup>227</sup> and does so in a “creative process”<sup>228</sup> by “revealing the myriad facets that spring from [her] own soul and imagination.”<sup>229</sup> Hagen calls her own method-based approach to acting “realism” and describes it as executing a series of actions that “involve a

<sup>222</sup> TEAM AMERICA: WORLD POLICE (Scott Rudin Productions, Braniff Productions 2004).

<sup>223</sup> *Thunderbirds* (AP Films 1965–1966).

<sup>224</sup> Gregory Elwood, *Motion Capture and Visual Effects Bring Back Tarkin for 'Rogue One,'* L.A. TIMES (Feb. 14, 2017 4:00 AM), <http://www.latimes.com/entertainment/envelope/la-en-mn-grand-moff-tarkin-rogue-one-20170214-story.html> (“[A] major [*Star Wars*] character . . . would be appearing on screen for the first time since the actor who portrayed him passed away over 20 years ago. Through visual effects wizardry and a live-action performance by actor Guy Henry, the commander of the first Death Star in 1977's [*Star Wars*], Grand Moff Tarkin, was brought back to the big screen as though the late Peter Cushing was still portraying him.”); Kristopher Tapley & Peter Debruge, *'Rogue One': What Peter Cushing's Digital Resurrection Means for the Industry*, VARIETY (Dec. 16, 2016, 4:07 PM), <https://variety.com/2016/film/news/rogue-one-peter-cushing-digital-resurrection-cgi-1201943759/#!> (describing difficult questions raised by “photoreal people”).

<sup>225</sup> UTA HAGEN, *A CHALLENGE FOR THE ACTOR* xiii (1991).

<sup>226</sup> *Id.* at 35.

<sup>227</sup> *Id.* at 50.

<sup>228</sup> *Id.* at 83.

<sup>229</sup> *Id.* at 58.

moment-to-moment *subjective* experience,”<sup>230</sup> “weav[ing]” personal realities “imaginatively into the circumstances of the character’s past life.”<sup>231</sup>

Laurette Taylor, a silent film star, described acting as “the physical representation of a mental picture and the projection of an emotional concept”<sup>232</sup> and twenty-first century actor Tom Hiddleston offers that “[a]ctors in any capacity, artists of any stripe, are inspired by their curiosity, by their desire to explore all quarters of life.”<sup>233</sup> Dana Ivey describes her acting process in words that could be used by a novelist or playwright:

All creative people use whatever is going on in their lives in what they are creating at that moment whether they are aware of it or not. I’m not proud I use any resource that comes along. I’ll copy people. I’ll remember something I had for breakfast that gives me a thought. You never know when the “Aha!” experience is going to strike and you’re going to say “Oh, yes! That’s the way to make that work!”<sup>234</sup>

After conducting a series of interviews with stage and film actors in the 1990s, Janet Sonenberg concluded that acting “relies in part upon the creative application of the unconscious mind [and] cannot be fully explained,”<sup>235</sup> that “[a]ll the actors strive to release the daring of their fundamental creativity,”<sup>236</sup> and that her interviewees expressed “similar ideas” to Albert Rothenberg’s theory of creativity in the 1994 book *Creativity and Madness*.<sup>237</sup>

Of course, there is an alternative vision that sees acting simply as recitation or “recitation+”: recitation with authenticity, recitation with sincerity, and other combinations. The director and playwright David Mamet

<sup>230</sup> *Id.* at 42 (emphasis in the original).

<sup>231</sup> *Id.* at 64. Hagen also describes actors she admires in “genius” terms and as “artists.” *Id.* at 123, 153 (“Their genius manifested itself in the utter spontaneity and unpredictability of their actions . . . . All artists, whether they are writers, painters, sculptors, musicians, dancers, or actors, share the fervent hope that their work will communicate, that it will be understood.”).

<sup>232</sup> Garff B. Wilson, *Levels of Achievement in Acting*, 3 *EDUC. THEATRE J.* 230, 231 (1951).

<sup>233</sup> Tom Hiddleston, *Superheroes Movies Like Avengers Assemble Should Not be Scorned*, *GUARDIAN: FILM BLOG* (Apr. 19, 2012), <http://www.guardian.co.uk/film/filmblog/2012/apr/19/avengers-assemble-tom-hiddleston-superhero>.

<sup>234</sup> Interview with Dana Ivey, in JANET SONENBERG, *THE ACTOR SPEAKS* 293 (1993).

<sup>235</sup> *Id.* at 1 (“[A]nything that relies in part upon the creative application of the unconscious mind cannot be fully explained. Acting partakes of the great mysteries when the actor lends her unconscious to the creative act. But the actor who has created a great performance is not working solely with unconscious creative inspiration, the stuff of ‘magic.’ She is using acting techniques and inspiration to ply her talent . . . .”).

<sup>236</sup> *Id.* at 10. Sonenberg also describes acting as an exercise of “creative intelligence.” *Id.* at 12.

<sup>237</sup> ALBERT ROTHENBERG, *CREATIVITY AND MADNESS: NEW FINDINGS AND OLD STEREOTYPES* (1994).

seems to be a proponent of this vision of acting,<sup>238</sup> although it is hard to separate his views on acting from his disdain for acting coaches and acting schools.<sup>239</sup> Actors sometimes make statements in this vein,<sup>240</sup> although even naysayers on actor creativity make statements hinting that copyright's low threshold of originality is crossed. For example, Declan Donnellan urges actors that "[i]n a way, creativity and originality are none of our business,"<sup>241</sup> but does so with an almost Holmesian faith in the uniqueness of the individual actor: "Every actor who plays Juliet will see through a different pair of eyes, because each actor is a different and unique human being . . . . Whenever we try to be original, it is evidence that we have lost confidence in our uniqueness."<sup>242</sup> Even actors who intensely research their roles for verisimilitude<sup>243</sup> do not seem to be doing anything different in terms of inputs to the creative process than the research of historical novelists or Disney Imagineers.

Recall Google's early argument in the *Garcia* litigation that an actor is a "creator of a work at another's direction, without contributing intellectual modification, [and, therefore,] is not an author."<sup>244</sup> Reasonably understood, this presents a zero-sum game of artistic contribution in which the film director has all and the actor has zero. While not a zero-sum game, there is unquestionably a trade-off between the director's artistic control and

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<sup>238</sup> See generally DAVID MAMET, TRUE AND FALSE: HERESY AND COMMON SENSE FOR THE ACTOR (1997).

<sup>239</sup> *Id.* at 6 ("The Stanislavsky 'Method,' and the technique of the schools derived from it, is nonsense. It is not a technique out of the practice of which one develops a skill—it is a cult."); *id.* at 43 ("Let me be impolite: most teachers of acting are frauds, and their schools offer nothing other than the right to consider oneself part of the theatre.").

<sup>240</sup> See, e.g., Gary Goldstein, *Movie Dads to be Proud of*, L.A. TIMES, Jan. 4, 2018, at S22 (quoting Michael Stuhlbarg describing his amazing talk in the film *Call Me By Your Name* by saying, "I just tried to utilize what I was given in our beautiful script [credited to James Ivory] and marry that with the natural chemistry and affection that was building with my fellow actors"); Interview with Zoe Caldwell, in SONENBERG, *supra* note 234, at 163 ("Actors, then, are the instrument through which the playwright can speak to the audience. I don't think any good actor analyzes the text for the structure of each scene. We are the channel, the vessel, and that can be a pretty holy thing, but we are not the creators. So, I obey the punctuation because that is what the playwright heard.").

<sup>241</sup> DECLAN DONNELLAN, THE ACTOR AND THE TARGET 229 (2005).

<sup>242</sup> *Id.* at 229–30.

<sup>243</sup> See, e.g., Gary Goldstein, *To "Breathe" Again*, L.A. TIMES, Nov. 30, 2017, at S8 (describing Andrew Garfield's efforts to study speech patterns of polio survivor Robin Cavendish); Josh Rottenberg, *One Actor, Two Heroes*, L.A. TIMES, Oct. 22, 2017, at E1, E6 (describing how, for a film on a legendary firefighting team, actor Miles Teller "underwent a grueling wild-land firefighting boot camp along with his co-stars"); Gary Goldstein, *A New Way to Play George VI*, L.A. TIMES, Dec. 14, 2017, at S30 (describing actor Ben Mendelsohn listening to archival recordings of George VI and using a speech consultant for the King's speech impediment); HAGEN, *supra* note 225, at 48 (describing an actor whose "background work occasionally went so far as going to live for weeks with families in the neighborhood where his character might have lived in order to absorb, subjectively, the daily habits, the very atmosphere of his character's previous life").

<sup>244</sup> Brief in Response to Suggestion, *supra* note 176, at 29 (citation omitted).

expression and the creative expression of the actor. And the relationship is complex. Addressing the director, Hagen writes “[i]f you believe your own [interpretation of a role] is definitive or the only one, you are not only wrong, but you will stultify the actor’s imagination and rob him of creative freedom.”<sup>245</sup> For actor and director Andy Serkis, it is the director’s “prerogative to shift the performance to shape the narrative and tone, but the skill is to do that without in any way fettering what actors want to do.”<sup>246</sup>

Indeed, the balance between the director and the actor is itself downstream from the trade-off between the scriptwriter and the director. In a scripted motion picture, the script constrains the director and both script and direction—that is, the *director*—constrain the actors. So if we believe that the director can bring “authorial” originality to the final recorded performance despite the script, it is not clear how we could say the actor cannot also bring “authorial” originality to the final recorded performance despite the script and the direction. As Richard Arnold puts it, “[t]he wider the margin of appreciation left by the text, the more likely it is that the director will qualify as an author. The more dictatorial the director, the less likely it is that the actors will qualify as authors.”<sup>247</sup> In short, as long as an actor is *not* a mechanical or digital amanuensis for the director, there is space for the original expression that American copyright law protects.

So what can we say on the bedrock question of whether the actor *is* merely an amanuensis for the director and the screenwriter? Is the actor just “the creator of a work at another’s direction,” or someone who contributes intellectual, emotional, or expressive “modification”?<sup>248</sup> Initially, we should put to one side a couple of distinct fact patterns.

First, there are many situations in which it is inaccurate to say that the actor “had no creative control over the script.”<sup>249</sup> After they are cast, actors can have considerable impact on a script, whether it is Lily Tomlin in *9 to 5* (1980),<sup>250</sup> John Turturro in *Barton Fink*<sup>251</sup> and *Jungle Fever*<sup>252</sup> (both 1991), or Daniel-Day Lewis in *Phantom Thread* (2017).<sup>253</sup>

<sup>245</sup> HAGEN, *supra* note 225, at 294.

<sup>246</sup> Rande Dawn, *They Can Write, They Can Act, But Can They Direct?*, L.A. TIMES, Nov. 30, 2017, at S32.

<sup>247</sup> RICHARD ARNOLD, PERFORMERS’ RIGHTS § 10.16, at 284–85 (4th ed. 2008).

<sup>248</sup> Brief in Response to Suggestion, *supra* note 176, at 29.

<sup>249</sup> *Id.* at 28.

<sup>250</sup> Interview with Lily Tomlin, in SONENBERG, *supra* note 234, at 233 (noting that Tomlin’s influence over her character’s story led to the addition of three related on-screen characters).

<sup>251</sup> Interview with John Turturro, in SONENBERG, *supra* note 234, at 38 (“In the course of that time together [with Ethan and Joel Coen], I suggested a couple of structural changes . . . . They went for that . . . . Once I started to do it, Joel told me that he liked that I made him much more human so that he was that much more horrible.”).

<sup>252</sup> *Id.* at 41.

<sup>253</sup> Mark Olsen, *Paul Thomas Anderson and Collaborators Unravel the Mysteries of ‘Phantom Thread,’* L.A. TIMES, Dec. 21, 2017, <http://www.latimes.com/entertainment/movies/la-ca-mn-phantom->

Second, even after the script is “complete,” there may be scenes in which the actors are invited to, expected to, or simply take it upon themselves to *ad-lib*—and that original expression is kept in the final film. Actor ad-libbing includes: Bogart’s “Here’s looking at you, kid” in *Casablanca* (1942);<sup>254</sup> Orson Welles’ take on European history in *The Third Man* (1949);<sup>255</sup> Robert de Niro’s entire “Are you talkin’ to me?” scene in *Taxi Driver* (1976);<sup>256</sup> John Belushi’s cafeteria scene in *Animal House* (1978);<sup>257</sup> eighteen minutes of Marlon Brando’s dialogue as Colonel Kurtz in *Apocalypse Now* (1979);<sup>258</sup> the “What do you mean funny?” restaurant scene in *Goodfellas* (1990);<sup>259</sup> and much of the dialogue in *The Little Hours* (2017).<sup>260</sup> We can add to this list some of Bill Murray’s lines in *Ghostbusters* (1984);<sup>261</sup> Whoopi Goldberg’s lines in *Ghost* (1990);<sup>262</sup> Denzel Washington’s lines in *Malcolm X* (1992);<sup>263</sup> and Jack Nicholson’s lines in *A Few Good Men* (1992).<sup>264</sup> The director of *Thor: Ragnarok* (2017) claims the entire film was “80% improvised.”<sup>265</sup>

In situations in which actors *ad-lib* or largely *ad-lib* their performance, the initial fixation of the dialogue constitutes the initial fixation of what we think of as the “script” in the same way that an authorized recording of a

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thread-paul-thomas-anderson-20171221-story.html (describing Daniel-Day Lewis’ extensive influence in the development of the script for *Phantom Thread*).

<sup>254</sup> John Birmingham, *Unscripted: 21 Ad-Libs that Became Classic Movie Lines*, PURPLE CLOVER (Apr. 19, 2017), <http://www.purpleclover.com/entertainment/4792-ultimate-ad-libs/>.

<sup>255</sup> *Top 10 Ad-Libbed Lines in Movies*, ACMI (Apr. 19, 2016), <https://2015.acmi.net.au/acmi-channel/2016/top-10-ad-libbed-lines-in-movie-history/> (“In Italy for 30 years under the Borgias, they had warfare, terror, murder, bloodshed, but they produced Michelangelo, Leonardo da Vinci and the Renaissance. In Switzerland they had brotherly love, they had 500 years of democracy and peace. And what did that produce? The cuckoo clock.”).

<sup>256</sup> *Id.*

<sup>257</sup> Birmingham, *supra* note 254.

<sup>258</sup> *Top 10 Ad-Libbed Lines in Movies*, *supra* note 255.

<sup>259</sup> *Id.*

<sup>260</sup> Jessica Roy, *Alison Brie, Aubrey Plaza and Molly Shannon Talk F-bombs and Faith in ‘The Little Hours’*, L.A. TIMES (Jul. 4, 2017), <http://www.latimes.com/entertainment/movies/la-et-mn-the-little-hours-aubrey-plaza-alison-brie-molly-shannon-20170703-htmstory.html>.

<sup>261</sup> Germain Lussier, *Five Things We Learned About ‘Ghostbusters’ From Jason Reitman’s Live Reading*, FILM (Dec. 14, 2012), <https://www.slashfilm.com/five-things-we-learned-about-ghostbusters-from-jason-reitmans-live-reading/>.

<sup>262</sup> Birmingham, *supra* note 254.

<sup>263</sup> See Interview by Jimmy Carter with Denzel Washington, YOUTUBE (Oct. 13, 2013), <https://www.youtube.com/watch?v=kDYFTssDwA> (“I never had the pressure of doing them word-for-word, and so I never did them the same way twice.”).

<sup>264</sup> Birmingham, *supra* note 254; see also Interview with Stephen Spinella, in SONENBERG, *supra* note 234, at 277–78 (describing a scene in *And the Band Played On* in which Spinella was the only one of three actors with scripted lines—the other actors ad-libbed).

<sup>265</sup> See Chris Compendio, *SDCC: Taika Waititi Explains How ‘Thor: Ragnarok’ Was “80 Percent Improvised”*, MCU EXCHANGE (July 25 2017), <https://mcuexchange.com/sdcc-taika-waititi-thor-ragnarok-80-percent-improvised/> (“[W]e improvised about eighty-percent of the film. We ad-libbed or threw in stuff.”).

jazz jam session can be the first fixation of both a new musical composition and a new sound recording.<sup>266</sup> But no matter how extensive or brilliant the ad-libbing, Hollywood practice and collective bargaining agreements make it improbable that an actor would ever be given writing credit for a script.<sup>267</sup>

But let us eliminate both situations in which the actor has significant input on the script prior to shooting and situations in which actors “write” meaningful portions of the script through permitted *ad-libbing*. Let us focus on what happens once the script is stabilized and filming has started. The Google argument was that actors are not authors because they only “create” the work at the film director’s direction and “the creator of a work at another’s direction, without contributing intellectual modification, is not an author.”<sup>268</sup>

The creative process of shooting a film is often more collaborative with significant modifications contributed by the actor. Actor John Turturro describes one experience of working with the Coen Brothers this way:

Because I played so many scenes by myself in *Barton Fink*, I absolutely needed Joel and Ethan to bounce off of. We would try everything one way, and then we’d experiment, trying it another way. They were excited because I was coming up with stuff that they hadn’t imagined. Because they worked very hard, I figured it was my job to truly understand what they wanted and to give them choices within their structure that they never even thought of.<sup>269</sup>

While Turturro’s *Barton Fink* experience may be extreme, it is not unusual for actors to add expression to their characters that the director neither sought nor seeks to suppress (once the actor demonstrates the expression).<sup>270</sup> Whether stage or film, one can think of the interpretation

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<sup>266</sup> The same can be said of an ad-libbed radio program. *See, e.g.,* *Trenton v. Infinity Broad. Corp.*, 865 F. Supp. 1416, 1424–25 (C.D. Cal. 1994) (concluding that there is “no distinction between the performance and the recording of the performance” for purposes of establishing federal copyright protection where the performance at issue was a live radio program featuring call-in guests and banter between co-hosts). Robert Brauneis has deftly explored how the Copyright Office’s acceptance of sound recordings as fixations of musical compositions may have altered our concept of those compositions. Brauneis, *supra* note 214, at 2–7.

<sup>267</sup> *See* Catherine L. Fisk, *The Role of Private Intellectual Property Rights in Markets for Labor and Ideas: Screen Credit and the Writers Guild of America, 1938-2000*, 32 *BERKELEY J. EMP. & LAB. L.* 215, 251–55 (2011) (describing the various types of credit given and who may receive it); *id.* at 252–53 (explaining that one reason for the Writers Guild’s tight control of writing credit is “[t]he view . . . that writers will enjoy the status akin to directors as the author of a film only if and when one or two writers control, and are perceived as controlling, the content of the script and the construction of the story”).

<sup>268</sup> Brief in Response to Suggestion, *supra* note 176, at 29.

<sup>269</sup> Interview with John Turturro, *in* SONENBERG, *supra* note 234, at 39.

<sup>270</sup> For example, the actor Betty Gabriel Georgina, who played a young black woman whose body has been possessed by an older white woman in the 2017 film *Get Out*, added “tiny physical glitches” inspired by old horror films and the idea that “not all the wires were connected quite right.” Lisa Rosen,

developed by the director *and* actors as a “text” layered on top of the text of the script.<sup>271</sup> Matthew Sussman’s description of the experience of a theatrical understudy can also apply to film:

[C]ertain vocal properties and physical gestures have become part of the text. For the understudy, two texts exist: the written word and the performance text the actors are doing each night. That performance text is like a transparency laid over the written text. There are comic or dramatic beats that have developed through the idiosyncrasies of the actor and his approach to the character, in collaboration with the other actors and the director. For instance, in the bar scene [in *Angels in America*], Roy talks about being family, ‘la familia,’ and then, just at the top of what looks like a hearty embrace, Ron mimed shooting Joe in the head with his finger like a Mafia execution. That’s a big laugh in the show. It’s not in Tony Kushner’s text, but the gesture, the laugh—the whole beat—has become part of the scene.<sup>272</sup>

While Sussman was describing theater performance, the same happens when the actor uses an *ad-lib* line, adds a dramatic pause, or gives his character some physical tic that gets into the final cut of the film: the sequence of those dramatic performances is like a transparency laid over the film script.<sup>273</sup>

Here it may be worthwhile to consider the different relationship between actors and directors in film and in theater. In the case of film, the director has significant control over the actor’s performance in post-production—a kind of control that does not exist in theater.<sup>274</sup> The director can decide which among various takes to use, often using a performance that the actor might not consider her best.<sup>275</sup> The director or the producer can cut the scene, slightly slow or speed up the performance, even running some frames backwards.<sup>276</sup> This is a kind of control unimaginable to a theater director.<sup>277</sup>

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*Making Each Moment Count*, L.A. TIMES, Dec. 21, 2017, at S26. Christopher Plummer described his own process as going with “instincts” and “trying things.” Gregory Ellwood, *The Contenders; Big Risk and Big Reward; A Half-Hour Drew Christopher Plummer into a Gutsy Gamble*, L.A. TIMES, Mar. 4, 2018, at S29.

<sup>271</sup> Interview with Matthew Sussman, in JANET SONENBERG, *supra* note 234, at 153.

<sup>272</sup> *Id.*

<sup>273</sup> *Id.*

<sup>274</sup> *Id.*

<sup>275</sup> *See, e.g.*, Interview with Marcia Gay Harden, in JANET SONENBERG, *supra* note 234, at 175 (describing how she gave the directors “many takes that had greater scope, shape, and emotion and lighter music,” but the directors chose a more “flat and stoical” take, choosing “the low, base tones” of the character).

<sup>276</sup> *Id.*

<sup>277</sup> *Id.*

On the other hand, while theater directors have weeks of rehearsal with actors to produce the overall performance the director envisions, consistent anecdotal evidence from the film industry is that film directors rely more on actors to develop an interpretation of their character, sometimes with limited input from the director.<sup>278</sup> For the film *Fedora*, actor Frances Sternhagen asked director Billy Wilder for time to discuss her character.<sup>279</sup> Sternhagen reports, “[a]nd he just said, ‘You do what you were doing in *Equus*. You will be marvelous.’ He wasn’t going to tell me anything and so I just made my own preparations.”<sup>280</sup> Kathleen Turner reports the same of director John Huston: “[o]n *Prizzi’s Honor*, John Huston used to say to Jack [Nicholson] and me, ‘Just call me when you’ve got it. We’ll come in and shoot.’”<sup>281</sup> To echo Richard Arnold, the less the director is dictatorial and the more the director is collaborative,<sup>282</sup> the more space there is for original expression from the actors.

Nonetheless, one could still conclude that while “genuine human creativity” goes “into acting a script,” nonetheless “this creativity is different in kind and in degree from the creativity that goes into creating fixed, author-driven works like literature and visual art.”<sup>283</sup> This is the foundation for the belief—prevalent in civil law jurisdictions—that granting performers “related rights” or “neighboring rights” is a better approach than extending copyright to performers’ creative expression.<sup>284</sup> It is worth reflecting on how “performance” originality might be viewed—or might have come to be viewed—as different from “authorial” originality.<sup>285</sup>

In one sense, the creativity in a performance—musical or dramatic—is parasitic, or dependent on the creativity in the pre-existing musical or

<sup>278</sup> *Id.* (“In film, you’re expected to come in having worked out emotional transitions and character. I’m particularly glad for my training when I work on a film because it enables me, on my own, to find the truth of a scene.”).

<sup>279</sup> Interview with Frances Sternhagen, in JANET SONENBERG, *supra* note 234, at 183.

<sup>280</sup> *Id.*

<sup>281</sup> Interview with Kathleen Turner, in JANET SONENBERG, *supra* note 234, at 237.

<sup>282</sup> And “collaborative” is a word that actors frequently use to describe favored directors. *See, e.g.*, Michael Ortona, *It’s Their Turn to Shine*, L.A. TIMES, Feb. 8, 2018, at S8 (quoting Academy Award nominee for best supporting actress Lesley Manville, who described *Phantom Thread* director Paul Thomas Anderson as “warm and collaborative and open”). Actors also talk about not wanting to be “over-directed,” which speaks to the creative space the actor seeks to safeguard. *See, e.g.*, Hugh Hart, *Depend on Her to Get It Right*, L.A. TIMES, May 24, 2018, at S4 (describing the working relationship between director Steven Soderbergh and actor Sharon Stone).

<sup>283</sup> Victor, *supra* note 67, at 86 (“[G]enuine human creativity goes into acting a script or performing a music composition, but . . . this creativity is different in kind and in degree from the creativity that goes into creating the fixed, author-driven works, like literature and visual art.”).

<sup>284</sup> In the traditional European view, “[p]erformance and interpretation are regarded as something quite different from authorship, and so performers are held not to have any role in the creation of dramatic and musical works.” ARNOLD, *supra* note 247, § 10.03 at 279.

<sup>285</sup> *Id.*

literary work.<sup>286</sup> But that itself would not be enough to cordon off creative expression in performance from copyright. For example, editorial work is also dependent or parasitic. If that were the difference between types of creativity, why should *selection and arrangement* of Walt Whitman's poems give a copyright to the anthology editor, but a recorded reading of Walt Whitman's poems would not give a copyright to the performer? Why should a sufficiently original recorded performance of a public domain dramatic work not receive a copyright when a sufficiently original *condensed* version of the same public domain dramatic work would garner a copyright?

Alternatively, the sense that there is a difference here may be rooted in a perceived difference between *composition* and *performance*. Discussing musical compositions and sound recordings, Robert Brauneis proposes that composition has been seen as a “deliberative activity that allow[s] rethinking and editing” while performance has been seen as an “unrepeatable, evanescent, . . . real-time, low-deliberation, no-editing activity.”<sup>287</sup>

But such a distinction breaks down quickly. Brauneis has skillfully explored how sound recordings themselves became musical compositions—with more specificity and detail than can be captured by standard musical notation.<sup>288</sup> This is not too distant from Sussman's idea that a successful theatre production has a “performance text” that is “laid over” the written script.<sup>289</sup> And the distinction between a single work that is repeatedly edited versus repetition of action may better describe most literary works than *some* artistic works.<sup>290</sup> A visual artist may do many sketches which are preliminary to a final drawing or painting, just as a performer may do many takes before settling on a final, satisfactory performance. Both the visual artist and the performer (musical or dramatic) may learn what works in those preliminary efforts. On the other side of the ledger, an artistic work does not lose that status if there was neither editing nor iterative expression. Drawings and even some paintings might be done in a matter of minutes; an essay or musical jingle might “pour” forth from a writer or composer in a short, single session.

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<sup>286</sup> *Id.*

<sup>287</sup> Robert Brauneis, *supra* note 214, at 2, 8 (footnotes omitted) (“Composition—a deliberative activity that allowed rethinking and editing—produced a score, a stable, visually perceptible . . . set of prescriptions for musicians to follow . . . . Performance contrasts with composition in many respects. While a score is stable and visually perceptible, performance is unrepeatable, evanescent, and aural. While composition is a deliberative process that allows for trial-and-error editing, performance is a real-time, low-deliberation, no-editing activity.”).

<sup>288</sup> *See id.* at 2–3 (describing the special nature of composition).

<sup>289</sup> Interview with Matthew Sussman, *in* SONENBERG, *supra* note 234, at 153.

<sup>290</sup> *See id.* (noting that an actor's idiosyncrasies may become an important part of the performance).

#### IV. THE NON-PROBLEMS OF JOINT AUTHORSHIP AND ‘CAST OF THOUSANDS’

If we start with the premise that an actor may contribute protectable expression to an audiovisual work, does that lead inextricably to the Ninth Circuit’s “proverbial ‘cast of thousands’”<sup>291</sup> problem? And keep in mind that that problem could take the form of either thousands of *distinct* copyright claims or thousands of claims to *joint authorship*.<sup>292</sup> Some of the darker language in Judge McKeown’s *en banc* opinion suggests that fear of this problem could justify completely denying the possibility of protectable expression in actors’ performances.<sup>293</sup>

Yet even after *Garcia*, worrying about “copyright of thousands”<sup>294</sup> in audiovisual works is like worrying about snow in South Florida—perhaps we should have contingencies in place, but the arrangement of the world is such that the problem will rarely occur. To use the words of the Supreme Court in *Qualitex*, denying authorship to actors because of the “cast of thousands” problem would “rel[y] on an occasional problem to justify a blanket prohibition.”<sup>295</sup> First, let us sketch out the existing filters—law and customary practices built on law—that almost always prevent the *Garcia* problem.

After reviewing this familiar turf—and how those filters are likely to remain robust in the future—we will turn to how the “copyright of thousands” problem may have contributed to a troubled jurisprudence of joint authorship. While this is not the place for a full-blown exploration of what has gone wrong in the case law on joint authorship, it is important to understand why joint authorship in audiovisual works is not the scary outcome that it may have appeared to be to Judge McKeown.

To the degree that courts have struggled to avoid judgments of joint authorship, they may have done so in the mistaken belief that a finding of joint authorship would require equal shares among the joint authors. But in situations in which the work-for-hire and implied licensing doctrines fail, a

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<sup>291</sup> *Garcia III*, 786 F.3d at 742.

<sup>292</sup> *See id.* (foreseeing the problems of “[u]ntangling . . . tens, hundreds, or even thousands of standalone copyrights”).

<sup>293</sup> *Id.* at 743 (citations omitted) (“The reality is that contracts and the work-made-for-hire doctrine govern much of the big-budget Hollywood performance and production world. Absent these formalities, courts have looked to implied licenses. Indeed, the district court found that *Garcia* granted Youssef just such an implied license to incorporate her performance into the film. But these legal niceties do not necessarily dictate whether something is protected by copyright, and licensing has its limitations. As filmmakers warn, low-budget films rarely use licenses. Even if filmmakers diligently obtain licenses for everyone on set, the contracts are not a panacea. Third-party content distributors, like YouTube and Netflix, won’t have easy access to the licenses; litigants may dispute their terms and scope; and actors and other content contributors can terminate licenses after thirty[-]five years. Untangling the complex, difficult-to-access, and often phantom chain of title to tens, hundreds, or even thousands of standalone copyrights is a task that could tie the distribution chain in knots.”).

<sup>294</sup> *Id.*

<sup>295</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 168 (1995).

greater willingness to find joint authorship with a quick determination of *unequal shares* might be a better solution. In contrast, if the case law makes the contribution of creative professionals—actors, directors, cinematographers—seem to “disappear” when there are no contractual arrangements, the jurisprudence will give unscrupulous producers a reason *not* to get rights and *not* to enter into contracts.

A. *The Filters that Prevent Both Copyright of Thousands and Thousands of Joint Authors*

Everyone agrees that there is a robust set of filters that, in almost any fact pattern, keep an actor from being deemed an author in an audiovisual work in which the actor’s performance is fixed. As Jay Dougherty noted in 2016, actors being authors:

[Is] not really a problem in almost every case because generally in films everyone works for hire. Maybe rarely it’s a joint work, but even if it isn’t, there is a possibility of assignment, and even if there is no assignment then there is an implied license in almost every case.<sup>296</sup>

In other words, audiovisual performances are almost always governed by an express contract that links to statutory provisions ensuring any copyright interests belong to the film’s producers, and where the copyright interests fail to consolidate completely under the film producer’s control, the producer will almost certainly have some ownership interest or an implied license. But even this account starts mid-way in the various filters against the “copyright of thousands.”<sup>297</sup>

1. *More Than de Minimis Original Expression*

In both *Garcia* and *Aalmuhammed*, the Ninth Circuit was motivated by an overblown fear of “splinter[ed]” copyright interests. In *Garcia*, the court cautioned against views that “would enable any contributor from a costume designer down to an extra or best boy to claim copyright in random bits and pieces of a unitary motion picture without satisfying the requirements of the Copyright Act.”<sup>298</sup> This is directly linked to a line of thinking in

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<sup>296</sup> Jay Dougherty, *The Misapplication of “Mastermind”: A Mutant Species of Work for Hire and the Mystery of Disappearing Copyrights*, 39 COLUM. J.L. & ARTS 463, 466 (2016) (citation omitted); see also Diana C. Obradovich, *Garcia v. Google: Authorship in Copyright*, 31 BERKELEY TECH. L.J. 785, 792 (2016) (noting that the question of authorship or co-ownership rarely arises with motion pictures because of the work-for-hire doctrine, and because motion pictures are normally joint, not collective, works).

<sup>297</sup> See *Garcia III*, 786 F.3d at 743 (identifying the problems resulting from “[t]reating every acting performance as an independent work”).

<sup>298</sup> *Garcia III*, 786 F.3d at 737.

*Aalmuhammed* where, in its concern about who counts as an “author” of a motion picture, the court had observed that “[e]veryone from the producer and director to casting director, costumer, hairstylist, and ‘best boy’ get listed in the movie credits because all of their creative contributions really do matter.”<sup>299</sup>

Of course, the costume designer already can have separate, protectable copyright interests; if the costume she designed is copyrightable,<sup>300</sup> its appearance in a film is no different than a painting, poster, or quilt on a wall.<sup>301</sup> As discussed above, the same might be true of hairstylists or other types of artists.<sup>302</sup> But recognition in movie credits is simply not the same thing as recognition of a *creative contribution* to a film. Drivers, caterers, personal assistants to featured performers, best boys, casting directors, and lawyers for the production may be listed in closing “credit crawls” without anyone thinking they contributed original expression seen or heard on the screen.<sup>303</sup>

Copyright’s bedrock requirement of *original expression* prevents most of these people from being in the universe of potential copyright claimants. In normal circumstances, the best boy—an assistant to an electrician on a film crew<sup>304</sup>—would not contribute any original expression to the film. It is the same with an extra in a crowded marketplace or battle scene: they probably contribute no original expression and, if they do, unauthorized reproduction would likely be *de minimis*.<sup>305</sup> While a claimant might argue

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<sup>299</sup> *Id.* at 742 (quoting *Aalmuhammed v. Lee*, 202 F.3d 1227, 1233 (9th Cir. 2000)).

<sup>300</sup> Many costumes will be analyzed under the standard announced by the Supreme Court in *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1016 (2017) (holding that a feature on cheerleading uniforms “is eligible for copyright protection if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work”).

<sup>301</sup> See *Ringgold v. Black Entm’t Television*, 126 F.3d 70, 79–80 (2d Cir. 1997) (holding that the use of a poster of a quilt as decoration on a television set could be non-*de minimis* copying when the poster appears sufficiently in the television program).

<sup>302</sup> See *supra* Section II.C (discussing circumstances in which various types of professionals may produce copyrightable work).

<sup>303</sup> Conversely, the names of dancers and members of orchestras playing on the soundtrack—people who might make a creative contribution—are typically omitted, appearing neither in opening nor closing credits.

<sup>304</sup> *Best Boy*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/best%20boy> (last visited Sept. 23, 2018) (defining “best boy” as “the chief assistant to the gaffer in motion-picture or television production”); *Gaffer*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/gaffer> (last visited Sept. 23, 2018) (defining “gaffer” as “a lighting electrician on a motion-picture or television set”).

<sup>305</sup> *De minimis* is principally used as a filter establishing a quantum for actionable infringement. See, e.g., *Neal Publ’ns v. F & W Publ’ns*, 307 F. Supp. 2d 928, 931–32 (N.D. Ohio 2004) (holding that copying a few words and phrases from a human resources guide was *de minimis*); *Werlin v. Reader’s Digest Ass’n*, 528 F. Supp. 451, 463–64 (S.D.N.Y. 1981) (determining that duplication of two sentences from article was *de minimis* copying).

that what was taken was a substantial part of their original expression,<sup>306</sup> with audiovisual works, the *de minimis* doctrine has special application. As formulated by the Second Circuit in the 1997 *Ringgold v. Black Entertainment Television* decision: “In cases involving visual works . . . the quantitative component of substantial similarity also concerns the observability of the copied work—the length of time the copied work is observable in the allegedly infringing work and such factors as focus, lighting, camera angles, and prominence.”<sup>307</sup> This variation on the *de minimis* doctrine has been used to turn back several claims of infringement in audiovisual works.<sup>308</sup>

In short, the requirements that a plaintiff contribute original expression and that the appearance of that original expression cross a *de minimis* threshold knock out much of the parade of horrors envisioned in *Garcia* and *Aalmuhammed*.

## 2. *Work-for-Hire Doctrine*

It is not an overstatement to say that the work made for hire (or work-for-hire) doctrine is “an essential building block for the movie industry,”<sup>309</sup> a building block consisting of both customary business relationships and statutory law that reflects those relationships. Codified in American copyright law in 1909 and re-codified in 1976, the doctrine provides that when the “work made for hire” conditions are met, the “employer or other person for whom the work was prepared is considered the author” for purposes of copyright law.<sup>310</sup>

As Catherine Fisk observes, in the United States “[f]ilm and television production is a densely unionized industry”<sup>311</sup> in which the unions representing actors, writers, directors, musicians, make-up artists, set designers, sound engineers, and more all engage in collective bargaining with television and film producers. It is fair to say the economic position of all these creative professionals was established early on more through their

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<sup>306</sup> NIMMER & NIMMER, *supra* note 140, § 13.03(A)(2)(a) (“The question in each case is whether the similarity relates to matter that constitutes a substantial portion of plaintiffs work—not whether such material constitutes a substantial portion of defendant’s work.”).

<sup>307</sup> *Ringgold v. Black Entm’t Television*, 126 F.3d 70, 75 (2d Cir. 1997).

<sup>308</sup> *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 218 (2d Cir. 1998) (holding that photos’ appearance in the background of the film *Seven* was *de minimis*); *Gordon v. Nextel Commc’ns*, 345 F.3d 922, 924–25 (6th Cir. 2003) (holding that the appearance of a dental illustration in an infomercial was fleeting, unfocused, and *de minimis*).

<sup>309</sup> Randal C. Picker, *Garcia v. Google: Stanislavski and Meisner Pay a Visit to Copyright*, MEDIA INST. (Mar. 11, 2014), <https://www.mediainstitute.org/2014/03/11/garcia-v-google-stanislavski-and-meisner-pay-a-visit-to-copyright> (“The work made for hire doctrine is an essential building block for the movie industry.”).

<sup>310</sup> 17 U.S.C. § 201(b) (2012).

<sup>311</sup> Fisk, *supra* note 267, at 221.

collective action than through the clarity of their intellectual property rights.<sup>312</sup> This collective bargaining system produces a robust baseline contractual structure for the vast majority of creative professionals in the audiovisual industry—a baseline contractual structure that relies on statutory work-for-hire provisions to consolidate economic rights with producers. Standard form contracting for actors in the audiovisual industry typically provides that:

[A]ll results and proceeds of Performer’s services, including, without limitation, all literary and musical material, designs and inventions of Performer shall be deemed to be a work made for hire for Producer within the meaning of the copyright laws of the United States or any similar or analogous law or statute of any other jurisdiction and accordingly, Producer shall be the sole and exclusive owner for all purposes . . . .<sup>313</sup>

Similar provisions abound in the world of audiovisual contracts.<sup>314</sup> This is not only how the statutory work-for-hire provisions are used in the audiovisual industry; this is also how Congress intended the provisions to be used. The definition of a “work made for hire” in the 1976 Copyright Act was expanded to include “a work specially ordered or commissioned for use

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<sup>312</sup> For a discussion of the labor struggle of screenwriters, see CATHERINE L. FISK, *WRITING FOR HIRE: UNIONS, HOLLYWOOD, AND MADISON AVENUE 137–38* (2016) (outlining elements of writers’ efforts with the Writers Guild); CYNTHIA LITTLETON, *TV ON STRIKE: WHY HOLLYWOOD WENT TO WAR OVER THE INTERNET 259* (2013) (recounting labor struggles of screenwriters in light of the emergence of streaming sources for television content). Much the same thing happened with live theater in the United States when playwrights organized and collectively demanded a more equitable economic relationship with play producers. See Jessica Litman, *The Invention of Common Law Play Right*, 25 *BERKELEY TECH. L.J.* 1381, 1418–20 (2010) (discussing unionization of playwrights and ensuing developments with producers).

<sup>313</sup> NIMMER & NIMMER, *supra* note 140, Form 23-40 (providing also for the waiver of moral rights and their transfer to Producers “to the extent permitted by law”). In another standard form provided in the Nimmer treatise, the counterpart provision reads:

Player acknowledges and agrees that all of the results and proceeds of Player’s services pursuant to this Agreement, including all material suggested, composed, written or performed by Player, shall be considered a “work-made-for-hire” specially ordered or commissioned by us and that we are and shall be the sole and exclusive owner . . . .

*Id.*, Form 23-41.

<sup>314</sup> For example, two standard contracts contain similar language covering “all results, product and proceeds of Writer’s services (including all original ideas in connection therewith) [that] are being specially ordered by Producer for use as part of a Motion Picture.” *Writer’s Theatrical Short-Form Contract*, WRITERS GUILD OF AMERICA WEST, ¶ 24, available at <https://www.wga.org/contracts/contracts/other-contracts/standard-theatrical> (last visited Sept. 24, 2018); see also *Writer’s Theatrical Short-Form Contract—Writers Lending Agreement*, WRITERS GUILD OF AMERICA WEST, ¶ 25, available at <https://www.wga.org/uploadedFiles/contracts/other-contracts/shortformwriterloanout.docx> (last visited Sept. 24, 2018) (including near-identical language).

as . . . a part of a motion picture or other audiovisual work.”<sup>315</sup> The legislative history of the 1976 Act noted that “a motion picture would normally be a joint rather than a collective work with respect to those authors who actually work on the film, although their usual status as employees for hire would keep the question of co-ownership from coming up.”<sup>316</sup> Some commentators are understandably critical of the work-for-hire provisions in American copyright law,<sup>317</sup> but in the “densely unionized” audiovisual industry, in exchange for the transfer of ownership galvanized by work-for-hire, the guilds obtain minimum salaries and wages, “residual” payments, financial support for health care programs, protection of workplace conditions, control of credits or attribution rights, and more.<sup>318</sup>

### 3. *Implied Licensing*

When it comes to assignments, federal copyright law’s requirement of a written, signed transfer preempts any flexibility otherwise provided by state contract law.<sup>319</sup> Perhaps because of this strictness concerning the complete transfer of rights, courts have been liberal in their interpretation of situations in which an author or other copyright owner has impliedly granted a non-exclusive license for use of copyrighted material.<sup>320</sup> Implied licensing is often coupled with the work-for-hire doctrine as providing a one-two punch to ensure that economic rights in audiovisual works may be exploited by the film producer.<sup>321</sup>

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<sup>315</sup> 17 U.S.C. § 101 (2012) (defining “work made for hire”). Although actors’ contracts recite that their contribution is a “work made for hire,” obviously that takes us back to the problem of whether an actor’s performance is a “work.”

<sup>316</sup> H.R. Rep. No. 94–1476, at 120 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5736.

<sup>317</sup> See, e.g., Roberta Rosenthal Kwall, *Authors in Disguise: Why the Visual Artists Rights Act Got It Wrong*, 2007 UTAH L. REV. 741, 749 (2007) (“The work-for-hire doctrine perhaps can be justified when it operates to divest an author of copyright ownership given the economic quid pro quo she receives. On the other hand, by allowing an author to relinquish her authorship status and all that such status entails, the work-for-hire doctrine arguably undermines authorship dignity in a fundamental way.”); MARK HELPRIN, DIGITAL BARBARISM 127 (2009) (asserting that “nothing should or need be” a work-for-hire). *But see* Justin Hughes & Robert P. Merges, *Copyright and Distributive Justice*, 92 NOTRE DAME L. REV. 513, 567, 569–70 (2017) (discussing the positive economic effect of work-for-hire in transactions between companies and “creative professionals”).

<sup>318</sup> See Fisk, *supra* note 267, at 218–19 (discussing the functions of a union in the audiovisual industry).

<sup>319</sup> 17 U.S.C. § 204(a) (2012) (“A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner’s duly authorized agent.”).

<sup>320</sup> If true, this would not be a unique case of courts creating work-arounds against strict statutory provisions. See, e.g., Litman, *supra* note 312, at 1403–10 (suggesting that courts sometimes recognized common law performance rights in dramatic works as a response to situations in which statutory copyrights were defective).

<sup>321</sup> See Picker, *supra* note 152 (“As applied to movies, the work-made-for-hire doctrine is designed to avoid the fragmentation of rights that might otherwise arise regarding a film, where any one person who did something in the making of the movie that gave rise to a separate work might be able to hold

The classic case in this area is the Ninth Circuit’s 1990 *Effects Associates, Inc. v. Cohen*<sup>322</sup> decision. In that case, a special effects company agreed to create “footage to enhance certain action sequences in the film,”<sup>323</sup> and Cohen, the film producer, “agreed to the deal orally, but no one said anything about who would own the copyright in the footage.”<sup>324</sup> Effects Associates delivered the special effects scenes, but Cohen did not pay the agreed amount, and Effects Associates sued for copyright infringement.<sup>325</sup> Following an earlier Ninth Circuit case, the court concluded that an implied license had been granted when “Effects created a work at defendant’s request and handed it over, intending that defendant copy and distribute it.”<sup>326</sup>

Today, there is no question that a non-exclusive license to copyright rights may “be implied from conduct”<sup>327</sup> and *Effects Associates* is widely recognized as establishing a tripartite test. An implied nonexclusive license is created when: “(1) a person (the licensee) requests the creation of a work; (2) the creator (the licensor) makes that particular work and delivers it to the licensee who requested it; and (3) the licensor intends that the licensee-requestor copy and distribute his work.”<sup>328</sup>

With only slight tweaking, these requirements map onto an actor’s dramatic performance for an audiovisual work: the film producer requests the performance; the actor gives the performance and delivers it while authorizing its fixation by the film producer; and the actor intends that the film producer copy and distribute the performance. So, as Bill Patry notes, generally speaking, “[t]he correct approach to resolving the situation where an individual . . . contributes expression to a work but is found not to be a joint author is to find an implied license.”<sup>329</sup> Indeed, the implied licensing of an actor’s contribution to an audiovisual work—as well as contributions of set designers, costumers, lighting, and cinematographers—finds strong support in the Berne Convention itself. Returning to Article 14*bis* of the Berne Convention, Article 14*bis*(2)(b) provides:

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out and block the distribution of that movie. And, even if the work-made-for-hire rules haven’t been implemented perfectly in a particular case, the usually generous rules regarding express or implied licenses to use copyrighted works will again make possible the distribution of the movie.”)

<sup>322</sup> 908 F.2d 555 (9th Cir. 1990).

<sup>323</sup> *Id.* at 556.

<sup>324</sup> *Id.*

<sup>325</sup> *Id.*

<sup>326</sup> *Id.* at 558 (citing and discussing *Oddo v. Ries*, 743 F.2d 630 (9th Cir. 1984)).

<sup>327</sup> NIMMER & NIMMER, *supra* note 140, § 10.03(A)(2).

<sup>328</sup> I.A.E., Inc. v. Shaver, 74 F.3d 768, 776 (7th Cir. 1996) (quoting *Effects Assoc.*, 908 F.2d at 558–59); *Nelson-Salabes, Inc. v. Morningside Dev., LLC*, 284 F.3d 505, 514 (4th Cir. 2002) (quoting *Shaver*, 74 F.3d at 776); *see also Johnson v. Jones*, 149 F.3d 494, 500–01 (6th Cir. 1998) (applying *Effects Associates*’ three-factor test in dispute over architectural drawings); *FenF, LLC v. Healion Health Inc.*, No. 5:08CV404, 2009 WL 10688713, at \*3 (N.D. Ohio Sept. 4, 2009) (applying *Effects Associates*’ three-factor test in a case where one company used copyrighted images of another on its own website).

<sup>329</sup> 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 5:17 (2018).

[I]n the countries of the Union which, by legislation, include among the owners of copyright in a cinematographic work authors who have brought contributions to the making of the work, such authors, if they have undertaken to bring such contributions, may not, in the absence of any contrary or special stipulation, object to the reproduction, distribution, public performance, communication to the public by wire, broadcasting or any other communication to the public, or to the subtitling or dubbing of texts, of the work.<sup>330</sup>

The Berne Convention expressly allows that national law *may* require “undertakings” to contribute to an audiovisual work to be in writing, but that is strictly optional,<sup>331</sup> agreements to perform may be oral or *implicit* and thereby impliedly license exploitation of the audiovisual work. The implied licensing approach only fell short during the *Garcia v. Google* case for those judges who believed that Youssef’s fraudulent representations negated step one of the *Effects Associates* test.<sup>332</sup>

#### 4. *Will These Filters Remain Robust?*

Is it reasonable to expect that these multiple filters will remain robust going forward as audiovisual production and distribution evolves, or as the technology to produce high-quality audiovisual works diffuses to more and more creators? As evidenced through *Garcia v. Google*, one of the biggest concerns surrounding actors-as-authors is the audiovisual works on YouTube, whether we want to call them amateur videos or user-generated-content (“UGC audiovisual works”). The concern is that YouTubers<sup>333</sup> and other makers of UGC audiovisual works who are not “professionals,” are often just starting in their efforts (whether amateur or intended as a business) and are not in the custom of getting the types of written contracts that are

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<sup>330</sup> Berne Convention, *supra* note 3, art. 14bis(2)(b), at 11.

<sup>331</sup> *See id.* art. 14bis(2)(c), at 11 (“The question whether or not the form of the undertaking referred to above should, for the application of the preceding subparagraph (b), be in a written agreement or a written act of the same effect shall be a matter for the legislation of the country where the maker of the cinematographic work has his headquarters or habitual residence.”). Article 14(3) establishes a presumption that this implied licensing regime does *not* apply to a film director, screenwriter, or composer unless “national legislation provides to the contrary.” *Id.*

<sup>332</sup> *See Garcia v. Google, Inc.*, 766 F.3d 929, 937–38 (9th Cir. 2014) (citation omitted) (“Youssef’s fraud alone is likely enough to void any agreement he had with Garcia. But even if it’s not, it’s clear evidence that his inclusion of her performance in ‘Innocence of Muslims’ exceeded the scope of the implied license and was, therefore, an unauthorized, infringing use.”), *dissolved by*, 786 F.3d 733 (9th Cir. 2015) (en banc).

<sup>333</sup> *YouTube*, OXFORD LIVING DICTIONARIES (2018), <https://en.oxforddictionaries.com/definition/youtuber> (“A person who uploads, produces, or appears in videos on the video-sharing website YouTube.”).

used in the film and television industry.<sup>334</sup> So, the argument goes, a new industry may be thwarted by such rules. And certainly the salaries earned by leading YouTubers<sup>335</sup> speak to the economic success for some UGC content on on-line platforms.

Of course, if YouTube videos are an important new business, then it is fair to say that these audiovisual entrepreneurs should treat their employees and contributors reasonably. As a general rule, we do not exempt start-ups from minimum wage and other labor laws; we exempt neither start-ups nor hobbyists from environmental standards, sanitation laws, or building codes. Indeed, the claim that creators of UGC audiovisual works should not have to follow the requirements of the work-for-hire doctrine in order to be free from the worry of actors asserting rights sounds a bit like Mr. Cohen's argument in *Effects Associates* that Hollywood film producers should be exempted from the requirement that copyright assignments be in writing because "[m]oviemakers do lunch, not contracts."<sup>336</sup>

#### B. *The Rare, But Unfrightening Prospect of an Actor as a Joint Author*

In the extremely rare fact pattern in which none of these filters apply to the actor's performance in an audiovisual work, we seem to be left with three possibilities: (a) the actor is the sole author of the audiovisual work; (b) the actor is a joint author; or (c) the actor is not an author at all.

This menu makes clear the strange distortion of the *Garcia v. Google* case. A finding of joint authorship would not have helped Garcia and claiming to be the sole author of the whole film would have been ridiculous,<sup>337</sup> so she claimed to be the sole author of something *within* the film, and the *en banc* majority opted to find she was not an author at all.<sup>338</sup> Similarly, in the Second Circuit's *16 Casa Duse, LLC v. Merkin*<sup>339</sup> decision, film director Merkin disclaimed joint authorship in the finished film *Heads Up* and claimed to be the sole author of the "raw" footage—another untenable claim.<sup>340</sup> The appellate panel found that he was not an author at all.<sup>341</sup>

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<sup>334</sup> See Ginsburg, *supra* note 110 ("But producers of amateur films, including (especially?) those posted on YouTube and similar platforms, may not be the actors' employers (indeed, the actors may not be professionals, either), and may be unaware of the need for written contracts.").

<sup>335</sup> John Lynch, *These Are the 19 Most Popular YouTube Stars in the World — and Some Are Making Millions*, BUSINESSINSIDER (Feb. 2, 2018, 8:58 AM), <http://www.businessinsider.com/most-popular-youtubers-with-most-subscribers-2018-2> (describing leading YouTubers' salaries as \$15, \$7, and \$5.5 million).

<sup>336</sup> *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 556 (9th Cir. 1990).

<sup>337</sup> *Garcia*, 766 F.3d at 933.

<sup>338</sup> *Garcia III*, 786 F.3d at 737.

<sup>339</sup> 791 F.3d 247, 255 (2d Cir. 2015).

<sup>340</sup> *Id.* at 252.

<sup>341</sup> *Id.* at 259, 261.

In both cases, the individual contributor disclaimed joint authorship, so neither court frontally addressed whether the actor or director should have been treated as a joint author. Maintaining the proper balance here is critical because the producer is the appropriate holder of consolidated economic rights in an audiovisual work. On the other hand, a finding of “joint authorship” for an individual contributor to an audiovisual work need not entitle that person to an equal share of any revenues from exploitation of a film. A joint owner may be entitled to a very small percentage of income—or none at all.

But the primary issue is whether an actor may have a bona fide claim to authorship of a “joint work”—that is, 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>342</sup> While this is not the place for a full critique of how joint authorship doctrine has developed,<sup>343</sup> the jurisprudence applying this definition has become encumbered with judge-created requirements that merit some discussion in relation to what actors (and directors and cinematographers) do in audiovisual works.

### 1. *The “Independently Copyrightable Contribution” Requirement*

Beginning in the 1990s, several federal courts recognized a requirement for joint authorship that “each of the putative co-authors . . . ma[k]e independently copyrightable contributions to the work.”<sup>344</sup> The existence and nature of this requirement is now a well-known disagreement between the two leading copyright treatises.<sup>345</sup> Paul Goldstein has advocated a strong form of the requirement, barring joint authorship unless each putative author’s “contribution represents *original expression that could stand on its own as the subject matter of copyright*,”<sup>346</sup> a requirement that several courts seem to have embraced.<sup>347</sup> In contrast, the Nimmer treatise has argued that

<sup>342</sup> 17 U.S.C. § 101 (2012).

<sup>343</sup> See Mary LaFrance, *Authorship, Dominance, and the Captive Collaborator: Preserving the Rights of Joint Authors*, 50 EMORY L.J. 193, 194–96 (2001) (discussing the legislative development of the definition of “joint works” or joint authorship); Michael Landau, *Joint Works Under United States Copyright Law: Judicial Legislation through Statutory Misinterpretation*, 54 IDEA 157, 158–61 (2014) (discussing case law interpreting the Copyright Act of 1976).

<sup>344</sup> Thomson v. Larson, 147 F.3d 195, 200 (2d Cir. 1998) (citing Childress v. Taylor, 945 F.2d 500, 507–08 (2d Cir. 1991)). For other appellate decisions adopting the requirement, see Erickson v. Trinity Theatre, Inc., 13 F.3d 1061, 1068–71 (7th Cir. 1994) (adopting a similar standard in the Seventh Circuit); Brownstein v. Lindsay, 742 F.3d 55, 64 (3d Cir. 2014) (adopting a similar two-prong test in the Third Circuit).

<sup>345</sup> See LaFrance, *supra* note 343, at 196–98 (summarizing the disagreement).

<sup>346</sup> GOLDSTEIN, *supra* note 184, § 4.2.1.2, at 379 (emphasis added).

<sup>347</sup> See, e.g., Erickson, 13 F.3d at 1070–71 (7th Cir. 1994) (finding the Act supports the validity of the Goldstein requirement); Berman v. Johnson, 518 F. Supp. 2d 791, 793 (E.D. Va. 2007) (using a jury instruction that questioned: “Do you find by a preponderance of the evidence that plaintiff’s . . . contributions to the documentary are independently copyrightable?”), *aff’d*, 315 Fed. Appx. 461 (4th Cir. 2009).

a joint author need only make a non-*de minimis* intellectual contribution to the copyrighted work, a contribution which could include *ideas*—for a narrative story, ways to reorder scenes, plot points, etc.<sup>348</sup> Judge Posner also aligned himself with this view, reasoning that one co-author might contribute “brilliant ideas but can’t write; another is an excellent writer, but his ideas are commonplace.”<sup>349</sup> For Posner, such a collaboration would be paradigmatically “joint authorship” if that is what the two people intended.<sup>350</sup>

In reality, any “strong” version of the independently copyrightable contribution standard may have given way to a more practical standard and there may be nothing in that standard to prevent an actor’s dramatic performance being a legitimate platform for a claim of joint authorship. Early on, Bill Patry proposed that the requirement ought not be taken at face value and should mean only that “the coauthor’s contribution must be the product of authorship, i.e., expression,” and *not* that “a coauthor . . . must be able to obtain a copyright on his or her separate contribution.”<sup>351</sup> In 2015, the Second Circuit panel in *16 Casa Duse, LLC v. Merkin* seemed to agree, noting that “[b]y ‘copyrightable’ [the *Childress* court] meant only to say that the coauthor’s contribution must be the product of authorship, i.e., expression.”<sup>352</sup>

At the end of the day, a strong “independently copyrightable contribution” requirement would be incompatible with our common thinking about films.<sup>353</sup> While the contribution of an actor might be imagined, or even shot, in isolation, there is no original expression from a film director or cinematographer that can be separated from what is done by other contributors. Yet in many jurisdictions, film directors are presumed to

<sup>348</sup> NIMMER & NIMMER, *supra* note 140, § 6.07(A)(3)(a).

<sup>349</sup> *Gaiman v. McFarlane*, 360 F.3d 644, 659 (7th Cir. 2004) (“Here is a typical case from academe. One professor has brilliant ideas but can’t write; another is an excellent writer, but his ideas are commonplace. So they collaborate on an academic article, one contributing the ideas, which are not copyrightable, and the other the prose envelope, and . . . they sign as coauthors. Their intent to be the joint owners of the copyright in the article would be plain, and that should be enough to constitute them joint authors within the meaning of 17 U.S.C. § 201(a).”).

<sup>350</sup> *Id.* See also Timothy J. McFarlin, *An Idea of Authorship: Orson Welles, The War of the Worlds Copyright, and Why We Should Recognize Idea-Contributors as Joint Authors*, 66 CASE W. RES. L. REV. 701, 706 (2016) (“I believe that this rule—collaborators who contribute ideas, and ideas alone, cannot be joint authors of copyrightable works—reflects a fundamentally flawed conception of authorship, one which ignores the reality of the creative process and prevents artists like Welles from obtaining the credit and compensation they deserve.”).

<sup>351</sup> PATRY, *supra* note 329, § 5:15.

<sup>352</sup> *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 255–56 n.3 (2d Cir. 2015) (citation omitted) (“It seems likely that ‘[b]y ‘copyrightable’ [the *Childress* court] meant only to say that the coauthor’s contribution must be the product of authorship, i.e., expression. [The court] did not mean that in order to be a coauthor one must be able to obtain a copyright on his or her separate contribution,’ or even that such would be possible.”).

<sup>353</sup> *Id.* at 255 (citing *Childress v. Taylor*, 945 F.2d 500, 507–08 (2d Cir. 1991)).

be *the* authors of audiovisual works.<sup>354</sup> So, the requirement in its strong form makes little sense for audiovisual works and to the degree courts are applying a standard that simply requires *original expression* from a putative joint author, this creates no problem for actors or directors.

## 2. “Superintendence,” “Dominance,” and “Masterminds”

In its effort to quash the joint authorship claim of a consultant to Spike Lee’s *Malcolm X*, the *Aalmuhammed* court ran through multiple indicia of being an author, including that an author is: “the originator or the person who causes something to come into being”,<sup>355</sup> “the ‘person with creative control’”,<sup>356</sup> “he to whom anything owes its origin”,<sup>357</sup> and “‘the inventive or master mind’ who ‘creates or gives effect to the idea.’”<sup>358</sup> This emphasis on “control” or “masterminding” the creation of a work has no obvious anchor in the definition of a “joint work” or its legislative history.<sup>359</sup>

If *Aalmuhammed* were limited to a requirement that each joint author act as “a ‘mastermind’ with ‘creative control,’”<sup>360</sup> then perhaps the traditional range of principal creative contributors to a film could be included in the Ninth Circuit’s approach; that might resolve any inconsistency between *Richlin*—recognizing that an actor, a director, and a composer might all be joint authors of a feature film<sup>361</sup>—and *Aalmuhammed*. The problem is the wrongheaded thinking in *Aalmuhammed* that an author, sole or joint, must have “superintended *the whole work*.”<sup>362</sup> On its face, that test bars from authorship of the film the screenwriter, the composer, and the actor—even when there would be no other actor in the film.

The problem was made worse in *16 Casa Duse, LLC v. Merkin*. There, the control criterion was firmly transplanted into the Second Circuit, which had not, until then, “proffered rules for determining which of multiple authors is ‘dominant.’”<sup>363</sup> Since both producer and director arguably

<sup>354</sup> For example, in European Union directives, the director of a cinematographic work is expressly considered an “author.” See, e.g., Council Directive 2006/115/EC of the European Parliament and of the Council of 12 December 2006 on Rental Right and Lending Right and on Certain Rights Related to Copyright in the Field of Intellectual Property, 2006 O.J. (L 376) art. 2, § 2 (“The principal director of a cinematographic or audiovisual work shall be considered as its author or one of its authors. Member States may provide for others to be considered as its co-authors.”).

<sup>355</sup> *Aalmuhammed v. Lee*, 202 F.3d 1227, 1232 (9th Cir. 2000).

<sup>356</sup> *Id.*

<sup>357</sup> *Id.* at 1233.

<sup>358</sup> *Id.* at 1234.

<sup>359</sup> LaFrance, *supra* note 343, at 224 (“Not only is the concept of a dominant author utterly absent from the 1976 Act and its legislative history, but is inconsistent with both.”).

<sup>360</sup> *Blizzard Entm’t, Inc. v. Lilith Games (Shanghai) Co.*, No. 3:15-cv-04084, 2017 WL 2118342, at \*1 (N.D. Cal. 2017) (quoting *Aalmuhammed*, 202 F.3d at 1232).

<sup>361</sup> *Richlin v. Metro-Goldwyn-Mayer Pictures, Inc.*, 531 F.3d 962, 967–68 (9th Cir. 2008).

<sup>362</sup> *Aalmuhammed*, 202 F.3d at 1233 (emphasis added); *Blizzard Entm’t*, 2017 WL 2118342, at \*1.

<sup>363</sup> *16 Casa Duse, LLC v. Merkin*, 791 F.3d 247, 260 (2d Cir. 2015).

controlled the “whole work,” the *Casa Duse* court essentially did a head-to-head comparison of who had *more* control, finding that “Casa Duse exercised far more decision[-]making authority”<sup>364</sup> and that the district court was correct in its determination that “Casa Duse was the dominant author” of the film.<sup>365</sup>

The *16 Casa Duse* language itself reveals the problem: if the inquiry is to “determin[e] which of multiple authors is ‘dominant,’” one has already conceded that there are *other* authors of the work. The requirement that one “superintend” the work as a whole or “master mind” the work unduly narrows authorship and eliminates too many creative contributors. As Jay Dougherty has pointed out, in the extreme the “mastermind” test for authorship slips into “a mutant species of work for hire basically based on the right to control.”<sup>366</sup> A court considering an actor’s claim of joint authorship would be better to hone to the statute, the more reasonable approach in *Richlin*, and Congress’s clear intent.

### 3. *The Intent to be Joint Authors*

Finally, there is the actual statutory requirement: that the numerous authors have “the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”<sup>367</sup> The legislative history says that “the touchstone here is *the intention, at the time the writing is done*, that the parts be absorbed or combined into an integrated unit.”<sup>368</sup> In the 1991 *Childress v. Taylor* decision, Judge Newman concluded that such a plain intention to “merge” contributions would not be enough—otherwise the statute “would extend joint author status to many persons who are not likely to have been within the contemplation of Congress.”<sup>369</sup> Newman’s primary example was a book editor who “makes numerous useful revisions to [a] first draft”—both the writer of the first draft and the editor intend for the revisions to be incorporated into the works, but neither intend for the editor to become a joint author.<sup>370</sup> For joint authorship to occur, the *Childress* court required the parties to “entertain in their minds the concept

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<sup>364</sup> *Id.*

<sup>365</sup> *Id.*

<sup>366</sup> Dougherty, *supra* note 296, at 468. *See also* LaFrance, *supra* note 343, at 254 (“[The *Aalmuhammed* ‘mastermind’ test] would make work made for hire contracts largely superfluous in the motion picture industry.”).

<sup>367</sup> 17 U.S.C. § 101 (2012). The statute does not expressly say that all the multiple authors must have this intention, although that can be reasonably inferred.

<sup>368</sup> H.R. REP. NO. 94-1476, at 120 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5736 (emphasis added).

<sup>369</sup> *Childress v. Taylor*, 945 F.2d 500, 507 (2d Cir. 1991).

<sup>370</sup> *Id.*

of joint authorship.”<sup>371</sup> Courts have adopted this interpretation of the statutory “intention” requirement with relatively little variation.<sup>372</sup>

There has been little or no development of what it means for parties to “intend” to be “joint authors” or to intend “joint authorship.” But one does not need a PhD in psychology to know that “intentionality” can be complex and layered; what people “intend” has been subject to much more rigorous examination in philosophy<sup>373</sup> or criminal law than in intellectual property. In the 1999 *Holloway v. United States* case,<sup>374</sup> the Supreme Court concluded that “intent” in a criminal statute includes not just “unconditional intent,” but also “conditional intent”—what one is *willing to do* to achieve certain outcomes if certain contingent facts happen.<sup>375</sup>

The *Holloway* holding may be limited to “intent” in that particular federal statute<sup>376</sup> or use of “intent” in criminal laws,<sup>377</sup> but it also points to some interesting possibilities: surely there are many circumstances—perhaps most—where the intent to be joint authors is *conditional*, i.e., “we will be joint authors if you do your share of the work.” This is suggested by the *Childress* court’s observation that “[a]n inquiry into how the putative

<sup>371</sup> *Id.* at 508.

<sup>372</sup> *See, e.g.*, *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1070 (7th Cir. 1994) (requiring that the parties “intended to be joint authors at the time the work was created”); *Nordstrom Consulting, Inc. v. M & S Tech., Inc.*, No. 06C3234, 2008 WL 623660, at \*5 (N.D. Ill. 2008) (citing *Erickson* for the same proposition); *Design Options, Inc. v. BellePointe, Inc.*, 940 F. Supp. 86, 90 (S.D.N.Y. 1996) (requiring each party to intend “that the work be jointly owned”); *Papa’s-June Music, Inc. v. McLean*, 921 F. Supp. 1154, 1157 (S.D.N.Y. 1996) (requiring each party to “intend to regard themselves as joint authors”).

<sup>373</sup> G.E.M. Anscombe, *Intention*, 57 PROC. ARISTOTELIAN SOC’Y 321–32 (1956–57) (discussing the philosophy behind determining human intention); *see also* LUDWIG WITTGENSTEIN, *PHILOSOPHICAL INVESTIGATIONS* ¶¶ 197–205 (G.E.M. Anscombe trans., Macmillan Publ’g Co., 3d ed. 1973) (using the example of an intention to play chess).

<sup>374</sup> 526 U.S. 1 (1999).

<sup>375</sup> *Id.* at 7. At issue was a jury instruction given by the District Court. *Id.* at 4 (“In some cases, intent is conditional. That is, a defendant may intend to engage in certain conduct only if a certain event occurs. In this case, the government contends that the defendant intended to cause death or serious bodily harm if the alleged victims had refused to turn over their cars. If you find beyond a reasonable doubt that the defendant had such an intent, the government has satisfied this element of the offense . . .”).

<sup>376</sup> *Id.* at 6 (“The specific issue in this case is what sort of evil motive Congress intended to describe when it used the words ‘with the intent to cause death or serious bodily harm’ in the 1994 amendment to the carjacking statute.”).

<sup>377</sup> *People v. Connors*, 97 N.E. 643, 645 (Ill. 1912) (holding that a “specific intent to kill” could be found even though that intent was “coupled with a condition”); *Beall v. State*, 101 A.2d 233, 236 (Md. 1953) (following *Connors*); *People v. Vandelinder*, 481 N.W.2d 787, 789 (Mich. Ct. App. 1992) (following *Connors*); *Price v. State*, 79 S.W.2d 283, 284 (Tenn. 1935) (following *Connors*). Section 2.02(6) of the Model Penal Code provides: “Requirement of Purpose Satisfied if Purpose is Conditional. When a particular purpose is an element of an offense, the element is established although such purpose is conditional, unless the condition negatives the harm or evil sought to be prevented by the law defining the offense.” MODEL PENAL CODE § 2.02(6) (AM. LAW INST. 1984). *See also* Larry Alexander & Kimberly D. Kessler, *Mens Rea and Inchoate Crimes*, 87 J. CRIM. L. & CRIMINOLOGY 1138, 1140–57 (1997) (discussing the problems related to “conditional purposes”).

joint authors regarded themselves in relation to the work has previously been part of our approach in ascertaining the existence of joint authorship.<sup>378</sup> It seems clear that dramatic performers working on an audiovisual work do have “the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole,”<sup>379</sup> but it remains an interesting question how one would measure intent to be joint authors for a dramatic performer. Would knowledge of recognition in a film’s credits—along with everyone else—indicate an intent to be a joint author? Recognition as a performer? Would an actor’s knowledge of “top-billing” (or “above title-billing”) increase their sense that they were a joint author?<sup>380</sup> Given all that dramatic performers think about their craft, it seems unlikely that the actor would think she is *not* an author.

#### 4. *A Joint Author May be Entitled to a (Very) Small Ownership Share*

In approaching joint authorship claims in copyright cases, courts have assumed that a finding of joint authorship will mean that each joint author is entitled to an *equal* share of the financial proceeds, distorting joint authorship inquiries by creating both a high-stakes incentive for parties to claim joint authorship and a motivation for judges to find against such claims.<sup>381</sup>

But nothing in the Copyright Act requires that outcome, and the legislative history indicates that that was *not* Congress’s intent. In the situation of a joint work, the Copyright Act provides that the “authors of a joint work are co[-]owners of copyright in the work,”<sup>382</sup> and makes no mention of their respective ownership shares. The House Report accompanying the 1976 Act also lacks any discussion of ownership shares, but it clearly states that, “[u]nder the bill, as under the present law, co[-]owners of a copyright would be treated generally as tenants in common.”<sup>383</sup>

<sup>378</sup> *Childress v. Taylor*, 945 F.2d 500, 508 (2d Cir. 1991).

<sup>379</sup> *Id.* at 504.

<sup>380</sup> *Top billing*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/top%20billing> (last visited Sept. 24, 2018) (defining “top billing” as: (1) “prominent emphasis, featuring, or advertising”; or (2) “the position at the top of a theatrical bill usually featuring the star’s name”). As one commentator explains, “[a]nywhere from one to three lead actors are often listed just before the title. It’s a similar position to the *auteur*, as the presence of these star actors is the reason many people came to see the movie.” Peter Bohush, *Opening Credits: Who, What, Where, When, and Why?*, NEWENGLANDFILM.COM (Aug. 1, 2012), <https://newenglandfilm.com/magazine/2012/08/credits> (last visited Sept. 24, 2018).

<sup>381</sup> See Benjamin E. Jaffe, Note, *Rebutting the Equality Principle: Adapting the Co-Tenancy Law Model to Enhance the Remedies Available to Joint Copyright Owners*, 32 CARDOZO L. REV. 1549, 1556–57 (2011) (making similar observations).

<sup>382</sup> 17 U.S.C. § 201(a) (2012). The moral rights provision of the Copyright Act similarly provides that “[t]he authors of a joint work of visual art are coowners [sic] of the [moral] rights conferred by subsection (a) in that work.” *Id.* § 106A(b).

<sup>383</sup> H.R. REP. NO. 94–1476, at 121 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5736 (emphasis added).

In interpreting the Copyright Act, courts have traditionally assumed that Congress intended copyright law to follow common law rules and principles,<sup>384</sup> unless the statute expressly digresses from those rules and principles.<sup>385</sup> In fact, within joint authorship, the duty to account appears to arise from common law principles; it is not to be found in the statute.<sup>386</sup> So it follows that when Congress chose to impose the structure of a tenancy-in-common on joint authors, Congress should be presumed to have intended to perpetuate common law principles for determining the tenants' relative ownership shares for joint authors. And nothing in those common law principles requires equal shares among tenants-in-common.

At best, the common law has a rebuttable presumption of equal ownership shares and that presumption is rebutted by clear evidence of intent, unequal contribution, or other circumstances establishing that equal ownership would be inappropriate. At common law, tenants-in-common simply "need not have equal shares in the property,"<sup>387</sup> and there is *abundant* case law that unequal contributions by tenants-in-common to the purchase, development, or maintenance of real property will produce proportionate, unequal ownership shares.<sup>388</sup>

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<sup>384</sup> *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 538 (2013) ("[W]hen a statute covers an issue previously governed by the common law, we must presume that 'Congress intended to retain the substance of the common law.'" (quoting *Samantar v. Yousuf*, 560 U.S. 305, 320 n.13 (2010))); *Comty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 738 (1989) (interpreting "employee" and "scope of employment" in Copyright Act "to describe the conventional master-servant relationship as understood by common-law agency doctrine").

<sup>385</sup> This is just part of the broader interpretative canon establishing a presumption that statutes do not derogate from common law principles. See *Samantar*, 560 U.S. at 320 (2010) (footnote omitted) ("The canon of construction that statutes should be interpreted consistently with the common law helps us interpret a statute that clearly covers a field formerly governed by the common law."); *Astoria Fed. Sav. & Loan Ass'n v. Solimino*, 501 U.S. 104, 108 (1991) (citations omitted) ("[W]here a common-law principle is well established . . . the courts may take it as given that Congress has legislated with an expectation that the principle will apply except 'when a statutory purpose to the contrary is evident.'" (quoting *Isbrandtsen Co. v. Johnson*, 343 U.S. 779, 783 (1952))); *Isbrandtsen Co.*, 343 U.S. at 783 (1952) ("Statutes which invade the common law . . . are to be read with a presumption favoring the retention of long-established and familiar principles, except when a statutory purpose to the contrary is evident.").

<sup>386</sup> *Oddo v. Ries*, 743 F.2d 630, 633 (9th Cir. 1984) ("[T]he duty to account does not derive from the copyright law's proscription of infringement. Rather, it comes from 'equitable doctrines relating to unjust enrichment and general principles of law governing the rights of co-owners.'" (quoting *Harrington v. Mure*, 186 F. Supp. 655, 657–58 (S.D.N.Y. 1960))); H.R. REP. NO. 94–1476, at 121 (1985), as reprinted in 1976 U.S.C.C.A.N. 5659, 5736 ("Under the bill, as under the present law, coowners [sic] of a copyright would be treated generally as tenants in common, with each coowner having an independent right to use or license the use of a work, subject to a duty of accounting to the other coowners for any profits.").

<sup>387</sup> 2 HERBERT THORNDIKE TIFFANY, *THE LAW OF REAL PROPERTY* § 426, at 213 (3d ed. 1939); see also RICHARD R. POWELL, *POWELL ON REAL PROPERTY* § 50.02[5] (Michael Allan Wolf, ed., 2009), LEXIS ("The undivided fractional shares held by tenants in common are usually equal and are presumed to be equal unless circumstances indicate otherwise.").

<sup>388</sup> *Ordlock v. Comm'r*, 126 T.C. 47, 88 (2006) (noting that the presumption that tenants in common have equal ownership shares "may be overcome by contrary evidence"); *Anderson v. Broadwell*, 6 P.2d 267, 268–69 (Cal. Ct. App. 1931) (holding that among three tenants in common, one was entitled to half

Against that abundant case law on ownership apportionment among tenants-in-common, there is quite little case law directly dealing with apportionment among joint authors.<sup>389</sup> The rare, possibly lone case directly deciding this issue was the 1960 *Sweet Music, Inc. v. Melrose Music Corp.*<sup>390</sup> litigation in which the district court found that two joint authors of a musical composition were entitled to equal ownership shares of the composition despite the defendant having written all of the music and what appears to have been a majority of the lyrics.<sup>397</sup> Despite unequal contributions to the creation of the work, the court found that “[n]o facts [we]re in evidence indicating that the ownership was intended as other than an undivided one-half interest for each of the co-authors,”<sup>391</sup> and that there was some evidence—a prior assignment agreement—for the parties to share in the profits equally.<sup>392</sup> The *Sweet Music* outcome can be explained as the court believing the evidence of intent undermined the evidence of unequal

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interest in property because he paid half the purchase price); *Fernandes v. Rodriguez*, 879 A.2d 897, 903 (Conn. App. Ct. 2005) (affirming trial court’s use of differing financial contributions of each party toward the purchase of the property as a “particularly relevant” factor in its determination of equities between the co-tenants); *Schroeder v. Todd*, 86 N.W.2d 101, 104 (Iowa 1957) (“Proof of unequal contribution to purchase price of realty by grantees, in conveyance to purchasers of tenancy in common, overcomes presumption that they take equal shares, and raises presumption they intended to share in proportion to amounts contributed by each.”); *Lemay v. Hardin*, 48 S.W.3d 59, 63 (Mo. Ct. App. 2001) (awarding one tenant in common disproportionate share on the basis of the cost of repairs, improvements, or other property-related expenses unilaterally incurred by the tenant); *Spector v. Giunta*, 405 N.E.2d 327, 331 (Ohio Ct. App. 1978) (affirming lower court order distributing property interests in proportion to the contributions of each party, but remanding to allow further evidence showing contributions made for repairs and improvements to the property); *Cudmore v. Cudmore*, 311 N.W.2d 47, 49 (S.D. 1981) (“This [equality] presumption is rebuttable, however, by a showing of unequal contribution . . . [which] raises a new presumption that the grantees intended to share in proportion to their contribution.”); *Huffman v. Mulkey*, 14 S.W. 1029, 1031 (Tex. 1890) (determining tenant in common’s share by contribution to the total price of the deed); *Cummings v. Anderson*, 614 P.2d 1283, 1287 (Wash. 1980) (en banc) (“[W]hen in rebuttal it is shown that they contributed unequally to the purchase price, a presumption arises that they intended to share the property proportionately to the purchase price.”).

<sup>389</sup> See Jaffe, *supra* note 381, at 1556 (“[T]here is very little case law directly dealing with the issue of apportioning profits in an accounting action.”); A.E. Korpela, *Rights and Remedies of Co-Owners of Copyright*, 3 A.L.R.3d 1301 § 6(b) (2011) (“[Because of the] dearth of case law on the subject, there appears to be little source material for discussion of the basis for determining the shares of copyright co-owners in accounting.”). Because of the lack of copyright case law on this point, it might be mentioned that in patent law, each co-inventor has *complete freedom* to use and license the invention without any duty to account to the other co-inventor(s). But this reflects a difference in the statutes. 17 USC §201(a) provides that “[t]he authors of a joint work are coowners of copyright in the work” and the legislative history ties this to Joint tenancy and all that goes with it. In contrast, 35 USC § 262 expressly provides that “[i]n the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.”

<sup>390</sup> 189 F. Supp. 655 (S.D. Cal. 1960).

<sup>397</sup> *Id.* at 659.

<sup>391</sup> *Id.*

<sup>392</sup> *Id.* (“The 1939 assignment, providing for advance royalties to be paid to Sweet and Grant, states that these royalties are ‘to be divided equally between them.’”).

contribution, but there are also statements in the opinion indicating the judge did not fully understand ownership shares in tenancy-in-common.<sup>393</sup>

The idea that joint authorship *requires* equal ownership shares—what one commentator calls the “equality principle”<sup>394</sup>—is just a notion that pops up in dicta repeatedly with courts seeming to mistake “equal undivided interests in the whole work”<sup>395</sup> for purposes of *exploitation of rights* to mean an “equal ownership share.”<sup>396</sup> The better rule is the common law principle governing tenants-in-common: that tenants-in-common “need not have equal shares in the property,”<sup>397</sup> and clear evidence of the parties’ intent or the parties’ unequal contribution can lead to allocation of unequal, proportionate shares. Proof of differing contributions in copyright joint authorship cases will not be particularly different than proof of differing contributions in real property disputes. Proof of intent to have differing ownership shares can also readily be part of the evidence before a court in a copyright dispute.<sup>398</sup> Indeed, with musical compositions it is very common for authors to establish unequal shares in their royalties documentation.<sup>399</sup>

Eliminating any irrebuttable presumption of equal shares could dampen the enthusiasm of some litigants to make joint authorship claims, but a court’s conclusion that someone is a “joint author” still gives that person the opportunity to license a work non-exclusively as well as to prevent exclusive licensing of the work. In short, these claims still pose both a substantial risk and a meaningful nuisance to film producers and others who consolidate the economic rights in complex works.<sup>400</sup> In other words, a willingness to

<sup>393</sup> *Id.* at 657–59.

<sup>394</sup> See Jaffe, *supra* note 381, at 1550 (citation omitted) (“Furthermore, the courts’ application of the accounting remedy in copyright law has resulted in the conclusive presumption that absent an agreement to the contrary, joint copyright authors possess equal ownership interests in a work (the equality principle).”).

<sup>395</sup> Thomson v. Larson, 147 F.3d 195, 199 (2d Cir. 1998) (“Joint authorship entitles the co-authors to equal undivided interests in the whole work—in other words, each joint author has the right to use or to license the work as he or she wishes, subject only to the obligation to account to the other joint owner for any profits that are made.”).

<sup>396</sup> See Jaffe, *supra* note 381, at 1550.

<sup>397</sup> TIFFANY, *supra* note 387, § 426, at 213.

<sup>398</sup> See, e.g., Janky v. Lake County Conv. & Visitors Bureau, 576 F.3d 356, 360 (7th Cir. 2009) (“Similarly, she filed a document with the American Society of Composers, Authors and Publishers (ASCAP) stating that Farag held a 10 percent ‘ownership share.’”).

<sup>399</sup> For example, colleagues at ASCAP report that it is currently very common for authors to stipulate unequal shares in their ASCAP documentation. As one example, a band may agree to apportion every main member in the group a writing credit, but give the song’s main writer the lion’s share. Email correspondence with Mr. Sam Mosenkis, Vice President, Business and Legal Affairs, ASCAP, July 3, 2018 [on file with author]; Email correspondence with Seth Saltzman, Senior Vice President, ASCAP, July 5, 2018 [on file with author].

<sup>400</sup> NIMMER & NIMMER, *supra* note 140, § 6.12(A) (“[I]n the present era of mass communications, use by one joint owner practically destroys the value of the copyright, and in effect precludes the other joint owner from himself using the work . . .”). But because a joint authorship dispute is likely to be litigated after exploitation of the work is well underway, the threat embodied in a

recognize unequal shares among joint authors would correct judicial fears of windfalls to undeserving litigants without diminishing film producers' incentives to get work-for-hire arrangements properly in place.

### CONCLUSION

Among the different kinds of works eligible for copyright, audiovisual works are arguably the most complex, often involving scores of contributors—screenwriters, directors, actors, cinematographers, producers, set designers, costume designers, lighting technicians, etc. Some countries expressly recognize which categories of these contributors are entitled to legal protection, whether copyright, “neighboring rights,” or statutory remuneration. But American copyright law does not. Given that the complex relationship among these creative contributors is usually governed by contract, there has been—for such a large economic sector—relatively little discussion of authorship in audiovisual works.

But glimmers of case law, pronouncements from the U.S. government, and commentary from scholars support the conclusion that actors can be “authors” under American copyright law. Indeed, any other conclusion would be inconsistent with basic principles of our copyright law.

The Ninth Circuit’s 2015 *en banc* decision in *Garcia v. Google* is sometimes misunderstood as denying copyright protection to actors. But the *Garcia* decision was more about fraud and fatwas than clear conclusions on how copyright law applies to actors and acting. Stepping back from the strange facts of *Garcia*, the same principles that allow us to recognize copyright in a musician’s recorded performance of a preexisting musical composition should apply to an actor’s recorded performance of a script. Certainly, people in the acting community believe that their work is *expressive*, using the same terminology as other creative communities.

Recognizing that actors’ performances are original expression subject to copyright protection does not lead inextricably to a “copyright of thousands” problems because of the robust mechanisms—both legal and customary—that consolidate rights and permissions in a film with the film producer. On the rare occasion when those filters fail and we are forced to determine if an actor is an author of an audiovisual work, a finding of joint authorship need not be disruptive of a film producer’s successful exploitation of the film.

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declaration of joint authorship might be blunted to some degree. It might also be the case that joint authors should be declared fiduciaries of one another, mitigating any market-undermining actions. See Avner D. Sofer, *Joint Authorship: An Uncomfortable First with Tenancy in Common*, 19 LOY. L.A. ENT. L. REV. 1, 3 (1998) (proposing that joint authors should be fiduciaries to one another). For a bolder proposal, see Abraham Bell & Gideon Parchomovsky, *Copyright Trust*, 100 CORNELL L. REV. 1015, 1055 (2015) (proposing trusts in which one joint author is “owner-trustee” with full managerial power, while all other joint authors are “owner-beneficiaries”).