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Performers' Rights and the Performance Right: A Constitutionally Confusing Conflation of Constructs

Sheldon Halpern (Moritz College of Law, The Ohio State University) · Thursday, July 2nd, 2015

The bizarre saga known as *Garcia v. Google* has finally come to end with an eleven judge *en banc* decision of the United States Court of Appeals for the Ninth Circuit (Garcia v. Google, Inc., 786 F.3d 733 (9th Cir. 2015)). That holding came in response to a remarkable, if not astonishing holding by a two to one majority of a Ninth Circuit panel. The *en banc* hearing, and its result, overturning the panel majority, was not at all surprising. The issue, however, was disturbing enough to have generated the filing of thirteen different *amici curiae* briefs on behalf of more than forty different purported *amici*.

While the end result was fully anticipated the case itself raises significant issues about the constitutional underpinning of US copyright law in the context of attempts, by treaty and legislation, to harmonize US copyright law with that of the European Union and most of the rest of the world. Unfortunately, this seriously important issue was obfuscated by its unlikely and bizarre context.

The case involved a claim by an actress that her brief filmed performance was itself, irrespective of the matter performed, a "work" protected by the United States Copyright Act. Nine of the eleven judges unequivocally rejected the copyright claim, finding no protected "work" from an actor's performance as such (one judge concurred but on the ground of no irreparable injury to justify injunctive relief; one judge, Kozinski, dissented). The copyright claim itself, that produced the succeeding firestorm, was essentially a makeweight to get around statutory restrictions on what might have been the appropriate form of relief in the circumstances.

Cindy Lee Garcia was paid $500 to perform four pages of script and attend three and half days filming as an actor with a small part in a film to be entitled *Desert Warrior*. Without her knowledge or consent, her performance was instead altered and used in an anti-Islamic film that was posted on YouTube. That film led to protests around the world and to issuance of a fatwa against all those involved in it, including Garcia. This misuse of her image might well have provided Garcia with a claim under accepted state defamation law and/or rights of privacy and publicity precedents.

The problem for Garcia was that she was primarily interested in having the offending material taken down from the internet. However, such a remedy, in traditional defamation or privacy or

publicity law, was expressly precluded by the provisions of the Communications Decency Act (47 U.S.C §230) which immunizes an internet service provider with respect to defamation or privacy/publicity liability arising from the posting of material provided by a third party. Although the ISP immunity was part of an overall legislative scheme embodied in the Act to deter child pornography, when the Supreme Court found the Communications Decency Act to be an unconstitutional abridgement of first amendment rights of free speech, the immunity provisions were allowed to stand, and thus served to bar the appropriate action against YouTube (or its owner, Google). To reach Google, and get the offending material off the internet, Garcia sought to frame her claim as one of copyright infringement, alleging that her "performance" was a protected work and that the Google/YouTube use of it and refusal to take it down after notice was an act of copyright infringement.

To no one's surprise, the federal district court in California denied her request for a mandatory injunction, holding that the "performance" by an actor standing alone (as opposed to the material performed) is not itself a "work" within the contemplation of the Copyright Act. To most everyone's surprise, Judge Alex Kozinski, writing for himself and one other member of the Ninth Circuit three judge reviewing panel, reversed, finding a colorable copyright in Garcia's performance itself. After vacating the panel opinion by granting an *en banc* rehearing, the full bench, with Judge Kozinski dissenting, affirmed the district court denial of relief and expressly held that a "performance" of a "work" is not itself an independent "work" to which copyright can attach.

This result is fully consistent both with the very nature of US copyright law and its constitutional underpinnings and would itself not be remarkable, let alone worthy of the intense interest the case generated. The difficulty however is that the case, while a poor vehicle, serves to reveal a serious gap between these constitutional underpinnings and the recent movement toward a harmonized approach to copyright law. In short, although the 1998 Digital Millennium Copyright Act purports to implement the WIPO Performances and Phonograms Treaty (the "WPPT"), in fact US copyright law does not generally recognize an independent "performers'" right, as opposed to a "performance" right in the "work" being performed. So, too, while the Beijing Treaty, to which the US is a signatory, purports generally to recognize such an independent "performers'" right, that treaty has not yet been ratified and, Judge Kozinski to the contrary notwithstanding, is not as yet part of US copyright law.

The truly interesting and far reaching question, however, assuming that current US law does not recognize a performance as a "work" for copyright purposes, is whether the US Congress could constitutionally create such copyright protection, either by *sui generis* legislation or through implementation of the Beijing Treaty. The issue, in short, is really one of congressional constitutional power. That power, to enact copyright legislation, derives from Article 1, section 8 of the Constitution, authorizing the grant of the copyright monopoly to the "writings" of "authors" and although both of those words have been construed expansively, there remain certain fundamental parameters for copyright protection under the US Constitution: as the Supreme Court has made clear, "originality" (in the sense of independent authorship coupled with minimal creativity) "is the *sine qua non* of copyright"; and copyright attaches to a "work of authorship" once it is "fixed in a tangible medium of expression." These limiting concepts, fundamental to US copyright law, are by no means universal and do not serve the same limiting function in the European Union. Thus, whether under the WPPT or the Rome Convention or Beijing, one does not ask, in considering a "performance" as such, what is the "work of authorship" to which one seeks to attach copyright nor is it necessary to find "originality" in that performance.

An analogous, although unstated, issue arises in connection with US protection of "sound recordings" under the Copyright Act. Theoretically, at least, the sound recording copyright, albeit more limited than the general copyright, attaches to a "sound recording" irrespective of the matter recorded and irrespective of any originality in the recording process. One must ask, where is the constitutionally requisite "originality" to justify attaching copyright to a recording as such, without more? That is, the sound recording copyright is *not* predicated on the recording being a protectable derivative work of the matter recorded or on anything at all beyond the simple existence of the recording. In this same vein, if a "performer" has copyright-like rights in his or her "performance" irrespective of the material performed – as in the EU to some extent, and much as broadcasters do in the EU, to a greater extent, with respect to their broadcasts – how does one find a "work of authorship" in the performance itself to satisfy US constitutional constraints?

We have not asked these questions with respect to the US sound recording copyright, which by now has become firmly embedded in US law. As to performers' rights, the US has signed onto Beijing while the area remains in a legal-constitutional limbo. To an extent, we plunge ahead, on the assumption that, either by simple neglect, as in the case of sound recordings, or by magical application of congressional power outside of the Constitution's copyright clause (e.g., through commerce clause or treaty power interpretive legerdemain, neither of which have as yet been effectively recognized at the highest level).

Cindy Garcia's copyright issue, which arose only as an attempt to avoid the statutory impediments to her real claim, standing alone, is quite limited in that for most actors in motion pictures the question of the performer's rights is elided by contractual provisions and work-for-hire doctrine. However, on a global scale, the "performers' rights" question, like that of the EU's broadcasters' rights, constitutes both a significant difference between the EU and the US and requires us, in looking at the continuing matter of harmonization of US and EU copyright law to fashion a regimen that recognizes and respects the institutional and constitutional constraints in each system. This is not easy. Just consider what it will take for the EU to adopt a nuanced and sophisticated approach to a harmonized "fair use" or flexible exception copyright doctrine. Nevertheless, such a nuanced and sophisticated approach is both possible and in fact the only realistic way to deal with the problem. (The overall issue of constitutional and institutional issues in creating a framework for harmonization is discussed in Sheldon W. Halpern and Phillip Johnson, *Harmonising Copyright Law and Dealing with Dissonance: A Framework for Convergence of US and EU Law* (Edward Elgar Publishing, Ltd., 2014).

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