

Copyright Decisions Demonstrate the Perils of Posting and Using Visual Content Online

Two recent decisions by federal courts emphasize the copyright complications that can arise when media entities post visual content online. In the first case, the U.S. Court of Appeals for the Ninth Circuit ordered Google to take down the “Innocence of Muslims” video after an actress sued Google claiming she had a right to control her performance under the Copyright Act and was not aware at the time the film was shot that it would be offensive to Muslims. In the second case, *Morel v. Getty Images, et al.*, a jury in the United States District Court for the Southern District of New York in Manhattan awarded a photographer \$1.22 million in statutory damages after several media organizations posted and distributed online a photograph which he took in Haiti after the 2010 earthquake without attributing it to him. The two cases highlight the importance of understanding copyright in the online context. They also raise questions about the distribution of copyrighted content going forward.

Ninth Circuit Sides with Actress in “Innocence of Muslims,” Orders Google to Remove Video From YouTube

On Feb. 26, 2014 in a 2-1 decision, the United States Circuit Court of Appeals for the Ninth Circuit ordered Google to remove a controversial video, “Innocence of Muslims,” from YouTube. *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014). An actress in the video, Cindy Lee Garcia, claimed that her performance in the film was dubbed over after filming to offend Muslims in a manner that was unknown to her and to which she did not consent. She argued she owned the copyright in her individual performance and that Google infringed her copyright by refusing to remove it from YouTube. The Ninth Circuit’s ruling has sparked controversy about the “moral rights” of artists and implicates significant free speech principles. As the *Bulletin* went to press, the Ninth Circuit was considering whether to grant Google’s petition for a rehearing of the case *en banc*.

In July 2012, a man named Nakoula Basseley Nakoula, who has since changed his name to Mark Basseley Youssef, uploaded two videos to YouTube which he claimed were trailers for the film “Innocence of Muslims.” The videos were offensive to many Muslims and sparked international outrage, including protests and demands from the international community for Google to take the video down. Google chose to block the video in Egypt and Libya, and had to block the video in Indonesia, Saudi Arabia, Malaysia, India, and Singapore under those

countries' censorship laws. The video was also involved in controversy because it was initially tied to the Sept. 11, 2012 attack on the U.S. embassy in Benghazi, Libya. (For more on the arguments to remove the video, see "Activists, U.S. Government Advocate Removal of User-Generated Content" in the Summer 2013 issue of the *Silha Bulletin*.)

After the video appeared online, several of the actors who appeared in the film announced that they were misled into performing in the film. They said they responded to casting calls posted by Sam Bacile, Youssef's alias, in July 2011. The casting calls for the film stated the film was to be called "Desert Warrior" and it would portray battles occurring after a comet struck Earth. After the actors filmed their scenes, they argued the filmmakers dubbed over the film without their knowledge, turning it into a short video that expressed strong anti-Muslim sentiments. Police later arrested Youssef and he pled guilty to four probation violations for lying to his probation officer and using aliases on Nov. 7, 2012.

Garcia sought to remove the film from YouTube after an Egyptian cleric issued a fatwa calling for the killing of anyone involved with "Innocence of Muslims." Garcia had a minor role in which she appeared on screen for five seconds and was paid \$500. In the dubbed version of the film, she appears to ask, "Is your Mohammed a child molester?" Garcia issued Digital Millennium Copyright Act (DMCA) takedown notices to Google and YouTube on Sept. 24 and 25, 2012, arguing the video violated her copyright in her performance. Google and YouTube refused to take the video down. On Sept. 26, 2012, Garcia filed a complaint in the United States District Court for the Central District of California for a temporary restraining order to have the film removed from YouTube, alleging direct and indirect infringement of copyright under 17 U.S.C. § 106. She argued Google and YouTube violated her copyright in her performance by maintaining its presence online against her will. She also made claims against the film's producers, who never responded to the complaint. The district court denied Garcia's request because it found that she was unlikely to succeed in her copyright claims because she had granted the producers an implied license to use her performance in the film. *Garcia v. Google, et al.*, No. 2:12-cv-08315-MWF-VBK (C.D.Cal. 2013). She appealed the denial to the Ninth Circuit.

Writing for the 2-1 majority, Chief Justice Alex Kozinski held on Feb. 26, 2014 that Garcia had a copyright interest in her performance in "Innocence of Muslims" and ordered Google to remove the video from YouTube. *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014). Kozinski concluded that Garcia's performance satisfied the standard for a copyrighted work because it "evinced[d] 'some minimal degree of creativity . . . no matter how crude, humble or obvious' it might be" (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)). He

noted that her performance met the minimum requirement for creativity even though her voice was dubbed over because even pantomimes qualify for protection. Kozinski wrote that because her performance added her own “body language, facial expression and reactions to other actors and elements of the scene,” she had a copyright interest in her individual performance. He acknowledged that this conclusion demonstrates that “any analysis of the rights that might attach to the numerous creative contributions that make up a film can quickly become entangled in an impenetrable thicket of copyright.” He stated that the issue of copyright interests rarely reaches this “thicket” because most films are governed by contracts, the work for hire doctrine or implied licenses. He then turned to an analysis of whether Garcia’s performance qualifies as a work made for hire, or, alternatively, whether Garcia had granted the filmmaker an implied license to use her performance.

Kozinski wrote that Garcia’s performance in “Innocence of Muslims” was not a work for hire and thus Garcia retained the copyright in her performance. A work is made for hire if it is “prepared by an employee within the scope of his or her employment” or if it is “specially ordered or commissioned for use . . . as a part of a motion picture . . . if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.” 17 U.S.C. § 101. There was no written instrument to qualify the performance as a work for hire under the second part of the definition. Kozinski also concluded Garcia was not Youssef’s employee. Garcia was hired only for a specific task that lasted for three days and Youssef did not provide any traditional benefits of employment. Kozinski emphasized that Youssef was not in the “regular business” of filmmaking because, if that was the case, “every schmuck with a videocamera becomes a movie mogul.”

Kozinski also found that Garcia had granted Youssef an implied license in this case, agreeing with Google that Garcia auditioned for her role, performed it, and expected the film to be released. The majority also found that the license should be construed broadly because any “narrow, easily exceeded license could allow an actor to force the film’s author to re-edit the film” or “prevent the film’s author from exercising his exclusive right to show the work to the public.” Kozinski wrote that a narrow implied license would mean that “actors could leverage their individual contributions into *de facto* authorial control over the film.” In this case, however, Kozinski concluded that Youssef’s use of Garcia’s performance “differs so radically from anything Garcia could have imagined when she was cast that it can’t possibly be authorized by any implied license she granted Youssef.” Kozinski noted that Youssef had to lie to obtain Garcia’s performance, and concluded that situations where a performance would be used

so wildly beyond the actor's expectations are rare, but Garcia had presented just such a case and so was likely to succeed on the merits of her claim.

To succeed in her request for a preliminary injunction, the court noted Garcia needed to show that she would suffer irreparable harm if the infringement were allowed to continue. Garcia argued that the ongoing infringement and fatwa, subjecting her to death threats, constituted irreparable harm. The court concluded the harm was "real and immediate" based on the "ongoing and serious" threats against Garcia's life and security precautions she had been forced to take, including relocating both her home and business and that she would have to continue to take security requirements in the future. Google argued that the harm occurred based on her performance in the film, not YouTube's continued hosting of it, and so her copyright claim was not the cause of the harm. The court disagreed, finding that "[t]aking down the film from YouTube will remove it from a prominent online platform—the platform on which it was first displayed—and will curb the harms of which Garcia complains." The court concluded that Garcia was likely to succeed on her copyright claim and ordered the preliminary injunction, requiring Google to remove the film from YouTube.

After the Feb. 26, 2014 opinion was released, news outlets learned that the court had instructed Google to take the video down from YouTube and prevent any uploading of the video in advance of the opinion in a secret order on Feb. 19, 2014. Google filed a motion to stay the order on Feb. 20, 2014, and the court denied this motion on Feb. 21, 2014, explaining that "[t]he order of February 19, 2014, was issued in advance of the opinion to prevent a rush to copy and proliferate the film before Google can comply with the order." Professor Eugene Volokh questioned the order in a Feb. 27, 2014 post on his blog, "The Volokh Conspiracy," which is hosted by the *Washington Post*. "[E]ven short speech restrictions have, for good reasons, been seen as raising substantial First Amendment questions, and the questions are made more substantial by the newsworthiness of the event—the removal of an extremely controversial video—that YouTube (and its parent, Google) was barred from talking about," Volokh wrote. In his April 16, 2014 post on "Technology & Marketing Law Blog," Santa Clara University Professor Eric Goldman called the secret gag order "a procedural move we don't normally see in our democratic republic."

After the opinion was published, Google filed an emergency motion to stay the order pending a rehearing *en banc* on Feb. 27, 2014, arguing that forcing Google to remove the video would "produce devastating effects" for free speech principles. Google argued in its motion that "under the panel's rule, minor players in everything from Hollywood films to home videos can wrest control of those works from their creators, and service providers like YouTube will lack the

ability to determine who has a valid copyright claim.” The harms to free speech would be grave, Google argued, “because the panel’s order will gag [Google, YouTube and the public’s] speech and limit access to newsworthy documents.” Google’s motion is available online at <http://www.shadesofgraylaw.com/media/Garcia-Mot-to-Stay.pdf>. The Ninth Circuit denied this emergency motion on Feb. 28, 2014, with one small change from the prior order: it did not “preclude the posting or display of any version of ‘Innocence of Muslims’ that did not include Cindy Lee Garcia’s performance.”

On March 6, 2014, a judge on the Ninth Circuit made a *sua sponte* request for the entire Ninth Circuit to vote on whether the full court should rehear the February 28 order to deny a stay of the panel’s order. The panel voted not to reconsider the stay on March 14, 2014. Google, however, filed a petition for a rehearing *en banc* asking the court to reconsider the Feb. 26 opinion on March 12, 2014. Amicus briefs were due on April 15, 2014 to the Ninth Circuit, which will now consider whether to rehear the entire case *en banc*. Nine groups filed *amicus* briefs in support of Google’s petition for a rehearing *en banc*. The Ninth Circuit has created a page online at http://www.ca9.uscourts.gov/content/view.php?pk_id=0000000725 that collects all of the documents in the case.

The U.S. Copyright Office refused to register separately Garcia’s copyright in her performance on March 6, 2014. The letter to Garcia’s attorney refusing the registration stated that “[f]or copyright registration purposes, a motion picture is single integrated work.” The letter explained that authorship in a motion picture only includes “production, direction, camerawork, editing and script.” Because Garcia did not own the copyright in the entire motion picture and her “contribution was limited to her acting performance,” the Office refused to “register her performance apart from the motion picture.” The U.S. Copyright Office’s letter is available online at <http://www.shadesofgraylaw.com/media/00039731.pdf>.

The Ninth Circuit’s opinion has stirred up widespread debate. Goldman focused in a Feb. 27, 2014 post of his “Technology & Marketing Law Blog” on the free speech issues with Kozinski’s opinion. Goldman concluded that Judge Kozinski reached his decision because of the case’s “bad facts,” calling the opinion “a textbook example of judicial activism, i.e., coming up with newly manufactured legal doctrines to find a remedy for a victim.” Of significant concern to Goldman were the case’s implications for speech as a record of history. “We cannot fully appreciate the Benghazi attacks or other anti-American attacks that may be attributable to the video, or the fatwa against Garcia, or even this opinion without seeing the video itself,” he wrote. “This opinion is spiritually

related to the efforts towards a ‘right to forget.’ That entire movement is an assault on our notions of historical developments and how we learn from history.”

Corynne McSherry, intellectual property director for the Electronic Frontier Foundation, agreed that the court gave short shrift to the First Amendment concerns in the case in a Feb. 26, 2014 post for EFF. She explained that although the court correctly noted that “the First Amendment does not protect copyright infringement,” the court ignored the fact that “the standards for this kind of injunction — a classic prior restraint — are particularly high.” She concluded that “[b]ased on nothing more than a tenuous (at best) copyright claim, the court has ordered a service provider to censor a video that has been the subject of considerable debate and comment, with only the most cursory analysis of the speech harms it will cause.”

Others have criticized the opinion’s implications for copyright law, reflecting the U.S. Copyright Office’s denial of Garcia’s registration. In his Feb. 26, 2014 story, TechDirt’s Mike Masnick wrote that the decision to interpret an actor’s performance as “independently copyrightable from the film” is “preposterous” because a motion picture itself has always been perceived as one work, not divided into its individual performances.

Some believe the court made the right decision. Eugene Volokh wrote in a Feb. 26, 2014 post on his blog that “Garcia’s performance is an independent work of authorship,” just like “a recorded performance of a song is an independent work of authorship on the singer’s part, though the singer didn’t write the song.” Volokh did argue, however, that Google should have asserted a fair use argument under 17 U.S.C. § 103. “The work is of important historical significance, and viewing it may be necessary to thoroughly understand the controversy related to the work,” Volkh wrote. “Garcia’s performance is only a small part of the work.”

Federal District Court Finds in Favor of Photographer in Case of Twitter Posting by Getty Images

On Nov. 22, 2013, after four years of litigation, a federal jury sitting in Manhattan awarded photographer Daniel Morel \$1.22 million in damages after several media organizations posted images he took online and distributed them to other organizations. Morel alleged that these organizations’ uses infringed his copyrights in the photos, and the jury agreed, finding two companies that distributed the images liable for willful copyright infringement and violations of the Digital Millennium Copyright Act. The case has attracted attention from photojournalists in particular because it pits these journalists against organizations that use and distribute photographs.

Daniel Morel, a photographer living in Port-au-Prince, Haiti, took photos during the aftermath of the earthquake that struck the country in January 2010. He posted some of these photos online using TwitPic, a service that posts images to a user's Twitter account, on Jan. 12, 2010. A Twitter user named Lisandro Suero then reposted Morel's photos on his own Twitter page, claiming they were his. Agence-France Presse (AFP), a company that distributes photos to clients who pay licensing fees, found the photos that Suero posted and began to distribute them to its customers, including Getty Images (Getty) under a reciprocal rights agreement. AFP and Getty use computer systems that examine the metadata of photos they receive to collect byline information. In this case, the metadata from the images Suero had posted did not provide Morel's information. Clients who used the incorrectly-attributed images included the *Washington Post*, ABC, CBS, TBS, and *The New York Times*. The next day, AFP employees began to question the attribution to Suero. They determined Morel was the actual copyright holder and issued a correction for the captions of the images. This correction also re-sent the corrected images from AFP's system to Getty's system. However, Morel had a relationship that exclusively licensed his photos to Corbis, another photo licensing service. Corbis discovered that AFP and Getty were licensing Morel's images on Jan. 13, 2010, and asked Getty to remove the infringing photos. Getty claimed it removed the photos from its client-facing website and AFP issued a notice to its subscribers on Jan. 14, 2010 to remove any photos attributed to Daniel Morel. However, images taken by Morel and attributed to Suero remained online for several weeks.

On March 26, 2010, AFP filed a complaint for a declaratory judgment, asking the District Court for the Southern District of New York to find that it had not infringed Morel's copyrights in his photos. In response, Morel filed counterclaims against AFP, Getty, CBS, ABC, TBS, and the *Washington Post*, arguing that the entities willfully infringed his copyrights under the Copyright Act, 17 U.S.C. §§ 106. Morel alleged that AFP and Getty also violated the Digital Millennium Copyright Act (DMCA), 17 U.S.C. § 1202(c)(3) because the captions for the images included false and altered copyright management information that represented that they, not Morel or Corbis, owned the images. The DMCA, in relevant part, protects the integrity of copyright ownership information and penalizes inaccurate reporting or alterations to copyright ownership information.

On cross-motions for summary judgment decided on Jan. 14, 2013, U.S. District Court Judge Alison Nathan granted Morel's motion for summary judgment, finding that AFP and the *Post* were liable for copyright infringement, and denied AFP's motion for summary judgment. AFP argued that it had an

implied license to use Morel's images because he posted them on Twitter. *Agence France Presse v. Morel*, 934 F.Supp.2d 547 (S.D.N.Y. 2013). AFP contended that it was a third-party beneficiary to Twitter's terms of service and that those terms provided a license to use the images. The court concluded that Twitter's terms of service provided for "some re-uses of content posted on Twitter," such as retweeting images posted to Twitter. However, the court decided that the Twitter terms of service did not provide users with a general license to use the information anywhere, even outside Twitter. That Morel posted the images on Twitter did not grant AFP and Getty the right to use them commercially. Judge Nathan also found that Morel sufficiently pled facts to support his claims for the DMCA violations, finding that the incorrect captions on the photos suggesting that Getty or AFP owned the rights to the photos conveyed information about copyright ownership that was false. *Agence France Presse v. Morel*, 934 F.Supp.2d 547 (S.D.N.Y. 2013).

The case proceeded to trial against AFP and Getty to determine whether the infringement was willful and whether the defendants violated the DMCA. The other defendants, including the *Washington Post*, CBS, and ABC had previously settled with Morel for undisclosed amounts. Under the Copyright Act, 17 U.S.C. § 504(c)(1), a copyright owner can recover up to \$30,000 per infringement for any infringement of his or her work. However, if a jury finds the infringement to be willful, meaning the infringer knew or should have known that the copyright was being infringed, the maximum statutory damages increase to \$150,000 per infringement under 17 U.S.C. § 504(c)(2). On the issue of willful infringement, AFP and Getty argued that their employees made innocent mistakes by using the images tweeted by Lisandro Suero, the Twitter user who posted Morel's photographs and falsely represented that they were his, and that the blame should fall on Suero. Damages for violations of the DMCA can reach a statutory maximum of \$25,000 per violation. 17 U.S.C. § 1203(c)(3)(B).

At the conclusion of trial, on Nov. 22, 2013, a jury awarded Morel \$1.22 million in damages against AFP and Getty. *Agence France-Presse v. Morel*, No. 10-02730 (S.D.N.Y., Nov. 22, 2013). This damages award represented the maximum statutory damages allowed for the infringement of eight photographs at issue. David Walker, a reporter for Photo District News Online, the online version of a magazine that covers news and business information, including copyright and other intellectual property issues, for professional photographers, spoke with one of the jurors in the case, Janice Baker, for a Nov. 26, 2013 story. Baker said she believed AFP and Getty's infringement was "obviously willful . . . because they didn't check on the author of the photographs," and that she was convinced that the infringement was willful after hearing email evidence Morel's attorney

presented that several of Getty's employees knew very quickly after the photos were posted that they belonged to Morel, not Suero. The jury also concluded that Getty and AFP were liable for violations of the DMCA due to the incorrect captions on the images.

AFP and Getty filed post-trial motions for either judgment as a matter of law or a new trial to overturn the jury verdict on Jan. 7, 2014. They argued that the evidence did not support a finding of willful infringement and that the award of \$1.22 million was grossly excessive. They noted that the damages award significantly exceeded the market value of the photos. Morel's lawyers filed a response to this motion, arguing that the large damages award was appropriate because penalties for copyright infringement should, for deterrence purposes, cost more than complying with the law would have cost the infringer. Morel attorneys' contended in the motion, "In AFP's view, the giant photo agency should be allowed to take whatever it wants from the Internet and later pay whatever it thinks is appropriate if the copyright holder fails to respond promptly to a request for permission to license." As the *Bulletin* went to press, the parties were awaiting a ruling on these post-trial motions.

After the verdict, Morel told Photo District News Online for its November 26 story, "I hope the internet is going to be a little safer now for all artists, all photographers." Getty Images's general counsel John Lapham told the *British Journal of Photography* for a Nov. 24, 2013 story, "I think it's fair to say that we're disappointed with the amount." He added, "At Getty Images, we're very interested in the proper attribution of all of our images, and we've spent the last three years improving our systems and our processes to prevent this type of error from happening again . . . We have a lot of images coming in every single day, and we've learned a lot from this case."

Reactions to the jury verdict have suggested that the case offers important lessons about the use of photographs online. Goldman wrote in a Nov. 25, 2013 post on his "Technology & Marketing Law Blog" that "photos are a huge liability trap on the Internet." He noted that although it appears to be common practice for individuals to copy photos from the Internet, "there are very few circumstances where republishing someone else's photo without permission isn't infringement, and the transaction costs of defending any such lawsuit almost always exceeds the upfront license fees." He advised Internet users to "be careful copying and republishing any photo on the Internet, wherever sourced." Mickey Osterreicher, attorney for the National Press Photographers Association, told Photo District News Online that the verdict sends infringers a message—"The lesson is: Ask for permission." Louis J. Levy and S. Jenell Trigg, attorneys with Lerman Senter LLC's Washington D.C. office, wrote in a Feb. 21,

2013 post for Martindale.com that the decision “underscores the importance of exercising caution when using content found online (particularly on social media websites), and of training staff at all levels to direct communications alleging copyright infringement or other claims to counsel.”

— Cassie Batchelder
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