

The Authorship Rights of Performers

Mary LaFrance

IGT Professor of Intellectual Property Law

William S. Boyd School of Law

University of Nevada, Las Vegas

Introduction

Judges are very confused about the notion of performers as authors. Because producers of recorded entertainment have generally used the work made for hire doctrine to secure authorship, federal courts have had few occasions to consider authorship claims by performers. *Garcia v. Google* has drawn attention to the question of whether and when performers enjoy rights of authorship. While the circumstances of that case are undeniably peculiar, the underlying question has much broader application.

This issue is likely to become more pressing in the immediate future. As recording technology has become cheaper and more widely available, more works are being created by amateurs or newcomers that fail to use the work made for hire doctrine effectively. User generated content on portals such as YouTube may lead to authorship assertions by willing or inadvertent performers in those recordings. Also, due to the ongoing wave of termination notices in the recorded music industry, courts will be asked to resolve authorship claims by recording artists.

Even though the United States is a signatory to recent international agreements that strengthen the economic and moral rights of performers, federal copyright law does not fully comply with those treaties. Because these agreements grant performers certain rights that heretofore were afforded only to authors, enacting legislation to comply with these treaties would give performers at least some of the rights they could otherwise obtain only through litigating their authorship claims or through collective bargaining. However, the recorded entertainment industry is likely to resist efforts to bring Title 17 into compliance, and due to the weak negotiating power of most performers, many of these rights are likely to be left on the bargaining table.

I. Changes in the Entertainment Industry Highlight Authorship Questions

In the recent past, the means to create collaborative works were largely controlled by movie studios, independent production companies, cable companies, and record companies. Technology to create recorded entertainment is now much cheaper and more widely available. As a result,

collaborative works of entertainment are increasingly being created by people who have never heard of a work made for hire. As a result, authorship questions are likely to arise more often.

For decades, recorded entertainment in the United States was the province of big business. In the music industry, major record labels selected the artists who would be allowed to record, as well as the music they would perform, then financed and closely supervised the creation of those recordings, and retained complete control over whether and when those recordings would be distributed and what additional uses of the recordings would be licensed. In the film and television industries, movie studios and major production companies exercised a similar level of control, selecting the underlying material as well as the creative personnel who would bring that material to full realization, exercising a high degree of creative and financial control throughout the production process, and making the final decisions as to distribution and licensing. Compared to filmmakers in other countries, the movie industry in the United States became known for big-budget blockbuster films, featuring expensive special effects and action sequences. Studios typically spent large amounts on publicity and distribution, sometimes more than the production budget. In contrast to these large businesses, amateur and aspiring professional filmmakers, as well as unsigned recording artists, had limited opportunities to create and disseminate recorded entertainment.

Large businesses dominated the recorded entertainment industries in the United States because production costs and the risk of failure were high. Producers needed significant borrowing power to finance their productions, plus a large pipeline of products to serve as loan collateral and to ensure that there would be enough hits to balance out the flops.

Because creative and financial control over recorded entertainment was vested in large businesses, and those businesses incurred significant financial risks, they sought maximum legal control over their products. This had the effect of squeezing out almost any consideration of performers' rights.

The legal mechanism that made it possible for producers of recorded entertainment to obtain complete control over their creative products was the work made for hire doctrine. Codified in the Copyright Act of 1909, the concept of a work made for hire was broadly interpreted by the federal courts, and it was under this regime that major movie studios came into existence and thrived. Although record companies had no copyright protection for their products until 1972, sound recordings could not readily be copied during the early twentieth century, giving the record companies a sort of de facto copyright protection for their works until copying technology improved after the mid-century mark. During the waning years of the 1909 Act, record companies benefitted from the courts' broad interpretation of the work made for hire doctrine. As revised in the Copyright Act of 1976, a narrowed version of the work made for hire doctrine still gave ample protection to film studios. Although the new definition was surprisingly silent on sound recordings, record studios continued to register their recordings as works made for hire, apparently assuming that they were still protected, an assumption that remained unchallenged until the 1990s.

Film and recording studios have incorporated the work made for hire doctrine into their contracts with creative participants in order to ensure that the latter enjoy no rights of authorship. They

have also used their bargaining power to ensure that most creative participants retain no creative control¹ or moral rights.²

Today, however, advances in recording and distribution technology make it possible to produce and disseminate recorded entertainment at a much lower cost. In the music industry, time in a recording studio is still expensive, but readily accessible computer technology makes mixing, editing, and distribution cheaper than ever before. In the film industry, digital recording equipment has replaced more expensive film and camera equipment, and amateur videos can be distributed at little or no cost via YouTube and other hosting sites. As a result, more collaborative creative efforts can be produced and disseminated without the involvement of major studios. Not only can anyone have 15 minutes of fame; now anyone can produce and distribute recorded entertainment.

Without the involvement of big businesses and their experienced legal teams, amateur or inexperienced producers of recorded entertainment may enter into collaborative creative projects without considering the legal aspects of their undertaking. Independent filmmakers and musicians who self-produce sound recordings or music videos can easily overlook the importance of work made for hire agreements and personal rights waivers.

A significant issue arising from these collaborations is the authorship rights of performers and other creative participants. Absent a valid work made for hire agreement, under current law it can be difficult to determine which participants enjoy rights of authorship. This problem can arise in a number of contexts. For example, recording artists may dispute their record company's claim of sole authorship in their recordings, and film performers may assert authorship rights in the film in which they appear, or portions thereof.

II. The Authorship Concept Stacks the Deck against Performers

Copyright law's notions of authorship stack the deck against performers. This is because the law generally disfavors recognition of collaborative authorship, and the vast majority of performers' authorship claims are based on collaborative rather than sole authorship.

Federal copyright statutes notoriously fail to define "author," leaving courts to fill this gap. However, the language that courts have evolved to describe the legal concept of authorship reveals a presumption that expressive works have a single author:

- "he to whom anything owes its origin"³
- "person who causes something to come into being"⁴

¹ On rare occasions, directors with sufficient bargaining power have retained creative control.

² Although performers are excluded from the moral rights provisions of federal law, see Visual Artists Rights Act, 17 U.S.C. § 106A (which does not recognize moral rights in recorded entertainment), their contracts with producers typically require them to waive any rights which resemble moral rights, such as their rights under the federal unfair competition statute, 15 U.S.C. § 43(a). These waivers will not necessarily be respected outside of the United States. See, e.g., *Turner v. Huston*, CITE ____.

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- “the party who actually creates the work”⁵
- “the person who translates the idea into a fixed, tangible expression”⁶

Often these descriptions depend on the notion that the author is a person who controls the work of others:

- “person with creative control”⁷
- one who “superintends’ the work by exercising control”⁸
- “the inventive or master mind”⁹

Because we tend not to think of control as something that is shared, any test that turns on control is biased in favor of sole authorship. This is evident in the joint authorship case law.¹⁰ Because performers who make authorship claims rarely assert sole authorship,¹¹ the law is stacked against them.

The question of joint authorship has rarely arisen in the case of recorded entertainment, because the work made for hire concept usually wrests any potential authorship claim out of the performers’ hands. This may change, at least for sound recordings, if musicians asserting termination rights persuade courts that sound recordings are not works made for hire.

A. The Uncertain Scope of Works Made For Hire

The work made for hire doctrine has greatly restricted the opportunities for performers to assert authorship claims in their recorded performances. In general, courts have interpreted this concept broadly in the case of recorded entertainment, to the detriment of performers.

The 1909 Act used the terms “employer” and “work made for hire” without defining them, stating only that “the word ‘author’ shall include an employer in the case of works made for hire.”¹² However, courts interpreted this language broadly by applying the “instance and expense” test to both

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¹⁰ See *infra* notes __ and accompanying text.

¹¹ The rare exception would be a case where the performer is the *only* creative contributor to the work – that is, a self-recording by a solo artist who performs self-created material.

¹² § 26, Copyright Act of 1909. Case law predating the 1909 Act dealt with works made for hire by employees, but did not define “employee.” See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 248 (1903); *Colliery Engineer Co. v. United Correspondence Schools Co.*, 94 F. 152 (S.D.N.Y. 1899); *Little v. Gould*, 15 F. Cas. 612 (N.D.N.Y. 1852).

employees and independent contractors.¹³ No signed writing was required; in the case of independent contractors, courts typically used an “implied assignment” rationale.¹⁴

The broad application of the 1909 work made for hire concept is illustrated by *Fifty-Six Hope Road Music Ltd. v. UMG Recordings, Inc.*,¹⁵ in which Bob Marley’s statutory heirs¹⁶ asserted ownership of the renewal term in his pre-1978 recordings. Applying the “instance and expense” test, the district court held that the recordings were ineligible for termination because they were works made for hire. Based on the language of Marley’s contracts with the record company, the court concluded that Marley made the recordings at the record company’s instance and expense, and that the company had the right to direct and supervise the manner in which Marley created the recordings.¹⁷ The court acknowledged that Marley “may have exercised artistic control over the recording process” – for example, selecting the recording studios, choosing the musicians and songs to record, and determining when the group recorded. However, the court declared artistic control to be “legally irrelevant” to the authorship determination, because the dispositive fact was the record company’s “contractual *right* to accept, reject, modify, and otherwise control the creation of the Sound Recordings.”¹⁸

Treating artistic control as irrelevant enabled this court to reject a performer’s authorship claim. Ironically, as discussed in the next section, courts that reject joint authorship claims often do so by treating artistic control as dispositive.

In the 1976 Act, Congress created two types of works made for hire. Any kind of copyrightable work is automatically a work made for hire if it is created by employees within the scope of their employment.¹⁹ In the case of non-employees, however, the statute requires a signed, written instrument expressly stating that the work is made for hire, and even then only certain types of copyrightable works are eligible.²⁰ Although motion pictures and collective works are eligible, the

¹³ *Martha Graham Sch. and Dance Found., Inc. v. Martha Graham Ctr. of Contemporary Dance*, 380 F.3d 624, 634-35 (2d Cir. 2004); *Brattleboro Publ'g Co. v. Winmill Publ'g Corp.*, 369 F.2d 565, 567 (2d Cir. 1966); *see also* *Estate of Burne Hogarth v. Edgar Rice Burroughs, Inc.*, 342 F.3d 149, 158-63 (2d Cir. 2003); *Picture Music, Inc. v. Bourne, Inc.*, 457 F.2d 1213, 1216 (2d Cir. 1972).

¹⁴ *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 744 & n.10 (1989) (CCNV) (citing *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 221 F.2d 569, 570, *rev'd*, 223 F.2d 252 (2d Cir. 1955); *Yardley v. Houghton Mifflin Co.*, 108 F.2d 28, 31 (2d Cir. 1939)).

¹⁵ 99 U.S.P.Q.2d 1735, 2010 WL 3564258 (S.D.N.Y. 2010).

¹⁶ Section 304 of the 1976 Act specifies who can terminate a copyright grant after the death of the author. 17 U.S.C. § 304 (c)(2). It does not apply to works made for hire. *Id.* § 304(c).

¹⁷ 2010 WL 3564258, at *8-9.

¹⁸ *Id.* at *10 (emphasis in original) (citing *Martha Graham*, 380 F.3d at 635; *Playboy*, 53 F.3d at 554; *Picture Music*, 457 F.2d at 1216).

¹⁹ 17 U.S.C. § 101.

²⁰ *Id.*

statute does not mention sound recordings.²¹ Thus, in some situations the characterization of the creative participant as an employee or independent contractor can be outcome-determinative.

However, like the 1909 Act, the 1976 Act does not define “employee,” and this omission has once again forced courts to develop their own interpretation. In *CCNV v. Reid*,²² the Supreme Court attempted to fill this gap by invoking the common law of agency:

In determining whether a hired party is an employee under the general common law of agency, we consider the hiring party's right to control the manner and means by which the product is accomplished. Among the other factors relevant to this inquiry are the skill required; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; *whether the hiring party has the right to assign additional projects to the hired party; the extent of the hired party's discretion over when and how long to work*; the method of payment; *the hired party's role in hiring and paying assistants*; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; *the provision of employee benefits*; and *the tax treatment of the hired party*.²³

These factors are non-exhaustive.²⁴

Although the Court expressly cited § 220(2) of the Restatement of Agency as the source for these factors,²⁵ the Restatement list is slightly different. The factors italicized above did not come from the Restatement at all. Instead, they are drawn from six cases decided by the Supreme Court and the federal courts of appeal. Only one of these is a copyright case; the others are labor, tax and ERISA cases.²⁶ *Dumas v. Gommerman*, the only copyright case in the group, also included two seemingly useful factors that *CCNV* did not mention: (1) “whether the artist works for several buyers at a time, or

²¹ *Id.* [Mention short-lived technical amendment.]

²² 490 U.S. 730 (1989).

²³ *Id.* at 751-52 (citing Restatement of Agency, § 220(2)) (emphasis added).

²⁴ *Id.*

²⁵ *Id.*

²⁶ The *right to assign additional projects* and the *tax treatment of the hired party* came from a copyright case, *Dumas v. Gommerman*, 865 F.2d 1093, 1105 (9th Cir. 1989). The *extent of the hiring party's discretion over when and how long to work* came from labor and ERISA cases: *NLRB v. United Ins. Co.*, 390 U.S. 254, 258 (1968) (labor); *Short v. Central States, Southeast & Southwest Areas Pension Fund*, 729 F.2d 567, 574 (8th Cir. 1984) (ERISA). Although *CCNV* cited Restatement § 220(2)(e) as one source for *the hiring party's role in hiring and paying assistants*, the Restatement refers generally to the “instrumentalities” used in the work; the specific reference to assistants comes from tax and ERISA cases: *Bartels v. Birmingham*, 332 U.S. 126, 132 (1947) (tax); *U.S. v. Silk*, 331 U.S. 704, 719 (1947) (tax); *Darden v. Nationwide Mutual Ins. Co.*, 796 F.2d 701, 705 (4th Cir. 1986) (ERISA); and *Short*, 729 F.2d at 574 (ERISA). The *provision of employee benefits* came from *Dumas*, 865 F.2d at 1105 (copyright) (inquiring specifically whether the benefits are the same as those provided to other employees); *United Ins. Co.*, 390 U.S. at 259 (labor); and *Short*, 729 F.2d at 574 (ERISA).

exclusively for one,” and (2) “whether the artist is hired through the channels the buyer customarily uses for hiring new employees.”²⁷

Conversely, § 220(2)²⁸ includes one factor which *CCNV* did not mention at all: *whether or not the parties believe they are creating the relation of master and servant*.²⁹ And the Third Restatement (published after *CCNV*, in 2006) not only reiterates this new factor but adds yet another one -- a factor that *CCNV* had expressly rejected: *the extent of control that the principal has exercised in practice over the details of the agent's work*.³⁰

In addition to copyright, tax, and ERISA cases, the common law test of agency is also used by the National Labor Relations Board (NLRB) and its reviewing courts to distinguish between employees and independent contractors in order to determine which workers can lawfully be represented by labor unions under the National Labor Relations Act (NLRA). Due to the importance of unions in the entertainment industry, and the temporary nature of most performers’ employment, the distinction between employees and independent contractors figures prominently in labor disputes in the context of both live and recorded entertainment. Like the Supreme Court, the NLRB has developed a test for employee status that departs slightly from the Second Restatement.³¹

At the time *CCNV* was decided, the NLRB and its reviewing courts gave significant weight to the hiring party’s right to control a worker’s activities, pursuant to the Supreme Court’s holding in *NLRB v. United Ins. Co.*³² While they have not dispensed with this factor completely, they have since deemphasized the right to control in favor of a new factor – the extent to which the putative independent contractor has *significant entrepreneurial opportunity for gain or loss*.³³ As the D.C. Circuit explained:

This subtle refinement was done at the Board's urging in light of a comment to the Restatement that explains a “ ‘full-time cook is regarded as a servant,’ ”-and not “an independent contractor”-“ ‘although it is understood that the employer will exercise no control over the cooking.’ ” Thus, while all the considerations at common law remain in play, an important animating principle by which to evaluate those factors in cases where some factors cut one way and some the other is whether the position presents the opportunities and risks inherent in entrepreneurialism.³⁴

²⁷ *Dumas*, 865 F.2d at 1105.

²⁸ This refers to the Restatement (Second) Agency (1958), which was current when *CCNV* was decided.

²⁹ Restatement (Second) Agency § 220(2)(i) (1958).

³⁰ Restatement (Third) Agency § 7.07 cmt. f (2006).

³¹ Compared to § 220(2), the current NLRB factors omit consideration of the type of occupation but add consideration of whether the worker bears the entrepreneurial risk and has the prospect for entrepreneurial reward. See, e.g., *Lancaster Symphony Orchestra*, 357 NLRB No. 152 (Dec. 27, 2011).

³² 390 U.S. 254, 256 (1968).

³³ *FedEx Home Delivery v. NLRB*, 563 F.3d 492 (D.C. Cir. 2009); *Corporate Express Delivery Sys. v. NLRB*, 292 F.3d 777, 780 (D.C. Cir. 2002); *Corp. Express Delivery Sys.*, 332 NLRB No. 144, at 6 (Dec. 19, 2000).

³⁴ *FedEx Home Delivery*, 563 F.3d at 497 (quoting Restatement (Second) of Agency § 220(1) cmt. d). In the labor context, the D.C. Circuit has also stated that the considerations of employee benefits or tax withholding are relevant to the intent of the parties. [CITE] Thus, these factors are arguably related to the Restatement’s consideration of whether the parties believe they are in an employer/employee relationship, see Restatement (Second) Agency § 220(2)(i), but it does not explain why *CCNV* chose the narrower version of this inquiry.

This table summarizes the differences between the CCNV factors and those currently considered under the NLRA:

CCNV	NLRA
Right to control manner and means.	Right to control manner and means.
Skill required.	Skill required.
Source of tools, etc.	Source of tools, etc.
Place of work.	Place of work.
Duration of work relationship.	Duration of work relationship.
Payment method.	Payment method.
Hiring party's regular business.	Hiring party's regular business.
Is hiring party "in business"?	Is hiring party "in business"?
<i>Right to assign additional projects.</i>	<i>Do parties believe it's employment?</i>
<i>Who decides work hours?</i>	<i>Who bears entrepreneurial risk/reward?</i>
<i>Hiring and paying assistants.</i>	<i>Is worker engaged in a distinct occupation or business?</i>
<i>Employee benefits.</i>	
<i>Tax treatment.</i>	

The highlighted terms indicate differences between the two lists. Although both lists are considered non-exhaustive, when factors are not expressly included on one list courts and disputing parties might fail to consider them. After all, how many copyright lawyers would look at labor law cases or tax or ERISA cases, for that matter), and vice versa?

The divergent evolution of these two multi-factor tests, both rooted in the common law of agency, could be mere happenstance. Because of their differences, however, it is entirely possible that a performer (or other artist) could be considered an employee for labor law purposes and an independent contractor for copyright purposes, or vice versa. For example, while recording artists are

considered employees for the purpose of representation by the American Federal of Musicians, a court might conclude that they are independent contractors for the purpose of copyright terminations. While there is nothing inherently wrong with this inconsistency, it does suggest that we should look more closely at whether we are applying the right tests, and whether they offer sufficient predictive value to enable performers (and those who pay them) to plan their business arrangements appropriately.

Given the uncertainty of the employee/ independent contractor distinction in copyright law, it is hardly surprising that this malleable definition has turned employee status into a moving target. Well-advised producers and other commissioning parties often utilize signed, written work made for hire agreements in order to eliminate this uncertainty. However, these agreements may not be valid for some works, such as sound recordings. In addition, because of the technological advances noted earlier, collaborators on recorded entertainment no longer fit the mold of big businesses with sophisticated legal knowledge, and missteps are all too easy.

B. Joint Authorship Precedents Disfavor Performers

In the past, it has been a rare occurrence when a recorded entertainment is not a work made for hire. These occasions may become more frequent in the near future, however, if recording artists succeed in establishing that their sound recordings are not works made for hire authored by their record companies. When a collaborative work is not a work made for hire, the question of joint authorship often arises. However, in addressing joint authorship claims, courts reveal a strong bias in favor of sole authorship. This works against authorship claims by performers.

Although performers undoubtedly contribute something of value to recorded entertainment, court-imposed restrictions on the concept of joint authorship – arising mostly from cases that did not involve performers -- make it difficult for them to establish joint authorship.³⁵ Some courts have openly acknowledged that the purpose of these restrictions is to defeat joint authorship claims, especially those asserted by parties they perceive as minor or subservient contributors.³⁶ While some circuits have not yet articulated a joint authorship test, those that have done so tend to focus on which collaborator has ultimate creative control, rather than focusing on the qualitative and quantitative significance of each person's contribution.³⁷ Because performers rarely have ultimate creative control over the works they help to create, their contributions will be heavily discounted under a control-oriented test.

³⁵ The statutory definition of a joint work is minimal: "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." 17 U.S.C. § 101. However, several circuits have adopted a test that inquires whether the contributors subjectively perceived one another as joint authors, even though such a test has no basis in either the copyright statutes or their legislative history. *See, e.g.*, *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000); *Thomson v. Larson*, 147 F.3d 195, 206 (2d Cir. 1998); *Seshadri v. Kasraian*, 130 F.3d 798 (7th Cir. 1997); *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1071 (7th Cir. 1994); *Childress v. Taylor*, 945 F.2d 500, 509 (2d Cir. 1991).

³⁶ CITES

³⁷ *See, e.g.*, *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000); *Thomson v. Larson*, 147 F.3d 195, 202-03 (2d Cir. 1998); *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1071-72 (7th Cir. 1994); *Childress v. Taylor*, 945 F.2d 500, 509

Another difficulty for performers asserting joint authorship is the requirement, adopted by most circuits, that each author's contribution be independently copyrightable.³⁸ The meaning of this requirement has never been entirely clear.³⁹ While it seems to rule out contributions that are abstract ideas, unoriginal, or factual in nature, it does not rule out contributions that are unfixed at the time they are offered, because the fixation requirement is satisfied if an author's contribution is fixed by another party acting under the author's authority.⁴⁰ In many collaborations it can be difficult to prove exactly what each party contributed, because the contributions are merged and memories fade.⁴¹ The alternative test proposed by the late Mel Nimmer – that each contribution be more than de minimis⁴² – does not solve the problem of fading memories, and also raises the question whether the subtle nuances of a performer's interpretation – vocal inflections, facial expressions, or body language – might be readily dismissed as de minimis.

Only a few cases have addressed authorship claims by performers *qua* performers (as opposed to performers, like Clarice Taylor in *Childress* or the actors in *Erickson*, whose authorship claims are based on their contributions to the literary works or musical compositions that are being performed). The results are decidedly mixed. They demonstrate, however, that it is possible for a performer to overcome the hurdles presented by the joint authorship concept.

1. Forward v. Thorogood⁴³

In 1976, John Forward arranged and paid for two recording sessions for George Thorogood and the Destroyers in order to create a demo tape.⁴⁴ He also requested specific songs to be recorded.⁴⁵ In 1988, after the band became successful, Forward sought to exploit the recording commercially, but Thorogood and the band objected. The First Circuit held that the band was the author of the recording, and Forward had no copyright interest: "The performer of a musical work is the author, as it were, of the

(2d Cir. 1991). The idea that the "dominant author" in a collaboration is the sole author originated with Judge Leval's dicta in *Fisher v. Klein*, 16 USPQ2d (BNA) 1795 (S.D.N.Y. 1990), which made no attempt to define or explain the concept. The Second Circuit embraced the concept in *Childress*, 945 F.2d at 508, again without definition or explanation.

³⁸ See, e.g., *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231 (9th Cir. 2000); *Thomson v. Larson*, 147 F.3d 195, 200 (2d Cir. 1998); *Seshadri v. Kasraian*, 130 F.3d 798, 803 (7th Cir. 1997); *Erickson v. Trinity Theatre*, 13 F.3d 1061, 1971 (7th Cir. 1994); *Childress v. Taylor*, 945 F.2d 500, 507 (2d Cir. 1991); *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1493 (11th Cir. 1990); *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1087 (9th Cir. 1989); *BTE v. Bonnezaze*, 43 F.Supp.2d 619, 623 (E.D. La. 1999); *Cabrera v. Teatro del Sesanta, Inc.*, 914 F. Supp. 743, 765 (D.P.R. 1995); *Ashton-Tate Corp. v. Ross*, 728 F.Supp. 597, 601 (N.D. Cal. 1989), *aff'd*, 916 F.2d 516 (9th Cir. 1990). However, this requirement is not universally accepted, see, e.g., *Gaiman v. McFarlane*, 360 F.3d 644, 658-59 (7th Cir. 2004) (endorsing the rule as well as an exception for comic book and motion picture characters), and many courts have not yet considered the issue.

³⁹ *Gaiman v. McFarlane*, 360 F.3d 644 (3d Cir. 2004), highlights this lack of clarity.

⁴⁰ 17 U.S.C. § 101.

⁴¹ See, e.g., *Erickson v. Trinity Theatre*, 13 F.3d 1061 (7th Cir. 1994).

⁴² [CITE D.C.Circuit case.]

⁴³ 985 F.2d 604 (1st Cir. 1993).

⁴⁴ *Id.* at 605.

⁴⁵ *Id.*

performance.”⁴⁶ The court also held that the recording was not a work made for hire under the “instance and expense” test of the 1909 Act.⁴⁷ The court gave little weight to the fact that Forward did not pay the band for their performance,⁴⁸ but otherwise its analysis was conclusory:

Nothing suggests that the tapes were prepared for the use and benefit of Forward. Rather, the purpose was to provide demo tapes to entice a recording company. Forward was a fan and friend who fostered this effort, not the Archbishop of Salzburg commissioning works by Mozart.⁴⁹

Nor was Forward a joint author, because he made “no musical or artistic contribution” to the 1976 recordings.⁵⁰ Despite its ruling in favor of Thorogood, the court suggested where a record producer makes a more substantial contribution, the producer and performers will typically be joint authors:

In the House Report on the Copyright Act of 1976, the committee observed that the copyright in sound recordings “will usually, though not always, involve ‘authorship’ both ... [by the artist and by] the record producer responsible for setting up the recording session, capturing and electronically processing the sounds, and compiling and editing them to make the final sound recording.” H.Rep. No. 94–1476, 94th Cong., 2d Sess. 56 (1976). It is apparent from this passage that the “producer” envisaged by the committee is one who engages in artistically supervising and editing the production.⁵¹

2. *Aalmuhammed v. Lee*⁵²

Although the authorship claim in *Aalmuhammed* did not come from a performer, the Ninth Circuit addressed performers’ authorship rights when it considered the general question of motion picture authorship. Asking “Who, in the absence of contract, can be considered an author of a movie?,” the court answered its own question:

The “auteur” theory suggests that it might be the director, at least if the director is able to impose his artistic judgments on the film. Traditionally, by analogy to books, the author was regarded as the person who writes the screenplay, but often a movie reflects the work of many screenwriters. Grenier suggests that the person with creative control tends to be the person in whose name the money is raised, perhaps a star, perhaps the director, perhaps the producer, with control gravitating to the star as the financial investment in scenes already shot grows. Where the visual aspect of the movie is especially important, the chief cinematographer might

⁴⁶ *Id.* (citing 1 Nimmer § 2.10[A](2)(a) at 2-149).

⁴⁷ *Id.* at ____.

⁴⁸ *Id.* at 606 (citing *CCNV v. Reid*, 490 U.S. at 734).

⁴⁹ *Id.*

⁵⁰ *Id.* at 607.

⁵¹ *Id.* (also citing 1 Nimmer § 2.10[A](2)(b), at 2–150 to 2–151).

⁵² 202 F.3d 1227, 1229 (9th Cir. 2000).

be regarded as the author. And for, say, a Disney animated movie like “The Jungle Book,” it might perhaps be the animators and the composers of the music.⁵³

Performers are noticeably absent from this list of potential authors – with the sole exception of a “star,” and then only if the star is instrumental in attracting financing.⁵⁴

Aahluhammed did a further disservice to performers with its revisionist interpretation of *Burrow-Giles Lithographic Co. v. Sarony*,⁵⁵ a case which stands for the simple proposition that photographs are “writings” within the meaning of Article 1, Section 8, Clause 8.⁵⁶ In the Ninth Circuit’s tortured retelling, however, *Burrow-Giles* made it virtually impossible for the person who poses for a photograph to be considered an author – at least, in the days before “selfies”:

Burrow-Giles defines author as the person to whom the work owes its origin and who superintended the whole work, the “master mind.” In a movie this definition, in the absence of a contract to the contrary, would generally limit authorship to someone at the top of the screen credits, sometimes the producer, sometimes the director, possibly the star, or the screenwriter—someone who has artistic control. After all, in *Burrow-Giles* the lithographer made a substantial copyrightable creative contribution, and so did the person who posed, Oscar Wilde, but the Court held that the photographer was the author.⁵⁷

Of course, *Burrow-Giles* held nothing of the kind.⁵⁸ But the Ninth Circuit panel apparently convinced itself that performers can simply be disregarded in the authorship analysis.

3. **Morrill v. The Smashing Pumpkins**⁵⁹

Despite coming on the heels of *Aahluhammed*’s troubling dicta, this case was a victory for performers – at least on the surface. When The Smashing Pumpkins released a music video, *Vieuphoria*, that included excerpts from an earlier video created for Billy Corgan’s previous band, The Marked, the videographer that created the Marked video sued for copyright infringement. Rejecting Morrill’s claim of sole authorship, the district court emphasized that the band’s music was “the central component of the completed work,” and the band “had sole control over the writing and performing of the video’s music.” Therefore, Morrill and the Marked band members were joint authors of the video:

⁵³ 202 F.3d at 1232 (citing Richard Grenier, *Capturing the Culture* 206-07 (1991)).

⁵⁴ The list of potential “auteurs,” in fact, corresponds to French law. [CITE]

⁵⁵ 111 U.S. 53, 61 (1884).

⁵⁶ U.S. Const., Art. 1, Sec. 8., Cl. 8.

⁵⁷ *Aahluhammed*, 202 F.3d at 1233-34.

⁵⁸ For support, *Aahluhammed* cites a passage in *Burrow-Giles*, 111 U.S. at 61, that discusses the English case *Nottage v. Jackson*, 11 Q.B. Div. 627 (1883). That case, however, merely held that the author of a photograph was the photographer who took the photo rather than the person that hired the photographer and later produced positive prints from the photographic negative. It is, in effect, a work made for hire analysis. Although the *Burrow-Giles* passage is replete with “master mind” language, neither *Nottage* nor *Burrow-Giles* ruled out the possibility that the subject of the photo could be a joint author with the photographer.

⁵⁹ 157 F.Supp.2d 1120 (C.D. Cal. 2001).

In a music video, the creator of the songs and the creator of the images are both “the inventive or master mind[s]” whose work comes together to produce a unitary whole. Since both parties had creative control over separate and indispensable elements of the completed product, the first *Aalmuhammed* factor favors a finding of joint authorship.⁶⁰

The evidence showed that the second *Aalmuhammed* factor – a “shared intent to create a joint work” was satisfied. The court also resolved the third factor – “the source of the audience appeal of the work” – in favor of joint authorship, concluding that “the audience appeal . . . rests both on the video's visual aspects and on the composition and performance of the music.”⁶¹

The district court declared the law to be “clear” regarding authorship of sound recordings and music videos:

In the case of a sound recording, the law is clear: absent an employment relationship or express assignment of copyright, the copyright for the sound recording “will be either exclusively in the performing artists, or (assuming an original contribution by the sound engineers, editors, etc., as employees of the record producer), a joint ownership between the record producer and the performing artists.” The case of a music video is equally clear: absent a written agreement, the copyright for the music video is a joint ownership between the performing artists and the video's producer (assuming an original contribution by the producer or an employee of the producer).⁶²

While this case was a victory for performers, there is a catch. The music performed on the Marked video included original compositions written by the band.⁶³ The court described The Marked as having “sole control over the writing and performing of the video’s music,” and noted that the video’s audience appeal derived in part from the “composition. . . of the music.” Thus, the court recognized that the members of The Marked were not merely performers – they were also authors of the underlying written expression. It is impossible to tell whether the case would have come out the same way if The Marked had performed only covers on the video.

⁶⁰ 157 F.Supp.2d at 1124 (citing *Aalmuhammed v. Lee*, 202 F.3d 1227, 1229 (9th Cir. 2000)).

⁶¹ *Id.* at 1125. The court evaluated the “appeal” factor in two time frames – the original release of the Marked video, and also the release of Vieuphoria eight years later:

At the time when Video Marked was first displayed, at the clubs where The Marked was playing, the appeal of the work presumably was based on the audience's ability to hear additional performances by the band and to view the band in a different light. After Corgan's new band, The Smashing Pumpkins, gained success, the appeal of “View Marked” [sic] was most likely based on the audience's ability to view images of a younger Corgan.

Id. While it seems counterintuitive to evaluate the audience appeal based on events that occurred eight years after the putative joint work was created, filmed entertainment is not necessarily released promptly after its creation.

⁶² 157 F.Supp.2d at 1126 (quoting *M. Nimmer & D. Nimmer*, 1 *Nimmer on Copyright* § 2.10[A][3] (2001)).

⁶³ *Id.* at 1123.

4. Natkin v. Winfrey⁶⁴

When the plaintiff photographers sued Oprah Winfrey for publishing photos they took of her on the set of her talk show, Winfrey argued that she and her production company, Harpo Productions, were joint authors with the photographers.⁶⁵ The court held, however, that the photos were not joint works, because the defendants' contributions were not independently copyrightable.⁶⁶ The court reached this conclusion by treating Winfrey's contributions to the photos as uncopyrightable, relying in part on an obscure Copyright Office regulation:

The Copyright Office, whose opinion as to the scope of the Copyright Act is afforded great deference, instructs that "the nature of the thing depicted or the subject of the photograph or hologram ... is not regarded as a copyrightable element." Copyright Office, *Compendium II of Copyright Office Practices* § 508.01 (1998 Supp.). This is because ideas and facts are not copyrightable; rather copyright law protects only the tangible expression of ideas and facts. Thus, for example, in *Leigh v. Warner Bros., Inc.*, the Eleventh Circuit rejected a photographer's copyright claim to the subject of his photograph, the combination of items in the photograph, the association of the photograph's subject matter with the best-selling novel on which the picture appeared (an association the defendants copied when advertising their film based on the book), and the "mood" of the photograph.⁶⁷

The court concluded that Winfrey and her company contributed only noncopyrightable elements to the photographs: "They claim authorship of Winfrey, her facial expressions, her attire, the 'look' and 'mood' of the show, the choice of guests, the staging of the show, and so on."⁶⁸ The court rejected all of these as uncopyrightable.

There are many problems with this analysis. First, the Copyright Office regulation clearly does not address copyright in any creative expression that is captured in a photograph. If a photograph depicts a painting or sculpture, for example, the "subject of the photograph" is clearly a "copyrightable element." Therefore, the regulation is probably intended to convey that the *photographer* cannot claim copyright in the subject matter of the photograph – that is, Oprah Winfrey's appearance, clothing, and expression. As interpreted by the court, however, the regulation provides that photographing copyrightable expression causes that expression to *lose* its copyright protection. Any such regulation

⁶⁴ 111 F.Supp.2d 1003 (N.D. Ill. 2000).

⁶⁵ The court rejected the defendants' argument that the photos were works made, finding that the photographers were not the defendants' employees, and that there was no signed, written work made for hire agreement. 111 F.Supp.2d at 1008-1010.

⁶⁶ *Id.* at 1010 (citing *Erickson*, 13 F.3d at 1071, which relied on the Goldstein test)

⁶⁷ *Id.* at 1010 (citations omitted) (citing *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991) and *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210, 1214-15 (11th Cir. 2000)); *see also id.* at 1011 (citing *Gentieu v. John Muller & Co.*, 712 F. Supp. 740, 742 (W.D. Mo. 1989) ("[T]he plaintiff cannot claim a copyright on the idea of photographing naked babies. Neither can the poses in which those babies are photographed be the proper material for copyright.")).

⁶⁸ *Id.* at 1011.

would clearly be inconsistent with sections 102 and 103 of the 1976 Act.⁶⁹ Thus, the regulation merely states that a photographer's copyright does not extend to the subject matter of the photograph.

Second, in quoting the regulation the court ellipsed out the phrase "as distinguished from its composition or arrangement."⁷⁰ When the regulation is read in its entirety, it clearly recognizes that composition and arrangement of uncopyrightable elements can be a copyrightable aspect of a photograph. To the extent that Winfrey or her production company chose how she would appear in the photographs, this could be considered an aspect of composition and arrangement, and therefore copyrightable. Thus, when read in its entirety, the regulation is largely consistent with established copyright law, and does not negate the possibility that a photograph may incorporate copyrightable expression that is not contributed by the photographer.

Finally, to the extent that the regulation takes a position that is inconsistent with federal copyright statutes, it is not a lawful regulation.

By latching onto the copyright regulation, and misconstruing it, the court missed the real issue – whether Winfrey or her production company made creative choices in presenting her image for still photography. If the case had involved a videotape rather than a photograph, the court might well have given greater weight to Winfrey's creative contribution. Not only would the copyright regulation have been inapplicable, but the additional creative elements of movement and speech would have been difficult for the court to ignore. The court expressly acknowledged that the videotape of Winfrey's show was copyrightable:

[A] performance itself is not subject to copyright until it is captured in a fixed tangible form. No doubt, Harpo has the copyright to the videotape of the show's broadcast; Harpo employees created a fixed, tangible expression of the performances via videotape. But, in terms of the photographs, Natkin and Green translated images of the performance into photographs. As to those photographs, the plaintiffs are the sole authors.⁷¹

Note that, even here, the court overlooks the possibility that some of the performers are authors of the videotape; the court that the production company is the author of the videotape because its employees "created a fixed, tangible expression of the performance." The court gives no authorship credit to the persons who created the performance itself – Winfrey and the guests and other performers on the show. This is the same error that led the court to give no credit to Winfrey for her role in creating the images captured in the photographs. From this court's perspective, a performance just happens – no authorship is involved. This dismissive attitude toward performers is reminiscent of the

⁶⁹ 17 U.S.C. §§ 102 (copyrightable subject matter), 103(b) (copyright in derivative work has no effect on copyright in underlying work).

⁷⁰ Copyright Office, *Compendium II of Copyright Office Practices* § 508.01 (1998 Supp.).

⁷¹ 111 F.Supp.2d at 1011.

pre-1971 perception that sound recordings were mechanical devices rather than creative works,⁷² or the argument in *Burrow-Giles* that photographs were not “writings” because they were merely physical phenomena.⁷³

5. *Olan Mills v. Eckerd Drug*⁷⁴

This dispute turned on the question whether the subjects of portrait photos are joint authors of the photos. More cursory in its analysis than *Natkin v. Winfrey*, the court dismissed the photographic subjects’ contributions with little discussion. While recognizing the concept of joint authorship, the court found it inapplicable to a portrait photo: “The simple fact that an individual brings his own image to the studio is not enough to give that person a protectable property right in the portrait.”⁷⁵

C. The Mess that is *Garcia v. Google*⁷⁶

Garcia illustrates the confusion courts can experience when faced with a performer’s claim of authorship. Actress Cindy Lee Garcia agreed to perform in “Desert Warrior,” an adventure film set in ancient Arabia, written and produced by Mark Basseley Youssef. Although there was no written contract, she performed her role, and was paid for her work. However, Youssef never made “Desert Warrior.” Instead, he incorporated Garcia’s recorded performance into an anti-Islamic film called “Innocence of Muslims,” in which her performance was partially dubbed so that she appeared to be asking “Is your Mohammed a child molester?” When the film was released in Egypt, a Muslim cleric issued a fatwa, calling for the death of everyone involved in the film, and Garcia received death threats.

When the film appeared on YouTube, Garcia sent Google several takedown notices pursuant to 17 U.S.C. § 512(c)(3). When Google refused to remove the film, Garcia applied for a temporary restraining order on the ground of copyright infringement, asserting that she owned the copyright in her recorded performance. Treating this as a motion for a preliminary injunction, the district court denied the motion, holding that Garcia was unlikely to succeed on the merits because she had granted Youssef an implied license to incorporate her performance in the film.⁷⁷

A split panel of the Ninth Circuit reversed.⁷⁸ In his majority opinion, Judge Kozinski held that Garcia was not a joint author of the film, because (1) she argued that she never intended her performance to be a part of a joint work, and (2) under Ninth Circuit law, she did not qualify as a joint

⁷² CITE See also *White-Smith Music Pub. Co. v. Apollo Co.*, 209 U.S. 1, 18 (1908) (holding that piano rolls were not “copies” of musical compositions because they were merely “parts of a machine”).

⁷³ *Burrow-Giles*, 111 U.S. at 59.

⁷⁴ 1989 Copr. L. Dec. ¶ 26,420, 1989 WL 90605 (N.D. Tex. 1989).

⁷⁵ 1989 WL 90605, at *1.

⁷⁶ 743 F.3d 1258 (9th Cir. 2014).

⁷⁷ *Garcia v. Nakoula*, CV 12-08315-MWF (VBKx) (C.D.Cal. Nov. 30, 2012).

⁷⁸ *Garcia v. Google, Inc.*, 2014 U.S. App. LEXIS 3694 (9th Cir. Feb 26, 2014).

author.⁷⁹ He noted, however, that even if Garcia was not a joint author of “Innocence of Muslims,” this did not foreclose the possibility that she could be the sole author of her recorded performance, and thus its copyright owner.⁸⁰ When Youssef, as screenwriter, recorded Garcia performing his script, he implicitly gave her permission to create a derivative work – her recorded performance.⁸¹ Although Kozinsky did not believe that Garcia owned a “copyright interest in the entire scene” in which she appeared, he held that she could “assert a copyright interest . . . in the portion of ‘Innocence of Muslims’ that represents her individual creativity.”⁸²

The majority rejected Google’s arguments that Youssef owned the copyright in Garcia’s scenes under the work made for hire doctrine or under an implied license. Garcia’s scene was not a work made for hire, because she was not a traditional employee, and she did not sign a written work-made-for-hire agreement.⁸³ Although Garcia granted Youssef an implied license to use her recorded performance, Youssef exceeded the scope of that license by incorporating her scene in a film that was “radically” different from the one in which she had agreed to appear.⁸⁴ In addition, the license was “likely” void because it was procured by fraud.⁸⁵ Therefore, Youssef’s use of the scene – and Google’s posting of the clip incorporating the scene -- was an infringement.⁸⁶

Dissenting, Judge Smith expressed doubt whether Garcia’s performance gave rise to a copyrightable work at all.⁸⁷ He also concluded that she was not an “author,”⁸⁸ and that her performance did not satisfy the fixation requirement of copyright law.⁸⁹ Even if her contribution was copyrightable, he concluded that it was a work made for hire because she was Youssef’s employee.⁹⁰

Unfortunately, the extreme nature of the parties’ litigating positions hindered the Ninth Circuit panel’s ability to apply the law correctly. Both parties took positions that prevented the court from analyzing Garcia’s recorded performance as a joint work. In addition, Judge Kozinsky erred in treating Garcia’s recorded performance as a derivative work of which she was the sole author. While the recorded performance of a script does give rise to a derivative work (in this case, a motion picture), that does not resolve the question of who authored the derivative work. Garcia was, at best, a joint author rather than a sole author of her recorded performance. Therefore, she had no legal authority to veto the other joint owners’ exploitation of her scene, including posting it on YouTube. At worst, she was no author at all, because the scene may have been a work made for hire. In either event, the idea that Garcia could be the author of one “scene” in a movie is nonsense, because scenes in a movie are part of

⁷⁹ *Id.* at *2.

⁸⁰ *Id.*

⁸¹ *Id.* at *3.

⁸² *Id.*

⁸³ *Id.* at *4.

⁸⁴ *Id.* at *5.

⁸⁵ *Id.*

⁸⁶ *Id.* at *6.

⁸⁷ *Id.* at *9.

⁸⁸ *Id.* at *10-12.

⁸⁹ *Id.* at *12-13.

⁹⁰ *Id.* at *13-14

a unitary work; if she recorded her scene with the intent of merging it into the other scenes of a motion picture, then she is either a joint author of the resulting film, or no author at all.

1. Was Garcia a Joint Author?

Like several other circuits, the Ninth Circuit's joint authorship analysis emphasizes control, requiring each author to be a "master mind," and to demonstrate an intent to share authorship with one another. However, it departs from other circuits by adding a third inquiry – how each contribution affects the audience appeal of the work. As stated in *Aalmuhammed v. Lee*:

First, an author "superintend[s]" the work by exercising control. This will likely be a person "who has actually formed the picture by putting the persons in position, and arranging the place where the people are to be--the man who is the effective cause of that," or "the inventive or master mind" who "creates, or gives effect to the idea." Second, putative coauthors make objective manifestations of a shared intent to be coauthors, as by denoting the authorship of *The Pirates of Penzance* as "Gilbert and Sullivan." We say objective manifestations because, were the mutual intent to be determined by subjective intent, it could become an instrument of fraud, were one coauthor to hide from the other an intention to take sole credit for the work. Third, the audience appeal of the work turns on both contributions and "the share of each in its success cannot be appraised." Control in many cases will be the most important factor.

The best objective manifestation of a shared intent, of course, is a contract saying that the parties intend to be or not to be co-authors. In the absence of a contract, the inquiry must of necessity focus on the facts. . . .⁹¹

Under this approach to joint authorship, it is entirely possible that Garcia was one of the joint authors of her specific scene in the film, if not the entire film.⁹² However, because she chose to assert sole authorship of her recorded performance, she disclaimed joint authorship of the film. It is hardly surprising, therefore, that the district court failed to perform a joint authorship analysis of her recorded performance. Instead, the district court concluded that even if she owned the copyright in her performance, she had granted Youssef an implied license to exploit that performance.⁹³

Google, too, passed up the opportunity to argue joint authorship. Instead, Google took the position that Garcia was not an author at all, because she did not "make a protectible contribution to the film."⁹⁴ When the Ninth Circuit rejected this extreme position, finding that Garcia did indeed have an authorship claim, Google's failure to assert that she was merely a joint author foreclosed an important defense to her infringement claim.

⁹¹ 202 F.3d 1227, 1235 (9th Cir. 2000).

⁹² This determination would require a factual inquiry as to the circumstances of the filming, including the specific creative contributions provided by Garcia and others involved in the filming, and their manifestations of intent with respect to authorship. None of that information appears in the district court opinion.

⁹³ *Garcia v. Nakoula*, *supra* (citing *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 558-59 (9th Cir. 1990)).

⁹⁴ *Garcia*, 2014 U.S. App. LEXIS 3694, at *2.

If the parties had not prevented the court from considering joint authorship, as a threshold matter the question would arise as to what “work” should be the focus of the authorship analysis – the entire film, or only the scene in which Garcia contributed. Assuming that she was aware that her scene was just one component of a larger work, she could conceivably make a joint authorship claim to the entire work.

However, even if Garcia was a joint author of her scene, or the entire film, the other joint author(s) could include the film’s director, its writer and producer (the two positions held by Youssef), the composer (if any), the other performers, the editors, the camera operators, and the sound, set, make-up, costume and lighting designers. Because Garcia insisted that she was not asserting joint authorship, neither the district court nor the court of appeals considered the existence or number of possible joint authors. Because it is highly unlikely that Garcia was the sole author of her scene, or of the entire film, she had no right to prevent any of her co-authors from exploiting the scene, including posting it on YouTube.⁹⁵

2. Was the Film a Work Made For Hire?

Judge Kozinsky also held that Google failed to establish that Garcia’s contribution to the film was a work made for hire. Because Garcia did not execute a signed, written work-made-for-hire contract (a serious oversight by the producer), her contribution to the film could be a work made for hire only if she performed her services as an employee of the producer. However, neither the majority nor the dissent undertook a rigorous analysis of this question. At the preliminary injunction stage, the evidence was probably insufficient to make a work-made-for-hire determination under the *CCNV* factors. Indeed, because Youssef was apparently an amateur filmmaker, he probably did not conform to industry norms; therefore, the courts could not make any assumptions based on custom. However, because Garcia was the party seeking the preliminary injunction, she bore the burden of proving that she was likely to succeed on the merits of her infringement claim, including the question of copyright ownership.⁹⁶ Because she failed to demonstrate that she was not Youssef’s employee under the common law of agency, the court should have ruled that she was unlikely to succeed in establishing sole authorship of her performance.

3. Implied License

When a court can find neither joint authorship nor a work made for hire relationship, it may conclude that the performer gave an implied license for the use of his or her recorded performance. The difficulty with an implied license, however, is that the court must invent the terms of the license, essentially guessing the parties’ intent. In a matter as complex and potentially valuable as recorded entertainment, guessing is a risky endeavor, especially in a situation like *Garcia*, where one or both of the contracting parties are inexperienced, outsiders, or otherwise unfamiliar with the customs of the industry. Nonetheless, Judge Kozinsky attempted to “fill in the blanks” of an imaginary license from

⁹⁵ For the same reason, it is immaterial whether Youssef used fraudulent means to obtain Garcia’s consent to use her scene in his film, because she did not own the scene to begin with.

⁹⁶ CITE

Garcia to Youssef.⁹⁷ He read limiting terms into Garcia's implied license, holding that the license "wasn't so broad as to cover the use of her performance in *any* project."⁹⁸ Because Youssef's film "differs so radically from anything that Garcia could have imagined when she was cast," the court concluded that "it can't possibly be authorized by any implied license she granted Youssef."⁹⁹ The opinion court cites no support for this conclusion. It might be argued that, on the contrary, an inexperienced, underemployed actor (which Garcia appears to have been) who is eager for employment would probably be willing to sign even the broadest of waivers regarding the subsequent use of his or her filmed performance. If that was Garcia's intention, then she implicitly gave Youssef permission to use her recorded performance in any film he created.

III. "Reality" Depictions and the First Amendment

Any discussion of performers' rights must grapple with the question: Who is a performer? If the concept of authorship is broadened to take account of performers' creative contributions, the potential for authorship claims will be greatest in situations where the parties have not executed enforceable work made for hire contracts. While this may occur with inexperienced filmmakers and record producers, it will occur even more often in the context of "reality" recordings – that is, sound or video recordings to which the participants did not give explicit or implicit consent. This scenario could arise from news or documentary footage, or from impromptu recordings of interesting people or events – the sort of recordings that might find their way to YouTube.

Litigation arising from the Woodstock music festival illustrates the potential for such claims. In *Man v. Warner Bros. Inc.*,¹⁰⁰ a professional musician performing at Woodstock mounted the stage at 4 a.m. and played his Flugelhorn. His impromptu performance was captured by documentary filmmakers, who included 45 seconds of this footage in their commercially released film without his consent. When he sued under New York's privacy statute, the court rejected his claim because (1) a professional musician who takes the stage in front of a large audience is a public figure, (2) the footage was a factual depiction of his participation in a newsworthy event, and (3) his performance was a de minimis portion of the film.¹⁰¹

In *Taggart v. Wadleigh-Maurice Ltd.*,¹⁰² the same documentarians encountered a worker (Taggart) who was cleaning the portable toilets at Woodstock. They engaged him in conversation as he carried out his work, and included two minutes of this footage in the finished film. This portion of the film proved to be significant and memorable, and was the subject of commentary by film critics. Although Taggart was aware that the defendants were using cameras, he was not aware that they were creating a film for commercial release, nor did he expressly consent to be a performer in that film. When he sued the filmmakers under the New York privacy statute, the case turned on the question whether he was made an involuntary performer in a commercial film or was merely a participant in a

⁹⁷ Of course, the issue of implied license becomes irrelevant if Garcia was not the sole author of her recorded performance, because she had no unilateral power to object to any unlicensed use of that performance.

⁹⁸ *Garcia*, 2014 U.S. App. LEXIS 3694, at *5.

⁹⁹ *Id.*

¹⁰⁰ 317 F.Supp. 50 (S.D.N.Y.1970).

¹⁰¹ *Id.* at 52-53.

¹⁰² 489 F.2d 434 (3d Cir. 1973).

newsworthy event. The Third Circuit held that a fuller factual record was necessary to this determination.¹⁰³ The court distinguished *Man* in two ways: (1) Taggart was not a professional musician performing before an audience; and (2) the critics' reaction precluded treating the use of Taggart's persona as de minimis.¹⁰⁴

Another illustrative case is *Gautier v. Pro-Football, Inc.*¹⁰⁵ Here, an animal trainer who agreed to perform at half-time during a football game sued under the New York privacy statute because his performance was televised without his consent. New York's highest court rejected his claim, because the football game was a newsworthy spectacle and he voluntarily made himself the center of attention during halftime.¹⁰⁶

While these were litigated as privacy/publicity claims, they could potentially turn into authorship disputes as well. If the participant knew that he or she was being recorded, and thus implicitly consented to the recording, this would satisfy copyright's fixation requirement as well as the intent-to-merge requirement for a joint work. The question would then turn on whether the contribution was independently copyrightable, and any other factors the jurisdiction uses to determine whether joint authorship requirements are satisfied (e.g., intent to share authorship). A successful claimant could obtain a share of any profits generated by the work, and could object to any assignment or exclusive license of the work. Even if the "performer" granted an express or implied license for exclusive exploitation of the work, that license would be subject to termination.

The performers in the examples above were either voluntary or semi-voluntary performers. Gautier and the flugelhorn player at Woodstock may have intended to perform, but not to be televised or recorded (although arguably these were foreseeable risks). In *Taggart*, the plaintiff consented to being recorded, and thus consented to perform, although like the plaintiff in *Garcia* he argued that he did not consent to the particular way his performance was presented. In addition to these scenarios, there is also a category of completely involuntary performers. Persons who do not know that they are being recorded (for example, on a security camera or on the cell phone of a passer-by), cannot consent to the fixation, which means they cannot assert either sole or joint authorship of a copyrighted work. This would be true even if the person was consciously performing in a creative manner – for example, a street performer. Other persons may not intend to perform any creative expression at all – yet may be filmed by a passerby who finds their appearance or behavior odd, amusing, or alarming. Arguably such persons would have even weaker claims of authorship, because they contributed no creative expression. This is the problem presented by *Natkin v. Winfrey* and *Olan Mills v. Eckerd Drug*. At what point is a person's "performance" contribution so minimal and uncreative that it cannot be the basis for an authorship claim? While the subject of a pedestrian snapshot may not contribute enough creativity to be considered an author, the same may not be true of a fashion model or a performance artist.

¹⁰³ *Id.* at 438.

¹⁰⁴ *Id.* at 437.

¹⁰⁵ 304 N.Y. 354, 107 N.E.2d 485 (1952).

¹⁰⁶ 304 N.Y. at 360. See also *Blumenthal v. Picture Classics*, 235 App. Div. 570, *aff'd*, 261 N.Y. 504 ().

While the truly involuntary performer who does not consent to fixation may have a claim for infringement of the right of publicity or privacy, in some cases that claim must bow to the First Amendment, especially if the performance was in a public place or in the context of a newsworthy event. If that performer *does* consents to being recorded, however, he or she may have an authorship claim based on the creativity of the contribution. At some point, it would seem that this authorship claim, too, should yield to First Amendment considerations. Thus, as we expand the notion of authorship to include performers' contributions, it will be essential to consider not only what kinds of contributions give rise to authorship claims, but also to what extent, if any, those claims should be barred by the First Amendment.