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## Using Copyright to Remove Content: An Analysis of *Garcia v. Google*

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## Using Copyright to Remove Content: An Analysis of Garcia v. Google

### Cover Page Footnote

Notes and Articles Editor, Fordham Intellectual Property, Media & Entertainment Law Journal, Volume XXVI; J.D. Candidate, Fordham University School of Law, 2016; B.A., Boston College, 2012. I would like to thank Professor Hugh Hansen and Nick Bartelt for their advice and guidance. Thank you to Liz, Katie, and the IPLJ staff for all your hard work. Lastly, to my family and Vishrut, thank you for your support and encouragement.

# Using Copyright to Remove Content: An Analysis of *Garcia v. Google*

Elizabeth Martin\*

INTRODUCTION.....	464
I. <i>GARCIA V. GOOGLE</i> .....	466
A. <i>Background Facts</i> .....	466
B. <i>Garcia I</i> .....	467
1. <i>Garcia Has a Copyrightable Interest</i> .....	467
2. <i>Implied License</i> .....	469
3. <i>Irreparable Harm and Injunctions</i> .....	469
4. <i>Amended Opinion</i> .....	471
C. <i>Criticism of Garcia I</i> .....	471
D. <i>Garcia II</i> .....	473
II. <i>GARCIA’S POTENTIAL ALTERNATIVE LEGAL     OPTIONS</i> .....	474
A. <i>What Relief Does Garcia Want?</i> .....	475
B. <i>Digital Millennium Copyright Act and Takedown         Notices</i> .....	477
C. <i>Garcia Should Have Pursued a Tort Claim in State         Court</i> .....	478
D. <i>Issues Created from Suing Youssef Alone</i> .....	479
1. <i>Google Not Liable Under Section 230</i> .....	479
2. <i>Enforcing an Injunction Against a Third-             Party</i> .....	480
E. <i>Websites Voluntarily Removing Content and         Complying With Injunctions</i> .....	481

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III. BEYOND <i>GARCIA I</i> AND <i>GARCIA II</i> : THE CURRENT LANDSCAPE.....	483
<i>A. Using Copyright to Remove Content: Revenge Porn ...</i>	483
<i>B. Using Copyright to Remove Content: Suppression of         “Negative” Information .....</i>	486
<i>C. Potential Solutions .....</i>	488
CONCLUSION.....	490

### INTRODUCTION

The facts leading up to *Garcia v. Google (Garcia I)*,<sup>1</sup> a Ninth Circuit case reheard en banc (*Garcia II*),<sup>2</sup> were just as strange as the effects of the original ruling. A casting call had been posted online for a film described as a “historical desert drama set in the Middle East”<sup>3</sup> about a man named George and his gang of warriors.<sup>4</sup> It was not until after the video was posted on YouTube, did the actors learn the true significance of the film. The film ended up being a fourteen minute anti-Islamic trailer, portraying the prophet Muhammad as a womanizer, pedophile, and murderer.<sup>5</sup>

The filmmaker intentionally deceived the actors.<sup>6</sup> He caused them emotional distress and even invaded the actors’ privacy.<sup>7</sup> Ultimately, one of the actors, Cindy Lee Garcia, and her attorney relied on a copyright claim in federal court to seek a motion for a pre-

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<sup>1</sup> *Garcia v. Google (Garcia I)*, 766 F.3d 929 (9th Cir. 2014), *rev’d en banc*, 786 F.3d 733 (9th Cir. 2015).

<sup>2</sup> *See Garcia v. Google (Garcia II)*, 786 F.3d 733 (9th Cir. 2015) (en banc).

<sup>3</sup> Adrian Chen, “*It Makes Me Sick*”: *Actress in Muhammed Movie Says She Was Deceived, Had No Idea It Was About Islam*, GAWKER (Sept. 12, 2012, 5:29 PM), <http://gawker.com/5942748/it-makes-me-sick-actress-in-muhammed-movie-says-she-was-deceived-had-no-idea-it-was-about-islam> [<http://perma.cc/482F-E9CB>].

<sup>4</sup> *See* Michael Joseph Gross, *Disaster Movie*, VANITY FAIR (Dec. 27, 2012, 12:00 AM), <http://www.vanityfair.com/culture/2012/12/making-of-innocence-of-muslims> [<http://perma.cc/M2H6-7Z35>].

<sup>5</sup> *See id.*

<sup>6</sup> Serge F. Kovaleski & Brooks Barnes, *From Man Who Insulted Muhammad, No Regret*, N.Y. TIMES (Nov. 25, 2012), <http://www.nytimes.com/2012/11/26/us/from-the-man-who-insulted-islam-no-retreat.html> [<http://perma.cc/DJ3D-74DM>].

<sup>7</sup> *Garcia I*, 766 F.3d 929 (9th Cir. 2014), *rev’d en banc*, 786 F.3d 733 (9th Cir. 2015).

liminary injunction to have Google remove the film from YouTube.<sup>8</sup>

However, although Garcia had suffered harm, such as receiving death threats,<sup>9</sup> the harms she had suffered cannot be appropriately remedied by copyright law. “Although we do not take lightly threats to life or the emotional turmoil Garcia has endured, her harms are untethered from—and incompatible with—copyright and copyright’s function as the engine of expression.”<sup>10</sup> Authors cannot seek claims for emotional distress, defamation, or privacy by filing claims under copyright law.<sup>11</sup>

“Privacy laws, not copyright, may offer remedies tailored to Garcia’s personal and reputational harms.”<sup>12</sup> Plaintiffs have attempted to use copyright law to resolve their issues, where privacy law would offer the best and most appropriate remedy to their harm. For example, there are individuals who want photos removed from websites because they have suffered privacy harms or they have suffered emotional distress. These individuals may attempt to use copyright law to have the photos removed, even though they have not suffered any harm related to the infringement of their copyright.

This Note will investigate how individuals attempt to use copyright law, instead of seeking damages for emotional distress or privacy, by using *Garcia I* and *Garcia II* as examples. Part I will provide background on *Garcia I* and *Garcia II*, the facts leading up to the lawsuit, the first decision and the criticism surrounding it, and the second decision. Part II will discuss what other legal methods Garcia may have used to achieve the same result and potentially obtain the same relief if she decided not to sue for copyright infringement. Part III will look beyond *Garcia I* and *Garcia II* at other types of situations where plaintiffs feel their best legal strategy is to sue for copyright infringement, even though their suits are more akin to defamation or privacy lawsuits, as a result of the protections for online hosts created by the Communications Decency Act.

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<sup>8</sup> *Id.*

<sup>9</sup> *Id.* at 932–33.

<sup>10</sup> *Garcia II*, 786 F.3d 733, 745 (9th Cir. 2015) (en banc).

<sup>11</sup> *See id.*

<sup>12</sup> *See id.*

I. *GARCIA V. GOOGLE*A. *Background Facts*

In 2011, Cindy Lee Garcia was featured in the film *Desert Warrior* for five minutes; a film she and her co-actors believed would be an Arabian “action-adventure movie.”<sup>13</sup> Prior to shooting the film, she received only four pages of script and roughly \$500 from the film’s screenwriter and producer, who referred to himself as Sam Bacile (real name Mark Basseley Youssef).<sup>14</sup>

It was only after the video had been posted on YouTube that the actors learned what Youssef had done and, as a result, how strongly the Islamic community had reacted to the newly titled *Innocence of Muslims*. Youssef had partially dubbed over the actors’ lines, making it appear as though Garcia was asking, “Is your Mohammed a child molester?”<sup>15</sup> The film had been described as “clearly designed to offend Muslims, portraying Mohammed as a bloodthirsty murderer and Lothario and pedophile with omnidirectional sexual appetites.”<sup>16</sup> Youssef admitted to creating the film as an open expression of his hatred of Islam and intentionally tricking the actors to help him create it.<sup>17</sup>

In 2012, an Egyptian cleric used a clip of the film on his television show sparking outrage and protests in Cairo.<sup>18</sup> The protests spread to Yemen, Morocco, Iran, Tunisia, Sudan, Iraq, Pakistan, Lebanon, Libya, Indonesia, and Malaysia.<sup>19</sup> Those involved with the film received death threats and went into hiding.<sup>20</sup> Garcia also

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<sup>13</sup> See Gross, *supra* note 4.

<sup>14</sup> See Gross, *supra* note 4. Youssef goes by several names, including his birth name Nakoula Basseley Nakoula, but the Ninth Circuit uses Youssef. See *Garcia I*, 766 F.3d at 932.

<sup>15</sup> See *id.*

<sup>16</sup> Gross, *supra* note 4.

<sup>17</sup> See Kovaleski & Barnes, *supra* note 6.

<sup>18</sup> David D. Kirkpatrick, *A Deadly Mix in Benghazi, Chapter 4: A Fuse Is Lit*, N.Y. TIMES (Dec. 28, 2013), <http://www.nytimes.com/projects/2013/benghazi/#/?chapt=3> [<http://perma.cc/ZE4F-R2CB>].

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

<sup>20</sup> See Gross, *supra* note 4.

claims she was made the subject of the cleric's fatwa "against anyone associated with *Innocence of Muslims*."<sup>21</sup>

Garcia filed several Digital Millennium Copyright Act ("DMCA")<sup>22</sup> takedown notices, which Google resisted.<sup>23</sup> In September 2012, Garcia brought suit against Youssef and Google seeking a restraining order, which would require Google to remove *Innocence of Muslims* from YouTube.<sup>24</sup> The district court denied her request for a preliminary injunction because Garcia had delayed in bringing the action.<sup>25</sup> The district court also found that Garcia had not established a likelihood of success on the merits of her claim because she is not considered an "author" under the Copyright Act and precedent,<sup>26</sup> and, even if she did own a copyright interest in her own performance, she had granted the film's author implied consent to use the performance.<sup>27</sup> Garcia ultimately appealed the preliminary injunction ruling to the Ninth Circuit.<sup>28</sup>

## B. Garcia I

On appeal, Judge Alex Kozinski, writing for a two-to-one majority, issued an order granting Garcia's motion for a preliminary injunction. The court's decision addressed three points: whether Garcia could retain a copyrightable interest in her performance, whether she had granted an implied license to Youssef to use her performance, and whether she is likely to show irreparable harm.

### 1. Garcia Has a Copyrightable Interest

In ordering Google to take the film down, the Ninth Circuit held that Garcia's performance is independently copyrightable.<sup>29</sup>

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<sup>21</sup> Brief of Plaintiff-Appellant at 10, *Garcia I*, 766 F.3d 929 (9th Cir. 2014) (No. 12-57302).

<sup>22</sup> See *infra* Part II.B. for a discussion on DMCA takedown notices.

<sup>23</sup> *Garcia I*, 766 F.3d at 932.

<sup>24</sup> See *id.*

<sup>25</sup> Order Denying Plaintiff's Motion for Preliminary Injunction at 2, *Garcia v. Nakoula*, No. 12-cv-08315-MWF-VBK (C.D. Cal. Nov. 30, 2012).

<sup>26</sup> See, e.g., *Aalmuhammed v. Lee*, 202 F.3d 1227, 1233 (9th Cir. 2000); see also *infra* Part I.B.

<sup>27</sup> See Order Denying Plaintiff's Motion for Preliminary Injunction, *supra* note 25, at 3.

<sup>28</sup> *Garcia I*, 766 F.3d 929.

<sup>29</sup> See *id.* at 940; see also Rebecca Tushnet, *My Long, Sad Garcia v. Google Blog Post*, REBECCA TUSHNET'S 43(B)LOG (Mar. 17, 2014), <http://tushnet.blogspot.com/2014/03/>

Judge Kozinski found that Garcia could retain a copyrightable interest in her own contribution to the film. Garcia admitted that she was not a joint author.<sup>30</sup> However, the court concluded that she could still be an author in her own performance, even if she is not a joint author of the whole film.<sup>31</sup> The majority held that her contribution was sufficient to make her an author of her own performance because an actor does more than simply speak the words on a page.<sup>32</sup> Otherwise, Judge Kozinski wrote, “every shmuck . . . is an actor because everyone . . . knows how to read.”<sup>33</sup> He wrote that it did not matter that Youssef had written the dialogue, managed all aspects of the production, and later dubbed over a portion of her scene.<sup>34</sup> The majority also noted that Garcia does not own an interest in the entire scene, just her contribution, albeit minor.<sup>35</sup> The court concluded that an individual could still make a copyrightable contribution and not become a joint author of the whole work.<sup>36</sup>

In opposition, the dissent asserted that the majority erred in holding that Garcia has a copyright interest in her performance.<sup>37</sup> The dissent argued Garcia’s performance is not protected under the Copyright Act because (1) it is not a “work,” (2) she is not an author, and (3) the performance is too personal to be fixed.<sup>38</sup> Additionally, it stated that Garcia’s claim is better characterized as one of a joint work.<sup>39</sup> The dissent wrote that, as Garcia was not the ori-

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my-long-sad-garcia-v-google-post.html [http://perma.cc/HFE5-R9WV] (providing further analysis on the holding of *Garcia*).

<sup>30</sup> See *Garcia I*, 766 F.3d at 933.

<sup>31</sup> See *id.* at 933–34.

<sup>32</sup> See *id.* at 934.

<sup>33</sup> See *id.* at 934 (quoting SANFORD MEISNER & DENNIS LONGWELL, SANFORD MEISNER ON ACTING 178 (1987)).

<sup>34</sup> See *id.*

<sup>35</sup> See *id.* at 935.

<sup>36</sup> See *id.* at 934.

<sup>37</sup> See *id.* at 941 (Smith, J., dissenting).

<sup>38</sup> See *id.*

<sup>39</sup> See *id.* at 942–44. The dissent uses *Aalmuhammed v. Lee* to show that Garcia does not qualify as an author because her contribution was minimal and she was not the originator of the ideas or concepts. See *id.* In *Aalmuhammed*, the Ninth Circuit rejected a consultant’s claim of co-authorship of a joint work because his contributions to the film, although valuable, were not enough for co-authorship. See *Aalmuhammed v. Lee*, 202 F.3d 1227, 1235 (9th Cir. 2000). The court said that to be an author “requires more than a minimal creative or original contribution to the work.” See *id.* (quoting *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1883)). However, the majority ultimately



ginator of the ideas or concepts (she simply acted them out), she is not the author.<sup>40</sup>

## 2. Implied License

Additionally, the court found that Garcia had granted an implied license to Youssef to use her performance in the film.<sup>41</sup> The majority held that implied licenses must be construed broadly, otherwise actors would possess an excessive amount of control over the films they starred in, especially if the film failed to meet the actor's "ex ante expectations."<sup>42</sup> However, the court found that an implied license is not unlimited.<sup>43</sup> Judge Kozinski wrote that Youssef exceeded the bounds of the license through his deceit and lies.<sup>44</sup> Further, "[t]he film 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."<sup>45</sup> Therefore, *Innocence of Muslims* itself is an infringing use of the implied license.<sup>46</sup>

## 3. Irreparable Harm and Injunctions

The majority discussed the finding of irreparable harm through both the damage to Garcia's reputation and through the death threats she received.<sup>47</sup> It is possible for "unreasonable delay [to] defeat irreparable injury."<sup>48</sup> The court found that even though Garcia took action only when she began to receive death threats,

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found that *Aalmuhammed* did not apply here because the case was about joint authorship over an *entire* work. *See Garcia I*, 766 F.3d at 934. The court concluded that an individual could still make a copyrightable contribution and not become a joint author of the work in its entirety. *See id.*

<sup>40</sup> *See id.* at 943 (Smith, J., dissenting).

<sup>41</sup> *See id.* at 937 (majority opinion).

<sup>42</sup> *See id.*

<sup>43</sup> *See id.*

<sup>44</sup> *See id.*

<sup>45</sup> *Id.*

<sup>46</sup> *See id.* at 938.

<sup>47</sup> *See id.* at 938–39.

<sup>48</sup> *See Garcia II*, 786 F.3d 733, 734 (9th Cir. 2015) (en banc) (quoting 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 14.06[A][3][c] (2002)).

and not earlier when she first discovered the video,<sup>49</sup> her actions were still reasonable and the issuing of an order to remove the film from YouTube would have enough of an effect on the death threats Garcia received to justify the injunction.<sup>50</sup> The court stated that:

A plaintiff seeking a preliminary injunction must show that: (1) she is likely to succeed on the merits, (2) she is likely to suffer irreparable harm in the absence of preliminary relief, (3) the balance of equities tips in her favor, and (4) an injunction is in the public interest.<sup>51</sup>

Here, the majority found a likelihood of success on the merits (Garcia's performance gives her a claim in copyright) and it found she suffered some irreparable harm. Accordingly, the court directed Google to "take down all copies of *Innocence of Muslims* from YouTube and any other platforms within its control and to take all reasonable steps to prevent further uploads."<sup>52</sup>

The dissent reminded the court that mandatory injunctions are particularly disfavored and should be subject to a higher degree of scrutiny.<sup>53</sup> As "Garcia seeks a mandatory injunction, she must establish that the law and facts *clearly favor* her position, not simply that she is likely to succeed."<sup>54</sup> The dissent also disagreed with the majority and found that since Garcia delayed in bringing suit, she had not demonstrated how she would continue to suffer irreparable harm.<sup>55</sup>

Last, the dissent included a discussion on balancing the equities.<sup>56</sup> The dissent argued that the balancing of the equities does not favor Garcia. It wrote that the injunction burdens Google, who is not a party to Youssef's actions, and it burdens free expression,

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<sup>49</sup> See *id.* ("Garcia waited months to seek an injunction after *Innocence of Muslims* was uploaded to YouTube in July 2012; she did not seek emergency relief when the film first surfaced on the Internet.").

<sup>50</sup> See *Garcia I*, 766 F.3d at 938-39.

<sup>51</sup> *Garcia II*, 786 F.3d at 740; *Farris v. Seabrook*, 677 F.3d 858, 864 (9th Cir. 2012) (citing *Winter v. Nat. Res. Def. Counsel*, 555 U.S. 7, 20 (2008)).

<sup>52</sup> See *Garcia I*, 766 F.3d at 940.

<sup>53</sup> See *id.* at 940 (quoting *Stanley v. Univ. of S. Cal.*, 13 F.3d 1313, 1320 (9th Cir. 1994)).

<sup>54</sup> See *Garcia II*, 786 F.3d at 740.

<sup>55</sup> See *Garcia I*, 766 F.3d at 947 (Smith, J., dissenting).

<sup>56</sup> See *id.* at 948.

whereas, Garcia's copyright interest is not guaranteed, but rather "potential."<sup>57</sup> Therefore, the dissent concluded that there was no abuse of discretion in the district court holding that Garcia would not likely succeed on the merits of her claim and should not be granted a preliminary mandatory injunction.<sup>58</sup>

#### 4. Amended Opinion

On July 11th, 2014, the court filed an amended opinion,<sup>59</sup> adding deliberations on the Copyright Office's refusal to register Garcia's copyright<sup>60</sup> and addressing the lack of discussion of any fair use defense.<sup>61</sup> The Copyright Office refused Garcia's application to register a copyright in her own performance and stated that actor's performances in motion pictures are a part of the motion picture and not a separable claim. The court also added that the majority opinion did not preclude the district court from finding that Garcia does not have a copyrightable interest in her performance on remand.<sup>62</sup> The dissent amended its opinion, as well, expanding its discussion to include first amendment concerns.<sup>63</sup>

### C. Criticism of Garcia I

Judge Kozinski's majority opinion in *Garcia I* attracted intense criticism, primarily on his interpretation of Garcia's copyright interest.<sup>64</sup> Most criticism resulted from the worry that third-party

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<sup>57</sup> See *id.*

<sup>58</sup> See *id.* at 949.

<sup>59</sup> Order and Amended Opinion, *Garcia I*, 766 F.3d 929 (No. 12-57302). The dissent also amended its opinion, albeit minimally.

<sup>60</sup> See Brief of Defendants-Appellees at Addendum 46, *Garcia I*, 766 F.3d 929 (No. 12-57302).

<sup>61</sup> See Alison Frankel, *Kozinski Amends Opinion in 9th Circuit 'Innocence' Case v. Google*, REUTERS (July 15, 2014), <http://blogs.reuters.com/alison-frankel/2014/07/15/kozinski-amends-opinion-in-9th-circuit-innocence-case-v-google/> [<http://perma.cc/53DH-2F4T>].

<sup>62</sup> See *Garcia I*, 766 F.3d at 935.

<sup>63</sup> For example, Judge Smith added a quote from the case *Winter v. Natural Resources Defense Council Inc.*, 555 U.S. 7 (2008). See *Garcia I*, 766 F.3d at 948-49 (Smith, J., dissenting).

<sup>64</sup> See, e.g., Corynne McSherry, *Bad Facts, Really Bad Law: Court Orders Google to Censor Controversial Video Based on Spurious Copyright Claim*, ELECTRONIC FRONTIER FOUND. (Feb. 26, 2014), <https://www.eff.org/deeplinks/2014/02/bad-facts-really-bad-law-court-orders-google-censor-controversial-video-based> [<http://perma.cc/NZ7A-XVR8>] (arguing that Garcia's copyright claim is questionable and that an injunction that

distributors and Internet publishers would not have the resources or the capability to determine whether an actor had a copyright interest in their own performance in a film.<sup>65</sup> Critics were concerned that Internet publishers may be forced to err on the side of those asserting their copyright rights, chilling more speech than should have to be removed, and placing a burden on websites that do not have the resources or the skills to remove content from their sites.

Other critics addressed the potential effect the ruling may have on the entertainment industry, especially the effect on small-budget amateur films or documentaries.<sup>66</sup> There was also concern for the potential effect on films where the lines of consent might be murky, for example where documentaries mislead their subjects in order to create their art.<sup>67</sup> In addition, there might be a heavier reliance on contracts for actors in the future; even though critics are currently concerned with the fact that movies generally do not contract with actors who played miniscule roles in the film. Movies with extremely large casts would have difficulty keeping track of all the actors who could claim a copyright in their performance.<sup>68</sup> The court attempted to address this problem in the amended opinion by stating that these problems would rarely occur since “the vast majority of films are covered by contract, the work for hire doctrine, or implied licenses.”<sup>69</sup>

However, Judge Kozinski is not without his supporters. For example, some have argued that the *Garcia I* decision is legally cor-

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suppresses speech should be heavily scrutinized); Schuyler M. Moore, *Garcia v. Google: Hard Cases Make Bad Law*, HUFFINGTON POST (May 5, 2014), [http://www.huffingtonpost.com/schuyler-m-moore/garcia-v-google-hard-case\\_b\\_4900376.html](http://www.huffingtonpost.com/schuyler-m-moore/garcia-v-google-hard-case_b_4900376.html) [<http://perma.cc/D26Q-M3JR>] (arguing the holding was wrong and the court should have used right of publicity); Tushnet, *supra* note 29.

<sup>65</sup> Brief of Defendants-Appellees, *supra* note 60, at 38.

<sup>66</sup> *Id.*

<sup>67</sup> See Roger Parloff, *11 Judges to Rehear Case Between Google and Actress with Fatwa on Her Head*, FORTUNE (Dec. 11, 2014), <http://fortune.com/2014/12/11/google-appeals-in-fatwa-case/> [<http://perma.cc/TSF5-PCGA>]; see also Jonathan Handel, *Hollywood Experts Divided on Implications of ‘Muslims’ Ruling*, HOLLYWOOD REP. (Feb. 28, 2014), <http://www.hollywoodreporter.com/thr-esq/hollywood-experts-divided-implications-muslims-684607> [<http://perma.cc/TV33-CLB4>].

<sup>68</sup> See *Garcia II*, 786 F.3d 733, 742 (9th Cir. 2015) (en banc) (using *Lord of the Rings* as an example of a movie that has twenty thousand extras).

<sup>69</sup> *Garcia I*, 766 F.3d 929, 936 (9th Cir. 2014), *rev'd en banc*, 786 F.3d 733 (9th Cir. 2015).

rect or that, given the unusual fact pattern, the ruling ultimately created the best outcome.<sup>70</sup> Actor and musician associations, in particular, expressed their approval, as these associations support the protection of actors' originality.<sup>71</sup>

Both sides were given an opportunity to set forth their positions when Google petitioned for a rehearing en banc.<sup>72</sup> Twelve amicus briefs were submitted in support for or opposition to the rehearing, including briefs by Netflix,<sup>73</sup> Adobe,<sup>74</sup> News Organizations,<sup>75</sup> intellectual property law professors,<sup>76</sup> and the Screen Actors Guild.<sup>77</sup>

#### D. Garcia II

In November 2012, the court granted Google's petition for a rehearing en banc.<sup>78</sup> Oral arguments were held on December 15, 2014 in front of a panel of eleven Ninth Circuit federal judges, and in May 2015 an opinion was issued.<sup>79</sup> The en banc court affirmed

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<sup>70</sup> See, e.g., Eugene Volokh, *Copyright Meets "Innocence Of Muslims": Ninth Circuit Orders Removal of Movie from YouTube, on Copyright Grounds*, WASH. POST (Feb. 26, 2014), <https://www.washingtonpost.com/news/volokh-conspiracy/wp/2014/02/26/copyright-meets-innocence-of-muslims-ninth-circuit-orders-removal-of-movie-from-youtube-on-copyright-grounds/> [http://perma.cc/7MQS-QY7X] (agreeing with the majority opinion, but arguing that Google has a fair use defense); see also Handel, *supra* note 67 (interviewing several law professors and entertainment lawyers who agree with the ruling).

<sup>71</sup> See generally Bill Chappell, *Google Wins Copyright and Speech Case over 'Innocence Of Muslims' Video*, NPR (May 18, 2015), <http://www.npr.org/sections/thetwo-way/2015/05/18/407732594/google-wins-copyright-and-speech-case-over-innocence-of-muslims-video> [http://perma.cc/NL84-XB5K].

<sup>72</sup> Petition for Rehearing En Banc, *Garcia I*, 766 F.3d 929 (No. 12-57302).

<sup>73</sup> Brief for Netflix, Inc. as Amicus Curiae Supporting Defendants-Appellees, *Garcia I*, 766 F.3d 929 (No. 12-57302) (arguing the reworking of copyright law hurts Netflix and other similar distributors).

<sup>74</sup> Brief for Adobe Systems et al. as Amici Curiae Supporting Defendants-Appellees, *Garcia I*, 766 F.3d 929 (No. 12-57302) (arguing the holding burdens online services and third-party distributors).

<sup>75</sup> Brief for News Organizations as Amici Curiae Supporting Defendants-Appellees, *Garcia I*, 766 F.3d 929 (No. 12-57302) (discussing First Amendment implications).

<sup>76</sup> Brief for Professors of Intellectual Property Law as Amici Curiae Supporting Defendants-Appellees, *Garcia I*, 766 F.3d 929 (No. 12-57302) (addressing the court's use of copyright law).

<sup>77</sup> Brief for Screen Actors Guild et al. as Amici Curiae Supporting Plaintiff-Appellant, *Garcia I*, 766 F.3d 929 (No. 12-57302).

<sup>78</sup> See Order Granting En Banc Rehearing, *Garcia I*, 766 F.3d 929 (No. 12-57302).

<sup>79</sup> *Id.*; see also *Garcia II*, 786 F.3d 733, 733 (9th Cir. 2015) (en banc).

the district court's opinion, holding that the district court did not abuse its discretion by denying the motion for a mandatory injunction.<sup>80</sup>

The majority wrote: "In this case, a heartfelt plea for personal protection is juxtaposed with the limits of copyright law and fundamental principles of free speech. The appeal teaches a simple lesson—a weak copyright claim cannot justify censorship in the guise of authorship."<sup>81</sup> The majority went on to point out that Garcia did not have a copyright claim because her performance was not fixed in a tangible medium, rather it is the role of the filmmaker to create the fixation of the performance.<sup>82</sup>

The majority also addressed the issue of irreparable harm.<sup>83</sup> The majority stated that Garcia had not demonstrated that she had suffered an irreparable harm as she had delayed before she sought an injunction.<sup>84</sup> Additionally, any harm she had suffered "did not stem from copyright"<sup>85</sup> and "Garcia's harms are too attenuated from the purpose of copyright."<sup>86</sup> This time Judge Kozinski, the author of the original majority opinion, dissented and reiterated much of his original opinion.<sup>87</sup>

## II. GARCIA'S POTENTIAL ALTERNATIVE LEGAL OPTIONS

Garcia initially began her lawsuit in state court, where she did not bring any claims under copyright law.<sup>88</sup> Garcia, in her complaint filed in district court, brought claims of: copyright infringement, fraud, unfair business practices, libel, and intentional infliction of emotional distress.<sup>89</sup> She left out a claim of right of publicity

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<sup>80</sup> *Id.* at 734.

<sup>81</sup> *Id.* at 736.

<sup>82</sup> *See id.* at 740–41.

<sup>83</sup> *See id.* at 744–46.

<sup>84</sup> *See id.* at 746.

<sup>85</sup> *Id.* at 744.

<sup>86</sup> *Id.* at 746.

<sup>87</sup> *See id.* at 749–53 (Kozinski, J., dissenting).

<sup>88</sup> Complaint, *Garcia v. Nakoula*, No. BC492358 (Cal. Super. Ct. Sept. 19, 2012).

<sup>89</sup> Complaint, *Garcia v. Nakoula*, No. 12-cv-08315-MWF-VBK (C.D. Cal. Sept. 26, 2012).

(which she had previously included in her complaint filed in state court).<sup>90</sup>

Garcia's choice to file a copyright lawsuit in federal court was strategic for a number of reasons. Yet, she should have filed a lawsuit in state court on tort claims, such as fraud. She would have had a high likelihood of success based on the facts of the case and the sympathy the court has expressed for her extremely unfortunate situation thus far.<sup>91</sup> The issue, however, is that the relief she received in federal court may not be the same or even similar to what she would have received in state court. This Part will discuss why Garcia pursued a copyright claim by addressing what type of relief Garcia might want, what types of potential legal methods were available to her, and how said legal methods act within the framework of copyright law.

#### *A. What Relief Does Garcia Want?*

As was made clear by her request for a temporary restraining order, Garcia wanted the film removed from YouTube.<sup>92</sup> Yet, by bringing a lawsuit against Youssef alone, there are different types of relief Garcia could seek and these goals would affect how she shapes her lawsuit.

First and foremost, Garcia wanted the video taken off the Internet and completely prevented from being re-uploaded. Google argued that it would be impossible to comply with the order.<sup>93</sup> The Ninth Circuit took some steps to prevent rush downloading of the film by prohibiting publication of the injunction.<sup>94</sup> However, Google also noted in its brief that the film is available on other video hosting websites and "those who wish to proliferate the film have ample copies to work from."<sup>95</sup> Even the district court felt that

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<sup>90</sup> Complaint, *supra* note 88. Garcia voluntarily withdrew her lawsuit in California state court after a judge found she had not shown a likelihood of success on the merits.

<sup>91</sup> See, e.g., Moore, *supra* note 64 (stating that judges sometimes "rule with their hearts").

<sup>92</sup> See *Garcia I*, 766 F.3d 929 (9th Cir. 2014), *rev'd en banc*, 786 F.3d 733 (9th Cir. 2015).

<sup>93</sup> Brief of Defendants-Appellees, *supra* note 60, at 12.

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

Garcia waited too long before bringing suit to prevent harm.<sup>96</sup> That being said, the amount of influence YouTube has, as one of the largest websites, cannot be ignored.<sup>97</sup> Therefore, only removing it from that platform would still have a great effect.

Reaching a defendant like Youssef might prove to be more difficult. Youssef goes by multiple aliases and constantly changes his name.<sup>98</sup> At the time the lawsuit began, he was in prison for violating parole on a prior conviction for bank fraud.<sup>99</sup> Youssef had already allegedly spent \$80,000 on *Innocence of Muslims*, which he received from ex-family members and donations.<sup>100</sup> A plaintiff should consider a cost-benefit analysis before going through the expense and trials of a lawsuit, with regards to what the potential rewards might be with respects to a potential defendant.

Another incentive to bringing a lawsuit is the possibility of repairing Garcia's reputation. By coming forward and bringing the lawsuit, Garcia can publicly denounce and distance herself from the film and its violence towards Islam. She was one of the few actors in the film to come out publicly against the film; other actors went into hiding.<sup>101</sup> These lawsuits could be more about declaring her innocence than fighting copyright infringement.<sup>102</sup> Judge Kozinski, in his opinion, discussed the importance of Garcia disassociating herself from the film's message.<sup>103</sup>

In discussing the type of relief Garcia might want, it is also worth noting the type of injunction that was originally issued. The court directed Google to "take down all copies of *Innocence of Muslims* from YouTube and any other platforms within its control and to take all reasonable steps to prevent further uploads."<sup>104</sup> As a result, Google will have to patrol its sites to ensure that the film

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<sup>96</sup> *Garcia I*, 766 F.3d at 947 (Smith, J. dissenting).

<sup>97</sup> *See id.* at 938-39 (majority opinion) (arguing that YouTube is so prominent that removing it from the platform will curb the harm).

<sup>98</sup> *See* Kovaleski & Barnes, *supra* note 6.

<sup>99</sup> *See id.*

<sup>100</sup> *See id.*

<sup>101</sup> *See* Gross, *supra* note 4.

<sup>102</sup> *See id.*

<sup>103</sup> *Garcia I*, 766 F.3d 929, 939 (9th Cir. 2014), *rev'd en banc*, 786 F.3d 733 (9th Cir. 2015).

<sup>104</sup> *See id.* at 940.



would not be uploaded in the future. It is unlikely that Garcia would receive as broad a mandatory injunction against Youssef as she received against Google. Google has the resources to comply with that injunction and Youssef does not. If Garcia were to convince a court to transfer the film's copyright interest to her as a remedy, she would still have to submit DMCA takedown notices.<sup>105</sup> Where, as here, it appears that the burden is on Google to keep the film off its platforms.

It is also worth addressing here the relationship between a broad injunction order, like the one in *Garcia I*, and the role of the safe harbor provisions of the DMCA, discussed below.<sup>106</sup> Some might argue that the purpose of the DMCA takedown notice construct was to put the takedown requests in the hands of those whose copyrights are being infringed.<sup>107</sup> Thus, Judge Kozinski's order might conflict with the DMCA.<sup>108</sup>

### *B. Digital Millennium Copyright Act and Takedown Notices*

The DMCA, enacted in 1998, created safe harbors to protect Internet service providers ("ISP") or online service providers from the liability of infringing content.<sup>109</sup> Under the DMCA, an ISP is defined as a "provider of online services or network access, or the operator of facilities therefor."<sup>110</sup> The DMCA was created to "provide certainty for copyright owners and Internet service providers with respect to copyright infringement liability online."<sup>111</sup>

The notice and takedown provision in the DMCA creates a safe harbor for ISPs. In order to be exempt from liability, an ISP is required to respond "expeditiously" "to notices of copyright infringement by removing hosted content, or links to content, when

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<sup>105</sup> See *infra* Part II.B. for a discussion on DMCA takedown notices.

<sup>106</sup> See *infra* notes 109–17.

<sup>107</sup> See Parloff, *supra* note 67.

<sup>108</sup> See *id.*

<sup>109</sup> See 17 U.S.C. § 512 (2010); Edward Lee, *Decoding the DMCA Safe Harbors*, 32 COLUM. J.L. & ARTS 233 (2009). It also criminalized technology created to circumvent measures that control access to digital content (digital rights management).

<sup>110</sup> 17 U.S.C. § 512(k)(B).

<sup>111</sup> See Lee, *supra* note 109, at 243.

they receive a notice alleging copyright infringement.”<sup>112</sup> Additionally, there is a condition that the ISP must not have actual or constructive knowledge of the infringement before receiving the notice.<sup>113</sup> Therefore, companies, like Google, must adhere to guidelines and create policies that quickly block access to or remove infringing material once they receive notice from a copyright holder.<sup>114</sup>

Submitting a takedown notice is a useful method for a victim of copyright infringement to protect her copyrights without having to seek legal advice, especially if she has not registered the copyright with the Copyright Office before the infringement occurred. A DMCA takedown request does not require the content to be copyrighted in order to process the takedown.<sup>115</sup>

However, the process is not without its complications. Simply put, once a copyright owner has found infringing material, she submits a takedown notice to the ISP identifying the infringing work.<sup>116</sup> If the alleged infringer feels that he was using the work legally or that the removal was a mistake, the infringer can submit a counter notice to the ISP and the ISP will repost the work.<sup>117</sup> At that point, the copyright owner’s only recourse is to file a lawsuit asking the court for an injunction.<sup>118</sup>

### C. *Garcia Should Have Pursued a Tort Claim in State Court*

If Garcia decided not to bring a copyright infringement claim against Youssef and Google in federal court, she could have attempted to bring a lawsuit against Youssef in state court for tort

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<sup>112</sup> Jennifer M. Urban & Laura Quilter, *Efficient Process or “Chilling Effects?” Takedown Notices Under Section 512 of the Digital Millennium Copyright Act*, 22 SANTA CLARA COMPUTER & HIGH TECH. L.J. 621, 624 (2006); *see also* 17 U.S.C. § 512(c)(1).

<sup>113</sup> § 512(c)(1).

<sup>114</sup> *See* Lee, *supra* note 109, at 233.

<sup>115</sup> *What is a DMCA Takedown?*, DMCA.COM, <http://www.dmca.com/FAQ/What-is-a-DMCA-Takedown> [<http://perma.cc/ACT7-E96K>] (last visited Nov. 12, 2015).

<sup>116</sup> *See* Carolyn E. Wright, *Two Easy Steps for Using the DMCA Takedown Notice to Battle Copyright Infringement*, NAT’L PRESS PHOTOGRAPHERS ASS’N, <https://nppa.org/page/5617> [<http://perma.cc/F262-TKWK>] (last visited Nov. 12, 2015).

<sup>117</sup> *See id.*

<sup>118</sup> *See id.*

claims. Those claims would most likely be fraud, right of publicity, invasion of privacy, or intentional infliction of emotional distress.

Generally, the standard for granting a preliminary injunction is “the likelihood the moving party ultimately will prevail on the merits, and the relative interim harm to the parties from the issuance or nonissuance of the injunction.”<sup>119</sup> Garcia’s best hope would be to have the court grant a preliminary injunction, forcing Youssef to both remove the videos he uploaded and prohibiting him from distributing the film in the future. If Garcia prevailed in a tort lawsuit, the court might also be able to grant Garcia the copyright interest in the work, which ultimately would give her the opportunity (or the burden) to submit DMCA takedown requests where she saw fit.

#### *D. Issues Created from Suing Youssef Alone*

If Garcia were able to receive a court injunction against Youssef alone for a tort claim, such as emotional distress, in state court, she would be unable to apply the injunction directly against Google or any content-hosting website. This is significant because it would be most efficient to go straight to the website that hosts the video in order to get it removed. Or, alternatively, the person against whom the injunction is sought might violate the court’s orders. However, for the following reasons, it is important to note that simply because Youssef receives an order by the court requiring him to take down the video, does not mean Google or any other content-hosting website has to comply with that order.

##### 1. Google Not Liable Under Section 230

Google, as an online host, is not liable for the third-party content provided by the creator or speaker; here, defendant Youssef.<sup>120</sup> The Communications Decency Act, 47 U.S.C § 230, states that “[n]o provider or user of an interactive computer service shall be

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<sup>119</sup> See *Hunt v. Superior Court*, 987 P.2d 705, 716 (Cal. 1999).

<sup>120</sup> See generally Brief for Public Citizen as Amicus Curiae Supporting Neither Party, *Garcia I*, 766 F.3d 929 (9th Cir. 2014) (No. 12-57302); see also Brief for Floor64, Inc. and Organization for Transformative Works as Amici Curiae Supporting Defendants-Appellees, *Garcia I*, 766 F.3d 929 (No. 12-57302). While the court did not directly address section 230, many of the amicus briefs felt that its ruling may greatly affect the statute.

treated as the publisher or speaker of any information provided by another information content provider.”<sup>121</sup> Therefore, the provider of an “interactive computer service” that publishes information, but is not the provider of the information content, cannot be held liable for the resulting tort.<sup>122</sup> Congress’ goal in enacting section 230 was to “promote the free exchange of information and ideas over the Internet” and to encourage online hosts to police themselves.<sup>123</sup> The Act’s purpose was to protect online Internet publishers and social networks from those limiting free expression. Here, Youssef willingly provided the content (the film) and, therefore, Google should receive full immunity.<sup>124</sup>

However, section 230 does not provide immunity to ISPs from “laws pertaining to intellectual property.”<sup>125</sup> Therefore, while Google would have immunity against not removing defamatory or fraudulent claims, for example, it only has this protection against non-intellectual property claims.<sup>126</sup> This is seemingly an important reason Garcia chose to pursue a copyright lawsuit in federal court in order to bring Google into the lawsuit.<sup>127</sup> Presumably, if Garcia had attempted to bring a non-intellectual property claim against Google, it would have been blocked by section 230.<sup>128</sup>

## 2. Enforcing an Injunction Against a Third-Party

*Blockowicz v. Williams* demonstrated that an Internet publisher website cannot be compelled to remove material by an injunction that was issued in a proceeding where the publisher was not a party.<sup>129</sup> The Blockowicz had secured an injunction against defendants requiring them to remove defamatory statements from sever-

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<sup>121</sup> 47 U.S.C. § 230(c)(1) (2010).

<sup>122</sup> See Ken S. Meyers, *Wikimmunity: Fitting the Communications Decency Act to Wikipedia*, 20 HARV. J.L. & TECH. 163, 178 (2006).

<sup>123</sup> See *Carafano v. Metrosplash.com*, 339 F.3d 1119, 1122 (9th Cir. 2003).

<sup>124</sup> See *id.* at 1124.

<sup>125</sup> 47 U.S.C. § 230(e)(2).

<sup>126</sup> *Id.*

<sup>127</sup> See *Perfect 10, Inc. v. CCBill LLC*, 488 F.3d 1102, 1119 (9th Cir. 2007).

<sup>128</sup> See Brief for Internet Law Professors as Amici Curiae Supporting Defendants-Appellees, *supra* note 76. *Perfect 10* also states that section 230’s reference to “intellectual property” only means “federal intellectual property.” *Perfect 10*, 488 F.3d at 1119.

<sup>129</sup> See *Blockowicz v. Williams*, 630 F.3d 563, 564 (7th Cir. 2010).

al websites, but defendants never responded.<sup>130</sup> Every website removed the statements except for [www.ripoffreport.com](http://www.ripoffreport.com) operated by Xcentric.<sup>131</sup> The plaintiffs asked the court to compel Xcentric to remove the statements by enforcing the injunction against Xcentric through Federal Rule of Civil Procedure 65(d)(2)(C).<sup>132</sup> The Blockowicz could not sue Xcentric directly because of section 230 immunity. Rule 65(d)(2)(C) allows courts to enforce injunctions against “third parties who have ‘actual notice’ of the injunction, and ‘who are in active concert or participation’ with the parties bound by the injunction.”<sup>133</sup> The court held that Xcentric does not fit within Rule 65(d)(2)(c) because actions that aid and abet must occur after the injunction is imposed so nonparties have “actual notice” of the injunction.<sup>134</sup> The court also noted in its opinion that the Blockowicz’s only relief may be a contempt charge against the original defendants for not complying with the injunction, and that it would not be possible to enforce an injunction against Xcentric in this way.<sup>135</sup> *Garcia I* and *Garcia II* are similar to *Blockowicz*, in that Garcia, if she received an injunction solely against Youssef, would be unable to enforce the injunction against Google.

*E. Websites Voluntarily Removing Content and Complying With Injunctions*

Most online Internet publishers are generally willing to remove infringing content when a court orders an injunction against the content creator on its own accord.<sup>136</sup> If the court had ruled that Youssef needed to take the film down, it is likely that Google may have assisted Garcia if she had run into any serious problems despite no legal authority requiring them to do so.<sup>137</sup> Google has a webpage where it assists users with submitting legal removal requests, injunctions, and other documents because of content that

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<sup>130</sup> See *id.* at 565.

<sup>131</sup> See *id.*

<sup>132</sup> See *id.* at 567.

<sup>133</sup> *Id.* at 567.

<sup>134</sup> See *id.* at 568.

<sup>135</sup> See *id.* at 569–70.

<sup>136</sup> See generally *Blockowicz*, 630 F.3d 563 (noting where all other websites removed content when the defendants did not comply with the injunction).

<sup>137</sup> See Brief for Public Citizen as Amicus Curiae Supporting Neither Party, *supra* note 120.

either violates their terms of service or the law.<sup>138</sup> Google's decision to block access to the video in Egypt and Libya (without completely removing it from their website) could be viewed positively in that Google was willing to stop the screening of offensive material by minimizing viewership of the video.<sup>139</sup>

On the other hand, Google's decision to take down the material, unless it comes directly from a court order is purely discretionary. *Innocence of Muslims* was removed only in response to violence and the company said its decision was unusual and "made because of the exceptional circumstances."<sup>140</sup> Notably, Google had determined the video "was not hate speech."<sup>141</sup> Ultimately, Google wants to do what is best in order to protect free speech, while simultaneously acting in the best interest of the company. In response to the protests over the video, Eric Schmidt, Google's chairman, said: "Google has a fairly clear view of this, which is that we believe that the answer to bad speech is more speech."<sup>142</sup> Where Google is defining what hate speech is (speech against individuals, not against groups)<sup>143</sup> and protecting itself and its users from censorship, there will be situations where content that should be removed, will not be because of section 230. No plaintiff can safely rely on an Internet publisher to remove all content voluntarily.

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<sup>138</sup> *Legal Removal Requests*, GOOGLE, <https://support.google.com/legal/answer/3110420?hl=en> [<http://perma.cc/JDE5-3MM2>] (last visited Nov. 12, 2015).

<sup>139</sup> See Brief for Public Citizen as Amicus Curiae Supporting Neither Party, *supra* note 120; see also 47 U.S.C. § 230(c) (2010); Claire Cain Miller, *As Violence Spreads in Arab World, Google Blocks Inflammatory Video in Egypt and Libya*, N.Y. TIMES (Sept. 13, 2012), <http://www.nytimes.com/2012/09/14/technology/google-blocks-inflammatory-video-in-egypt-and-libya.html> [<http://perma.cc/774G-V449>].

<sup>140</sup> Miller, *supra* note 139.

<sup>141</sup> *Id.*

<sup>142</sup> See *Google's Eric Schmidt Defends YouTube for Hosting Anti-Islam Film*, DAILY MOTION (Sept. 27, 2012), [http://www.dailymotion.com/video/xtx4he\\_google-s-eric-schmidt-defends-youtube-for-hosting-anti-islam-film\\_news](http://www.dailymotion.com/video/xtx4he_google-s-eric-schmidt-defends-youtube-for-hosting-anti-islam-film_news) [<http://perma.cc/5UEV-AUX7>] [hereinafter *Eric Schmidt Defends YouTube*].

<sup>143</sup> Miller, *supra* note 139.

### III. BEYOND *GARCIA I* AND *GARCIA II*: THE CURRENT LANDSCAPE

The goal of copyright is to give authors an incentive to create<sup>144</sup> by rewarding certain authors for their creations with exclusive enforceable rights. As in *Garcia I*, copyright is increasingly being used for the purpose of removing content from the Internet, when the plaintiff disagrees with or has been damaged by the content. Lawsuits that should be centered on claims of contract disputes transform into copyright lawsuits. In *Garcia I*, the plaintiff was not motivated by the incentive to create; rather her lawsuit was based on “ex-post incentives to claim copyright.”<sup>145</sup> Essentially, plaintiffs, like Garcia, are using federal copyright law as a workaround to avoid section 230 blocking state tort law claims.

In *Garcia II*, the Ninth Circuit used the example of *Bollea v. Gawker Media*<sup>146</sup> to demonstrate how plaintiffs pursue copyright claims to suppress derogatory material and not with the actual intent of protecting their intellectual property rights.<sup>147</sup> In *Bollea*, the wrestler Hulk Hogan sought an order requiring defendants to remove a sex tape from its website, claiming copyright infringement. The court held that the plaintiff “produced no evidence demonstrating that he will suffer irreparable harm in the copyright sense absent a preliminary injunction.”<sup>148</sup> Discussed below are several other examples that push the parameters of copyright.

#### A. Using Copyright to Remove Content: Revenge Porn

In August of 2014, hackers leaked hundreds of nude photographs of celebrities onto the Internet.<sup>149</sup> The source of these pho-

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<sup>144</sup> Eldred v. Ashcroft, 537 U.S. 186, 219 (2003).

<sup>145</sup> See Clark D. Asay, *Ex Post Incentives and IP in Garcia v. Google and Beyond*, 67 STAN. L. REV. ONLINE 37, 41 (2014) (comparing ex-ante and ex-post incentives to create intellectual property and applying them to patent trolls).

<sup>146</sup> *Bollea v. Gawker Media, LLC*, 913 F. Supp. 2d 1325 (M.D. Fla. 2012).

<sup>147</sup> See *Garcia II*, 786 F.3d 733, 745 (9th Cir. 2015) (en banc); *Bollea*, 913 F. Supp. 2d at 1327.

<sup>148</sup> See *Garcia II*, 786 F.3d at 745 (quoting *Bollea*, 913 F. Supp. 2d at 1329).

<sup>149</sup> See Dan Kedmey, *Hackers Leak Explicit Photos of More Than 100 Celebrities*, TIME (Sept. 1, 2014), <http://time.com/3246562/hackers-jennifer-lawrence-cloud-data/> [http://perma.cc/RU2V-YBER] (noting that Jennifer Lawrence was one of the affected celebrities).

tos was believed to be a breach in Apple's iCloud system, a service where users can store data remotely. The photos were initially uploaded to social networking websites and forum boards, such as 4Chan and Reddit, and quickly spread across the Internet. If celebrities took the photos themselves, they could, as copyright holders of the photos, file DMCA takedown notices to possibly get the photos removed from the website. In the event that the attempt to have the photos removed through takedown notices is ignored, the celebrity could then bring a lawsuit in order to have the photographs taken down.

While this strategy may be helpful in getting nude photographs and pornography removed from less reputable websites,<sup>150</sup> there are several challenges celebrities may run up against while attempting to employ this legal strategy. For instance, celebrities may have to prove that they are the copyright holder of the picture, such as that he or she took the photo. Search engines like Google generally only remove URLs from the search engines when they receive a valid notice of copyright infringement.<sup>151</sup> Also, once a celebrity does file a DMCA takedown notice and succeeds in removing the infringing photo from one website, another photo could still emerge on the same or another website.<sup>152</sup> "Fighting this fire through DMCA is akin to playing digital whack-a-mole."<sup>153</sup>

Similarly, celebrities are not alone in experiencing the same frustration at being unable to find a legal method to have the nude photos or sexually explicit material removed from the Internet.

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<sup>150</sup> Kadeen Griffiths, *Jennifer Lawrence's Nude Pic Lawsuit Allegedly Hits a Copyright Snag That Will Horrify You*, BUSTLE (Sept. 3, 2014), <http://www.bustle.com/articles/38344-jennifer-lawrences-nude-pic-lawsuit-allegedly-hits-a-copyright-snag-that-will-horrify-you> [<http://perma.cc/A3A2-CR7M>] (alleging that a pornography website refuses to remove nude photographs of Lawrence because she did not take the photos and isn't the copyright holder).

<sup>151</sup> See Eric Gardner, *Google Responds to Jennifer Lawrence Attorney's \$100 Million Lawsuit Threat*, HOLLYWOOD REP. (Oct. 2, 2014), <http://www.hollywoodreporter.com/thr-esq/google-responds-jennifer-lawrence-attorneys-737656> [<http://perma.cc/FXD4-V4TL>] (arguing that Google may take a higher scrutiny for copyright infringement claims).

<sup>152</sup> Alex Fitzpatrick, *Here's How Celebrities Can Get Their Nude Selfies Taken Down*, TIME (Sept. 2, 2014), <http://time.com/3256732/jennifer-lawrence-selfies-copyright/> [<http://perma.cc/W4SV-REAJ>].

<sup>153</sup> *Id.*



“Nonconsensual pornography,” also known as “revenge porn,” is the “distribution of sexually graphic images of individuals without their consent.”<sup>154</sup> Typically the images are created during an intimate relationship, and then are later uploaded by ex-partners.<sup>155</sup> The victims may have more difficulty in asserting that the copyright in their photo or “selfie” was violated, due to the fact that non-celebrities do not have the same resources as celebrities to pursue a lawsuit and the types of websites that host revenge porn tend to ignore victims’ requests.<sup>156</sup> However, many believe that DMCA takedown notices are a good tool for victims to force websites that specialize in hosting revenge porn to accept liability.<sup>157</sup>

Some legal scholars have gone even further and suggested that victims of revenge porn should be joint “authors of their own performances.”<sup>158</sup> By making victims of revenge porn joint authors of their own performance, victims would be given a copyright interest in the photo and would avoid the problem of proving that they are, in fact, the copyright holder. However, this change would greatly change the meaning of “joint author” in copyright law, or otherwise make revenge porn its own exception to section 230.<sup>159</sup>

As of 2015, twenty-four states have passed some form of revenge porn legislation criminalizing revenge porn<sup>160</sup> and establish-

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<sup>154</sup> Danielle Keats Citron & Mary Anne Franks, *Criminalizing Revenge Porn*, 49 WAKE FOREST L. REV. 345, 346 (2014).

<sup>155</sup> *See id.*

<sup>156</sup> *See id.* at 360.

<sup>157</sup> *See* Amanda Levenowski, *Our Best Weapon Against Revenge Porn: Copyright Law?*, ATLANTIC (Feb. 4, 2014), <http://www.theatlantic.com/technology/archive/2014/02/our-best-weapon-against-revenge-porn-copyright-law/283564/> [<http://perma.cc/KL3B-FA3P>].

<sup>158</sup> *See* Derek Bambauer, *Exposed*, 98 MINN. L. REV. 2025 (2014); *see also* Rebecca Tushnet, *Performance Anxiety: Copyright Embodied and Disembodied*, 60 J. COPYRIGHT SOC’Y U.S.A. 209, 237 (2013) (quoting Derek Bambauer, *Beating Revenge Porn with Copyright*, INFO/LAW (Jan. 25, 2013), <http://blogs.law.harvard.edu/infolaw/2013/01/25/ beating-revenge-porn-with-copyright/> [<http://perma.cc/93H7-EDFV>]).

<sup>159</sup> *See* Rebecca Tushnet, *How Many Wrongs Make a Copyright?*, 98 MINN. L. REV. 2346 (2014).

<sup>160</sup> *See* Steven Nelson, *Congress Set to Examine Revenge Porn*, U.S. NEWS & WORLD REP. (July 30, 2015, 11:32 AM), <http://www.usnews.com/news/articles/2015/07/30/congress-set-to-examine-revenge-porn> [<http://perma.cc/34HQ-V4ZT>].

ing penalties of jail time, fines, and restitution.<sup>161</sup> Activists, such as Professor Mary Anne Franks, are helping to draft a federal criminal revenge porn law, which would specifically act as a workaround of section 230, because section 230 does not “trump federal criminal law.”<sup>162</sup> Furthermore, once federal revenge porn law has been enacted, websites, like Google, would become liable.<sup>163</sup> Still there are those who believe these laws may be overbroad and that the availability of tort law against the initial poster and copyright law against the website is a sufficient means of redress for victims.<sup>164</sup>

Regardless, nonconsensual pornography has shown that copyright law has been useful to take down speech that should not be on the Internet. Obviously, nonconsensual pornography is an awful and emotionally damaging problem that needs to be solved. It has to be asked, however, whether copyright is the best means to aid victims, both celebrities and non-celebrities, or whether they should have another medium through which they can seek legal remedy. An alternative solution would be for more states to criminalize revenge porn or for section 230 to be adapted to allow greater flexibility for laws, such as privacy or intentional infliction of emotional distress.

*B. Using Copyright to Remove Content: Suppression of “Negative” Information*

Often individuals want certain data removed from the Internet that they feel violates their privacy, is untrue or wrong, or is defamatory. The data might be information that hurts the individual from attaining employment, private images that he or she did not want shared,<sup>165</sup> or past criminal convictions. Regularly, businesses

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<sup>161</sup> *Infographic: The Anatomy of an Effective Revenge Porn Law*, END REVENGE PORN (Jan. 23, 2015), <http://www.endrevengeporn.org/anatomy-effective-revenge-porn-law/> [<http://perma.cc/982Q-C3S3>].

<sup>162</sup> See Steven Nelson, *New Federal Legislation Could Take a Nip Out of ‘Revenge Porn,’* U.S. NEWS & WORLD REP. (Nov. 21, 2013), <http://www.usnews.com/news/articles/2013/11/21/new-federal-legislation-could-take-a-nip-out-of-revenge-porn> [<http://perma.cc/6PTU-3RPQ>].

<sup>163</sup> See *id.*

<sup>164</sup> See *id.*; see also Sarah Jeong, *Revenge Porn is Bad, Criminalizing It Is Worse*, WIRED (Oct. 28, 2013), <http://www.wired.com/2013/10/why-criminalizing-revenge-porn-is-a-bad-idea/> [<http://perma.cc/YPX5-8PN7>].

<sup>165</sup> See *supra* text accompanying notes 149–57.

want to remove content from websites that criticize their products and services because it is hurting their reputation.<sup>166</sup> Businesses blame consumer-review websites, such as Yelp, for dips in profits and sales when they receive negative reviews. Sometimes negative reviews are bad for businesses.<sup>167</sup> Yelp attracts around 120 million visitors a month and has more than 50 million customer-generated reviews.<sup>168</sup>

Section 230 protects certain consumer review websites, like Yelp, from defamatory and untrue statements made by users.<sup>169</sup> Therefore, these businesses may be forced to go after the individuals themselves, many of whom are anonymous, in order to remove defamatory posts. Yelp receives six subpoenas monthly, some of which require the website to turn over the true identities of anonymous reviewers.<sup>170</sup> When a lawsuit is filed, the business rarely wins the lawsuits against a consumer over a defamatory review.<sup>171</sup>

Businesses have used copyright law against a website to bring down a negative post. Sometimes they claim that the poster has misappropriated their intellectual property (something from their website, press release, or photo) into their post and they want the post taken down. While this might work against a large company processing thousands of DMCA copyright requests,<sup>172</sup> it will likely not work in front of a federal judge who understands a fair use de-

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<sup>166</sup> Angus Loten, *Yelp Reviews Brew a Fight Over Free Speech vs. Fairness*, WALL ST. J. (Apr. 2, 2014, 7:31 PM), <http://www.wsj.com/articles/SB10001424052702303847804579477633444768964> [<http://perma.cc/S4VE-8Z9G>].

<sup>167</sup> See Rebecca Jarvis, *The Power of Yelp: Small Businesses Feel Joys, Pains of Yelp Reviews*, ABC NEWS (Aug. 8, 2014, 5:55 PM), <http://abcnews.go.com/Business/power-yelp-small-businesses-feel-joys-pains-yelp/story?id=24908378> [<http://perma.cc/7TD8-E3V2>].

<sup>168</sup> See Loten, *supra* note 166.

<sup>169</sup> *Terms of Service*, YELP, <http://www.yelp.com/static?p=tos> [<http://perma.cc/6THG-4BVG>] (last visited Nov. 13, 2015). Yelp's terms of service state that it will take down posts it finds defamatory. The website will likely err on the side of the poster as long as he or she is offering a legitimate opinion. See Loten, *supra* note 166.

<sup>170</sup> See *id.*

<sup>171</sup> See *id.* ("We do see consumers who lose lawsuits over defamatory reviews, but rarely." (quoting Eric Goldman, professor at Santa Clara University School of Law)).

<sup>172</sup> For example, Google's copyright transparency report shows that it received 35,178,654 requests for URLs to be removed in one month. See *Transparency Report*, GOOGLE, <https://www.google.com/transparencyreport/removals/copyright/> [<http://perma.cc/F2KH-S8Z4>] (last visited Nov. 13, 2015).

fense.<sup>173</sup> For example, in order to work around section 230, one business attempted to have consumers sign over their intellectual property rights in their potential future consumer reviews. Medical Justice provided doctors and dentists, like Dr. Ken Cirka, with a “mutual privacy agreement.”<sup>174</sup> The form had “patients waive their rights to post online reviews of the doctor”<sup>175</sup> in exchange for greater privacy protection from the doctors. Dr. Cirka was unable to remove a negative post directly from Yelp despite the agreement<sup>176</sup> and his assertions that he owned a copyright interest in the post. Medical Justice, as well, hasn’t been successful with its “ex ante customer gag order.”<sup>177</sup>

Businesses are attempting to suppress information as consumer reviewing websites like Yelp become more popular. Forcing a consumer or a patient to sign over her intellectual property right is unethical because it chills speech and a consumer or patient may feel it is the only way for her to receive exceptional service or care. However, similar to the above mentioned revenge porn victims, it may be a useful tool for an individual who needs a defamatory review removed from a website and has run out of legal options.

### C. *Potential Solutions*

Some might say that creating a copyright infringement claim instead of using state tort law is an abuse of copyright law and an extreme method for silencing free speech that violates First Amendment rights. Others might argue that copyright law is a useful tool for victims who can find no other legal alternative. Regardless, plaintiffs, like Garcia, should still have the means to bring the appropriate lawsuit and pursue remedies. Alternative legal methods exist that may provide these individuals relief if pursued.

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<sup>173</sup> 17 U.S.C. § 107 (2010).

<sup>174</sup> Timothy B. Lee, *Criticism and Takedown: How Review Sites Can Defend Free Speech*, ARS TECHNICA (June 1, 2011, 9:04 AM), <http://arstechnica.com/tech-policy/2011/06/criticism-and-takedown-how-review-sites-can-defend-free-speech/> [<http://perma.cc/79KX-K2PT>].

<sup>175</sup> Eric Goldman, *The Regulation of Reputational Information*, in *THE NEXT DIGITAL DECADE: ESSAYS ON THE FUTURE OF THE INTERNET* 293, 302 (Berin Szoka & Adam Markus eds., 2010).

<sup>176</sup> See Lee, *supra* note 174.

<sup>177</sup> See Goldman, *supra* note 175.

However, the benefits of implementing a new statute or industry standard must be weighed against the harms.

First, states individually could create their own criminal laws, targeting the individuals responsible for the individual harm. For example, states are increasingly introducing bills to make posting revenge porn a felony.<sup>178</sup> This would take the burden away from the Internet publisher and could more effectively deter culprits.<sup>179</sup>

Additionally, Internet publishers and ISPs could be forced to listen more closely to the demands of their users as to what they are and are not allowed to publish. For example, the European Union developed the “right to be forgotten” which, in theory, allows an individual to remove data in order to control one’s image or one’s privacy.<sup>180</sup> Internet publishers could delete unflattering photos or newspaper articles containing information of old criminal arrests in response to requests.<sup>181</sup> This puts the burden on websites to correctly approve and remove requests, but also has the potential to chill speech.<sup>182</sup> Conversely, we could also encourage more speech, in order to drown out the offending speech.<sup>183</sup>

Intellectual property rights law, itself, could be stretched to include these extremely rare, special cases and violations. In *Garcia I*, there existed a tension between the Copyright Office asserting that an actor cannot be an author in her performance and the majority court arguing the opposite.<sup>184</sup> If we allow for this wiggle room, then actors and victims, like Garcia, would not be taken advantage off.

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<sup>178</sup> See *supra* text accompanying notes 160–64.

<sup>179</sup> See Tracy Clark-Flory, *Criminalizing “Revenge Porn,”* SALON (Apr. 6, 2013, 9:00 PM), [http://www.salon.com/2013/04/07/criminalizing\\_revenge\\_porn/](http://www.salon.com/2013/04/07/criminalizing_revenge_porn/) [<http://perma.cc/SG9Y-2TFQ>]; see also *supra* text accompanying notes 160–64.

<sup>180</sup> Danny Hakim, *Right to Be Forgotten? Not That Easy*, N.Y. TIMES (May 29, 2014), <http://www.nytimes.com/2014/05/30/business/international/on-the-internet-the-right-to-forget-vs-the-right-to-know.html> [<http://perma.cc/LH95-N4AM>]. The “right to be forgotten” is the concept of an individual’s right to have data deleted from search engines that infringes on their privacy. *Id.*

<sup>181</sup> See Steven C. Bennett, *The “Right To Be Forgotten”: Reconciling EU and US Perspectives*, 30 BERKELEY J. INT’L L. 161, 167 (2012).

<sup>182</sup> See *id.* at 172.

<sup>183</sup> See, e.g., *Eric Schmidt Defends YouTube*, *supra* note 142 (arguing that the answer to “bad speech is more speech”).

<sup>184</sup> See *Garcia I*, 766 F.3d 929 (9th Cir. 2014), *rev’d en banc*, 786 F.3d 733 (9th Cir. 2015).

Even Judge Kozinski found that this would rarely occur,<sup>185</sup> so this type of legal argument would not be able to be used very often. On the other hand, the court has to consider the can of worms it might open by tweaking definitions within copyright law and the types of new claims others may bring. It might be difficult to draw a line in order to find what types of plaintiffs can find relief in copyright law.

During the oral arguments, Judge Kozinski introduced the idea that the Beijing Treaty on Audiovisual Performances<sup>186</sup> could be a solution. “The treaty endows performers with exclusive rights over when and how their recorded performances can be copied, distributed or otherwise made available to the public,” as well as providing moral rights.<sup>187</sup> While it may give Garcia a copyright in her performance, however, the treaty has yet to be ratified or become effective.<sup>188</sup>

Lastly, another option is that plaintiffs could be granted stronger arguments or claims when bringing lawsuits enforcing other rights. For example, victims could be allowed to have a stronger claim when they bring lawsuits claiming that they have suffered an invasion of privacy.<sup>189</sup>

## CONCLUSION

With the growing expansion of the Internet, individuals are more often finding themselves unable to control their presence online. As demonstrated by the dissemination of non-consenting, explicit photographs of women being posted online, which became newsworthy in 2014 when celebrities were affected. Similarly, businesses have been attempting to control their reputations from

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<sup>185</sup> See *id.* at 933–36.

<sup>186</sup> See Beijing Treaty on Audiovisual Performances, June 24, 2012, WIPO Doc. AVP/DC/20; see also Margot Kaminski, *The Shadow of a Treaty in Garcia v. Google*, NOTICE & COMMENT BLOG (Feb. 5, 2015), <http://www.yalejreg.com/blog/the-shadow-of-a-treaty-in-garcia-v-google-by-margot-kaminski> [<http://perma.cc/2ZLR-QHY7>].

<sup>187</sup> Steven Seidenberg, *US Perspectives: “Innocence of Muslims” Creates Copyright Controversy in US*, IP-WATCH (Mar. 31, 2014, 8:36 PM), <http://www.ip-watch.org/2014/03/31/innocence-of-muslims-creates-copyright-controversy-in-us/> [<http://perma.cc/GY6R-R3NL>].

<sup>188</sup> See Kaminski, *supra* note 186.

<sup>189</sup> See Tushnet, *supra* note 158.

being affected by negative often anonymous, and potentially untrue, online reviews. Likewise, in *Garcia I*, actors were deceived into playing roles in an anti-Islamic film.<sup>190</sup> There are other examples, but these are a few prominent illustrations.

In the absence of a law that directly provides plaintiffs or victims the relief they desire, such as the removal of the content from the Internet, individuals have increasingly turned to copyright law. Section 230 of the Communications Decency Act protects Internet publishers, such as Google, from the kinds of claims individuals could be bringing (defamation, privacy, fraud, right of publicity, etc.). However, individuals can still bring lawsuits alleging that their intellectual property rights were violated. It is the protection for Internet publishers that section 230 provides that directs the individuals to this legal strategy.

Garcia should have pursued other legal methods in her lawsuit against Youssef, the film's producer, and should not have initiated a copyright lawsuit against Google. The order to take down the film was broad. Garcia naturally would not get the exact same results against an individual as against a behemoth company like Google. Her lawsuit was understandable given the legal strategies that are available to her and similarly situated plaintiffs at the time. However, her harm was one that would be better suited to a resolution by privacy law, not copyright law.

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<sup>190</sup> See Brief for Internet Law Professors as Amici Curiae Supporting Defendants-Appellees, *supra* note 76, at 9 (“[T]his lawsuit initially sought to vindicate harms putatively protected by defamation and privacy law, but it converted into a copyright battle only because Congress’ broad grant of immunity in section 230 requires courts to reject all non-IP claims . . .”).