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TESLAW

THE STATE BAR OF TEXAS ENTERTAINMENT & SPORTS LAW SECTION

May 15, 2014

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Dear Members,

Need ethics credit? You are in luck! Chair-Elect Craig Crafton has put together three fantastic ethics presentations on from 1-5 p.m. June 26 in conjunction with the State Bar of Texas Annual Meeting, June 26-27 at the Austin Convention Center in Austin, Texas. I recommend attending, as these presentations will include some familiar and famous faces! For more information or to register for the Annual Meeting, visit [State Bar of Texas Annual Meeting](#).

I hope you enjoy the May e-newsletter - and the bonus case note by Adam Litwin. I'm so appreciative of the hard work put in by the editors and contributors to this newsletter.

Very truly yours,
Catherine Hough, Chair
[Entertainment and Sports Law Section](#)

TESLAW Member Spotlight



Stephen Summer is an entertainment lawyer, educator, and drummer based in Austin, Texas. Before becoming an attorney, Mr. Summer toured extensively with jazz saxophonist Kirk Whalum, performed

with Andy Williams, and had the privilege of opening concerts for such renowned artists as Santana, Spiro Gyra, Chuck Mangione, and Smokey Robinson.

After spending two decades touring the U.S. and abroad as a professional drummer, Stephen decided to head back to the classroom, completing first a master's degree in music from the University of Texas and then a Juris Doctorate from South Texas College of Law.

Currently, Mr. Summer practices entertainment law, estate planning and business formation at his Westlake office. He also teaches music business courses at Texas State University and the Austin Live Music Academy (a UT adjunct program) and, of course, still plays the drums.

Stephen can be seen performing regularly with the popular Salsa band, [Beto and the Fairlanes](#), in and around Austin, Texas. For more information on Stephen, [click here](#).

To be considered for the TESLAW Member Spotlight please submit a short bio (no more than 200 words) and photograph to [Victoria Helling](#).

Could Garcia v. Google Establish a Copyright Interest in an Actor's Performance?

There may be a limit to the saying, "There's no such thing as bad publicity." Cindy Lee Garcia believed she was acting in a low-budget film entitled "Desert Warrior," which was written and produced by [Mark Basseley Youssef](#). To her surprise, her performance was dubbed over and used in an anti-Islamic film entitled "Innocence of Muslims" that was posted on YouTube and resulted in her receiving death threats. Garcia attempted to remove the film from YouTube by filing take-down notices under the Digital Millennium Copyright Act. When Google refused to respond to her notices, Garcia filed a copyright infringement action and a motion for a temporary restraining order in a U.S. District Court in California. The district court denied Garcia's motion for a temporary restraining order, in part because she failed to demonstrate that she was likely to succeed in her copyright infringement suit. Garcia appealed the decision to the Ninth Circuit.

To prove that she was likely to succeed in her copyright infringement suit, Garcia had to prove that her acting was an original work of authorship fixed in a tangible medium of expression and thus, an independent, protected interest under the Copyright Act. Once established, she must also prove that Youssef did not own any such interest due to her performance being a "work-for-hire" and did not have an implied license to use her performance. Relying upon acting manuals and treatises, the majority of the Ninth Circuit held that an actor's creativity expressed through his voice, image, body language, facial expression and reaction to other actors, when fixed, is copyrightable. The court further reasoned that without a written agreement stating that an actor's performance in a small role is a work-for-hire, an actor does not qualify as a traditional employee and thus, retains rights to his performance. The court went on to explain that although an actor grants the copyright owner of the film a broad implied license upon agreeing to act in the film, that implied license is not broad enough to include a use of an actor's performance that is radically different from anything the actor could have imagined when he was cast in the film.

Therefore, on February 26, the majority of the Ninth Circuit signed a [controversial opinion](#) holding that Garcia was likely to succeed in her copyright infringement suit. Judge Smith wrote a dissenting opinion to the contrary stating that (a) acting is a procedure or process by which an original work is performed, which the Copyright Act specifically states is not a "work;" (b) Garcia was not the author of the work because she had no creative control over the script or her performance; and (c) acting out a script is akin

to singing lyrics to a song, which precedent establishes is not “fixed.” The dissent went on to argue that even if an acting performance were capable of being protected under the Copyright Act, Garcia was an employee and her performance was a work for hire because Youssef managed all aspects of the production. On March 6, 2014, the Copyright Office essentially agreed with Judge Smith’s dissent when it issued a letter rejecting Garcia’s copyright application, explaining that the U.S. Copyright Office “views dramatic performances in motion pictures to be only part of the integrated work— the motion picture.” Since then, Google filed a petition for rehearing and [ten amicus briefs](#) have been filed in this case. The court’s decision could have a dramatic effect on filmmakers and actors and make the use of written work-for-hire agreements even more essential.

[Adam Litwin](#) is a managing member of Litwin Law Group, PLLC, a Plano-based law firm, focusing on entertainment, business and estates, with attorneys licensed in both Texas and Florida.

How Specific Does the Language in an Agreement Need to Be in Order to Use Someone’s Image in Merchandise?

Most of us have spent considerable time in an office and therefore have thoroughly enjoyed Mike Judge’s far-too-accurate depiction of the workplace in the 1999 film “Office Space.” [Todd Duffey](#), the actor who portrays “Chotchkie’s Waiter” in the film, signed a one-page Day Player Agreement with the production company, Cubicle, in connection with his performance in the film granting Cubicle “all rights throughout the universe” to his performance and the right to use the results of his performance for “commercial” purposes. Nonetheless, after Twentieth Century Fox began using his image on merchandise called “[The Office Space Box of Flair](#),” Duffy sued Twentieth Century Fox claiming industry standard requires explicit enumeration of the right to sell merchandise and since that right was not explicitly enumerated in his contract the use of his photograph on the merchandise constitutes false endorsement under the Lanham Act and, in the alternative, that defendants have breached the SAG Agreement. He sought money damages, a permanent injunction, destruction of any such merchandise, and a ban on use of the photograph for future merchandise. Defendants moved to dismiss the complaint for failure to state a claim.

In determining whether to grant the defendants’ motion, the U.S. District Court for the Southern District of New York, applying Texas rules of contract interpretation, [rejected Duffey’s attempt](#) to establish as industry standard the requirement of explicit enumeration of the right to sell merchandise. Instead, the court relied upon the plain meaning of the words of the contract. Specifically, the court reasoned that the right to use images of Duffey’s performance for “commercial purposes” includes the right to sell merchandise. The court further reasoned that even if merchandising fell outside of the contemplated “commercial purposes,” it would be included in the grant of “all rights throughout the universe” to the results of Duffey’s performance. The court also found that evidence of a customary practice of requiring explicit enumeration of the right to sell merchandise in the 1950s plus two modern examples of the purported custom does not make it plausible that Duffey and the production company had a justified expectation that said 1950s custom would apply to their modern agreement.

Therefore, the court granted the defendants’ motion to dismiss, explaining that Duffey granted Cubicle the right to use images of his performance on merchandise through the language of the Day Player Agreement, even though there was no specific mention of the term “merchandise.” Although the result allows a slight sigh of relief for any attorneys who have not included the full kitchen-sink list of rights granted in agreements drafted for producer clients, it is a reminder to be specific and anticipate all reasonable uses of a party’s work in every contract, even those with day players, to avoid the unnecessary expense of litigation.

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estates, with attorneys licensed in both Texas and Florida.

Send questions, comments, and submissions for the TESLAW E-Newsletter to [Victoria Helling](#).

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