

FAIR USE AND THE TAKEDOWN/ PUT BACK PROVISIONS OF THE DIGITAL MILLENNIUM COPYRIGHT ACT

CHARLES W. HAZELWOOD, JR.*

I. INTRODUCTION

This paper examines the legal and practical effects of the takedown and put back provisions in section 512 of the Digital Millennium Copyright Act (DMCA)¹ on the fair use rights of the average Internet user. Since there are no economic or legal costs which penalize copyright holders for sending broad and questionable takedown notices, there is no reason for copyright holders to limit their takedown notices to cases of piracy or instances of economic or commercial harm. The copyright holder is free to send a takedown notice for cases of questionable infringement, de minimis infringement,² or in clear cases of fair use. This is in sharp contrast to the incentive in non-digital copyright cases. In order to get an allegedly infringing work removed in non-digital copyright cases, a copyright holder has to seek an injunction in court.³ This procedure necessarily involves legal expenses. These expenses act as an economic disincentive on copyright holders to pursue cases of de minimis infringement or cases where there is an arguable fair use right. A copyright holder is thus much more likely to only pursue cases of piracy in which the copyright holder is suffering an economic harm.

In Part II of this paper, the purpose of the DMCA and structure of section 512 will be reviewed. Part III will examine the history and purposes of fair

* LL.M. Intellectual Property, George Washington University School of Law; J.D. University of Richmond School of Law; B.A. University of Virginia. The author is currently engaged in the private practice of law in Burke, Virginia.

¹ Digital Millennium Copyright Act, Pub. L. No. 105-304, § 202, 112 Stat. 2860, 2877-86 (1998) (current version at 17 U.S.C. § 512 (2006)).

² See Jennifer R. R. Mueller, *All Mixed up: Bridgeport Music v. Dimension Films and De Minimis Digital Sampling*, 81 IND. L.J. 435 *passim* (2006) (discussing de minimis infringement cases).

³ 17 U.S.C. § 502(a) (2006).

use. Part IV will argue that the takedown provisions of section 512 are unnecessarily broad in scope in light of the purposes underlying the enactment of the DMCA. Part V will make the case that the put back provisions do not protect fair use as originally intended. Part VI will recommend changes to the DMCA to insure that it continues to protect the copyright holder against piracy, while at the same time respecting the fair use rights of the internet user.

II. PURPOSE AND STRUCTURE OF THE DMCA

A review of the legislative history of the DMCA reveals two major goals underlying its adoption.⁴ These goals were the protection of intellectual property and the promotion of the “growth and development of electronic commerce”⁵ because Congress was concerned with protecting copyrighted works against piracy.⁶ The Senate noted that because “digital works can be copied and distributed worldwide virtually instantaneously, copyright owners will hesitate to make their works readily available on the Internet without reasonable assurance that they will be protected against massive piracy.”⁷ The House of Representatives noted that “[i]n contrast to the analog experience, digital technology enables pirates to reproduce and distribute perfect copies of works—at virtually no cost at all to the pirate. As technology advances, so must our laws.”⁸ It is clear that Congress felt that copyright laws that existed at the time were inadequate to protect copyright owners against the threat of piracy in the digital age.

Congress also wanted to insure the “growth and development of electronic commerce.”⁹ To accomplish this goal, the DMCA contains provisions to provide service providers with protection against copyright infringement claims.¹⁰ As the Senate report noted, “without clarification of their liability, service providers may hesitate to make the necessary investment in the expansion of the speed and capacity of the Internet.”¹¹

One of the ways that Congress sought to advance its goals was through the Online Copyright Infringement Liability Limitation Act, included in the DMCA as section 512. Although other provisions of the DMCA may also ad-

⁴ H.R. REP. NO. 105-551, pt. 2, at 23 (1998).

⁵ *Id.*

⁶ *Id.* at 25; S. REP. NO. 105-190, at 8 (1998).

⁷ S. REP. NO. 105-190, at 8.

⁸ H.R. REP. NO. 105-551, pt. 2, at 25.

⁹ *Id.* at 23.

¹⁰ S. REP. NO. 105-190, at 8.

¹¹ *Id.*

vance the two goals of Congress, the discussion in this article will be limited to the provisions of section 512. This section contains provisions that advance both of Congress's goals discussed above. It protects internet service providers from copyright infringement claims and copyright owners against piracy by providing means for copyright owners to have infringing material immediately removed from the Internet. It divides service providers into five categories and provides protection from infringement claims.

Section 512(a) describes the first category of protected services as “[t]ransitory digital network communications.”¹² A service provider acts as a transitory digital network when it “plays the role of a ‘conduit’ for the communications of others.”¹³ A Section 512(a) service provider will not be held liable for copyright infringement “by reason of the provider’s transmitting, routing, or providing connections for, material through a system or network controlled or operated by or for the service provider, or by reason of the intermediate and transient storage of that material in the course of such transmitting, routing, or providing connections.”¹⁴ The notice and put back provisions of section 512 do not apply to these service providers; thus, the limitation of liability for copyright infringement granted by section 512 is not dependent on responding to a takedown notice.

The second category of protection is for service providers involved in “[s]ystem caching.”¹⁵ Section 512(b) provides protection from copyright infringement “by reason of the intermediate and temporary storage of material on a system or network controlled or operated by or for the service provider.”¹⁶ The notice and put back provisions of section 512 apply to these service providers in a limited way.¹⁷ In order to be required to respond to a takedown notice, the material must have been previously “removed from the originating site or access to it has been disabled, or a court has ordered that the material be removed from the originating site.”¹⁸ In addition, the notice to the service provider must contain a statement that the material has been previously removed or ordered to be taken down.¹⁹

¹² 17 U.S.C. § 512(a) (2006).

¹³ H.R. REP. NO. 105-551, pt. 2, at 51 (1998).

¹⁴ 17 U.S.C. § 512(a).

¹⁵ *Id.* § 512(b).

¹⁶ *Id.* § 512(b)(1).

¹⁷ *Id.* § 512(b)(2)(E).

¹⁸ 17 U.S.C. § 512(b)(2)(E)(i) (2006).

¹⁹ *Id.* § 512(b)(2)(E)(ii).

The third category of protection is entitled “[i]nformation residing on systems or networks at direction of users.”²⁰ This type of service provider is protected from liability “by reason of the storage at the direction of a user of material that resides on a system or network controlled or operated by or for the service provider.”²¹ Examples of such service providers are Facebook, YouTube, and MySpace. In order to qualify for the limitation of liability provided by section 512(c), a service provider must “not have actual knowledge that the material . . . is infringing . . . [or be] aware of facts or circumstances from which infringing activity is apparent.”²² Upon obtaining such knowledge, the service provider must “act[] expeditiously to remove, or disable access to, the material.”²³

In addition, the service provider must “not receive a financial benefit directly attributable to the infringing activity, in a case in which the service provider has the right and ability to control such activity.”²⁴ The service provider will be shielded from copyright infringement liability if, “upon notification of claimed infringement . . . , [it] responds expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity.”²⁵ Lastly, the service provider must designate an agent with the Register of Copyrights to receive the notice of claimed infringements described in section 512(c)(1)(C).²⁶ As long as the service provider complies with the takedown notice, it is granted a safe harbor and is immune from liability for infringement for the material removed.²⁷

The fourth category of protection is entitled “[i]nformation location tools.”²⁸ These provide protection for service “provider[s] referring or linking users to an online location containing infringing material or infringing activity, by using information location tools, including a directory, index, reference, pointer, or hypertext link.”²⁹ Two examples of sites which fall under this definition are Yahoo and Google. The requirements for the limitation of liability conferred by section 512(d) are very similar to the requirements of section 512(c).

²⁰ *Id.* § 512(c).

²¹ *Id.* § 512(c)(1).

²² *Id.* § 512(c)(1)(A)(i)–(ii).

²³ *Id.* § 512(c)(1)(A)(iii).

²⁴ 17 U.S.C. § 512(c)(1)(B) (2006).

²⁵ *Id.* § 512(c)(1)(C).

²⁶ *Id.* § 512(c)(2).

²⁷ *Id.* § 512(g).

²⁸ *Id.* § 512(d).

²⁹ *Id.*

The qualification requirements for limitation of liability are identical to those under section 512(c)(1), listed above.³⁰ Also, as in section 512(c), the service provider must “not receive a financial benefit directly attributable to the infringing activity, in a case in which the service provider has the right and ability to control such activity.”³¹ Lastly, the service provider must comply with a takedown notification as set forth in section 512(c)(3).³² The service provider under section 512(d) is granted a safe harbor and immunity from infringement liability upon compliance with the notice and takedown provisions.³³

The final category of protection is entitled “[l]imitation on liability of nonprofit educational institutions.”³⁴ This category provides protection when the service provider is “a public or other nonprofit institution of higher education.”³⁵ There is no takedown provision in this section; however, one of the conditions of this section for protection from copyright liability is that the institution must not have, “within the preceding 3-year period, received more than two notifications described in subsection (c)(3) of claimed infringement by such faculty member or graduate student”³⁶

In summary, of the five protected categories of service providers, section 512(a) has no takedown requirements and section 512(b) has a limited takedown requirement. In section 512(e), the limitation on liability is conditioned on not receiving more than two takedown notices in a three-year period. The notice and takedown provisions of section 512(c)(3) are only fully applicable to sections 512(c) and 512(d).

The takedown requirements of sections 512(c) and 512(d), along with the anti-circumvention protections of the DMCA, are the primary tools used by Congress to accomplish its goal of protecting copyright holders from piracy in the digital age. Section 512(c) gives the right to copyright owners to request service providers to remove allegedly infringing material. The service providers must comply with this takedown notice if they wish to receive the protections against copyright infringement granted by sections 512(c) and 512(d). Section 512(c)(3) sets forth the elements required in the notification sent by the copyright owner to the service provider.

³⁰ See 17 U.S.C. § 512(d)(1)(A)–(C) (2006).

³¹ *Id.* § 512(d)(2).

³² *Id.* § 512(d)(3).

³³ *Id.* § 512(g).

³⁴ *Id.* § 512(e).

³⁵ *Id.* § 512(e)(1).

³⁶ 17 U.S.C. § 512(e)(1)(B) (2006).

Section 512(c)(3)(A) provides that “To be effective under this subsection, a notification of claimed infringement must be a written communication provided to the designated agent of a service provider”³⁷ The notification must contain:

- (i) A physical or electronic signature of a person authorized to act on behalf of the owner of an exclusive right that is allegedly infringed.
- (ii) Identification of the copyrighted work claimed to have been infringed
- (iii) Identification of the material that is claimed to be infringing
- (iv) Information reasonably sufficient to permit the service provider to contact the complaining party
- (v) A statement that the complaining party has a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law.
- (vi) A statement that the information in the notification is accurate, and under penalty of perjury, that the complaining party is authorized to act on behalf of the owner of an exclusive right that is allegedly infringed.³⁸

As noted above, upon receipt of the takedown notification, the service provider must act “expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity.”³⁹ Section 512(g) grants immunity from liability to the service provider for taking down material pursuant to a takedown notice provided certain conditions are met.⁴⁰

Section 512(g)(2)(A) requires the service provider to “take[] reasonable steps promptly to notify the subscriber that it has removed or disabled access to the material.”⁴¹ After receiving notification of the takedown, the subscriber has the option to send a counter notification requesting the material be put back.⁴² This is known as the put back or counter notification. Upon receipt of the put back notification, the service provider must promptly provide the person who gave the original takedown notice with a copy of the put back notification and must inform the person who gave the original takedown notice “that it will re-

³⁷ *Id.* § 512(c)(3)(A).

³⁸ *Id.* § 512(c)(3)(A)(i)–(vi).

³⁹ *Id.* § 512(d)(3).

⁴⁰ *Id.* § 512(g)(1).

⁴¹ *Id.* § 512(g)(2)(A).

⁴² 17 U.S.C. § 512(g)(2)(B)–(C) (2006).

place the removed material or cease disabling access to it in 10 business days.”⁴³ The service provider must replace the removed material between ten and fourteen business days following receipt of the put back notification unless the service provider receives notice from the person who originally filed the takedown notice that they are seeking an injunction against use of the material.⁴⁴

The content requirements of the put back or counter notification are very similar to the contents of the initial notification. The put back notification must contain:

- (A) A physical or electronic signature of the subscriber.
- (B) Identification of the material that has been removed or to which access has been disabled and the location at which the material appeared before it was removed or access to it was disabled.
- (C) A statement under penalty of perjury that the subscriber has a good faith belief that the material was removed or disabled as a result of mistake or misidentification of the material to be removed or disabled.
- (D) The subscriber’s [contact information], and a statement that the subscriber consents to the jurisdiction of Federal District Court for the judicial district in which the address is located⁴⁵

If the put back notice contains the above required information and complies with the requirements mentioned above, the service provider must put back the material within ten to fourteen days of the counter notification.⁴⁶

III. HISTORY AND PURPOSES OF FAIR USE

In order to explore the effect of the takedown and put back provisions of section 512 on the fair use rights of the Internet user, it is necessary to briefly review the history and purposes of fair use. Fair use as a legal doctrine was a “child of the common law,”⁴⁷ which evolved in a series of court decision between 1740 and 1839 in England.⁴⁸ Those decisions arose in abridgment cases, and their basic underlying premise was the recognition that where original content was added to portions of copyrighted works, a completely new work was

⁴³ *Id.* § 512(g)(2)(B).

⁴⁴ *Id.* § 512(g)(2)(C).

⁴⁵ *Id.* § 512(g)(3)(A)–(D).

⁴⁶ *Id.* § 512(g)(2)(C).

⁴⁷ WILLIAM F. PATRY, *THE FAIR USE PRIVILEGE IN COPYRIGHT LAW* 5 (2d ed. 1995).

⁴⁸ *Id.* at 3.

created and the use of the copyrighted work was not infringement.⁴⁹ In 1841, Justice Story enunciated these common law principals from England in *Folsom v. Marsh*.⁵⁰ Justice Story wrote:

In short, we must often, in deciding questions of this sort, look to the nature and objects of the selections made, the quantity and value of materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.⁵¹

As noted by Justice Souter in *Campbell v. Acuff-Rose Music, Inc.*,⁵² this formulation of fair use remained strictly a judicial doctrine until Congress passed the Copyright Act of 1976.⁵³ The Copyright Act of 1976 included section 107, setting forth a fair use legislative exception to copyright infringement as follows:

Notwithstanding the provisions of sections 106, and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.⁵⁴

The Supreme Court in *Acuff-Rose* noted that it was the intent of Congress in enacting section 107 to restate the judicial doctrine of fair use and “that courts continue the common-law tradition of fair use adjudication.”⁵⁵ The Court further stated, “The task is not to be simplified with bright-line rules, for the sta-

⁴⁹ *Id.*

⁵⁰ 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4,901).

⁵¹ PATRY, *supra* note 47, at 21 (quoting *Folsom*, 9 F. Cas. at 348).

⁵² 510 U.S. 569 (1994).

⁵³ *Id.* at 577.

⁵⁴ Copyright Act of 1976, Pub. L. No. 94-533, § 107, 90 Stat. 2541, 2546 (1976) (current version at 17 U.S.C. § 107 (2006)).

⁵⁵ *Campbell*, 510 U.S. at 577 (quoting H.R. REP NO. 94-1476, at 66 (1976)).

tute, like the doctrine it recognizes, calls for case-by-case analysis.”⁵⁶ In conducting an analysis of whether fair use exists, the Supreme Court noted that all four factors should be considered and “the results weighed together, in light of the purposes of copyright.”⁵⁷

IV. EVERYTHING GETS TAKEN DOWN

The following analogy may be helpful in illustrating the effect of the takedown provisions on fair use rights. A patient goes to a surgeon to have a cancerous tumor removed. Instead of using a scalpel to remove the tumor, the surgeon uses a butcher knife. The tumor is removed, but the operation causes massive collateral damage to the patient’s body. In enacting these takedown provisions, Congress has provided a procedure to remove a cancerous tumor, namely piracy from the Internet. Unfortunately, the broad scope and unlimited right of the takedown notice is like using a butcher knife instead of a scalpel. As a result, Congress has effectively eviscerated the fair use right of the Internet user.

As the notice and takedown provisions of the DMCA are presently structured, everything gets taken down. Infringing material gets taken down along with noninfringing material. There is no discrimination. There is no independent party to review what gets taken down. This is unlike the situation under non-digital copyright law where in order to remove allegedly infringing material the copyright holder must seek injunctive relief from a court.⁵⁸ Further, there is no incentive on the part of the service provider to review what gets taken down. In fact, the incentive is for the service provider to take everything down. By removing material pursuant to a takedown notice, the service provider receives immunity from copyright infringement claims.

There is no effective requirement to force the copyright owners to discriminate in their takedown notices between infringing material and noninfringing material. A short list of material taken down pursuant to takedown notices is very informative: price data removed from bargain websites fatwallet.com and dealexpert.net after retailers sent takedown notices claiming that price data was copyrighted;⁵⁹ a website against the development of New York’s Union Square and Union Station, which parodied the official website of a group back-

⁵⁶ *Id.* at 577.

⁵⁷ *Id.* at 578.

⁵⁸ 17 U.S.C. § 502(a) (2006).

⁵⁹ Eddan Katz, *Bargain Shoppers Chilled by Retailers’ DMCA Threats*, CHILLING EFFECTS CLEARINGHOUSE, Nov. 22, 2002, <http://www.chillingeffects.org/weather.cgi?WeatherID=280>.

ing the redevelopment, removed after takedown request of the group backing redevelopment;⁶⁰ a thirteen minute video attempting to explain the act of “paranormalist” Uri Geller, who supposedly bends spoons with his mind, removed from YouTube for having eight seconds of video allegedly under copyright;⁶¹ and a video of an animal welfare group showing injuries and deaths of animals during rodeos removed from YouTube at the request of the Professional Rodeo Cowboys Association.⁶² Although a copyright claim was the basis for each of the above takedown notices, the real reason for the takedown was either political or competition-related. A recent study of takedown notices sent to Google found that over half were related to competition.⁶³ The underlying problem is that the statute does not require discrimination on what is taken down, and there is no economic reason for either the copyright holder or the service provider to discriminate.

Section 512(f) is the section of the DMCA that should provide a safeguard so that the copyright owner only issues a notice to take down infringing material. In discussing its purpose the Senate Report noted, “This subsection is intended to deter knowingly false allegations to service providers in recognition that such misrepresentations are detrimental to rights holders, service providers, and Internet users.”⁶⁴ Section 512(f) should provide an economic disincentive to remove noninfringing material. As noted by the court in *Lenz v. Universal Music Corp.*,⁶⁵ “The purpose of Section 512(f) is to prevent the abuse of takedown notices.”⁶⁶ Section 512(f) provides as follows:

Any person who knowingly materially misrepresents under this section—

- (1) that material or activity is infringing, or

⁶⁰ See Electronic Frontier Foundation, *USP v. Durkee*, ELECTRONIC FRONTIER FOUND., <http://www.eff.org/cases/usp-v-durkee> (last visited Feb. 5, 2009) (reporting on *Union Square P’ship v. Durkee*, which was settled on Jan. 20, 2009).

⁶¹ See Electronic Frontier Foundation, *Sapient v. Geller*, ELECTRONIC FRONTIER FOUND., <http://www.eff.org/cases/sapient-v-geller> (last visited Feb. 5, 2009) (reporting on *Sapient v. Gellar*, which was dismissed).

⁶² See Electronic Frontier Foundation, *Shark v. PRCA*, ELECTRONIC FRONTIER FOUND., <http://www.eff.org/cases/shark-v-prca> (last visited Feb. 5, 2009) (reporting on *Showing Animals Respect & Kindness v. Prof’l Rodeo Cowboy Ass’n*, which was dismissed).

⁶³ 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, 678 (2006).

⁶⁴ S. REP. NO. 105-190, at 49 (1998).

⁶⁵ 572 F. Supp. 2d 1150 (N.D. Cal. 2008).

⁶⁶ *Id.* at 1156.

- (2) that material or activity was removed or disabled by mistake or misidentification,

shall be liable for any damages, including costs and attorneys' fees, incurred by the alleged infringer, by any copyright owner or copyright owner's authorized licensee, or by a service provider, who is injured by such misrepresentation, as the result of the service provider relying upon such misrepresentation in removing or disabling access to the material or activity claimed to be infringing, or in replacing the removed material or ceasing to disable access to it.⁶⁷

Section 512(f) applies to the alleged infringer, the copyright holder and authorized licensee, and to the service provider. In regards to the copyright holder, the language of 512(f) requires that in order for the copyright holder to be liable for damages for wrongfully requesting the removal of material from the Internet, the copyright holder, or its authorized licensee, must "knowingly materially misrepresent[] . . . that material or activity is infringing."⁶⁸ Thus, it is not enough that there be a material misrepresentation that the material or activity is infringing, the representation must be "knowingly" made. If there is a knowing misrepresentation, section 512(f) provides for damages, costs, and attorney fees to the alleged infringer whose material was wrongfully removed.

The first case to interpret the "knowingly" requirement under section 512(f) was *Online Policy Group v. Diebold*.⁶⁹ Online Policy Group (OPG) was seeking injunctive, declaratory, and monetary relief in the form of damages under section 512(f).⁷⁰ Diebold was the manufacturer of electronic voting machines, which were criticized for being inaccurate.⁷¹ In 2003, unknown parties published on the Internet the entire email archive of Diebold.⁷² Some of the emails between Diebold employees acknowledged the problems with the Diebold machines.⁷³ The emails were published on various websites using several service providers, one of which was OPG.⁷⁴ Diebold sent cease and desist let-

⁶⁷ 17 U.S.C. § 512(f) (2006).

⁶⁸ *Id.*

⁶⁹ 337 F. Supp. 2d 1195 (N.D. Cal. 2004).

⁷⁰ *Id.* at 1198–99.

⁷¹ *Id.* at 1197.

⁷² *Id.*

⁷³ *Id.*

⁷⁴ *Id.* at 1197–98. OPG in fact argued that it was not a service provider. The court did not decide this question. Instead the court stated, "Accordingly, for the purposes of the present litigation, the Court will assume without deciding that OPG is IndyMedia's ISP and Hurricane is OPG's ISP." *Id.* at 1198 n.2.

ters to the service providers, including OPG.⁷⁵ OPG, instead of removing the emails and taking advantage of the safe harbor provisions, filed suit on the basis that “Diebold’s claim of copyright infringement was based on knowing material misrepresentation and that Diebold interfered with Plaintiffs’ contractual relations with their respective ISPs.”⁷⁶ The parties filed cross motions for summary judgment and the court noted that since Diebold had withdrawn its cease and desist letter and would not send future letters relating to the emails, OPG’s claims for injunctive and declaratory relief were moot.⁷⁷ However, the court addressed the issue of damages for alleged violation of section 512(f).⁷⁸

The court began its analysis by noting that the parties disputed the meaning of “knowingly materially misrepresents.”⁷⁹ OPG had argued for the same standard that would apply in preliminary injunction cases.⁸⁰ In other words, there would be a violation of section 512(f) if, when Diebold sent the cease and desist letters, it did not have a “likelihood of success.”⁸¹ On the other hand, Diebold argued that the court should adopt the same standard that applies in the Federal Rule of Civil Procedure 11 (Rule 11). Under this standard Diebold would violate section 512(f) if sending the cease and desist letters was “frivolous.”⁸²

The court noted that this was a case of first impression and rejected the standards argued by both parties.⁸³ The court stated that requiring a likelihood of success before sending a cease and desist letter would “impermissibly chill the rights of copyright owners.”⁸⁴ The court also felt that adoption of a Rule 11 standard would be at odds with the clear statutory language of section 512(f).⁸⁵ The court felt that the language of the statute was clear on its face.⁸⁶

A party is liable if it “knowingly” and “materially” misrepresents that copyright infringement has occurred. “Knowingly” means that a party actually knew, should have known if it acted with reasonable care or diligence, or

⁷⁵ Online Policy Group v. Diebold, Inc., 337 F. Supp. 2d 1195, 1198 (N.D. Cal. 2004).

⁷⁶ *Id.*

⁷⁷ *Id.* at 1202.

⁷⁸ *Id.*

⁷⁹ *Id.* at 1204.

⁸⁰ *Id.*

⁸¹ Online Policy Group v. Diebold, Inc. 337 F. Supp. 2d 1195, 1204 (N.D. Cal. 2004).

⁸² *Id.*

⁸³ *Id.*

⁸⁴ *Id.*

⁸⁵ *Id.*

⁸⁶ *Id.*

would have had no substantial doubt had it been acting in good faith, that it was making misrepresentations.⁸⁷

Applying this standard, the court concluded “that Diebold knowingly materially misrepresented that Plaintiffs infringed Diebold’s copyright interest, at least with respect to the portions of the email archive clearly subject to the fair use exception.”⁸⁸ The court also stated that the misrepresentations were material because it resulted in the removal of the content from other websites.⁸⁹ The court concluded by saying that Diebold used the safe harbor provisions (takedown provisions) of the DMCA “as a sword to suppress publication of embarrassing content rather than as a shield to protect its intellectual property.”⁹⁰

Viewed in any light, the decision in *Online Policy Group* was a victory for the Internet user. The court set forth a definition of “knowingly” which included any one of three beliefs. First, there was a subjective belief test on the part of the copyright holder: Did the copyright holder actually know that it was making a misrepresentation?⁹¹ Next, there was objective belief on the part of the copyright holder: Should the copyright holder have known that it was making a misrepresentation, if it had acted with reasonable care and diligence?⁹² Lastly, the copyright holder would have no substantial doubt it was making a misrepresentation, if it was acting in good faith.⁹³

The decision in *Online Policy Group* was issued on September 30, 2004.⁹⁴ If the decision by the court in *Online Policy Group* was a victory for fair use on the Internet, the victory was apparently of short duration. On December 1, 2004, the United States Court of Appeals of the Ninth Circuit decided the case of *Rossi v. Motion Picture Association of America, Inc.*⁹⁵

Michael J. Rossi owned and operated a website called “internetmovies.com.”⁹⁶ The Motion Picture Association of America (MPAA) became aware of the website and upon viewing the website saw such statements as: “Join to download full length movies online now! new [sic] movies every

⁸⁷ *Online Policy Group v. Diebold, Inc.*, 337 F. Supp. 2d 1195, 1204 (N.D. Cal. 2004).

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.* at 1204–05.

⁹¹ *Id.* at 1204.

⁹² *Id.*

⁹³ *Online Policy Group v. Diebold, Inc.*, 337 F. Supp. 2d 1195, 1204 (N.D. Cal. 2004).

⁹⁴ *Id.* at 1195.

⁹⁵ 391 F.3d 1000 (9th Cir. 2004).

⁹⁶ *Id.* at 1001.

month”; “Full Length Downloadable Movies”; and “NOW DOWNLOADABLE.”⁹⁷

Following these statements were graphics of a number of MPAA copyrighted movies.⁹⁸ Based on these statements and the graphics, the MPAA believed that Rossi was infringing copyrighted material.⁹⁹ Following the notice and takedown procedures of the DMCA, the MPAA sent notice informing Rossi’s service provider of the alleged infringement.¹⁰⁰ Upon being notified that his website was going to be shut down, Rossi immediately found another service provider to host his website.¹⁰¹ He then filed an action against the MPAA, asserting four claims, among which were tortious interference with contractual relations and tortious interference with prospective economic advantage.¹⁰² The MPAA filed a motion for summary judgment, which the District Court granted.¹⁰³ The Court of Appeals for the Ninth Circuit found that because the MPAA acted in compliance with the DMCA, the plaintiff’s claims for tortious interference with contract must fail.¹⁰⁴ In reviewing whether the MPAA had acted in compliance with the DMCA, the court relied primarily on section 512(c)(3)(A)(v), which requires that the notice contain “[a] statement that the complaining party has a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law.”¹⁰⁵

The MPAA argued that the good faith belief required under section 512(c)(3)(A)(v) was a subjective one according to other cases interpreting good faith and that Congress could have specifically included an objective standard or required a reasonable investigative requirement into the section.¹⁰⁶ The court agreed with the MPAA’s arguments and interpreted the good faith belief requirement of the section to be subjective.¹⁰⁷ In making this determination, the court relied on a line of cases interpreting good faith in other federal statutes.¹⁰⁸

⁹⁷ *Id.* at 1002.

⁹⁸ *Id.*

⁹⁹ *Id.*

¹⁰⁰ *Id.*

¹⁰¹ *Rossi v. Motion Picture Ass’n of Am., Inc.*, 391 F.3d 1000, 1002 (9th Cir. 2004).

¹⁰² *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 1003.

¹⁰⁶ *Id.* at 1004.

¹⁰⁷ *Rossi v. Motion Picture Ass’n of Am., Inc.*, 391 F.3d 1000, 1004 (9th Cir. 2004).

¹⁰⁸ *Id.*

The court also stated that the overall structure of section 512 supported their conclusion that Congress intended section 512(c)(3)(A)(v) to set forth a subjective standard of good faith.¹⁰⁹ In reaching this conclusion, the Court cited section 512(f) and stated, “A copyright owner cannot be liable simply because an unknowing mistake is made, even if the copyright owner acted unreasonably in making the mistake. Rather, there must be a demonstration of some actual knowledge of misrepresentation on the part of the copyright owner.”¹¹⁰ Looking to the text of section 512(f), the court concluded:

Juxtaposing the “good faith” proviso of the DMCA with the “knowing misrepresentation” provision of that same statute reveals an apparent statutory structure that predicated the imposition of liability upon copyright owners only for knowing misrepresentations regarding allegedly infringing websites. Measuring compliance with a lesser “objective reasonableness” standard would be inconsistent with Congress’s apparent intent that the statute protect potential violators from *subjectively* improper actions by copyright owners.¹¹¹

The court in *Rossi* then reviewed the MPAA’s actions in light the subjective standard which it had enunciated. The MPAA admitted that it had used the “Ranger” program to locate infringing websites.¹¹² It was argued on Rossi’s behalf that computers conducting automated searches could not form the belief required by the DMCA or distinguish between infringing content and words that suggest infringement.¹¹³ However, the MPAA also stated that it had employees examine the websites identified by the Ranger program and that it was these employees who made the decision that Rossi’s site contained infringing material.¹¹⁴ The court then stated that there was no indication that the MPAA’s belief regarding Rossi’s alleged infringement was not sincere and that Rossi failed to raise a triable issue about whether the MPAA had complied with the notice and takedown provisions of the DMCA.¹¹⁵ The court then concluded that since the MPAA’s actions complied with the DMCA, the tortious interference claims failed as a matter of law.¹¹⁶ Since the District Court that decided *Online Policy Group* was part of the Ninth Circuit, there is no doubt that *Online Policy Group* is in conflict with *Rossi*. As a result, there seems to be a consensus among

¹⁰⁹ *Id.*

¹¹⁰ *Id.* at 1005 (citation omitted).

¹¹¹ *Id.* (emphasis added).

¹¹² *Id.*

¹¹³ *Rossi v. Motion Picture Ass’n of Am., Inc.*, 391 F.3d 1000, 1005 (9th Cir. 2004).

¹¹⁴ *Id.*

¹¹⁵ *Id.*

¹¹⁶ *Id.* at 1006.

commentators that the objective standard set forth in *Online Policy Group* is no longer good law.¹¹⁷

The decision in *Rossi* has been followed by a district court in at least one other circuit. In *Dudnikov v. MGA Entertainment, Inc.*,¹¹⁸ the United States District Court of Colorado relied on the holding in *Rossi* and applied a subjective standard in rejecting a claim of perjury, which was analyzed by the Court as a fraudulent misrepresentation claim using section 512(f).¹¹⁹

In *Dudnikov*, the plaintiffs, Mr. and Mrs. Dudnikov, operated a small business that offered items for sale on eBay.¹²⁰ One of the items offered by Dudnikov on eBay was a fleece hat with “a Bratz® applique affixed to it,” a trademark wholly owned by MGA Entertainment.¹²¹ MGA, who utilized eBay’s Verified Rights Owner’s Program (VeRO), claimed that the Dudnikovs were infringing MGA’s copyright among other rights, and had the Dudnikovs’ auction removed.¹²² The Dudnikovs filed a pro se action alleging among other things, perjury.¹²³ The Court in *Dudnikov* applied the subjective standard enunciated by the Court in *Rossi* and stated:

Thus, as long as MGA acted in good faith belief that infringement was occurring, there is no cause of action under § 512(f). Plaintiffs’ claim for perjury must be supported by substantial evidence that MGA knowingly and materially misrepresented Plaintiffs’ infringement when it utilized eBay’s VeRO program to have the auction shut down.¹²⁴

The court found that the Dudnikovs failed to meet this burden of proof and granted MGA’s motion for summary judgment.¹²⁵ The court affirmed and adopted a finding of the Recommendation of the United States Magistrate Judge that had cited the holding in *Rossi* supporting a subjective standard of knowledge.¹²⁶

¹¹⁷ See Matt Williams, *The Truth and the “Truthiness” About Knowing Material Misrepresentations*, 9 N.C. J.L. & TECH. 1, 3 (2007).

¹¹⁸ 410 F. Supp. 2d 1010 (D. Colo. 2005).

¹¹⁹ *Id.* at 1012.

¹²⁰ *Id.* at 1011.

¹²¹ *Id.*

¹²² *Id.*

¹²³ *Id.* at 1012.

¹²⁴ *Dudnikov v. MGA Entm’t, Inc.*, 410 F. Supp. 2d 1010, 1012 (D. Colo. 2005).

¹²⁵ *Id.*

¹²⁶ *Id.* at 1012, 1017.

In the recent case of *Lenz v. Universal Music Corp.*,¹²⁷ the U.S. District Court for the Northern District of California elaborated on the subjective test of *Rossi*. In this particular case, Stephanie Lenz uploaded a video of her son dancing to the Prince song “Let’s Go Crazy” to YouTube.¹²⁸ The video is approximately twenty-nine seconds in length and the Prince song can be heard in the background for approximately twenty seconds.¹²⁹ Universal, the owner of the copyright to “Let’s Go Crazy” sent YouTube a takedown notice pursuant to the DMCA claiming that the video infringed their copyright.¹³⁰ YouTube removed the video in response to Universal’s takedown notice.¹³¹ Lenz sent YouTube a counter-notification pursuant to section 512(g) claiming fair use.¹³² Lenz also filed suit against Universal alleging misrepresentation under section 512(f).¹³³ Universal filed a motion to dismiss Lenz’s action.¹³⁴

There was no dispute that Lenz used Prince’s copyrighted music in her video.¹³⁵ However, Lenz argued “that copyright owners cannot represent in good faith that material infringes a copyright without considering all authorized uses of material, including fair use.”¹³⁶ Thus, the issue before the court was whether a copyright owner is required to consider fair use in formulating a good faith belief as required by section 512(c)(3)(A)(v).¹³⁷

The first argument of Universal was that fair use was merely an excused infringement of copyright, rather than a use authorized by the copyright owner or by law.¹³⁸ Further, Universal argued that section 512(c)(3)(A) makes no mention of fair use nor requires “a good faith belief that a given use of copyrighted material is not fair use.”¹³⁹ In answering the question of whether fair use qualifies as a use “authorized by law” within the meaning of the DMCA, the court noted that this was an issue of first impression.¹⁴⁰

¹²⁷ 572 F. Supp. 2d 1150 (N.D. Cal. 2008).

¹²⁸ *Id.* at 1152.

¹²⁹ *Id.*

¹³⁰ *Id.*

¹³¹ *Id.*

¹³² *Id.*

¹³³ *Lenz v. Universal Music Corp.*, 572 F. Supp. 2d 1150, 1153 (N.D. Cal. 2008).

¹³⁴ *Id.*

¹³⁵ *Id.*

¹³⁶ *Id.* at 1154.

¹³⁷ *Id.*

¹³⁸ *Id.*

¹³⁹ *Lenz v. Universal Music Corp.*, 572 F. Supp. 2d 1150, 1154 (N.D. Cal. 2008).

¹⁴⁰ *Id.*

In *Lenz*, the court rejected the arguments of Universal. It noted that fair use was provided for in section 107 and that the Supreme Court has consistently held that fair use is not infringement of a copyright.¹⁴¹ Therefore, in order to have a good faith belief under section 512(c)(3)(A), a consideration of fair use was required.¹⁴² The court stated:

The DMCA already requires copyright owners to make an initial review of the potentially infringing material prior to sending a takedown notice; indeed, it would be impossible to meet any of the requirements of Section 512(c) without doing so. A consideration of the applicability of the fair use doctrine simply is part of that initial review.¹⁴³

The court then reviewed section 512(f) and noted that “The purpose of Section 512(f) is to prevent the abuse of takedown notices. If copyright owners are immune from liability by virtue of ownership alone, then to a large extent Section 512(f) is superfluous.”¹⁴⁴

At first glance, the ruling in *Lenz* would seem to be a victory for users of the Internet. Although *Lenz* does require a fair use analysis on the part of the copyright owner before requesting a takedown notice, the subjective standard of knowledge enunciated by the Ninth Circuit in *Rossi* still remains a major hurdle for Internet users claiming that copyright owners violated the provisions of section 512(f).¹⁴⁵ This hurdle is highlighted by the Ninth Circuit in an order denying the motion to certify an interlocutory appeal filed by Universal Music Corp.¹⁴⁶ In rejecting the appeal, the court stated that the District Court was not requiring “that every takedown notice must be preceded by a full fair use investigation.”¹⁴⁷ The court continued:

Rather, [the District Court] recognized, as it has previously, that in a given case fair use may be so obvious that a copyright owner could not reasonably believe that actionable infringement was taking place. In such a case, which is likely to be extremely rare, the policy objectives of the DMCA are served by requiring copyright owners at least to form a subjective good faith belief

¹⁴¹ *Id.* at 1155.

¹⁴² *Id.*

¹⁴³ *Id.*

¹⁴⁴ *Id.* at 1156.

¹⁴⁵ See *Lenz v. Universal Music Corp.*, 572 F. Supp. 2d 1150, 1154 (N.D. Cal. 2008); *Rossi v. Motion Picture Ass’n of Am., Inc.*, 391 F.3d 1000, 1005 (9th Cir. 2004).

¹⁴⁶ *Lenz v. Universal Music Corp.*, No. C 07-3783 JF (RS), 2008 WL 4790669, at *1 (N.D. Cal. Oct. 28, 2008).

¹⁴⁷ *Id.* at *6.

that the “particular use is not a fair use” before sending the takedown notice.¹⁴⁸

It is somewhat surprising that the court in rejecting the interlocutory appeal would cite the holding in *Online Policy Group*, which had enunciated an objective standard in determining whether there was a knowing misrepresentation in the takedown notification. Although it cited *Online Policy Group*, the court also restated the subjective knowledge requirement of *Rossi*.¹⁴⁹ The court also noted that it is an extremely rare “case [where] fair use may be so obvious that a copyright owner could not reasonably believe that actionable infringement was taking place.”¹⁵⁰

As the case law interpreting section 512(f) now stands, there is virtually no penalty for copyright owners issuing broad and questionable takedown notices. As long as the copyright holder has a subjective belief of infringement, no liability will attach to the copyright holder for the removal of noninfringing material. The copyright owner must consider fair use only in the “rare case” where fair use is obvious. Unfortunately, the courts by adopting the subjective standard of knowledge of *Rossi*, instead of an objective standard of knowledge as set forth in *Online Policy Group*, have made the provisions of section 512(f) virtually worthless in terms in preventing abuse of the takedown provisions of the DMCA. In fact, although the DMCA has been in existence for approximately ten years and there have been thousands of takedown notices, the decision in *Online Policy Group* appears to be the only court decision finding a violation of section 512(f) against a copyright holder for a knowing material misrepresentation.¹⁵¹

¹⁴⁸ *Id.* at *6–7 (citation omitted).

¹⁴⁹ *Id.* at *2.

¹⁵⁰ *Id.*

¹⁵¹ As confirmed by performing a Terms and Connectors search on LexisNexis under the Federal Court Cases, Combined database using the search term: 17 U.S.C.S. § 512(f). This returned 118 results (search performed on February 11, 2010). A FOCUS search was then performed on the search results using the search terms: 512(f) & knowing! & misrepr!. This search returned 18 results. *E.g.*, *BioSafe-One, Inc. v. Jorgensen*, 639 F. Supp. 2d 358, 363–64, 369–70 (S.D.N.Y. 2009) (dismissed on summary judgment defendant’s counterclaim that notices sent to web hosting company violated § 512(f)); *Capitol Records, Inc. v. MP3tunes, LLC*, 611 F. Supp. 2d 342, 346–47 (S.D.N.Y. 2009) (granting motion to dismiss defendant’s counterclaim that Capitol Record’s Take Down Notice telling defendant to remove links to copyrighted recordings violated § 512(f)); *UMG Recordings, Inc. v. Augusto*, 558 F. Supp. 2d 1055, 1058, 1065 (C.D. Cal. 2008) (summary judgment granted against defendant’s counterclaim that UMG Recording’s notification to eBay’s VeRO program violated § 512(f)); *Arista Records, Inc. v. MP3Board, Inc.*, No. 00 Civ. 4660 (SHS), 2002 U.S. Dist. LEXIS 16165, at *43–46 (S.D.N.Y. Aug. 29, 2002) (RIAA entitled to summary judgment against de-

Since section 512(f) does not impose a legal or economic cost on sending broad takedown notices, copyright holders have no incentive to limit their takedown notices to cases of piracy. As shown above, the prevention of piracy was one of Congress's main goals. The term piracy as used by Congress has a very specific meaning. Although the term piracy historically in copyright law was another term for infringement,¹⁵² it seems clear that in the last forty to fifty years, and as used by Congress, piracy means a very specific type of infringement. In the legislative history of the Sound Recording Act of 1971 entitled "Prohibiting Piracy of Sound Recordings," Congress stated the following reason for the legislation:

The attention of the Committee has been directed to the widespread unauthorized reproduction of phonograph records and tapes. While it is difficult to establish the exact volume or dollar value of current piracy activity, it is estimated by reliable trade sources that the annual volume of such piracy is now in excess of \$100 million.¹⁵³

Not only did Congress have this specific meaning for piracy, but so have the courts. A look at the language of the Supreme Court in the case of *Goldstein v. California*¹⁵⁴ clearly shows the modern meaning of the term piracy in relation to copyright law. *Goldstein* involved the Supreme Court's review of a California law that made it illegal to copy tapes with the intent to sell or cause to be sold. The Supreme Court stated:

Petitioners were engaged in what has commonly been called "record piracy" or "tape piracy"—the unauthorized duplication of recordings of performances by major musical artists. Petitioners would purchase from a retail distributor a single tape or phonograph recording of the popular performances they wished to duplicate. . . . At petitioners' plant, the recording was reproduced on blank tapes, which could in turn be used to replay the music on a tape player. . . . After final packaging, the tapes were distributed to retail outlets for sale to the public, in competition with those petitioners had copied.¹⁵⁵

defendant's claim that a notice letter to defendant's service provider violated § 512(f) because it was vague and listed only artist's names without specifying particular songs or links). *But cf.* *Brave New Films 501(c)(4) v. Weiner*, 626 F. Supp. 2d 1013, 1017, 1018 (N.D. Cal. 2009) (denying motion to dismiss complaint that defendant violated § 512(f)).

¹⁵² See *Folsom v. Marsh*, 9 F. Cas. 342, 342 (C.C.D. Mass. 1841), in which the suit is brought by a "Bill in equity for piracy of the copyright" and the court refers to the alleged infringement as piracy.

¹⁵³ H.R. REP. NO. 92-487, at 2 (1971), *reprinted in* 1971 U.S.C.C.A.N. 1566, 1567.

¹⁵⁴ 412 U.S. 546 (1973).

¹⁵⁵ *Id.* at 549–50.

Accordingly, when Congress set as one of its major goals the prevention of “piracy,” Congress was not talking about the prevention of all copyright infringement. Rather, Congress was talking about the specific type of infringement discussed above, where duplicate copies are made that compete with the original. The Senate defined the term “pirate” site as one “where sound recordings, software, movies or books were available for unauthorized downloading, public performance or public display.”¹⁵⁶

Therefore, as shown by the legislative history and case law above, for piracy to exist there must be two components: (1) an unauthorized copy or duplication of the original; and (2) an economic or commercial component, such that the copy or duplicate competes with the original in the market place.¹⁵⁷ In the digital age, Congress realized the ease with which copies could be made and distributed and the economic danger this posed.¹⁵⁸ The pirate no longer had to have a plant and equipment to make duplicate copies of a copyrighted work. Instead, anyone could be a pirate, and piracy could be accomplished with the push of a button on a computer. It was in response to this threat that Congress enacted the extraordinary remedy of a takedown without prior court approval.

As a consequence of the failure of section 512(f) to protect against abuse of the takedown provisions, there is no economic or legal incentive for copyright holders to limit their takedown notices to cases of piracy. In addition, unlike in non-digital copyright cases where there are economic costs associated with attempting to obtain an injunction to have copyrighted material removed, in the digital world there are no such costs. This means, as a practical matter, the copyright holder has no economic incentive to only pursue infringement cases where there is an economic harm being caused by the infringement. As a result, the extraordinary remedy of takedown without court approval has been abused.¹⁵⁹ Much of the material being removed as a result of takedown is not piracy and causes no economic loss to the copyright holder or economic gain to

¹⁵⁶ S. REP. NO. 105-190, at 48 (1998).

¹⁵⁷ *Goldstein v. California*, 412 U.S. 546, 549–50 (1973); see also H.R. REP. NO. 92-487, at 2 (1971), reprinted in 1971 U.S.C.C.A.N. 1566, 1567.

¹⁵⁸ H.R. REP. NO. 105-551, pt. 2, at 25 (1998); S. REP. NO. 105-190, at 8.

¹⁵⁹ See Katz, *supra* note 59; Electronic Frontier Foundation, *USP v. Durkee*, ELECTRONIC FRONTIER FOUNDATION, <http://www.eff.org/cases/usp-v-durkee> (reporting on *Union Square P’ship v. Durkee*, which was settled on Jan. 20, 2009); Electronic Frontier Foundation, *Sapient v. Gellar*, ELECTRONIC FRONTIER FOUNDATION, <http://www.eff.org/cases/sapient-v-gellar> (reporting on *Sapient v. Gellar*, which was dismissed); Electronic Frontier Foundation, *Shark v. PRCA*, ELECTRONIC FRONTIER FOUNDATION, <http://www.eff.org/cases/shark-v-prca> (reporting on *Showing Animals Respect & Kindness v. Prof’l Rodeo Cowboy Ass’n*, which was dismissed); Urban & Quilter, *supra* note 63, at 678, and accompanying text.

the alleged infringer.¹⁶⁰ Copyright owners have used the takedown provisions to remove any copyrighted material regardless of whether it is piracy, de minimis infringement, or fair use material.¹⁶¹ By failing to limit the takedown provisions of the DMCA to cases involving economic harm, the current takedown provisions are overly broad and unnecessary to accomplish Congress's goal of protecting against piracy. In addition, by enacting broad takedown provisions with no limit, the practical effect has been the total disregard of the fair use provisions of the copyright law. The fact that these takedowns or censorship is done by copyright owners instead of the government does not make the end result any less oppressive.

V. DOES PUT BACK PROTECT FAIR USE?

Even though several Judiciary Committee members claimed no amendments were needed, I made sure that the industry compromise respected the rights of typical Internet users, ordinary people, by offering an amendment that provided a protection included in the original bill I had offered. It is an idea which is referred to as the "notice and put-back" provision. If material is wrongfully taken down from the Internet user's home page, my amendment ensures that the end user will be given notice of the action taken and gives them a right to initiate a process that allows them to put their material back on line without the need to hire a lawyer or go to court.¹⁶²

As noted in the above quote by Senator Ashcroft during the debates on the DMCA, the purpose behind the put back provisions of the DMCA was to protect the fair use rights of the Internet user. As discussed above, upon receipt of notice that material has been removed from the Internet, the user has the right to send a counter notice and have the removed material put back on the Internet. In light of this right, proponents of the unlimited scope of the takedown provisions of the DMCA may say that it does not matter what is taken down, since the Internet user has the right to put back the material. This ignores the basic fact that legal material should not be taken down at all. Is it permissible for a copyright owner to put a piece of tape over a person's mouth for allegedly singing a song that infringes their copyright just because the person can take the tape off in two to three weeks? The fact that the material can be put back in two to three weeks neither protects fair use nor justifies the fact that it is taken down in the first place.

¹⁶⁰ *Id.*

¹⁶¹ *Id.*

¹⁶² 144 CONG. REC. S4884, S4889 (daily ed. May 14, 1998) (statement of Sen. Ashcroft).

There are many instances where the time period in which the material is taken down is critical. The following example took place during the recent presidential campaign. The John McCain campaign had campaign videos removed from YouTube pursuant to takedown notices.¹⁶³ These notices were sent because the videos had used short clips from various news shows.¹⁶⁴ The campaign argued that these clips were clearly fair use.¹⁶⁵ The campaign even attempted to have YouTube not follow the usual takedown procedures due to the length of the campaign.¹⁶⁶ YouTube refused this request and took down the campaign videos.¹⁶⁷ Most material is not likely to be as time sensitive as a campaign video. However, it is likely that much of the material that is removed is a comment on current events or issues. As the court in *Lenz* recognized, “the unnecessary removal of non-infringing material causes significant injury to the public where time-sensitive or controversial subjects are involved and the counter-notification remedy does not sufficiently address these harms.”¹⁶⁸

Timing of removal is not the only critical issue; more important is the probability that the material will not be put back. One recent survey of 867 takedown notices found that there were only seven counter notifications requesting a put back.¹⁶⁹ One explanation for this is that the receipt of a takedown notice by the average person is intimidating. The following is from a recent takedown notice from YouTube:

Please Note: Repeat incidents of copyright infringement will result in the deletion of your account and all videos uploaded to that account. In order to avoid future strikes against your account, please delete any videos to which you do not own the rights, and refrain from uploading additional videos that infringe on the copyrights of others.¹⁷⁰

The average user of the Internet, who posts for fun or to comment on a current issue, will not want to risk copyright infringement or even having their account suspended by reposting material. This user is not posting for economic or

¹⁶³ Amy E. Bivins, *Digital Millennium Copyright Act: McCain Campaign DMCA Process Suggestion Highlights Web Services' Removal Conundrum*, 13 ELECTRONIC COM. & L. REP. 1362 (2008).

¹⁶⁴ *Id.*

¹⁶⁵ *Id.*

¹⁶⁶ *Id.*

¹⁶⁷ *Id.*

¹⁶⁸ *Lenz v. Universal Music Corp.*, 572 F. Supp. 2d 1150, 1156 (N.D. Cal. 2008).

¹⁶⁹ Urban & Quilter, *supra* note 63, at 679.

¹⁷⁰ Wendy.Seltzer.org: Legal Tags, the Blog, http://wendy.seltzer.org/blog/archives/2007/02/13/my_first_dmca_takedown.html (Feb. 13, 2007, 20:55 EST) [hereinafter Wendy's Blog].

commercial gain. Why would they want to take the risk of reposting material that is claimed to be infringing?

Not only is intimidation a reason that the average Internet user does not exercise their rights under the put back provisions, but so is lack of knowledge. In order to exercise their rights under the put back provisions, the average Internet user must be aware of both the right to put back and their fair use rights. Section 512(g)(2)(a) requires that the service provider “take[] reasonable steps promptly to notify the subscriber that it has removed or disabled access to the material.”¹⁷¹ However, in this section there is no requirement that the person whose material is removed receive notice that they have the right to put back the material. Unfortunately, there is a lack of data on the number of takedown notices that advise the user of the right to put the material back. One limited review of ten notices from service providers found that four did not inform the user about the counter notification procedure, four did inform the user about the counter notification procedure, “and two were ambiguous or confusing.”¹⁷² The following example from the YouTube takedown notice referenced above shows the information provided to the Internet user regarding a right to put back the material removed: “If you elect to send us a counter notice, to be effective it must be a written communication provided to our designated agent that includes substantially the following (please consult your legal counsel or see 17 U.S.C. Section 512(g)(3) to confirm these requirements)”¹⁷³ This notice can best be described as ambiguous. The user is informed about the opportunity to send a counter notice, a term left undefined. Certainly, there is no plain language statement informing the Internet user of the right to have the removed material put back.

Even if the average user of the Internet understands that there is a right to have material put back, it is safe to say that the average user does not understand the legal intricacies of section 512 that are necessary to make an informed decision about whether to send a counter notification requesting a put back. As discussed above, under section 512(g)(3) the subscriber statement requesting a put back must be “[a] statement under penalty of perjury that the subscriber has a good faith belief that the material was removed or disabled as a result of mistake or misidentification.”¹⁷⁴ Further, the average Internet user is probably unaware of section 512(f), which limits liability for making a misrepresentation

¹⁷¹ 17 U.S.C. § 512(g)(2)(a) (2006).

¹⁷² Urban & Quilter, *supra* note 63, at 680.

¹⁷³ Wendy’s Blog, *supra* note 170.

¹⁷⁴ 17 U.S.C. § 512(g)(3)(C).

under section 512 to one that “knowingly materially misrepresents.”¹⁷⁵ Lastly, the average Internet user is unlikely to be aware of the decision in *Rossi*, which applied a subjective standard to representations, rather than an objective standard.¹⁷⁶

Just as it is unlikely that the average Internet user understands the legal intricacies of section 512, it is also likely that that average Internet user lacks the understanding of the fair use doctrine necessary, in many cases, to make an informed decision of whether to send a put back notice. Since there is no clear-cut agreement even among legal scholars as to what constitutes fair use, it is understandable that the average Internet user might be reluctant to base a put back notification on a doctrine of the law which is so difficult to interpret. This is especially true if the user is not aware of the subjective standard for making representations set by *Rossi*.¹⁷⁷

VI. PIRACY V. FAIR USE

One of the two primary purposes of the DMCA is to prevent piracy.¹⁷⁸ Unfortunately, the cost of this attempted prevention of piracy has resulted in the demise of fair use in many instances. There are two possible methods to change the provisions of section 512, so the right to fair use is not abridged: (1) interpretation of the current statute by the courts, and (2) legislative amendment. As has been seen, the case law interpreting section 512 since its enactment approximately ten years ago has done little to protect the fair use rights of the Internet user. Given the broad scope of section 512 for takedown notices, it is questionable whether any court decision can provide adequate protection for these fair use rights. More importantly, why should users of the Internet have to wait for a court decision to protect their fair use rights, which have been in existence, in this country, since the 1800's?

Legislative change to amend section 512 is the proper course. Under the present law, the fair use rights of the Internet user are sacrificed in the name of the prevention of piracy. Section 512 should be amended to narrow its scope so as to protect these fair use rights while at the same time protecting the copyright holder against piracy. The notice and takedown provisions should be changed so that the automatic right of takedown only applies to instances where all or substantially all of the copyrighted material is being used and the alleged

¹⁷⁵ *Id.* § 512(f).

¹⁷⁶ *See Rossi v. Motion Picture Ass'n of Am., Inc.*, 391 F.3d 1000, 1004–05 (9th Cir. 2004).

¹⁷⁷ *Id.* at 1005.

¹⁷⁸ H.R. Rep. No. 105-551, pt. 2, at 23, 25 (1998); S. Rep. No. 105-190, at 8 (1998).

infringing use competes with the original. The right of takedown without court approval is an extraordinary right and it should only be granted for extraordinary circumstance, such as digital piracy. In order to accomplish this change, Congress must narrow the scope of section 512(3)(A). The following provision should be added to the requirements of a notification in section 512(3)(A) in order to implement these changes:

- (vii) A statement that the complaining party has a good faith belief that infringing material constitutes all or a substantial portion of the copyrighted work and that the continued presence of this material on the Internet causes or has the potential to cause economic harm to the copyright holder through competition with the copyrighted work.

It is hoped that the addition of this language would protect against piracy, but at the same time protect most fair use material from being automatically removed as a result of a takedown notification. By enacting this amendment, Congress would still achieve their goal of not allowing “pirates to reproduce and distribute perfect copies of works.”¹⁷⁹ That which might be fair use material or other infringing material would not be subject to automatic takedown. The copyright laws that apply to non-digital copyright would apply to this material. If the copyright owner felt that the material was infringing, the copyright owner would have to resort to the normal court procedures in non-digital copyright cases for having material removed. If the infringing material is not a copy that threatens to compete with the original in the market place, there is no urgency which justifies its removal without a court hearing.

Another necessary change is to strengthen section 512(f) to protect against abuse of the amended takedown provision. Unless this section is strengthened, there is no disincentive for copyright owners who might violate the takedown provisions and send notices where there is no piracy. Section 512(f) should be amended to include the following definition:

The term “knowingly” as used in this section means that a party actually knew or should have known if it acted with reasonable care or diligence.

By enacting an objective standard of knowledge as set forth by the Court in *Online Policy Group*, section 512(f) would provide a true disincentive to send takedown notices in violation of the statute.

¹⁷⁹ H.R. REP. NO. 105-551, pt. 2, at 25 (1998).

Lastly, Congress must amend section 512 to require that notices from service providers inform the Internet user in plain language of their right to have material returned to the Internet. Section 512(g)(2)(A), which requires the service provider to send a notice of the takedown to the subscriber, should be amended to read as follows:

takes reasonable steps to promptly notify the subscriber that it has removed or disabled access to material and that the subscriber has the right to have the material put back by sending a counter notification. The requirements of a counter notification shall be provided to the subscriber as part of this notification.

At least if the above provision was added to section 512, the average Internet user upon receipt of a takedown notice would be aware of their right to have the material put back on the Internet.

VII. CONCLUSION

This writer's son, Alex, is probably a lot like most high school students today. Given the choice of writing a paper or making a video, he chooses making a video every time. Recently, for his high school world history class, Alex made a video about the use of tools by stone-age man during the Neolithic period. This video started out with a narration by Professor Shanks (Alex). The next scene is Professor Shanks getting into a time chamber and traveling back in time to the Neolithic period. There are then various scenes that show stone-age man using tools for farming, fighting, hunting and fishing. Alex was extremely proud of his video and like a lot of Internet users, published it on YouTube. The video was approximately eight minutes in length. Unfortunately, Alex made the mistake of using part of a copyrighted song during the introduction and the closing credits for background music. These songs comprised probably less than thirty seconds of the entire video. As a consequence, YouTube disabled the entire audio of the video. The video remains posted, but is now like a silent movie from the 1920's.¹⁸⁰

This example is related because it probably represents the typical type of material which is being disabled or removed from the Internet. It is material that is not piracy and does not compete with or economically harm any copyrighted material. It may be fair use or it may be de minimis infringement. Even if it is copyright infringement, there is no reason for it to be treated differently

¹⁸⁰ See Alex Hazelwood, *The Neolithic Revolution*, June 12, 2008, <http://www.youtube.com/watch?v=Lz2t-aNsvCw>.

from non-digital copyright infringement. There is no danger of pirated copies of this video being transmitted instantaneously across the Internet to compete with the original copyrighted work. There is nothing about this video that requires it to be treated differently than any non-digital work.

The above example also shows the effect of the broad takedown notices on creativity. After all, at its heart, copyright law is about encouraging creativity by providing incentive for creative works. This goal is accomplished by providing the copyright holder certain exclusive rights to the copyrighted material. On the other hand, fair use is an attempt to balance these exclusive rights by allowing such use that may promote further creativity. The broad scope of the takedown provisions of section 512 have disrupted this balance. The current scope of the takedown provisions is unnecessary to protect current copyright holders against the economic harm of piracy and unnecessarily stifles future creativity by destroying the fair use rights of the Internet user.