

2009

Looking for Fair Use in the DMCA's Safety Dance

Ira Nathenson, *St. Thomas University School of Law*

LOOKING FOR FAIR USE IN THE DMCA’S SAFETY DANCE

Ira S. Nathenson^{*}

*We can dance if we want to.
We can leave your friends behind.
‘Cause your friends don’t dance and if they don’t dance,
Well, they’re no friends of mine.
– Men Without Hats, “The Safety Dance”¹*

Introduction	122
I. A New Dance Sensation.....	128
A. Uncertainty regarding intermediaries	129
B. A statutory “solution”	131
C. A discordant note, and Senator Ashcroft’s amendment.....	133
II. Intermediaries and Senator McCain’s Suggestion	135
A. Section 512 and remix culture	135
B. Senator McCain’s suggestion	137
III. Copyright Owners and Stop-And-Think	140
A. Take-down abuse and the Lenz case	140
B. Owners must consider fair use.....	143
C. Willful blindness as a knowing material misrepresentation	147

^{*} Assistant Professor of Law, St. Thomas University School of Law. This Article was prompted by the invitation of the University of Akron School of Law to participate in its Second Annual Akron IP Forum on the topic of secondary intellectual property liability. I would like to thank the participants at the forum for many helpful suggestions and comments, including Mark Bartholemew, Jay Dratler, Jr., Thomas C. Folsom, Laura A. Heymann, Connie D. Powell, and Elizabeth A. Reilly. I would also like to thank Rory Bahadur for his separate suggestions. This Article was aided by a research grant from St. Thomas University School of Law. Finally, I would like to thank my research assistant Bryn Williams for her research assistance. Any errors are mine alone.

1. MEN WITHOUT HATS, *The Safety Dance*, on RHYTHM OF YOUTH (MCA Records 1982).

D. Considering fair use is not burdensome.....	150
IV. Users, Counter-notification, and Fair Use.....	157
A. What's a "mistake"?	158
B. Limiting abusive counter-notifications.....	162
C. The DMCA is poorly suited for complex cases.....	167
Conclusion	170

INTRODUCTION

In 1998, Congress passed the Digital Millennium Copyright Act ("DMCA").² Prior to the DMCA, there was tremendous uncertainty regarding copyright infringement on the internet. Copyright owners wanted to hold accountable users of internet services as well as the service providers themselves. But service providers – I will also call them "intermediaries" – greatly feared copyright liability. They wanted to offer internet services to users, but feared potentially limitless copyright liability for materials hosted on and routed through their networks. Arguably, they could be both directly liable by distributing the materials, and secondarily liable for the infringement of their users.³ Even worse, courts split over the liability of intermediaries for materials sent through their networks.⁴ The resulting uncertainty might have chilled the development of internet services at a critical time in the web's development.

These concerns led to Title II of the DMCA, which created the "notice and take-down" procedures codified at 17 U.S.C. § 512.⁵ Section 512 provides intermediaries with safe harbors from monetary copyright liability for essential internet functions such as routing, system caching, providing search tools, and hosting user content.⁶ But if a copyright owner sends a take-down notice stating that hosted user content infringes its copyrights, the intermediary must quickly take

2. Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998).

3. Direct copyright infringement is covered by statute. *See* 17 U.S.C.A §§ 106, 106A, 501 (West 2009). Secondary liability, such as contributory infringement, vicarious infringement, and the newer theory of inducement, was judicially created because "[t]he Copyright Act does not expressly render anyone liable for infringement committed by another." *Sony Corp. of America v. Universal City Studios, Inc.* 464 U.S. 417, 434 (1984); *see id.* at 434-36 (discussing secondary liability generally); *see also* *Metro-Goldwyn-Mayer Studios Inc. v. Gorkster, Ltd.*, 545 U.S. 913 (2005) (crafting inducement cause of action).

4. *See infra* Part I.A.

5. Online Copyright Infringement Liability Limitation Act, Pub. L. No. 105-304, Title II, § 202(a), 112 Stat. 2877 (1998) (codified as amended at 17 U.S.C. § 512).

6. 17 U.S.C.A § 512 (West 2009).

down the materials to preserve its safe harbor.⁷ This encourages intermediaries to provide inventive internet services while still providing owners with a mechanism to protect themselves.⁸

Section 512 is thus a kind of "safety dance" where each partner moves to avoid stepping on the other's toes.⁹ But it only takes two to tango, and three is a crowd. What about the third wheel in this dance, namely, the users of internet services who host their websites, blogs, and videos through intermediaries like Google, YouTube, and Yahoo?¹⁰ Unfortunately for users, Section 512 fosters overreaching copyright claims that ignore fair use.¹¹ The *Chilling Effects Clearinghouse* database is filled with thousands of cease-and-desist letters, many showing appalling copyright overreach.¹² Even *Chilling Effects* founder

7. See *id.* § 512(c).

8. Malla Pollack, *Rebalancing Section 512 To Protect Fair Users From Herds Of Mice – Trampling Elephants, Or a Little Due Process Is Not Such a Dangerous Thing*, 22 SANTA CLARA COMPUTER & HIGH TECH. L.J. 547, 547 (2006) ("ISPs should have robust safe harbors against liability for their subscribers' copyright infringement").

9. See 3 DAVID NIMMER, NIMMER ON COPYRIGHT, at § 12B.07[B][C] (2009) ("Section 512 prescribes a complex minuet").

10. For this Article, I prefer the term "user" as it is more evocative of user rights, as opposed to the term "subscriber" that is used in the statute. Indeed, even the legislative history concedes that "subscriber" should be read broadly. See S. REP. NO. 105-190, at 52 n.24 (1998) ("subscribers" includes persons with a requisite business relationship with service provider even if a formal contract does not exist); H.R. REP. NO. 105-551(II), at 61 n.3 (1998) (same).

11. From the standpoint of the song quoted above, the singer would be the owner and the dance partner the intermediary. Since it takes two to tango, the users – the shunned "friends" – are left without any dance partner. Another verse illustrates even better the irony of Section 512 as a "Safety Dance":

Say, we can act if we want to.
If we don't nobody will.
And you can act real rude, and totally remove,
And I can act like an imbecile.

The Safety Dance, *supra* note 1. Section 512 has received significant and deserved criticism. See Michael W. Carroll, *Fixing Fair Use*, 85 N.C. L. REV. 1087, 1113 (2007) ("legal uncertainty surrounding fair use, coupled with the Copyright Act's so-called notice-and-takedown regime, led to a retreat from reliance on fair use in a number of cases"); Rebecca Tushnet, *Naming Rights: Attribution and Law*, 2007 UTAH L. REV. 789, 800 n.50 (2007) (finding that notifications "often result in the cessation of the challenged conduct, even when there are legitimate issues of noninfringement or fair use").

12. Chilling Effects Clearinghouse, <http://www.chillingeffects.org/> (last visited Oct. 18, 2008). Some studies have suggested that upwards of thirty percent of take-down notices on *Chilling Effects* present weak claims, baseless claims, or claims with strong fair use defenses. See 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, 666-67 (2006) (concluding that thirty-one percent of 512(c) and 512(d) notices raised "significant questions related to the underlying copyright claim, including fair use defenses, other substantive defenses, very thin copyright, or non-copyrightable subject matter"); see also MARJORIE HEINS & TRICIA BECKLES, WILL FAIR USE SURVIVE? 29-36 (2005), available at

Wendy Seltzer was targeted by highly questionable take-downs for materials that appear to be fairly posted to YouTube.¹³

Abusive take-downs also affected the 2008 general election campaign. Senator John McCain complained to YouTube that some of his political advertisements were wrongly taken down in response to take-down notices.¹⁴ He requested that YouTube refrain from removing campaign videos without individual review by YouTube legal personnel.¹⁵ YouTube declined, noting that it risked losing its safe harbor if it failed to remove content in response to a take-down notice.¹⁶ YouTube nevertheless suggested that it looked forward to working with McCain to strengthen the fair use doctrine “so that intermediaries like us can rely on this important doctrine with a measure of business certainty.”¹⁷

<http://www.fepproject.org/policyreports/WillFairUseSurvive.pdf> (earlier study of cease-and-desist letters from 2004); Sonia Katval (moderator), *Fair Use: Its Application, Limitations and Future*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1017, 1028 (2007) (comments of Professor Laura Quilter) (discussing problems with Section 512) [hereinafter “Quilter Comments”]. It is questionable how much weight can be given studies based on the *Chilling Effects* database. As Urban and Quilter admit, the data set consists of two main groups: a Google set that is skewed towards search engine issues, and a “self-reported” data set that is relatively small; moreover, “individuals who have a strong defense (or at least believe there is a strong defense) are more likely to submit their notices” to *Chilling Effects*. Urban & Quilter, *supra* note 12, at 642. It is therefore conceivable that even though studies reflect high percentages of abusive notifications, it is possible that the overall percentage of problematic notifications is smaller.

13. The NFL sent notices demanding removal of a video containing the overblown copyright claims the NFL puts in football broadcasts. See Posting of Super Bowl Highlights to <http://www.youtube.com/watch?v=a4uC2H10uIo> (Feb. 8, 2007); Posting of NFL: Second Down and Goal? to WENDY’S BLOG: LEGAL TAGS, http://wendy.seltzer.org/blog/archives/2007/04/05/nfl_second_down_and_goal.html (Apr. 5, 2007). Further posts by Wendy Seltzer about the dispute can be found at <http://wendy.seltzer.org/blog/dmca-nfl> (last visited Oct. 25, 2008); see also *infra* text accompanying notes 162-168.

14. Letter from Trevor Potter, General Counsel McCain/Palin, to Chad Hurley, CEO, YouTube, LLC, et al. (Oct. 13, 2008), available at http://blog.wired.com/27bstroke6/files/mccain_youtube_copyright_letter_10.13.08-3.pdf [hereinafter “Letter from McCain”]; see also Sarah Lai Stirland, *Stifled by Copyright, McCain Asks YouTube to Consider Fair Use*, WIRED BLOG NETWORK: THREAT LEVEL, <http://blog.wired.com/27bstroke6/2008/10/stifled-by-copy.html> (last visited Oct. 14, 2008).

15. Letter from McCain, *supra* note 14.

16. Sarah Lai Stirland, *YouTube to McCain: You Made Your DMCA Bed, Lie in It*, WIRED BLOG NETWORK: THREAT LEVEL, <http://blog.wired.com/27bstroke6/2008/10/youtube-to-mcca.html> (reprinting Letter from Zahavah Levine, Chief Counsel, YouTube, to Trevor Potter, General Counsel McCain/Palin (Oct. 15, 2008)) [hereinafter “Letter to McCain”]. YouTube noted that “[n]o number of lawyers could possibly determine with a reasonable level of certainty whether all of the videos for which we receive disputed takedown notices qualify as fair use.” Letter to McCain, *supra* note 16, at 2.

17. Letter to McCain, *supra* note 16, at 3.

Regardless of what happened in these particular examples, all too often take-downs are sent without sufficient thought being given to fair or other non-infringing uses. Although there may be some justification to treating fair use as an affirmative defense in actual litigation, the take-down process is equivalent to a *de facto ex parte seizure*.¹⁸ This creates tremendous incentives for lawyers to send questionable take-downs in the hopes that the affected users will back down after their materials are removed. Although Section 512(f) contains a provision permitting damages and attorney fees for knowing material misrepresentations in connection with a take-down,¹⁹ this provision has been rarely construed by the courts.²⁰

Is there anything that users like Seltzer and McCain can do to seek put-back of their materials? At first glance, users would seem to have an easy remedy because Section 512(g) permits users to send counter-notifications.²¹ After materials are removed, a user can send a counter-notice to the intermediary, which must restore the material unless the owner files suit.²² Although Seltzer sent counter-notices, in reality, few users ever send counter-notices.²³ Why? One answer may be that many DMCA notices seek removal of genuinely infringing materials, and a counter-notice would be meritless.²⁴

But the dearth of counter-notices may also be because the counter-notification procedures are so unclear that they chill users from asserting their rights.²⁵ Section 512(g)(3) states that materials can be restored only if the user 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."²⁶ Does "mistake" mean just an error of fact (such as an owner incorrectly citing the materials to be removed or an

18. See *infra* Part III.B

19. 17 U.S.C.A § 512(f) (West 2009).

20. See *infra* note 99 and accompanying text.

21. 17 U.S.C.A § 512(g) (West 2009).

22. *Id.*

23. As one study notes, *Chilling Effects* contains few counter-notices, which intermediaries confidentially suggest are rare. See Urban & Quilter, *supra* note 12, at 679.

24. In such a case, the user may count its lucky stars if the worst thing that happens is that the materials are removed without suit. Where applicable, statutory damages per work can go up to \$150,000, not counting possible attorney's fees. See 17 U.S.C.A §§ 504-505 (West 2009).

25. Robert Kasunic, *Preserving the Traditional Contours of Copyright*, 30 COLUM. J.L. & ARTS 397, 415 (2007) (noting that unclear counter-notification process makes it easy to chill transformative uses, "rais[ing] serious questions about the effects on speech that are not fully known"). It is worth noting that Professor Kasunic is also Principal Legal Advisor at the Office of the General Counsel at the U.S. Copyright Office. *Id.* at 397 n. *.

26. 17 U.S.C.A § 512(g)(3)(C) (West 2009) (emphasis added).

intermediary's removal of the wrong materials), or does it also include an error of law (such as claiming infringement when the conduct is fair use)? Unfortunately, Section 512 does not expressly answer this question and is silent on whether fair or other non-infringing uses are bases for put-back.

Even more troublingly, the allegation of mistake must be made on penalty of perjury, further chilling users from sending them.²⁷ Although a user might file suit for a declaration of non-infringement, most people lack the resources or backbone for litigation, causing potentially lawful speech to be removed from the internet without any judicial scrutiny. That would permit owners to obtain relief that they could never get in court. Such a scenario is appalling, especially considering that the put-back provisions were added at the prompting of then-Senator John Ashcroft, who strongly felt that a fair user should not have to go to court to protect herself.²⁸

Today, it is encouraging to hear another Senator – now, Senator McCain – speak up for fair use, but it is also worth noting that McCain voted for the Senate version of the DMCA.²⁹ Regardless, McCain's request to YouTube contains an intriguing premise: implicit in it is the assumption that fair use can be protected under Section 512 *as it exists without amendment*.³⁰ In this Article, I test McCain's assumption, asking whether we can interpret Section 512 to better foster fair use. I believe that we can. In this Article, I argue that copyright owners must consider fair or other non-infringing uses before sending take-down notices, and that users should be able to send counter-notices on the basis of fair or non-infringing use. Although neither conclusion is obvious from the face of the statute, both are strongly supported by examinations of legislative history as well as of the statute itself, particularly in light of the fact that DMCA take-downs essentially permit

27. *Id.*

28. 144 CONG. REC. S4884-01, S4889 (May 14, 1998) (statement of Sen. Ashcroft).

29. See U.S. Senate Roll Call Votes, 105th Congress - 2nd Session, http://www.senate.gov/legislative/LIS/roll_call_lists/roll_call_vote_cfm.cfm?congress=105&session=2&vote=00137. In fairness, all voting on the bill voted in favor of it. *Id.*

30. As a practical matter, it is unlikely that Section 512 will be amended in the short term and that we are stuck with it, warts and all. Regarding proposals to amend Section 512 to expressly address fair use, see generally Pollack, *supra* note 8. I agree that Section 512 could be vastly improved by changes – for example, Professor Pollack proposes that materials not be initially removed until at least ten days have passed from the time the take-down notice is received. *Id.* at 574. This would give users parallel rights to those of owners (who get ten to fourteen days before material is restored after a counter-notice is sent), and would reduce the harm that is created when speech is improperly removed.

ex parte seizures of speech that might never be permitted in civil actions. In the spirit of the forum for which this Article was prepared, and with the aim of keeping length reasonable, the Article assumes a basic knowledge of copyright law, particularly regarding the distinctions between direct and secondary liability as well as fundamentals of fair use.

Part I recounts the concerns that prompted the drafting of Section 512. It also discusses Senator Ashcroft's addition of counter-notification procedures. Although those procedures are not as clear as they could be, the legislative history leaves no doubt that Ashcroft felt strongly that fair users need not go to court to have removed materials put back.

Part II addresses intermediaries. After noting how the notice and take-down process has been pervasive and led to a broad remix culture, Part II turns to Senator McCain's suggestion that intermediaries like YouTube consider fair use before removing political videos. Unfortunately, Section 512's safe harbors give intermediaries little incentive to accept McCain's suggestion. Instead, the statute as it exists encourages intermediaries to operate with blinders, ignoring user content until a take-down notice is received. Moreover, failing to remove materials after a take-down is received might expose intermediaries to potentially significant liability.

Instead, I argue that fair use might be better protected through proper construction of the take-down, counter-notice, and misrepresentation provisions. With that in mind, Part III addresses copyright owners, for which a recent case provides support. In *Lenz v. Universal Music Corp.*,³¹ the court held that owners who deliberately ignore fair use before sending take-downs could be liable for knowing material misrepresentations under Section 512(f).³² *Lenz* reached the right result. In the *ex parte* context of take-downs (where works are taken down without prior involvement of the user), fair use must be considered by the owner. Plus, failure to consider fair use may be willful blindness by the owner. By requiring owners to *stop-and-think*, the *Lenz* case may deter frivolous take-downs.

In Part IV, I turn to how Section 512 should be interpreted regarding users. Because a stop-and-think rule for take-downs will not cure all problems with abusive take-down notices, users need a safety

31. 572 F. Supp. 2d 1150 (N.D. Cal. 2008).

32. *Id.* at 1154-56 (noting that copyright owner must consider fair use before sending take-down notice or risk suit by user under 17 U.S.C. § 512(f)); see *infra* notes 93-103 and accompanying text (discussing *Lenz* case).

valve. Moreover, fair use is highly indeterminate, and in many cases a lawyer who considers fair use might reasonably conclude that the law is sufficiently unclear that a take-down can be sent in good faith. In both cases, the materials will still be taken down. Therefore, users must be permitted to send counter-notices based on fair or other non-infringing uses. In other words, “mistake or misidentification” must include not just errors of fact, but also arguable errors of law. This conclusion is preferable to forcing fair users to go to the expense and delay of litigation to obtain restoration of fairly used materials. Any concerns about a flood of frivolous counter-notices may be amply countered by the fact that users who send frivolous put-backs expose themselves to potentially significant copyright liability, as well as potential liability for making misrepresentations in connection with a counter-notice. Regarding more arguable cases of fair use, the burden of filing suit should be on owners who seek to limit speech.

I. A NEW DANCE SENSATION

In drafting Section 512, Congress recognized that the internet is a hotbed of copyright infringement.³³ Through its non-judicial process for quick removal of claimed infringement, Section 512 tremendously reduced the costs of copyright enforcement. It also spurred the development of a wide variety of online services by intermediaries that otherwise might not have been created.³⁴ Indeed, on the DMCA’s 10th anniversary, even *Wired Magazine* recognized that “[t]oday’s internet is largely an outgrowth of the much-reviled” DMCA.³⁵ In this Part, I

33. As Professor John Tehranian argues, there is a “vast disparity between copyright law and copyright norms.” John Tehranian, *Infringement Nation: Copyright Reform and the Law/Norm Gap*, 2007 UTAH L. REV. 537, 539 (2007). Using a fictional Professor named “John,” he suggests that a normal day of activity could lead to potential copyright liability of over \$12 million. *Id.* at 543-48; see also Tim Wu, *Tolerated Use*, 31 COLUM. J.L. & ARTS 617 (2008) (noting that opt-in emerging as system to deal with patterns of mass but tolerated infringement).

34. Examples abound, such as YouTube, Cafepress, Facebook, MySpace, etc. Of course, some of these have led to highly contested litigation. The Google Book Search litigation ended in a \$125 million settlement that permitted Google to profit from books it scanned. See Miguel Helft & Motoko Rich, *Google Settles Suit over Book-Scanning*, N.Y. TIMES, Oct. 28, 2008, <http://www.nytimes.com/2008/10/29/technology/internet/29google.html>. Litigation against YouTube and Google for infringing videos is pending. See *Viacom International, Inc. v. YouTube, Inc.*, 1:2007cv02103 (S.D.N.Y. filed Mar. 13, 2007), unofficial docket available at <http://news.justia.com/cases/featured/new-york/nysdce/1:2007cv02103/302164/>.

35. “If you’re wondering whom to thank for the Web 2.0 explosion in interactive websites, consider sending a bouquet to Congress.” David Kravets, *10 Years Later, Misunderstood DMCA is the Law That Saved the Web*, WIRED.COM THREAT LEVEL, Oct. 27, 2008, <http://blog.wired.com/27bstroke6/2008/10/ten-years-later.html>.

review the technological and legal history that led to the drafting of Section 512, consider the statute that resulted, and outline the statutory problems specific to fair use concerns.

A. *Uncertainty regarding intermediaries*

Ten years ago, the copyright liability of intermediaries was uncertain. Emerging case law left it unclear whether internet intermediaries would be liable for copyright infringement of others. On the one hand, in *Playboy Enterprises, Inc. v. Frena*,³⁶ the court held that the operator of a bulletin board ("BBS") was directly liable for copyright infringement by unknowingly distributing and displaying images that had been uploaded to the BBS by a user.³⁷ The outcome implied that intermediaries might be liable for providing backbone internet services such as routing, making temporary cache copies, or providing hosting services. Such an outcome could chill the market for developing internet services.³⁸

A contrary result was reached in *Religious Technology Center v. Netcom On-Line Communication Services*,³⁹ where Netcom, an internet service provider ("ISP"), was sued for infringing works that were posted online by a BBS user and distributed to others via Netcom.⁴⁰ The court reached a very different result, holding that Netcom was not liable for direct infringement:⁴¹

36. 839 F. Supp. 1552 (M.D. Fla. 1993).

37. *Id.* at 1554, 1556-57. Although the BBS operator complained that he didn't know of the infringement and promptly removed the materials upon receiving notice, the court noted that direct copyright liability does not require knowledge. *Id.* at 1554, 1559.

38. "Without these issues being clearly delineated we would have faced a future of uncertainty regarding the growth of Internet" 144 CONG. REC. S4884-01, S4889 (May 14, 1998) (statement of Sen. Ashcroft).

39. 907 F. Supp. 1361 (N.D. Cal. 1995).

40. *Id.* at 1365. Plaintiffs, who owned copyrights to works written by Scientology founder L. Ron Hubbard, filed suit over works posted to a BBS by a critic who was once a church minister. *Id.* Plaintiffs sued the critic, the BBS operator, and Netcom, which provided the BBS with internet service. *Id.* at 1365-66. The Usenet is a "worldwide community of electronic BBSs" containing messages "organized into thousands of topical groups, or 'Newsgroups.'" *Id.* at 1365 n.4 (some internal quotes omitted).

41. *Id.* at 1370-71; *see also* *Marobie-FL, Inc. v. Nat'l Ass'n of Fire Equip. Distrib.*, 983 F. Supp. 1167, 1178 (N.D. Ill. 1997) (holding that a web host "may not be held liable for direct infringement"). Strangely, the *Netcom* court distinguished *Frena* on the basis that the earlier case concerned the rights of *public distribution* and *public display*. 907 F. Supp. at 1370-71. In contrast, said the *Netcom* court, the suit at hand was for infringement of the right of *reproduction*. *Id.* at 1371. This distinction is odd, considering that the rationale of *Frena* – that one may directly infringe without knowledge or intent – would appear to apply as strongly to reproduction as it does to public distribution and display.

Netcom's actions, to the extent that they created a copy of plaintiffs' works, were necessary to having a working system for transmitting Usenet postings to and from the Internet. . . . Netcom's act of designing or implementing a system that automatically and uniformly creates temporary copies of all data sent through it is not unlike that of the owner of a copying machine who lets the public make copies with it.⁴²

Although the court's "copying machine" analogy is debatable,⁴³ the result was good as a policy matter. Liability against Netcom "would also result in liability for every single" linked server, even though such intermediaries "do no more than operate or implement a system that is essential if . . . messages are to be widely distributed."⁴⁴ Nevertheless, the court left the door open for liability in appropriate circumstances implicating contributory infringement⁴⁵ or possibly vicarious liability.⁴⁶

Cases like *Frena* and *Netcom* left unclear the potential liability of ISPs. Should they be subject to the traditional strict liability? Should statutory immunity provisions be enacted?⁴⁷ Or should Congress leave

42. *Netcom*, 907 F. Supp. at 1368-69.

43. The analogy suggests that it is the public who is using the "copy machine," but in for internet services, both the user and the owner of the "copy machine" participate in the transmission of files online. If an ISP is like a copy machine, it is arguably like one at a Kinko's store where a Kinko's employee makes copies at a customer's request without looking at the copies.

44. *Netcom*, 907 F. Supp. at 1369-70.

45. Contributory infringement exists where the defendant, "'with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another.'" *Id.* at 1373 (quoting *Gershwin Publ'g Corp. v. Columbia Artists Mgmt. Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971)). The court concluded that the plaintiffs raised a genuine issue of material fact for contributory infringement as to postings made after Netcom was on notice of claimed infringement. *Id.* at 1375.

46. Vicarious liability exists where the defendant "(1) has the right and ability to control the [direct] infringer's acts and (2) receives a direct financial benefit from the infringement." *Id.* at 1375. Summary judgment was appropriate for Netcom because its fixed service fee was not a "direct financial benefit." *Id.* at 1377. However, nothing in *Netcom* appears to foreclose vicarious liability against intermediaries in other circumstances, such as where there is a direct tie between service fees and infringement.

47. Only two years earlier, interactive computer services (such as ISPs) were granted immunity from defamation and certain other claims. See Communications Decency Act of 1996, Pub. L. No 104-104, Title I, § 509, 110 Stat. 137-38 (1996) (codified as amended at 47 U.S.C. § 230); see also, e.g., *Zeran v. America Online, Inc.*, 129 F.3d 327, 328 (4th Cir. 1997) (holding that Section 230 "immunizes computer service providers like AOL from liability for information that originates with third parties"). Like the DMCA, CDA section 230 overruled earlier caselaw that found intermediaries liable for the wrongs of others. See H.R. CONF. REP. NO. 104-458, at 194 (1996), reprinted in 1996 U.S.C.C.A.N. 1, 194. As Professor Laura Heymann noted at the IP forum, Section 512 has one advantage over the CDA: a user can seek reinstatement of material under the DMCA, but a user has no right of reinstatement for material removed under the CDA. Compare 17 U.S.C.A § 512(g) (West 2009) (put-back process), with 47 U.S.C.A § 230(c)(2) (West

development of the law to courts? Commissioner Bruce Lehman's "White Paper"⁴⁸ took the latter approach, suggesting that it would be "premature to reduce" service provider liability, and arguing:

It would be unfair – and set a dangerous precedent – to allow one class of distributors to self-determine their liability by refusing to take responsibility. This would encourage intentional and willful ignorance. Whether or not they choose to reserve the right to control activities on their systems, they have that right.⁴⁹

Lehman's approach was not followed, and a legislative solution was crafted. As noted below, the DMCA solves the problem of intermediaries by crafting a solution that in fact relies in part on the legislatively sanctioned willful blindness of the intermediary.⁵⁰

B. A statutory "solution"

Despite Lehman's concerns, Congress faced heavy pressure from intermediaries wanting immunity and copyright owners who wanted easy enforcement of copyrights on the internet.⁵¹ After tense negotiations between these constituencies and Congress, Section 512 was included as Title II of the DMCA.⁵² Section 512 rejects the holding of *Frena* in favor of a modified version of the framework enunciated in *Netcom*.⁵³ Thus, it provides qualified safe harbors for internet backbone

2009) (no comparable provision).

48. Bruce Lehman & Ronald Brown, INFORMATION INFRASTRUCTURE TASK FORCE, INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE: THE REPORT OF THE WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS (Sept. 1995), <http://www.uspto.gov/go/com/doc/ipnii/ipnii.pdf> [hereinafter "White Paper"]. The White Paper was published prior to the *Netcom* decision, although the authors were aware of the pending litigation. *See id.* at 121-22 & n. 391 (noting filing of the complaint).

49. *Id.* at 122.

50. Ironically, although Section 512 encourages intermediaries to be willfully blind, I suggest in *infra* Part III.C and IV.B that willful blindness is highly relevant to whether an owner or user has made a misrepresentation that causes liability under Section 512(f).

51. Orrin G. Hatch, *Toward a Principled Approach to Copyright Legislation at the Turn of the Millennium*, 59 U. PITT. L. REV. 719, 749 (1998) (noting "service providers argued that they needed more certainty in order to attract the huge investments necessary to achieve the potential of the Internet").

52. Online Copyright Infringement Liability Limitation Act, Pub. L. No. 105-304, Title II, § 202(a), 112 Stat. 2877 (1998) (codified as amended at 17 U.S.C. § 512).

53. *See* H.R. REP. NO. 105-551(I), at 11 (1998) (stating that the bill "essentially codifies the result" in *Netcom*, "overrules" *Frena*, and "[a]s to direct infringement, liability is ruled out for passive, automatic acts engaged in through a technological process initiated by another"); *see also* *ALS Scan, Inc. v. RemarQ Communities, Inc.*, 239 F.3d 619, 622 (4th Cir. 2001) (quoting House

services, including routing, system caching, hosting services, and location tools.⁵⁴

Of primary interest here is Section 512(c), which provides a safe harbor for providing hosting services for others, such as hosting users' websites, blogs, photos, and videos. Broadly speaking, a "service provider" is not monetarily liable for copyright infringement if: 1) it lacks the knowledge requisite for contributory infringement;⁵⁵ 2) it is not vicariously liable;⁵⁶ or 3) upon receiving proper notice from a copyright owner, it acts "expeditiously" to remove or disable access to the allegedly infringing material.⁵⁷ The third condition is the basis for the "notice and take-down" regime of the DMCA. If a copyright owner provides proper notification, the service provider must act quickly to remove or disable the disputed content or risk losing the protections of the safe harbor.⁵⁸ Proper notification should include, *inter alia*, "[i]dentification of the material that is claimed to be infringing or to be the subject of infringing activity" and 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."⁵⁹

Report and noting that statute codified *Netcom*). Although an earlier version of H.R. 2281 stated that the safe harbor would be against only direct liability, the enacted statute provides safe harbor against all kinds of copyright infringement liability. See *CoStar Group, Inc. v. LoopNet, Inc.*, 373 F.3d 544, 554 & n.* (4th Cir. 2004) (discussing H.R. REP. NO. 105-551(I), at 7-8).

54. 17 U.S.C.A. § 512(a)-(d) (West 2009).

55. *Id.* § 512(c)(1)(A). There is no mention of activities such as giving material contribution to the infringement of others, because one who provides hosting services is, by definition, materially contributing to direct infringement. If a service provider becomes aware of "facts or circumstances from which infringing activity is apparent," they must act "expeditiously to remove, or disable access to, the material" to retain the safe harbor. *Id.* § 512(c)(1)(A)(ii), (iii).

56. *Id.* § 512(c)(1)(B).

57. *Id.* § 512(c)(1)(C). As Professor Jane Ginsburg points out, "the threshold requirements for immunity closely track the traditional elements of secondary liability." Jane C. Ginsburg, *Separating the Sony Sheep from the Grokster Goats: Reckoning the Future Business Plans of Copyright-Dependent Technology Entrepreneurs*, 50 ARIZ. L. REV. 577, 591 (2008).

58. 17 U.S.C.A. § 512(c)(1)(C) (West 2009); see also *id.* § 512(c)(3) (listing contents of proper notification).

59. *Id.* § 512(c)(3)(A)(iii), (v). Section 512(d) contains a similar notice and take-down regime for online location tools such as search engines that link to infringing materials. *Id.* § 512(d). The discussion of take-downs in this Article generally focuses on Section 512(c) and 512(f). Nonetheless, this Article's analysis is generally applicable to search engine take-downs as well, as the requirements for take-downs in Section 512(d) are generally the same as those in Section 512(c). See *id.* § 512(d)(3).

C. *A discordant note, and Senator Ashcroft's amendment*

Unfortunately, during the statute's drafting, user rights were treated as an afterthought. Nothing in Section 512 mentions fair use.⁶⁰ Instead, the Senate Judiciary Committee mostly focused on obtaining agreement between copyright owners and intermediaries.⁶¹ This creates three problems. First, the statute does not expressly indicate that owners must consider fair or other non-infringing uses before sending takedowns. Because Section 512 permits a copyright owner to obtain quick removal of materials without filing suit, the potential for abuse is strong. Second, if a baseless take-down notice is sent, it is not clear when a lawyer (or its client) will be civilly liable for frivolous take-downs. Section 512(f) provides a civil action for damages and attorney's fees arising from notifications based on a knowing material misrepresentation.⁶² But the scope of that action is unclear. What if a notice asserts a *prima facie* case of infringement but the sender is willfully blind to strong signs of fair use? Third, the scope of a user's right to attain quick restoration of fairly used materials is not clear.

Fortunately, procedures permitting notice and put-back were added, primarily at the behest of then-Senator John Ashcroft, who was concerned that the agreement between intermediaries and copyright owners "provided little or no protection for an Internet user wrongfully accused of violating the copyright laws."⁶³ With the support of Senators Hatch and Leahy, the "Ashcroft-Leahy-Hatch amendment" was added to the Senate version of S. 2037.⁶⁴ Although the Senate and House put forth competing versions of the DMCA, Ashcroft's amendments

60. See Pollack, *supra* note 8, at 574 (noting that Section 512 "assumes that the subscriber is a rodent and makes no provision for fair use").

61. 144 CONG. REC. S4884-01, S4885 (May 14, 1998) (statement of Sen. Hatch) (finding that Section 512 "reflects 3 months of negotiations between the major copyright owners and the major [service providers], which I encouraged and in which I participated, and which took place with the assistance of Senator Ashcroft").

62. 17 U.S.C.A. § 512(f) (West 2009). It also covers misrepresentations in counter-notices. *Id.*

63. 144 CONG. REC. S4884-01, S4889 (May 14, 1998) (statement of Sen. Ashcroft); see also Urban & Quilter, *supra* note 12, at 635-36 (quoting Ashcroft).

64. 144 CONG. REC. S4884-01, S4886 (May 14, 1998) (statement of Sen. Leahy). Ironically, the only floor statement Senator McCain made when S. 2037 was voted on was a request that the Senate also consider an amendment to a DOD bill, a request denied as "not the pending business." *Id.* at S4884 (statements of Sens. McCain, Levin, and Presiding Officer). Before the passage of the DMCA, Ashcroft had introduced an earlier bill addressing the liability of online service providers. See Digital Copyright Clarification and Technology Education Act of 1997, S. 1146, 105th Cong. (1997).

remained without material change in the bill that was later enacted.⁶⁵ Finding it “totally unacceptable” that a “user would have to go to court to prove their innocence,”⁶⁶ Ashcroft stated:

If material is wrongly taken down from an Internet user’s home page because the original notice *mistakenly did not take into account that the Internet user was only making a fair use of the copyrighted work*, 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 and go to court.*⁶⁷

Unfortunately, it is not entirely clear whether Sen. Ashcroft’s amendments accomplish his goals. Whereas an owner’s take-down must identify the “infringing” materials and assert that the use is “not authorized” by the owner or the law, the statute does not provide that a counter-notice can assert that the materials are “non-infringing” or that they are “authorized by the law.”⁶⁸ Instead, an aggrieved user seeking

65. The DMCA followed a tortured path through the two chambers of Congress before passage. The Senate passed S. 2037 on May 14, 1998 by a vote of 99-0. *See* 144 CONG. REC. S4884-01, S4894 (May 14, 1998). Soon after, the House Judiciary Committee proposed a bill, H.R. 2281, that contained a version of Section 512, but which lacked any provisions for counter-notification. *See* H.R. REP. NO. 105-551(I), at 7-8 (1998) (proposed Section 512). After referral to the House Commerce Committee, counter-notification provisions similar to the Senate version were added to H.R. 2281. *See* H.R. REP. NO. 105-551(II), at 15 (1998) (adding a proposed 17 U.S.C. §512(f)). On Aug. 4, 1998, the House passed H.R. 2281 by voice vote. *See* 144 CONG. REC. H7103 (Aug. 4, 1998). The Senate balked at the House version because of variations and additions to other parts of the bill. *See* 144 CONG. REC. S9935 (Sept. 3, 1998) (statement of Sen. Ashcroft). The Senate subsequently passed a bill that mostly replaced H.R. 2281 with the text of previously passed S. 2037. *See* 144 CONG. REC. S10537 (Sept. 17, 1998). Conferees were appointed and a modified version of H.R. 2281 was passed by both chambers. *See* 144 CONG. REC. S11889 (Oct. 8, 1998) (passage by Senate); 144 CONG. REC. H10615 (Oct. 12, 1998) (passage by House). A comparison of Ashcroft’s earlier bill (S. 2037) to the passed act show no material differences regarding the misrepresentation and counter-notification provisions, namely, what ultimately became Sections 512(f) and (g). *Compare* 144 CONG. REC. S4884-01, S4898 (May 14, 1998) (S. 2037 versions of 512(e) and (f)), *with* 17 U.S.C. § 512(f), (g) (enacted and codified). Thus, the Ashcroft-Hatch-Leahy amendment ultimately became the law.

66. 144 CONG. REC. S4884-01, S4888 (May 14, 1998) (statement of Sen. Ashcroft).

67. *Id.* at S4889 (emphasis added). Ashcroft also stated:

We shouldn’t allow Disney to say, “We own Donald Duck. That looks too much like Donald,” and be able to bully a little girl from having a duck on her web site. We needed protection for the small user, not just for the big content promoters.

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

Id. at S4888.

68. 17 U.S.C.A. § 512(c)(3)(A)(iii), (v), (g)(3)(C) (West 2009).

put-back must state that it has a good faith belief that the materials were removed by "mistake or misidentification of the material to be removed or disabled."⁶⁹ The statute does not expressly indicate that removal of fair or non-infringing materials constitutes a "mistake," which may deter users from sending counter-notices. Further, a declaration of "mistake" must be made under penalty of perjury, further chilling counter-notices.⁷⁰ These issues are important. If fair or non-infringing uses do not support put-back, a user may have to go to court for a declaration of non-infringement, which would be costly and damaging for time-sensitive materials. It would also permit owners to effectively get *ex parte* injunctions they could not obtain in a civil suit. In the next three Parts of this Article, I consider these and other questions from the perspective of intermediaries, copyright owners, and users.

II. INTERMEDIARIES AND SENATOR MCCAIN'S SUGGESTION

In this Part, I first address how the DMCA's take-down scheme has encouraged intermediaries to offer online services. Next, I consider whether Senator McCain's suggestion is consistent with Section 512 as currently written. Despite the appeal of McCain's suggestion that service providers screen take-downs aimed at political campaigns, his approach is not feasible under current law because it would vastly increase costs and potentially expose intermediaries to significant copyright liability.

A. *Section 512 and remix culture*

Although it would be incorrect to give sole credit to Section 512 for the explosion of colorable fair use and remix on the web, the statute is without a doubt a part of the equation. In a world without a copyright safe harbor for intermediaries, development of a web services may have been significantly chilled. Even if a majority of courts or even the Supreme Court ultimately adopted a *Netcom*-like scheme for intermediary copyright liability, the period of uncertainty would have been significant. But under Section 512, ISPs are able to provide a wide variety of services without being automatically liable for copyright infringement, making possible services such as traditional website hosting, blogging services such as Blogger and Wordpress.com, and photo-sharing sites such as Flickr and Photobucket. As a result, we have

69. *Id.* § 512(g)(3)(C).

70. *Id.*

an explosion of user content including blogs and many kinds of “remix” content such as YouTube parodies and fan fiction.⁷¹ Although some content becomes the subject of take-down notices, often the material comes back online quickly. Conversely, some infringing materials might stay online for years without objection.

The architecture engendered by Section 512 has also become deeply entrenched in intermediary business practices. Although traditional ISPs typically qualify for the safe harbor, the definition of “service provider” for hosting services is broad, including providers of “online services or network access.”⁷² This permits many other entities beyond traditional ISPs to potentially qualify for the safe harbor, such as Amazon and eBay.⁷³ Even copyright owners often have websites with content, such as Disney, CBS, and Warner Bros., and considering themselves to be service providers, post DMCA take-down policies.⁷⁴

Further, the DMCA’s notice and take-down scheme has been employed in contexts where the safe harbors might not technically apply. I will call them “quasi-DMCA” policies.⁷⁵ Thus, even though the Internet Archive itself often posts content online (rather than merely

71. See Anupam Chander & Madhavi Sunder, *Everyone’s A Superhero: A Cultural Theory Of “Mary Sue” Fan Fiction As Fair Use*, 95 CAL. L. REV. 597, 600 (“The World Wide Web offers writers a relatively inexpensive and simple mass distribution vehicle.”); Rebecca Tushnet, *Legal Fictions: Copyright, Fan Fiction, And A New Common Law*, 17 LOY. L.A. ENT. L.J. 651, 653 (1997) (“Many entertainment corporations have left fan fiction alone, but a few have attempted and are attempting to stamp out unauthorized use of their proprietary characters.”).

72. For the safe harbor relating to providing hosting services, the definition of “service provider” includes “a provider of online services or network access” or the operator of such facilities. 17 U.S.C.A. § 512(k)(1)(B) (West 2009).

73. *In re Aimster Copyright Litig.*, 334 F.3d 643, 655 (7th Cir. 2003) (finding that the definition of service provider is broad); *ALS Scan, Inc. v. RemarQ Communities, Inc.*, 239 F.3d 619, 623 (4th Cir. 2001) (definition is broad); *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1100 (W.D. Wash. 2004) (“This definition encompasses a broad variety of Internet activities, . . . and there is no doubt that Amazon fits within the definition.”); *Hendrickson v. eBay, Inc.*, 165 F. Supp. 2d 1082, 1088 (C.D. Cal. 2001) (“eBay clearly meets the DMCA’s broad definition of online ‘service provider.’”). But see Ginsburg, *supra* note 57, at 593-94 (noting that courts defining “service provider” broadly are either at district court level, or if appellate courts, lack full analysis).

74. Disney lists a take-down policy at <http://disney.go.com/corporate/privacy/terms.html>. CBS has a take-down policy at <http://www.cbsinteractive.com/info/tou#link10>. Warner Bros. has a copyright policy at <http://www.warnerbros.com/#/page=terms-of-use/>. That Disney considers itself to be both a copyright owner and “service provider” is another irony of the information age, considering that Disney was one of the plaintiffs in the Sony Betamax case. See *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 421 (1984) (Disney a respondent). But considering that large media companies are often both copyright owners and service providers, it makes perfect sense that they would seek safe harbor.

75. See Mike Scott, Note, *Safe Harbors Under the Digital Millennium Copyright Act*, 9 N.Y.U. J. LEGIS. & PUB. POL’Y 99, 123-27 (2005) (noting “convergence” of online industry to using DMCA-like policies as a matter of “best practices”).

hosting content for others), it has a quasi-DMCA take-down policy.⁷⁶ Even though Section 512 applies only to copyrights, auction site eBay's take-down policy permits intellectual property owners to assert a wide variety of claims beyond copyright such as trademark, patent, and right of publicity.⁷⁷ A similar take-down policy is offered by Cafepress, a site that makes and sells t-shirts and mugs bearing graphics uploaded by users who create online stores on the site.⁷⁸ Such quasi-DMCA policies make good sense by providing a good-faith take-down mechanism, even if they do not technically fall within the scope of the Copyright Act.⁷⁹ Although the question of whether quasi-DMCA policies will ultimately insulate providers from claims of direct or secondary liability is beyond the scope of this Article, the extent of quasi-DMCA policies shows how pervasive the notice and take-down regime has become.

B. *Senator McCain's suggestion*

To the extent that new services may have fostered fair use, they may trace back to the protections offered to intermediaries by Section 512. But that statute can also frustrate fair use when frivolous take-downs are sent. Thus, what about Senator McCain's suggestion to YouTube? In his letter, he asks YouTube to conduct a full legal review of all political campaign videos that are the subject of take-down notices:

We fully understand that YouTube may receive too many videos, and too many takedown notices, to be able to conduct full fair-use review of all such notices. But we believe it would consume few resources—and provide enormous benefit—for YouTube to commit to a full legal review of all

76. *Internet Archive Terms of Use*, <http://www.archive.org/about/terms.php> (last visited Oct. 25, 2008).

77. eBay, *Notice of Claimed Infringement*, <http://pages.ebay.com/help/community/NOCII.pdf> (last visited Oct. 25, 2008) (blank form). Also, eBay offers a Verified Rights Owner ("VeRO") program to facilitate cooperation and removal. eBay, *Reporting Intellectual Property Infringements*, <http://pages.ebay.com/help/tp/vero-rights-owner.html> (last visited Oct. 25, 2008).

78. Cafepress, *Intellectual Property Rights Policy*, <http://www.cafepress.com/cp/info/help/iprights.aspx> (last visited Oct. 25, 2008).

79. A recent case commented on eBay's VeRO program, noting that "[w]hile the law does not impose a duty on eBay to take steps in response to generalized knowledge of infringement, the record is clear that eBay, nevertheless, made significant efforts to protect its website from counterfeiters." *Tiffany (NJ) Inc. v. eBay, Inc.*, 576 F. Supp. 2d 463, 514 (S.D.N.Y. 2008); *but see* David Kravetz, *Google Profits From Typo Squatting, Report Charges*, WIRED.COM, Oct. 13, 2008, <http://blog.wired.com/27bstroke6/2008/10/google-profitin.html> (Ben Edelman arguing that there is no "notification safe harbor" to typo-squatting asserted against Google in pending class-action lawsuit).

takedown notices on videos posted from accounts controlled by (at least) political candidates and campaigns. . . . If YouTube is satisfied that the use at issue is fair, or otherwise non-infringing, we propose that it decline to act upon the notice. Surely the protection of core political speech, and the protection of the central role YouTube has come to play in the country's political discourse, is worth the small amount of additional legal work our proposal would require.⁸⁰

YouTube declined the offer, noting the danger of losing its safe harbor if it failed to remove content in response to a take-down notice.⁸¹ YouTube nevertheless suggested that it looked forward to working with McCain to strengthen the fair use doctrine “so that intermediaries like us can rely on this important doctrine with a measure of business certainty.”⁸² YouTube is correct that failing to remove materials upon take-down would eviscerate the safe harbor.⁸³ But the mere fact that a service provider ignores a take-down notice does not prove that it is liable, and loss of the safe harbor does not immediately establish liability.⁸⁴ It simply means that the safe harbor is gone, and a court must then consider whether the service provider is directly or secondarily liable.⁸⁵

In this context, *Netcom* may be of some assistance. In that case, the court recognized that an intermediary should not be held liable for contributory infringement where the use is arguably fair:

[I]t is beyond the ability of a BBS operator to quickly and fairly determine when a use is not infringement *where there is*

80. Letter from McCain, *supra* note 14, at 2.

81. Letter to McCain, *supra* note 16, at 1.

82. *Id.* at 3. As noted, Senator McCain voted for the DMCA. See *supra* note 29 and accompanying text.

83. 17 U.S.C.A. § 512(c)(1)(C) (West 2009) (noting that the safe harbor requires service provider, “upon notification of claimed infringement as described in paragraph (3), responds expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity”).

84. The safe harbor can also be lost if the service provider fails to remove the infringement upon gaining knowledge of it or of facts making it apparent, or if it receives a direct financial benefit from infringing activity that it had a right and ability to control. *Id.* § 512(c)(1)(A), (B). As such facts basically mirror the requirements for contributory infringement and vicarious liability, the loss of the safe harbor in those conditions would very likely ensure liability if the use was not fair.

85. See *CoStar Group, Inc. v. LoopNet, Inc.*, 373 F.3d 544, 552 (4th Cir. 2004) (holding that even if the safe harbor fails, “an ISP is still entitled to all other arguments under the law—whether by way of an affirmative defense or through an argument that conduct simply does not constitute a *prima facie* case of infringement under the Copyright Act”); see also 17 U.S.C.A. § 512(l) (West 2009) (providing that failure to qualify for safe harbor does “not bear adversely” on any defense that the service provider’s conduct is not infringing).

at least a colorable claim of fair use. Where a BBS operator cannot reasonably verify a claim of infringement, either because of a *possible fair use defense*, the lack of copyright notices on the copies, or the copyright holder's failure to provide the necessary documentation to show that there is a likely infringement, the operator's lack of knowledge will be found reasonable and there will be no liability for contributory infringement⁸⁶

This passage stands in stark contrast to Section 512, which never mentions fair use. To the extent that courts might follow the approach of *Netcom*, YouTube could choose to engage in case-by-case analysis, refusing to remove videos that present possible fair use defenses. But there are several deep flaws in this approach. First, by reverting to a pre-DMCA framework, YouTube would face uncertainty as to whether other courts would follow *Netcom*'s fair use approach.⁸⁷ Second, even if YouTube limited analysis to political videos, it is likely that the quantity would still be great. Third, although political speech merits high First Amendment protection, McCain's approach would ignore other socially valuable speech such as parody and social criticism. Fourth, the language from *Netcom* (which is not binding nationwide) discusses only contributory infringement and not vicarious or direct infringement.

More fundamentally, Senator McCain's approach ignores the fact that the parties in the best position to consider fair-use analyses are those with the most direct stakes: the copyright owner and the user. The fair-use factors look to matters such as market harm, the purpose of the defendant's use, the nature of the plaintiff's work, and the amount taken from the original.⁸⁸ But the owner will know more than the intermediary about market harm. The user will know more about purpose of its use. Both owner and user will likely know more about the nature of the dueling works and the portion taken from the original. Most importantly, the stakes are the most concrete for owner and user: one who wants to stop the use, and the other who wants to maintain it without liability.

86. *Religious Tech. Ctr. v. Netcom On-Line Comm. Services*, 907 F. Supp. 1361, 1374 (N.D. Cal. 1995) (emphasis added).

87. *See A & M Records, Inc. v. Napster, Inc.*, 114 F. Supp. 2d 896, 918-19 (N.D. Cal. 2000) (quoting *Netcom* fair use discussion and noting that it is dicta since *Netcom* "raised a genuine issue of material fact regarding knowledge"), *aff'd in part, rev'd in part*, *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (2001).

88. *See generally* 17 U.S.C.A. § 107 (West 2009).

Nonetheless, Senator McCain's broader concerns for fair use might be helped through a "fairer" interpretation of the statute. As argued in the next two Parts, copyright owners must "stop-and-think" before sending a take-down notice under Section 512(c); failure to do so in cases involving fair use may be "willful blindness," giving rise to a possible claim for a knowing material misrepresentation under Section 512(f). Regarding users, courts should clarify that counter-notifications may be based on fair or other non-infringing uses. Thus, by my argument, the proper route for Senator McCain would be to send a counter-notification to obtain put-back.⁸⁹

III. COPYRIGHT OWNERS AND STOP-AND-THINK

Considering that it is not feasible under current law to expect service providers to police bad take-down notices, we must next consider the extent to which the existing statute can be interpreted to pay greater respect to fair use concerns. This section considers the duties of copyright owners. As discussed below, I conclude that owners must consider fair and other non-infringing uses before sending take-downs, and that willful blindness to fair use may constitute a knowing, material misrepresentation, giving rise to liability to users who are damaged as a result.

A. *Take-down abuse and the Lenz case*

As things currently stand, not enough consideration is always given to fair use. It is easy to imagine the following conversation happening in a law firm today:

PARTNER: Good morning. Our client called us this morning about a YouTube video. They want it taken down.

ASSOCIATE: Ok, sure. What's the video about?

PARTNER: The video makes fun of them. Pokes fun at their products.

ASSOCIATE: Anything else?

89. Unfortunately, because of Section 512's ten to fourteen day delay, time-sensitive materials would remain offline for a troublingly long period. *See id.* § 512(g)(2)(C).

PARTNER: It uses images of our client's products from the client's website. *Prima facie* copyright infringement.

ASSOCIATE: What about fair use?

PARTNER: Fair use is an affirmative defense. Just send a DMCA take-down notice to YouTube. That should do it. Nothing will ever come of it because users never send counter-notifications.

ASSOCIATE: Right on it!

Unfortunately, conversations like this may occur far too often in law firms.⁹⁰ Below is an example of a take-down that I find to be absurd, although we cannot know what level of analysis, if any, led to its dispatch. One of my favorite YouTube videos – a mash-up of William Shatner's spoken-word version of The Beatles' *Lucy in the Sky with Diamonds* with images from *Star Trek* and other sources – was removed at the apparent behest of Twentieth Century Fox.⁹¹ The video brilliantly puts together bits of pop culture history to comment wryly on Shatner, *Star Trek*, The Beatles, and more, such as the movies *Titanic* and *Taxi Driver*. The best I can tell from my review, it does not appear that Fox owns *Star Trek*, The Beatles' music, or the Shatner album. If so, then one would wonder what portion of the video Fox believed infringed its copyrights. There are a number of pop culture references in the video, but I will focus here on the film *Titanic*, which Fox appears to own or co-own. Perhaps Fox was unhappy with the short segment of the video where Leonardo DiCaprio's character "Jack" stands at the bow of the *Titanic* lovingly holding William Shatner, who is digitally substituted for Kate Winslet's "Rose." The image is accompanied by Shatner singing "Picture yourself in a boat on a river." If so, it is a very strong case of fair use, by parodying, among other things:

90. See Kasunic, *supra* note 25, at 416 n. 60 (noting that platforms like YouTube contain significant transformative material and concluding that "it appears that many takedown notices are automated and insufficiently reviewed by the copyright owners or their agents").

91. The video was originally posted at <http://youtube.com/watch?v=L7lKgFMxWyw>. That link now refers users to another page that states "This video is no longer available due to a copyright claim by Twentieth Century Fox." As of this writing, the video can be found elsewhere. See Posting of William Shatner *Lucy in the Sky with Diamonds* to <http://video.google.com/videoplay?docid=-7258896287489458266> (May 21, 2005); see also WILLIAM SHATNER, *Spleen/Lucy in the Sky with Diamonds*, on *THE TRANSFORMED MAN* (Decca 1968).

- Shatner's Captain Kirk character, who was a serial womanizer;
- The Beatles' song, by visually mocking the lyrics; *and*
- *Titanic*, by substituting Jack's true love Rose with Shatner, a person whose ego might compete with the equally dominating Jack character, who boasts that he is "king of the world."⁹²

Regarding reported cases, the Stephanie Lenz case highlights a great example of a DMCA notification that likely should never have been sent. Lenz posted a video on YouTube of her young son dancing called *Let's Go Crazy' #1*.⁹³ Audible in the background is approximately twenty seconds of the Prince Song *Let's Go Crazy*.⁹⁴ The sound is of extremely poor quality.⁹⁵ Nevertheless, Universal sent a take-down notice to YouTube and the video was promptly removed.⁹⁶ The video was restored after Lenz sent a counter-notice claiming fair use.⁹⁷ Represented by the Electronic Frontier Foundation, Lenz filed suit against Universal for sending a baseless take-down notice, in violation of Section 512(f)'s prohibition on "knowing material misrepresentations."⁹⁸ Section 512(f) is a rarely invoked civil cause of

92. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (holding that a Two Live Crew parody of song "Pretty Woman" can be fair use).

93. See Posting of *Let's Go Crazy' #1* to <http://www.youtube.com/watch?v=N1KfJHFWlhQ> (Feb. 7, 2007) [hereinafter "Lenz Video"].

94. PRINCE AND THE REVOLUTION, *Let's Go Crazy*, on MUSIC FROM THE MOTION PICTURE "PURPLE RAIN," (Warner Bros. 1984).

95. Lenz Video, *supra* note 93.

96. *Lenz v. Universal Music Corp.*, 572 F. Supp. 2d 1150, 1152 (N.D. Cal. 2008).

97. *Id.* The video remains online as of this writing. See Lenz Video, *supra* note 93.

98. *Lenz*, 572 F. Supp. 2d at 1151-53. Section 512(f) states in full:

(f) Misrepresentations.--Any person who knowingly materially misrepresents under this section--

(1) that material or activity is infringing, or

(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.

17 U.S.C.A. § 512(f) (West 2009). Under Section 512, reliance should be generally easy for a user to establish, as the service provider typically takes things down quickly upon demand from the copyright owner. Damages will vary, and in many cases may be nominal. Attorneys' fees, however, is a major plus for damaged persons. In addition, both lawyers and clients may be potentially liable to the extent either make or cause a knowing material misrepresentation, since the

action for users, intermediaries, or owners damaged by misrepresentations in connection with take-downs or counter-notices.⁹⁹

Universal moved to dismiss.¹⁰⁰ The motion was denied, with the court holding that copyright owners *must* consider fair use before sending a take-down.¹⁰¹ The complaint was sufficient, by alleging that Universal deliberately ignored fair use, and instead acted to promote the “personal agenda” of Prince.¹⁰² Although the court doubted Lenz could prove the “subjective bad faith” needed under Ninth Circuit precedent to prove a “knowing material misrepresentation,” it held that Lenz stated a claim.¹⁰³

B. Owners must consider fair use

For the reasons stated by the court and more, I think *Lenz* got it right. First, the language of Section 512 and structure of the Copyright Act make it clear that a copyright owner must consider fair and other non-infringing uses as part of a statutorily compliant DMCA take-down notice. *Lenz* noted that a proper notification must include, *inter alia*, a statement by the owner that it has a “good faith belief” that the use is not authorized by “the law.”¹⁰⁴ But a determination that a use is not

statute makes liable “[a]ny person.”

99. See *Rossi v. Motion Picture Ass’n of America Inc.*, 391 F.3d 1000 (9th Cir. 2004) (holding statute requires subjective actual knowledge, unknowing mistake not enough); *UMG Recordings, Inc. v. Augusto*, 558 F. Supp. 2d 1055, 1065 (C.D. Cal. 2008) (holding that statute requires lack of “subjective good faith belief”); *Dudnikov v. MGA Entm’t, Inc.*, 410 F. Supp. 2d 1010, 1012 (D. Colo. 2005) (holding that good faith belief of infringement means no liability); *Online Policy Group v. Diebold, Inc.*, 337 F. Supp. 2d 1195, 1204 (N.D. Cal. 2004) (in case decided before *Rossi*, holding that “[k]nowingly” means that a party actually knew, should have known if it acted with reasonable care or diligence, or would have had no substantial doubt had it been acting in good faith, that it was making misrepresentations”); *Arista Records, Inc. v. Mp3Board, Inc.*, No. 00 CIV. 4660(SHS), 2002 WL 1997918, at *15 (S.D.N.Y. Aug. 29, 2002) (holding no liability “for merely sending a letter that constitutes insufficient notification”); see also Matt Williams, *The Truth and the “Truthiness” About Knowing Material Misrepresentations*, 9 N.C. J. L. & TECH. 1 (2007) (discussing section 512(f)).

100. An earlier complaint had been dismissed with leave to amend. *Lenz v. Universal Music Corp.*, No. C 07-03783 JF, 2008 WL 962102, at *1 (N.D. Cal. Apr. 8, 2008).

101. *Lenz*, 572 F. Supp. 2d at 1156-57. A motion to certify for interlocutory appeal was later denied. See *Lenz v. Universal Music Corp.*, No. C 07-3783 JF (RS), 2008 WL 4790669 (N.D. Cal. Oct. 28, 2008).

102. *Lenz*, 572 F. Supp. 2d at 1156. A press statement issued by Universal stated broadly that as a “matter of principle,” “Prince believes it is wrong for YouTube, or any other user-generated site, to appropriate his music without his consent.” *Id.* at 1152.

103. *Id.* at 1156. “An allegation that a copyright owner acted in bad faith by issuing a takedown notice without proper consideration of the fair use doctrine thus is sufficient to state a misrepresentation claim pursuant to Section 512(f)” *Id.* at 1154-55.

104. *Id.* at 1154 (quoting 17 U.S.C. § 512(c)(3)(A)(v)).

authorized involves more than merely glancing at the exclusive copyright rights listed in Section 106.¹⁰⁵ As *Lenz* pointed out, the fair use statute in Section 107 provides that “[n]otwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work . . . is *not an infringement* of copyright.”¹⁰⁶ In addition, though not noted by the court, section 106 expressly states that the copyright owner’s exclusive rights are “[s]ubject to section[] 107,” which is the fair use statute.¹⁰⁷ Simply put, a fair use is a non-infringing use, and to claim otherwise is incorrect.¹⁰⁸

Second, the nature of the DMCA take-down procedure demands that the copyright owner consider fair use as a matter of procedural fairness. It is true that courts typically treat fair use as a defense that can rebut a *prima facie* case of infringement. But this approach is inappropriate in the context of DMCA notifications. The process in Section 512 is in essence an *ex parte* adjudication, one that lacks the procedural protections of civil litigation.¹⁰⁹ In an *ex parte* proceeding seeking a temporary restraining order (“TRO”), the plaintiff can get relief only if “specific facts in an affidavit or a verified complaint clearly show that immediate and irreparable injury, loss, or damage will result.”¹¹⁰ But a take-down notice need not allege irreparable harm, needing instead to baldly assert that the materials are infringing. In an *ex parte* TRO proceeding, the movant must “certif[y] in writing any efforts made to give notice and the reasons why notice should not be required.”¹¹¹ With take-downs, the copyright owner has no duty to contact the user before sending a take-down notice,¹¹² and the service

105. 17 U.S.C.A. § 106 (West 2009) (listing exclusive rights of reproduction, adaptation, public distribution, public display, public performance, and public performance of sound recordings by digital audio transmission).

106. *Lenz*, 572 F. Supp. 2d at 1154 (quoting 17 U.S.C. § 107) (italics added).

107. 17 U.S.C.A. § 106 (West 2009) (emphasis added). Even the limited moral rights contained in Section 106A indicate that they are subject to the fair use statute. *Id.* § 106A(a).

108. The same can be said of other reasons that undercut claimed infringement, such as lack of ownership or that the disputed use does not implicate one of the exclusive rights.

109. See Pollack, *supra* note 8, at 561 (noting the “extraordinary lack of court protection available to the subscriber before s/he is silenced”); Scott, *supra* note 75, at 128-29 (even in federal court, a mere complaint does not merit “automatic granting” of relief).

110. FED. R. CIV. P. 65(b)(1)(A).

111. *Id.* 65(b)(1)(B).

112. *Contra id.* 11(c)(1)(2) (providing that a motion for sanctions under Rule 11 may not be filed unless motion served on opposing party twenty-one days earlier); *id.* 37(a)(1), (d)(1)(B) (party moving for motion to compel or for certain discovery sanctions must certify it has “in good faith conferred or attempted to confer” with the opposing party before seeking court action).

provider need not contact the user until after the take-down is complete, making the process like a prior restraint.¹¹³

In an *ex parte* TRO proceeding, a neutral decision-maker evaluates the claim, but in the take-down context, the service provider acts as an automaton, blindly and necessarily taking down the materials at the owner's behest.¹¹⁴ Even worse, while a judge in a civil proceeding must be impartial and unbiased, a service provider has tremendous incentive to comply with the take-down notice so that it avoids liability.¹¹⁵ Indeed, the service provider is potentially adverse to both the present party (the owner) and an absent person (the user), and has maximum incentive to do anything to avoid liability. As YouTube counsel noted in response to Senator McCain's letter, if "service providers do not remove the content in response to [a take-down] notice," they lose their safe harbor.¹¹⁶

Thus, take-downs not only lack the procedural protections of an *ex parte* TRO proceeding,¹¹⁷ but typically become *de facto ex parte* seizures as well since few users write counter-notifications.¹¹⁸ The initial take-down notice accomplishes the same result as a civil litigation that proceeds almost immediately from filing to judgment to execution. In a civil litigation, consideration of fair use is a safeguard that serves as one of copyright law's "built-in First Amendment accommodations."¹¹⁹

113. 17 U.S.C.A. § 512(g)(2)(A) (West 2009) (service provider must "take[] reasonable steps promptly to notify the subscriber that it has removed or disabled access to the material"). In an *ex parte* proceeding, the movant must also typically issue security such as a bond. FED. R. CIV. P. 65(c). Reading the statute to require pre-consideration of fair use may avoid some potential problems with due process. Laura Quilter states that Section 512 "is effectively a prior restraint with no judicial review." *Quilter Comments, supra* note 12, at 1028; *see also* Pollack, *supra* note 8, at 573 (Section 512 impinges on First Amendment liberty interest).

114. Indeed, if the service provider refuses or even takes too long, it may find itself subject to liability for copyright infringement.

115. In fact, the statute generally immunizes the provider from any liability to anyone "for any claim based on the service provider's good faith disabling of access to, or removal of, material or activity claimed to be infringing . . . , regardless of whether the material or activity is ultimately determined to be infringing." 17 U.S.C.A. § 512(g)(1) (West 2009).

116. Letter to McCain, *supra* note 16, at 1.

117. In the trademark context, *see* 15 U.S.C.A. § 1116(d) (West 2009) (detailed procedures for proceedings requesting *ex parte* seizures of goods bearing counterfeit trademarks). The protections of Rule 65 also apply to copyright impoundments. *See* FED. R. CIV. P. 65(f); *see also* 17 U.S.C.A. § 503 (West 2009) (copyright impoundments).

118. A TRO must typically be dissolved after ten days. FED. R. CIV. P. 65(b)(2). With take-downs, if a counter-notification is received, the materials must be restored within ten to fourteen days of receiving the counter-notification. 17 U.S.C.A. § 512(g)(2)(C) (West 2009).

119. *Eldred v. Ashcroft*, 537 U.S. 186, 219-20 (2003); *see also* Computer Communications Ind. Ass'n, *Abstract: Copyright* (May 2008), <http://www.ccianet.org/docs/abstracts/2008/Copyright2008.pdf> ("According to the Supreme Court

But permitting an owner to ignore fair use could eviscerate fair use in the take-down context. Considering that fair use is non-infringing use, that the procedure excludes the alleged infringer until after the removal, and that the “adjudicator” is itself potentially liable if it fails to act, the copyright owner must consider fair use.¹²⁰

Third, the structure of Section 512 makes it clear that an owner must make a pre-filing investigation. A proper notification is essentially certified by including matters such as signature, contact information, identification of the owner’s work and of the infringing materials, a statement that the use is unauthorized, and statements of good faith, authority, and accuracy.¹²¹ Such requirements are similar to the certification requirements in the Federal Rules of Civil Procedure.¹²² Rule 11 requires a lawyer to conduct a reasonable investigation into the law and the facts before presenting any paper to the court.¹²³ Signing and filing a paper such as a complaint is a certification that there has been such an investigation and that the paper is not filed for improper purposes.¹²⁴ Some courts have held that a lawyer can violate Rule 11 by failing to investigate, even if the lawyer “through sheer fortuity” turns out to be correct.¹²⁵ Although sanctions for violations “must be limited to what suffices to deter repetition” of the wrongful conduct, in extreme cases, sanctions can even include dismissal.¹²⁶ As I suggest in the next

in *Eldred*, fair use is one of the ‘traditional First Amendment safeguards’ that ensure the constitutionality of copyright law.”) (quoting *Eldred*, 537 U.S. at 220).

120. If Section 512(g) does *not* permit a counter-notice on the basis of fair or non-infringing use, the aggrieved user’s only remedy would be to file suit in court. Yet this would eviscerate the goal of Senator Ashcroft’s amendment, i.e., to make sure that fair users would not be required to go to court to protect themselves. See *supra* Part I.C; see also Pollack, *supra* note 8, at 572-76 (arguing that Section 512 impinges on First Amendment liberty interest and recommending changes to statute).

121. 17 U.S.C.A. § 512(c)(3)(A)(i)-(vi) (West 2009).

122. See Scott, *supra* note 75, at 159 (suggesting Section 512 be amended to include Rule 11’s reasonable inquiry requirement).

123. FED. R. CIV. P. 11(b).

124. *Id.*

125. *Lichtenstein v. Consol. Serv. Group, Inc.*, 173 F.3d 17, 23 (1st Cir. 1999); *Garr v. U.S. Healthcare, Inc.*, 22 F.3d 1274, 1279 (3d Cir. 1994) (“a signer making an inadequate inquiry into the sufficiency of the facts and law underlying a document will not be saved from a Rule 11 sanction by the stroke of luck that the document happened to be justified”). Not all courts agree. See *Moore v. Keegan Mgmt. Co.*, 78 F.3d 431, 435 (9th Cir. 1996) (“We do little to undermine the deterrent goals of the Rule by not sanctioning complaints which have merit on their face.”). See generally RICHARD L. MARCUS ET AL., CIVIL PROCEDURE: A MODERN APPROACH 151 (updated 4th ed. 2008) (citing *Lichtenstein* and *Moore* and noting split).

126. FED. R. CIV. P. 11(c)(4); see also Jerold S. Solovy & Laura A. Kaster, 2 MOORE’S FEDERAL PRACTICE § 11.24[2] (“Dismissal is a severe sanction, but it is available when appropriate to deter the sanctionable conduct.”).

section, failure to investigate may constitute willful blindness, possibly leading to a knowing material misrepresentation under Section 512(f).

C. Willful blindness as a knowing material misrepresentation

A failure to consider fair use may be considered willful blindness, which in turn may satisfy the knowledge element of 512(f). In *Lenz*, the plaintiff argued, and the court agreed, that failure to consider fair use was deliberate ignorance, thus constituting a misrepresentation.¹²⁷ Willful blindness – also known by terms such as deliberate indifference and reckless disregard¹²⁸ – is typically used to prove knowledge in criminal law. “Under the doctrine of willful blindness or deliberate ignorance, which is used more often in the criminal context than in civil cases, knowledge can be imputed to a party who knows of a high probability of illegal conduct and purposely contrives to avoid learning of it.”¹²⁹ As stated by another court:

[A] deliberate indifference instruction is not the same as a constructive knowledge instruction. . . . A deliberate indifference instruction is used to inform the jury that a defendant's actions, or failures to act, combined with other circumstances may suffice to prove that a defendant had actual knowledge of a fact.¹³⁰

Willful blindness is not limited to criminal cases, and has been used in copyright and trademark cases.¹³¹ As held by the United States Court

127. See *Lenz v. Universal Music Corp.*, 572 F. Supp. 2d 1150, 1156 (N.D. Cal. 2008) (“sufficient allegations of bad faith and deliberate ignorance of fair use to survive the instant motion to dismiss”); Opposition to Motion to Dismiss Second Amended Complaint, *Lenz v. Universal Music Corp.*, No. C 07-03783 JF, at 18 (N.D. Cal. Jun. 20, 2008) (“*Rossi* does not authorize willful blindness”), available at http://www.eff.org/files/filenode/lenz_v_universal/Lenz_Opp_MTD.pdf.

128. As well as other terms such as “conscious avoidance,” “contrived ignorance,” “deliberate ignorance,” and “willful ignorance.”

129. *Williams v. Obstfeld*, 314 F.3d 1270, 1278 (11th Cir. 2002); see also David Luban, *Contrived Ignorance*, 87 GEO. L.J. 957, 959 (1999) (“In essence, the doctrine states that willful ignorance is equivalent to knowledge. Self-generated deniability doesn’t work: you can be convicted of knowingly committing a crime even if you don’t commit it knowingly-provided that you contrived your own ignorance.”).

130. *United States v. Falcon*, 477 F.3d 573, 578-79 (8th Cir. 2007) (citing *United States v. Parker*, 364 F.3d 934, 947 n. 3 (8th Cir. 2004)).

131. *In re Aimster Copyright Litig.*, 334 F.3d 643, 650 (7th Cir. 2003) (discussing willful blindness in copyright case); see also *Island Software and Computer Serv., Inc. v. Microsoft Corp.*, 413 F.3d 257, 263 (2d Cir. 2005) (holding that willfulness requires either actual awareness or that defendant acted with “‘reckless disregard’ for, or ‘willful blindness’ to, the copyright holder’s rights”); *Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 511 (7th Cir. 1994) (“a finding of willfulness is justified if the infringer knows that its conduct is an infringement or if the

of Appeals for the Seventh Circuit, “[w]illful blindness is knowledge, in copyright law . . . as it is in the law generally.”¹³² All that is needed is “a deliberate effort to avoid guilty knowledge.”¹³³ As Black’s Law Dictionary aptly puts it, willful blindness is “[d]eliberate avoidance of knowledge of a crime . . . by failing to make a reasonable inquiry about suspected wrongdoing despite being aware that it is highly probable.”¹³⁴

Willful blindness is particularly apt in the context of take-down notices. Although typically used to show knowledge of *illegal* conduct, for take-down notices, willful blindness should be used to show that a copyright owner intentionally blinded itself to potentially *legal* conduct of the user. In a notification, the owner must state that they have a “good faith belief” that the use is unauthorized. But as stated by numerous courts, willful blindness is not compatible with good faith.¹³⁵ In contexts where the use suggests that fair use may be applicable, a decision to ignore fair use cannot be good faith. Sending a take-down under such circumstances is bad faith, and is a subjective misrepresentation. As a matter of procedural fairness, this analysis must be correct. The weakest stakeholder in take-down notices is the user.

infringer has acted in reckless disregard of the copyright owner’s right”) (internal quotes omitted).

132. *Aimster*, 334 F.3d at 650; *see also* *Hard Rock Cafe Lic. Corp. v. Concession Svcs., Inc.*, 955 F.2d 1143, 1149 (7th Cir. 1992) (“we have held that willful blindness is equivalent to actual knowledge for purposes of the Lanham Act”).

133. *Aimster*, 334 F.3d at 650. “Willful blindness requires ‘more than mere negligence or mistake’ and does not lie unless the defendant knew of a high probability of illegal conduct and purposefully contrived to avoid learning of it, for example, by failing to inquire further out of fear of the result of the inquiry.” *Tiffany (NJ) Inc. v. eBay, Inc.*, 576 F. Supp. 2d 463, 515 (S.D.N.Y. 2008) (quoting *Nike, Inc. v. Variety Wholesalers, Inc.*, 274 F. Supp. 2d 1352, 1369-70 (S.D. Ga. 2003)).

134. BLACK’S LAW DICTIONARY (8th ed. 2004). Similarly, under a “Jewell” or “Deliberate-indifference” instruction,

If a defendant claims ignorance of some fact essential to the crime, such as not knowing that a particular bag contained drugs, but the surrounding circumstances would put a reasonable person on notice that there was a high probability of illegality, as when the defendant has taken the bag from a known drug-dealer and has noticed the smell of marijuana coming from the bag, then the court may instruct the jury that it is entitled to infer the defendant’s guilty knowledge if the defendant deliberately avoided knowledge of the critical facts.

Id.

135. *See, e.g.*, *United States v. Anthony*, 545 F.3d 60, 65 (1st Cir. 2008) (“because deliberate ignorance of a duty to pay taxes is contrary to a good-faith belief, the willful blindness instruction may be given in appropriate tax evasion cases”); *United States v. Muriel*, 48 Fed. Appx. 102, at *3 (5th Cir. 2002) (non-precedential) (“*deliberate* ignorance of fraudulent conduct is at odds with a contention of subjective good faith”); *United States v. Beech-Nut Nutrition Corp.*, 871 F.2d 1181, 1194 (2d Cir. 1989) (“This Court has repeatedly approved use of a conscious-avoidance charge in a variety of cases in which there was a genuine issue as to the defendant’s good-faith ignorance of the illegality of his conduct.”); *In re Harbour*, 845 F.2d 1254, 1258 (4th Cir. 1988) (“willful ignorance in the face of facts which cried out for investigation may not support a finding of good faith”).

Section 512 *requires* the intermediary to remain ignorant of any infringement if they want to retain the safe harbor.¹³⁶ To permit the copyright owner *also* to remain willfully ignorant to fair use leaves the user with little protection.

However, it must be noted that in *Rossi v. MPAA*,¹³⁷ the Ninth Circuit stated that Section 512(f) “imposes a subjective good faith requirement upon copyright owners,” violated only when the owner makes “a knowing misrepresentation.”¹³⁸ Further, said the court, an unknowing mistake would not lead to legal liability, “even if the copyright owner acted unreasonably in making the mistake.”¹³⁹ Instead, held the court, “there must be a demonstration of some actual knowledge of misrepresentation on the part of the copyright owner.”¹⁴⁰ Does that mean that an owner who intentionally chooses to ignore fair use lacks actual knowledge of a misrepresentation: in other words, *see no evil, hear no evil, speak no evil*? I think it does not. It is debatable whether *Rossi*’s requirement of actual knowledge is dicta.¹⁴¹ *Rossi* did not involve a claim under Section 512(f); rather, the owner was sued based on a number of state-law theories.¹⁴² But my approach does not require disagreement with *Rossi*. Even if “actual” knowledge is required, it should be satisfied by willful blindness, a *knowing* failure to acknowledge or consider fair use under circumstances when a colorable fair use argument is presented by the facts. The rationale, facts, or outcome of *Rossi* do not demand a different result, especially considering that the dispute in that case did not present facts even remotely suggesting willful blindness: as noted by the *Rossi* court, the

136. Although a service provider can try to track down infringement, failure to remove any such content quickly would risk losing the safe harbor.

137. 391 F.3d 1000 (9th Cir. 2004). In a case decided while *Rossi* was pending, a lower court in that circuit held that “[k]nowingly” means that a party actually knew, should have known if it acted with reasonable care or diligence, or would have had no substantial doubt had it been acting in good faith, that it was making misrepresentations.” *Online Policy Group v. Diebold, Inc.*, 337 F. Supp. 2d 1195, 1204 (N.D. Cal. 2004) (citing various definitions in BLACK’S LAW DICTIONARY (8th ed. 2004)).

138. *Rossi*, 391 F.3d at 1004-05.

139. *Id.* at 1005.

140. *Id.*

141. See Williams, *supra* note 99, at 29 (noting that although *Rossi* arguably contains dicta, the decision is correct because 512(c)(3)(A)(v) and 512(f) are two sides of “same coin”); see also Pollack, *supra* note 8, at 562 (noting that *Rossi* “properly concluded that the ‘good faith belief’ in infringement required to support a take down notice was purely subjective”).

142. *Rossi*, 391 F.3d at 1002 (noting causes of action). The court, however, was correct in concluding that Sections 512(c)(3)(A)(v) (requirement of good faith claim of infringement) and 512(f) (knowing material misrepresentations of infringement) should be read together because each deals squarely with the owner’s claim of infringement.

facts of the case – where the website at issue advertised “Full Length Downloadable Movies” – practically screamed out infringement.¹⁴³ In contrast, I believe that where the facts scream out non-infringement, an owner who deliberately ignores fair use has satisfied Section 512(f)’s knowledge requirement.

D. Considering fair use is not burdensome

One might object that fair use is notoriously uncertain and that it is therefore unfair to conclude that ignoring fair use is misrepresentation. As noted by Justice Blackmun, fair use is the “most troublesome” area of copyright law.¹⁴⁴ But that would misunderstand the nature of misrepresentations under Section 512(f). The answer is not that the owner must make an *exhaustive* or *correct* fair-use determination, but that it must *consider* fair use where it is reasonably presented. Moreover, if fair use is reasonably debatable, a take-down can be sent in good faith. As noted by the *Lenz* court in a subsequent opinion denying permission to appeal,

The Court did not hold that every takedown notice must be preceded by a full fair use investigation. Rather, it 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.¹⁴⁵

143. The owner’s initial investigation in *Rossi* screamed out a high likelihood of infringement, where the alleged infringer’s website stated, “Join to download full length movies online now! new movies every month,” “Full Length Downloadable Movies,” and “NOW DOWNLOADABLE,” along with “graphics for a number of” movies. *Id.* at 1002. Although “no movies could actually be downloaded” from the site, *id.* at 1003, the defendant’s “customers often believed that actual movies were available for downloading on his website.” *Id.* at 1005. Such circumstances show that the take-down was sent in good faith. *See id.* (“The unequivocal language used by [the alleged infringer on his site] not only suggests that conclusion, but virtually compels it.”).

144. *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 475 (1984) (Blackmun, J., dissenting) (quoting *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939)); *cf. Upjohn Co. v. United States*, 449 U.S. 383, 393 (1981) (“An uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.”) (discussing attorney-client privilege).

145. *Lenz v. Universal Music Corp.*, No. C 07-3783 JF (RS), 2008 WL 4790669, at *2 (N.D. Cal. Oct. 28, 2008) (citation omitted). Although the court felt that such cases may be “extremely rare,” *id.*, I am not as optimistic. It may be that a large number of transformative non-commercial works are removed pursuant to take-downs. Unfortunately, since the take-down process is private and there is no requirement of maintaining public records or statistics, one can’t be sure how many such works are removed. *See Urban & Quilter, supra* note 12, at 623.

By way of analogy, under Rule 11, a proper investigation prior to filing a complaint need not be perfect or exhaustive. All that is required is an “inquiry reasonable under the circumstances.”¹⁴⁶ In the context of take-down notices, considering fair use must be part of that investigation. As noted by *Lenz*:

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.¹⁴⁷

In a court proceeding, a plaintiff may not have to negate fair use.¹⁴⁸ But a take-down notice side-steps the need for the owner to make any affirmative showing at all beyond satisfying the statutory elements of a take-down notice. As such, the copyright owner must consider fair use or other reasons why the use is non-infringing. Just as a bald failure to investigate may violate Rule 11, a failure to consider fair use where it is arguably applicable should violate Section 512(f), at a minimum, if the use turns out to be fair and the user is thereby damaged.

In practice, *considering* fair use will not be onerous. Proper inquiry into the facts and law is part of an attorney's normal due diligence prior to sending a demand letter or take-down notice. There is no excuse for a lack of competence, and an attorney who sends a take-down notice without knowledge of basic copyright law breaches his duty of competence.¹⁴⁹ As noted by the United States Court of Appeals for the Third Circuit, Rule 11 sanctions were appropriate against an attorney who filed a copyright suit when he “had not sufficiently investigated the facts of the case nor had he educated himself well enough as to copyright law.”¹⁵⁰ And since fair uses are not infringing, how can a lawyer *not* consider fair use when signing a take-down that must include the statutory statement that he has “a *good faith belief* that use of the

146. FED. R. CIV. P. 11(b).

147. *Lenz v. Universal Music Corp.*, 572 F. Supp. 2d 1150, 1155 (N.D. Cal. 2008).

148. *See, e.g., Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1158 (9th Cir. 2007) (holding that in preliminary injunction proceeding, once plaintiff shows likelihood of success on the merits, burden shifts to defendant to show that its fair use defense will succeed).

149. Indeed, the duty of competence is the very first rule listed in the ABA model rules. *See* MODEL RULES OF PROF'L CONDUCT R. 1.1 (“A lawyer shall provide competent representation to a client. Competent representation requires the legal knowledge, skill, thoroughness and preparation reasonably necessary for the representation.”).

150. *Zuk v. Eastern Pa. Psych. Inst. of the Med. Coll. of Pa.*, 103 F.3d 294, 299 (3d Cir. 1996).

material in the manner complained of is not authorized by the copyright owner, its agent, *or the law*.”¹⁵¹

Importantly, I emphasize that lawyers must consider fair and other non-infringing uses, *not* that they always get it right. When a lack of fair use is obvious, its consideration will be properly fleeting. Other times, circumstances will give rise to the need for further inquiries, such as red flags concerning validity or ownership, concerning various defenses, and concerning fair use.¹⁵² The following sub-sections contain illustrative examples of obvious infringement, obvious non-infringement (for a variety of reasons), and strong versus debatable cases of fair use.¹⁵³ As noted in the Introduction, this Article assumes a basic knowledge of copyright law, so I will not engage in extended fair use analyses in the examples provided below. In fact, these analyses are done *purposely* in a cursory manner to highlight the fact that it is not difficult to identify cases where fair use may arguably exist. Where fair or other non-

151. 17 U.S.C.A. § 512(c)(3)(A)(v) (West 2009) (emphasis added).

152. I reject the analysis in *Dudnikov v. MGA Entertainment*, where the court stated “Plaintiffs have not presented any authority that supports applying a different standard than subjective good faith belief to lawyers trained in IP law.” 410 F. Supp. 2d 1010, 1013 (D. Colo. 2005). *Dudnikov* forgets that an assertion of “good faith” is inconsistent with willful blindness. Indeed, the epitome of *bad* faith is willfully ignoring something that screams out for your attention. If anything, the knowledge of an IP attorney makes it far easier to find bad faith, and thus a knowing misrepresentation. But the knowledge of intellectual property lawyers does not permit general practitioners to ignore their own duties of competence and give copyright advice without proper inquiry.

153. The fair use statute states:

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.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

17 U.S.C.A. § 107 (West 2009). As indicated in the statute, the factors are non-exclusive. In practice, the first and fourth factors tend to be the most important. *See American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 931 (2d Cir. 1994) (characterizing first and fourth factors as “important”); Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, 156 U. PA. L. REV. 549, 555, 587 (2008) (noting the extent of discussion in opinions supports conclusion that first and fourth factors “drive the outcome of the test”).

infringing use may exist, willful blindness to such issues may be a knowing material misrepresentation.

1. Likely infringement – posting entire commercial works

In many cases, the lack of fair use will be obvious. For example, Guns N' Roses' album *Chinese Democracy* was posted online before its release.¹⁵⁴ There was no fair use argument made, nor could there be under these facts.¹⁵⁵ Much the same can be said about a DMCA notice sent to Google concerning a blog that provided downloads of the movie *Shrek the Third*.¹⁵⁶ In such circumstances, the lack of fair use will be obvious. Counsel would likely spend at most a moment on fair use, instantly realizing that such uses simply are not fair. Further, even a failure to consider fair use would not lead to misrepresentation liability. These facts do not give rise to an obligation to inquire further about fair use, so no willful blindness would occur. Also, a necessary element of a Section 512(f) claim – injury – would be lacking, because the user would have no right under copyright law to post such materials.¹⁵⁷

2. Likely non-infringement – no valid copyright

In contrast, it is equally easy to imagine circumstances where an attorney should inquire further, and the failure to do so might be willful blindness if it constitutes a material misrepresentation that causes injury. For example, a lawyer should reasonably inquire to determine that its client owns the copyright and that the copyright is valid. The extent of this inquiry will vary with circumstances. In some cases, written assignments will exist. In others, circumstances may support a conclusion that grounds will exist to assert ownership. But in others, circumstances should give an attorney pause. For example, the purchaser of a globe that once belonged to Adolph Hitler recently

154. David Kravets, *Guns N' Roses Uploader to Plead Guilty*, WIRED, Nov. 10, 2008, <http://blog.wired.com/27bstroke6/2008/11/guns-n-roses-up.html>.

155. The uploader pleaded guilty to criminal copyright infringement. *See id.*; *see also* Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 554 (1985) (holding that unpublished nature of work is "key" but not determinative factor against fair use).

156. DMCA Notification from Paramount Pictures Corp. to Google (May 22, 2007), <http://chillingeffects.org/dmca512/notice.cgi?NoticeID=7363>.

157. Even though a knowing material misrepresentation is a necessary element of Section 512(f), it is not sufficient by itself to state a claim, as the user would also have to show it was injured by the misrepresentation. 17 U.S.C.A. § 512(f) (West 2009) (providing that damages and attorneys' fees for user "who is injured by such misrepresentation" via removal by the intermediary).

asserted copyright in the globe, a questionable claim considering that the purchaser of an object obtains no U.S. copyright from the mere act of purchase.¹⁵⁸ Also, the U.S. Air Force sent a DMCA notice to YouTube, demanding removal of a video containing content owned by the Air Force.¹⁵⁹ But works created by the U.S. government do not qualify for copyright, although the government can be assigned copyrights of others.¹⁶⁰ Did the Air Force own a copyright? Such circumstances should put counsel on notice that copyright rights might be lacking, requiring further investigation.¹⁶¹

3. Likely fair use – noncommercial parody or criticism

In other cases, the fair use argument will be strong. Unfortunately, sometimes demands are sent even when fair use is strong. Two examples noted in the introduction are *Chilling Effects* founder Wendy Seltzer and Senator John McCain. Seltzer, a strong fair-use advocate, posted to YouTube a short clip from an NFL game containing the NFL's overblown copyright notice.¹⁶² During the video, an announcer states "This telecast is copyrighted by the NFL for the private use of our audience. Any other use of this telecast or any pictures, descriptions, or accounts of the game without the NFL's consent is prohibited."¹⁶³ The breadth of the NFL's copyright claim is mind-boggling. By the NFL's assertion, *any* news account or photograph of the game – even if not based on the telecast – would require permission from the NFL. Such an assertion is baseless, considering that "[t]he most fundamental axiom of copyright law is that '[n]o author may copyright his ideas or the facts he narrates.'"¹⁶⁴

158. See *Achtung! Tom's Globe a No-No*, NY POST, Jan. 2, 2009, http://www.nypost.com/seven/01022009/gossip/pagesix/achtung_toms_globe_a_no_no_146812.htm; see also 17 U.S.C. § 202 (transfer of ownership of object does not impart copyright ownership).

159. Letter from U.S. Air Force to YouTube (Mar. 5, 2008), <http://chillingeffects.org/dmca512/notice.cgi?NoticeID=17583>.

160. See 17 U.S.C.A. § 105 (West 2009).

161. According to Wired's Threat Level, an Air Force spokesperson said that "any intellectual property claim should have gone through his office, and none did." Kevin Poulsen, *Air Force Cyber Command's New Weapon: DMCA Notices*, WIRED THREAT LEVEL, Mar. 7, 2008, <http://blog.wired.com/27bstroke6/2008/03/air-force-cyber.html>.

162. Posting of Super Bowl Highlights, *supra* note 13; see also *supra* note 13 and accompanying text.

163. Posting of Super Bowl Highlights, *supra* note 13.

164. Feist Publications, Inc. v. Rural Telephone Serv. Co., Inc., 499 U.S. 340, 344-45 (1991) (quoting Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 556 (1985)). Although one court has permitted protection against misappropriation of "hot news," this protection is limited to misappropriation of time-sensitive information by a direct competitor. National

Seltzer's purpose in posting the short clip to YouTube was to showcase the NFL's overblown claim, in short, to *criticize* the NFL. Such use is classic fair use.¹⁶⁵ The posting was not done for monetary gain, took only a few seconds from the game, and in no way would supplant the market for NFL broadcasts. In short, it was a very strong case of fair use. Yet the NFL compounded potential copyright misuse by sending not one, but *two* DMCA take-down notices to YouTube.¹⁶⁶ The materials were restored after Seltzer sent counter-notifications.¹⁶⁷ Unfortunately, a less savvy user would likely be cowed by the NFL and big-money law firms.¹⁶⁸

Regarding Senator McCain, Fox News objected to McCain about one of his campaign commercials because it contained "a few seconds of his participation in a Fox-sponsored presidential debate."¹⁶⁹ Although

Basketball Ass'n v. Motorola, Inc., 105 F.3d 841, 845 (2d Cir. 1997). The NFL's copyright announcement is not "hot news," and even if it was, Seltzer is a fair-use advocate and law professor, not a competitor of the NFL.

165. The preamble to Section 107 lists a number of uses as possible fair use: "purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research." 17 U.S.C.A. § 107 (West 2009).

166. See Wendy Seltzer, NFL: Second Down and Goal?, WENDY'S BLOG: LEGAL TAGS, Apr. 5, 2007, http://wendy.seltzer.org/blog/archives/2007/04/05/nfl_second_down_and_goal.html. Further posts by Professor Seltzer about the take-downs and counter-notifications can be found at <http://wendy.seltzer.org/blog/dmca-nfl> (last visited Oct. 25, 2008).

167. See Seltzer, *supra* note 166. In 2007, the Computer & Communications Industry Association ("CCIA") filed a complaint against the NFL, Major League Baseball, and others with the Federal Trade Commission. In re Misrepresentation of Consumer Fair Use and Related Rights (complaint dated Aug. 1, 2007), available at <http://www.ftc.gov/os/070801CCIA.pdf>; see also Computer & Communications Industry Association, *CCIA Files FTC Complaint against NBC/Universal, MLB, the NFL and Others Alleging Years of Consumer Deception*, Aug. 1, 2007, available at http://www.cciagnet.org/artmanager/publish/news/FTC_copyright_complaint.shtml. Although FTC staff decided "not to recommend" formal action at that time, it noted that "[w]idespread use of inaccurate copyright warnings could contribute to consumers' misunderstanding" of consumer protections under copyright law. Opinion letter from Mary K. Engle, Assoc. Dir. for Advertising Practices, Federal Trade Commission, to Computer & Communications Ind. Assoc. (Dec. 6, 2007), at 1, 5, <http://www.ftc.gov/os/closings/staff/071206ccia.pdf>. The letter noted that no formal determination had been made, thus leaving open the possibility of future action. *Id.* at 6.

168. The copyright claim underlying the NFL's notifications are even less meritorious than the copyright suit Mattel filed against Tom Forsythe, a photographer who sold photos of dismembered Barbie dolls posed with kitchen appliances. In that case, the Ninth Circuit held that the artist had engaged in fair use. See *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792, 800 (9th Cir. 2003). On remand, the district court granted Forsythe attorney's fees under Section 505 of the Copyright Act. See *Mattel, Inc. v. Walking Mountain Productions*, No. CV99-8543RSWL(RZX), 2004 WL 1454100, at *2 (C.D. Cal. Jun. 21, 2004) ("Plaintiff is a sophisticated entity with access to good legal representation. Plaintiff's claims were not in an unsettled area of law and had little likelihood of success. Plaintiff's copyright claims, therefore, were frivolous.").

169. Sarah Lai Stirland, *McCain's Disputed Fox Debate Clip a Viral Hit Online*, WIRED THREAT LEVEL, Oct. 26, 2007, <http://blog.wired.com/27bstroke6/2007/10/mccains-dispute.html>;

the complaint was apparently to McCain rather than YouTube, it provides a good illustrative example. Fox News' objection is also highly questionable, considering that McCain's use was for political purposes, the portion taken was minimal, the materials were factual and of historic relevance, and the use did not supplant the market for the original.¹⁷⁰ One wonders whether Fox's lawyers considered fair use in any serious way.

Similarly, fair use arguments in the *Lenz* case are strong. Lenz's video is non-commercial, has poor audio quality, and uses only a small portion of the song *Let's Go Crazy*. Moreover, Lenz was making a joke (albeit a gentle one) at the song's expense by displaying her young son himself going crazy by dancing to the song.¹⁷¹ Although the original work is creative rather than factual, Lenz's use is non-commercial and in no way competes with the market for the original. Simply put, nobody will prefer Lenz's video to the original CD or an iTunes download. One wonders whether Universal's lawyers did not consider fair use, or figured that Lenz – like most users – would rather fold than fight.

4. Unclear fair use – the case of *The Grey Album*

But I recognize that fair use can be complex and debatable. Under such circumstances, a lawyer who considers fair use and still decides to send a take-down would not violate Section 512(f), even if a court may ultimately later disagree with the lawyer's fair use analysis. For example, in 2002, Brian Burton, a musician better known as Danger Mouse (now half of the famous group Gnarls Barkley) released *The Grey Album*, a mash-up of The Beatles' *White Album* with Jay Z's *Black Album*.¹⁷² The album brilliantly overlays Jay Z's vocals with samples

Jim Rutenberg, *Fox Orders Halt to McCain Ad*, THE CAUCUS (N.Y. TIMES POLITICS BLOG), Oct. 25, 2007, <http://thecaucus.blogs.nytimes.com/2007/10/25/fox-orders-halt-to-mccain-ad/>.

170. Anyone wanting to watch the whole debate would not be interested in watching the few seconds excerpted in the ad. Fox suggested, likely *post hoc*, that McCain's use was objectionable because it was "commercial." See Stirland, *supra* note 169. But even if the snippet of the Fox debate video (containing McCain's own comments) was used in part to raise campaign funds, it is hard to see how it would prevent fair use if there is no market harm, which is the case here. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 591 (1994) (holding that duplication of original in entirety makes market harm likely, but where "second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred").

171. Although the infamous *Dr. Seuss* case concluded that a parody must target the original at least in part, that occurred here, as Lenz's video holds the Prince song up to gentle and direct ridicule. See *Dr. Seuss Enterprises, L.P. v. Penguin Books USA*, 109 F.3d 1394, 1400 (9th Cir. 1997) ("unless the plaintiff's copyrighted work is *at least in part the target* of the defendant's satire, then the defendant's work is not a 'parody' in the legal sense") (emphasis in original).

172. *The Grey Album Legal Battle Summarized*, <http://www.illegal-art.org/audio/grey.html>

from *White Album*. In my mind, this is fair use. It's highly transformative, creating a new work. But fair use here is less clear. *The Grey Album* doesn't directly comment on or criticize the original works; instead, the jist of mash-ups is that they juxtapose disparate works in a way that arguably comments on both in a "quasi-parody" fashion.¹⁷³

My purpose here is not to prove that mash-ups are or are not fair use. Rather, an owner's lawyer might reasonably conclude that fair use issues are sufficiently uncertain that a take-down notice would not be unwarranted. In fact, take-down and cease and desist letters were sent seeking removal of *The Grey Album*,¹⁷⁴ including in response to "Grey Tuesday," a day of mass protest where the album was made available for download from over 150 websites.¹⁷⁵ Legal or not, the album is still available for download from a fair-use advocacy site, apparently without further complaints from any copyright owners.¹⁷⁶

IV. USERS, COUNTER-NOTIFICATION, AND FAIR USE

Requiring lawyers to stop-and-think about fair use will prevent some notices from being sent. But it will not cure all problems with take-downs. Lawyers may still fail to consider fair use, so the damaging take-down is sent. Or lawyers might consider fair use and conclude in good faith that fair use is by no means clear.¹⁷⁷ Also, unrepresented owners may not realize that their take-downs are improper.¹⁷⁸ In such circumstances, the take-down notice will be sent, and pursuant to the "safety dance," the content will be removed. Can the user get the

(last visited Oct. 18, 2008).

173. Cf. Aaron Power, *15 Megabytes Of Fame: A Fair Use Defense For Mash-Ups As DJ Culture Reaches Its Postmodern Limit*, 35 SW. U. L. REV. 577, 600 (noting that mash-ups may appear to be "open and shut" infringement, but arguing that they may fall into a "quasi-parody" category of works that could merit fair use protection).

174. See, e.g., DMCA Notice to Waxy.org (Feb. 13, 2004), <http://chillingeffects.org/fairuse/notice.cgi?NoticeID=1093>; Letter from J. Christopher Jensen (Feb. 24, 2004), <http://chillingeffects.org/fairuse/notice.cgi?NoticeID=1132>.

175. Bill Werde, *Defiant Downloads Rise From Underground*, N.Y. TIMES, Feb. 25, 2004, <http://www.nytimes.com/2004/02/25/arts/music/25REMI.html?ex=1232946000&en=1570b2c178bd76e7&ei=5070>.

176. *The Grey Album Legal Battle Summarized*, *supra* note 172.

177. Even the *Lenz* court doubted that the Section 512(f) claim would survive summary judgment. *Lenz v. Universal Music Corp.*, 572 F. Supp. 2d 1150, 1156 (N.D. Cal. 2008).

178. Whether such persons are acting willfully blind will vary with the circumstances. Even laypeople have been sufficiently exposed through the media to widely publicized disputes that they may realize that certain conduct (for example, non-commercial parodies) are possibly not infringing. Such circumstances might also give rise to inquiry into fair or non-infringing use before a take-down is sent.

content put back online without having to file a suit for a declaration of non-infringement? Unfortunately, the bases for counter-notices are not clear. I argue below that fair use is sufficient to justify a counter-notice. In addition, this Part argues that any fears over frivolous counter-notices are likely overstated due to the fact that users sending counter-notices may subject themselves to liability for copyright and Section 512(f) liability. Finally, this Part considers the reality that DMCA notices are unhelpful in resolving the considerations present in complex fair use disputes.

A. What's a "mistake"?

The right of counter-notification would appear at first glance to be a powerful tool. But the scope of counter-notification at first seems to be narrow. Whereas a *take-down* can claim material to be "infringing," nowhere does Section 512(g) state that a *counter-notification* can claim material is "non-infringing," such as under fair use.¹⁷⁹ Instead, a counter-notification must include "[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."¹⁸⁰ Reading Section 512(g) in isolation, it is not at all clear that "mistake" can include a "mistaken view of the law," such as a notification that fails to consider an assertion of fair or other non-infringing use.¹⁸¹ At the very least, "mistake or misidentification" would seem to concern materials removed by error (such as an intermediary *mistakenly* removing the wrong webpage), or identified in error (such as the owner *misidentifying* the URL of the page to be removed). But does "mistake" also include fair or other non-infringing use? It could easily

179. Compare 17 U.S.C.A. § 512(c)(3)(A)(iii), (c)(3)(A)(v) (West 2009) (elements of notification), with *id.* § 512(g)(3)(C) (elements of counter-notification).

180. *Id.* § 512(g)(3)(C); see also *supra* Part I.C (discussing problems with statute).

181. It appears that no court has considered whether "mistake" encompasses fair or other non-infringing uses. Commentators have taken a variety of approaches. See JAY DRATLER, JR., CYBERLAW: INTELLECTUAL PROPERTY IN THE DIGITAL MILLENNIUM § 6.03 n. 464 (2008) (stating that the statute "does not permit counter-notifications based on disputes, whether or not in good faith, over ownership of copyright or copyright infringement (for example, based on a belief that an exception such as fair use applies)"); Kasunic, *supra* note 25, at 415 n. 59 ("It is not at all clear . . . that a subscriber whose use was noninfringing . . . [can assert] 'mistake or misidentification.'"); Scott, *supra* note 75, at 132 & n.188 (citing DRATLER, *supra* note 181, and stating "it is by no means clear that 'mistake or misidentification' covers situations where the complainant was simply wrong about the claim of infringement"); Williams, *supra* note 99, at 2-3 n.7 (noting Ashcroft's statement and suggesting courts would be likely to treat "mistake or misidentification" as permitting claims of non-infringing use).

be argued that it does not. Congress could have written Section 512(g) to permit counter-notices based on “a good faith belief that the material was fair use or otherwise not infringing.”¹⁸² But Congress did not do that.

Such a reading is extremely troubling because it would prevent non-judicial replacement of materials removed by a baseless take-down notice. Even worse, a user sending a counter-notice opens itself up to charges of perjury. Although an *owner* need not claim infringement under penalty of perjury,¹⁸³ a *user's* assertion of “mistake or misidentification” must be made under penalty of perjury.¹⁸⁴ For users who have a viable fair use defense, the prospect of jail is chilling. It is no surprise, then, that counter-notifications are sent out far less often than notifications.¹⁸⁵

Nevertheless, it is worth considering whether this flawed statute can be read to permit fair use as a basis for counter-notification. For a number of reasons, I think it should. As noted previously, during the drafting of the DMCA, Senator Ashcroft found it “totally unacceptable” that a “user would have to go to court to prove their innocence.”¹⁸⁶ Having prompted the amendment that led to the counter-notice procedure, Ashcroft expressly stated that a failure to consider fair use was a mistake, and that the counter-notices permitted users to “put their material back on-line, without the need to hire a lawyer and go to court.”¹⁸⁷

182. Indeed, the misrepresentation provision distinguishes between an owner's misrepresentation “that material or activity is infringing,” and a user's misrepresentation “that material or activity was removed or disabled by mistake or misidentification.” 17 U.S.C.A. § 512(f) (West 2009).

183. Regarding sworn statements, the only thing the copyright owner (or its agent) must state under penalty of perjury is “that the complaining party is authorized to act on behalf of the owner of an exclusive right that is allegedly infringed.” *Id.* § 512(c)(3)(A)(vi). The other elements of the notification can be asserted without having to expressly submit oneself to perjury, including the assertions that the use is infringing, that it is unauthorized, and that the information in the notification is accurate. *Id.* § 512(c)(3)(A)(iii), (v), (vi).

184. A counter-notification must include “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.” *Id.* § 512(g)(3)(C) (emphasis added).

185. As noted by Robert Kasunic, “[t]he paucity of § 512(g) counter-notifications may, in part, be the result of the fact that the counter-notification requirements do not expressly address noninfringing use or fair use as a basis for replacing content.” Kasunic, *supra* note 25, at 415; *see also Quilter Comments, supra* note 12, at 1030 (“The counter-notice process is virtually never used, for various reasons.”).

186. 144 CONG. REC. S4884-01, S4889 (May 14, 1998) (statement of Sen. Ashcroft); *see also supra* Part I.C.

187. 144 CONG. REC. S4884-01, S4889 (May 14, 1998) (statement of Sen. Ashcroft); *see also supra* notes 63-67 and accompanying text.

Although legislative history is not determinative when a statute is clear on its face, Section 512(g) is arguably ambiguous, permitting exploration of legislative history.¹⁸⁸ The term “mistake” might refer to a mistake of fact or a mistake of law.¹⁸⁹ Plus, the structure of Section 512(g), looking to removal “as a result of mistake,” does not make it clear *whose* mistake would be relevant: the owner’s, the intermediary’s, or both?¹⁹⁰ Although the statement of a lone Senator might normally merit little weight, Senator Ashcroft was instrumental in pushing for the counter-notification procedure, so his views may merit some weight.¹⁹¹ On the other hand, it would appear that fair use was primarily Senator Ashcroft’s cause. Although Senators Hatch and Leahy spoke about the bill from the Senate floor, neither commented on the meaning of “mistake” or the role of fair use in counter-notifications.¹⁹²

188. See, e.g., *Eldred v. Ashcroft*, 537 U.S. 186, 209 n. 16 (2003) (ambiguity permits consideration of legislative history).

189. Courts have differed over the meaning of “mistake” in the context of relation-back. In civil litigation, if a pleading is amended to change a party or its name, the Federal Rules of Civil Procedure permit relation-back to the date of the original pleading if certain conditions are met, including that the party being brought in must have “[known] or should have known that the action would have been brought against it, but for a mistake concerning the proper party’s identity.” FED. R. CIV. P. 15(c)(1)(C)(ii). Some courts hold lack of knowledge is a “mistake,” and others do not. Compare *Worthington v. Wilson*, 8 F.3d 1253, 1256 (7th Cir. 1993) (holding that the term “mistake” in Rule permitting relation-back when party name changed, does not include “lack of knowledge of the proper party”) and *Barrow v. Wethersfield Police Dep’t*, 66 F.3d 466, 469-70 (2d Cir. 1995) (collecting cases), with *Varlack v. SWC Caribbean, Inc.*, 550 F.2d 171, 175 (3d Cir. 1977) (permitting relation-back for amendment replacing “John Doe” with named party), and *Swartz v. Gold Dust Casino, Inc.*, 91 F.R.D. 543, 547 (D. Nev. 1981) (holding that mistake “exists whenever a party who may be liable . . . was omitted”); see also MARCUS, *supra* note 125, at 224-25 (excerpting *Swartz* case, discussing meaning of “mistake” in context of Rule 15(c)(1)(C), and citing cases).

190. See 17 U.S.C.A. § 512(g)(3)(C) (West 2009) (“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.”).

191. Ashcroft has prior interests in copyright matters. When he was Missouri’s Attorney General, he filed a brief in the Sony Betamax case in support of consumers. See *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 418 (1984); 144 CONG. REC. S4884-01, S4890 (May 14, 1998) (statement of Sen. Ashcroft).

192. See 144 CONG. REC. S4884-01, S4884-S4885 (May 14, 1998) (statement of Sen. Hatch); *id.* S4885-S4887 (statement of Sen. Leahy). Neither may guidance be found in the Senate Judiciary Committee report, which mostly discusses the bill in general terms. See SEN. REP. NO. 105-190, at 7 (May 11, 1998) (noting the Ashcroft-Hatch-Leahy amendment); *id.* at 9 (noting protections for subscribers so that they are not “mistakenly” denied web access); *id.* at 19-21 (discussing bill generally); *id.* at 50-51 (discussing put-back procedure generally). The most relevant comment is this:

The Committee was acutely concerned that it provide all end-users—whether contracting with private or public sector online service providers—with appropriate procedural protections to ensure that material is not disabled *without proper justification*. The provisions in the bill balance the need for rapid response to potential infringement with

But we need not rely solely on legislative history.¹⁹³ More helpful is the overall structure of Section 512, which assumes that a “mistake” refers to errors of fact *and* errors of law in a take-down notice. One basis for counter-notification is that the materials were removed due to “misidentification of the material to be removed or disabled.”¹⁹⁴ This language is an obvious reference to the *elements* of notification by the owner, namely identification of the copyrighted work and of the infringing materials.¹⁹⁵ But if *misidentification* refers to the elements of an owner’s take-down, *mistake* should logically concern elements of the owner’s take-down as well. Most significantly here, the take-down must include “[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*.”¹⁹⁶ Thus, by the structure of the statute, a notification that erroneously asserts infringement contains a mistake of *law* that can serve as a basis for counter-notification. Put simply: 1) a take-down must assert that the use is unauthorized by the law; 2) a mistake in a take-down is a mistake that supports a counter-

the end-users legitimate interests in not having material removed without recourse. *Id.* at 21 (emphasis added). For his part, Sen. Leahy added a statement to the Committee Report stating:

[A]n Ashcroft-Leahy-Hatch amendment was adopted to ensure that computer users are given reasonable notice of when their Web sites are the subject of infringement complaints, and to provide procedures for computer users to have material that is *mistakenly* taken down put back online.

Id. at 67 (emphasis added). Similarly, little of interest can be found in the relevant House Commerce and Conference reports. See H.R. REP. NO. 105-551(II), at 20-21, 33, 59-60 (1998) (Commerce Committee report); H. CONF. REP. NO. 105-796, at 72-76 (1998), *reprinted in* 1998 U.S.C.C.A.N. 649-52 (Conference report).

193. One court characterized a counter-notice as one “of noninfringement.” *Online Policy Group v. Diebold, Inc.*, 337 F. Supp. 2d 1195, 1201 (N.D. Cal. 2004). At least one ISP appears to treat non-infringing use as sufficient for a counter-notice. Chilling Effects has a communication appearing to be from an ISP to one of its users stating that a counter-notice can assert “that the Claimant is wrong and that the Infringing Material is lawfully posted on the Web Site.” Letter from ThePlanet to user (Jan., 16, 2008), <http://chillingeffects.org/copyright/notice.cgi?NoticeID=16926>. Likely others do as well. The Electronic Frontier Foundation – a free-speech advocacy group that represented Lenz – takes the position that counter-notices can assert fair use. See Electronic Frontier Foundation, *Bloggers’ Legal Guide: Intellectual Property*, <http://www.eff.org/issues/bloggers/legal/liability/IP> (last visited Feb. 17, 2009) (“The DMCA provides an opportunity for you to counter-notify, to tell your ISP that the material in question is not infringing.”). YouTube states that counter-notices can assert fair use. YouTube, *YouTube Copyright Policy: DMCA and Counternotice Procedure*, <http://www.google.com/support/youtube/bin/answer.py?answer=83757&topic=13656> (last visited Feb. 17, 2009).

194. 17 U.S.C.A. § 512(g)(3)(C) (West 2009).

195. *Id.* § 512(c)(3)(A)(ii), (iii).

196. *Id.* § 512(c)(3)(A)(v) (emphasis added).

notice; 3) a fair use is a use that is authorized by the law; and 4) a take-down that erroneously claims that fairly used content is infringing is a mistake for purposes of Section 512(g), thus supporting counter-notice. The next section addresses how *clear* such a “mistake” should be to permit counter-notice.

B. Limiting abusive counter-notifications

One might object that permitting fair use as a basis for counter-notice might lead to a deluge of frivolous put-back demands. Any such objection is somewhat disingenuous, as it ignores that baseless take-down notices cause the removal of lawful speech that would never be permitted in judicial proceedings. More fundamentally, how do we best ensure that lawful speech is not removed and that infringing conduct is? I think that fears of a floodgate of frivolous put-backs are likely overblown. Let us not forget that we are talking about copyright infringement. A user who posts infringing material that is removed, and who later gets it put back based on a meritless counter-notice, is still an infringer. Under normal copyright law, he or she might be liable for actual or statutory damages, as well as attorney’s fees.¹⁹⁷

Further, Section 512 contains a number of protections that limit abuse. First, what goes for the goose goes for the gander. Under *Lenz*, if an owner must consider fair use before sending a take-down, then a user must consider whether the use is infringing before sending a counter-notification. Second, to avoid foul play, the statute makes the user’s burden extra high: whereas an owner need not risk perjury when making its substantive assertion of infringement,¹⁹⁸ the user must make the substance of its counter-notification upon penalty of perjury.¹⁹⁹ This by itself is quite chilling for users. Third, when sending a counter-notice, the user must provide their name, address, and telephone number.²⁰⁰ This is a tremendous concession by users who lose any

197. See *id.* §§ 412, 501, 504, 505. Indeed, a user who knowingly sends a baseless take-down may be a willful infringer, subjecting themselves to the higher statutory damages of Section 504(c)(2).

198. The only thing the owner needs to state under penalty of perjury is “that the complaining party is authorized to act on behalf of the owner of an exclusive right that is allegedly infringed,” which is an easy requirement to satisfy. *Id.* § 512(c)(3)(A)(vi). In comparison, the more important substantive statement of “good faith belief that use of the material in the manner complained of is not authorized” need not be made under penalty of perjury. *Id.* § 512(c)(3)(A)(v).

199. The counter-notice must include “[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.” *Id.* § 512(g)(3)(C) (emphasis added).

200. *Id.* § 512(g)(3)(D).

anonymity, enabling service of process. More importantly, they must consent to jurisdiction for the federal judicial district for the address.²⁰¹ Obtaining consent to jurisdiction is of tremendous benefit to owners, who may otherwise struggle to determine where personal jurisdiction would be appropriate and whether it exists under the nebulous “minimum contacts” test.²⁰²

Finally and most importantly, there's justification to conclude that the assertion of non-infringement-as-mistake must be more than non-frivolous. By choosing the word “mistake,” Congress intended counter-notifications to be based on erroneous claims of infringement (either factually or legally). Thus, to the extent that a counter-notification relies on fair use, the user must be able to state in good faith that there is a colorable *mistake* of law, not just that there is some slender thread of hope for fair use.

What might this mean? Although the question is extremely difficult, I would suggest consideration by analogy to the defense of qualified immunity used in federal civil rights actions. Under qualified immunity, a state actor is generally not liable for deprivations of civil rights unless their conduct violated “clearly established” law of which a reasonable person would have known.²⁰³ Equally so, if a court finds that a use is not fair, the user should not be found to have made a “knowing material misrepresentation” in its counter-notice unless its use was infringing under clearly established law that a reasonable person would have known or would have learned through reasonable inquiry.

It might be argued by owners that the standard should be the opposite, a mirror image of what I suggest above. Under a mirror image, a counter-notification would be proper under Section 512(f) only if the disputed use was fair or otherwise non-infringing under clearly established law. I reject this reading because it leaves no breathing room for the indeterminacy of the fair-use doctrine. More fundamentally, the statute makes clear that a counter-notice need not be unassailable.

201. *Id.* If the user is located outside the United States, they must consent to jurisdiction in any district where the intermediary may be found. *Id.*

202. *See* *Int'l Shoe Co. v. Washington*, 326 U.S. 310 (1945).

203. *See* 42 U.S.C.A. § 1983 (West 2009) (action for deprivation of civil rights); *Groh v. Ramirez*, 540 U.S. 551, 563 (2004) (holding that qualified immunity hinges “on whether the right that was transgressed was clearly established - that is, whether it would be clear to a reasonable officer that his conduct was unlawful in the situation he confronted”) (some internal quotations removed); *Harlow v. Fitzgerald*, 457 U.S. 800, 818 (1982) (“government officials performing discretionary functions generally are shielded from liability for civil damages insofar as their conduct does not violate clearly established statutory or constitutional rights of which a reasonable person would have known”).

Instead, Section 512(g) only requires that a user have a *good faith* belief that the take-down was based on a mistake.²⁰⁴ This does not require that the user be *correct*, it only requires that the user have a good faith belief that the owner is *wrong*. This should permit an argument that current law does not foreclose fair use and that a reasonable extension or analogous application of existing law would support fair use.

But I emphasize that it is not enough for a user to blithely assert fair use without inquiry. A take-down puts a user on notice of claimed infringement. Before sending a counter-notice, the user must consider whether its use is infringing.²⁰⁵ Just as an owner cannot be willfully blind to fair use, a user cannot be willfully blind to its own infringement.²⁰⁶ A user's willful failure to consider the merits of its counter-notice could be a bad faith assertion of non-infringement, and may open it up to Section 512(f) liability if the use was infringing under clearly established law that a reasonable person would have known or would have learned through reasonable inquiry.

Nevertheless, copyright owners may still fear that permitting counter-notifications to assert fair use will encourage baseless counter-notifications, increasing infringement and gutting the protections they obtained through the DMCA. Indeed, it is true that my approach would increase the number of counter-notifications and likely also lead to some baseless fair use claims. However, I think this argument proves too much, as can be shown by examination of the same hypotheticals discussed in the context of take-down notices.²⁰⁷ I will re-address the same examples discussed in Part III.D, but in an order more fitting to the counter-notice concerns at hand.

1. Likely non-infringement

Part III.D.2 discussed two examples: Hitler's globe, and an Air Force video. Suppose hypothetically a user had taken a picture of Hitler's globe and posted it to a website. Suppose additionally that the purchaser of the globe, who apparently lacks copyright, has the photo removed pursuant to a take-down notice. Under such circumstances, the take-down would appear to be unfounded and the user must have the right to assert the purchaser's mistaken claim of ownership as a basis for

204. 17 U.S.C.A. § 512(g)(3)(C) (West 2009).

205. The extent of the due diligence may vary depending on the circumstances of the disputed use.

206. See *supra* Part III.C.

207. See *supra* Part III.D.

put-back. Requiring the user to file suit to obtain put-back would be a heavy burden, considering that this hypothetical claim appears to be without merit.

Similarly, recall the take-down of the Air Force video. The user whose online content is removed may reasonably question whether the Air Force had any rights to assert. Here, however, the user should not blindly assume that the Air Force has no rights as they might exist via assignment. The user might therefore make an inquiry with the Air Force, asking whether it owns any copyright. If the work was entirely created as a U.S. Government work, then no copyright rights ever existed and the take-down notice would be baseless. On the other hand, it is possible that the work did not qualify as a government work and that any copyright was properly assigned to the Air Force. But by making inquiry, a user avoids willful blindness, making a counter-notice in good faith.²⁰⁸

2. Likely fair use

Part III.D.3 discussed the examples of Wendy Seltzer's NFL video, Senator McCain's dispute with Fox News, and the *Lenz* case. All three cases involve strong assertions of fair use because the uses were either non-commercial (Seltzer and *Lenz*), for purposes of commentary or criticism (Seltzer and McCain), or were parodic in nature (*Lenz*). In all three cases, only small amounts of the original works were used (Seltzer's short clip, McCain's short clip, and *Lenz*'s twenty-second audio of poor quality). In two of them, the original materials taken were factual or not particularly creative in nature (Seltzer's NFL video and McCain's portion of a debate). In all, the prospects of market harm were little-to-none. Nobody will stop watching NFL games because of Seltzer's video. Nobody will stop watching Fox News because Senator McCain used a portion of his own debate performance in a campaign advertisement. Nobody will substitute *Lenz*'s low-resolution audio of twenty seconds of *Let's Go Crazy* for Prince's original. All three cases show strong fair use arguments. Under such circumstances, users would have strong bases for asserting put-back, making their counter-notices in good faith.

208. Even if the Air Force owns the video, the use might be fair if done for purposes of commentary, which should be considered by the user. This would require further analysis.

3. Unclear fair use

Part III.D.4 gave an example of unclear fair use, namely, Danger Mouse's *The Grey Album*. There are meritorious fair use arguments here. The work was not distributed commercially. Although it's hard to characterize *The Grey Album* as a typical parody (it doesn't make you laugh),²⁰⁹ the work is nonetheless highly transformative, by taking two seemingly disparate styles of music and mashing them together into something new. By doing so, Danger Mouse comments, in a fashion, on both works. But there are counter-arguments. Both the original works (*The White Album* and *The Black Album*) are commercial creative works. Plus, one can argue that *The Grey Album* might serve as a market substitute, at least for users who want to hear *The Black Album*.²¹⁰ One could even argue that mash-ups might be something that the owners of the original works might be interested in creating or licensing.²¹¹ Indeed, The Beatles themselves have recently released a mash-up album of their own works, *Love*, which takes snippets from various Beatles' songs and works them together in new ways.²¹²

Such a case shows a good example of where both the take-down and the counter-notice might be made in good faith. The law on fair use here is sufficiently uncertain that the copyright owner could conclude in good faith that the use is not fair, permitting take-down. Equally so, the user could conclude in good faith that fair use is not at all foreclosed under existing law, also permitting a counter-notice. Recalling my qualified-immunity analogy, here, the user would not be making a knowing material misrepresentation, because the disputed use was not considered infringing by clearly established law. Instead, it is an unclear issue that requires court adjudication. After counter-notice, the materials should be restored. If the owner cares enough, it should negotiate with the user or file suit. The lack of a real copyright injury here is implicitly

209. Nonetheless, in *Suntrust Bank v. Houghton Mifflin Co.*, the court held that the book *Wind Done Gone* was a parody of Mitchell's *Gone with the Wind*, although the parodic nature of the book was somewhat hard to discern. 268 F.3d 1257, 1269 & n. 23 (11th Cir. 2001) (taking an approach to parody that "requires no assessment of whether or not a work is humorous").

210. Market substitution would be less clear for *The White Album* because only snippets of some of the songs are taken. But entire Jay-Z songs with the full lyrics are used in *The Grey Album*.

211. Compare *Princeton Univ. Press v. Michigan Document Services, Inc.*, 99 F.3d 1381, 1387 (6th Cir. 1996) (rejecting argument that licensing argument is circular), and *American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 930-31 (2d Cir. 1994) (same), with *Williams and Wilkins v. United States*, 487 F.2d 1345, 1357 n. 19 (Ct. Cl. 1973) ("one cannot assume at the start the merit of the plaintiff's position, *i. e.*, that plaintiff had the right to license"), *aff'd by equally div. ct.*, 420 U.S. 376 (1975).

212. THE BEATLES, *LOVE* (EMI Records Ltd./Apple Corps. Ltd. 2006).

underscored by the fact that *The Grey Album* remains online years after Grey Tuesday.

4. Likely infringement

Finally, I will discuss cases where infringement is likely. Part III.D.1 discussed the examples of the album *Chinese Democracy* and the movie *Shrek the Third*. As noted, such cases present what appear to be obvious cases of copyright infringement. Under such circumstances, there would appear to be no mistake of law and a user would have no basis to send a counter-notice. Significantly, a take-down notice provides circumstances that would require the user to consider whether the disputed use is in fact infringing. Failure to do before sending counter-notice could be willful blindness.²¹³ As a practical matter, users who engage in flagrant infringement are unlikely to send counter-notices, because they would have to sacrifice anonymity and consent to suit for significant damages. This factor by itself will significantly deter baseless counter-notices.

C. *The DMCA is poorly suited for complex cases*

As a final note, the fact that some people may abuse the process is not a proper basis to deny users the right to make good faith assertions of fair use. Indeed, considering that fair use is an often indeterminate area of the law, the DMCA take-down procedure is ill-suited to *bona fide* issues of fair use. A useful analogy can be found through domain name disputes. The Uniform Domain Name Dispute Resolution Policy ("UDRP") is a streamlined arbitration procedure that was created to provide a low-cost and quick mechanism to obtain transfer of cybersquatted domain names.²¹⁴ It is more involved than DMCA take-downs but is significantly quicker and cheaper than court litigation. However, some disputes are still better suited to full judicial intervention. One UDRP panel, over dissent, refused to transfer the domain name MERCEDESSHOP.COM to DaimlerChrysler.²¹⁵ The

213. Indeed, in a world where RIAA lawsuits and knowledge of the Napster lawsuit is widespread, people commonly know that file sharers may be directly liable for copyright infringement.

214. ICANN, Uniform Domain Name Dispute Resolution Policy, <http://www.icann.org/en/udrp/udrp-policy-24oct99.htm> (adopted Aug. 26, 1999).

215. DaimlerChrysler A.G. v. Donald Drummonds, WIPO No. D2001-0160 (2001), *available at* <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0160.html>.

case raised difficult issues of trademark fair use, and the majority concluded such matters were far beyond the limited scope of the UDRP:

The majority also notes that the Policy was not designed to deal with, nor is the Panel asked to determine, the issue of trademark infringement. Whether the use of Complainant's trademark on Respondent's web site constitutes trademark infringement is not for the Panel to decide. If Complainant wishes to pursue that issue, other forums are available.²¹⁶

These considerations ring even clearer in the context of a Section 512 take-down. In a case where infringement is obvious, it will provide a quick remedy to the owner. But where potentially difficult issues of fair use exist, Section 512's simple *ex parte* procedure is less appropriate, and breathing room must be given for users to obtain put-back. If owners care enough about the dispute, the burden should be on them to choose court litigation, where fair use can be adjudicated by a knowledgeable and neutral judge. Indeed, Section 512 itself makes clear that in normal circumstances, it is not the user who is expected to file suit, but the owner. Whereas a user sending counter-notice must submit to personal jurisdiction, there is no comparable provision for an owner sending a take-down notice.²¹⁷ Also, the counter-notice provision indicates that put-back must occur between ten and fourteen days after counter-notice is received, unless the service provider receives notice that the owner has filed a relevant copyright lawsuit.²¹⁸ Thus, the burden of filing suit is on the owner and not the user.²¹⁹ Although the DMCA is intended to reduce transaction costs through an abbreviated procedure, more complex disputes belong in a court of law, and the burden of seeking judicial redress should be placed on the party who seeks removal of the speech of others.²²⁰

As a practical matter, after a counter-notice is sent, the owner should contact the user directly. If the material is indeed infringing, a proper cease-and-desist letter sent directly to the user can directly inform

216. *Id.* at ¶ 6.

217. 17 U.S.C.A. § 512(g)(3)(D) (West 2009).

218. *Id.* § 512(g)(2)(C).

219. Nonetheless, there is no bar on users filing suits for a declaration of non-infringement. *See* 28 U.S.C.A. § 2201 (West 2009) (declaratory judgment act). Plus, Section 512(f) permits users to seek damages and attorney's fees for an owner's knowing material misrepresentations that the materials were infringing. 17 U.S.C.A. § 512(f) (West 2009).

220. Indeed, considering how willing the RIAA was to file numerous lawsuits for file-sharing, it is hard to imagine that it would be that burdensome for copyright owners to file copyright suits if they are particularly interested in pressing their claims.

him or her of the consequences, and may achieve the owner's goals directly without the need for more formal legal action. After all, when a user sends a counter-notification, it is incumbent on the owner to reconsider its claim: the user has claimed on penalty of perjury that the owner made a mistake of law or fact in its notice. At this point, the appropriate course of action is for the parties to resolve the matter or litigate.

Moreover, experience has shown that it is indeed possible for copyright owners to tell the difference between clear cases of infringement and more difficult cases. Viacom – the company that has sued YouTube for copyright infringement – now uses real people trained in fair use to review videos.²²¹ It further declares that it has “not generally challenged users . . . where the use or copy is occasional and is a creative, newsworthy or transformative use of a limited excerpt for non commercial purposes.”²²² It would appear that Viacom is more interested in removal of clearly infringing materials and has little-to-no interest in expending resources on *bona fide* fair-use issues. Even more fundamentally, Viacom likely has little interest in antagonizing viewers who watch its shows and movies. Such an approach gives some reason for cautious optimism regarding the future of fair use on the internet.²²³

221. See *supra* note 34 (regarding suit by Viacom against YouTube); K.C. Jones, *Viacom Settles One YouTube Copyright Dispute*, INFORMATIONWEEK, Apr. 4, 2007, <http://www.informationweek.com/news/internet/ebusiness/showArticle.jhtml?articleID=199201099>. Viacom was sued for taking down a YouTube video with material from *Comedy Central*. See Williams, *supra* note 99, at 4-6 (discussing suit over *Stop the Falsiness* video). Viacom admitted that the take-down was erroneous and improved its existing copyright procedures (which it claimed were already good), including posting materials online regarding fair use. See Electronic Frontier Foundation, *Viacom Admits Error – Takes Steps to Protect Fair Use on YouTube*, Apr. 23, 2007, <http://www.eff.org/deeplinks/2007/04/viacom-admits-error-takes-steps-protect-fair-use-youtube>. The suit was dismissed by the plaintiffs. *Id.*

222. Viacom, *Fair Use and Availability of Viacom Content on Authorized Websites*, <http://www.viacom.com/news/pages/aboutfairuse.aspx> (last visited Feb. 17, 2009). A presentation by Viacom general counsel Michael Fricklas is illuminating. See Hoag Levins, producer, *Why Viacom Ignores Mash-ups of Its Copyrighted Content*, ADVERTISING AGE, Feb. 12, 2009, http://adage.com/video/article?article_id=134571 (including link to podcast). Fricklas considers fair use to be a “sideshow,” and that the real issue is “exact copies with no substantial additional creativity.” *Id.* He also noted that he would not be interested in taking down a video of SpongeBob Squarepants to which somebody had added a soundtrack, regardless of whether the use was fair. *Id.*

223. An interesting development beyond the scope of this Article is the role of automatic filtering systems. YouTube’s “Content ID” tool permits owners to create digital “fingerprints” of their audio and video works; if a user’s video matches the fingerprint, the video it can be blocked, tracked, or monetized. YouTube, *YouTube Copyright Policy: Video Identification Tool*, <http://www.google.com/support/youtube/bin/answer.py?hl=en&answer=83766> (last visited Feb. 17, 2009); YouTube, *Content Identification and Management System (Content ID)*, <http://www.youtube.com/t/contentid> (last visited Feb. 17, 2009). Although the system is efficient

CONCLUSION

Although I have titled this Article *Safety Dance*, it might have easily been called *DMCA Take-Downs and Fair Use: A Tale of Two Senators*. Despite Senator Ashcroft's desire, the take-down procedure has not protected users as much as he hoped. But with a more fair-use friendly interpretation, many of Ashcroft's goals might be realized. In contrast, under current law, no amount of interpretation can support the suggestions made by Senator McCain. Intermediaries have done much to further the goals of fair use, but they cannot be expected to cavalierly sacrifice their safe harbor. In sum, other courts should adopt the holding of *Lenz*, making copyright owners stop-and-think before sending baseless take-down notices. Owners cannot be willfully blind to strong showings of fair use. Finally, users must be permitted to send counter-notifications based on fair or other non-infringing use.

for owners, it can lead to erroneous removals of arguable fair uses, such as when a user creates a remix video using copyrighted music along with images that comment on the music. See Fred von Lohmann, *YouTube's January Fair Use Massacre*, EFF DEEPLINKS BLOG, Feb. 3, 2009, <http://www.eff.org/deeplinks/2009/01/youtubes-january-fair-use-massacre>; cf. also *supra* notes 91-92 and accompanying text (discussing Shatner video). YouTube does have procedures to protect users. YouTube permits users to dispute removals, and upon receiving a dispute, it notifies the copyright owner, who must decide whether to submit a take-down notice. See YouTube, *Copyright Claim Disputes: Video ID Disputes*, <http://www.google.com/support/youtube/bin/answer.py?answer=83768> (last visited Feb. 17, 2009). The Content ID program is outside of the scope of the DMCA, but properly implemented, could go a long way towards permitting efficient copyright enforcement without overly censoring fair use. First, filtering technology should be further refined to err on the side of transformative uses. Von Lohmann suggests that videos not be removed unless both audio and video coincide. See Von Lohmann, *supra*. Instead, where the match is only audio or video, a better course for YouTube would be to notify the owner rather than automatically blocking the user's video. Indeed, if Viacom doesn't care if somebody puts a soundtrack to SpongeBob, why should YouTube? See Levins, *supra* note 222 (comments by Viacom general counsel Michael Fricklas). Second, users must be able to assert fair or other non-infringing uses as a basis for put-back of blocked materials. Third, put-back should be immediate or relatively quick, since the ten to fourteen day delay of the DMCA is inapplicable.