A Modern Whodunit

Takedown notifications' impact on identifying alleged copyright infringers.

BY **PIERRE GROSDIDIER**

The Digital Millennium Copyright Act's safe harbor section 512 shields qualifying online service providers from claims of copyright infringement by their users.[1] But copyright owners can send providers takedown notifications to remove infringing material as well as subpoenas to learn the identities of who uploaded the materials.[2]

In 2015's *In re DMCA Subpoena to eBay, Inc.*, eBay sought to quash a subpoena served by photographer Barry Rosen,[3] arguing that Rosen's subpoena was invalid because it was served after the company had received his takedown notification and had removed the infringing material. Although the California federal district court upheld the validity of Rosen's subpoena, the case illustrates the importance to copyright owners of complying *substantially* with section 512's notification requirements.

Section 512 protects online service providers from infringement done by their users, such as when someone uploads a video to YouTube without the copyright owner's permission. For copyright owners to discover the identities of the alleged infringers, subsection 512(h) provides for a subpoena process. In simple terms, a copyright owner must present to a district court, inter alia, a proposed subpoena and copy of a notification that was, or will be, served on the provider and that complies with section 512(c)(3)(A) by including "substantially" six items of specific identifying information that allows the provider to locate the infringing material. The owner must serve the subpoena with or after serving the notification.[4]

In *In re DMCA*, eBay's move to quash the subpoena relied on a 2011 California federal district court case with somewhat different circumstances. The court in *Maximized Living, Inc. v. Google, Inc.* quashed a DMCA subpoena on motion by the alleged infringer (designated as John Doe) "because the documentation initially filed with the Court did not meet the statutory requirements of section 512, and because the subpoena" was overbroad.[5] The day after the court quashed the subpoena, Doe made it known through his attorney that the disputed material had been taken down.

A month later, the copyright owner sent Google a DMCA notification letter and, five months later, it served another subpoena. Doe moved to quash this second subpoena, arguing that the notification did not comply with section 512 "because the infringing material had already been taken down." The court agreed with Doe that section 512(h)'s subpoena power applies only when there is "currently infringing activity." The language of section 512(c)(3)(A)(iii), which is integral to section 512(h), requires the copyright owner to identify "the material that is claimed *to be infringing* or to be the subject of *infringing* activity and that is to be removed or access to which is to be disabled."[6] The court held that this language's strict present tense does not reach past infringing activity that is no longer ongoing and that cannot be terminated. Because the copyright owner could not identify infringing material coexistent with the second notification and subpoena, the court in *Maximized Living* granted Doe's motion to quash.

In *eBay*, however, Rosen served the takedown notifications before the infringing material was removed and eBay did not challenge the notifications' validity.[7] eBay's motion to quash raised the question of whether a DMCA subpoena becomes void if the infringing material is removed after an online service provider is served with a notification but before it is served a subpoena. The court squarely rejected this proposition. The plain language of section 512(h) states that a copyright owner may serve a subpoena after serving a notification. Moreover, the provider must respond to the copyright owner "regardless" of whether it has responded to the notification.[8] The court held, therefore, that a subpoena is valid whether served at the same time as or after a valid notification, and that the latter is valid if served when copyrighted material is infringed. The point of the notification is to give the online service provider access to section 512's safe harbor, but this does not protect the alleged wrongdoer whose identity must be revealed regardless of whether the provider responds to the notification.

The takeaway from these two cases is that DMCA notification details matter. A DMCA section 512(c)(3)(a) notification that fails to comply "substantially" with the statutory requirements might be held invalid when challenged in court. But it will almost certainly tip off the online service provider and the wrongdoer that infringing material must be taken down. Once the material is removed, the copyright owner might have lost a chance to learn the identity of the alleged infringer because a second notification and subpoena might be held invalid (at least that has been the case in the U.S. District Court for the Southern District of California). The practical takeaway is to serve the notification and the subpoena concurrently to avoid the risk of leaving yourself with a whodunit. **TBJ**

Notes

1. *See* 17 U.S.C. § 512(a)-(d). Section 512 is known as the Online Copyright Infringement Liability Limitation Act.
2. *Id.* § 512(b)-(d), (h).
3. No. 15cv922, 2015 WL 3555270, at *1 (S.D. Cal. June 5, 2015).
4. *Id.* § 512(h)(5) (subpoena must "either accompany[] or [be] subsequent to the receipt of a notification").
5. No. C11-80061, WL 6749017, at *1 (N.D. Cal. Dec. 22, 2011).
6. 17 U.S.C. § 512(c)(3)(A)(iii) (emphases added).
7. *eBay*, 2015 WL 3555270, at *3.
8. *Id.*; see also 17 U.S.C. § 512(h)(5).

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