A Modern Whodunit: Non-compliant DMCA § 512 "Take-down" Notifications Might Prevent a Copyright Owner from Learning an Alleged Infringer's Identity

By Pierre Grosdidier

The Digital Millennium Copyright Act's ("DMCA") safe harbor § 512 shields qualifying online service providers ("OSPs") from claims of copyright infringement.[1] But copyright owners can send OSPs take-down notifications to remove infringing material, and subpoenas to learn the identity of the wrongdoer who uploaded the material to the OSPs' websites.[2] In *In re DMCA Subpoena to eBay, Inc.*, eBay sought to quash a subpoena served by Barry Rosen (a photographer). No. 15-cv-922, 2015 WL 3555270, at *1 (S.D. Cal. June 5, 2015) (slip op.). eBay argued that Rosen's subpoena was invalid because it was served after eBay had received Rosen's notification and after eBay had removed the infringing material. Although the district court upheld the validity of Rosen's subpoena, the case illustrates the importance to copyright owners of complying *substantially* with § 512's notification requirements.

Section 512 protects OSPs from infringement because of the doings of their users, like when a user uploads a video to YouTube without the copyright owner's permission. Subsection 512(h) governs the subpoena process, which allows copyright owners to discover the identity of alleged infringers. In simple terms, a copyright owner must present to a district court, *inter alia*, a proposed subpoena and a copy of a notification that was, or will be, served on the OSP and that complies with § 512(c)(3)(A). This subsection provides that the notification must "include[] substantially" six items of information, which must be specific enough to allow the OSP to identify and locate the infringing material. The owner must serve the subpoena together with or after serving the notification.[3]

In *In re DMCA*, eBay moved to quash a subpoena on the basis that it was allegedly invalid. eBay relied on an earlier California district court case, *Maximized Living, Inc. v. Google, Inc.*, where the court quashed a DMCA subpoena under somewhat different circumstances.[4] In that

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[1] *See* 17 U.S.C. § 512(a)-(d). Section 512 is known as the Online Copyright Infringement Liability Limitation Act ("OCILLA").

[2] *Id.* § 512(b)-(d), (h).

[3] *Id.* § 512(h)(5) (subpoena must "either accompany[] or [be] subsequent to the receipt of a notification").

[4] No. C 11-80061, 2015 WL 6749017 (N.D. Cal. Dec. 22, 2011).

case, the court quashed a first 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, on June 24, 2011, the copyright owner sent Google a DMCA notification letter and, five months later, on October 20, it served another § 512 subpoena. Doe moved to quash this second subpoena, arguing that the notification did not comply with § 512 "because the infringing material had already been taken down." The *Maximized Living* court agreed with Doe that § 512(h)'s subpoena power reaches only "currently infringing activity." The language of § 512(c)(3)(A)(iii), which is integral to § 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 the subpoena, the *Maximized Living* court granted Doe's motion to quash.

In *eBay*, Rosen served the DMCA 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 between the time an OSP is served with a notification and a subpoena. The court squarely rejected this proposition. The plain language of § 512(h) states that a copyright owner may serve a subpoena after serving a notification. Moreover, the OSP must respond to the copyright owner "regardless of whether the [OSP] responds to the notification."[8] The court held, therefore, that a subpoena is valid whether served together with 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 OSP access to § 512's safe harbor. But the safe harbor does not protect the alleged wrongdoer whose identity the OSP has to reveal regardless of whether the OSP responds to the notification.

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[5] *Id.* at *1.

[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).

The take-away from these two cases is that, as is so often the case, DMCA notification details matter. A DMCA § 512(c)(3)(a) notification that fails to comply "substantially" with the statutory requirements might be held invalid when challenged in court. But the notification will almost certainly tip-off the OSP and the wrongdoer that infringing material must be taken down. Once the material is removed, the copyright owner might have lost his chance to learn the identity of the alleged infringer because a second round of notification and subpoena might be held invalid, at least in the Southern District of California. The practical take-away is to serve the notification and the subpoena concurrently to avoid the risk of leaving yourself with a "whodunit" caper.

About the Author

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