

DMCA TAKEDOWN? NOT WITHOUT A REGISTRATION

by **Joshua Kaufman**

A recent court ruling has provided yet another reason to register your copyrights sooner than later. One of the most effective ways of protecting your copyrights is a takedown under the Digital Millennium Copyright Act (DMCA) (17 U.S.C. § 512). The DMCA was an outgrowth of a compromise between Web hosts and copyright owners.



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Pre-Internet, the publisher of content, be it in a newspaper or magazine, was liable for copyright infringing matter which appeared in their publications. With the advent of the early Internet bulletin boards, websites provided users the ability to upload material, also known as user-generated content (UGC). The result was a flooding of photographs, music, and text being uploaded to the Web.

Unfortunately a significant part of the UGC being uploaded was infringing, and the copyright owners looked to the Web hosts/websites for relief and attempted to hold the Web hosts/websites liable for the infringing UGC. The websites understandably claimed that they had no

idea what people were posting and that there was no way for them to know, with hundreds of thousands or millions of UGC postings, what was contained in them. The copyright owners argued that the Internet could not be a marketplace for infringing goods with the hosts being free from any liability.

The compromise that was reached and set out in the DMCA was quite simple, that if a copyright owner felt that his or her copyright were being infringed upon on a website they would send a Takedown Notification Letter to the website.

The statute provides in detail what the Takedown Notification Letter must contain. Upon receipt of a proper Takedown Notification Letter, the website is on notice of the claim and they are required to "expeditiously" take down the allegedly infringing material and to send a notice to their customer saying that they

have received a DMCA takedown notice and are taking down the UGC.

Their customer then has the opportunity to do nothing at all, and the work remains down, or files a Counter-Notification Letter claiming non-infringement. The contents of the Counter-Notification Letter are also very specifically laid out in the DMCA. Upon receipt of the Counter-Notification Letter the Web host notifies the copyright owner that a Counter-Notification Letter has been received and if the copyright owner does nothing the work at issue would

no liability to the copyright owner for the posted infringing material, nor to its customer for taking down the material.

The DMCA takedown has been effective, although it certainly has frayed at the edges, when dealing with mass infringements where the courts have ruled that for each infringement a separate DMCA notice is to be provided. Thus in certain recent cases courts have required hundreds of thousands of takedown notices to be filed, but that is an issue for another day. The issue linking DMCA takedowns and copyright registrations stems from the fact that the copyright owner has only between 10 to 14 days to file suit in order

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be put back up on the site. However, if the copyright owner within 10 to 14 days files suit against the alleged infringer the material would not be put back up and would remain off the site during the pendency of the litigation.

If the Web host followed the DMCA procedures (i.e. registered a DMCA agent with the copyright office, established Takedown, and repeat infringer policies) it has

to keep the allegedly infringing works off the website after a counter-notification has been posted. Under the Copyright Act there is a prerequisite that before filing a copyright infringement law suit that a U.S. created work must be registered with the U.S. Copyright Office. There is a massive schism in court opinions by what is meant

continued on page 42

LEGAL ISSUES

REGISTRATION continued from page 40

by "copyright registration." There are two camps: The Application Camp, one which holds that simply filing the application with the appropriate fee and deposit material is sufficient in order for the court to have jurisdiction and a case to proceed; and the Registration Camp, which says no, you actually have to have the final copyright registration back from the Copyright Office.

The problem is it can take anywhere from six weeks to six months, depending on the nature of the work and the backlog at the Copyright Office, to get an actual registration from the Copyright Office. While there is a provision for expediting the application process (Caution: It is not always available if there is a significant backlog in the Copyright Office) it takes from a week to a couple of weeks in order to accomplish. The other aspect is cost. A basic e-filed application fee to file online for a copyright registration is \$55. To expedite registration of a work, there is an additional surcharge of \$800, in addition to the basic \$55, for a total of \$855 dollars. That would be per published work, therefore, if you are dealing with a number of infringing works the filing fees will, instead of being a de minimis amount of money, could end up in

the thousands of dollars just to be able to get into court.

If you do not already have a registration in place, when you wish to file suit in a DMCA Take Down situation and the case is brought and you are in a registration jurisdiction, you will have to wait and as a result you will be precluded from having the disputed material remaining down during the pendency of any litigation. With the current backlog at the Copyright Office, you would probably still be precluded even if you filed on an expedited basis, as there is a very good chance you would not get the necessary registration back within the 10 to 14 days. Although it is possible, it is just not likely. This situation recently came up in *Schenck v. Orosz*, in the U.S. District Court for the Middle District of Tennessee. The Sixth Circuit, whose decisions control Tennessee, has not yet addressed the issue of whether the registration or application approach is to be adopted. So the trial court in this case looked at other district court judges' rulings and determined that it was going to follow the registration rule.

It did not allow the suit to proceed as to the works where there was not already a registration in hand, and denied providing the plaintiff with the DMCA benefit of

continued on page 44

Registration, recordation and related services Fees (\$)

1. Registration of a standard claim in an original work of authorship:	
Single author, same claimant, one work, not for hire	35
All other filings	55
Paper Filing (Forms PA, SR, TX, VA, SE, SR)	85
2. Registration for a group of published photographs, or an automated database that predominately consists of photographs and updates thereto:	
Electronic filing	55
Paper filing	65
3. Registration of a claim in a group of serials (Form SE/Group) (per issue, minimum 2 issues)	25
4. Registration of a correction or amplification to a claim (Form CA)	130
5. Certification of other Copyright Office records, including search reports (per hour)	200
6. Estimate of search fee (credited to search fee)	200
7. Restoration of document, including a notice of intention to enforce (single title)	105
8. Additional titles (per group of 1 to 10 titles)	35
9. Recordation of a designation of agent to receive notification of claimed infringements under §512 (c) (2)	105

Special Services

1. Appeals:	
First appeal (per claim)	250
Second appeal (per claim)	500
2. Copying of Copyright Office records by staff:	
Photocopy (black & white, 8 1/2 x 11) per page, minimum \$12	0.50
Photocopy (black & white, 11 x 17) per page, minimum \$12	1
Photocopy (color, 8 1/2 x 11) per page, minimum \$12	2
Photocopy (color, 11 x 17) per page, minimum \$12	4
CD or DVD	30
Flash Drive	30
Special handling fee	800
Special handling fee of a recordation of a document	550
Full-term retention of a published deposit	540

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LEGAL ISSUES

REGISTRATION continued from page 42

the takedown and thus permitted the defendants to keep the allegedly infringing works up during the pendency of the litigation. Also, if your works get infringed upon in China, it is likely that infringing work will find its way on to: www.alibaba.com or on to: www.Aliexpress.com, the largest e-Bay type sites in China. To use their takedown procedures you will need to have a registered copyright and the registration number.

It is highly recommended that one registers one's

copyrights prior to releasing the material to the public or in copyright terms, "published." Any time the work is released to the public it can be

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infringed upon and the key benefits of copyright registration attorneys' fees, statutory damages (up to \$150,000), the right to file suit or quickly get an injunction and to get DMCA protections will all be lost unless a registration has been timely filed.

With the e-filing fee of only \$55, and the completion of a relatively simple application, there is no excuse for all works not to be

registered with the Copyright Office in a timely manner. If you care about your copyrights and want to protect them, registering them prior to publication is a must!

The Web address is: www.copyright.gov.

Joshua J. Kaufman, Esq. is a partner in the law firm of Venable, LLP, and Chair of their Copyright & Licensing Group. He is one of the country's foremost attorneys in art, copyright, and licensing law. Mr. Kaufman has published more than 200 articles, co-authored several books, and is a regular lecturer on various topics in the Art Law and Licensing fields. Mr. Kaufman is also an adjunct law professor at American University Law School where he teaches Art Law, and is counsel to the Art Copyright Coalition. E-mail him at: jjkaufman@venable.com or call him at (202) 344-8538.

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