VENABLE® LLP

Articles

March 25, 2014

DMCA Takedown? Not Without a Registration

AUTHORS

Joshua J. Kaufman

RELATED PRACTICES

Intellectual Property

Copyrights and Licensing

ARCHIVES

2014 2010 2006
2013 2009 2005
2012 2008 2004
2011 2007

A recent court ruling has provided yet another reason to register your copyrights sooner rather 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. Pre-Internet, the publisher of content, be it in a newspaper or magazine, was liable for copyright-infringing matter which appeared in its 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 flood of photographs, music, and text being uploaded to the Web.

Unfortunately, a significant part of the UGC being uploaded was infringing. 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, if a copyright owner felt that his or her copyright was being infringed upon on a Website, he or she 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 is required to "expeditiously" take down the allegedly infringing material and to send a notice to the customer saying that it had received a DMCA takedown notice and is taking down the UGC. The customer then has the opportunity to do nothing, and the work remains down, or file a Counter-Notification Letter claiming non-infringement. The contents of the Counter-Notification Letter are also 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 be put back up on the site. However, if the copyright owner files suit within 10 to 14 days 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, and established take down and repeat infringer policies) it has 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's 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 and 14 days to file suit in order to keep the allegedly infringing works off the Website after a counter-notification is 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 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. While there is a provision for

expediting the application process, it takes from a week to a couple of weeks in order to accomplish and it is not always available if there is a significant backlog in the Copyright Office. The other aspect is cost. A basic e-filed application fee to file online for a copyright registration is $35. To expedite registration of a work, there is an additional surcharge of $760, in addition to the basic $35, for a total of $795 dollars. (Rates are due to change on May 1, 2014. We will be sending an Alert out as to the new fee schedule). That would be per published work. Therefore, if you are dealing with a number of infringing works the filing fees 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 if 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 in 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 the takedown and thus permitted the defendants to keep the allegedly infringing works up during the pendency of the litigation.

It is always highly recommended that one registers his or her 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 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 had been timely filed.[1] With the e-filing fee of only $35, 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!

---

[1] Foreign works are not required to be registered in order to file suit, however, do not get attorneys' fees and statutory damages, the same as a U.S. work, unless they file prior to the act of infringement.