

Misrepresentation Under the DMCA: The State of the Law

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I. Introduction

The Digital Millennium Copyright Act (DMCA) was enacted in 1998, a time when widespread Internet access was a “relatively new concept”¹ and materials were not as rapidly disseminated as they are today. In order to balance the interests of copyright owners, online service providers, and the users of those services, one goal of the statute was to create a safe harbor from liability for copyright infringement for Internet service providers (ISPs or service providers), which would “provide[] greater certainty to service providers concerning their legal exposure for infringements that may occur in the course of their activities.”² Service providers can avail themselves of this safe harbor of §512 of the DMCA if, among taking other steps to comply with the statute, they follow the extrajudicial mechanism by which copyright owners can have infringing content quickly removed from the Internet, and users whose material had been wrongfully removed can direct the service provider to put back the material. These takedown and “put back” procedures were designed for the purpose of providing a process whereby copyright owners could have infringing copies of their works expeditiously removed from the Internet without being required to engage in the lengthy process of seeking judicial remedy, while also providing a self-help remedy for users whose material was improperly removed. Supporters of the system believe that the notice and takedown procedures are the only way to combat widespread infringement on the Internet because of the speed with which the high number of infringements occurs daily. Opponents of the process argue that the put back procedure is insufficient to remedy the harm caused to a user from having his or her material removed by an improper takedown notice.³ In addition, some argue that the notice and takedown procedure is being abused by people and entities who use the DMCA to silence their critics and suppress free speech, and not for the purpose of validly enforcing copyrights. These opponents also argue that abuse of the notice and takedown procedure weakens the fair use doctrine, an important counterbalance to the long-term exclusive rights granted to copyright owners. In addition to the put back procedures, users who believe that their materials have been removed unlawfully can employ the section of the DMCA which provides for a cause of action against a copyright owner who misrepresents that the materials are infringing in a takedown notice.⁴ The statutory language and the prevailing case law, however, set a high bar for an aggrieved user to overcome in order to prevail on such a claim.

Some recent and pending cases provide examples of attempts to surmount or lower that bar.

II. The Statute

Service providers are generally shielded from liability for copyright infringement if they comply with the notice, takedown and put back procedures of §512. The copyright owners utilizing the notice/takedown procedures, and any user invoking the put back procedure, must adhere to the rules of the statute. In making a takedown request, the copyright owner must state, among other things, 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.”⁵ A user whose material has been taken down pursuant to a takedown notice from a copyright owner has recourse to have the material replaced. Section 512(g) contains the put back procedure, whereby a user may send a counter notification to the service provider stating that he or she “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.”⁶ The ISP must then replace the material within 10 to 14 days, unless the copyright owner commences suit against the user within that time frame.⁷ The Senate Report on the DMCA conveys Congress’ belief that “[t]he provisions in the bill balance the need for rapid response to potential infringement with the end-users [sic] legitimate interests in not having material removed without recourse.”⁸

In addition, Congress “was acutely concerned that it provide all end-users...with appropriate procedural protections to ensure that material is not disabled without proper justification.”⁹ While the statute does not provide *per se* liability for a violation of §512(c)(3)(A)(v), Congress did impose liability on a copyright owner who “knowingly materially misrepresents” that the material it is requesting to be taken down is infringing.¹⁰ Section 512(f) provides:

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.¹¹

Congress's reason for including §512(f) was "to deter knowingly false allegations to service providers in recognition that such misrepresentations are detrimental to rights holders, service providers, and Internet users."¹² Courts around the country have addressed the issue of determining what steps a copyright owner must take, or fail to take, in order to be liable for "knowingly materially misrepresenting" that a work is infringing because it is not "authorized by law."

III. Problems of Interpretation

A. What Does "Knowingly Materially Misrepresenting" Mean?

Under what circumstances will a court find a defendant liable for "knowingly materially misrepresenting" that "the material or activity is infringing" in a DMCA takedown notice? Should "knowing misrepresentation" be based on an objective reasonableness standard, or a subjective standard demonstrating that the defendant knew the use was not infringing and sent the notice anyway?

1. Existing Case Law

*Online Policy Group v. Diebold, Inc.*¹³ was a decision from the Northern District of California in which the court applied an objective test to define "knowingly" in the context of §512(f). Diebold, Inc. (Diebold) made electronic voting machines which had come under public criticism during the 2000 presidential election. Two of the plaintiffs, college students, obtained an archive of internal emails among Diebold employees in which there was evidence that some employees were aware of problems of accuracy of the machines. The students published the archive online, and an online newspaper wrote an article criticizing the machines, providing a link to the archive. Diebold sent takedown notices to the students' and the online newspaper's ISPs. The plaintiffs sued Diebold for a declaratory judgment and liability under §512(f). Concluding that "the statutory language is sufficiently clear," and adopting a definition from Black's Law Dictionary, that court ruled 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.¹⁴ In applying this objective test to the facts, the court reasoned that "no reasonable copyright holder could have believed that the portions of the mail archive discussing possible technical problems with Diebold's voting machines were protected by copyright," and

granted plaintiff's summary judgment as to the §512(f) claim.¹⁵ The court also considered the fact that Diebold never sued any of the plaintiffs for copyright infringement as a presumption that Diebold was using the DMCA takedown procedure "as a sword to suppress publication of embarrassing content rather than as a shield to protect its intellectual property."¹⁶

Shortly after the decision in *Diebold*, the Ninth Circuit issued its decision in *Rossi v. Motion Picture Ass'n of Am. Inc.*,¹⁷ in which it applied a subjective test to define "good faith." Michael J. Rossi (Rossi) owned and operated a website, internetmovies.com, which he described as "an internet news magazine providing information and resources about movies on the internet."¹⁸ The Motion Picture Association of America (MPAA), the trade organization that represents the interests of the major motion picture studios, reviewed the site and discovered statements such as: "Join to download full length movies online now!"; "Full Length Downloadable Movies"; and "NOW DOWNLOADABLE." The MPAA subsequently sent takedown notices to Rossi and his ISP. Rossi sued the MPAA for, among other things, tortious interference with his contractual relationship with his ISP resulting from sending the takedown notice. On the MPAA's motion for summary judgment, construing the good faith requirement of §512(c)(3)(A)(v), the district court held the MPAA not liable for misrepresentation, finding that the information discovered on visiting the site led the MPAA to have "more than sufficient basis to form the required good faith belief that [Rossi's] site contained infringing content prior to asking the ISP to shut down the site."¹⁹ On appeal, Rossi argued that an objective standard should apply to determine what constitutes failure to use "good faith" in requesting a takedown, and therefore a copyright owner must "conduct a reasonable investigation into the allegedly offending [works]."²⁰ If the MPAA had done so, he argued, it would have seen that one could not actually download any of its movies from the site. Based on its reading of legislative history, the language of the statute, and non-DMCA cases addressing the definition of "good faith," the court concluded that a determination of good faith must be a subjective, rather than objective, standard, reasoning that if the legislature had intended an objective standard, it would have stated so explicitly. Although §512(f) was not before it, as to the mental state required to be liable for misrepresentation, the court read (c)(3)(A)(v) and (f) together, decided that the test should be a subjective one, and commented that "copyright owners cannot be liable simply because an unknowing mistake is made, even if the copyright owner acted unreasonably in making the mistake....[T]here must be a demonstration of some *actual knowledge of misrepresentation* on the part of the copyright owner."²¹ The appeals court agreed that the information obtainable by a review of the site alone was sufficient for the MPAA employee to conclude in good faith that the material was infringing, and affirmed.

While at least one court outside the Northern District of California has followed *Diebold's* objective test,²² most follow *Rossi's* subjective one.²³ One court following *Rossi (Disney Enterprises Inc. v. Hotfile Corp.)* recently held that the defendant counter-claimant actually did present evidence sufficient for his misrepresentation claim to survive summary judgment by presenting evidence that the plaintiff subjectively knew that some of the works on the defendant's site were not infringing on the plaintiff's copyrights when it sent the takedown notice.²⁴ Unfortunately, the defendant lost on many other claims, and ended up settling with the plaintiffs with a judgment against it of \$80 million and dismissal of its misrepresentation counterclaim.

2. Current Cases of Interest

Two cases have recently been filed in the Northern District of California implicating the potential abuse of DMCA takedown notices, and alleging misrepresentation under §512(f).²⁵ In *Automattic Inc. v. Steiner (Straight Pride)*, plaintiffs Oliver Hotham (Hotham) is a journalist and Automattic Inc. is the parent company of WordPress.com (WordPress), Hotham's website host. The defendant identifies himself as the "Press Officer" of an organization called Straight Pride UK, an anti-gay organization in the United Kingdom. Interested in reporting on Straight Pride, and after asking permission from the organization, Hotham sent questions to Straight Pride. The questions were answered by the defendant, labeled "Press Statement," and came with the email address press@straightpride.co.uk. On August 3, 2013, Hotham wrote a blog post about Straight Pride, which included verbatim portions of Straight Pride's responses to his questions. On that same day, Steiner sent a takedown notice to both plaintiffs, claiming copyright infringement of the alleged press release. WordPress removed the posting in accordance with the takedown notice. WordPress was later made aware of the facts surrounding the takedown, and joined with Hotham in suing Steiner in the Northern District of California for misrepresentation under §512(f) on November 21, 2013. In their complaint, the plaintiffs allege that because the defendant knew that Hotham was a journalist, and titled his responses to Hotham's questions "Press Statement," he intended for the Press Statement to be published and therefore he knew he was making a material misrepresentation when he claimed that the blog post was infringing.

In a sister case to Straight Pride, *Automattic Inc. v. Chatwal (Retraction Watch)*, WordPress again sued for misrepresentation under §512(f) on behalf of one of the blogs it hosts.²⁶ The plaintiff Retraction Watch, LLC (Retraction Watch) is a blog dedicated to informing the public about retractions of published scientific results. WordPress hosts the Retraction Watch blog. On October 5, 2012, Retraction Watch published a blog post about a recent retraction notice from a researcher who had on multiple occasions previously made retractions of his findings. In early

February 2013, according to Retraction Watch, defendant Narendra Chatwal (Chatwal) copied 10 of the blog posts about that researcher and published them as his own on his website NewsBullet.in. On February 4, 2013 Chatwal sent WordPress a takedown notice for the 10 blog posts claiming Retraction Watch was infringing his copyrights. On November 21, 2013, WordPress and Retraction Watch sued Chatwal in the Northern District of California for misrepresentation under §512(f), arguing that Chatwal's actions demonstrated that he was using the DMCA to suppress speech. The plaintiffs argued that by copying the blog posts from Retraction Watch and posting them on his own site, the defendant knew that he was making a material misrepresentation by claiming the posts were infringing because it was in fact he who was the infringer.

B. Section 512(3)(c)(A)(v)'s "Good Faith" Requirement and Fair Use

Further complicating misrepresentation claims are the cases in which plaintiffs claim that defendants are liable for misrepresentation under §512(f) because their uses of the allegedly copyright protected materials were fair uses. In order to make a valid 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," pursuant to §512(3)(c)(A)(v), are copyright owners obligated to consider, or make a full-blown analysis of, fair use? Is a defendant's failure to consider fair use evidence that it could not form a subjectively good faith belief that the work was infringing?

Section 107 says explicitly, "[n]otwithstanding the provisions of §§106 and 106A, the fair use of a copyrighted work..., is not an infringement of copyright."²⁷ Proponents of this reading of §512(f) argue that if the use of the complained-of material is fair use, then it is not infringement, so the copyright owner misrepresented that the use was infringing in its takedown notice. While there are those whose position is that fair use is "authorized by the law" as provided in §512(c)(3)(A)(v), the opposing view is that fair use is merely an affirmative defense to a use that would otherwise be an infringement, and that "authorized by the law" means only that the use is subject to a compulsory license.²⁸

1. Existing Case Law

Lenz v. Universal Music Corp. is a DMCA case that has been proceeding in the Northern District of California for almost seven years. In February 2007, Stephanie Lenz (Lenz) recorded a video of her children in her kitchen dancing to the Prince song "Let's Go Crazy," and uploaded the video to YouTube. On June 4, 2007, Universal Music Corp. (Universal), the owners of the copyright in "Let's Go Crazy" sent a takedown notice to YouTube, and the video was taken down. On June 21, 2007, Lenz sent a counter-notice to YouTube, and the video was subsequently replaced. On July 24, 2007, Lenz sued Universal for misrepresentation, interference with her contract with

YouTube, and for declaratory relief, arguing that her use of the song was a self-evident, non-infringing, fair use under 17 U.S.C. §107,²⁹ and that Universal “knew or should have known” that the use was non-infringing.³⁰ On Universal’s motion to dismiss the complaint, on April 8, 2008, the district court dismissed Lenz’s claim for misrepresentation with leave to amend (*Lenz I*).³¹ Discussing *Diebold*’s objective definition of “knowingly,” and mentioning Lenz’s contention that *Rossi* did not interpret “knowingly,” the court stated that “the cases are not necessarily in conflict.” Regardless of the definition of “knowingly” employed, the court found that Lenz failed to allege facts sufficient to infer misrepresentation on the part of Universal and that she failed to allege facts demonstrating that her use of “Let’s Go Crazy” was self-evident fair use.³²

On Universal’s motion to dismiss the amended complaint, on August 20, 2008 (*Lenz II*),³³ the court considered whether fair use was a non-infringing use “authorized by the law” pursuant to §512(3)(c)(A)(v), which a copyright owner must consider prior to being able to make a good faith representation that the user’s use of the copyrighted work is infringing. Universal argued that “fair use is merely an *excused* infringement of a copyright rather than a use *authorized* by the copyright owner or by law.”³⁴ Adopting Lenz’s argument that because §107 of the Copyright Act explicitly provides that “the fair use of a copyrighted work...is not an infringement of copyright,” the court held that a copyright owner must evaluate whether the use of the copyrighted work is a fair use prior to sending a takedown notice in order to demonstrate the good faith belief that the work is infringing under §512(3)(c)(A)(v). The court concluded that “in the majority of cases, a consideration of fair use prior to issuing a takedown notice will not be so complicated as to jeopardize a copyright owner’s ability to respond rapidly to potential infringers,”³⁵ and will maintain the balance intended by Congress between the injury to the public caused by unnecessary removal of non-infringing uses and copyright owners’ right to maintain the integrity of their works. On the matter of whether Universal acted in bad faith when it sent the takedown notice, Lenz alleged facts demonstrating that Universal did not send the takedown notice because it had a good faith belief that the use was infringing, but rather that it sent it in order to appease Prince. Although it stated that it had “considerable doubt that Lenz will be able to prove that Universal acted with the subjective bad faith required by *Rossi*,”³⁶ the court also found that Lenz’s second amended complaint alleged sufficient facts of Universal’s subjective bad faith in sending the takedown to withstand the motion to dismiss.

In its most recent opinion on the case, on January 24, 2013 the district court denied both parties’ motions for summary judgment (*Lenz III*).³⁷ The court, while maintaining that fair use is use “authorized by law” pursuant to §512(3)(c)(A)(v), but apparently refining its rule from its previous opinion, held that even though Lenz

proffered evidence sufficient to prove that Universal did not consider fair use prior to sending the takedown notice, Universal’s mere failure to consider fair use was insufficient to give rise to liability under §512(f) because making a mistake does not amount to liability for misrepresentation, per *Rossi*. The court emphasized that Lenz must “demonstrate that Universal had some actual knowledge that its takedown notice contained a material misrepresentation.”³⁸ Lenz argued that Universal’s failure to evaluate whether her use was fair amounted to willful blindness of whether it was “authorized by the law,” which was equivalent to the actual knowledge purportedly required by *Rossi*. Equating willful blindness and actual knowledge, and applying the two-pronged test for willful blindness from the Supreme Court case of *Global Tech. Appliances, Inc. v. SEB SA*,³⁹ the court found that while Lenz did provide evidence that Universal took deliberate actions to avoid learning whether or not her use was fair by assigning the task of review of the video to an employee untrained in fair use, she did not present evidence that Universal subjectively believed use of the song in YouTube videos generally, or her use of the song specifically, was fair use. Even though the court acknowledged that “a legal conclusion that fair use was ‘self-evident’ necessarily would rest upon an objective measure rather than the subjective standard required by *Rossi*,” it also stated that Lenz was “free to argue that a reasonable actor in Universal’s position would have understood that fair use was ‘self-evident’” and that Universal’s failure to make any inquiry into whether the use was a fair use is evidence of its willful blindness, the proof of which would demonstrate Universal’s misrepresentation in its takedown notice. The court also held that Universal had not shown that “it lacked a subjective belief that there was a high probability” that the use of the song in the video was fair use.⁴⁰

On the other side of the country, the district court in Massachusetts is currently hearing the misrepresentation case of *Tuteur v. Crosley-Corcoran*.⁴¹ This case involves two people with divergent opinions on home birth, each using a blog to condemn the other’s positions. Dr. Amy Tuteur (Tuteur), an OB/GYN, runs “The Skeptical OB” blog, a blog critical of home birth. Gina Crosley-Corcoran (Crosley-Corcoran) runs “The Feminist Breeder,” and is a proponent of home birth. The parties exchanged a series of heated criticisms via their blogs regarding home birth, culminating in Crosley-Corcoran posting a photo of herself giving Tuteur “the finger” on her own blog, with the caption saying that she was giving Tuteur something she “can take back to [her] blog and obsess over....”⁴² Tuteur then did, in fact, repost the photo to her own blog. Crosley-Corcoran sent a takedown notice to Tuteur’s ISP, claiming that Tuteur’s reposting of the photo was infringement of Crosley-Corcoran’s copyright in the photo. After Tuteur moved the blog to another service provider, Crosley-Corcoran sent a takedown notice to that one as well. Unable to reach an amicable resolution among their

counsel, Tuteur filed suit against Crosley-Corcoran, claiming that the latter was liable for misrepresentation under §512(f) because she was using a takedown notice to silence a critic rather than to validly enforce her copyright. Tuteur's complaint asserted that her use of the photo was also not an infringement because Crosley-Corcoran's statement to "take something back to her blog" was a license to do so, or because the use was self-evident fair use, and that Crosley-Corcoran "should have known, if she had acted with reasonable care," that Tuteur's use was non-infringing. Furthermore, Tuteur was able to put forth evidence that Crosley-Corcoran's motive in sending the takedown notices was to silence her critic, and not to enforce her copyright. Specifically, Crosley-Corcoran allegedly made comments on the public Facebook page for "The Feminist Breeder," such as: "Thanks for your continued support and patience while I move things into place," "Oh man, [Tuteur's] brain is going to EXPLODE when she sees what I'm up to," and "When will a certain person learn that no host in their right mind is going to keep her hateful content on their servers?"⁴³ In its order denying Crosley-Corcoran's motion to dismiss, the court rejected Tuteur's reliance on *Diebold's* objective standard for knowing misrepresentation and also rejected the applicability of *Lenz II's* holding that in order for a copyright owner to make a good faith belief that the use of the work is not "authorized by the law," the owner must consider whether the use of the material is fair use. This court affirmatively stated that "Congress did not require that a notice-giver verify that he or she had explored an alleged infringer's possible affirmative defenses prior to acting,"⁴⁴ because "to have required more would have put the takedown procedure at odds with Congress' intent of creating an 'expeditious[,] 'rapid response' to 'potential infringement' on the Internet."⁴⁵ Citing *Lenz III's* "retreat" from its earlier opinion, the court held that the standard to be applied to the copyright owner sending the takedown notice is *Rossi's* subjective test of whether a plaintiff can provide sufficient evidence that the defendant "had some actual knowledge that its Takedown Notice contained a material misrepresentation."⁴⁶ The court did find, however, that the evidence proffered by Tuteur in order to demonstrate that Crosley-Corcoran's motives in sending the takedown notices were for the purpose of silencing a critic, rather than protecting her copyright, was sufficient to plead a claim of "a knowing material misrepresentation" such that the claim survived Crosley-Corcoran's motion to dismiss.

Unlike the district court in *Tuteur*, two cases of note adopted the *Lenz II* rule that "in order for a copyright owner to proceed under the DMCA with 'a good faith belief that use of the material in the manner complained of is not authorized by ... the law,' the owner must evaluate whether the material makes fair use of the copyright."⁴⁷ Both cases also followed *Rossi* in requiring a subjective knowledge of misrepresentation.

In a case where it was the sender of the counter notice accused of misrepresentation in his counter notification by the party sending the original takedown notice,⁴⁸ *Shropshire v. Canning*, the court denied the defendant's motion to dismiss and found that the evidence of the plaintiff's conversations with the defendant explaining how the plaintiff, holder of the song composition copyright, had a copyright interest in the defendant's sound recording, plus the defendant's challenge to the plaintiff to "[g]o ahead, contact the Video site managers and get my video removed" were "specific and plausible allegations that Defendant did not have a good faith belief that the [] video was removed due to mistake or misidentification."⁴⁹ This court equated a "lack of good faith" with "willful misrepresentation" and allowed the plaintiff's §512(f) claim to proceed. Interestingly, the court never mentioned *Rossi* or *Diebold*. Raising the issue of fair use *sua sponte* in a footnote to its decision, the court in *Shropshire* indicated that if that issue were presented to it, it would adopt the *Lenz II* rule that "[f]air use of a copyrighted work does not constitute copyright infringement, and in order to proceed under the DMCA, a copyright owner must evaluate whether the material made fair use of the copyright."⁵⁰

A case out of Montana, *Ouellette v. Viacom Int'l Inc.*, adopted the *Lenz's II* rule that "in asserting its good faith belief of a copyright infringement..., a copyright owner must evaluate whether the material makes fair use of the copyright."⁵¹ In that case, Todd Ouellette (Ouellette), a *pro se* plaintiff, took on Viacom International Inc. (Viacom) for misrepresentation in a takedown notice. The court found, however, that Ouellette had not "presented any factual information plausibly suggesting Viacom actually knew Ouellette made fair use of its copyrighted material," nor did Ouellette plead any actual facts demonstrating that his use of the materials was indeed fair use.

2. Current Cases of Interest

On appeal to the Ninth Circuit, in *Lenz v. Universal*, Universal argues that no evidence exists establishing that Universal willfully blinded itself to the knowledge that *Lenz's* use of the song was fair use, leading to liability for misrepresentation. Universal also argues that even if the failure to consider the fair use defense was a mistake, it does not equate to knowingly making a material misrepresentation that the use is infringing. *Lenz* argues that the district court misapplied *Rossi*, and that *Rossi's* subjective standard applies only to the copyright owner's belief about the facts, and not to its belief about the legal import of those facts. She states that the facts make obviously clear that her use is fair, and was authorized by the law.

The *Tuteur* case is proceeding to trial with motions due in May 2014, and another section 512(f) case has recently been filed in the District of Massachusetts.⁵² The plaintiff in *Lessig v. Liberation Music Pty. Ltd.* is Lawrence Lessig (Lessig), a world-renowned copyright lawyer,

scholar, and professor. In June 2010, Lessig delivered the keynote speech at a Creative Commons conference in South Korea. In his 49-minute presentation, he used five brief clips of amateur music videos for the song “Lisztomania,” by the band Phoenix, found on the Internet. He later posted his lecture on YouTube. Liberation Music, the alleged owner of the copyright in the “Lisztomania” song, sent a takedown notice to YouTube, claiming that Lessig’s use of the clips in his lecture was copyright infringement. Lessig sent a counter notice to YouTube, but later retracted it as a result of alleged threats of legal action by Liberation Music. Lessig sued Liberation Music for declaratory relief and misrepresentation under §512(f), claiming that Liberation Music “knew or should have known that the [] lecture did not infringe its copyright when it sent YouTube the takedown notice,” because Lessig’s use of the work “is lawful under the fair use doctrine.”⁵³

IV. What Next for Misrepresentation Claims?

Even within the Ninth Circuit, the proper way to evaluate §512(3)(c)(A)(v)’s “good faith” requirement, and the mental state required of an actor to conclude that a misrepresentation in a takedown notice that a work was infringing was sent “knowingly,” is in flux. *Rossi* remains the precedential case cited around the country, so the subjective standard for determining “good faith” is generally applied. Some interest groups contend, however, that *Rossi*’s statement that “[a] copyright owner cannot be liable simply because an unknowing mistake is made, even if the copyright owner acted unreasonably in making the mistake,” is dictum and not precedential, because §512(f) and the meaning of “knowingly” was not an issue before that court.⁵⁴

Thus, cases continue to challenge courts’ reading of *Rossi* and distinguish their facts. Lessig, for example, in a case for which no briefs have yet been filed, argues to the court of the District of Massachusetts that Liberation Music “knew or should have known” that his lecture made fair use of Liberation Music’s song, and that Liberation Music therefore “acted in knowing bad faith when it sent the takedown notice, knowingly and materially misrepresenting” that the material was infringing.⁵⁵ As the same court in *Tuteur* held that the reasonableness standard was not the objective “knew or should have known” test, but rather *Rossi*’s subjective test, Lessig may need to establish more facts demonstrating that Liberation Music “knew” it was materially misrepresenting that Lessig’s use of the song in the lecture was infringing in order to prevail on his §512(f) claim.⁵⁶ The *Tuteur* decision, however, may have foreclosed the possibility of Lessig, or any other plaintiff, prevailing on a §512(f) claim in the district of Massachusetts based on the contention that the plaintiff’s use was a fair use and therefore “authorized by law.”

Of the misrepresentation cases currently pending, the plaintiffs in *WordPress* and *Tuteur* may just have enough facts in their favor to prevail on their §512(f) claims. It

remains to be seen whether a reasonable trier of fact will find that Crosley-Corcoran’s actions and statements are sufficient proof that she knew her statement in her takedown notices that Tuteur’s use of the photo was infringement was false. It appears that such mental state will have to be proven without relying on the claim that Crosley-Corcoran failed to consider whether Tuteur’s use of the photo was fair use, as the district court has already rejected that argument. Similarly, if proven true, the facts supporting the misrepresentation claims in *Straight Pride* and *Retraction Watch* could also satisfy the actual knowledge requirement. Notably, the *WordPress* cases demonstrate that it is not only users of service providers, but also the service providers themselves, who take issue with copyright owners’ alleged abuses of DMCA takedown notices.

The issue of whether fair use is authorization under the law, rather than merely an affirmative defense to infringement, is also unsettled law having a bearing on the success of misrepresentation claims. District courts in California have held that a fair use is not infringement and is authorized by law under §512(3)(c)(A)(v),⁵⁷ and plaintiffs in other jurisdictions have urged their courts to adopt such a rule. Some parties and advocates maintain, however, that “authorized by law” means only that the use is subject to a compulsory license.⁵⁸ While the failure of a defendant to consider whether a use was a fair use may cause a defendant to be mistaken when he or she makes a good faith statement that the use was infringing, *Lenz III* makes clear that such a mistake does not arise to the level of knowing misrepresentation required by §512(f).

In jurisdictions adopting the rule that a copyright owner must evaluate whether a use is fair before being able to send a takedown notice in good faith, another question that could be addressed before courts is whether the plaintiff can succeed in demonstrating that the defendant knowingly misrepresented its good faith by proving that the defendant was willfully blind to the fact that the use was fair. Currently, that argument appears foreclosed in the District of Massachusetts per the district court’s decision in *Tuteur*, but remains alive in California in the appeal in *Lenz*. A finding at the appeals court level that a defendant may be found liable for misrepresentation if it willfully blinded itself to the facts that a use was fair could go far in making it less difficult for a plaintiff to prevail on a §512(f) claim, at least in the Ninth Circuit.

V. Conclusion

It remains uncertain how difficult it will be for current or future plaintiffs asserting that copyright owners are unlawfully using the DMCA takedown procedures to silence critics or suppress speech to succeed on their §512(f) misrepresentation claims. While critics feel that courts’ interpretations of the mental state of the defendant required to prove a §512(f) claim makes it extremely diffi-

cult, if not impossible, for an aggrieved user to prevail on a claim for misrepresentation, for so long as the language of the statute remains the same, Internet users seeking recourse for misrepresentations in DMCA takedown notices will have to prove that the owner knew the use was non-infringing and still sent the takedown.

Congress believed that “the procedural protections afforded by the notification requirements of subsection 512(c)(3) and the provisions for the replacement of removed or disabled materials in subsection 512[(g)] provide all the process that is due.”⁵⁹ From the courts’ interpretations, it appears that §512(f) does remain “an expressly limited cause of action for improper infringement notifications.”⁶⁰ Even though the takedown and put back procedures of the DMCA may be insufficient to address users’ rights under copyright law with respect to the fair use of others’ works, “[i]f experience ultimately proves that the remedy is weighted too heavily in favor of copyright owners at the expense of those who seek to make ‘fair use’ of another’s intellectual property, the resetting of the balance is for Congress and not a court to strike.”⁶¹

Endnotes

1. S. Rep No. 105-190, at 21 (1998).
2. *Id.* at 20.
3. Appellee And Cross-Appellant’s Answering And Opening Brief On Cross-Appeal Public Redacted Version at 20, *Lenz v. Universal*, Nos. 13-16106, 13-16107 (9th Cir. filed Dec. 6, 2013).
4. 17 U.S.C. § 512(f).
5. *Id.* at § 512(c)(3)(A)(v).
6. *Id.* at § 512(g)(3)(C).
7. *Id.* at § 512 (g)(2)(C).
8. S. Rep No. 105-190, at 21 (1998).
9. *Id.*
10. 17 U.S.C. § 512(f) also imposes liability on a user requesting a put back who materially misrepresents that the “material or activity was removed or disabled by mistake or identification.”
11. The issue of damages and their impact on the determination of misrepresentation is beyond the scope of this article.
12. S. Rep No. 105-190, at 49 (1998).
13. *Online Policy Group v. Diebold, Inc.*, 337 F. Supp. 2d 1195 (N.D. Cal. 2004).
14. *Id.* at 1204.
15. *Id.*
16. *Id.* at 1205.
17. *Rossi v. Motion Picture Ass’n of Am., Inc.*, 391 F.3d 1000 (9th Cir. 2004).
18. *Rossi v. Motion Picture Ass’n of Am., Inc.*, 2003 WL 21511750, *1 (D. Haw. 2003).
19. *Id.* at *3.
20. *Rossi v. Motion Picture Ass’n of Am., Inc.*, 391 F.3d 1000, 1003-04 (9th Cir. 2004).
21. *Id.* at 1005 (emphasis added).
22. *Ground Zero Museum Workshop v. Wilson*, 813 F. Supp. 2d 678, 704 (D. Md. 2011) (holding no facts on the record to support the conclusion that the defendant “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”).
23. See *Third Education Group, Inc. v. Phelps*, 675 F. Supp. 2d 916, 927 (E.D. Wis. 2009) (finding that because the plaintiff presented “no evidence to suggest that [defendant] acted without subjective good faith when he brought his claim under the DMCA” the plaintiff’s claim for misrepresentation under the DMCA is dismissed); and *Dudnikov v. MGA Entertainment Inc.*, 410 F. Supp. 2d 1010, 1012 (D. Colo. 2005) (affirming magistrate judge’s dismissal of the plaintiff’s “perjury” claim under 512(f) because the plaintiff failed to present evidence that the “[Defendant] knowingly and materially misrepresented Plaintiff’s infringement,” and following Rossi’s assertion that Congress only intended 512(f) to protect users from “subjectively improper actions by copyright owners”) (quoting *Rossi v. Motion Picture Ass’n of Am., Inc.*, at 1005) (emphasis in original).
24. *Disney Enterprises Inc. v. Hotfile Corp.*, 2013 WL 6336286, *48 (S.D. Fla. 2013) (“There is sufficient evidence in the record to suggest that [plaintiff] intentionally targeted files it knew it had no right to remove.”).
25. *Automattic Inc. v. Steiner*, No. 3:13-cv-05413 (N.D. Cal. filed Nov. 21, 2013).
26. *Automattic Inc. v. Chatwal*, No. 5:13-cv-05411 (N.D. Cal. filed Nov. 21, 2013).
27. The full text of 17 U.S.C. § 107 is:

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.
28. Appellants’ First Brief On Cross-Appeal Public Redacted Version at 35-36, *Lenz v. Universal*, Nos. 13-16106, 13-16107 (9th Cir. filed Oct. 9, 2013).
29. Amended Complaint at 4-5, *Lenz v. Universal*, No. C 07-03783 (N.D. Cal. filed Aug. 15, 2007).
30. *Id.* at 4.
31. *Lenz v. Universal*, 2008 WL 962102 (N.D. Cal. 2008) (“Lenz I”).
32. *Id.* at 3.
33. *Lenz v. Universal*, 572 F. Supp. 2d 1150 (N.D. Cal. 2008) (“Lenz II”).
34. *Id.* at 1154 (emphases in original).

35. *Id.* at 1155.
36. *Id.* at 1156.
37. *Lenz v. Universal*, 2013 WL 271673 (N.D. Cal. 2013) (“*Lenz III*”).
38. *Id.* at *6.
39. *Global Tech. Appliances, Inc. v. SEB SA*, 131 S.Ct. 2060, 2070 (2011) (“(1) the defendant must subjectively believe that there is a high probability that a fact exists and (2) the defendant must take deliberate actions to avoid learning of that fact.”).
40. *Lenz III*, at *8.
41. *Tuteur v. Crosley-Corcoran*, 1:13-cv-10159, 2013 WL 4832601 at *7 (D. Mass. filed Jan. 25, 2013).
42. *Id.* Complaint at 4.
43. *Id.* at 10-11.
44. *Tuteur*, at *7.
45. *Id.* (quoting S. Rep No. 105-190, at 21 (1998)).
46. *Tuteur*, at *7 (quoting *Lenz III* at *6).
47. *Lenz II*, at 1148.
48. *Shropshire v. Canning*, 809 F. Supp. 2d 1139, 1148 (N.D. Cal. 2011).
49. *Id.*
50. *Id.* at n.3.
51. *Ouellette v. Viacom Int’l, Inc.*, 2012 WL 850921, *3 (D. Mont. 2012) (quoting *Lenz II* at 1154).
52. *Lessig v. Liberation Music PTY Ltd.*, 1:13-cv-12028 (D. Mass 2013).
53. Amended Complaint at 11, *Lessig v. Liberation Music PTY Ltd.*, 1:13-cv-12028 (D. Mass filed Sept. 19, 2013).
54. Brief Of Amici Curiae Automattic Inc., et al. 15, *Lenz v. Universal*, Nos. 13-16106, 13-16107 (9th Cir. filed Dec. 13, 2013).
55. Amended Complaint at 11, *Lessig v. Liberation Music PTY Ltd.*, 1:13-cv-12028 (D. Mass filed Sept. 19, 2013).
56. See *Tuteur*, at *7.
57. *Online Policy Group v. Diebold, Inc.*, 337 F. Supp. 2d 1195, 1200 (N.D. Cal. 2004) (“Fair use is not infringement of a copyright.”); *Shropshire v. Canning*, 809 F. Supp. 2d 1139, n.3 (N.D. Cal. 2011) (“Fair use of a copyrighted work does not constitute copyright infringement.”); *Lenz II*, at 1154 (“Fair use is a lawful use of a copyright.”).
58. See Appellants’ First Brief On Cross-Appeal Public Redacted Version at 35-36, *Lenz v. Universal*, Nos. 13-16106, 13-16107 (9th Cir. Oct. 9, 2013).
59. S. Rep No. 105-190, at 21 (1998).
60. *Rossi v. Motion Picture Ass’n of Am., Inc.*, 391 F.3d 1000, 1004 (9th Cir. 2004).
61. *Tuteur*, at *7.

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