

# **The Digital Millennium Copyright Act (DMCA): Update and Enforcement Strategies**

**By:**

**Thomas J. Oppold  
Larkin Hoffman Daly & Lindgren Ltd.  
1500 Wells Fargo Plaza  
7900 Xerxes Avenue South  
Minneapolis, MN 55431-1194  
Direct Dial: (952) 896-3397  
Email: [toppold@larkinhoffman.com](mailto:toppold@larkinhoffman.com)**

**2004 Midwest Intellectual Property Institute  
October 7 - 8, 2004  
Hyatt Regency Hotel  
Minneapolis, Minnesota**

## TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION .....	1
II. THE FOUR DMCA SAFE HARBORS .....	2
A. Preliminary Eligibility Requirements .....	2
1. <u>Qualifying as a Service Provider</u> .....	2
2. <u>Reasonably implemented policy for terminating repeat infringers</u> .....	2
3. <u>Accommodation and non-interference with "Standard Technical Measures."</u> .....	3
B. Safe Harbor for -- <i>Information Residing on Systems or Networks at the Direction of Users</i> (§ 512(c)).....	3
1. <u>Requisite knowledge standard:</u> .....	4
2. <u>Notification Requirements:</u> .....	5
3. <u>Takedown Procedure:</u> .....	5
4. <u>Counter Notice Requirements:</u> .....	6
5. <u>Put-Back Procedure:</u> .....	7
C. Safe Harbor for -- <i>Transitory Digital Network Communications</i> (§ 512(a)).....	8
1. <u>No Notification or Takedown procedures:</u> .....	9
D. Safe Harbor for -- <i>System Caching</i> (§ 512(b)).....	9
1. <u>Notification requirements:</u> .....	10
2. <u>Take Down procedures:</u> .....	10
3. <u>Counter-Notification and Put-Back procedures:</u> .....	10
E. Safe Harbor for -- <i>Information Location Tools</i> (§ 512(d)) .....	11
1. <u>Notification requirements:</u> .....	12
2. <u>Take Down procedures:</u> .....	12
3. <u>Counter-Notification and Put-Back procedures:</u> .....	12

APPENDIX

A-1 Notification of Claimed Infringement Noncompliance letter ..... 14

A-2 Notification of Claimed Infringement ("NCI") Form ..... 15

B-1 Subscriber Suspension Letter ..... 16

B-2 Counter-Notification Form..... 17

C-1 Notice to Complainant of Receipt of Counter Notification from Subscriber ..... 18

## I. INTRODUCTION

The Digital Millennium Copyright Act (DMCA) was signed into law on October 28, 1998. The DMCA was enacted to address several important issues, including bringing U.S. copyright law into compliance with international treaties and to address issues of copyright liability in the online world, as well as to address other miscellaneous copyright-related issues.<sup>1</sup> As enacted, the DMCA includes five titles:

Title I -- the "WIPO Copyright and Performances and Phonograms Treaties Implementation Act of 1998" -- implements the WIPO treaties.

Title II -- the "Online Copyright Infringement Liability Limitation Act" -- creates limitations on the liability of online service providers for copyright infringement when engaging in certain types of activities.

Title III -- the "Computer Maintenance Competition Assurance Act" -- creates an exemption for making a copy of a computer program by activating a computer for purposes of maintenance or repair.

Title IV -- contains six miscellaneous provisions, relating to the functions of the Copyright Office, distance education, the exceptions in the Copyright Act for libraries and for making ephemeral recordings, "webcasting" of sound recordings on the Internet, and the applicability of collective bargaining agreement obligations in the case of transfers of rights in motion pictures.

Title V -- the "Vessel Hull Design Protection Act" creates a new form of protection for the design of vessel hulls.<sup>2</sup>

This memorandum addresses only Title II of the DMCA -- the *Online Copyright Infringement Liability Limitation Act*.

Title II of the DMCA added new section 512 to the Copyright Act (17 U.S.C. § 512). New Section 512 serves two main functions, namely: (1) To provide "safe harbors" for eligible service providers to escape liability for monetary damages and most injunctive relief for copyright infringement;<sup>3</sup> and (2) To provide a procedure by which copyright holders can obtain subpoenas from federal courts ordering the service providers to disclose the identity of any subscriber engaged in infringing activities using the services providers network or system.<sup>4</sup>

The safe harbor provisions of the DMCA are discussed in Section II below. The subpoena provisions of the DMCA are discussed in Section III below.

---

<sup>1</sup> *The Digital Millennium Copyright Act of 1998: U.S. Copyright Office Summary*, <http://www.copyright.gov/legislation/dmca.pdf> (December, 1998), at p. 1. (hereinafter "DMCA Summary"); *Ellison v. Robertson*, 357 F.3d 1072, 1076 (9th Cir. 2004) (citing Pub. L. No. 105-304, 112 Stat. 2860 (1998)).

<sup>2</sup> DMCA Summary at p. 1.

<sup>3</sup> DMCA Summary at p. 8; 17 U.S.C. 512(a), (b), (c), (d).

<sup>4</sup> DMCA Summary at p. 9; 17 U.S.C. § 512(h).

## II. THE FOUR DMCA SAFE HARBORS

There are four available safe harbors under Section 512 of the DMCA, each relating to a separate and distinct function or type of online service, namely, the providing of: (1) *Transitory Digital Network Communications*;<sup>5</sup> (2) *System Caching*;<sup>6</sup> (3) *Information Residing on Systems or Networks at the Direction of Users*;<sup>7</sup> and (4) *Information Location Tools*.<sup>8</sup> A service provider may fall under one or more safe harbors, each of which has different requirements. Regardless of which of the four safe harbors is applicable, each safe harbor affords a complete bar on monetary damages against the service provider and restricts the availability of most injunctive relief against the service provider. The determination of whether a service provider qualifies under one safe harbor does not effect the determination for qualification under any other safe harbor.<sup>9</sup>

### A. Preliminary Eligibility Requirements

#### 1. Qualifying as a Service Provider

A party seeking the benefit of any of the four safe harbors must first qualify as a "service provider." Under the safe harbor for *Transitory Digital Network Communications*, a "service provider" is defined as: "[A]n entity offering the transmission, routing, or providing of connections for digital online communications, between or among points specified by a user, of material of the user's choosing, without modification to the content of the material as sent or received."<sup>10</sup> Under the remaining three safe harbors, a "service provider" is more broadly defined as "a provider of online services or network access, or the operator of facilities therefor, and includes an entity described in subparagraph (A)."<sup>11</sup> At least one court has held that the DMCA definitions of a service provider are so broad that "we have trouble imagining the existence of an online service that *would not* fall under the definitions, particularly the second."<sup>12</sup>

#### 2. Reasonably implemented policy for terminating repeat infringers.

The service provider must (a) adopted a policy that provides for the termination of service access for repeat copyright infringers; (b) implement that policy in a reasonable manner; and (c) inform its subscribers of the policy.<sup>13</sup> It has been held that the repeat infringer termination requirement is satisfied where the service provider's website terms of service page or the website legal notice page includes the statement that service provider will terminate services to a subscriber accused of infringing third party copyrights.<sup>14</sup> Where a service provider logs and tracks notifications of claimed infringement, the reasonable policy implementation requirement is also met.<sup>15</sup> However, where a service provider changed its email address to which infringement notifications were

---

<sup>5</sup> 17 U.S.C. § 512(a).

<sup>6</sup> 17 U.S.C. § 512(b).

<sup>7</sup> 17 U.S.C. § 512(c)(1).

<sup>8</sup> 17 U.S.C. § 512(d).

<sup>9</sup> 17 U.S.C. § 512(n).

<sup>10</sup> 17 U.S.C. § 512(k)(1)(A).

<sup>11</sup> 17 U.S.C. § 512(k)(1)(B).

<sup>12</sup> *In re Aimster Copyright Litigation*, 252 F. Supp. 2d 634, 658 (N.D. Ill. 2002) (emphasis in original); *aff'd*, *In re Aimster Copyright Litigation*, 334 F.3d 643 (7th Cir. 2003).

<sup>13</sup> 17 U.S.C. § 512(i)(1)(A); *Ellison v. Robertson*, 357 F.3d 1072, 1080 (9th Cir. 2004)

<sup>14</sup> *Perfect 10, Inc. v. CCBill, LLC*, No. CV 02-7624 LGB(SHx), 2004 U.S. Dist. LEXIS 17643 at \*24 (June 22, 2004).

<sup>15</sup> *Id.* at \*24 - \*25.

supposed to have been sent and failed to provide for forwarding of messages sent to the old email address or to provide notification that the old email address was inactive, a court has held that the a jury may conclude that the service provider had not reasonably implemented its policy against repeat infringers.<sup>16</sup> As previously identified, the requirement for "informing subscribers of the policy" has been found to be met where the service provider posts the policy on its website.<sup>17</sup>

### 3. Accommodation and non-interference with "Standard Technical Measures."

The service provider must accommodate and not interfere with "standard technical measures."<sup>18</sup> "Standard technical measures" are defined as measures used by copyright holders to identify or protect copyrighted works, that have been developed pursuant to a broad consensus of copyright owners and service providers in an open, fair and voluntary multi-industry standards process, are available to anyone on reasonable nondiscriminatory terms, and do not impose substantial costs or burdens on service providers or their systems or networks.<sup>19</sup>

#### B. **Safe Harbor for -- Information Residing on Systems or Networks at the Direction of Users (§ 512(c))**

The safe harbor relating to *Information Residing on Systems or Networks at the Direction of Users* is discussed first because it is generally the most used or commonly asserted safe harbor, and because its "Notification" and "Takedown" provisions (discussed below) are referenced by two of the three other safe harbors as will be identified later.

The safe harbor for *Information Residing on Systems or Networks at the Direction of Users* (§ 512(c)) precludes monetary relief and most injunctive relief for copyright infringement against service providers that host websites or otherwise store infringing material on their servers at the direction of their subscribers or users.<sup>20</sup>

In order to qualify for this safe harbor, the following conditions must be met:

- i. The service provider must not have the requisite level of knowledge of the infringing activity (discussed in more detail below).<sup>21</sup>
- ii. If the service provider has the *right and ability to control the infringing activity*, it must not receive a *financial benefit directly attributable to the infringing activity*.<sup>22</sup>
  - The "*right and ability to control the infringing activity*" requires more than the ability to delete or block user access to infringing postings on a website after those postings have already found their way on the service provider's servers.<sup>23</sup>

---

<sup>16</sup> *Ellison*, 357 F.3d at 1080.

<sup>17</sup> *Perfect 10*, No. CV 02-7624 LGB(SHx), 2004 U.S. Dist. LEXIS 17643 at \*24 (June 22, 2004).

<sup>18</sup> 17 U.S.C. § 512(i)(1)(B).

<sup>19</sup> 17 U.S.C. § 512(i)(2).

<sup>20</sup> 17 U.S.C. § 512(c); *Ellison v. Robertson*, 189 F. Supp. 2d 1051, 1068 (C.D. Cal. 2002) ("[F]unctions such as hosting a web site or chatroom fall under the scope of subsection [512](c)", *aff'd in relevant part and reversed in part by, Ellison v. Robertson*, 357 F.3d 1072 (9th Cir. 2004).

<sup>21</sup> 17 U.S.C. § 512(c)(1)(A).

<sup>22</sup> 17 U.S.C. § 512(c)(1)(B).

<sup>23</sup> *Ellison*, 189 F. Supp. 2d at 1062.

Rather, it requires the right and ability to exercise control over the "*infringing activity*" of the infringer.<sup>24</sup>

- The *direct financial benefit attributable to the infringing activity* requirement exists where the availability of infringing material acts as a draw for consumers.<sup>25</sup> "In general, a service provider conducting a legitimate business would not be considered to receive a 'financial benefit directly attributable to the infringing activity' where the infringer makes the same kind of payment as non-infringing users of the provider's services."<sup>26</sup>
- iii. Upon receiving the requisite knowledge of the infringing activity, the service provider must follow the statutory "Takedown" and "Put-Back" procedures (discussed below).<sup>27</sup>
- iv. The service provider must have its "designated agent" registered with the U.S. Copyright Office, i.e., the individual designated by the service provider to receive notifications of claimed infringement.<sup>28</sup>
  - The Copyright Office provides a suggested form at -- <http://www.copyright.gov/onlinesp/agent.pdf> -- for registering designated agents with the Copyright Office.
  - A listing of designated agents registered with the Copyright Office is available at -- <http://www.copyright.gov/onlinesp/list/index.html> --.
- v. The contact information of the service provider's designated agent must also be posted on the services providers website in a location accessible to the public.<sup>29</sup>

#### **1. Requisite knowledge standard:**

Under the knowledge standard, a service provider is eligible for the limitation on liability only if: (1) it does not have actual knowledge of the infringement,<sup>30</sup> or (2) in the absence of actual knowledge, it is not aware of facts or circumstances from which infringing activity is apparent,<sup>31</sup> or (3) upon gaining such knowledge or awareness, it responds expeditiously to remove or disable access to the material.<sup>32</sup> There is no requirement under the DMCA for the service provider to monitor its service or to affirmatively seek facts indicating infringing activity apart from employing "standard technical measures" (described below) in order to be eligible for any of the safe harbors.<sup>33</sup>

Thus, absent actual knowledge of the infringement, a service provider will not be deemed to have the requisite knowledge of infringing activity unless and until it is in receipt of a written

---

<sup>24</sup> *Id.*; *Perfect 10*, No. CV 02-7624 LGB(SHx), 2004 U.S. Dist. LEXIS 17643 at \*71 - \*72 (June 22, 2004).

<sup>25</sup> *Ellison*, 189 F. Supp. 2d at 1062-1064.

<sup>26</sup> *Id.* at 1064 (quoting H.R. Rep. 105-51(II), at p. 54 (July 22, 1998).

<sup>27</sup> 17 U.S.C. § 512(c)(1)(C).

<sup>28</sup> 17 U.S.C. § 512(c)(2).

<sup>29</sup> *Id.*

<sup>30</sup> 17 U.S.C. § 512(c)(1)(A)(i).

<sup>31</sup> 17 U.S.C. § 512(c)(1)(A)(ii).

<sup>32</sup> 17 U.S.C. § 512(c)(1)(A)(iii).

<sup>33</sup> 17 U.S.C. § 512(m).

"notification of claimed infringement" ("NCI") in substantial compliance with the provisions of Section 512(c)(3)(A) (identified below under "Notification Requirements").<sup>34</sup>

## **2. Notification Requirements:**

The NCI must be in writing and must include substantially the following information:

- i. A physical or electronic signature of the copyright owner or its authorized representative (hereinafter the "Complainant");<sup>35</sup>
- ii. The identification of the copyrighted work(s) claimed to have been infringed.<sup>36</sup>
- iii. The identification of the alleged infringing material in reasonably sufficient detail to enable the service provider to locate the material.<sup>37</sup>
- iv. The Complainant's contact information.<sup>38</sup>
- v. A statement that the Complainant has a good faith belief that the use of the material by the in the manner complained of is not authorized by the copyright owner, its agent, or the law;<sup>39</sup> and
- vi. A statement that the information in the NCI is accurate and, under penalty of perjury,<sup>40</sup> that the Complainant is authorized to act on behalf of the copyright holder.<sup>40</sup>

Penalties are provided for knowing material misrepresentations in a NCI. Any person who knowingly materially misrepresents that material or activity complained of is infringing is liable for any resulting damages (including costs and attorneys' fees) incurred by the alleged infringer or the service provider.<sup>41</sup>

## **3. Takedown Procedure:**

Upon receipt of a NCI, the service provider must do the following:

- i. Ensure that the NCI substantially complies with the above Notice Requirements.<sup>42</sup>
- ii. If the NCI does not substantially comply with the Notice Requirements, but still enables the service provider to:
  - (A) identify the copyright work;

---

<sup>34</sup> 17 U.S.C. § 512(c)(3)(B)(i).

<sup>35</sup> 17 U.S.C. § 512(c)(3)(A)(i).

<sup>36</sup> 17 U.S.C. § 512(c)(3)(A)(ii).

<sup>37</sup> 17 U.S.C. § 512(c)(3)(A)(iii).

<sup>38</sup> 17 U.S.C. § 512(c)(3)(A)(iv).

<sup>39</sup> 17 U.S.C. § 512(c)(3)(A)(v).

<sup>40</sup> 17 U.S.C. § 512(c)(3)(A)(vi).

<sup>41</sup> 17 U.S.C. § 512(f).

<sup>42</sup> 17 U.S.C. § 512(c)(3)(B)(ii)



- (B) reasonably locate the infringing material; and
- (C) contact the Complainant,

then the service provider must promptly attempt to contact the Complainant or take reasonable steps to assist in the receipt of a substantially compliant NCI.<sup>43</sup>

- A sample non-compliance letter along with a suggested NCI Form is attached hereto as Appendix A-1 and A-2
- iii. If the NCI is in substantial compliance with the Notice Requirements, then the service provider must:
- (A) "Expediently" remove or disable access to the alleged infringing material that resides on the system or network controlled or operated by the service provider.<sup>44</sup>
  - (B) Take reasonable steps to "promptly" notify its subscriber of the action taken against the subscriber's alleged infringing material.<sup>45</sup>

If the service provider follows the above referenced Takedown procedures the service provider will not be liable for the removal or disabling of access of the alleged infringing material, even if the material is ultimately found not to infringe.<sup>46</sup>

#### **4. Counter Notification Requirements:**

The DMCA protects against the possibility of erroneous or fraudulent NCI's by giving the subscriber the opportunity to respond to a NCI by filing a "Counter Notification."

The Counter Notification must be in writing and must include the following information:

- i. A physical or electronic signature or the subscriber.<sup>47</sup>
- ii. The identification of the material that has been removed or to which access has been disabled and the location at which the material appeared before it was removed or disabled.<sup>48</sup>
- iii. A statement under penalty of perjury that the subscriber has a good faith belief that the material was removed or disabled as a result of mistake or misidentification.<sup>49</sup>
- iv. The subscriber's contact information.<sup>50</sup>

---

<sup>43</sup> *Id.*

<sup>44</sup> 17 U.S.C. § 512(c)(1)(C).

<sup>45</sup> 17 U.S.C. § 512(g)(2)(A).

<sup>46</sup> 17 U.S.C. § 512((g)(1).

<sup>47</sup> 17 U.S.C. § 512(g)(3)(A).

<sup>48</sup> 17 U.S.C. § 512(g)(3)(B).

<sup>49</sup> 17 U.S.C. § 512(g)(3)(C).

<sup>50</sup> 17 U.S.C. § 512(g)(3)(D).

- v. A statement that the subscriber consents to the personal jurisdiction of the Federal District Court in the subscriber's home jurisdiction, or, if the subscriber lives outside the US, in any judicial district where the service provider may be found;<sup>51</sup> and
- vi. A statement that the subscriber will accept service of process from the Complainant or the Complainant's agent.<sup>52</sup>

A sample subscriber suspension letter with a Counter-Notification Form is attached hereto as Appendix B.

Penalties are provided for knowing material misrepresentations in a Counter Notice. Any person who knowingly materially misrepresents that material was removed or blocked through mistake or misidentification, is liable for any resulting damages (including costs and attorneys' fees) incurred by the Complainant or the service provider.<sup>53</sup>

### **5. Put-Back Procedure:**

Upon receipt of a proper Counter Notification from a subscriber, the DMCA requires the service provider to replace or cease blocking access to the material after a ten (10) day waiting period unless the service provider is served with notice from the Complainant that it has initiated copyright infringement suit against the subscriber. As long as the service provider follows the statutory Put-Back procedures, the service provider is immune from copyright infringement liability for replacing or ceasing to block access to any alleged infringing material identified by the Complainant in the NCI.<sup>54</sup>

The Put-Back procedures are as follows: -- Upon receipt of a Counter Notice, the service provider must:

- i. Verify that the Counter Notice is "effective," i.e., that it is in substantial compliance with the above Counter Notification requirements.<sup>55</sup>
- ii. If the Counter Notification is not in substantial compliance, then the service provider should attempt to contact the subscriber or take reasonable steps to assist in the receipt of a proper Counter-Notification. (*Note, not specifically stated in statute, but prudent*).
- iii. If the Counter Notification is in substantial compliance, provide a copy of the Counter Notification to the Complainant and inform the Complainant that the alleged infringing material will be replaced after ten (10) business days from the date of receipt of the Counter Notification.<sup>56</sup>
- iv. After the ten (10) business day waiting period expires, but not more than fourteen (14) business days from the date of receipt of the Counter

---

<sup>51</sup> *Id.*

<sup>52</sup> *Id.*

<sup>53</sup> 17 U.S.C. § 512(f).

<sup>54</sup> 17 U.S.C. § 512(g)(4).

<sup>55</sup> 17 U.S.C. § 512(g)(2)(B).

<sup>56</sup> *Id.*

Notification, replace or cease disabling access to the alleged infringing material unless a notice is received that the Complainant has filed an action seeking a court order to restrain the subscriber from engaging in infringing activity relating to material on the service provider's system or network.<sup>57</sup>

A sample letter to the Complainant providing notice of receipt of a Counter Notification is attached hereto as Appendix C.

**C. Safe Harbor for -- *Transitory Digital Network Communications* (§ 512(a))**

The safe harbor for *Transitory digital network communications* (§ 512(a)) precludes liability of service providers for monetary relief and most injunctive relief for infringement of copyright where the service provider merely acts as a data conduit by transmitting, routing, or providing connections for the material, or for the intermediate and transient storage of that material.<sup>58</sup> Examples of providers of *Transitory digital network communications* include any company that provides e-mail service or Internet connectivity,<sup>59</sup> Usenet service providers,<sup>60</sup> as well as online third party payment processors.<sup>61</sup>

In order to qualify for this safe harbor, the following conditions must be met:

- i. The transmission of the material must be initiated by or at the direction of a person other than the service provider.<sup>62</sup>
- ii. The transmission, routing, provision of connections, or storage must be carried out by an automatic technical process without selection of the material by the service provider.<sup>63</sup>
- iii. The service provider must not select the recipient of the material except as an automatic response to the request of another.<sup>64</sup>
- iv. Any intermediate copies must not ordinarily be accessible to anyone other than anticipated recipients, and must not be retained for longer than reasonably necessary.<sup>65</sup>
- v. The material must be transmitted with no modification to its content.<sup>66</sup>

---

<sup>57</sup> 17 U.S.C. § 512(g)(2)(C).

<sup>58</sup> DMCA Summary at p. 10.; 17 U.S.C. § 512(a)

<sup>59</sup> *Ellison*, 189 F. Supp. 2d at 1068 ("Certain functions such as the provision of e-mail service or Internet connectivity clearly fall under the purview of subsection [512](a)"); *affm'd in relevant part and reversed in part by*, 357 F.3d 1072, 1081 (9th Cir. 2004).

<sup>60</sup> *Id.* at 1070 (holding that America On Line's UseNet service fell within the purview of § 512(a))

<sup>61</sup> *Perfect 10*, No. CV 02-7624 LGB(SHx), 2004 U.S. Dist. LEXIS 17643 (June 22, 2004) (holding that third party payment processor falls under § 512(a))

<sup>62</sup> 17 U.S.C. § 512(a)(1).

<sup>63</sup> 17 U.S.C. § 512(a)(2).

<sup>64</sup> 17 U.S.C. § 512(a)(3).

<sup>65</sup> 17 U.S.C. § 512(a)(4).

<sup>66</sup> 17 U.S.C. § 512(a)(5).

## 1. No Notification or Takedown procedures:

Because this safe harbor relates only to services which do not involve the storage of alleged infringing material other than for its "intermediate and transient storage" there is no corresponding Notification or Takedown procedures under this safe harbor since, by definition, there is nothing is stored for the service provider to remove or to deny access.<sup>67</sup>

### D. Safe Harbor for -- *System Caching* (§ 512(b))

The safe harbor for *System Caching* (§ 512(b)) precludes liability of service providers for monetary relief and most injunctive relief for infringement of copyright by reason of the intermediate and temporary storage of material on a system or network controlled or operated by the service provider.

In order to qualify for this safe harbor, the following conditions must also be met:

- i. The material is made available on line by another person (the "originating source").<sup>68</sup>
- ii. The material is transmitted by the originating source through the service provider's system to another user at the direction of that user;<sup>69</sup>
- iii. The storage of the material is part of an automatic technical process for purposes of making the material available to users who request access to the material from the originating source.<sup>70</sup>
- iv. The content of the retained material must not be modified.<sup>71</sup>
- v. The service provider must comply with rules about refreshing, reloading or other updating the information from the originating site in accordance with generally accepted industry standard data communication protocol.<sup>72</sup>
- vi. The service provider must not interfere with any technology associated with the material that returns information to the originating source,<sup>73</sup> provided that:
  - The associated technology does not interfere with the service provider's system or network,<sup>74</sup>
  - The associated technology is consistent with accepted industry communication protocols,<sup>75</sup> and

---

<sup>67</sup> *Recording Ind. Assoc. of America, Inc. v. Verizon Internet Services, Inc.*, 351 F.3d 1229 (D.C. Cir. 2003) ("[N]otably absent from § 512(a), is the so-called notice and takedown provision.").

<sup>68</sup> 17 U.S.C. § 512(b)(1)(A).

<sup>69</sup> 17 U.S.C. § 512(b)(1)(B).

<sup>70</sup> 17 U.S.C. § 512(b)(1)(C).

<sup>71</sup> 17 U.S.C. § 512(b)(2)(A).

<sup>72</sup> 17 U.S.C. § 512(b)(2)(B).

<sup>73</sup> 17 U.S.C. § 512(b)(2)(C).

<sup>74</sup> 17 U.S.C. § 512(b)(2)(C)(i).

<sup>75</sup> 17 U.S.C. § 512(b)(2)(C)(ii).

- The associated technology does not extract information from the service providers system that would not have otherwise been made available had the user gained access to the material from the originating site.<sup>76</sup>

For example, the service provider must provide to the originating source the same type of "hit" information about the cached material as if the material was obtained directly from the originating source.

- vii. The service provider must not allow users of its system or network the ability to access material without such users meeting the conditions imposed by the originating source, such as a condition based on payment of a fee or provision of a password.<sup>77</sup>
- viii. The service provider must have its "designated agent" registered with the U.S. Copyright Office, i.e., the individual designated by the service provider to receive notifications of claimed infringement pursuant to Section 512(c)(2). *Note, this requirement is not specifically set forth, but is implied by reference to Section 512(c)(3) in Section 512(b)(2)(E).*
- ix. The contact information of the service provider's designated agent must also be posted on the services providers website in a location accessible to the public pursuant to Section 512(c)(2). *Note, this requirement is not specifically set forth, but is implied by reference to Section 512(c)(3) in Section 512(b)(2)(E).*

**1. Notification requirements:**

The service provider must be served with a written NCI substantially in compliance with the Notification Requirements identified above for the safe harbor for *Information Residing on Systems at Direction of Users*.<sup>78</sup> In addition, the NCI must include a statement confirming that the material alleged to infringe has been removed from the originating site, or that access to it has been disabled, or that a court has ordered the material to be removed from the originating site or access to the material on the originating site be disabled.<sup>79</sup>

**2. Take Down procedures:**

Upon receipt of a NCI in compliance with the above Notification Requirements, the service provider must expeditiously remove or disable access to the material as described under the take down provisions described for the safe harbor for *Information Residing on Systems at Direction of Users*.<sup>80</sup>

**3. Counter-Notification and Put-Back procedures:**

The same procedures for receipt of a Counter-Notification and Put Back Procedures described for the safe harbor for *Information Residing on Systems at Direction of Users* applies to this safe harbor.<sup>81</sup>

---

<sup>76</sup> 17 U.S.C. § 512(b)(2)(C)(iii).

<sup>77</sup> 17 U.S.C. § 512(b)(2)(D).

<sup>78</sup> 17 U.S.C. § 512(b)(2)(E).

<sup>79</sup> 17 U.S.C. § 512(b)(2)(E)(ii).

<sup>80</sup> 17 U.S.C. § 512(b)(2)(E); 17 U.S.C. § 512(g)(2)

<sup>81</sup> *Id.*

The provisions establishing safeguards against the possibility of erroneous or fraudulent NCI's and Counter Notifications as discussed above, as well as those protecting the service provider against claims based on having taken down the material or putting back the material apply to this safe harbor as well.<sup>82</sup>

**E. Safe Harbor for -- *Information Location Tools* (§ 512(d)).**

The safe harbor for *Information Location Tools* (§ 512(d)) precludes liability for monetary relief and most injunctive relief for copyright infringement for service providers that refer or link users to websites containing infringing material through the use of information location tools, directories, indexes, references, pointers or hypertext links.<sup>83</sup> Service providers falling within the scope of this safe harbor include internet search engines such as Yahoo!, and Google, online age verification service providers,<sup>84</sup> and the like.

In order to qualify for this safe harbor, the following conditions must be met:

- i. The service provider must not have the requisite level of knowledge of the infringing activity – applying the same standard as under the safe harbor for *Information Residing on Systems or Networks at Direction of Users*.<sup>85</sup>
- ii. If the service provider has the right and ability to control the infringing activity, it must not receive a financial benefit directly attributable to the infringing activity.<sup>86</sup>
- iii. Upon receiving the requisite knowledge of the infringing activity, the service provider must follow the statutory "Takedown" and "Put-Back" procedures as under the safe harbor for *Information Residing on Systems or Networks at Direction of Users*.<sup>87</sup>
- iv. The service provider must have its "designated agent" registered with the U.S. Copyright Office, i.e., the individual designated by the service provider to receive notifications of claimed infringement pursuant to § 512(c)(2). *Note, this requirement is not specifically set forth, but is implied by reference to § 512(c)(3) under § 512(d)(3).*
- v. The contact information of the service provider's designated agent must also be posted on the services providers website in a location accessible to the public pursuant to Section 512(c)(2). *Note, this requirement is not specifically set forth, but is implied by reference to § 512(c)(3) under § 512(d)(3).*

---

<sup>82</sup> 17 U.S.C. § 512(f).

<sup>83</sup> 17 U.S.C. § 512(d); *Perfect 10*, No. CV 02-7624 LGB(SHx), 2004 U.S. Dist. LEXIS 17643 at \*50 (June 22, 2004) (holding that Internet Key, Inc.'s sexkey.com website is within the scope of 17 U.S.C. § 512(d)).

<sup>84</sup> *Perfect 10*, No. CV 02-7624 LGB(SHx), 2004 U.S. Dist. LEXIS 17643 at \*50 (June 22, 2004) (holding that Internet Key, Inc.'s sexkey.com website is within the scope of 17 U.S.C. § 512(d)).

<sup>85</sup> 17 U.S.C. § 512(d)(1)(A), (B) and (C).

<sup>86</sup> 17 U.S.C. § 512(d)(2).

<sup>87</sup> 17 U.S.C. § 512(d)(3).

**1. Notification requirements:**

The service provider must be served with a written NCI substantially in compliance with the Notification Requirements identified above for the safe harbor for *Information Residing on Systems at Direction of Users*, with the exception that the identification of infringing material must include identification of the reference link to the material claimed to infringe.<sup>88</sup>

**2. Take Down procedures:**

Upon receipt of a proper NCI, the service provider must expeditiously remove or disable access to the material as described under the take down provisions described for the safe harbor for *Information Residing on Systems at Direction of Users*.<sup>89</sup>

**3. Counter Notification and Put-Back procedures:**

The same procedures for receipt of a Counter Notification and Put-Back Procedures described for the safe harbor for *Information Residing on Systems at Direction of Users* applies to this safe harbor.<sup>90</sup>

The provisions establishing safeguards against the possibility of erroneous or fraudulent NCI's and Counter Notifications as discussed above, as well as those protecting the service provider against claims based on having taken down the material or putting back the material apply to this safe harbor as well.<sup>91</sup>

**III. DMCA SUBPOENA PROVISIONS**

The anonymity of the Internet has made it easier for copyright infringers to obtain and distribute infringing materials. The provisions of Section 512(c) are usually sufficient to stop infringing activity, as many website owners are only interested in providing the infringing content for as long as they can remain undetected. However, there may be situations where a copyright owner will want to identify and take legal action against a website owner who repeatedly provides infringing content on his or her website by finding another Internet service provider ("ISP") to host the website. In these situations, Section 512(h) of the DMCA becomes a useful and powerful tool. Note, however, that Court of Appeals for the D.C. Circuit has recently held that the subpoena provisions apply only to service providers that actually store infringing material on their servers in some capacity (i.e., those service providers within the scope of § 512(b), (c) and (d)) and not to service providers that merely act as a conduit (i.e., service providers within the scope of § 512(a)).<sup>92</sup>

Website owners must register their contact information with a domain name registry. Sometimes, the website owner will provide incomplete or inaccurate information in order to avoid being contacted. Section 512(h) remedies this problem by providing that any copyright owner or person authorized to act on the owner's behalf, can request the clerk of any U.S. district court to issue a subpoena requiring an Internet service provider to identify an infringer.

---

<sup>88</sup> 17 U.S.C. § 512(d)(3).

<sup>89</sup> *Id.*

<sup>90</sup> *Id.*; 17 U.S.C. § 512(g)(2).

<sup>91</sup> 17 U.S.C. § 512(f).

<sup>92</sup> *Recording Ind. Assoc. of America, Inc. v. Verizon Internet Services, Inc.*, 351 F.3d 1229, 1237 (D.C. Cir. 2003)

## **A. Requirements of the Subpoena Request**

Section 512(h) does not require a copyright owner to initiate a lawsuit in order to obtain the subpoena. The clerk of court, upon receiving the appropriate documents from the requester, need only open a miscellaneous file and assign a case number for each Internet service provider or subpoena request. The subpoena provides authority to the Internet service provider to disclose information sufficient to identify the infringer. To obtain the subpoena, the copyright owner must file the following documents with the clerk of court:

- i. A copy of notification of claimed infringement in substantial compliance with the requirements of the NCI as identified above under the safe harbor for *Information Residing on Systems or Networks at the Direction of Users*;
- ii. A proposed subpoena; and
- iii. A sworn declaration stating the sole purpose of the subpoena is to identify the infringer and protect the copyright owners rights under the Act

A sample subpoena and sworn declaration are attached as Appendix D1-D2.

## **B. Domestic Enforcement / Practical Considerations**

Most Internet service providers will respond appropriately upon receipt of the notification of infringement; however, some providers will resist taking action, or may not respond expeditiously upon receipt of the notice. An effective way to get the Internet service provider to respond is to include a draft complaint along with the notification of infringement. The draft complaint informs the Internet service provider that the copyright owner fully intends to pursue legal action against the Internet service provider for contributory and vicarious infringement.

## **C. International Enforcement / Practical Considerations**

There are numerous U.S.-based Internet service providers that host websites owned by individuals residing outside of the United States. Under these circumstances, the provisions of the DMCA will be effective. However, for those websites that are hosted by Internet service providers outside of the United States, the task is more difficult. While many countries are taking steps to protect copyright owners against infringement on the Internet, many countries laws do not go as far as the DMCA does to protect those rights. Any claim of copyright infringement will have to be enforced under the provisions of that country's laws.

Some individual Internet service providers in other countries have their own policies and procedures for addressing infringement. For example, some Internet service providers in the Netherlands require the complainant upon receipt of a notification of infringement to fill out a questionnaire, which asks for, among other things, evidence of illegal activity. These questionnaires allow copyright owners to provide their rationale for why the infringing website should be disabled beyond what is required in a DMCA notice. The questionnaire also provides the Internet service provider with additional support for its decision to disable an infringing website.

Even if there is no formal procedure in place, Internet service providers outside of the United States will usually respond to a modified version of the sample notification of infringement above, inserting language from that country's copyright laws. If not, the copyright owner may want to consider hiring local counsel in that particular country to assist in enforcing his or her rights in the copyrighted works.



**APPENDIX A-1**  
**Notification of Claimed Infringement**  
**Noncompliance letter**

[Copyright Holder]  
[Address]

**VIA US MAIL**

Re: DMCA Notification of Claimed Infringement / [Accused Website]

Dear [Copyright holder]:

We represent [Service Provider]. Your email of [\_\_\_\_\_] (attached hereto) concerning alleged infringing material at the URL - [http://www.\[Accused Website\].com](http://www.[Accused Website].com) -- was forwarded to us for review and comment.

First, we wish to assure you that [Service Provider] respects the intellectual property rights of others and takes such matters very seriously. However, because [Service Provider] is merely a [\_\_\_\_\_ provider], it is not in a position, and cannot reasonably be placed in a position, to independently evaluate the merits of any infringement claims asserted against material posted by its subscribers. The Digital Millennium Copyright Act ("DMCA"), 17 U.S.C. § 512, was enacted to provide a procedural mechanism to address the type of alleged on-line copyright infringement about which you are complaining. Therefore, for the protection of all parties and efficient resolution of this matter, strict compliance with the DMCA is necessary.

Under the DMCA, [Service Provider] is not authorized to suspend its services or otherwise remove or disable access to any alleged infringing material available through its system or network until it receives a "notification of claimed infringement" that is in substantial compliance with the requirements specified under the DMCA (17 U.S.C. § 512(c)(3)(A)) from either the copyright holder or an agent authorized to act on behalf of the copyright holder (the "Complainant").

Accordingly, so that this matter can be resolved pursuant to the provisions of the DMCA, please complete the attached Notification of Claimed Infringement ("NCI") Form and fax or email the completed NCI Form as identified at the bottom of the NCI form.

Upon receipt of the completed NCI Form, [Service Provider] will promptly remove or otherwise disable access to the alleged infringing material. For further information about the DMCA and Notification requirements, we direct your attention to 17 U.S.C. § 512(c)(3).

We thank you in advance for your prompt cooperation and compliance with the DMCA requirements and anticipate that a prompt resolution of this matter can be achieved to the satisfaction of all parties involved if you comply with the foregoing request.

Respectfully,

Attorney

**APPENDIX A-2**  
**Notification of Claimed Infringement ("NCI") Form**

I, the undersigned Complainant, state and declare **UNDER PENALTY OF PERJURY** as follows:

1. I am the owner of the copyright in the following work(s), or I am an agent authorized to act on behalf of the copyright owner in the following works.

- \_\_\_\_\_
- \_\_\_\_\_
- \_\_\_\_\_

2. I have a good faith belief that the use of the following material(s) is/are not authorized by the copyright owner, its agents, or the law. *Note: Identify the alleged infringing material by its URL address and/or describe the alleged infringing material in sufficient detail to permit the location of the alleged infringing material so it can be removed or access to it disabled.*

- \_\_\_\_\_
- \_\_\_\_\_
- \_\_\_\_\_

3. Complainant's contact information: (\* required):

Complainant's name:\* \_\_\_\_\_  
(last\*) (first\*) (middle initial)

Complainant's title: \_\_\_\_\_

Complainant's company: \_\_\_\_\_

Complainant's address:\* \_\_\_\_\_  
(street\*) (city\*) (state\*) (zip\*)

Complainant's e-mail address:\* \_\_\_\_\_

Complainant's telephone:\* \_\_\_\_\_

Complainant's fax: \_\_\_\_\_

4. All statements in this NCI Form are true and accurate.

**Complainant:**

\_\_\_\_\_  
(Signature) Date: \_\_\_\_\_

**FAX THIS SIGNED AND COMPLETED NCI FORM TO:**  
**(XXX) XXX-XXXX ATTENTION: XXXXXXXX**  
**OR**  
**E-MAIL TO: [XXX@\[AccusedWebsite\].com](mailto:XXX@[AccusedWebsite].com)**

**APPENDIX B-1**  
**Subscriber Suspension Letter**

[Subscriber]  
[Address]

**VIA US MAIL**

Re: Notice of suspension of services

Dear [Subscriber]:

We represent the [Service Provider]. Effective as of [Date], access to the URL [http://www.\[AccusedWebsite.com\]](http://www.[AccusedWebsite.com]) through the [Service Provider] system or network has been suspended.

The above action was taken as a result of [Service Provider] receiving a notification of claimed infringement, pursuant to the Digital Millennium Copyright Act ("DMCA") (17 U.S.C. § 512), concerning alleged infringing activity involving your account and website. A copy of the notification of claimed infringement received from the complainant is enclosed for your reference.

If you believe that the materials posted on your website do not infringing the Complainant's copyright, or if you believe that the Complainant's complaint about those materials is a result of mistake or misidentification, you may complete the attached Counter-Notification Form, signed under penalty of perjury, and serve it on [Service Provider's] designated agent at the fax number or email address identified at the bottom of the Counter-Notification Form.

Upon receipt of the properly completed and signed Counter Notification Form from you, [Service Provider] will provide a copy to the Complainant. Pursuant to the DMCA, after a 10-day waiting period, [Service Provider] will reactivate services to your website unless [Service Provider] receives written notice from the Complainant that the Complainant has filed an action seeking a court order to restrain you from further alleged infringing activities.

The foregoing should not be construed as offering legal advise, nor should you construe this communication as establishing any sort of attorney-client relationship. Rather, this information is provided solely as a courtesy to [Service Provider's] subscribers regarding DMCA requirements.

Respectfully,

Attorney

**APPENDIX B-2**  
**Counter Notification Form**

I, the undersigned subscriber to the services of [Service Provider], or an authorized agent of the subscriber (hereinafter "Subscriber") state and declare **UNDER PENALTY OF PERJURY** as follows:

1. Subscriber is in receipt of a Notification of Claimed Infringement ("NCI") by [\_\_\_\_\_] (hereinafter the Complainant), which was forwarded by [Service Provider] to the Subscriber.

2. Subscriber has a good faith belief that the alleged infringing material identified by the Complainant in the NCI, which was relied upon by [Service Provider] in removal or disabling of access to the material identified therein, is a result of mistake or misidentification.

3. Subscriber's full name, address and telephone number is as follows:

Subscriber's name:\* \_\_\_\_\_  
(last\*) (first\*) (middle initial)

Subscriber's title: \_\_\_\_\_

Subscriber's company: \_\_\_\_\_

Subscriber's address:\* \_\_\_\_\_  
(street\*) (city\*) (state\*) (zip\*)

Subscriber's e-mail address:\* \_\_\_\_\_

Subscriber's telephone:\* \_\_\_\_\_

Subscriber's fax: \_\_\_\_\_

4. Subscriber consents to the jurisdiction of the district courts of the United States for the judicial district within which Subscriber's above address is located (if in the United States). If subscribers address is outside the United States, Subscriber consents to the jurisdiction of the district courts of the United States for any judicial district in which [Service Provider] may be found.

5. Subscriber will accept service of process from the Complainant or its agents.

**Subscriber:**

\_\_\_\_\_  
(Signature)

Date: \_\_\_\_\_

**FAX THIS SIGNED AND COMPLETED COUNTER NOTIFICATION FORM TO:**

**(XXX) XXX-XXXX ATTENTION:**

**OR**

**E-MAIL TO: [XXX@\[ServiceProvider.COM\]](mailto:XXX@[ServiceProvider.COM])**

**APPENDIX C**  
**Notice to Complainant of**  
**Receipt of Counter Notification from Subscriber**

[Complainant]  
[Address]

**VIA US MAIL**

Re: Notice of receipt of Counter-Notification concerning alleged infringing materials at URL –  
[http://www.\[accusedwebsite.com\]](http://www.[accusedwebsite.com])

Dear [Complainant]:

We are in receipt of a counter notification from the [Subscriber] regarding alleged infringing materials identified in your notification of claimed infringement received on [Date]. A copy of the subscriber's counter notification is attached hereto for your reference.

The counter notification appears to be in compliance with the requirements of 17 U.S.C. § 512(g)(3). Accordingly, as required under 17 U.S.C. § 512(g)(2)(B) and (C), [Service Provider] will restore services to the above referenced website and/or the alleged infringing materials accessible thereon after [Date] (i.e., not less than ten (10) business days but no more than fourteen (14) business days from the date of receipt of the counter notification) unless you serve upon [Service Provider's] designated agent, on or before that date, a notice that you have filed an action seeking a court order to restrain the subscriber from engaging in infringing activity relating to the material on [Service Provider's] system or network.

Respectfully,

Attorney

983911.1