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Control, Alt, Delete: Understanding the Implications of Courts' Current Interpretation of 17 U.S.C. § 1202(b)

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**Control, Alt, Delete: Understanding the Implications
of Courts’ Current Interpretation of
17 U.S.C. § 1202(b)**

*Tess Layton**

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INTRODUCTION

John, a professional photographer, owns the copyrights to his photographs. He takes numerous precautions to maintain the integrity of his work, going above what other photographers do to protect their own work. John puts copyright management information into the photos' files in metadata, maintains contracts with his customers, and monitors the Internet diligently for potential infringement. After discovering his photographs on an infringing website without intact metadata, John sues the company that removed the copyright management information, claiming a 17 U.S.C. § 1202(b) violation. The court rules that John could not prove specific instances of infringement caused by the defendant's removal of copyright management information, and thus the defendant is not found liable. With this strict interpretation of § 1202(b), John may find no relief for the damages he suffers. However, if the court adopts an updated standard that favors copyright holders, he may be able to recover after all.

John is not the only digital artist affected by such actions. The United States Court of Appeals for the Eleventh Circuit recently decided *Elias v. Ice Portal*, which concerned another artist and the struggle to protect his work.¹ Victor Elias had his identifying information removed from his photographs, which were then distributed to other third-party websites without his permission.² Not only did the photographs not give Elias credit, but also credited someone other than him.³ *Elias v. Ice Portal* illustrates the consequences when one removes copyright management information from the work of digital artists.⁴ It becomes orphan work and

1. Victor Elias Photography, LLC v. Ice Portal, Inc., 43 F.4th 1313, 1315 (11th Cir. 2022).

2. *Id.* at 1315.

3. *Id.* at 1318.

4. Brief for American Society of Media Photographers, Inc. et al. as Amici Curiae in Support of Appellant Requesting Reversal at 18, Victor Elias

makes it vulnerable to infringement.⁵ Orphan works are copyrighted works whose owner is difficult to find or impossible to reach.⁶ A person may use a work because he or she is unaware that it belongs to someone else, thus creating the risk of the true owner bringing an infringement action against the unknowing user.⁷ A user may also avoid a work because he or she is unable to determine the owner and is unsure if this use is allowed.⁸ When this occurs, “a significant part of the world’s cultural heritage embodied in copyright-protected works” may go untouched.⁹ This can lead to the restriction of millions of works that would otherwise be available to all citizens.¹⁰

While orphan works affect all kinds of works, the majority of the problem surrounds orphan photographs.¹¹ Copyright in all works, including photographs, exists automatically when an author fixes an original work of authorship in a tangible medium.¹² No registration is required unless the copyright holder wishes to enforce the copyright through litigation.¹³ Therefore, since there is no registration requirement, many works lack a public record relating to the ownership and authorship of the work.¹⁴ Photographs are particularly difficult works to trace because their ownership information is often removed, including the label or caption attached to the photograph itself.¹⁵ Due to this separation, potential users lack the basic information necessary to discern ownership of the images.¹⁶ Thus, users cannot utilize some photographs without the risk of potential litigation for infringement.¹⁷

Photography, LLC v. Ice Portal, Inc., 43 F.4th 1313 (11th Cir. 2022) (No. 21–11892).

5. *Id.*

6. *Orphan Works*, BENTLEY UNIV. LIBR. (Jan. 23, 2023, 10:24 AM), <https://libguides.bentley.edu/c.php?g=535059&p=3660375> [<https://perma.cc/NW5J-3HHB>].

7. U.S. COPYRIGHT OFF., ORPHAN WORKS AND MASS DIGITIZATION: A REPORT OF THE REGISTER OF COPYRIGHTS 35 (June 2015) [hereinafter ORPHAN WORKS AND MASS DIGITIZATION].

8. *Id.*

9. *Id.*

10. *Id.* at 36.

11. *Id.* at 11.

12. *Copyright Basics*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/circs/circ01.pdf> [<https://perma.cc/ZNF4-QVSS>] (last visited Nov. 2, 2022).

13. *Id.*

14. *Id.*

15. ORPHAN WORKS AND MASS DIGITIZATION, *supra* note 7, at 11.

16. *Id.*

17. *Id.* at 1.

The uncertainty of orphan photographs can become a risk to good-faith users if an author has knowingly let the work circulate free of registration.¹⁸ Therefore, protecting the work of digital artists who desire to preserve their rights in ownership is important for consumers to trust “the integrity of the electronic marketplace.”¹⁹ Congress enacted 17 U.S.C. § 1202 to protect the integrity of copyright management information.²⁰ This statute attempts to prevent the removal of identifying information in copyrighted works so users might avoid problems like orphan works.²¹ To achieve the purpose of § 1202, it is necessary to develop and implement a uniform standard for courts’ application of the statute.

This Comment suggests that Congress revise and clarify § 1202(b) to allow for consistent application of the provision throughout the circuits. By providing further explanation, Congress can enable courts to obtain a unified solution for § 1202(b) cases. First, Congress should revise the language and provide clarification of § 1202(b) to include statements that reflect the original legislative intent of the statute. Courts interpret § 1202(b) incorrectly due to the statute’s current language.²² The courts are forcing copyright owners to bear a burden that Congress never intended to be so high.²³ Congress enacted § 1202 to provide a layer of protection for copyright management information, and utilizing a standard that makes it nearly impossible for copyright holders to effectively protect copyright management information ignores that legislative intent.²⁴ The requisite intent should be lower and less of a burden on copyright holders to prove. By revising the statute, courts will have a clear and unambiguous standard to follow in future cases.

Additionally, if the plaintiff can prove certain acts by the defendant, the court should include a rebuttable presumption that the defendant intentionally removed the copyright management information with the specific intent necessary. Currently,²⁵ plaintiffs must prove defendants knew or reasonably should have known their actions would certainly

18. *Id.* at 35.

19. *WIPO Copyright Treaties Implementation Act, and Online Copyright Liability Limitation Act: Hearing Before the H. Subcomm. on Courts and Intellectual Property of the H. Comm. on the Judiciary*, 105th Cong. 51 (1997) (statement of Marybeth Peters, Register of Copyrights).

20. 17 U.S.C. § 1202.

21. *Id.*

22. Brief for American Society of Media Photographers, *supra* note 4, at 27.

23. *Id.* at 5.

24. *Id.* at 14.

25. This Comment was written in 2023.

“induce, enable, facilitate, or conceal an infringement.”²⁶ With a new standard, defendants will have to prove they did not know their actions would lead to infringement. The plaintiff, injured by the defendant’s actions, should not have to bear the complete burden of showing intent. This solution will favor copyright owners by lowering the standard that they must meet to succeed in § 1202(b) cases.

Part I of this Comment provides the background and history of copyright infringement in the age of the Internet, the formation of the Digital Millennium Copyright Act, and Title 17 § 1202 of the United States Code. Additionally, Part I examines the legislative history of the Digital Millennium Copyright Act, defines copyright management information, and provides illustrations of § 1202(b) disputes. Part II discusses primary and secondary liability using examples of prior contributory infringement cases. Part III examines how § 1202(b) cases differ from contributory infringement cases and therefore should be treated differently. Part III also argues that the courts’ past interpretations of § 1202(b) are incorrect and do not adhere to the historical legislative intent of the statute. Finally, Part III proposes that Congress revise the wording in § 1202(b), provide clarification of the statute, and create a rebuttable presumption more favorable to copyright holders.

I. THE INTERNET AND COPYRIGHT INFRINGEMENT

The Internet has rapidly grown since its introduction in the 1960s.²⁷ Unfortunately, this growth has also increased the likelihood for infringers to reproduce or manipulate a work.²⁸ The Internet made copyright infringement as simple as the click of a button.²⁹ It quickly became apparent that new legislation was necessary to combat the infringement generated by this new technology.³⁰ The ease with which online pirates distributed and infringed upon digital copyrighted works forced Congress into action in the late 1990s.³¹ Congress did this in conjunction with, or in

26. *Victor Elias Photography, LLC v. Ice Portal, Inc.*, 43 F.4th 1313, 1320 (11th Cir. 2022).

27. *A Brief History of the Internet*, ONLINE LIBR. LEARNING CTR., https://www.usg.edu/galileo/skills/unit07/internet07_02.phtml [<https://perma.cc/D7JP-XXZ5>] (last visited Oct. 11, 2022).

28. BRUCE A LEHMAN, *INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE: THE REPORT OF THE WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS* 12 (1995).

29. *Id.*

30. *Id.* at 5.

31. Brief for American Society of Media Photographers, *supra* note 4, at 16.

partial response to, two international treaties enacted by the World Intellectual Property Organization.³²

A. The World Intellectual Property Organization

In 1996, the World Intellectual Property Organization (WIPO)³³ held a diplomatic conference in Geneva, Switzerland to tighten international copyright law.³⁴ The need for the conference arose out of the global use of the Internet.³⁵ WIPO enacted two treaties: the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty.³⁶

The WIPO Copyright Treaty protects the authors of artistic and literary works.³⁷ These works include writings, musical works, fine art, and photographs.³⁸ The WIPO Performances and Phonograms Treaty protects rights related to copyrights, which include the rights of performers and phonogram producers.³⁹ WIPO enacted these two treaties to update and supplement existing treaties on copyright law.⁴⁰ Both treaties address the challenges of modern technology and the circulation of digital works over the Internet.⁴¹ Over 100 countries, including the United States, adopted the WIPO Copyright Treaty and the WIPO Performances and

32. *Id.* at 13.

33. *Id.* at 10. In 1970, the Bureau for the Protection of Intellectual Property transformed into what is now known as the World Intellectual Property Organization in Geneva, Switzerland. *WIPO – A Brief History*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/about-wipo/en/history.html> [<https://perma.cc/GQ7D-UXYL>] (last visited Oct. 11, 2022). Since then, the World Intellectual Property Organization has turned into a global forum for intellectual property services comprised of 193 member states. *Inside WIPO*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/about-wipo/en/> [<https://perma.cc/XNC3-N5YM>] (last visited Oct. 11, 2022).

34. INT'L BUREAU OF WIPO, THE ADVANTAGES OF ADHERENCE TO THE WIPO COPYRIGHT TREATY (WCT) AND THE WIPO PERFORMANCES AND PHONOGRAMS TREATY (WPPT) 2 (1996).

35. *Id.*

36. *Id.*

37. *Id.*

38. *Id.*

39. *Id.*

40. WIPO created these two treaties to update and supplement major existing WIPO treaties on copyright and related rights, specifically the Berne Convention and the Rome Convention, which were last revised around a quarter century before these two treaties were enacted. *Id.*

41. *Id.*

Phonograms treaty, reflecting a widespread international agreement on the management of copyright law in the age of the Internet.⁴²

B. The Digital Millennium Copyright Act

In 1998, the Digital Millennium Copyright Act (DMCA) implemented both the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty in the United States, as both marked the most substantial redrafting of international copyright law in more than 25 years.⁴³ Congress passed the DMCA to address concerns regarding copyright law and the Internet.⁴⁴ The Internet posed a threat to protected digital materials because they could be easily disseminated over digital networks.⁴⁵ The three main focuses of the DMCA are to: (1) protect online service providers if their users are engaging in copyright infringement; (2) provide legal protection to copyright owners to encourage increased availability of their work in digital formats; and (3) create legal consequences for removing or altering copyright management information.⁴⁶ The DMCA not only attempts to regulate the electronic marketplace but also penalizes those who break copyright laws.⁴⁷

The DMCA amended Title 17 of the United States Code to add provisions on the integrity of copyright management information.⁴⁸ Specifically, 17 U.S.C. § 1202(b) covers the intentional removal and distribution of copyright management information when the copyright owner does not authorize such actions.⁴⁹ Section 1202(b) provides that:

No person shall, without the authority of the copyright owner or the law—

. . . (3) distribute, import for distribution, or publicly perform works, copies of works, or phonorecords, knowing that copyright management information has been removed or altered without authority of the copyright owner or the law, knowing, or, with respect to civil remedies under section 1203, having reasonable

42. *Id.*

43. Presidential Statement on Signing the Digital Millennium Copyright Act, 34 WEEKLY COMP. PRES. DOC. 2168 (Nov. 2, 1998).

44. U.S. COPYRIGHT OFF., THE DIGITAL MILLENNIUM COPYRIGHT ACT OF 1998: U.S. COPYRIGHT OFFICE SUMMARY I (Dec. 1998).

45. Brief for American Society of Media Photographers, *supra* note 4, at 11.

46. Digital Millennium Copyright Act, 17 U.S.C. §§ 1201–03 (1998).

47. THE DIGITAL MILLENNIUM COPYRIGHT ACT OF 1998: U.S. COPYRIGHT OFFICE SUMMARY, *supra* note 44, at 1.

48. 17 U.S.C. § 1202.

49. *Id.* § 1202(b).

grounds to know, that it will induce, enable, facilitate, or conceal an infringement of any right under this title.⁵⁰

Plainly stated, if someone distributes a work and is aware of the removal of copyright management information, there may be civil or criminal consequences.⁵¹

C. Copyright Management Information for Dummies

Copyright management information identifies information about a copyrighted work or its owner.⁵² This information is directly connected to the copyrighted work.⁵³ Section 1202(c) enumerates a list of eight broad categories⁵⁴ that describe the various types of copyright management information.⁵⁵ The list includes, but is not limited to, the title of the work, the name of the author, and terms and conditions.⁵⁶ Visible copyright management information, like a watermark on a photograph, can obscure

50. *Id.*

51. *Id.*

52. *Stevens v. CoreLogic, Inc.*, 899 F.3d 666, 670 (9th Cir. 2018).

53. *Id.*

54. The list in 17 U.S.C. § 1202(c) includes:

(1) The title and other information identifying the work, including the information set forth on a notice of copyright.

(2) The name of, and other identifying information about, the author of a work.

(3) The name of, and other identifying information about, the copyright owner of the work, including the information set forth in a notice of copyright.

(4) With the exception of public performances of works by radio and television broadcast stations, the name of, and other identifying information about, a performer whose performance is fixed in a work other than an audiovisual work.

(5) With the exception of public performances of works by radio and television broadcast stations, in the case of an audiovisual work, the name of, and other identifying information about, a writer, performer, or director who is credited in the audiovisual work.

(6) Terms and conditions for use of the work.

(7) Identifying numbers or symbols referring to such information or links to such information.

(8) Such other information as the Register of Copyrights may prescribe by regulation, except that the Register of Copyrights may not require the provision of any information concerning the user of a copyrighted work.

55. *Id.*

56. *Id.*

parts of the image.⁵⁷ It is also typically not text searchable, meaning that it is not easily found in a keyword search.⁵⁸ For example, performing a keyword search in a large PDF makes finding a specific word simple.⁵⁹ In contrast, if a user performs a keyword search on an image instead, it requires tediously reading through every word on each page.⁶⁰ Thus, some people will use metadata copyright management information to avoid the issue of text searchability.⁶¹

Metadata is embedded data that is not visible on the image, allowing users to store copyright management information within it without obscuring the image itself.⁶² This type of information is beneficial because it appears in various keyword searches.⁶³ Many copyright holders use metadata within their works so they can track them—as well as who is using them—on the Internet.⁶⁴ Additionally, metadata protects the commercial value of an image because it is not visible.⁶⁵ Metadata is the best option for copyright holders because it allows the copyright owner to convey as much copyright management information as he or she desires.⁶⁶

A § 1202(b) violation occurs when an infringer knowingly removes metadata without the owner's permission.⁶⁷ Therefore, metadata copyright management information is important because it deters copyright infringement.⁶⁸ If there is no identifying information on the work, there is a greater chance of infringement occurring.⁶⁹ Comparably, a stranger is less likely to return a wallet left in public with no contact information than one with a driver's license inside.⁷⁰

D. Understanding the Legislative Intent of § 1202(b)

To understand why Congress enacted § 1202 and the correct application of it in infringement cases, it is important to look at the

57. Brief for American Society of Media Photographers, *supra* note 4, at 8.

58. *Id.* at 9.

59. *Id.*

60. *Id.*

61. *Id.* at 7.

62. *Stevens v. CoreLogic, Inc.*, 899 F.3d 666, 670–71 (9th Cir. 2018).

63. Brief for American Society of Media Photographers, *supra* note 4, at 9.

64. *Id.*

65. *Id.* at 10.

66. *Id.*

67. *Stevens*, 899 F.3d at 671.

68. Brief for American Society of Media Photographers, *supra* note 4, at 18.

69. *Id.* at 19.

70. *Id.*

legislative history of the statute. On September 16, 1997, the Register of Copyrights, Marybeth Peters, addressed the Subcommittee on Courts and the Intellectual Property Committee on the Judiciary.⁷¹ The goal of the meeting was to provide detailed information about the two WIPO treaties eventually adopted as the DMCA.⁷² Peters discussed § 1202 and how it would make copyright management information more reliable and accurate.⁷³ She addressed worries revolving around the statute, stating that copyright owners “expressed concern that this standard will be too difficult to meet.”⁷⁴ The stance of the Copyright Office is as follows:

[I]t is important to make clear, possibly in legislative history, that the reference to infringement does not mean that the actor must have intended to further any particular act of infringement—just to make infringement generally possible or easier to accomplish.⁷⁵

Therefore, as political entities and organizations debated about the DMCA, the Register of Copyrights made it clear that the Copyright Office did not want the standard for intent to be an overwhelming burden on copyright holders.⁷⁶ Instead, Peters plainly stated that the Copyright Office desired to ease the minds of copyright holders by assuring them that the standard for intent would not be too difficult to meet.⁷⁷

E. Federal Courts’ Recent § 1202(b) Interpretations

To understand how courts have applied § 1202(b) in practice, it is necessary to look at recent decisions in the circuit courts. One opinion, *Stevens v. CoreLogic*, showcases how the United States Court of Appeals for the Ninth Circuit interpreted the statute.⁷⁸ This case, as well as *Mango v. BuzzFeed* and *Elias v. Ice Portal*, create an alarming precedent for copyright holders.⁷⁹

71. *WIPO Copyright Treaties Implementation Act, and Online Copyright Liability Limitation Act: Hearing Before the H. Subcomm. on Courts and Intellectual Property of the H. Comm. on the Judiciary*, *supra* note 19, at 1.

72. *Id.*

73. *Id.*

74. *Id.*

75. *Id.*

76. *Id.*

77. *Id.*

78. *Stevens v. CoreLogic, Inc.*, 899 F.3d 666, 666 (9th Cir. 2018).

79. *See generally* *Mango v. Buzzfeed, Inc.*, 970 F.3d 167 (2d Cir. 2020). *See also* *Victor Elias Photography, LLC v. Ice Portal, Inc.*, 43 F.4th 1313, 1313 (11th Cir. 2022).

1. Stevens v. CoreLogic

In *Stevens*, the Ninth Circuit considered whether CoreLogic removed copyright management information from two photographers' photographs and distributed these images with knowledge of the detached information.⁸⁰ Robert Stevens and Steven Vandel were photographers who took digital pictures of houses and licensed them to real estate agents, all while still retaining the copyrights in the photos.⁸¹ Some of the photographs had embedded metadata that was not visible on the images, including information about the image, and sometimes the photographer as well.⁸² CoreLogic's image processing software⁸³ occasionally deleted the metadata attached to images.⁸⁴ Stevens and Vandel alleged that this occurred to the images they provided to CoreLogic.⁸⁵ The two photographers filed suit against CoreLogic for removing the copyright management information metadata from their images.⁸⁶ Ultimately, the claim concerned whether CoreLogic violated § 1202(b) by removing the metadata.⁸⁷

The Ninth Circuit held that "the mental state requirement in Section 1202(b) must have a more specific application than the universal possibility of encouraging infringement."⁸⁸ Therefore, a defendant must have a knowing mental state that his or her actions will cause infringement.⁸⁹ The photographers argued that since this impaired one method of identifying copyright infringement, unauthorized third-party use of their photographs might go undetected.⁹⁰ The court rejected this argument by stating that it does not rely on any affirmative evidence.⁹¹ The argument, the court added, only shows that infringement is generally

80. *Stevens*, 899 F.3d at 672.

81. *Id.* at 670.

82. *Id.*

83. CoreLogic makes software and provides it to Multiple Listing Services. *Id.* at 671. A Multiple Listing Service is a database established by real estate brokers to provide data about properties for sale. James Chen, *Multiple Listing Service (MLS): Definitions, Benefits, and Fees*, INVESTOPEDIA (Jan. 21, 2022), <https://www.investopedia.com/terms/m/multiple-listing-service-mls.asp> [<https://perma.cc/BA8U-BAZD>].

84. *Stevens*, 899 F.3d at 671.

85. *Id.* at 672.

86. *Id.*

87. *Id.*

88. *Id.* at 674.

89. *Id.* at 673.

90. *Id.*

91. *Id.*

possible when an infringer removes copyright management information.⁹² Thus, according to the Ninth Circuit, plaintiffs bringing a § 1202(b) claim must affirmatively show that the defendants knew of the likely future impact of their actions.⁹³ The court noted that plaintiffs can show this by demonstrating a *modus operandi*⁹⁴ or pattern of past conduct that the defendant “was aware or had reasonable grounds to be aware of the probable future impact of its actions.”⁹⁵ Accordingly, to meet the knowledge requirement of § 1202(b), plaintiffs “must provide evidence from which one can infer that future infringement is likely, albeit not certain, to occur as a result of the removal or alteration of [copyright management information].”⁹⁶ The United States Court of Appeals for the Second Circuit further considered the issue of how to interpret § 1202(b) in *Mango v. BuzzFeed*.⁹⁷

2. *Mango v. BuzzFeed*

In *Mango*, the Second Circuit considered whether § 1202(b) requires that defendants know or have reason to know that their actions would cause future third-party infringement.⁹⁸ Gregory Mango, a photographer who licensed his photographs to newspapers, took a photo of a man named Raymond Parker.⁹⁹ Mango licensed the picture to the *New York Post*, who published the picture and gave Mango credit in the article below the photo.¹⁰⁰ About three months after the *New York Post* published Mango’s article, a BuzzFeed¹⁰¹ journalist published an article that included the photo taken by Mango without Mango’s permission or any credit to him.¹⁰² Mango filed suit against BuzzFeed, alleging that a § 1202(b) violation occurred due to the removal of the copyright management information

92. *Id.*

93. *Id.* at 674.

94. *Modus operandi* is Latin for “a manner of operating.” *Modus operandi*, BLACK’S LAW DICTIONARY (11th ed. 2019). It is a “method of operating or a manner of procedure; esp., a pattern of criminal behavior so distinctive that investigators attribute it to the work of the same person.” *Id.*

95. *Stevens*, 899 F.3d at 674.

96. *Id.*

97. *Mango v. BuzzFeed, Inc.*, 970 F.3d 167, 170 (2d Cir. 2020).

98. *Id.* at 171.

99. *Id.* at 169.

100. *Id.*

101. BuzzFeed is a media company that publishes various types of entertainment content online. *Id.*

102. *Id.*

from his photo.¹⁰³ The Second Circuit held that plaintiffs must prove four factors in a § 1202(b) case.¹⁰⁴ The factors include:

(1) the existence of [copyright management information] in connection with a copyrighted work; and (2) that a defendant “distribute[d] . . . works [or] copies of works”; (3) while “knowing that [copyright management information] has been removed or altered without authority of the copyright owner or the law”; and (4) while “knowing, or . . . having reasonable grounds to know” that such distribution “will induce, enable, facilitate, or conceal an infringement.”¹⁰⁵

The court noted that the language of § 1202(b) contains a double scienter requirement.¹⁰⁶ As a result, a defendant must have knowledge of the copyright management information’s removal and must also know or have reason to know that this removal will enable, induce, facilitate, or conceal copyright infringement.¹⁰⁷

The court added that infringement is not limited by a certain actor or time.¹⁰⁸ Therefore, future infringement by a third party can meet the infringement standard under § 1202(b), but it is not the only way.¹⁰⁹ The court held that BuzzFeed distributed the photograph with knowledge of the copyright management information’s removal, and thus, BuzzFeed knew or had reasonable grounds to know that the removal enabled an infringement.¹¹⁰ The decision relied on the fact that BuzzFeed distributed the photo with the photographer’s credit removed and instead put the name of a law firm in its place.¹¹¹ The Second Circuit ruled in favor of the copyright holder in this case only because he was able to show specific instances of infringement caused by the defendants’ actions.¹¹² The court found that replacing Mango’s credit with the name of a law firm concealed the fact that the defendants did not have permission to use the photograph.¹¹³

103. *Id.* at 170.

104. *Id.* at 171.

105. *Id.*

106. *Id.* at 172.

107. *Id.*

108. *Id.*

109. *Id.*

110. *Id.* at 172–73.

111. *Id.* at 172.

112. *Id.*

113. *Id.*

Therefore, under *Mango* and *Stevens*, the Second Circuit and Ninth Circuit place a high burden on copyright holders.¹¹⁴ This burden requires the copyright holder to show specific evidence that a defendant's actions will lead to infringement.¹¹⁵ The United States Court of Appeals for the Eleventh Circuit followed in the same path as the Second and Ninth Circuits in deciding *Elias v. Ice Portal*.¹¹⁶

3. *Elias v. Ice Portal, Inc.*

In *Elias*, the Eleventh Circuit considered whether Ice Portal possessed the requisite intent to render the company liable for a § 1202(b) violation.¹¹⁷ Victor Elias, a professional photographer whose specialty is hotel and resort photography, registered his photographs with the Copyright Office and maintained the copyrights for his images.¹¹⁸ Elias licensed his photographs to hotels, inserted metadata into the files and allowed them to use the photos to promote their properties.¹¹⁹ Elias used the embedded copyright management information in his photographs to monitor the Internet for potential copyright violations.¹²⁰ As he searched for violations, Elias discovered some of his photographs posted on unauthorized websites without the copyright management information attached.¹²¹ Ice Portal, now a division of Shiji, Inc.,¹²² placed the photos on third-party websites.¹²³ To do this, it used software that sometimes removed the metadata copyright management information from the

114. *Id.* at 167; *Stevens v. CoreLogic, Inc.*, 899 F.3d 666, 675 (9th Cir. 2018).

115. *Mango*, 970 F.3d at 167; *Stevens*, 899 F.3d at 666.

116. *Victor Elias Photography, LLC v. Ice Portal, Inc.*, 43 F.4th 1313, 1313 (11th Cir. 2022).

117. *Id.* at 1315.

118. *Id.* at 1316.

119. *Id.* at 1316–17.

120. *Id.* at 1317.

121. *Id.* at 1318.

122. Shiji was an intermediary between hotels and online travel agencies. They received copies of hotel photographs and made them available to online travel agencies. During the relevant time period, Ice Portal was the company acting as the intermediary between the hotels and the online travel agencies. Shiji acquired Ice Portal in February 2019, at which time Ice Portal merged into Shiji and became a division of the larger company. This Comment will now refer to the companies collectively as Shiji. *Id.* at 1315 n.1, 1317.

123. *Id.* at 1317.

photos.¹²⁴ Elias filed suit against Shiji, arguing that the removal of the copyright management information enabled copyright infringement.¹²⁵

The interpretation of § 1202(b) was an issue of first impression for the Eleventh Circuit.¹²⁶ The court interpreted the term *will* in § 1202(b) to mean that it is not enough for the defendant to know, or have reason to know, that his or her actions *may* cause infringement.¹²⁷ Therefore, the person who removed the copyright management information “must know, or have reasonable grounds to know” that their actions *will* cause infringement.¹²⁸

The court first looked at the Second Circuit opinion in *Mango* to describe the four elements that a claimant must prove in a § 1202(b) case.¹²⁹ Like the Second Circuit, the Eleventh Circuit found that § 1202(b) cases contain a double scienter requirement, which requires that a defendant must have constructive knowledge of the removal of copyright management information and that this will induce, enable, facilitate, or conceal infringement.¹³⁰ Next, the Eleventh Circuit used the Ninth Circuit’s opinion in *Stevens* to explain the mental state requirement of § 1202(b).¹³¹ The Eleventh Circuit found that there must be more than just the possibility of causing infringement; rather, there must be an affirmative showing that the defendant knew or had reasonable grounds to know that future infringement would occur.¹³² Elias was unable to meet this burden because he could not show evidence that Shiji’s distribution of the photographs enabled infringement; therefore, Elias lost the suit.¹³³

Elias argued that the court should adopt a standard in which a defendant “can be held liable so long as the defendant knows, or has reasonable grounds to know, that its actions ‘make infringement generally possible or easier to accomplish.’”¹³⁴ However, the Eleventh Circuit rejected this interpretation of § 1202(b) and adopted the interpretation of the Ninth Circuit in *Stevens*.¹³⁵ That is, the plain language of § 1202(b) “requires some identifiable connection between the defendant’s actions

124. *Id.*

125. *Id.* at 1318.

126. *Id.* at 1319.

127. *Id.* at 1320.

128. *Id.* at 1321.

129. *Id.* at 1320.

130. *Id.*

131. *Id.*

132. *Id.*

133. *Id.* at 1325.

134. *Id.* at 1320–21.

135. *Stevens v. CoreLogic, Inc.*, 899 F.3d 666, 674 (9th Cir. 2018).

and the infringement or the likelihood of infringement.”¹³⁶ The Eleventh Circuit enforced a heightened standard for copyright holders to follow by requiring that plaintiffs must make an affirmative showing that defendants knew infringement would occur.¹³⁷

II. WHO IS LIABLE?

The legislative history makes clear that the goals of the DMCA and § 1202 in particular are to protect the integrity of copyright management information and create liability for violations of the statute.¹³⁸ The Second, Ninth, and Eleventh Circuits implemented the theory of secondary liability to make their decisions.¹³⁹ The courts combined primary liability for the removal of copyright management information with secondary liability for copyright and trademark infringement.¹⁴⁰ Instead, courts should rely solely on the theory of primary liability provided in § 1202(b) because that is the type of liability the statute requires.¹⁴¹

A. Primary vs. Secondary Liability

Primary liability relates to an obligation for which a party is directly responsible.¹⁴² Conversely, secondary liability is liability that is derived from primary liability.¹⁴³ In general, courts impose secondary liability on a person who does not commit a wrongdoing directly but can still be held liable even if the court may also pursue the primarily liable party.¹⁴⁴ Secondary liability does not exist without some primary liability, and it is

136. *Victor Elias Photography*, 43 F.4th at 1325.

137. *Id.* at 1320.

138. Presidential Statement on Signing the Digital Millennium Copyright Act, *supra* note 43.

139. *Stevens*, 899 F.3d at 666; *Mango v. BuzzFeed, Inc.*, 970 F.3d 167, 172 (2d Cir. 2020); *Victor Elias Photography*, 43 F.4th at 1313.

140. *Stevens*, 899 F.3d at 666; *Mango*, 970 F.3d at 167; *Victor Elias Photography*, 43 F.4th at 1313.

141. 17 U.S.C. § 1202(b).

142. *Primary Liability*, LEGAL INFO. INST., https://www.law.cornell.edu/wex/primary_liability [<https://perma.cc/B35N-CC9T>] (last visited Nov. 1, 2022).

143. *Secondary Liability*, LEGAL INFO. INST., https://www.law.cornell.edu/wex/secondary_liability [<https://perma.cc/46VY-8NBN>] (last visited Jan. 14, 2022).

144. JAMES BOYLE & JENNIFER JENKINS, *INTELLECTUAL PROPERTY: LAW & THE INFORMATION SOCIETY CASES AND MATERIALS* 515 (5th ed. 2021).

found in all areas of intellectual property law.¹⁴⁵ Contributory infringement is a form of secondary liability¹⁴⁶ and pertains to copyrights, trademarks, and patents.¹⁴⁷ Contributory infringement occurs when a court holds a person liable for infringement even though he or she did not participate directly in the infringing activities.¹⁴⁸ Generally, the two elements needed to fulfill contributory infringement are the user's knowledge of the infringement and contribution to the activity.¹⁴⁹

1. *Contributory Liability and Copyright Law*

The Copyright Act of 1976, which provides the basic framework for current copyright law, does not create liability for contributory infringement.¹⁵⁰ However, the United States Supreme Court stated that the absence of express language discussing contributory infringement does not preclude liability from it.¹⁵¹ A court may hold one contributorily liable if he or she knowingly contributes to copyright infringement but has not participated directly in the activities himself or herself.¹⁵² Liability occurs if the person knew or had reason to know about the infringement.¹⁵³ An

145. *Intentional Inducement of Copyright Infringements Act of 2004: Hearing Before the S. Comm. on the Judiciary*, 108th Cong. 51 (2004) (statement of Marybeth Peters, Register of Copyrights).

146. Secondary liability cases in intellectual property include vicarious liability as well. Robert M. Hirning, *Contributory and Vicarious Copyright Infringement in Computer Software: Harming One Form of Intellectual Property by Protecting Another*, 6 CHI.-KENT J. INTELL. PROP. 10, 10 n.2 (2006). However, this Comment will not discuss vicarious liability because it revolves around a person's liability for the infringing act of someone else, even though this person has not directly committed an act of infringement himself or herself. *Id.* This Comment focuses on those persons who contribute directly to the infringement and have some sort of knowledge of it. Therefore, this Comment will only discuss contributory liability. *Id.*

147. *Contributory Infringement*, LEGAL INFO. INST., https://www.law.cornell.edu/wex/contributory_infringement [<https://perma.cc/8NKH-YN5P>] (last visited Oct. 11, 2022).

148. *Id.*

149. *Id.*

150. *See generally* U.S. COPYRIGHT OFF., COPYRIGHT LAW OF THE UNITED STATES AND THE RELATED LAWS CONTAINED IN TITLE 17 OF THE UNITED STATES CODE (Oct. 2022); *Contributory Infringement*, *supra* note 147.

151. *Intell. Rsrv., Inc. v. Utah Lighthouse Ministry, Inc.*, 75 F. Supp. 2d 1290, 1292 (D. Utah 1999).

152. *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 930 (2005).

153. *Contributory Infringement*, *supra* note 147.

example of contributory infringement in copyright law is shown in the United States Supreme Court case *MGM v. Grokster*.¹⁵⁴

In *MGM v. Grokster*, the United States Supreme Court determined when a distributor of a product that is capable of some lawful and unlawful use is liable for copyright infringement by third parties.¹⁵⁵ The defendant software company, Grokster, issued products which allowed computer users to distribute files through peer-to-peer networks.¹⁵⁶ A group of copyright holders,¹⁵⁷ known collectively as MGM, brought suit against Grokster for the copyright infringement of their users, claiming that Grokster “knowingly and intentionally distributed [MGM’s] software to enable users to reproduce and distribute the copyrighted works in violation of the Copyright Act.”¹⁵⁸

The Court stated that it was impossible to enforce rights in the protected works against every direct infringer due to the vast amount of people using Grokster’s software.¹⁵⁹ Therefore, the only practical alternative was to go against the manufacturer of the copying device itself for contributory infringement.¹⁶⁰ The Court noted that someone participates in contributory infringement when he or she intentionally induces or encourages direct infringement.¹⁶¹ Thus, one who administers a device with the “object of promoting its use to infringe copyright, as shown by clear expression or other affirmative steps taken to foster infringement, is liable for the resulting acts of infringement by third parties.”¹⁶²

The Court found three pieces of evidence displaying Grokster’s intent to induce or encourage direct infringement.¹⁶³ First, Grokster advertised itself in a way that aimed to satisfy a well-known source of demand for copyright infringement.¹⁶⁴ Second, Grokster never attempted to create filtering tools to lower the infringing activity on its software.¹⁶⁵ Third and

154. *MGM Studios*, 545 U.S. at 913.

155. *Id.* at 918–19.

156. *Id.* at 919.

157. The group that brought this suit included motion picture studios, song writers, recording companies, and music publishers. *Id.* at 920. For the purposes of this Comment, the group as a whole will be referred to as MGM. *Id.*

158. *Id.* at 920–21.

159. *Id.* at 929.

160. *Id.* at 929–30.

161. *Id.* at 930.

162. *Id.* at 936–37.

163. *Id.* at 939.

164. *Id.*

165. *Id.*

finally, Grokster made money by selling advertising space, and this profit depended on high-volume use recognized to be infringing.¹⁶⁶ The Court held that Grokster's unlawful objective was unmistakable, and therefore Grokster was held secondarily liable.¹⁶⁷

In *Perfect 10 v. Visa International*, the United States Court of Appeals for the Ninth Circuit also interpreted contributory infringement.¹⁶⁸ Perfect 10 operated a subscription magazine and website that displayed copyrighted images of models.¹⁶⁹ The defendants, Visa and Mastercard, processed payments, issued credit cards, and helped settle debits and credits.¹⁷⁰ In return for their services, Visa and Mastercard received a fee for each transaction.¹⁷¹ Perfect 10 used Visa and Mastercard services for credit card payments on its site.¹⁷² The company realized that various websites were stealing and illegally selling its images in different countries.¹⁷³ Instead of filing suit against the direct infringers, Perfect 10 sued Visa and Mastercard, asserting that the two companies processed credit card payments for the infringing websites and thus were liable for contributory copyright infringement.¹⁷⁴

In determining whether Visa and Mastercard infringed upon Perfect 10's images, the Ninth Circuit stated that a defendant contributorily infringes when he or she knows of third-party infringement and either contributes to or induces that infringement.¹⁷⁵ Thus, the court found that the two defendant credit card companies could not contribute to said infringement because there was no direct connection between them and the infringement itself.¹⁷⁶ The services that Visa and Mastercard provided did not assist in locating or distributing the images.¹⁷⁷ The court held that this copyright infringement could occur without using the defendants' systems, and therefore, the defendants' actions did not materially contribute to or induce the infringement.¹⁷⁸

166. *Id.* at 939–40.

167. *Id.* at 940.

168. *See generally* Perfect 10 v. Visa Int'l Serv. Ass'n, 494 F.3d 788 (9th Cir. 2007).

169. *Id.* at 793.

170. *Id.*

171. *Id.*

172. *Id.*

173. *Id.*

174. *Id.*

175. *Id.* at 795.

176. *Id.* at 796.

177. *Id.*

178. *Id.* at 798.

2. Contributory Liability and Trademark Law

Copyright law is not the only area in which courts have decided contributory infringement cases, as courts have also used this standard in trademark disputes.¹⁷⁹ The Lanham Act “provides for a national system of trademark registration and protects the owner of a federally registered mark against the use of similar marks if such use is likely to result in consumer confusion, or if the dilution of a famous mark is likely to occur.”¹⁸⁰ Although the Lanham Act does not expressly impose liability for contributory infringement, the Supreme Court recognized this liability by stating that “infringement can extend beyond those who actually mislabel goods with the mark of another.”¹⁸¹ If a person intentionally persuades another to engage in trademark infringement or supplies its product to someone who he or she knows is engaging in infringement, that person may be held contributorily liable for any harm done.¹⁸²

In the United States Supreme Court case *Inwood v. Ives*, the Court considered under what circumstances it may hold a manufacturer of a generic drug, designed to replicate a competitor’s drug, vicariously liable for trademark infringement.¹⁸³ Ives Laboratories marketed a patented drug under a registered trademark until the patent expired in 1972.¹⁸⁴ After the patent’s expiration, multiple generic drug manufacturers, including Inwood Laboratories, began to market the drug and intentionally copied the appearance of the trademarked capsules.¹⁸⁵ Ives filed suit against Inwood and other manufacturers, alleging that pharmacists mislabeled generic drugs as the trademarked drug due to the manufacturers’ production of identical capsules.¹⁸⁶

The Supreme Court stated that even if a manufacturer does not have direct control over others such as employees in a distribution chain, that manufacturer can still be held liable for the infringing activities of others in the chain under certain circumstances.¹⁸⁷ The Court created a test to

179. *Lanham Act*, LEGAL INFO. INST., https://www.law.cornell.edu/wex/lanham_act [https://perma.cc/5U4L-26FL] (last visited Oct. 11, 2022).

180. *Id.*

181. *Inwood Lab’y, Inc. v. Ives Lab’y, Inc.*, 456 U.S. 844, 853 (1982).

182. *Contributory Infringement*, *supra* note 147.

183. *Inwood Lab’y*, 456 U.S. at 846.

184. *Id.*

185. *Id.* at 847.

186. *Id.* at 849–50.

187. *Id.* at 853–54.

determine if a defendant is contributorily liable for the infringing activities of another.¹⁸⁸ The test states that:

[I]f a manufacturer or distributor intentionally induces another to infringe a trademark, or if it continues to supply its product to one whom it knows or has reason to know is engaging in trademark infringement, the manufacturer or distributor is contributorily responsible for any harm done as a result of the deceit.¹⁸⁹

The Court found that the pharmacists who mislabeled the generic drugs with the registered trademark undoubtedly violated § 32 of the Trademark Act of 1946, which covers trademark infringement.¹⁹⁰ However, the Court stated that whether the manufacturers were contributorily liable depended on whether they intentionally induced the pharmacists to mislabel the generic drugs or continued to supply the drugs to pharmacists who they knew mislabeled them.¹⁹¹ Ultimately, the Court held that the Second Circuit erred in ignoring findings of fact that were not erroneous and remanded the case.¹⁹² However, federal circuit courts still used the *Inwood* test, as exemplified in *Tiffany v. eBay*.¹⁹³

In *Tiffany*, the United States Court of Appeals for the Second Circuit considered whether eBay was liable for contributory trademark infringement for the sale of counterfeit Tiffany goods on its website.¹⁹⁴ eBay is the owner of an internet marketplace that provides a platform for consumers to buy and sell goods, but it never takes possession or sells any of the goods itself.¹⁹⁵ Tiffany is a merchant of high-end branded jewelry, but it only sells merchandise through Tiffany retail stores, the Tiffany website, and catalogs.¹⁹⁶ In 2004, Tiffany discovered that eBay was selling counterfeit products on its website.¹⁹⁷ Tiffany filed suit against eBay, alleging that by advertising and facilitating the sale of counterfeit Tiffany goods, eBay engaged in direct and contributory trademark infringement.¹⁹⁸

188. *Id.* at 854.

189. *Id.*

190. *Id.*

191. *Id.* at 855.

192. *Id.* at 858.

193. *Tiffany, Inc. v. eBay, Inc.*, 600 F.3d 93, 102 (2d Cir. 2010).

194. *Id.*

195. *Id.* at 96–97.

196. *Id.* at 97.

197. *Id.*

198. *Id.* at 101.

The Second Circuit relied upon the test enumerated by the Supreme Court in *Inwood* to decide if eBay was contributorily liable.¹⁹⁹ Tiffany argued that eBay continued to provide services to the sellers of the counterfeit goods although it knew or had grounds to know that the sellers infringed upon Tiffany's mark.²⁰⁰ The court held that a service provider like eBay "must have more than a general knowledge or reason to know that its service is being used to sell counterfeit goods."²⁰¹ Thus, plaintiffs must show specific instances of infringement.²⁰² The court interpreted the *Inwood* test narrowly and found that Tiffany's generic allegations of counterfeiting failed to supply eBay with the knowledge necessary to be contributorily liable under *Inwood*.²⁰³ Accordingly, Tiffany failed to meet the requisite standard of proof and, as a result, lost the suit.²⁰⁴

A final case applying the theory of contributory infringement in the trademark context is *Gucci America v. Frontline Processing*.²⁰⁵ In this case, the United States District Court for the Southern District of New York considered whether three companies were contributorily liable for assisting a website selling counterfeit Gucci products.²⁰⁶ Gucci America is a New York company that is the exclusive distributor of Gucci products in the United States.²⁰⁷ Internet merchants, such as TheBagAddiction.com, occasionally sold counterfeit Gucci products to capitalize on the luxury brand's popularity.²⁰⁸ Gucci successfully sued TheBagAddiction.com in an effort to prevent further trademark infringement and also sought relief against Durango Merchant Services, Frontline Processing Corporation, and Woodforest National Bank.²⁰⁹ Gucci argued, on the basis of contributory infringement, that these three defendants established credit card processing services that were essential to the sale of the counterfeit goods by TheBagAddiction.com.²¹⁰

199. *Inwood Lab'y, Inc. v. Ives Lab'y, Inc.*, 456 U.S. 844, 854 (1982); *Tiffany*, 600 F.3d at 105–06.

200. *Tiffany*, 600 F.3d at 106.

201. *Id.* at 107.

202. *Id.*

203. *Id.* at 109.

204. *Id.* at 107.

205. *See generally* *Gucci Am., Inc. v. Frontline Processing Corp.*, 721 F. Supp. 2d 228 (S.D.N.Y. 2010).

206. *Id.* at 237.

207. *Id.* at 236.

208. *Id.*

209. *Id.* at 240.

210. *Id.*

The court used a test specifically crafted for service providers who are charged with contributory liability.²¹¹ The test avoids holding temporary service providers liable when they are simply acting as ancillaries.²¹² A plaintiff must show that a third party had direct control of the instrumentality used to infringe upon the plaintiff's mark.²¹³ Additionally, he or she also must show that the defendant "intentionally induced the website to infringe through the sale of counterfeit goods."²¹⁴ The court found that Durango reached out to high-risk merchant accounts and designed advertisements specifically to stimulate others to commit infringements.²¹⁵ As a result, the court held that Durango intentionally induced the website to infringe on Gucci's products.²¹⁶ Gucci also argued that Frontline's and Woodforest's credit card processing services were necessary for the transaction of counterfeit goods online.²¹⁷ The court agreed with Gucci that Frontline and Woodforest were, at the least, aware or willfully blind to the fact that the merchant they supplied their services to dealt in counterfeit goods.²¹⁸ Thus, the court found that Frontline and Woodforest held some control over the third-party infringement.²¹⁹ The court held that Gucci sufficiently plead enough facts to infer that "Durango intentionally induced trademark infringement, and that Woodforest and Frontline exerted sufficient control over the infringing transactions and knowingly provided its services to a counterfeiter."²²⁰ Thus, the court found the defendants contributorily liable.²²¹

Gucci, along with *Inwood* and *Tiffany*, decided contributory infringement issues using a strict standard of constructive knowledge or direct control over the infringement.²²² Although courts have used a similar standard in deciding § 1202(b) cases, there is a difference between the two both statutorily and within the legislative history. Therefore, courts

211. *Id.* at 248. *See, e.g.*, *Perfect 10, Inc. v. Visa Int'l Serv. Ass'n*, 494 F.3d 788, 807 (9th Cir. 2007); *Lockheed Martin Corp. v. Network Sols., Inc.*, 194 F.3d 980, 984 (9th Cir. 1999).

212. *Gucci*, 721 F. Supp. 2d at 248.

213. *Id.*

214. *Id.*

215. *Id.* at 249.

216. *Id.*

217. *Id.*

218. *Id.*

219. *Id.* at 251.

220. *Id.* at 260.

221. *Id.* at 260.

222. *Id.* at 228; *Inwood Lab'y, Inc. v. Ives Lab'y, Inc.*, 456 U.S. 844, 860 (1982); *Tiffany, Inc. v. eBay, Inc.*, 600 F.3d 93, 103 (2d Cir. 2010).

should decide § 1202(b) cases based upon a theory of primary liability, not secondary liability. This will provide for an accurate application of the statute based upon its legislative history and plain meaning.

B. Primary Liability for Removing Copyright Management Information

Title 17 U.S.C. § 1202(b) prohibits the intentional removal or alteration of copyright management information with knowledge that removal will induce, facilitate, or conceal infringement of any right in the Copyright Act.²²³ If the obligation is neglected, and an infringer removes or alters the copyright management information, the person responsible may be primarily liable. The digital art and photography industries developed standards to integrate copyright management information into images.²²⁴ The integration of copyright management information into digital works protects copyright owners by identifying them and their creations.²²⁵ Without this system, works can be orphaned and left at the mercy of the Internet.²²⁶ The ability to secure property on the Internet allows rightsholders to fully exploit the market and make valuable works available.²²⁷ Therefore, it is vital to hold § 1202(b) infringers liable for the removal or alteration of copyright management information by using a standard specifically for the statute and not the standard courts have used in secondary liability cases.

III. FIXING THE COURTS' CONFUSION

The difference between contributory infringement and a § 1202(b) violation stems from what behaviors the laws attempt to encourage and discourage through the creation of liability.²²⁸ This difference distinguishes the two violations and requires two different standards for courts to follow.²²⁹ If the same standard remains, copyright holders will always be at an unjust disadvantage.²³⁰

223. 17 U.S.C. § 1202.

224. Brief for American Society of Media Photographers, *supra* note 4, at 4.

225. *Id.*

226. *Id.*

227. *Id.* at 12–13.

228. 17 U.S.C. § 1202(b); *Contributory Infringement*, *supra* note 147.

229. 17 U.S.C. § 1202(b); *Contributory Infringement*, *supra* note 147.

230. Brief for American Society of Media Photographers, *supra* note 4, at 6.

A. *Contributory Infringement as Compared to § 1202(b) Violations*

The activities of a contributory infringer are not objectionable on their own if divorced from the linkage to the directly infringing activities of another party.²³¹ In fact, many times business activities are generally of a type that society would want to encourage.²³² For example, in *Gucci America*, the court held three credit card processing companies liable for contributory infringement.²³³ Typically, credit card processing companies provide services that are beneficial to consumers, but in *Gucci America*, they knowingly engaged in activities which induced trademark infringement.²³⁴ Therefore, one is only liable for contributory infringement when his or her conduct, which would usually be allowed, knowingly leads to unsavory consequences.²³⁵ Contributory infringement typically requires that the defendant materially contributes to the infringing activity or has some specific knowledge of it.²³⁶ This is similar to the ruling in *Elias* where the Court held that there must be more than just the possibility of causing infringement.²³⁷ There must be an affirmative showing that the defendant knew or had reasonable grounds to know that future infringement would occur.²³⁸

Section 1202(b) differs from statutes that allow for the unauthorized use of copyrighted works because § 1202(b) involves conduct that is not salutary.²³⁹ Section 1202(b) involves primary liability for discouraged conduct like the removal of copyright management information based on the fact that the conduct has no positive outcomes.²⁴⁰ The statute attempts to discourage the removal of copyright management information through the creation of liability for these actions.²⁴¹ When one strips copyright management information from a work, it leaves the work vulnerable to infringement.²⁴²

231. *Contributory Infringement*, *supra* note 147.

232. *Gucci Am., Inc. v. Frontline Processing Corp.*, 721 F. Supp. 2d 228, 260 (S.D.N.Y. 2010).

233. *Id.*

234. *Id.*

235. *Contributory Infringement*, *supra* note 147.

236. *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1019 (9th Cir. 2001).

237. *Victor Elias Photography, LLC v. Ice Portal, Inc.*, 43 F.4th 1313, 1322 (11th Cir. 2022).

238. *Id.* at 1320.

239. 17 U.S.C. § 1202(b).

240. *Id.*

241. Brief for American Society of Media Photographers, *supra* note 4, at 18–19.

242. *Id.* at 18.

Section 1202(b) cases should have a different standard because nothing useful or constructive stems from the removal of copyright management information.²⁴³ No defendant in a § 1202(b) case who willingly removes copyright management information performs a beneficial service by stripping works of their identifying information.²⁴⁴ Although, it is important to understand that not all unauthorized reproduction or distribution of another person's copyright-protected work is infringement.²⁴⁵ For example, 17 U.S.C. § 107 states that the fair use of a copyrighted work "for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringement of copyright."²⁴⁶ To determine what constitutes fair use, courts use the following factors: (1) the purpose of use; (2) the nature of the copyrighted work; (3) the amount used in relation to the work as a whole; and (4) the effect of use.²⁴⁷ Additionally, 17 U.S.C. § 115 establishes a compulsory license for certain musical works and sound recordings for distribution.²⁴⁸ This license allows the use of copyrighted materials without the explicit permission of the copyright holder.²⁴⁹ There are some uses of copyright-protected materials that the owner may not approve of but are authorized under copyright law's design.²⁵⁰ Therefore, liability for the infringement of copyright-protected material differs from liability for copyright management information and should not be held to the same standard.

B. Congress's Purposeful Enactment of § 1202

In addition to the alternate standard required for § 1202(b), the legislative history and intent of § 1202 illustrate how courts incorrectly apply the statute. The Register of Copyrights, Marybeth Peters, commented on concerns regarding § 1202(b) at the time Congress enacted the DMCA.²⁵¹ The Copyright Office desired to make it clear that "the reference to infringement does not mean that the actor must have intended to further any particular act of infringement—just to make infringement

243. *Id.*

244. *Id.*

245. 17 U.S.C. § 107.

246. *Id.*

247. *Id.*

248. *Id.* § 115.

249. *Id.*

250. *Id.* § 107.

251. *WIPO Copyright Treaties Implementation Act, and Online Copyright Liability Limitation Act: Hearing Before the H. Subcomm. on Courts and Intellectual Property of the H. Comm. on the Judiciary, supra* note 19, at 1.

generally possible or easier to accomplish.”²⁵² Thus, the legislative history indicates that the Copyright Office did not intend for § 1202(b) to produce such a heightened burden for copyright holders.²⁵³ The Eleventh Circuit in *Elias* created a standard for plaintiffs bringing § 1202(b) actions that is nearly impossible to meet.²⁵⁴ A statute that the Register of Copyrights hoped would protect copyright holders and copyright management information is now an overwhelming burden.²⁵⁵ The *Elias* case, along with the Second and Ninth Circuits’ opinions in *Mango* and *Stevens*, ignores the legislative history of § 1202(b) and sets an alarming precedent for copyright holders in future litigation.²⁵⁶ If courts set an unreasonably high standard, plaintiffs may be dissuaded from bringing suits.²⁵⁷ Some rightsholders may be hesitant to create and share works on the Internet because they do not want their works to be stolen, which could in turn reduce the number of valuable works available on the Internet.

Currently, courts require that a plaintiff must show particular acts of infringement, which is contrary to the plain language of § 1202(b).²⁵⁸ In *Stevens*, the Ninth Circuit held that “Section 1202(b) must have a more specific application than the universal possibility of encouraging infringement.”²⁵⁹ This standard, if kept in place, will prove the statute useless.²⁶⁰ The prospective language of the statute suggests that Congress intended for the statute and liability to apply only when infringers intentionally remove copyright management information but the probable subsequent infringement has not yet occurred.²⁶¹ Section 1202(b) states that no person shall intentionally remove copyright management information knowing or having reasonable grounds to know “that it will induce, enable, facilitate, or conceal an infringement.”²⁶² The language of the statute does not tie one person’s secondary act to another person’s

252. *Id.*

253. *Id.*

254. Brief for American Society of Media Photographers, *supra* note 4, at 6.

255. *Id.* at 4.

256. *Stevens v. CoreLogic, Inc.*, 899 F.3d 666, 673 (9th Cir. 2018); *Mango v. BuzzFeed, Inc.*, 970 F.3d 167, 172 (2d Cir. 2020); *Victor Elias Photography, LLC v. Ice Portal, Inc.*, 43 F.4th 1313, 1319 (11th Cir. 2022).

257. Brief for American Society of Media Photographers, *supra* note 4, at 5.

258. 17 U.S.C. § 1202(b).

259. *Stevens*, 899 F.3d at 674.

260. 17 U.S.C. § 1202(b).

261. *Id.*

262. *Id.*

existing wrong; rather, it ties a secondary act with no particular market value to the likelihood of future harm in the form of infringement.²⁶³

In the past, Congress has clarified statutory language to avoid misinterpretation and confusion.²⁶⁴ In 2006, Congress corrected courts' misinterpretation of what *dilution* meant in the Trademark Dilution Revision Act (TDRA).²⁶⁵ The TDRA clarified whether the Federal Trademark Dilution Act (FTDA) "required trademark owners to show a 'likelihood' of dilution or 'actual economic injury' to prevail."²⁶⁶ The TDRA amended the FTDA by changing the language from "including as a result of dilution" to "including as a result of a likelihood of dilution."²⁶⁷ This amendment provided a means for trademark owners to stop dilution at its origin instead of waiting until actual harm to the mark occurred.²⁶⁸ Similarly, courts apply § 1202(b) to require that there is current economic injury to a plaintiff instead of the possibility of future injury.²⁶⁹ Section 1202(b) includes the prospective language, thus making this interpretation contrary to the statute itself.²⁷⁰ Congress amended the FTDA to favor trademark holders by including future-oriented language instead of requiring infringement to have already occurred.²⁷¹ Section 1202(b) already includes future-oriented language and therefore should also favor intellectual property owners.²⁷² The issue arises courts' current application of the statute, which both ignores the language of the statute and puts copyright holders at a disadvantage.²⁷³ Just as Congress clarified the language of the TDRA, it should also clarify § 1202(b) so courts may correctly apply the statute.

C. The Necessity for Court's to Have a Different Standard to Follow

Section 1202(b) requires revision to meet the demands of modern-day copyright law and to avoid confusion within courts. Congress enacted

263. *Id.*

264. Trademark Dilution Revision Act of 2006, H.R. 683, 109th Cong. (2006).

265. *Id.*

266. Dale M. Cendali & Bonnie L. Schriefer, *The Trademark Dilution Revision Act of 2006: A Welcome—and Needed—Change*, 105 MICH. L. REV. 108, 108 (2006).

267. Trademark Dilution Revision Act of 2006, H.R. 683, 109th Cong. (2006).

268. Cendali & Schriefer, *supra* note 266, at 109.

269. *Stevens v. CoreLogic, Inc.*, 899 F.3d 666, 674 (9th Cir. 2018).

270. 17 U.S.C. § 1202(b).

271. Cendali & Schriefer, *supra* note 266, at 109.

272. 17 U.S.C. § 1202(b).

273. *Stevens*, 899 F.3d at 674.

§ 1202 for the specific purpose of protecting copyright management information, making it unlike all other contributory infringement and secondary liability cases.²⁷⁴ Copyright management information requires a standard of its own. Further, the legislative history of the statute indicates that Congress did not intend for § 1202(b) to have such a strict mental state requirement.²⁷⁵ Thus, Congress should revise and clarify the statute to provide courts with a clear understanding as to what constitutes a § 1202(b) cause of action.

1. How § 1202(b) Currently Stands vs. How it Should Stand

Section 1202(b) currently states that:

No person shall, without the authority of the copyright owner or the law—

(3) distribute, import for distribution, or publicly perform works, copies of works, or phonorecords, knowing that copyright management information has been removed or altered without authority of the copyright owner or the law, knowing, or, with respect to civil remedies under section 1203, having reasonable grounds to know, that it will induce, enable, facilitate, or conceal an infringement of any right under this title.²⁷⁶

This language is problematic because it leads courts to uphold a strict intent standard that makes it nearly impossible for copyright holders to succeed.²⁷⁷ Instead, Congress should revise § 1202(b) to change the word “will” to “may” to soften the language and avoid misinterpretation within courts.

A revised § 1202(b) should state:

No person shall, without the authority of the copyright owner or the law—

(3) distribute, import for distribution, or publicly perform works, copies of works, or phonorecords, knowing that copyright management information has been removed or altered without authority of the copyright owner or the law, knowing, or, with respect to civil remedies under section 1203, having reasonable

274. 17 U.S.C. § 1202(b).

275. *WIPO Copyright Treaties Implementation Act, and Online Copyright Liability Limitation Act: Hearing Before the H. Subcomm. on Courts and Intellectual Property of the H. Comm. on the Judiciary*, *supra* note 19, at 1.

276. 17 U.S.C. § 1202(b).

277. Brief for American Society of Media Photographers, *supra* note 4, at 14.

grounds to know, that it *may* induce, enable, facilitate, or conceal an infringement of any right under this title.

The change from the word “will” to “may” encourages courts to use a lesser intent standard that puts copyright holders in a more favorable position. Instead of plaintiffs proving that defendants knew or should have known that infringement would certainly occur, they should only have to prove that defendants knew or should have known that infringement may occur due to their actions.²⁷⁸ To further prevent the misunderstanding of § 1202(b), Congress should specify that the Eleventh Circuit’s § 1202(b) interpretation does not accurately represent Congress’s original intent.²⁷⁹ Section 1202(b) includes future-oriented language that does not include a requirement of current infringement.²⁸⁰ To avoid proving the statute useless, Congress should clarify that this language does not tie the removal of copyright management information to certain infringement.²⁸¹ Instead, the statute ties it to the likelihood of future harm in the form of infringement.²⁸² Thus, Congress may correct courts’ misinterpretation of § 1202(b) that plaintiffs are required to make an affirmative showing of specific instances of infringement.

To further protect copyright holders, courts should introduce a rebuttable presumption that shifts some of the burden to prove intent from the plaintiff to the defendant. Plaintiffs currently hold the high burden of proving that the defendant knew or should have known that his or her actions would cause infringement.²⁸³ This contradicts the reason why Congress enacted the DMCA and § 1202, which was to protect copyright holders and promote the creation of valuable works.²⁸⁴ Instead, courts should include a rebuttable presumption that the defendant intentionally removed the copyright management information with the specific intent necessary as long as the plaintiff can prove certain acts done by the defendant. Instead of plaintiffs proving that defendants knew or should have known their actions would cause infringement, defendants will have to prove that they did not know their actions would cause infringement. This solution will favor copyright owners by lowering the required burden of proof to succeed in § 1202(b) cases.

278. *Stevens*, 899 F.3d at 673.

279. 17 U.S.C. § 1202(b).

280. *Id.*

281. *Id.*

282. *Id.*

283. *Victor Elias Photography, LLC v. Ice Portal, Inc.*, 43 F.4th 1313, 1325 (11th Cir. 2022).

284. 17 U.S.C. § 1202(b).

CONCLUSION

The goal of § 1202(b) actions should be to assist copyright owners in maintaining the integrity of their works. Enforcing a heightened standard of intent for rightsholders undermines the importance of copyright management information. Consequently, copyright infringers are likely under the impression that they can avoid liability for removing copyright management information.²⁸⁵ Congress structured § 1202(b) to ensure that metadata copyright management information remained with the digital work it is attached to.²⁸⁶ The recent opinion in *Elias* sabotages Congress's purpose for enacting § 1202(b) by generating burdens that go beyond the plain meaning of the statute.²⁸⁷ The burdens make it almost impossible for a plaintiff to succeed in a § 1202(b) case.²⁸⁸ Thus, Congress must revise § 1202(b) to maintain the integrity of copyright management information and to fulfill the duties that Congress enacted the statute for.

285. Brief for American Society of Media Photographers, *supra* note 4, at 31.

286. *Id.* at 4.

287. *Id.* at 5.

288. *Id.* at 6.