

**SUBSTANTIALLY PERFECT: THE SOUTHERN
DISTRICT OF NEW YORK’S PROBLEMATIC
REWRITE OF THE DMCA’S ELEMENTS OF
NOTIFICATION♦**

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INTRODUCTION

Imagine that you enter a taxi in New York City and instruct the driver to take you to *Great Restaurant* on Forty-ninth Street and Seventh Avenue. The driver says he cannot take you anywhere unless you provide him with the exact street address of your desired destination. He explains that New York City has a law mandating that all passengers substantially comply with a rule that requires passengers to provide cab drivers with the identification of their final destination and information reasonably sufficient to permit the cab driver to locate

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the destination. You reply that you *did* substantially comply and ask why the driver would ever need more than the name of the restaurant and the intersection. He explains that a recent court ruling interpreted the word “substantial” to require the exact street address and that anything less will not suffice. You explain that the only way for you to get the exact address would be to run back to your apartment and go online to find it, but by the time you do all of that and return to the cab, you will be late for your reservation and you will lose your table. Then, you notice that the driver appears to have a phone with Internet access. You ask if he can find the address for you. The driver says that he still cannot help you because it would be a terrible burden on cab drivers to make them search for addresses. Moreover, he says that the law forbids him to affirmatively seek out addresses. In a last ditch effort, you say you can get the exact address once you are there and give it to him if he still wants it. The driver refuses for the last time and informs you that: (a) this conversation never happened; and (b) the meter began running as soon as you sat down, so pay up and get out.

This crazy situation would infuriate even a non-native New Yorker. Why on Earth would a court ever read the word “substantial” to mean the exact street address? Well, this is exactly what is happening in the world of online copyright infringement. In that world, the cab driver represents online service providers and the passenger represents copyright holders. And just as the court in the above hypothetical read the word “substantial” to mean exact street address, the Southern District of New York in *Viacom v. YouTube*¹ read the word “substantial” in the Digital Millennium Copyright Act² (“DMCA”) to mean exact URL address.³ So, if a copyright holder asks a service provider to remove the infringing content called *Great Restaurant* at the online equivalent of Forty-ninth Street and Seventh Avenue in NewYorkCity.com, that will not be enough to place any burden at all on the service provider. At least the cab driver told you that he needed an exact street address. According to *YouTube*, a service provider would not need to be so kind. They would not need to talk to you at all. Instead, the service provider could continue to be unjustly enriched by any potential revenue that the infringing material brings in, much like the cab driver was unjustly enriched by the fare he did not have to drive anywhere to collect.

Admittedly, the analogy is not a perfect one. Copyright holders are not customers of online service providers in the same way that passengers are to cab drivers, so the incentive to get to the final

¹ *Viacom Int’l, Inc. v. YouTube, Inc.*, 718 F. Supp. 2d 514, 519 (S.D.N.Y. 2010).

² 17 U.S.C. § 512 (1998).

³ See *YouTube*, 718 F. Supp. 2d at 529. A URL address is the precise location of material on the web. See WEBOPEDIA, <http://www.webopedia.com/TERM/U/URL.html> (last visited Aug. 29, 2011).

destination is not the same. Online service providers most likely prefer not to deliver copyright holders to their destinations while cab drivers would presumably want to deliver passengers to theirs. Nonetheless, despite the service provider's best case scenario, the DMCA mandates that it cooperate in the same way that a cab driver might want to. So regardless of the differing incentives, the example illuminates the absurdity of the *YouTube* court's specificity requirement.

Moreover, the specificity dictated by the *YouTube* holding represents a hard break from the explicit language and cooperative spirit of the DMCA. By misreading and commingling the legislative history of the DMCA's distinct provisions, the *YouTube* court raised the threshold of what constitutes a DMCA-compliant notification to new and unreasonable heights. Future courts⁴ must not repeat *YouTube*'s mistake. Instead, what courts must do is re-evaluate the plain language of the statute and respect it.

This Note focuses on the elements of notification required under DMCA safe harbor § 512(c) – information residing on systems or networks at the direction of users. It is under § 512(c) that much litigation is taking place. Part I provides a general background of the DMCA, and specifically of § 512(c). Part II provides a detailed understanding of § 512(c)(3) – the elements of notification. Part III examines and analyzes how courts have applied the elements of notification over time. Part IV provides a commentary on different courts' interpretations, and sheds light on the consequences that can result from those interpretations. Finally, Part V concludes with thoughts on the steps that future courts should take when confronted with the elements of notification.

I. BACKGROUND

A. *The DMCA Generally*

The DMCA was written to balance the competing interests of service providers and copyright holders.⁵ Congress sought to reconcile the need to encourage expansion of the Internet with the need to preserve copyright holders' enforcement rights online.⁶ The result was a series of safe harbors available “to ‘innocent’ service providers who can prove they do not have actual or constructive knowledge of the infringement”⁷ The DMCA limits the liability of service providers and “ensures that the efficiency of the Internet will continue to improve and that the variety and quality of services on the Internet will expand,”⁸

⁴ Particularly the Second Circuit, which, at the time of this writing, is preparing to hear oral arguments in the *YouTube* appeal.

⁵ See 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 12B-04 (2008).

⁶ See *ALS Scan, Inc. v. RemarQ Cmtys., Inc.*, 239 F.3d 619, 625 (4th Cir. 2001).

⁷ *Id.*

⁸ S. REP. NO. 105-190, at 8 (1998).

but does so “while still protecting intellectual property rights.”⁹ The whole legislative scheme of the DMCA was written with this balancing act in mind and sought to achieve that balance through cooperation between service providers and copyright holders alike.

The DMCA’s “safe harbors provide protection from liability for [service providers engaging in]: (1) transitory digital networking communications; (2) system caching; (3) information residing on systems or networks at the direction of users; and (4) information location tools.”¹⁰ To be eligible for any one of these four safe harbors, a provider must meet certain threshold conditions. First, it must fall within the definition of “service provider” under the DMCA.¹¹ Second, it must demonstrate that it has a policy of disciplining infringers and that it accommodates copyright holders who seek to protect their copyrighted works.¹² After meeting these threshold conditions, a service provider must “then satisfy the specific requirements for the particular safe harbor” it seeks refuge under.¹³ Each of the four available safe harbors was individually calibrated to balance the competing interests through a system of cooperation. The idea was always to preserve the “strong incentives for service providers and copyright owners to cooperate to detect and deal with copyright infringements that take place in the digital networked environment.”¹⁴

B. Section 512(c) – Information Residing on Systems or Networks at the Direction of Users

Section 512(c) is the safe harbor that service providers, like YouTube, seek protection under. Rather than providing connectivity to the Internet, YouTube provides a service to users who are already online making them an Online Service Provider (“OSP”) as opposed to an Internet Service Provider (“ISP”). The distinction, however, is not crucial because both types of providers can fall under the ambit of § 512(c). Any service provider that enables information to reside on systems or networks at the direction of users will attempt to utilize § 512(c). Accordingly, the blanket term “service provider” is used interchangeably throughout this Note. That some cases involve ISPs while others involve OSPs is unimportant because their analysis under §

⁹ *Costar Group, Inc. v. Loopnet, Inc.*, 164 F. Supp. 2d 688, 694 (D. Md. 2001).

¹⁰ *Ellison v. Robertson*, 357 F.3d 1072, 1076–77 (9th Cir. 2004) (citing 17 U.S.C. § 512(a)–(d) (1998)).

¹¹ *See Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1099 (W.D. Wash. 2004), *abrogated, in part, by Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, (9th Cir. 2010).

¹² *Id.*

¹³ *Id.* *See also* 17 U.S.C. § 512(n) (“Whether a service provider qualifies for the limitation on liability in any one of those subsections shall be based solely on the criteria in that subsection, and shall not affect a determination of whether that service provider qualifies for the limitations on liability under any other such subsection.”).

¹⁴ *ALS Scan, Inc. v. RemarQ Cmtys., Inc.*, 239 F.3d 619, 625 (4th Cir. 2001) (quoting H.R. REP. NO. 105-796, at 72 (1998), *reprinted in* 1998 U.S.C.C.A.N. 649).

512(c) is the same.

The § 512(c) safe harbor will protect a service provider who does not have actual or constructive knowledge of infringing material present on its site.¹⁵ The “actual knowledge standard is high, and by itself does not reach an entity that willfully ignores blatant indications of infringement. To avoid rewarding those who adopt the posture of an ostrich [and stick their head in the sand], the statute adds an additional basis for potential liability here.”¹⁶ The additional basis is constructive knowledge. “[I]n the absence of such actual knowledge, [a service provider must not be] aware of facts or circumstances from which infringing activity is apparent”¹⁷ This “can best be described as a ‘red flag’ test”¹⁸ under which a service provider will lose its safe harbor protection if it “deliberately proceed[s] in the face of blatant factors of which it was aware.”¹⁹ However, this standard has also proven to be a difficult obstacle for copyright holders to overcome.²⁰ Indeed, “it appears that not even blood crimson is enough to warrant investigation”²¹ At least one commenter has said that the recent line of cases, leading up to and culminating with *YouTube*, has erroneously raised the red flag standard to the same as actual knowledge.²² In either case, upon gaining actual or constructive knowledge, the service provider will maintain its safe harbor status provided it acts “expeditiously” to remove access to the allegedly infringing material.²³

Inasmuch as actual and constructive knowledge have become such difficult showings for a copyright holder to make, the best route is to notify the service provider directly under § 512(c)(1)(C).²⁴ A DMCA-compliant notification provides the requisite knowledge by virtually taking the red flag and placing it in the service provider’s hand. After the service provider has notice, the statute requires that it “respond[] expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity.”²⁵ Section 512(c)(2) governs the method for receiving notification. In

¹⁵ See 17 U.S.C. § 512(c)(1)(A)(i)–(ii).

¹⁶ See NIMMER, *supra* note 5, at § 12B-04 [A][1].

¹⁷ 17 U.S.C. § 512(c)(1)(A)(ii).

¹⁸ NIMMER, *supra* note 5, at § 12B-04 [A][1].

¹⁹ *Id.*

²⁰ *Cf. Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1107 (W.D. Wash. 2004) (stating that the “most powerful evidence of a service provider’s knowledge [is DMCA-compliant] notice of infringement from the copyright holder”).

²¹ NIMMER, *supra* note 5, at § 12B-04 [A][1].

²² See Scott A. Zebrak, *Viacom v. YouTube: A Missed Opportunity*, NATIONAL LAW JOURNAL ONLINE (July 26, 2010), <http://www.law.com/jsp/nlj/PubArticleNLJ.jsp?id=1202463839409&slreturn=1&hbxlogin=1#>.

²³ See 17 U.S.C. § 512(c)(1)(A)(iii) (1998).

²⁴ This Note intentionally skips 17 U.S.C. § 512(c)(1)(B), which requires that a service provider not “receive a financial benefit directly attributable to the infringing activity, in a case in which the service provider has the right and ability to control such activity.” As this provision is not central to the Note’s thesis, a more thorough explanation would be superfluous. For a detailed analysis, see generally NIMMER, *supra* note 5 at § 12B-04 [A][2][b].

²⁵ 17 U.S.C. § 512(c)(1)(C).

order to stay protected by the safe harbor, a service provider must provide a designated agent to receive the notification and make the agent's contact information available to the public.²⁶

II. SECTION 512(C)(3) – ELEMENTS OF NOTIFICATION

A. *Understanding Section 512(c)(3)*

As discussed above, the DMCA was intended to provide a balancing of competing interests through cooperation.²⁷ The Act's goal of cooperation is illuminated through its § 512(c)(3) notification procedures. Section 512(c)(3) operates as a dialogue with notification being the copyright holder's initiation, and expeditious removal of alleged infringing content being the service provider's response. However, only DMCA-compliant notification will suffice. “[N]either actual knowledge nor awareness of a ‘red flag’ may be imputed to a service provider based on information from a copyright owner or its agent that does not comply with the notification provisions”²⁸ So, what is needed to comply with the notification provisions? Section 512(c)(3) states that “[t]o be effective under this subsection, a notification of claimed infringement must be a written communication provided to the designated agent of a service provider that includes *substantially* the following:”²⁹

1. A “signature of a person authorized to act on behalf of the owner of an exclusive right that is allegedly infringed.”³⁰
2. The notification must identify “the copyrighted work claimed to have been infringed, or, if multiple copyrighted works at a single online site are covered by a single notification, a representative list of such works at that site.”³¹
3. The notification must identify “the material that is claimed to be infringing . . . and that is to be removed or access to which is to be disabled” and the notification must

²⁶ See 17 U.S.C. § 512(c)(2).

²⁷ See *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1098 (W.D. Wash. 2004) stated: “The DMCA intended to balance the interests of [service providers and copyright holders] by creating a mechanism for rights holders to inform [service providers] of potentially infringing conduct while, at the same time, providing greater certainty to service providers concerning their legal exposure for infringements that may occur in the course of their activities. This balancing effort resulted in a statute that creates *strong incentives for service providers and copyright owners to cooperate and detect and deal with copyright infringements that take place in the digital network environment.*”

Id. (emphasis added) (internal quotation marks omitted).

²⁸ NIMMER, *supra* note 5 at § 12B-04 [B] n.50 (quoting S.REP. NO. 105-190, at 45 (1998)).

²⁹ 17 U.S.C. § 512(c)(3)(A).

³⁰ 17 U.S.C. § 512(c)(3)(A)(i).

³¹ 17 U.S.C. § 512(c)(3)(A)(ii).

- include information that is “reasonably sufficient to permit the service provider to locate the material.”³²
4. The notification must include “reasonably sufficient” information, like a phone number or e-mail address, so the service provider can contact the complaining party, if necessary.³³
 5. The notification must include a statement certifying that the “complaining party has a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law.”³⁴
 6. The notification must include a statement certifying that the information provided is accurate and “under penalty of perjury, that the complaining party is authorized to act on behalf of the owner”³⁵

As written, a notification requires three elements: (1) it must be a written communication; (2) it must be served to a designated agent; and (3) it must comply substantially with all six of the foregoing sub-provisions. Thus, there are two tiers of priority present in the law. The first tier requires perfection. A written communication and service upon a designated agent are required.³⁶ A notification that is not in writing and/or not served upon a designated agent will render the notice defective and impose no obligation on the service provider.³⁷ The second tier requires something less than perfection. Congress chose to reduce the standard for the remaining six sub-provisions by including the word “substantially.”³⁸ Accordingly, if a notification meets all of the foregoing requirements, it will be an effective notice said to provide the service provider with at least constructive knowledge. At that point, the burden shifts to the service provider who must respond expeditiously to take down the alleged infringing content.³⁹

If a notification is a written communication served on a designated agent, but does not comply substantially with all six sub-provisions, it will not be considered an effective notice said to provide the service provider with the knowledge needed to require expeditious removal of the content.⁴⁰ But, the concern here appears to be about vital contact information.⁴¹ For, even if the notification does not provide a signature or either of the two statements, but still substantially complies with the

³² 17 U.S.C. § 512(c)(3)(A)(iii).

³³ 17 U.S.C. § 512(c)(3)(A)(iv).

³⁴ 17 U.S.C. § 512(c)(3)(A)(v).

³⁵ 17 U.S.C. § 512(c)(3)(A)(vi).

³⁶ See 17 U.S.C. § 512(c)(3)(A).

³⁷ See DAVID NIMMER, COPYRIGHT SACRED TEXT, TECHNOLOGY, AND THE DMCA 370 (2003).

³⁸ See NIMMER, *supra* note 5 at § 12B-04 [B][4][a].

³⁹ See 17 U.S.C. § 512(c)(1)(A)(iii).

⁴⁰ See 17 U.S.C. § 512(c)(3)(B)(i).

⁴¹ See NIMMER, *supra* note 5 at § 12B-04 [B][4][a].

identification, identification/location, and contact information, a burden to act still shifts to the service provider.⁴² However, instead of having to expeditiously remove the content, the service provider's burden is to "promptly attempt[] to contact the person making the notification or take[] other reasonable steps to assist in the receipt of notification that substantially complies with all the provisions"⁴³ Then, after working with the copyright holder to cure those of the three portions that do not substantially comply, the service provider must expeditiously remove the content.⁴⁴

In sum, the plain language of the statute lays out a scheme that requires a court to make at least three, and up to five, determinations. First, whether the notification was in writing and served to a designated agent.⁴⁵ Second, whether the six factors have been substantially complied with.⁴⁶ Third, if the six factors have been substantially complied with, whether the service provider acted expeditiously to remove the material.⁴⁷ Fourth, if all six factors were not substantially complied with, whether at least factors two, three and four were.⁴⁸ And finally, if factors two through four were substantially complied with, whether the service provider acted promptly to contact the copyright holder and help cure the other elements of notification.⁴⁹

B. *Understanding Section 512(c)(3)(A)(ii)–(iv)*

Clearly, prongs two, three, and four—identification of copyrighted material, identification and location of infringing material, and contact information—are receiving special attention. They have been "characterized as solemnities designed to give the notification due gravity."⁵⁰ Congress decided that a notification from a copyright holder could shift a reduced burden to the service provider even without the signature of an authorized person, a statement certifying a good faith belief that the material is infringing, or a statement certifying that the information provided is accurate.⁵¹ The language states that if the notification at least identifies the copyrighted material (ii), identifies and provides information reasonably sufficient to locate the infringing material (iii), and provides contact information (iv), then the service provider must promptly reach out in an attempt to cure the rest of the notification.⁵² Namely, the service provider must contact the copyright

⁴² See 17 U.S.C. § 512(c)(3)(B)(ii).

⁴³ *Id.*

⁴⁴ See 17 U.S.C. § 512(c)(1)(A)(iii).

⁴⁵ See 17 U.S.C. § 512(c)(3)(A).

⁴⁶ See *id.*

⁴⁷ See 17 U.S.C. § 512(c)(1)(A)(iii).

⁴⁸ See 17 U.S.C. § 512(c)(3)(B)(ii).

⁴⁹ See *id.*

⁵⁰ NIMMER, *supra* note 5 at § 12B-04 [B][1].

⁵¹ See 17 U.S.C. § 512(c)(3)(B)(ii).

⁵² See *id.*

holder to obtain the signature and two statements.⁵³ Now, it is important to understand what the statute means by identification, location, and contact information.

1. Section 512(c)(3)(A)(ii) – Identification of Copyrighted Material

The identification required here refers to the copyrighted material that is allegedly being infringed.⁵⁴ For example, if Lady Gaga owns the copyright to the “Poker Face” music video and alleges that her copyright is being infringed on YouTube, this identification requirement only requires Lady Gaga to identify the “Poker Face” music video by Lady Gaga. While the statute requires Lady Gaga to later identify the infringing material, here, she must only identify her copyrighted material.⁵⁵ Furthermore, if more than one of Lady Gaga’s copyrighted works is being infringed at a single online site, she does not need to provide more than one notification. Instead, she may cover all of the copyrighted works she is alleging are being infringed with one notification by including “a representative list of such works at that site.”⁵⁶ An example of a representative list “could be citing an unauthorized Internet jukebox with a representative list of the musical works or sound recordings that it has infringed.”⁵⁷ The idea of this list is to enable the service provider to “understand the nature and scope of the infringement being claimed.”⁵⁸

2. Section 512(c)(3)(A)(iii) – Identification and Location of Infringing Material

Here, the identification refers to the allegedly infringing material. So, now, in addition to identifying the “Poker Face” music video by Lady Gaga, she must also identify the video committing the infringement. In some instances these two things could be one and the same. If, for example, someone has uploaded an unauthorized copy of Lady Gaga’s “Poker Face” music video on YouTube, that video is both the copyrighted material and the infringing material. However, the infringing material could be something quite different. For example, someone could upload a short film that featured a clip of Lady Gaga’s “Poker Face” music video without her consent. In that case, the film containing the infringing material would need to be identified separately.⁵⁹ Additionally, Lady Gaga, as the copyright holder, must

⁵³ *See id.*

⁵⁴ *See* 17 U.S.C. § 512(c)(3)(A)(ii).

⁵⁵ *See* 17 U.S.C. § 512(c)(1)(A)(iii).

⁵⁶ *See* 17 U.S.C. § 512(c)(1)(A)(ii).

⁵⁷ NIMMER, *supra* note 5, at § 12B-04 [B][2].

⁵⁸ *Id.* n.66 (quoting S.REP. NO. 105-190, at 46 (1998)).

⁵⁹ Other examples of possibly infringing material could include the copyrighted material “in guises as various as a sound recording, an animated short story, a collection of poetry, a movie, or staff notation.” *See id.* at § 12B-04 [B][2].

provide information “reasonably sufficient to permit the service provider to locate the material.”⁶⁰ That requirement adds a reasonableness standard to the provision, which adds another layer to the analysis. The language requires that a copyright holder providing a notification substantially comply with being reasonable. Accordingly, information must be provided that enables the service provider to reasonably locate the material. And, as we shall see, it is this provision that is so often a sticking point.

3. Section 512(c)(3)(A)(iv) – Contact Information

This provision is not very controversial. In addition to having to identify the copyrighted material and identify and locate infringing material, the copyright holder must provide reasonable contact information so that, if need be, the service provider can get in touch with her to potentially resolve any insubstantial compliance with the signature and statement requirements.⁶¹

What all of this means is that if compliance is not substantial with all three of the foregoing prongs, the burden never shifts and the notification will not be deemed admissible as evidence of knowledge.⁶² This all begs the question, what is “substantial,” and how much is needed for a copyright holder to ensure that her notification substantially identifies copyrighted material, identifies and provides reasonable location information for infringing material, and provides contact information? An overly specific reading of “substantial” that requires perfection may be too high of a burden for a copyright holder to overcome. Furthermore, if Congress intended for “substantial” to mean perfect, they would have said so, as opposed to creating two tiers within the elements of notification.

III. JUDICIAL APPLICATION OF THE ELEMENTS OF NOTIFICATION

A. *The Beginning*

1. ALS Scan

In *ALS Scan v. RemarQ Communities*,⁶³ one of the earliest cases to discuss the elements of notification, the Fourth Circuit determined that substantial compliance does not require perfection, but something less. Two newsgroups operated by RemarQ contained thousands of ALS Scan’s copyrighted images.⁶⁴ ALS Scan provided RemarQ with a written communication that listed the names of the two newsgroups

⁶⁰ See 17 U.S.C. § 512(c)(3)(A)(iii).

⁶¹ Recall that if sections (ii)–(iv) of section 512(c)(3)(A) are satisfied, the service provider must contact the copyright holder promptly to cure sections (i)(v) and (vi).

⁶² See 17 U.S.C. § 512(c)(3)(B)(i).

⁶³ *ALS Scan v. RemarQ Cmtys.*, 239 F.3d 619 (4th Cir. 2001).

⁶⁴ See *id.* at 621.

hosting the images and provided information on how the images could be identified as ALS Scan copyrights.⁶⁵ “RemarQ responded by refusing to comply with ALS Scan’s demand but advising ALS Scan that it would eliminate individual infringing items from these newsgroups if ALS Scan identified them with ‘sufficient specificity.’”⁶⁶ ALS Scan responded by claiming that the two identified newsgroups were created solely to infringe, that virtually everything posted in the identified newsgroups was infringing, that there were over 10,000 ALS Scan copyrighted images in the newsgroups, and that the images could be easily identified by the ALS Scan logo present on each image.⁶⁷ Thereafter, communication came to a halt and RemarQ never took down the images, so ALS Scan filed suit.

RemarQ argued protection under the § 512(c) safe harbor and attempted to justify its position on the grounds that ALS Scan did not “substantially” comply with the identification of either the copyrighted material or the allegedly infringing material.⁶⁸ Although ALS Scan provided RemarQ with a written communication identifying two specific newsgroups out of the thousands operated by the defendant where virtually every image was infringing, RemarQ claimed that identification of the newsgroups was not the same as identification of the copyrighted material or identification of alleged infringing works.⁶⁹ Moreover, RemarQ argued that if ALS Scan failed in either of those two identifications, the notification is defective.⁷⁰ Therefore, argued RemarQ, there was no substantial compliance because ALS Scan “never provided it with even a ‘representative list’ of the infringed photographs, as required by § 512(c)(3)(A)(ii), nor did it identify the infringing copies of those photographs with sufficient detail to enable RemarQ to locate and disable them, as required by § 512(c)(3)(A)(iii).”⁷¹ Accordingly, to resolve the dispute, the court was required to make a determination about how much information would be sufficient to substantially comply with identifying copyrighted material and identifying and locating infringing material. The court found that ALS Scan’s notification was substantially compliant with both. The court explained that “the DMCA requires that a copyright owner put the service provider on notice in a detailed manner but allows notice by means that comport with the prescribed format only ‘substantially,’ rather than perfectly.”⁷² In doing so, the court established that providing the name of a newsgroup that contained

⁶⁵ *See id.*

⁶⁶ *See id.*

⁶⁷ *See id.*

⁶⁸ *See id.* at 622.

⁶⁹ *See id.* at 624.

⁷⁰ *See id.*

⁷¹ *Id.*

⁷² *Id.* at 625 (emphasis added).

virtually all copyrighted images and information on how those images could be identified (specifically the ALS Scan logo present on each image) was sufficient in substantially complying with identifying the copyrighted material. Additionally, because the infringing images were verbatim copies of the copyrighted images, the same information provided to identify the copyrighted images served to identify the infringing images whose location was already clearly identified as the newsgroup. The court implicitly held that because virtually all of the photographs in the identified newsgroups were infringing, it would not be an overly burdensome task for RemarQ to simply go to the newsgroups and disable access to the photos. The court felt that such an interpretation was more closely aligned with “the spirit of achieving a balance between the responsibilities of the service provider and the copyright owner”⁷³

2. Hendrickson

Shortly after *ALS Scan*, the Central District of California weighed in on the question of substantial compliance in *Hendrickson v. eBay, Inc.*⁷⁴ In that case, pro se plaintiff Robert Hendrickson notified eBay in writing that he was the copyright holder of the DVD version of a film entitled *Manson* and that illegal copies of it were being made available on eBay’s website.⁷⁵ Hendrickson did not, however, provide the requisite statements of a good faith belief that the allegedly infringing material is not authorized and accuracy of the claim under penalty of perjury as required under the safe harbor.⁷⁶ Nor did Hendrickson provide any information concerning the identification of the allegedly infringing material.⁷⁷ Nevertheless, eBay responded promptly to Hendrickson’s notification and tried to cure it.⁷⁸ In doing so, eBay asked Hendrickson to provide specific item numbers of the allegedly infringing material, so that it could identify the infringing content.⁷⁹ Hendrickson refused to provide *any* further information and was generally uncooperative and hostile toward eBay.⁸⁰ eBay suggested that

⁷³ *Id.*

⁷⁴ *Hendrickson v. eBay, Inc.*, 165 F. Supp. 2d 1082 (C.D. Cal. 2001).

⁷⁵ *See id.* at 1084.

⁷⁶ The statements required by 17 U.S.C. § 512(c)(3)(A)(v)-(vi) (1998).

⁷⁷ *See Hendrickson*, 165 F. Supp. 2d. at 1084.

⁷⁸ *See id.* at 1085.

⁷⁹ *See id.*

⁸⁰ Indeed, Hendrickson’s initial non-compliant notification threatened prosecution “to the fullest extent provided by the law.” *Id.* Despite Hendrickson’s threat and non-compliance, eBay still attempted to cooperate with Hendrickson by sending more than one response describing how Hendrickson could assist eBay in curing the notification. Instead, Hendrickson ignored eBay’s correspondence and later stated that his refusal to cooperate was because the systems eBay had in place were “nothing more than a wickedly concealed scheme to defraud unknowledgeable proprietors of Copyrights, out of their LAWFUL rights” *Id.* Hendrickson was a character to say the least. It is worth recalling that the copyrighted work he sought to protect was a documentary he created about Charles Manson and his murders. *See* Terry Smith, *The Manson Movie: A Conversation with Director Robert Hendrickson*, SCREEN CRAVE (May 23, 2008),

specific order numbers would be the most efficient way to identify the infringing material. The court agreed that on the facts of this case – one where the requisite statements were never provided, the plaintiff was uncooperative and hostile, and there was only one copyrighted work allegedly being infringed – item numbers would be needed to satisfy the identification portion of the identification and location of infringing material prong of the elements of notification.⁸¹ However, the court did not give an opinion on what sort of information would be required to satisfy the *location* part of that prong. Moreover, the court refused to rule that such specificity would always be required to make notification substantially compliant.⁸² The court recognized “that there may be instances where a copyright holder need not provide eBay with specific item numbers to satisfy the identification requirement.”⁸³ The court provided an example: “[I]f a movie studio advised eBay that *all* listings offering to sell a new movie (e.g., ‘Planet X’) that has not been released . . . eBay could easily search its website using the title ‘Planet X’ and identify the offensive listings.”⁸⁴ *Hendrickson* solidified the rationale of *ALS Scan* in two key ways. First, it refused to require perfection to substantially comply with any of the elements of notification; and second, it implicitly favored the cooperative party.

3. Cybernet

The Central District of California continued the trend established by *ALS Scan* and *Hendrickson* in *Perfect 10 v. Cybernet*,⁸⁵ where it dismissed the notion that notice must be perfect to substantially comply. Cybernet provided access to different websites, many of which contained allegedly infringing material and the court held that it did not qualify for § 512(c) safe harbor protection because of its deficient notification procedures.⁸⁶ “Cybernet’s procedures depart[ed] from th[e] statutory scheme in several quite significant ways.”⁸⁷ Cybernet’s stated policy required that a copyright holder alleging infringement must provide the “specific web page at which a given [copyrighted] work is located, rather than the site.”⁸⁸ The court held that such a policy contradicted the language of § 512(c)(3)(A)(ii), which does not require such specificity, but requires only a representative list where multiple copyrighted works are meant to be identified by a single notification.⁸⁹

<http://screenrave.com/2008-05-23/a%C2%80%C2%9Cthe-manson-moviea%C2%80%C2%9D-a-conversation-with-director-robert-hendrickson/>.

⁸¹ See *Hendrickson*, 165 F. Supp. 2d at 1091.

⁸² See *id.* at 1090.

⁸³ *Id.*

⁸⁴ *Id.* (emphasis added).

⁸⁵ *Perfect 10, Inc. v. Cybernet Ventures*, 213 F. Supp. 2d 1146 (C.D. Cal. 2002).

⁸⁶ See *id.* at 1179.

⁸⁷ *Id.*

⁸⁸ *Id.* at 1180.

⁸⁹ See 17 U.S.C. § 512(c)(3)(A)(ii) (1998).

The court found that “[t]hese apparently small differences . . . upset the Congressionally apportioned burden between copyright holder and service provider by placing the entire burden on the copyright owner.”⁹⁰

So, here the court, like *ALS Scan* and *Hendrickson* before it, refused to heighten the specificity required under the elements of notification; specifically, the identification of the copyrighted work prong. Additionally, cooperation was again implicitly required. The court stated that the heightened specificity required “combined with the failure to show any flexibility on its policy that a notification meet all of Cybernet’s standards, leads the Court to conclude that Cybernet has failed to structure a notice system that complies with section 512.”⁹¹ Had Cybernet not required perfection or been so rigid in its stated policy, it more likely would have enjoyed the protection of the safe harbor.

B. *The Shift*

1. CCBill

Five years later, the Ninth Circuit addressed the elements of notification in *Perfect 10 v. CCBill, L.L.C.*⁹² In that case, Perfect 10 claimed that CCBill was hosting infringing material and did not deserve the protection of § 512(c) because it had ignored the provided DMCA-compliant notification. The allegedly DMCA-compliant notification, however, consisted of three separate notifications that the court declared defective when read individually.⁹³ Perfect 10 argued that the separate notifications should be read cumulatively, and that if they had been, the notification would be DMCA-compliant.⁹⁴ The court disagreed. “Permitting a copyright holder to cobble together adequate notice from separately defective notices . . . unduly burdens service providers. Indeed, the text of § 512(c)(3) requires that a notice be ‘a written communication.’”⁹⁵

Additionally, in direct response to the argument that *ALS Scan* stood for the proposition that “*only* location information is required for substantial compliance,”⁹⁶ the court held that “substantial compliance

⁹⁰ *Cybernet*, 213 F. Supp. 2d at 1180.

⁹¹ *Id.*

⁹² *Perfect 10, Inc. v. CCBill, LLC*, 488 F.3d 1102 (9th Cir. 2007).

⁹³ Perfect 10 claimed that it met its notification requirements through a combination of three sets of documents that were all received on different dates months apart. First, there was a 22,185 page bates-stamped production that included pictures with URLs of allegedly infringing images. This document lacked any sworn statements. Second, there was a spreadsheet identifying the images by bates number. This document, too, lacked any sworn statements. Third, there were interrogatory responses which were signed under penalty of perjury that incorporated the spreadsheet by reference. *See id.* at 1112.

⁹⁴ *See id.*

⁹⁵ *Id.* at 1113 (quoting 17 U.S.C. § 512(c)(3) (1998)).

⁹⁶ *Id.* at 1112 n.3. The court explicitly stated that they do not read *ALS Scan* to stand for that proposition and, therefore, did not cast doubt on the Fourth Circuit’s opinion.

means substantial compliance with *all* of § 512(c)(3)'s clauses, not just some of them.⁹⁷ Under that seemingly obvious framework, the court found that “[e]ach [of the communications Perfect 10 provided] contain[ed] more than mere technical errors; often one or more of the required elements are entirely absent.”⁹⁸ The court then directed its attention to the importance of the statements prongs of the elements of notification.⁹⁹

To this point, with regards to the elements of notification, the crux of the court's opinion centered on merely substantially complying with all of the required prongs and the importance of those elements of notification that the earlier cases had not as explicitly dealt with, namely, the sworn statements and requirement that the notification be singular.¹⁰⁰ The court was less focused on the identification of copyrighted and infringing works prongs. Accordingly, with regards to specificity, the court did not turn away from, or cast doubt on, the cases that preceded it. Moreover, the court seemed to embrace the earlier court's implicit requirement of cooperation when it discussed the overly burdensome task that would lie with the service provider if it had been forced to scour through the 22,185 page notification that it was provided.¹⁰¹ Indeed, at first blush, this decision looks much like those that came before it in that the court favored the more cooperative party and made no demands of heightened specificity within the elements of notification.

Then, however, the court took matters a step further when it stated that “[t]he DMCA notification procedures place the burden of policing copyright infringement—identifying the potentially infringing material and adequately documenting infringement—squarely on the owners of the copyright.”¹⁰² Cooperation had been a key element in each of the foregoing cases. The significant role of cooperation in the DMCA had been mentioned explicitly in those cases and its spirit was an implicit part of each holding. Yet, with this one sentence, the Ninth Circuit sent all future DMCA elements of notification jurisprudence in a different direction. In actuality, the court simply defined the phrase “policing

⁹⁷ *Id.* at 1112.

⁹⁸ *Id.*

⁹⁹ The court held that the statement prongs are vital. Indeed the court appeared to assign them the same due gravity that others assign to those prongs considered solemnities. *See* NIMMER, *supra* note 5 at § 12B-04 [B][1]. The court explained that if content that infringes is removed, “justice has been done. But if it does not, speech protected under the First Amendment could be removed. We therefore do not require a service provider to start potentially invasive proceedings if the complainant is unwilling to state under penalty of perjury that he is an authorized representative of the copyright owner, and that he has a good-faith belief that the material is unlicensed.” *CCBill*, 488 F.3d at 1112.

¹⁰⁰ The court gave great weight to this requirement: “[t]his requirement is not a mere technicality. It would have taken [CCBill] substantial time to piece together the relevant information for each instance of claimed infringement.” *Id.* at 1113.

¹⁰¹ *See id.* at 1112.

¹⁰² *Id.* at 1113.

copyright infringement” to specifically mean “identifying infringing material and adequately documenting infringement” in the notification context.¹⁰³ That is undoubtedly what is required. As stated above, for a notification to be considered evidence of knowledge, the elements of notification must be substantially complied with in an adequately documented writing and served on the designated agent of the service provider. However, as future cases demonstrate, this statement has been read more broadly and expanded to mean more than it did within the confines of this particular case. Finally, *CCBill* did not address cooperation or balancing in the same manner that the preceding cases did. In fact, the court did not explicitly mention the word once in its entire opinion. It is for both of these reasons that *CCBill* is the first case to represent “The Shift.”

2. UMG

Two years later the Central District of California decided *UMG Recordings v. Veoh Networks*.¹⁰⁴ In that case, UMG provided Veoh with a notification that included the names of specific musicians and links to music videos by those artists and alleged that those videos were being infringed.¹⁰⁵ UMG argued that its notification provided a substantially compliant identification of the copyrighted material by providing a link to an infringing copy of the music video and the name of the artist who made it.¹⁰⁶ Furthermore, it argued that its notification also served as a representative list of *other* music videos by the named artists.¹⁰⁷ What UMG left unclear, however, was whether the other copyrighted music videos meant to be covered by the representative list were verbatim copies of the videos identified by the links accompanying the artists’ names, or entirely different videos (other copyrighted works) by the same artist. The court did not address the question. Instead, it broadly held that identification of the *artists’* names was not the same as identification of the copyrighted *works*.¹⁰⁸ The court was thus splitting hairs over the fact that the work itself was not named despite the fact that going to the provided link would surely identify at least one copyrighted work. The court applied the same rationale to identifying and locating the infringing material when it held that merely stating “[a]n artist’s name is not ‘information reasonably sufficient to permit the service provider to locate [such] material.’”¹⁰⁹ Again, this is despite the fact that going to the provided link would

¹⁰³ Moreover, the extent of the court’s concern with identifying infringing works is part and parcel of the requirement that the notification be adequately documented, i.e. not an overly cumbersome notification that would place a large burden on the service provider.

¹⁰⁴ *UMG Recordings, Inc. v. Veoh Networks, Inc.*, 665 F. Supp. 2d 1099 (C.D. Cal. 2009).

¹⁰⁵ *See id.* at 1109–10.

¹⁰⁶ *See id.* at 1110.

¹⁰⁷ *See id.*

¹⁰⁸ *See id.*

¹⁰⁹ *Id.*

surely identify and locate at least one allegedly infringed work.

In laying down such a rule, the court heightened the levels of specificity required to substantially comply with the identification of copyrighted and infringed works prongs to levels never before seen. First, the court established that the name of an artist coupled with a link to a video by the artist will always fail to identify copyrighted material because the name of the work itself is not provided. That is far beyond what *ALS Scan* required. *ALS Scan* did not need to identify the individual name of each copyrighted image present in RemarQ's newsgroups.¹¹⁰ It was enough that they included the *ALS Scan* logo.¹¹¹ Second, the court established the same rule for identifying and locating infringing material. Because "Veoh presented undisputed evidence that simply searching for a name would not necessarily unearth only unauthorized material,"¹¹² the court assigned that evidence to any future case it hears. Despite prior courts' refusal to lay down such a rule,¹¹³ this court embraced it.

The court was apparently attempting to invoke *CCBill*. The court stated that even when a notification includes information (like the artists' names) that could potentially lead to the discovery of the allegedly infringing material, a service provider would never be required to perform any searches because "[r]equiring . . . such searches would . . . conflict with the principle articulated in *CCBill* that '[t]he DMCA notification procedures place the burden of policing copyright infringement-identifying the potentially infringing material and adequately documenting infringement-squarely on the owners of the copyright."¹¹⁴ *UMG* used *CCBill*'s language in a much stricter sense. When *CCBill* used that language, it was on facts that would have required the service provider to piece together individually defective notifications to create one DMCA-compliant notification. Indeed, the service provider in *CCBill* could have found the infringing images because the notifications, when read together, did in fact identify and locate them.¹¹⁵ However, the service provider would have needed to parse through over twenty thousand pages of materials. Accordingly, it was presumably the overly inadequate documentation and the tremendous burden its inadequacy would have placed on the service provider that led the *CCBill* court to its conclusion.¹¹⁶ Moreover, other elements (sworn statements) were also absent from the notifications at issue in *CCBill*. The notification that *UMG* provided to *Veoh* was far

¹¹⁰ See *ALS Scan, Inc. v. RemarQ Cmty., Inc.*, 239 F.3d 619, 625 (4th Cir. 2001).

¹¹¹ See *id.*

¹¹² *UMG*, 665 F. Supp. 2d at 1110.

¹¹³ See, e.g., *Hendrickson v. eBay, Inc.*, 165 F. Supp. 2d 1082 (C.D. Cal. 2001).

¹¹⁴ *UMG*, 665 F. Supp. 2d at 1110 (quoting *Perfect 10, Inc. v. CCBill, LLC*, 488 F.3d 1102, 1113 (9th Cir. 2007)).

¹¹⁵ See *CCBill*, 488 F.3d at 1112 n.4.

¹¹⁶ *Id.* at 1113.

less problematic. It did not consist of thousands of pages nor was it missing other required § 512(c)(3) elements. Nevertheless, the court expanded the *CCBill* holding to also mean that where a notification requires a service provider to do anything at all, namely, enter a search term, it is defective for failure to substantially comply. Implicit in the court's reasoning is that requiring a service provider to enter a search term is as burdensome as requiring it to look through thousands of bates stamped documents. The court did not care that RemarQ would have to at least look at the images to find the ALS Scan logo,¹¹⁷ or that eBay might be required to enter a search term into its site in certain situations.¹¹⁸ Moreover, it did not care that its own holding in *Cybernet* refused to require the levels of specificity that it laid down in this decision.¹¹⁹

Finally, in addition to applying *CCBill* much more strictly, the court also read parts of *CCBill* out of context and erroneously applied part of its holding to the notification realm. As discussed, proving actual or constructive (red flag) knowledge is a very hard thing to do.¹²⁰ Many courts have said as much, *CCBill* included, when it reiterated the fact that service providers are not required to monitor their site or affirmatively seek out infringement on their own.¹²¹ However, this was stated with regards to imputing knowledge on a service provider *absent a notification*. A service provider acting on information received in a notification is entirely different than a service provider independently seeking out infringement. Still, *UMG* erroneously applied *CCBill*'s knowledge without a notification analysis to a situation in which there *was* a notification. In doing so, the court stated that “*CCBill* teaches that if investigation of ‘facts and circumstances’ is required to identify material as infringing, then those facts and circumstances are not ‘red flags.’”¹²² Accordingly, by commingling separate parts of *CCBill*'s analysis and expanding *CCBill*'s holding to levels of specificity never before seen or anticipated, all while refusing to acknowledge any cooperation requirement within the statute, *UMG* took § 512(c)(3) jurisprudence even further away from what the legislature had intended.

3. YouTube

In *YouTube*, decided the following year, Viacom sent a notification similar to the one in *UMG* when it provided YouTube with thousands of direct links to video clips of infringing material.¹²³ Viacom then made the argument illustrated by the Lady Gaga example provided earlier –

¹¹⁷ See *ALS Scan, Inc. v. RemarQ Cmty., Inc.*, 239 F.3d 619, 625 (4th Cir. 2001).

¹¹⁸ See *Hendrickson*, 165 F. Supp. 2d at 1090.

¹¹⁹ See *Perfect 10, Inc. v. Cybernet Ventures*, 213 F. Supp. 2d 1146 (C.D. Cal. 2002).

¹²⁰ See *supra* Section I.B.

¹²¹ See *CCBill*, 488 F.3d at 1114.

¹²² *UMG Recordings, Inc. v. Veoh Networks, Inc.*, 665 F. Supp. 2d 1099, 1108 (C.D. Cal. 2009).

¹²³ See *Viacom Int'l, Inc. v. YouTube, Inc.*, 718 F. Supp. 2d 514, 524 (S.D.N.Y. 2010).

that the copyrighted work and the infringing work were one and the same. Therefore, by providing a direct link to a video clip, Viacom identified both the copyrighted material and the infringing material (at least that particular instance of infringement). Furthermore, the copyrighted material identified by the direct link also served as a representative list for that particular copyrighted work.¹²⁴ Viacom also made clear what UMG did not. Recall that UMG claimed that names of artists and links to their music videos constituted a representative list of the copyrighted works sufficient to cover other music videos by the artists, but did not specify whether the other music videos were entirely different music videos by the same artist, or other unauthorized copies of the music videos identified by the links. Viacom, on the other hand, made very clear that the other copyrighted works meant to be covered by its notification were other unauthorized copies of the very same copyrighted work identified by the provided link.¹²⁵

The court did not find this difference to be a significant one. It held that the identification of one copyrighted work could not serve as a representative list of other unauthorized versions of that same work.¹²⁶ According to the court, “[t]his ‘representative list’ reference would eviscerate the required specificity of notice . . . if it were construed to mean a merely generic description . . . without also giving the works’ locations at the site, and would put the provider to the factual search forbidden by § 512(m).”¹²⁷ The portion of § 512(m) that the court referred to states that nothing conditions the applicability of any of the safe harbors on “a service provider monitoring its service or affirmatively seeking facts indicating infringing activity”¹²⁸ Moreover, the court went even further by holding that the *location* of each individual copyrighted work on the site must also be provided by the copyright holder.

UMG read the statute very strictly when it held that only the name of the copyrighted *work* and not the *artist* would sufficiently identify a copyrighted work. *YouTube* did more than read the statute strictly, it rewrote it. *YouTube* requires not only that the copyrighted work be identified by its name¹²⁹ but that its *location* on the site is provided.¹³⁰

¹²⁴ *See id.* at 528.

¹²⁵ *See id.*

¹²⁶ *See id.*

¹²⁷ *Id.* at 528–29.

¹²⁸ 17 U.S.C. § 512(m)(2) (1998).

¹²⁹ Like *UMG*, *YouTube* indicated that an artist’s name by itself would never substantially comply with the statute and foreclosed the possibility of *Hendrickson*’s example (“all movies titled X”) ever being viable by providing its own hypothetical – “all works by Gershwin,” for example, would never be sufficient for identifying the copyrighted work. This is remarkable in that the court is specifically referring to the *copyrighted* works, not the *infringing* works. So, in a scenario where literally all works by Gershwin present on the site are indeed copyrighted, saying so would not be enough, you would have to list each work regardless. *See Youtube*, 718 F. Supp. 2d 514, 528–29 (S.D.N.Y. 2010).

¹³⁰ *See id.*

The copyright identification prong, however, requires no more than identification.¹³¹ *YouTube* also erroneously placed § 512(m) within the notification context. The court claimed that allowing a link to a copyrighted work to serve as a representative list of itself would put the service provider to factual search forbidden by § 512(m) because the service provider would be required to seek out other copies of the same work. This reasoning is flawed on two fronts. First, the service provider would not need to seek out another copy of the copyrighted work once the first work has been identified. The first work satisfies the requirement and represents the copyrighted work that is subject to infringement. To use the example from earlier, once the Lady Gaga “Poker Face” music video is identified as a copyrighted work, there is no need to identify that video as copyrighted again. Whether there is one or one hundred *infringing* copies of it is irrelevant because they will be infringing only the one copyrighted work. Second, § 512(m) is not meant to be read within the notification context. It simply refers to the knowledge that will be imputed on a service provider absent a notification, but says nothing to the burden that will lie with the service provider after receipt of a notification.¹³² In relying on § 512(m) in this manner, the court erred in the same way that *UMG* did in applying *CCBill’s* knowledge without notification analysis in the knowledge with notification context.

In addition to raising the specificity required for identifying copyrighted works, the court also heightened the requisite level of specificity for identifying and locating infringing material by essentially holding that only the exact URL address of the infringing material would make a notification DMCA-compliant.¹³³ That is a remarkable shift. Like *UMG*, *YouTube* also relied on *CCBill* for the proposition that the burden of identifying infringement and adequately documenting it lies exclusively with the copyright holder.¹³⁴ And like *UMG*, it erroneously took that holding too far. *CCBill* was a case whose facts described what was undoubtedly too great a burden to make a service provider shoulder. Yet, *UMG* and *YouTube* have read that to mean that any burden at all is too great to place on a service provider. Indeed, anything short of perfection puts too great a burden on the service

¹³¹ See 17 U.S.C. § 512(c)(3)(A)(ii).

¹³² See *UMG Recordings, Inc. v. Veoh Networks, Inc.*, 665 F. Supp. 2d 1099, 1113 n.17 (C.D. Cal. 2009).

¹³³ *YouTube*, 718 F. Supp. 2d at 529. Admittedly, the court was relying on legislative history: “An example of such sufficient information [for reasonably identifying and locating allegedly infringing material] would be a copy or description of the allegedly infringing material and the URL address of the location (web page) which is alleged to contain the infringing material.” S.REP. NO. 105-190, at 42 (1998). Nevertheless, the legislature was merely offering an *example* and the Supreme Court has made it clear that even where there is support for a proposition in the legislative history, the language of the statute itself must be able to support it, which it cannot here. See *Comty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 739 (1989). For more on the plain language of the statute, see *infra* Section IV.A.

¹³⁴ See *YouTube*, 718 F. Supp. 2d at 523.

provider. The court justified its position by relying heavily on legislative history. It commingled legislative history from all four safe harbors to reach the conclusion that the DMCA has within it the tenor of specificity.¹³⁵ Indeed, the court found a higher level of specificity than the plain language of the statute itself requires and a higher level than has ever been gleaned from the legislative history before.¹³⁶ Furthermore, the court reached this conclusion while completely ignoring the cooperative spirit of the DMCA and omitting the language explicitly referring to cooperation in the legislative history. Moreover, *YouTube* failed to address or distinguish itself from any of the cases that addressed the issue prior to *CCBill*.

Finally, different courts' interpretations of what is necessary to make DMCA notifications substantially compliant have differed greatly. First, in *ALS Scan*, the Fourth Circuit held that perfection was not required to be substantially compliant with regards to identification of copyrighted and infringing material. Then, the Central District of California in *Hendrickson* and *Cybernet* reiterated that holding. *Hendrickson* made clear that perfection was not required for identification of infringing material and *Cybernet* held the same with regards to copyrighted material. Then, while the Ninth Circuit's *CCBill* decision did not cast doubt on, or overrule, any of the preceding holdings, it represented a shift in a new direction. The Central District of California, in its *UMG* decision, backed away from its earlier positions and interpreted the *CCBill* holding to up the level of specificity required for identifying and locating infringing material. Finally, in *YouTube*, the Southern District of New York raised the level of specificity required even more by demanding perfection for identification and location of both infringing and copyrighted material.

IV. REEVALUATING THE ELEMENTS OF NOTIFICATION

The elements of notification under § 512(c) have been mangled to the point of being rewritten. By requiring perfection for all of the elements, courts have erroneously applied the high standard of proving actual or constructive knowledge without a notification even when a notification has been received. As a result, service providers are shrouded by a virtually insurmountable defense. That goes far beyond the statute's plain language and eviscerates its cooperative intention. Doing so leads to dangerous results and, to fix the problem, courts must

¹³⁵ See *YouTube*, 718 F. Supp. 2d at 523 (where the court refers to legislative history pertaining to § 512(d) and applies it to § 512(c)). The court commingled the legislative history for different provisions despite the fact that each safe harbor is meant to be read individually and treated distinctly. See 17 U.S.C. § 512(n) (1998).

¹³⁶ Recall that *RemarQ* had the burden of going through the images in *ALS Scan*, that *Hendrickson* acknowledged that perfection was not required, and that *Cybernet* ruled that heightening the specificity of the identification prongs was disallowed by the DMCA.

course-correct and revert to applying the law as they did prior to *CCBill*.

A. *The Statute's Plain Language*

Congress chose to use the word “substantially” in the elements of notification.¹³⁷ The term substantial, by definition, is something less than perfect. Substantial refers to something “being largely but not wholly that which is specified.”¹³⁸ Congress’ choice of words is analogous to the substantial performance doctrine in contract law, which is “[t]he rule that if a good-faith attempt to perform does not precisely meet the terms of an agreement or statutory requirements, the performance will still be considered complete if the essential purpose is accomplished”¹³⁹ The essential purpose of the elements of notification is to make a service provider aware of facts or circumstances about infringing content on their site and then ensure that the infringing content is disabled.¹⁴⁰ Congress explicitly stated the word substantial in order to prevent courts from requiring perfection in a copyright holder’s notification. “[T]he meaning of the statute must, in the first instance, be sought in the language in which the act is framed, and if that is plain . . . the sole function of the courts is to enforce it according to its terms.”¹⁴¹ Nevertheless, courts are not doing that. Instead, they are going beyond what has traditionally been considered substantial despite it being “well established that ‘[w]here Congress uses terms that have accumulated settled meaning under . . . the common law, a court must infer, unless the statute otherwise dictates, that Congress means to incorporate the established meaning of these terms.’”¹⁴²

UMG laid down a rule requiring more than what is arguably substantial. Then, *YouTube* went even further by requiring the URL address for every individual instance of infringing content.¹⁴³ The problem is that a URL address is a precise location. While a precise location would certainly comply with the statute, requiring it conflicts with the statute because, again, substantial by definition is something less than precise. Accordingly, courts have moved too far away from the plain language of the statute whereas the earlier cases tracked the language more precisely. “[T]he DMCA requires that a copyright owner put the service provider on notice in a detailed manner but allows notice by means that comport with the prescribed format only ‘substantially,’ rather than perfectly.”¹⁴⁴

¹³⁷ See 17 U.S.C. § 512(c)(3)(A).

¹³⁸ MERRIAM-WEBSTER’S DICTIONARY (11th ed. 2003).

¹³⁹ BLACK’S LAW DICTIONARY (9th ed. 2009).

¹⁴⁰ See 17 U.S.C. § 512(c)(1)(A)(iii).

¹⁴¹ *Caminetti v. United States*, 242 U.S. 470, 485 (1917).

¹⁴² *Comty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 739 (1989).

¹⁴³ See *Viacom Int’l, Inc. v. YouTube, Inc.*, 718 F. Supp. 2d 514, 529 (S.D.N.Y. 2010).

¹⁴⁴ *ALS Scan, Inc. v. RemarQ Cmtys., Inc.*, 239 F.3d 619, 625 (4th Cir. 2001).

B. *The Statute's Purpose*

As mentioned above, the purpose of the statute is to balance the competing interests of service providers and copyright holders while ensuring the continued expansion of the Internet. While the plain language of the elements of notification is clear, a plethora of extrinsic evidence in the form of legislative history on the DMCA exists, and has been quoted extensively in court decisions interpreting it. The preceding case analysis shows two key themes running throughout the legislative history of the DMCA: (1) anti-policing; and (2) cooperation.

With regards to anti-policing, Congress did not want to burden service providers with the duty to affirmatively police their sites for infringing content. Moreover, that purpose was codified within the act itself at § 512(m).

The second purpose is one of cooperation and, while it is not expressed explicitly in the language of the statute, it clearly presents itself within the construction of the elements of notification.¹⁴⁵ As discussed earlier, the elements of notification itself represents a conversation between the copyright holder and service provider. The required steps force communication and a joint resolution of the presence of infringing content. The spirit of cooperation is also explicitly present in the legislative history. As stated earlier, the idea of the DMCA was always to preserve “the strong incentives for service providers and copyright owners to cooperate and detect and deal with copyright infringements that take place in the digital networked environment.”¹⁴⁶

Starting with *CCBill*, courts stopped discussing the cooperative intent of the DMCA and began focusing solely on the anti-policing provisions.¹⁴⁷ Specifically, it has been repeatedly held that the burden of policing for copyright infringement is with the copyright holder alone.¹⁴⁸ The only logical explanation for the courts' shift away from enforcing cooperation is because of the burden it would place on a service provider to require it to affirmatively search its own site for infringing material or evidence of that infringing material. However, that concern is explicitly dealt with by § 512(m), which states that such a burden shall never lie with the service provider.¹⁴⁹ The service provider is not in danger of being saddled with any great burden simply because the plain language of substantial compliance is followed. A

¹⁴⁵ See *supra* Section II.A.

¹⁴⁶ H.R. REP. NO. 105-796, at 72 (1998), reprinted in 1998 U.S.C.C.A.N. 649.

¹⁴⁷ Neither *CCBill*, *UMG*, nor *YouTube* mention the word cooperation once in their opinions, whereas *ALS Scan*, *Hendrickson*, and *Cybernet* do.

¹⁴⁸ The first case to say so was *CCBill*. *UMG* and *YouTube* followed suit, even though it was recognized as early as *Cybernet* that Congress never intended for the copyright holder to shoulder the entire burden. See *Perfect 10, Inc. v. Cybernet Ventures*, 213 F. Supp. 2d 1146, 1180 (C.D. Cal. 2002).

¹⁴⁹ See 17 U.S.C. § 512(m) (1998).

burden does shift after finding a notification substantially compliant, but not to one of affirmative policing, but rather to expeditiousness. Accordingly, § 512(m) could not have been meant to apply in the notification context; rather, the anti-policing concern is most appropriately applied to situations where a service provider will have actual or constructive knowledge absent a notification. In other words, the anti-policing concern is meant to prevent a service provider from being forced to conduct a search for actual or constructive knowledge unilaterally. That concern was then dealt with by the elements of notification, which forces cooperation between the service provider and copyright holder in policing without placing the entire burden on either party. Placing the entire burden on either party alone goes beyond the intent of the statute.¹⁵⁰

No independent search is required by the service provider. Instead, the copyright holder conducts the search, discovers the presence of infringing content, and alerts the service provider. If a notification is not perfect, it does not mean the service provider is put to the task of affirmatively searching out infringing material. All that happens is that the burden shifts, just as Congress mandated. Under the *YouTube* rationale, however, the burden would not shift at all. Rather, the service provider would be aware of at least red flag knowledge, yet have to take no action. Accordingly, a refusal to shift the burden because the notification is imperfect overlooks the cooperative intent implicit in the structure of the elements of notification.

C. The Consequences of Anti-Policing at the Expense of Cooperation

Reading the anti-policing intent so broadly as to require perfect notification essentially requires the service provider to do nothing. It makes no sense to say that a notification that requires a service provider to take any more than one step to locate and remove infringing content is forbidden because it is a search. Assume that in *YouTube*, Viacom alleged that only one video by one artist was infringing and that a search conducted using both the name of the artist and the name of the song yielded only one result – the infringing material. According to the court, that notification would not be sufficient and no burden would shift to the service provider because that is a forbidden factual search that amounts to policing. But, that is just not true. Such a notification cannot be said to be insubstantial. Yet, the service provider will be able to continue being unjustly enriched by any potential revenue generated by the infringing material's presence on its site. That result distorts the meaning of the word "substantial" and cuts directly against the plain language of the statute. Moreover, according to the legislative history, technical errors "will not render ineffective an otherwise complete . . .

¹⁵⁰ See generally *Cybernet*, 213 F. Supp. 2d at 1180.

notification.”¹⁵¹ Accordingly, if a URL address is provided, but is off by one character, the notification would still be deemed substantially compliant. However, when a URL address is off by a character, it is broken. It does not provide the location of the infringing material at all, but the standard is still one of expeditiousness on the service provider. So, in order to live up to its duty, the service provider must take steps to correct the situation, which will invariably include either conducting a reasonable search on its own or reaching out to the copyright holder. Certainly, a situation like that requires more than one step, yet for some reason, that sort of factual search – the kind where the service provider must do something – is not the forbidden policing kind that results from entering an effective search term that is provided. Perhaps when a court is confronted with such a situation in the future, it will require even more of the copyright holder by ruling that all the URL addresses be working and perfect. Or perhaps a court will go even further to require that copyright holders be given access to service providers’ take down mechanisms and remove the infringing content themselves! Courts must reevaluate the plain language of the statute and respect it. Congress meant for the burden to shift to the service provider after being provided with a substantially compliant notification. And inherent in the burden shift is the notion that a service provider do something, i.e., enter a search term or utilize whatever other reasonable road map the copyright holder provides. Rather than requiring that notification be perfect, perhaps they should just require it to be substantially compliant to avoid silly results.

What is crucial to keep in mind is that a DMCA-compliant notification does not create or prove copyright liability. It does not even put the safe harbor out of the service provider’s reach. It simply shifts the burden to the service provider to either act expeditiously or promptly depending on how much of the notification is substantially compliant. When a court rules that a notification is not substantially compliant because it is not perfect, it is also ruling that no burden shifts.

V. CONCLUSION – HOW COURTS SHOULD CHANGE COURSE

A. *Finding Substantiality*

Courts should be more willing to find a notification substantial. A notification is meant to shift a burden to the service provider whether it is fully compliant (expeditious removal) or it is not (prompt contact to cure). Moreover, it is the only real way to put any burden on the service provider.¹⁵² While refusing to shift the burden ensures that the safe harbor protection remains available to the service provider, it does so at

¹⁵¹ *Recording Indus. Ass’n of Am. v. Verizon*, 351 F.3d 1229, 1236 (D.D.C. 2003).

¹⁵² *See Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1107 (W.D. Wash. 2004).

too great a cost to the copyright holder. On the other hand, if courts return to the traditional definition of what constitutes “substantial,” or at least reduce it to something less than perfection, the safe harbor still remains available to the service provider. At that point, the standard to be adjudicated would be one of expeditiousness or promptness, rather than substantiality, and the copyright holder is not out of the game before it even begins. It is no more difficult for a court to evaluate whether a service provider has acted expeditiously in removing infringing content it had knowledge of than it is to evaluate whether a notification is substantially compliant, and it allows the Act’s intended spirit of cooperation to remain intact.

B. Expeditiousness, Good Faith, and Weighing the Response Against the Notification

Expeditiousness is “characterized by or acting promptly and efficiently.”¹⁵³ Analysis of a service provider’s expeditiousness will invariably require an examination of the effort it made, which will include the steps it took in removing the infringing material identified by the information provided – just as the quickness of a person instructed to run an errand would be evaluated by the steps she took. For example, whether the person walked when she could have taken a train, and whether she relied on her internal compass when she could have read a map. Acting expeditiously is not the same as affirmatively policing and there can never be a bright line definition of what expeditious means. Instead, it will depend on the facts, such as whether it took a week when it should have taken an hour, or, whether the service provider quickly removed the material or blatantly ignored the notification.

It is under the standard of expeditiousness that courts should be focusing their attention. It requires service providers to be reasonable rather than looking the other way and doing nothing. The court can still decide if the safe harbor provided by § 512(c) ought to apply. It can look at all the facts in a given case and evaluate the notification that was provided. If the notification at least makes the service provider aware that there is infringing material on the site and provides some sort of roadmap to where the material is located on the site, then the burden should shift. As long as the service provider acts to remove as much of the infringing content as the notification can be said to identify, then the safe harbor applies. If the service provider does nothing, however, the safe harbor does not apply.

The bottom line for courts must ultimately be the good faith effort made by both parties. It is not difficult, when evaluating the good faith efforts of both parties, to determine whether one party was trying to get

¹⁵³ MERRIAM-WEBSTER’S DICTIONARY (11th ed. 2003).

one over on the other. If a notification can truly be said to provide no information at all, then clearly that is not a good faith effort by the copyright holder and cannot be said to be DMCA-compliant. At the same time, where a notification clearly provides notice of infringement, the service provider should make a good faith effort to remove that content. If, after a short time, the infringing content cannot be located via the information provided in the notification, the service provider may not simply end communication, but instead must reach out to the copyright holder and inform him that it attempted to locate the infringing material with the information provided and could not, just as it would have to do in a situation where a broken URL was provided. That is what the good faith implicit in law requires. As long as the service provider makes a reasonable effort to remove the content identified by the notification, even if that effort is fruitless, it is protected by the safe harbor. That is what the language of the statute requires and that is what the courts must enforce.

The court is there to evaluate the facts and all of the circumstances and make a determination as to whether the service provider genuinely tried to remove the infringing content identified. Heightening the specificity required to a bright line rule of perfection not only goes beyond the intent of the statute, but it mitigates the courts role. A court would not even be necessary if the rule was so clear-cut. Instead, courts must be more willing to find a notification that is less than perfect to still be substantially compliant. Then, courts must weigh the response of the service provider against the notification provided. Finally, as long as the service provider's response is as expeditious as the notification is reasonable, the safe harbor should apply. Anything less, however, should foreclose that protection and entertain the possibility that the service provider may have to bear some of the liability for the infringement it makes possible through its platform.

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