

DEFINING *EXPEDITIOUS*:  
 UNCHARTED TERRITORY OF THE DMCA SAFE HARBOR  
 PROVISION\*

A SURVEY OF WHAT WE KNOW AND DO NOT KNOW ABOUT  
 THE EXPEDITIOUSNESS OF SERVICE PROVIDER RESPONSES  
 TO TAKEDOWN NOTIFICATIONS

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#### INTRODUCTION

In an effort to adapt traditional copyright laws to the vast and complex world of the Internet, as well as other digital communications on an international level, Congress enacted in 1998 Title II of the Digital Millennium Copyright Act ("DMCA").<sup>1</sup> The Online Copyright Infringement Liability Limitation Act ("OCILLA"), codified in § 512, protects qualifying internet service providers ("ISPs" or "service providers") from liability for monetary relief for direct, vicarious, and contributory infringement and, often, from injunction where infringing or allegedly infringing materials are carried on the system without the knowledge and involvement of the service provider.<sup>2</sup> The DMCA attempted to respond to challenging and "controversial questions of copyright liability in the online world."<sup>3</sup> Yet, since its inception, new media and technologies, such as video-sharing and user-generated websites and peer-to-peer networks ("P2P"), have developed, creating new and difficult issues that were not expressly considered by the DMCA's authors. As a result, courts, legal practitioners, content owners, and Internet users have been confronted with novel questions and challenges regarding how to interpret and apply the DMCA in unprecedented situations.

Part of the difficulty of applying the DMCA to recent disputes between service providers and copyright owners has arisen from rapidly evolving Internet technology and new forms of web formats such as "Web 2.0." In recent years, a new "generation of online services built around user-generated content has taken tra-

<sup>1</sup> Digital Millennium Copyright Act of 1998, 17 U.S.C. § 512 (2006).

<sup>2</sup> *Id.*

<sup>3</sup> *Ellison v. Robertson*, 357 F.3d 1072, 1076 (9th Cir. 2004).

ditional major media by storm."<sup>4</sup> An "amalgam of 'participatory Web' applications," Web 2.0<sup>5</sup> "encapsulates websites that provide services like blogs, wikis, social networking, photo sharing, and video sharing."<sup>6</sup> One such Web 2.0 application, YouTube, has received astounding popularity since its creation in February 2005.<sup>7</sup> With its success, YouTube has not only attracted "more than sixty-three million people (age fifteen and up)," but has also attracted numerous lawsuits brought by copyright owners alleging that YouTube is permitting copyright-infringing content to be posted on its site in the form of music videos, movies, sports highlights and major television shows, among others.<sup>8</sup> In one such case, *Tur v. YouTube*,<sup>9</sup> journalist Robert Tur filed a lawsuit in United States District Court in Los Angeles, California, in July of 2006 seeking damages and an injunction prohibiting YouTube from further use of his copyrighted material.<sup>10</sup> Tur contends that YouTube permitted its users to upload without his authorization copyrighted video footage from the 1992 Los Angeles riots that Tur had filmed. The footage was "allegedly posted on YouTube without Tur's permission and viewed more than one thousand times." In response to Tur's request to the court for \$150,000 in monetary damages for each infringed work, YouTube asserted that it was "in compliance with all the provisions of the [DMCA] and therefore 'entitled to the full protections of the safe harbor provisions of the Act.'"<sup>11</sup> YouTube also states that all video clips identifiable as Tur's were also removed from its website.<sup>12</sup> In another lawsuit pending

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<sup>4</sup> Eugene C. Kim, Note, *YouTube: Testing the Safe Harbors of Digital Copyright Law*, 17 S. CAL. INTERDISC. L.J. 139, 139 (2007) (evaluating the copyright infringement issues that currently confront YouTube, as well as discussing whether YouTube will be held liable for copyright infringement).

<sup>5</sup> Examples of Web 2.0 applications include Wikipedia, an online encyclopedia consisting of content uploaded by users, and social networking sites like Facebook and Friendster. The popularity of these sites stems to a large extent from the ability of users to connect, share information, and collaborate with other users on the Internet.

<sup>6</sup> Kim, *supra* note 4, at 139.

<sup>7</sup> *Id.*

<sup>8</sup> *Id.* at 140-41 ("Despite YouTube's stated focus on user-generated content, the website also plays host to copyright-infringing content like music videos, sports highlights, news clips, excerpts from movies, and episodes of mainstream shows from current seasons."); see also Heather Green, *YouTube: Way Beyond Home Videos*, BUS. WK., Apr. 10, 2006, available at [http://www.businessweek.com/magazine/content/06\\_15/b3979093.htm](http://www.businessweek.com/magazine/content/06_15/b3979093.htm); "Major media companies, along with smaller players in the content industry, have expressed contrary viewpoints on the matter. Although many copyright owners have repeatedly expressed strong disapproval of YouTube, a growing number have come to embrace it as an efficient means of increasing exposure and awareness of their content." Ellen Lee, *Google Moves YouTube Ahead*, S.F. CHRON., Mar. 4, 2007, available at <http://www.sfgate.com/cgi-bin/article.cgi?f=/c/a/2007/03/04/BUG1NODSLR1.DTL>.

<sup>9</sup> See Complaint and Answer, *Tur v. YouTube, Inc.*, 2007 WL 4947615 (C.D. Cal. 2006) (No. CV 06-4436).

<sup>10</sup> Greg Sandoval, *YouTube Sued over Copyright Infringement*, CNET NEWS.COM, July 18, 2006, [http://news.com.com/2100-1030\\_3-6095736.html](http://news.com.com/2100-1030_3-6095736.html).

<sup>11</sup> Kim, *supra* note 4, at 142 (quoting Sandoval, *supra* note 10).

<sup>12</sup> Kim, *supra* note 4, at 142.

against YouTube, Viacom alleges that YouTube should not qualify for safe harbor under § 512 because it failed to remove content that it knew to be infringing and allowed the same copyrighted material to be posted by another user as soon as it had been removed.<sup>13</sup> In addition, other types of online content providers, such as Google search engine and Amazon.com marketplace, are also facing allegations of infringement from copyright owners and are attempting to limit their liability under the DMCA's § 512 safe harbor provision.

While not a defense to direct copyright infringement, the DMCA safe harbor provision provides a refuge for qualifying service providers who are contributorily or vicariously liable for copyright violations. In order to qualify for safe harbor under § 512 of the DMCA, service providers must adhere to the requirements for removal outlined in § 512(c). One such requirement instructs service providers, upon receiving a takedown notice from a copyright owner alleging infringing content or activity, to expeditiously remove or disable access to the infringing material.<sup>14</sup>

Until recently, not much attention has been paid as to whether service providers responded in an expeditious manner to takedown notices. Yet, the question over whether a service provider has responded expeditiously is emerging as fertile ground for legal disputes. Perhaps one reason for why a copyright owner may challenge the adequacy of a service provider's response is that other aspects of § 512 have already been heavily litigated and defined by courts. Meanwhile, copyright owners recognize that courts have not decisively ruled on what constitutes an expeditious response and may seize the opportunity for a determination in their favor.

Recent case law indicates the emerging attention given by courts to the adequacy of a service provider's response to takedown notices. One major case pending in the Ninth Circuit, *Perfect 10, Inc. v. Amazon.com*, involves a lawsuit brought by a copyright owner of pornographic images against two major service providers, Google and Amazon.com. On November 19, 2004 and June 29, 2005, the pornographic website Perfect 10 ("P10") filed separate suits against Google, Inc. and against Amazon.com, Inc. and its subsidiary, A9.com, respectively, for various copyright and trademark infringement claims.<sup>15</sup> On November 7, 2005, the

<sup>13</sup> Complaint at 5, *Viacom Int'l Inc. v. YouTube, Inc.*, (S.D.N.Y. 2008) (No. 07 Civ. 2103).

<sup>14</sup> 17 U.S.C. § 512(c)(3) (2006).

<sup>15</sup> *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828, 834 (C.D. Cal. 2006). On November 19, 2004, P10 filed an action against Google that included copyright infringement claims; then, on June 29, 2005, P10 filed a similar action against Amazon.com. P10 asserted various copyright and trademark infringement claims: direct copyright infringement, vicarious copyright infringement, contributory copyright infringement, circumvention of copyright protection systems under the DMCA, direct trademark infringement, contributory

Southern District Court of New York consolidated the claims against Google and Amazon.com, concluding that while Perfect 10 was likely to prevail on its direct infringement claims with respect to Google's use of thumbnails in its search engine, P10 would not prevail against Amazon.com. In 2007, the Court of Appeals for the Ninth Circuit affirmed the district court's ruling in part, but found that the district court "did not resolve the factual disputes over the adequacy of Perfect 10's notices to Google and Google's response to these notices."<sup>16</sup> Google argued that it properly responded to P10's notifications by investigating the websites allegedly containing infringing material and for suppressing those links that they found to be violating P10's copyrighted work.<sup>17</sup> On remand, the district court was instructed to evaluate whether Google could be found liable under the *Napster* precedent and not be entitled to safe harbor under DMCA § 512 for failing to expeditiously respond to P10's notifications. In Amazon.com's case, the appellate court found that, while P10 did not show likelihood that it would prevail on its claim that Amazon.com was directly or vicariously liable, there was a possibility that Amazon.com [was] contributorily liable.<sup>18</sup> The appellate court held that the lower court "did not consider whether Amazon.com had 'actual knowledge that specific infringing material is available using its system'"<sup>19</sup> and might "have 'take[n] simple measures to prevent further damage'"<sup>20</sup> although it still "continue[d] to provide access to infringing works."<sup>21</sup>

The appellate court's mandate to consider whether P10 would likely succeed in showing that Google and Amazon.com were not entitled to the immunity provided by Title II of the DMCA may ostensibly seem clear. However, the appellate court does not offer specific guidelines or a bright line set of rules to establish whether both service providers' actions constituted a sufficiently expedient response pursuant to § 512. Uncertainty on how the lower court should proceed under the higher court's instructions in evaluating whether Google and Amazon.com properly responded to P10's notifications results from the ambiguous language in § 512's safe harbor provision regarding what constitutes *expeditious*.

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trademark infringement, vicarious trademark infringement, trademark dilution, unfair competition, wrongful use of a registered mark, and violation of rights of publicity. *Id.*

<sup>16</sup> Perfect 10, Inc. v. Amazon.com, Inc., 487 F.3d 701, 729 (9th Cir. 2007).

<sup>17</sup> *Id.* at 732.

<sup>18</sup> Perfect 10, Inc. v. Amazon.com, Inc., 487 F.3d 701 (9th Cir. 2007).

<sup>19</sup> *Id.* (quoting A&M Records, Inc. v. Napster, Inc., 239 F.3d 1004, 1022 (9th Cir. 2001)).

<sup>20</sup> *Id.* (quoting Religious Tech. Ctr. v. Netcom On-Line Commc'n Servs., Inc., 907 F. Supp. 1361, 1375 (N.D. Cal. 1995)).

<sup>21</sup> *Id.* at 733. While P10's contributory and vicarious liability claims against both Google and Amazon are on remand, this Note will focus on P10's claims against Google, which directly address the adequacy of a service provider's response to P10's notifications.

This Note seeks to present a survey of what is currently known and still unknown about proper ISP responses to takedown notices. In particular, it discusses the ambiguity of the meaning of *expeditious* in § 512's safe harbor provision of the DMCA. It will show that in order to create more uniform and predictable outcomes in future litigation, specific guidelines should be established through a reasonableness test. The test will include three prongs: (1) ISPs should be required to have the most up-to-date software technology readily available in the industry in order to detect copyrighted material; (2) the nature of the notification should be a primary consideration in evaluating whether the ISP's responded *expeditiously*, or within a reasonable amount of time; and (3) based on the totality of the circumstances, the ISP should not suffer an undue burden in cost and resources.

The three-pronged reasonableness test described in this Note offers a suggested framework with which to assess the adequacy of an ISP's response as an *expeditious* one. In particular, the application of this three-part test to the facts of *Perfect 10, Inc. v. Amazon.com*, which is being considered on remand to the district court, will demonstrate the value in this approach. This test, however, is only a recommendation; other alternative tests could be equally workable. Yet, the underlying purpose of creating more specific guidelines for evaluating service providers' responses to takedown notices still remains imperative in the complex labyrinth of the digital universe.

This Note will first introduce some basic tenets and goals of copyright law and relevant portions of the DMCA's § 512, which limits liability for qualifying service providers. In particular, Part I will address the issues regarding proper notice and takedown procedures necessary for a service provider to find refuge under the safe harbor provision. Part II will then address the ambiguity of certain provisions of § 512, specifically the unclear meaning of *expeditious* with respect to a service provider's response time in removing allegedly infringing material or activity. That section will then contend that the uncertain meaning of *expeditious* is becoming the next fertile legal battleground for service providers and copyright owners, as relevant case law will illustrate. Part III will then discuss the importance of creating a more workable standard to determine when a service provider has responded *expeditiously*, and will propose a three-part reasonableness test as a possible solution. That final section will demonstrate the value and advantage of this three-pronged approach by applying it to the facts of *Perfect 10, Inc. v. Amazon.com*, now on remand to determine whether Google responded *expeditiously* to P10's notification.

## I. BACKGROUND OF RELEVANT COPYRIGHT LAW AND DMCA SAFE HARBOR PROVISION

### A. Copyright Infringement Law

As a threshold question in any copyright infringement adjudication, a plaintiff who claims copyright infringement must show: (1) ownership of a valid copyright to the material in question, and (2) that the defendant violated the copyright owner's exclusive rights under the Copyright Act.<sup>22</sup> Essentially, copyright infringement occurs "when a defendant violates one of the exclusive rights of the copyright holder."<sup>23</sup>

Courts have recognized three doctrines of copyright liability: direct copyright infringement, contributory copyright infringement, and vicarious copyright infringement.<sup>24</sup> To prove a claim of direct copyright infringement, a plaintiff must demonstrate that he owns the copyright and that the defendant himself violated one or more of the plaintiff's exclusive rights under the Copyright Act.<sup>25</sup> In order for any contributory or vicarious infringement to exist, there must first be a finding of direct copyright infringement. However, a third party who does not directly infringe may still be held secondarily liable. Secondary liability includes contributory or vicarious infringements of copyrighted material.<sup>26</sup> Contributory infringement occurs when an actor has knowledge of the infringing activity and induces, causes, or materially contributes to the infringing conduct of another.<sup>27</sup> Material contribution exists when an actor "either actively encourages infringement, or knows of the infringing activity and could control it, but does nothing to prevent it."<sup>28</sup> An actor infringes contributorily by intentionally inducing or encouraging direct infringement.<sup>29</sup> Comparatively, vicarious liability for copyright infringement occurs when an

<sup>22</sup> *Ellison v. Roberston*, 357 F.3d 1072, 1076 (citing 17 U.S.C. § 501(a) (2003)). The court also affirmed the district court's ruling that AOL was eligible for protection under the safe harbor provision of the DMCA as a "conduit service provider." *Id.* at 1081.

<sup>23</sup> *Parker v. Google, Inc.*, 422 F. Supp. 2d 492, 496-97 (E.D. Pa. 2006) (quoting *Religious Tech. Ctr. v. Netcom On-Line Comm'n Servs., Inc.*, 907 F. Supp. 1361, 1366-67 (N.D. Cal. 1995)).

<sup>24</sup> See *Ellison*, 357 F.3d at 1076 (discussing the court's recognition of three doctrines of copyright liability: direct, contributory, and vicarious copyright infringement).

<sup>25</sup> *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1013 (9th Cir. 2001); see also *Ellison*, 357 F.3d at 1076.

<sup>26</sup> *Napster*, 239 F.3d at 1013.

<sup>27</sup> *Ellison*, 357 F.3d at 1076 (citing *Gershwin Pub'g Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971)). The *Ellison* court interprets the knowledge requirement for contributory copyright infringement to include both those with actual knowledge and those who have reason to know of direct infringement. *Napster*, 239 F.3d at 1020.

<sup>28</sup> Todd E. Reese, Comment, *Wading Through the Muddy Waters: The Court's Misapplication of Section 512(c) of the Digital Millennium Copyright Act*, 34 Sw. U. L. REV. 287, 290 (2004) (examining congressional intent in passing provisions of § 512(c) of the DMCA).

<sup>29</sup> *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 930 (2005); see also *Gershwin Pub'g Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971).

actor "enjoys a direct financial benefit from another's [directly] infringing activity and has the right and ability to supervise the infringing activity," but declines to stop or limit it.<sup>30</sup>

### B. *History and Purpose of the DMCA*

The DMCA endeavors to facilitate cooperation among service providers and copyright owners in order to "detect and deal with copyright infringements that take place in the digital networked environment."<sup>31</sup> Congress aspired to "provide greater certainty to service providers concerning their legal exposure for infringements that may occur in the course of their activities."<sup>32</sup> The Act did not aim to rewrite copyright law. Congressional records indicate that, rather than "embarking on a wholesale clarification" of the various doctrines of copyright liability, Congress decided "to leave current law in its evolving state and, instead, to create a series of 'safe harbors,' for certain common activities of service providers."<sup>33</sup> Overall, the Act aspires to afford some protection to qualifying service providers against secondary copyright liability through the actions of their users.

The safe harbor provision of the DMCA reflects "a compromise between the demands of copyright holders and the concerns of the Internet industry."<sup>34</sup> Thus far, courts have broadly defined a service provider "to include not only conventional ISPs like AOL, but also online merchants like Amazon and eBay."<sup>35</sup> Partly due to their "deep pockets, easy identifiability, and potential ability to act as gatekeepers," Internet service providers "were repeatedly held liable for infringing materials distributed by their subscribers under the doctrines of contributory and vicarious infringement."<sup>36</sup> In response, Congress "created safe harbors because of the recognized need for reduction of liability in special instances."<sup>37</sup>

### C. *Elements of the DMCA Safe Harbor Act: Legislation and Qualifications*

Title II of the DMCA added a new § 512 to the Copyright Act, thereby creating four new limitations on liability or "safe harbors" for copyright infringement by online service providers. Since the

<sup>30</sup> *Ellison*, 357 F.3d at 1076; *Shapiro, Bernstein & Co., Inc. v. H. L. Green Co., Inc.*, 316 F.2d 304, 307 (2d Cir. 1963).

<sup>31</sup> S. REP. NO. 105-190, at 20 (1998).

<sup>32</sup> *Ellison*, 357 F.3d at 1076.

<sup>33</sup> S. REP. NO. 105-90, at 20; see also *Ellison*, 357 F.3d at 1076.

<sup>34</sup> Kim, *supra* note 4, at 153; see also Niva Elkin-Koren, *Making Technology Visible: Liability of Internet Service Providers for Peer-to-Peer Traffic*, 9 N.Y.U. J. LEGIS. & PUB. POL'Y 15, 28 (2005-2006).

<sup>35</sup> Kim, *supra* note 4, at 154.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.*



DMCA provides a defense to copyright infringement, "a potential infringer must first be found liable under direct or secondary infringement principles before the need to raise the DMCA defense arises."<sup>38</sup> Furthermore, "secondary liability for copyright infringement does not exist in the absence of direct infringement by a third party."<sup>39</sup> A service provider qualifying under § 512 is protected from liability for all monetary relief for direct, vicarious, and contributory infringement in circumstances in which the infringing or allegedly infringing content are contained in the system without the knowledge and involvement of the service provider. Accordingly, a service provider "may be subject only to the narrow injunctive relief set forth in [section] 512(j)."<sup>40</sup>

Under the DMCA's four safe harbors, service providers that have passed the preliminary threshold requirements may limit their liability for claims of copyright infringement.<sup>41</sup> A party must first qualify as a "service provider" in order to find refuge under the four safe harbors. The limitations are divided into four categories of a service provider's conduct: (1) transitory digital network communications;<sup>42</sup> (2) system caching;<sup>43</sup> (3) information residing on systems or networks at the direction of users;<sup>44</sup> or (4) information location tools.<sup>45</sup> Each limitation "relates to a separate and distinct function."<sup>46</sup> Determining whether a service provider qualifies for one of the limitations "does not bear upon a determination of whether the provider qualifies for any of the other three [limitations]."<sup>47</sup>

To be eligible for any of the safe harbor provisions, a service provider must also satisfy two additional conditions: (1) it must adopt and reasonably implement a policy of terminating in ap-

<sup>38</sup> Reese, *supra* note 28, at 290-91. See 17 U.S.C. § 512(l) (2006); see also S. REP. NO. 105-190, at 19-20; H.R. REP. NO. 105-551, at 50 (1998).

<sup>39</sup> *Napster*, 239 F.3d at 1013 n.2 (finding that "Napster does not facilitate infringement of the copyright laws in the absence of direct infringement by its users").

<sup>40</sup> *Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d at 701.

<sup>41</sup> Congress enacted the title II of the DMCA to provide greater certainty to service providers concerning their legal exposure for infringements that may occur in the course of their activities. Sections 512(a) through (d) provide safe harbor protection from liability for: (1) transitory digital network communications; (2) system caching; (3) information residing on systems or networks at the direction of users; and (4) information location tools. 17 U.S.C. § 512(a)-(d).

<sup>42</sup> 17 U.S.C. § 512(a); see also 17 U.S.C. § 512(k)(1)(A) (defining a "service provider" as "an entity offering the transmission, routing, or providing of connections for digital online communications, between or among points specified by a user, of material of the user's choosing, without modification to the content of the material as sent or received").

<sup>43</sup> 17 U.S.C. § 512(b); see also 17 U.S.C. § 512(j)(B) (a "service provider" as used in § 512, other than in subsection (a), is more broadly defined as "a provider of online services or network access, or the operator of facilities").

<sup>44</sup> 17 U.S.C. § 512(c).

<sup>45</sup> 17 U.S.C. § 512(d). Section 512(e) also includes special rules regarding these limitations as applied to nonprofit educational institutions.

<sup>46</sup> U.S. Copyright Office Summary, *The Digital Millennium Copyright Act of 1998* (Dec. 1998), at 9, available at <http://www.copyright.gov/legislation/dmca.pdf>.

<sup>47</sup> *Id.*

propriate circumstances the accounts of subscribers who are repeat infringers, and (2) it must accommodate and not interfere with "standard technical measures."<sup>48</sup> "Standard technical measures" constitute measures that copyright owners use to identify or protect copyrighted works and that "(A) have been developed pursuant to a broad consensus of copyright owners and service providers in an open, fair, voluntary, multi-industry standards process; (B) are available to anyone on reasonable nondiscriminatory terms; and (C) do not impose substantial costs . . . or substantial burdens on their systems or networks."<sup>49</sup>

Further, the failure of a service provider's conduct to qualify for any of the limitations in § 512 does not necessarily make it liable for copyright infringement.<sup>50</sup> Pursuant to § 512(l), "the copyright owner must still demonstrate that the provider has infringed, and the provider may still avail itself of any of the defenses, such as fair use, that are available to copyright defendants generally."<sup>51</sup> In addition, § 512(h) establishes a procedure by which a copyright owner can obtain a subpoena from a federal court "ordering a service provider to disclose the identity of a subscriber who is allegedly engaging in infringing activities."<sup>52</sup> To "ensure that service providers are not placed in the position of choosing between limitations on liability . . . and preserving the privacy of their subscribers," § 512(m) expressly states that "nothing in section 512 requires a service provider to monitor its service or access material in violation of law (such as the Electronic Communications Privacy Act) in order to be eligible for any of the liability limitations."<sup>53</sup>

Section 512(c) applies to information residing on systems or networks at the direction of users; it limits the liability of service providers for infringing material on websites (or other information repositories) hosted on their systems.<sup>54</sup> A service provider will not be held liable if: (1) the provider does not have actual knowledge of the infringing material or activity; (2) the service provider has the right and ability to control the infringing activity, but does not receive a financial benefit directly attributable to the infringing activity; and (3) upon receiving proper notification of the claimed infringement, the service provider responds expeditiously

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<sup>48</sup> 17 U.S.C. § 512(i).

<sup>49</sup> 17 U.S.C. § 512(i)(2).

<sup>50</sup> 17 U.S.C. § 512(l).

<sup>51</sup> 17 U.S.C. § 512(l) ("Other defenses not affected . . . The failure of a service provider's conduct to qualify for limitation of liability under [§ 512] shall not bear adversely upon the consideration of a defense by the service provider that the service provider's conduct is not infringing . . .").

<sup>52</sup> 17 U.S.C. § 512(h).

<sup>53</sup> U.S. Copyright Office Summary, *supra* note 46, at 9.

<sup>54</sup> The conditions specific to § 512(c) and (d) are virtually identical. Thus, while this Note primarily discusses § 512(c), even an ISP falling under § 512(d) still must adhere to the same notice and takedown instructions outlined in § 512(c)(3).

to remove, or disable access to, the allegedly infringing material or activity.<sup>55</sup> Additionally, a service provider must have filed a designated agent with the Copyright Office to “receive notifications of claimed infringement.”<sup>56</sup> If a service provider receives proper notice from a copyright owner that material on the service provider’s website is allegedly infringing, the service provider must “expeditiously remove the allegedly infringing content.”<sup>57</sup>

The applicable standard of knowledge “is critical to retention of safe harbor.”<sup>58</sup> As a prerequisite for a service provider to be eligible for safe harbor, a service provider must not be “aware of facts or circumstances from which infringement is apparent.”<sup>59</sup> Upon obtaining the requisite level of knowledge or awareness – usually through the receipt of a takedown notice – the service provider must “[act] expeditiously to remove, or disable access to,” the allegedly infringing material.<sup>60</sup> Regardless of whether the content or material is actually infringing, a service provider “must comply with a takedown notice or chance the loss of safe harbor.”<sup>61</sup>

#### D. Notice and Takedown Procedures as Provided by Section 512(c)(3)<sup>62</sup>

Proper notice for an alleged copyright infringement must be in the form of a written communication provided to the designated agent of a service provider that includes the following:

- (i) A physical or electronic signature of a person authorized to act on behalf of the owner of an exclusive right that is allegedly infringed;
- (ii) Identification of the copyrighted work claimed to have

<sup>55</sup> 17 U.S.C. § 512(c)(1)(A)-(C).

<sup>56</sup> 17 U.S.C. § 512(c)(2).

<sup>57</sup> 17 U.S.C. § 512(c)(1)(A)(3), (c)(1)(C).

<sup>58</sup> Kim, *supra* note 4, at 156.

<sup>59</sup> *Id.* at 157.

<sup>60</sup> 17 U.S.C. § 512(c)(2).

<sup>61</sup> Kim, *supra* note 4, at 156.

<sup>62</sup> Sections 512(a) and (b) seem to be less significant and more technical than § 512(c). In addition, the steps outlined in § 512(c) for notification of claimed infringement and removal by the service provider are applicable to § 512(a) and (b). Therefore, this Note will primarily focus on § 512(c); section 512(d) relates to hyperlinks, online directories, search engines and similar service providers. The requirements are essentially the same conditions that apply under § 512(c)(3), with some differences in the notification requirements. Sections 512(f)-(g) are provisions establishing safeguards against the possibility of erroneous or fraudulent notifications, as well as those protecting the provider against claims based on having taken down the material which apply to this limitation. They limit liability for the acts of referring or linking users to a site that contains infringing material by using such information location tools, if the following conditions are met: (1) the service provider must not have the requisite level of knowledge that the material is infringing. The knowledge standard is the same as under the limitation for information residing on systems or networks; (2) if the provider has the right and ability to control the infringing activity, the provider must not receive a financial benefit directly attributable to the activity; and (3) upon notification of the claimed infringement as described in subsection (c)(3), response expeditiously to remove, or disable access to, the infringing material or activity. See generally 17 U.S.C. § 512(a)-(g).

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;

(iii) Identification of the material that is claimed to be infringing or to be the subject of infringing activity and that is to be removed or access to which is to be disabled, and information reasonably sufficient to permit the service provider to locate the material;

(iv) Information reasonably sufficient to permit the service provider to contact the complaining party, such as an address, telephone number, and, if available, an electronic mail address at which the complaining party may be contacted;

(v) A statement that the complaining party has a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law;

(vi) A statement that the information in the notification is accurate, and under penalty of perjury, that the complaining party is authorized to act on behalf of the owner of an exclusive right that is allegedly infringed . . . .<sup>63</sup>

Notice that fails to substantially comply with these requirements will not be considered in "determining whether a service provider has actual knowledge or is aware of facts or circumstances from which infringing activity is apparent."<sup>64</sup> However, if the copyright owner substantially complies with the requirements to identify the allegedly infringed work, identifies the material that is allegedly being infringed, and provides contact information for the complaining party, then the service provider must make an effort to remedy the deficient notice with the copyright owner.<sup>65</sup>

## II. PROPER NOTICE AND TAKEDOWN PROCEDURES: A SURVEY OF WHAT WE KNOW AND DO NOT KNOW

### A. Summary of Provision

Under § 512(c), a copyright owner's notification to a service provider must "substantially comply" with the statutory requirements in order to be considered proper notification, thereby prompting the service provider's duty to *expeditiously* remove the allegedly infringing material. If notification is lacking or improper, then a court cannot consider the notification when determining a service provider's knowledge of the infringement. For example, in *Perfect 10, Inc. v. CCBill LLC*, the Court of Appeals for

<sup>63</sup> 17 U.S.C. § 512(c)(3)(A).

<sup>64</sup> 17 U.S.C. § 512(c)(3)(B)(i).

<sup>65</sup> S. REP. NO. 105-190, at 46-47 (1998) (discussing 17 U.S.C. § 512(c)(3)(B)).

the Ninth Circuit found that "Perfect 10 did not provide notice that substantially complied with the requirements of § 512(c)(3) [of the DMCA]."<sup>66</sup> In *CCBill*, each of the three notices that Perfect 10 sent contained errors and "one or more of the required elements [were] entirely absent."<sup>67</sup>

However, if the copyright owner's notice contains at least an identification of the allegedly infringed work, of its location, and of the copyright owner's contact information, then the service provider must contact the copyright owner and request the rest of the notice requirements.<sup>68</sup> If the service provider fails to contact the copyright owner and does not insist upon receiving correct notice, then the service provider is deemed to have received correct notice.<sup>69</sup> Accordingly, if the copyright owner refuses to send correct notice, then the service provider is presumed to not have received notice, and is thereby exempt from liability.<sup>70</sup>

### B. *Initial Challenges: Conflicting Interpretations of "Substantial Compliance" with Notice*<sup>71</sup>

Confusion has arisen in the past decade over what is necessary to substantially comply with the DMCA notice provisions.<sup>72</sup> Initially, most of the cases dealing with substantial compliance by service providers "dealt with extreme situations where [service providers] have ignored infringement on their sites and tried to hide behind the DMCA to shield them from liability for the infringement."<sup>73</sup> In cases such as these, "courts have been eager to hold the [service provider] liable and thus have interpreted some

<sup>66</sup> 488 F.3d 1102, 1111 (9th Cir. 2007).

<sup>67</sup> *Id.* at 1112.

<sup>68</sup> 17 U.S.C. § 512(c)(3)(B).

<sup>69</sup> 17 U.S.C. § 512(c)(3)(B)(2) states that a service provider will not be deemed to have received notice of infringement when "the notification that is provided to the service provider's designated agent fails to comply substantially with all the provisions of subparagraph (A) but substantially complies with clauses (ii), (iii), and (iv) of subparagraph A so long as the service provider responds to the inadequate notice and explains the requirements for substantial compliance; see *Perfect 10, Inc. v. CCBill LLC*, 488 F.3d 1102, 1112 (9th Cir. 2007) (finding that the copyright owner did not provide notice that substantially complied with the notice requirements of § 512(c)(3)).

<sup>70</sup> 17 U.S.C. § 512(c)(3)(B); see also *Perfect 10, Inc. v. CCBill LLC*, 488 F.3d at 1112 (noting that permitting a copyright owner to "cobble together adequate notices from separately defective notices so unduly burdens service providers").

<sup>71</sup> While this Note does not engage in a thorough analysis of a copyright owner's adherence to proper notification procedures, it is helpful to recognize that part of the confusion over the DMCA provision originates in confusion over substantial compliance with notice procedures by copyright owners. This Note instead focuses on the confusion on the part of service providers in expeditiously removing allegedly infringing material based on proper notification. Nevertheless, it is still important to recognize the overall confusion that this provision of the DMCA provokes.

<sup>72</sup> See generally Reese, *supra* note 28 (addressing the confusion over different provisions of § 512 and the resulting inconsistencies amongst court decisions).

<sup>73</sup> *Id.* at 288; see also *ALS Scan, Inc. v. RemarQ Cmty. Inc.*, 239 F.3d 619, 620 (4th Cir. 2001); *Napster*, 239 F.3d at 1020 (Napster permitted the exchange of copyrighted and trademarked songs and work).

provisions of the DMCA in a manner that eviscerates the protections provided."<sup>74</sup> Furthermore, courts have also interpreted the same provision of the DMCA differently, thus leading to different outcomes. In *Hendrickson v. eBay*,<sup>75</sup> the court deemed the copyright owner's notice deficient, yet suggested that a copyright owner's notice that "all" instances of a product on the service provider's site was infringing might potentially comply with the DMCA's requirements.<sup>76</sup> Comparatively, in *ALS Scan, Inc. v. RemarQ Communities, Inc.*,<sup>77</sup> the court held it sufficient for a copyright owner only to provide the service provider with "virtually all" of the images which were infringing and a link to the copyright owner's database where its copyrighted images could be found.<sup>78</sup> While arguably "virtually all" and "all" may allow the copyright owner to exercise the same degree of consideration in notifying a service provider of infringing activity, "there is a great chasm of liability between 'virtually all' and 'all.'"<sup>79</sup>

In *Hendrickson*, Robert Hendrickson, a documentary filmmaker, sent eBay a cease and desist letter, asserting his ownership of a documentary film and that eBay was selling pirated copies of that film.<sup>80</sup> The letter, however, did not explain which digital video disks ("DVD") were infringing; nor did it fully describe Hendrickson's copyright interest.<sup>81</sup> Upon receiving Hendrickson's notification, eBay responded by sending an e-mail requesting more detailed information regarding his copyright and the allegedly infringing items.<sup>82</sup> Hendrickson refused to comply. The *Hendrickson* court found that the copyright owner's notice was deficient because it did not contain all of the enumerated requirements; specifically, it failed to list the item numbers of the allegedly problematic listings.<sup>83</sup> In addition, the court suggested that "notice may have been valid if it claimed that all instances of material on [a service provider's] website are infringing, rather than identifying the location of specific material."<sup>84</sup>

In contrast to the *Hendrickson* court, the court in *ALS Scan* found that notice substantially complied with DMCA requirements even though the location of specific infringements was not identi-

<sup>74</sup> Reese, *supra* note 28, at 288 (citing *ALS Scan*, 239 F.3d at 620 (holding that the notice provided to ALS Scan by RemarQ substantially complied with the DMCA)).

<sup>75</sup> 165 F. Supp. 2d 1082, 1090 (C.D. Cal. 2001).

<sup>76</sup> Reese, *supra* note 28, at 289.

<sup>77</sup> *ALS Scan*, 239 F.3d 619.

<sup>78</sup> *Id.* at 619.

<sup>79</sup> Reese, *supra* note 28, at 289.

<sup>80</sup> *Hendrickson*, 165 F. Supp. 2d 1082.

<sup>81</sup> *Id.* at 1084.

<sup>82</sup> *Id.* at 1085.

<sup>83</sup> *Id.* at 1089-90.

<sup>84</sup> Reese, *supra* note 28, at 309 (referring to the court's speculation that notice may have been sufficient if eBay had stated that "all" material on the website was infringing).

fied.<sup>85</sup> In this case, defendant RemarQ refused to comply with ALS Scan's cease and desist letter because it did not contain sufficient specificity.<sup>86</sup> Subsequently, ALS Scan answered "that RemarQ had included over 10,000 copyrighted images belonging to ALS Scan in its newsgroups over the period of several months."<sup>87</sup> The *ALS Scan* court held that ALS Scan substantially complied with the DMCA notification requirement of providing a representative list of infringing material, as well as information reasonably sufficient to enable RemarQ to locate the infringing material; by stating "virtually all" of the material was infringing, ALS Scan sufficiently complied with the DMCA notification requirement.<sup>88</sup> The inconsistency between court decisions has led to uncertainty and unpredictability for what ISPs must do to qualify for safe harbor.<sup>89</sup>

### C. *The Uncertain Definition of Expeditious*

Even though the DMCA establishes certain safe harbors that protect service providers from liability, and aims to define the threshold requirements for ISPs to qualify for protection under § 512, it does not clearly or adequately explain what constitutes an *expeditious* response by a service provider in order for the provider to find refuge under the safe harbors of § 512. As a result, the meaning of *expeditious* remains "open to debate."<sup>90</sup> *Expeditious* appears to function as a constructive term, leaving courts to decipher and interpret what is an adequately "expedient" response by a service provider. This consequently leads to a lack of uniformity amongst various court decisions. No court to date has found a service provider liable for a failure to act expeditiously to a takedown notice.<sup>91</sup> However, as recent case law suggests, this provision is beginning to receive more attention as copyright owners increasingly argue that a service provider did not respond ade-

<sup>85</sup> *ALS Scan*, 239 F.3d at 625.

<sup>86</sup> *Id.* at 621.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.* at 625 (The court held that ALS Scan's notification was sufficient because it provided RemarQ with information that (1) identified two sites created for the sole purpose of publishing ALS Scan's copyrighted works, (2) asserted that virtually all the images at the two sites were its copyrighted material, and (3) referred RemarQ to two web addresses where RemarQ could find pictures of ALS Scan's models and obtain ALS Scan's copyright information. In addition, the letter noted that the material could be identified since it contained ALS Scan's name or copyright symbol beside it).

<sup>89</sup> See Reese, *supra* note 28, at 308 (arguing that the *ALS Scan* decision is erroneous because it misinterprets the notification requirement, but contending that the court was accurate in saying that the representative list must be limited to a list of copyrights owned by the copyright owner, and not be a representative list of locations on the service provider's site. The court was erroneous in finding that "virtually all" of the material in a newsgroup was reasonably sufficient to permit the service provider to locate the material).

<sup>90</sup> *Id.* (analyzing Congress' intent behind the DMCA provision dealing with expeditious removal and contending that the ambiguity of the term "expeditious" has not been clarified by the courts).

<sup>91</sup> *Id.*

quately, or rather, *expeditiously*, to takedown notifications.

It is difficult to ascertain a bright-line rule for what constitutes an expeditious response. The Senate committee report regarding the passing of the DMCA suggests that differing technical facts or varying circumstances may dictate different expeditious time frames.<sup>92</sup> In some instances, a copyrighted image posted by a third party infringer could result in millions of subsequent downloads by other users within twenty-four hours. An *expeditious* response in this scenario may require a response by a service provider to occur within a four to five hours. Comparatively, other factual situations may merit a more delayed response time, such as if it is necessary for the service provider to consult its lawyer.

In addition, *expeditious* could vary based on what is required in the process of taking down the allegedly infringing content; "while 'expeditious' for an automated system may be virtually instantaneous, 'expeditious' for a manual system of receipt and takedown is likely to be longer, especially if review by an attorney is necessary."<sup>93</sup> Courts have not clearly defined the parameters of what constitutes expeditious in such varied circumstances. Leaving the courts to determine whether a service provider's response was expeditious based on the particular facts and circumstances will result in a highly fact-intensive investigation by each trier of fact, and opens the door to arbitrary and inconsistent findings. This leaves the service provider not necessarily knowing in advance if its takedown will be found to be expeditious enough. Accordingly, service providers do not have a definite and reliable framework to gauge whether they are properly responding, thereby satisfying the requirements of § 512(c).

In order to avoid similar confusion to what has arisen over other requirements found in § 512(c), such as the standard of knowledge required in order for a service provider to be found liable<sup>94</sup> or what constitutes "substantial compliance" with notification requirements,<sup>95</sup> it is necessary to create more specific guidelines for evaluating whether a service provider has responded *expeditiously*.

#### D. *The Ambiguity of Expeditious in Case Law: Perfect 10, Inc. v. Amazon.com and the Remand Component*

As courts are increasingly faced with the question of whether a service provider responded expeditiously, the need for more definable standards becomes evident. One major case in the Court

<sup>92</sup> S. REP. NO. 105-190, at 44.

<sup>93</sup> Reese, *supra* note 28, at 308.

<sup>94</sup> 17 U.S.C. § 512(c)(A)(i)-(ii) (2006).

<sup>95</sup> § 512(c)(3).



of Appeals for the Ninth Circuit, *Perfect 10, Inc. v. Amazon.com, Inc.*,<sup>96</sup> demonstrates the importance of creating workable guidelines as soon as possible. *Perfect 10, Inc. v. Amazon.com* was an appeal from a 2004 ruling of the Central District Court of California.<sup>97</sup> Perfect 10 is the publisher of the adult magazine, *Perfect 10*. It also operates the subscription website, perfect10.com. Both the magazine and the website "feature high-quality, nude photographs of 'natural' models."<sup>98</sup> P10 sued Google for infringing P10's copyrighted photographs of nude models, among other claims.<sup>99</sup> P10 also brought a similar action against Amazon.com and its subsidiary A9.com, which the district court collectively referred to as "Amazon.com."<sup>100</sup>

The district court preliminarily enjoined Google from creating and publicly displaying thumbnail-versions of Perfect 10's images, but did not enjoin Google from linking to third-party websites that display infringing full-size versions of Perfect 10's images.<sup>101</sup> It found that Google "did not itself display or distribute images to which it in-line linked," but that Google "did display thumbnail versions of responsive images."<sup>102</sup> The court held that Google's display of thumbnail versions of P10's images likely did infringe P10's copyrights directly and that Google was unlikely to succeed on a fair use defense.<sup>103</sup> Furthermore, it also held that Google was not likely to be found secondarily liable for direct infringement either by its users or third-party websites.<sup>104</sup> Both P10 and Google appealed. The district court did not preliminarily enjoin Amazon.com from giving users access to information and images that Google provides.<sup>105</sup>

In May of 2007, the Court of Appeals for the Ninth Circuit issued an opinion affirming in part and reversing in part the district court's decision, and remanding the case back to the lower court.<sup>106</sup> The appellate court agreed with the district court's ruling, that because P10 has the burden of showing a likelihood of success on the merits, it also has the burden of demonstrating a likelihood of overcoming Google's fair use defense under 17 U.S.C. § 107.<sup>107</sup> It also agreed that P10 was not likely to successfully

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<sup>96</sup> *Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d at 710.

<sup>97</sup> *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828.

<sup>98</sup> *Id.* at 831-32.

<sup>99</sup> *Id.* at 831.

<sup>100</sup> *Id.*

<sup>101</sup> *Id.*

<sup>102</sup> *Id.* at 844.

<sup>103</sup> *Id.*

<sup>104</sup> *Id.*

<sup>105</sup> *Id.*

<sup>106</sup> *Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d 701.

<sup>107</sup> See 17 U.S.C. § 107 (2006). The party seeking a preliminary injunction for a copyright infringement bears the burden of showing that it is likely to succeed in overcoming a fair

show direct infringement through in-line linking.<sup>108</sup> The appellate court, however, reversed the district court's ruling and found that P10 would most likely not prevail against Google's fair use affirmative defense.<sup>109</sup> The appellate court remanded the claim back to the district court partly because the lower court "did not resolve the factual disputes over the adequacy of Perfect 10's notices to Google and Google's responses to these notices."<sup>110</sup> The higher court also found factual disputes existing over "whether there [were] reasonable and feasible means for Google [and Amazon] to refrain from providing access to infringing images."<sup>111</sup> It instructed the lower court to consider "whether Perfect 10 would likely succeed in establishing that Google was contributorily liable for in-line linking to full-size infringing images" under the *Napster* precedent.<sup>112</sup> In *A&M Records, Inc. v. Napster Inc.*, the Court of Appeals for the Ninth Circuit articulated a test for determining when contributory liability can be imposed on service providers in the context of cyberspace: if the service provider "has actual knowledge that specific infringing material is available using its system"<sup>113</sup> and fails to take simple measures to block access to these copyrighted materials<sup>114</sup> Accordingly, under what has come to be known as the *Napster* precedent, Google can be held contributorily liable if "it had knowledge that infringing Perfect 10 images were available using its search engine, could take simple measures to prevent further damage to Perfect 10's copyrighted works, and failed to take such steps."<sup>115</sup>

Furthermore, the appellate court applied the *Grokster* test to determine whether Google could be held vicariously liable. Under *Grokster*, a service provider is vicariously liable if it "infringes vicariously by profiting from direct infringement while declining to exercise a right to stop or limit it."<sup>116</sup> To succeed, the appellate court stated, "a plaintiff must show that the defendant exercises the requisite control over the direct infringer and that the defendant derives a direct financial benefit from the direct infringement of showing that Google has the legal right to stop or limit

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use defense.

<sup>108</sup> *Google*, 416 F. Supp. 2d at 838 (defining "in-line" linking as "the process whereby a webpage can incorporate by reference . . . content stored on another site (citing *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 816 (9th Cir. 2003)); "The in-line link instructs the user's browser to retrieve the linked-to image from the source website and display it on the user's screen, but does so without leaving the linking document.").

<sup>109</sup> *Id.* at 726-29.

<sup>110</sup> *Amazon.com*, 487 F.3d at 729.

<sup>111</sup> *Id.*

<sup>112</sup> *Id.* (discussing *Napster*, 239 F.3d at 1019-22).

<sup>113</sup> *A&M Records, Inc. v. Napster Inc.*, 239 F.3d 1004, 1022 (9th Cir. 2001).

<sup>114</sup> *Napster*, 239 F.3d at 1019-22; see also *Amazon.com*, 487 F.3d at 728 (discussing the *Napster* test for contributory liability).

<sup>115</sup> *Id.*

<sup>116</sup> *Amazon.com*, 487 F.3d at 729-30 (citing *Grokster II*, 545 U.S. at 930).

the direct infringement of the third party sites."<sup>117</sup> The court further discussed *Grokster's* explanation of the "control" element of the vicarious liability test "as the defendant's 'right and ability to supervise the direct infringer.'"<sup>118</sup> The court determined that Google's right to terminate an AdSense partnership "does not give Google the right to stop direct infringement by third party websites" because "a third-party site can continue to reproduce, display and distribute its infringing copies of P10 images after its participation in the AdSense program has ended."<sup>119</sup> Google was distinguished from Napster, which had a closed system requiring user registration and could terminate its user's accounts and block their access to the Napster system.<sup>120</sup> In addition, "Napster had the right and ability to prevent its users from engaging in the infringing activity."<sup>121</sup> Comparatively, Google cannot stop third party websites from reproducing, displaying or distributing unauthorized copies of images because infringing conduct takes place on third party websites and Google "cannot terminate those third-party websites or block their ability to host and serve infringing full-size images."<sup>122</sup>

P10 and Google dispute whether Google meets the specific criteria under § 512 of the DMCA. P10 contends that it sent qualifying notices to Google and "it did not act expeditiously to remove the infringing material."<sup>123</sup> In response, Google claims that "Perfect 10's notices did not comply with the notice provisions of section 512 and were not adequate to inform Google of the location of the infringing images on the Internet or identify the underlying copyrighted work."<sup>124</sup> In addition, Google also asserts that it "responded to all notices it received by investigating the webpages identified by Perfect 10 and suppressing links to any webpages that Google confirmed were infringing."<sup>125</sup>

The remand component of the Court of Appeal for the Ninth Circuit's decision raises a significant issue as to what factors necessarily must be present in order for a service provider to respond promptly enough to satisfy the requirements for safe harbor under § 512. Since the district court determined that P10 was unlikely to succeed on its contributory and vicarious liability claims, the district court did not have the opportunity to evaluate Google's

<sup>117</sup> *Id.* at 730.

<sup>118</sup> *Id.* at 730 (citing *Grokster II*, 545 U.S. at 930) (explaining that a defendant exercises control over a direct infringer when the defendant has a legal right and practical ability to limit or stop the infringing activity).

<sup>119</sup> *Id.* at 730.

<sup>120</sup> *Id.* at 730-31.

<sup>121</sup> *Id.*

<sup>122</sup> *Id.* at 731.

<sup>123</sup> *Google*, 487 F.3d at 732.

<sup>124</sup> *Id.* at 729.

<sup>125</sup> *Id.*

claims that it qualifies for safe harbor under § 512.<sup>126</sup> The Court of Appeals had previously held that the limitations on liability contained in § 512 protect secondary infringers as well as direct infringers.<sup>127</sup> However, the court did not specify how broadly or narrowly to construe § 512 safe harbor provisions.

Few cases have specifically addressed what constitutes an expeditious response by a service provider. Indeed, precedent merely offers a general framework within which to analyze the adequacy of P10's notice and the responses offered by Google and Amazon.com. In *Ellison v. Robertson*,<sup>128</sup> the Court of Appeals for the Ninth Circuit held that it was difficult to conclude that AOL reasonably implemented a policy against repeat infringers and that AOL did not respond, let alone respond *expeditiously*, to Ellison's notifications. Evidence in the record suggests that AOL "did not have an effective notification procedure in place at the time the alleged infringing activities were taking place."<sup>129</sup> The court held that AOL's notification to the Copyright office of its correct e-mail address before Ellison's attorney attempted to contact AOL and post its correct e-mail address was insufficient. It also found that AOL's notification procedures were improper despite its actions because AOL also changed its e-mail address "to which infringement notifications were supposed to have been sent," with "a brief summary of its policy to repeat to which infringement notification were directed to be sent."<sup>130</sup> Furthermore, AOL neither provided a means for the forwarding of messages sent to its old e-mail account, nor did it inform copyright holders who sent copyright notices that AOL's old e-mail address was inactive.<sup>131</sup> AOL should have closed the old e-mail account or forwarded the e-mails sent to the old account to the new one. Instead, "AOL allowed notices of potential copyright infringement to fall into a vacuum and to go unheeded."<sup>132</sup> Because AOL changed its e-mail address in an "unreasonable manner" and "should have been on notice of infringing activity," the court concluded that a reasonable trier of fact could determine that AOL had not reasonably

<sup>126</sup> *Google*, 416 F. Supp.2d at 831.

<sup>127</sup> *See, e.g., Napster*, 239 F.3d at 1025 (finding that § 512 can protect secondary infringers).

<sup>128</sup> 357 F.3d 1072 (9th Cir. 2004).

<sup>129</sup> *Id.* at 1080. Evidence suggests that AOL had knowledge of the infringing material and failed to respond to the notification. On April 17, 2000, in compliance with the DMCA notification procedures, Ellison's counsel sent an e-mail message to agents of Tehama County Online and AOL "to notify the service provider of the infringing activity." *Id.* at 1075. Ellison never received an acknowledgment of receipt from AOL, even though he received one from Tehama County Online. On April 24, 2000, Ellison filed an action against AOL and others in the District Court of Central District of California. Upon receipt of Ellison's complaint, AOL then blocked its subscribers' access to the news-group at issue. *Id.*

<sup>130</sup> *Ellison*, 357 F.3d at 1080.

<sup>131</sup> *Id.*

<sup>132</sup> *Id.*

implemented its policy against repeat infringers.<sup>133</sup>

Unfortunately, *Ellison* offers limited insight into what qualifies as an “expeditious” response. At minimum, it suggests that AOL’s response in blocking its subscribers’ access to the news-group at issue only after it received Ellison’s complaint does not suffice as an expeditious or proper response. Further, it exhibits the lack of jurisprudence available regarding the expeditiousness of service providers’ responses to takedown notices. *Ellison* is an extreme example in which AOL virtually failed to respond at all. The facts of that case are more straightforward than those of cases pending before courts today; *Ellison* does not help resolve more complicated factual situations such as whether Google’s response to P10 by investigating the websites and removing confirmed infringing material also fails as an expeditious response. Moreover, *Ellison* also offers very little insight into how promptly an ISP such as Google or Amazon.com must respond, since AOL did not even receive Ellison’s notifications.

### III. THREE PRONGED REASONABLENESS TEST: CREATING A MORE WORKABLE STANDARD TO DETERMINE THE *EXPEDITIOUSNESS* OF A SERVICE PROVIDER’S RESPONSE

#### A. *The Three-Pronged Reasonableness Test*

In order to provide greater consistency and predictability for court decisions, the factors used to determine whether an ISP responded *expeditiously* should be more uniformly articulated through specific guidelines. This more workable standard should be in the form of a three-pronged reasonableness test: (1) that the service provider operates and maintains up-to-date software to detect and remove copyright violations, and that such software does not fall below industry standards of software used by other similarly situated service providers; (2) that given the character of the notification, the service provider responds appropriately and within a reasonable amount of time; and (3) that the service provider does not suffer an undue burden, in cost or resources, based on the nature of its response to the notification or obtainment of knowledge or awareness of infringing activity.

#### 1. Up-to-Date Software to Track and Eliminate Infringing Content

The first prong of the test provides a new theoretical approach to standard technical measures by mandating that service providers implement the most current detection software technology available in its industry. For example, content-recognition

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<sup>133</sup> *Id.* at 1077.

software and digital fingerprinting detection tools now make it possible to identify copyrighted material.<sup>134</sup> Although courts do consider the type of software service providers utilize in order to monitor and eradicate infringing material on their websites, they have yet to view such consideration as a definitive factor in their analyses. If a service provider does not utilize the most current software technology available, there would then be a rebuttable presumption that the ISP could have expedited the detection and retrieval of infringing material, but failed to do so. It would still be left to the court to figure out what is to be deemed updated software technology in each factual situation. By requiring service providers to implement the most up-to-date detection software that is readily available and not cost prohibitive, courts will have a clearer method of evaluating an important aspect of a service provider's conduct. As a result, one can expect more uniform and consistent decisions as to whether a service provider acted *expeditiously*.

Such a requirement would also further the legislative intentions behind the DMCA of providing a "floor, not a ceiling,"<sup>135</sup> of protection for ISPs. The Senate report indicates a legislative desire to encourage service providers not to contribute or facilitate further copyright violations.<sup>136</sup> Requiring a minimum industry standard of copyright detection technology to be used by ISPs would further these stated goals.

The law recognizes the struggle with requiring up-to-date technology and offers some insight into how to overcome such a challenge. It is not uncommon in the legal system to look to standards of an industry to evaluate whether a party should be held liable by falling below such standards. By importing what is primarily a tort concept, proof of custom and usage in the trade, into ISP liability, courts will have a pre-defined framework with which to evaluate a service provider's response when compared to other comparable and similarly situated industry actors. Indeed, even the Ninth Circuit Court's opinion in *Perfect 10, Inc. v. Amazon.com*, when considering the imputation of intent, analyzes Google's contributory liability through common law tort principles.<sup>137</sup> Further, in *Grokster*, the court imports patent law's "staple article of com-

<sup>134</sup> Brad Stone & Miguel Helft, *Software Could Protect Against Online Media Piracy*, N.Y. TIMES, Feb. 20, 2007, available at <http://tech.mit.edu/V127/N5/webpiracywire.html>.

<sup>135</sup> *CoStar Group, Inc. v. LoopNet, Inc.*, 373 F.3d 544, 555 (4th Cir. 2004) (rejecting plaintiff's claim regarding the legislative intent behind the DMCA, and finding that Congress intended the DMCA's safe harbor for ISP's to be a floor, not a ceiling of protection).

<sup>136</sup> S. REP. NO. 105-190 (1998).

<sup>137</sup> *Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d at 727 (comparing tort law principles to the facts of the case, in that the common law ordinarily imputes to an actor the intention to cause the natural consequences of his action, and stating that contributory liability should be analyzed "in light of 'rules of fault-based liability derived from the common law'" (citing *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 934-35 (2005))).

merce doctrine" into the copyright context.<sup>138</sup>

Tort law acknowledges the probative power of proof of trade custom and usage because it "formulate[s] the general expectation of society as to how individuals will act in the course of their undertakings" and "guide[s] the common sense or expert intuition" of a fact finder when judging "particular conduct under particular circumstances."<sup>139</sup> There are various rationales for establishing a standard based on common usage and trade custom. Evidence of custom indicates a "composite judgment as to the risks of the situation, the precautions required to meet them and the feasibility of such precautions" as well as "the difficulty of any change in accepted methods, the actor's opportunity to learn what is called for" and the justifiable expectation that [the actor] will do and expect to be done what is reasonable.<sup>140</sup> These same reasons provide support for importing a reasonableness standard based on industry custom into copyright law. Requiring service providers to utilize up-to-date detection software that is reasonably obtainable and feasible to maintain will sharpen the fact finder's focus and will allow her to better ascertain whether the service provider was taking "reasonable and feasible steps" to "avoid assisting websites" in distributing infringing content.<sup>141</sup>

Additionally, precedent already exists for requiring service providers to have some format for dealing with infringing activity through standard technical measures. Extending this type of requirement into evaluating the adequacy of a service provider's response to notification of allegedly infringing activity would be fairly simple. Section 512(i)(1)(A) of the DMCA requires service providers to adopt a policy providing for the termination of infringing activity or material, to inform users of the platform of the policy, and to implement that policy in a reasonable manner.<sup>142</sup> Courts have treated this requirement seriously and have held that an ISP can qualify for safe harbor if its policy adheres to the guidelines of § 512(i)(1)(A).<sup>143</sup> For example, in *Corbis Corp. v. Ama-*

<sup>138</sup> *Grokster*, 545 U.S. at 932.

<sup>139</sup> Pound, "The Administrative Application of Legal Standards," in 44 A.B.A. Rep. 445, 456-57 (1919); see also *Trimarco v. Klein*, 56 N.Y.2d 98, 107 (N.Y. 1982) (finding that proof of an accepted practice or trade custom, and that an actor fell below that standard, can bear on what is reasonable conduct under the circumstances when determining negligence).

<sup>140</sup> Restatement (Second) of Torts § 295 cmt.b (1965). See, e.g., Prosser, Torts [4th ed] § 33 (asserting that proof of custom and usage "reflects the judgment and experience and conduct of many."); Clarence Morris, *Custom and Negligence*, 42 COLUM. L. REV. 1147, 1148 (1942) ("[I]ts relevancy and reliability comes . . . from the direct bearing it has on feasibility" in that it focuses "on the practicality of a precaution in actual operation and the readiness in which it can be employed.").

<sup>141</sup> *Amazon.com*, 487 F.3d at 731, 733.

<sup>142</sup> § 512(i)(1)(A) (2006).

<sup>143</sup> See, e.g., *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp. 2d 1090, 1100 (W.D. Wash. 2004); *Ellison*, 357 F.3d 1072.

zon.com, Inc., the court granted summary judgment to Amazon.com on Corbis' copyright infringement claims and held that Amazon.com qualified for safe harbor under § 512(c).<sup>144</sup> The court found that Amazon.com had satisfied the DMCA requirements of adopting a policy that provided for the termination of accounts of repeat infringers, informed vendors using its shopping platform of that policy, and implemented that policy in a reasonable manner.

A requirement of updated technology would not eclipse the DMCA's other requirements, but would supplement and enhance the effectiveness of the service provider's policy against copyright violations on its website. Service providers generally take the DMCA requirements very seriously and post on their websites statements of policy and terms of service that mirror the DMCA's provisions.<sup>145</sup> For instance, YouTube's terms of service and statement of policy advises users that it will remove any content that infringes copyright or does not comply with the terms after proper notification of infringement is provided or at its discretion.<sup>146</sup> YouTube also operates a content verification program "that assists copyright owners in searching for material that they believe to be infringing, and providing YouTube with information reasonably sufficient to permit [YouTube] to locate that material."<sup>147</sup> However, these efforts still do not resolve the time frame in which an ISP will, or should, act to remove the allegedly infringing material. Automatic detection software will expedite the amount of time it would take for an ISP to retrieve or disable access to the material; it could go "well beyond . . . copyright-protection efforts," which

<sup>144</sup> See generally *Corbis Corp.*, 351 F. Supp. 2d 1090 (finding that § 512 of the DMCA shielded Amazon.com from liability because it had adopted a policy providing for the termination of accounts of repeat infringers, informed vendors using the zShops platform of that policy, and implemented that policy in a reasonable manner). "An infringement policy need not be perfect; it need only be reasonably implemented." *Id.* at 1103.

<sup>145</sup> Copies of YouTube's *Terms of Use* and *Copyright Infringement Notification* can be found at <http://www.youtube.com/t/terms> and [http://www.youtube.com/t/dmca\\_policy](http://www.youtube.com/t/dmca_policy), respectively.

<sup>146</sup> The precise provisions, as found in YouTube's Terms of Use, User Submissions are as follows: users will not "(i) submit material that is copyrighted, protected by trade secret or otherwise subject to third party proprietary rights, including privacy and publicity rights, unless you are the owner of such rights or have permission from their rightful owner to post the material and to grant YouTube all of the license rights granted herein; (ii) publish falsehoods or misrepresentations that could damage YouTube or any third party; (iii) submit material that is unlawful, obscene, defamatory, libelous, threatening, pornographic, harassing, hateful, racially or ethnically offensive or encourages conduct that would be considered a criminal offence, give rise to civil liability, violate any law, or is otherwise inappropriate; (iv) post advertisements or solicitations of business; (v) impersonate another person." *Terms of Service*, at <http://www.youtube.com/t/terms> (last visited on Jan. 13, 2008). For a more detailed discussion of YouTube and analysis of whether YouTube can survive a copyright infringement lawsuit, see Jason C. Breen, *YouTube or YouLose? Can YouTube Survive a Copyright Infringement Lawsuit* (Berkley Elec. Press, Working Paper No. 1950, 2007).

<sup>147</sup> YouTube, Content Verification Program, [http://www.youtube.com/t/copyright\\_program](http://www.youtube.com/t/copyright_program) (last visited Jan. 13, 2008).



for sites such as YouTube and Google, "basically consist of taking down copyright-infringing clips it discovers or is told about."<sup>148</sup>

Furthermore, some service providers have already been implementing software technology to detect infringing material. For instance, Google and YouTube announced in September of 2006 that, in addition to its stated policy against alleged copyright violations,<sup>149</sup> it would also adopt technology that would allow it to "fingerprint" and block copyrighted videos and other materials.<sup>150</sup> Audible Magic, the California-based startup company that offers the fingerprinting technology, "claims that [the technology] can scan video clips for signature vectors to compare with vectors stored in a database."<sup>151</sup> This fingerprinting technology is evidently able to "find and remove videos based on audio music or soundtrack fingerprints embedded in files provided by media companies, while disallowing users from re-uploading the files in a different format."<sup>152</sup> The database of copyrighted video "fingerprints" would match these "fingerprints" against uploaded clips to screen out those appearing to be copyrighted.<sup>153</sup> The new technology enables Google and YouTube to "automatically spot copyrighted material that users upload without the permission of media companies."<sup>154</sup> It would not be a drastic leap to require that all similarly situated service providers also implement this type of technology.

## 2. Given the Nature of the Notification, the Service Provider Should Respond Appropriately and Within a Reasonable Amount of Time

The second prong of the test specifies that courts should consider how the nature of the notification may affect the response time by the service provider. The Senate and House reports both acknowledged that different factual circumstances may merit different response times by service providers.<sup>155</sup> The second prong attempts to give effect to these congressional considerations by cabinining them into a focused framework of analysis. Certain variables should be taken into account, such as whether the service

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<sup>148</sup> Fred J. Aun, *Filtering Software Makes YouTube Copyright Cop*, E-COM. TIMES, July 30, 2007, <http://www.ecommercetimes.com/story/58570.html?welcome=1200257210&welcome=1200259145>.

<sup>149</sup> Section 5(D) of YouTube's *Terms of Service* and *Copyright Info* outlines the elements needed for proper notification, which follow the requirements provided for in 17 U.S.C. § 512(c)(3).

<sup>150</sup> Stone & Helft, *supra* note 134.

<sup>151</sup> Kim, *supra* note 4, at 146.

<sup>152</sup> *Id.*

<sup>153</sup> Aun, *supra* note 148.

<sup>154</sup> Breen, *supra* note 146, at 9 (quoting Kevin J. Delaney & Ethan Smith, *YouTube Model is Compromise Over Copyrights*, WALL ST. J., Sept. 19, 2006, at B1).

<sup>155</sup> See generally S. REP. NO. 105-190 (1998).

provider had to consult with an attorney about the notification; whether the notification was for material that the service provider was already made aware of and known to be infringing, which it could remove without consulting legal counsel; and the adequacy of the notification. While each case will still have to be determined based on its individual facts, at least courts and parties to the dispute will have a more uniform list of elements to consider when making a determination or legal argument.

In general, when courts have evaluated the promptness of a service provider's response, they have considered the factual circumstances of that particular case. The problem arises when different courts implement different standards to satisfy the requirements of the safe harbor provision. This variance between court decisions is exemplified in the Fourth and Ninth Circuits' differing interpretations of "substantial compliance" in § 512(c)(3)'s notification provisions. As discussed above, the Fourth Circuit's decision in *CLS Scan* required only information of the allegedly infringing content's location. Comparatively, the Ninth Circuit's decision in *Perfect 10, Inc. v. CCBill LLC* found that the copyright owners' notifications to the service provider were inadequate because, "taken individually, Perfect 10's communications do not substantially comply with [all] the requirements" of § 512(c)(3).<sup>156</sup> Further, "each communication contain[ed] more than mere technical errors; often one or more of the required elements are entirely absent."<sup>157</sup> In *CCBill's* case, the service provider did not have to respond until the copyright owner's notices substantially complied with § 512(c)(3). A service provider's expectations of what it must do to qualify for safe harbor under § 512 is a relevant factor that courts should take into account when assessing the timeliness of a service provider's response, at least until jurisprudence becomes more consistent.

Once a service provider has received the proper notification, there are still other elements to take into account. A service provider should not necessarily be required to remove the allegedly infringing material immediately or else be deemed to have failed to respond expeditiously. There may be other factors that result

<sup>156</sup> *Perfect 10, Inc. v. CCBill LLC*, 488 F.3d at 1112.

<sup>157</sup> *Id.*; *Perfect 10* argues that it satisfied the requirements of § 512(c)(3) through a combination of three sets of documents. The first set was sent on October 16, 2002 and consisted of a 22,185 page bates-numbered document of photographs containing pictures with URLs of Perfect 10's models allegedly posted on defendants' websites. The documents did not satisfy § 512(c)(3)(A)(vi) because they did not contain a statement under penalty of perjury that the complaining party was authorized to act. The second set of documents, emailed on July 14, 2003, also did not contain a sworn statement, and consisted of a spreadsheet identifying the same pictures of models already identified. The third set of documents was sent on December 2, 2003 and contained interrogatory responses by Perfect 10 that were signed under penalty of perjury. These last interrogatory responses incorporated the July 14, 2003 spreadsheet by reference. *Id.*

in further delay of removal that a court should consider, such as how quickly the ISP can analyze the material or how much traffic the website may be receiving. These factors may be more properly considered under the third prong of the test that takes into account the degree of the burden placed upon the service provider to remove the allegedly infringing material.

### 3. Service Providers do not Suffer an Undue Burden of Resources or in the Time Frame of the Response

The third prong undertakes a totality of the circumstances approach and assesses the burden of costs and resources imposed on the service provider *vis-a-vis* its response time. An "undue burden standard" is a pervasive concept in the legal field. In general, factors considered in determining the existence of undue burden would include: the nature and cost of the action needed; the overall financial resources of the ISP; the number of persons employed who are able to monitor and respond to takedown notifications; the effect on the service provider's expenses and resources; and, if applicable, the effect on the overall financial resources of the parent corporation or entity.<sup>158</sup> In other contexts, courts have defined undue hardship as having "the purpose or effect of placing a substantial obstacle in the path" of an individual.<sup>159</sup>

Certain factors may hinder a service provider from responding sooner than it has done so without the service provider suffering undue hardship. For instance, the amount of traffic that the service provider receives must be taken into account. Large service providers receive hundreds of thousands or millions of visits a day from Internet users. With highly trafficked websites, like Google, Amazon.com, or YouTube,<sup>160</sup> it may take a service provider longer to respond to all of the copyright infringement notifica-

<sup>158</sup> The factors listed have been drawn from a variety of sources primarily discussing the Americans With Disabilities Act. See, e.g., Golden, Nina, *Access This: Why Institutions of Higher Education Must Provide Access to the Internet to Students with Disabilities*, 10 VAND. J. ENT. L. & TECH. L. 363, 382 (2008) (discussing factors "to determine when an action would be readily achievable, which by definition is the opposite of an undue burden").

<sup>159</sup> *Planned Parenthood of Se. Pa. v. Casey*, 505 U.S. 833, 877 (1992).

<sup>160</sup> See, e.g., Kim, *supra* note 4, at 140 ("In July 2006, more than sixty-three million people (age fifteen and up) worldwide visited [YouTube] . . . During the same period, it streamed a daily average of ninety-six million videos worldwide, with twenty-one million videos in the United States."). By the time Google acquired YouTube in October of 2006 for \$1.65 billion in stock, YouTube was streaming over 100 million videos per day. *Id.* In January 2007, YouTube controlled an incredible 43.3% share of the online video market and was ranked twelfth overall in domain traffic. Jason Lee Miller, *YouTube Gives MySpace, TV Networks a Thumpin'*, WEBPRONNEWS, Feb. 28, 2007, <http://www.webpronews.com/topnews/2007/02/28/youtube-gives-myspace-tv-networks-a-thumpin>. Google serves more than 59 million unique visitors each month and performs more than one-third of all searches worldwide – more than 200 million per day. "Google, the #1 U.S. search engine, is growing fast, having gained 27 million unique global visitors in just a year." Nielsen NetRatings, available at <http://www.google.com/ads/indepth.html> (last visited Feb. 7, 2008).

tions it than it would for a comparatively smaller service provider. This circumstance must, of course, be weighed against the likelihood that a website hosting tremendous traffic may also risk exposing copyright infringing work on a larger scale. In this situation, a sizeable amount of damage can be done to a copyright owner within a matter of minutes. Another issue may be the size of the employee staff – a service provider may not be able to increase the amount of employees responsible for overseeing the receipt of takedown notices. A service provider's response time may be limited by sheer access to human capital. Based on the totality of the circumstances, if a service provider can demonstrate that operating the most current detection software technology would be an undue burden, or that due to the amount of traffic its website receives responding more promptly than it did constituted excessive hardship, then a service provider should not be deemed to have failed to respond expeditiously.

After taking into account the totality of the circumstances, courts should balance the efficiency of the available detection software and mechanisms service providers have for removing the copyrighted material with the nature of interactive web applications. Courts should consider factors such as whether the content posted continuously, rapidly and in large volume. Additionally, courts should also weigh the legitimate rights of users who have posted copyrighted material with fair use concerns and freedom of expression. One of the main controversies in the YouTube lawsuits<sup>161</sup> revolves around the question of whether the service provider, once notified, is now responsible for wherever and whenever the infringing content is posted. If the ISP cannot track the violations with the most up-to-date software, or if tracking every violation as quickly as possible is virtually impossible, or if it is unduly burdensome to do so, then the failure of a service provider to conduct such monitoring should not constitute a failure to expeditiously respond.

Achieving a balance between the competing interests of copyright owners and service providers can be undermined by placing too high a demand on the adequacy of a service provider's response time. It is important to be careful and not make the requirements so stringent that a service provider's sole option is to respond by immediately removing all allegedly infringing content. A chilling effect could ensue as service providers automatically respond to all notifications, regardless of their adequacy or veracity, in order to avoid costly litigation.<sup>162</sup> Perhaps, arguably, this chill-

<sup>161</sup> See, e.g., Complaint, *supra* note 13, at 5; Complaint and Answer, *supra* note 9.

<sup>162</sup> Symposium, *Panel III: Fair Use: Its Application, Limitations and Future*, 17 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1017, 1028 (2007) (discussing how copyright and intel-

ing effect is already occurring. A recent study conducted by the Chilling Effects Clearinghouse “traced the use of the Section 512 takedown process and considered how the usage patterns” found appeared to likely “affect expression or other activities on the Internet.”<sup>163</sup> In addition, the study also conducted an analysis of the “surprisingly high incidence of flawed takedowns.”<sup>164</sup> Along with other findings, the study found “some interesting patterns” of questionable claims by copyright owners, including the observation that more than one-half (57%) of notices sent to Google “to demand removal of links in the index were sent by businesses targeting apparent competitors.”<sup>165</sup> In order to avoid these negative repercussions, courts should take into account the expectations and extent of the burden placed on the ISP to remove allegedly infringing content as *expeditiously* as possible.

#### B. *Reasonableness Test as Applied to Perfect 10, Inc. v. Amazon.com*

This three-pronged reasonableness test can be applied to the *Perfect 10, Inc. v. Amazon.com* case, which the Court of Appeals for the Ninth Circuit remanded to determine the adequacy of the alleged infringement notifications from Perfect10 to Amazon.com and Google, and whether Google and Amazon.com responded expeditiously. Applying the suggested guidelines to that case demonstrates the effectiveness of this three-pronged approach; at the very least, it makes evident the value of implementing more specific guidelines.

##### 1. Do Google and Amazon.com Have the Most Up-to-Date Technology That Will Enable Them to Respond as Promptly as Possible Under the Given Circumstances?

The first question inquires whether Google and Amazon.com have software in place that enables them to track images indexed by their search engines. Further, if they do, is that software the most up-to-date software readily available in the industry? If they had the most up-to-date detection software available in the industry, then that factor would support that Google did all in its power

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lectual property disputes are increasingly being mediated informally and rapidly with cease and desist letters, pursuant to § 512(c)(3) notification procedures. “From First Amendment perspectives” this process appears to effectively be “a prior restraint with no judicial review.”)

<sup>163</sup> Jennifer M. Urban & Laura Quilter, Summary Report, *Efficient Process or “Chilling Effects”? Takedown Notices Under Section 512 of the Digital Millennium Copyright Act*, SANTA CLARA COMPUTER & HIGH TECH. L.J. (2006), available at <http://mylaw.usc.edu/documents/512Rep/> (observing, among other findings, that thirty percent of notices demanding takedown constituted claims presenting an obvious question for a court, and that one out of eleven notices included significant statutory flaws rendering the notice unusable).

<sup>164</sup> *Id.*

<sup>165</sup> *Id.*

to respond in a timely manner. On the other hand, if the court finds that Google did not operate the most current detection software and that this software would have made the retrieval or removal process of copyrighted materials faster, then Google's response arguably has not passed muster. This requirement would provide a more standardized time frame or relatively well-defined window in which Google is able to respond. Thus, if Google did not respond within that window of time, there is a rebuttable presumption that the response was not "expeditious." Since this requirement is not yet in effect, it is difficult to presume that Google did not adequately respond. Yet, if this requirement was in effect, then this clearly defined standard would be helpful in determining Google's efforts in responding to P10.

## 2. Given the Nature of the Notification, Was the Amount of Time Taken to Respond Reasonable?

While the *Perfect 10, Inc. v. Amazon.com* case presents a very fact-specific analysis of whether Google responded in a timely manner, the second prong of the reasonableness test provides a general framework with which to assess the totality of the circumstances. Certain considerations should be taken into account, such as if Perfect 10's notifications required the advice of legal counsel, if notification was inadequate, and if Google promptly informed Perfect 10 of the inaccuracies. Perfect 10 claims that, beginning in May of 2004, "P10 sent Google 37 detailed notices of infringement, covering more than 7,000 infringing URLs."<sup>166</sup> P10 asserts that its notices complied with DMCA takedown requirements under § 512(c)(3)(A)(d).<sup>167</sup> Despite its notices, P10 alleged that Google continued to display some images for over 400 days after notice and that "even after P10 provided to Google" numerous infringing images in hard copy form, "Google continued to display virtually all of them."<sup>168</sup> Further, as P10 argues, Google "failed to expeditiously remove infringing links from its Web Search results after notice."<sup>169</sup> Google responds that Perfect 10's notices "did not comply with the notice provisions of section 512 and were not adequate to inform Google of the location of the infringing images on the Internet or identify the underlying copyrighted work."<sup>170</sup> Google also argues that it "responded to all notices it received by investigating the webpages identified by Perfect 10 and suppressing links to any webpages that Google confirmed

<sup>166</sup> Brief on Cross Appeal of Plaintiff-Appellant-Cross-Appellee at 11, *Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d 701 (9th Cir. 2007) (No. 06-55406).

<sup>167</sup> *Id.*

<sup>168</sup> *Id.*

<sup>169</sup> *Id.*

<sup>170</sup> *Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d at 732.

were infringing.”<sup>171</sup>

In this case, Google contends that P10’s notifications had errors and were incomplete.<sup>172</sup> While acknowledging that it received P10’s notices, Google argues “that those notices frequently did not describe in sufficient detail the specific location (URL) of an infringing image and frequently did not identify the underlying copyrighted work.”<sup>173</sup> Google asserts that despite the shortcomings of P10’s notifications, “it promptly processed all of the notices it received, suppressing links to specific webpages that it could confirm displaying infringing P10 photos.”<sup>174</sup>

If Google’s contentions are correct that the notices were inadequate, it would be reasonable that Google did not immediately remove the allegedly infringing content. However, if the findings of fact were different and the court found that the notifications were proper, and Google failed to remove the content upon being notified, then, arguably, the outcome would be altered as Google would have disregarded its duty of expeditiously responding. If, under other circumstances, Google had already been properly notified of the infringing content and had already established that the material was a violation of copyrighted material, then, presumably, an expeditious response could be an immediate one, and a response that took, for instance, 400 days could presumably be deemed *not* expeditious. Of course, these determinations are to be decided by the fact-finder. The second-prong of the test provides a more standardized list of elements than what is currently in place. Having this list will make the analysis easier for the court, and the parties will be more attuned to the evidence they must demonstrate to prove their case.

### 3. Based on the Totality of the Circumstances, Would a More Prompt Response Present an Undue Burden to Google or Amazon.com?

In an effort to balance a service provider’s interests with those of a copyright owner, the third prong of the reasonableness test ensures that the obligations imposed on the service provider do not exceed its resources or capabilities. In this case, if the court finds that Google satisfied the first two prongs of the reasonableness test, and that any of Google’s further efforts such as employing more staff to monitor and track infringing material would be

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<sup>171</sup> *Id.*

<sup>172</sup> See generally *id.*

<sup>173</sup> *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d at 854 (“[S]ome notices included invalid, truncated URLs with an ellipsis between the domain name of the website and the file name of the particular webpage on which that image appeared. Other notices listed entire websites as infringing, or entire directories within a website.”).

<sup>174</sup> *Id.*

too onerous to implement, then Google's response should be deemed *expeditious*.

Google is a very large service provider with tremendous resources. Currently, Google claims to have a market capitalization of \$108.80 billion and approximately 17,000 employees.<sup>175</sup> Its overall financial resources could sustain the most current detection software technology and its large employment staff can conceivably oversee a high flow of incoming notification. Furthermore, considering that Google is in the business of hosting websites and its inherent profit motive relies on the successful functioning of its online operations with its large, technically savvy employment staff, it should be able to maintain software that could expedite its responses to copyright owners.

On the other hand, given the tremendous traffic that Google receives on a daily basis and the millions of users it hosts each day, there is the chance that Google could excessively expend its resources by responding to countless false leads. If this were the case, the court could find that it would be too burdensome for Google to respond to Perfect 10's notifications immediately. In addition, if the cost of the most up-to-date detection software exceeds Google's funds, then Google should not be required to maintain it at the expense of its sustainability. Overall, although it may be practically impossible for Google to remove or catch all copyrighted material on its website, it is not an undue hardship for Google to utilize its sizeable financial and human resources to maintain up-to-date detection software and to engage its staff in responding as promptly as reasonably possible to P10's notifications.

#### CONCLUSION

The DMCA attempts to find a virtual golden mean between the interests of copyright owners in protecting their own creative works and the equally important interests of service providers in facilitating the transmission of information and freedom of expression. However, despite the drafters' best efforts, inherent ambiguities present in certain provisions of the DMCA safe harbor provision have resulted in conflicting jurisprudence and uncertainty in litigation. As other aspects of the DMCA safe harbor provision have been heavily litigated, the timeliness of a service provider's response has remained in the shadows of the judicial system. Yet, this is changing, partly due to changing forms of Internet applications such as Web 2.0 and peer-to-peer and file-

<sup>175</sup> Yahoo! Finance, available at <http://finance.yahoo.com/q?s=goog> (last visited Oct. 7, 2008) (Market Capitalization equals the Share Price multiplied by the Shares Outstanding).



sharing networks, and partly because the expeditiousness of a service provider's response is one of the last frontiers of the DMCA where parties can attempt to establish precedent in their favor.

In order to create greater uniformity amongst courts and ensure more predictable outcomes, what constitutes expeditious should be more precisely defined. One manner of achieving a more workable standard is through engaging in the three-part reasonableness test discussed above. This three-pronged approach will provide more specific guidelines to make it easier for courts and parties to determine the adequacy of a service provider's response. As a result, it would facilitate greater consistency between court decisions and more predictable outcomes. Even if this three-pronged approach is not embraced, the need for a more workable standard of evaluating the timeliness of responses to takedown notifications would better effectuate Congress' stated goals.

*Debra Weinstein\**

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