

# Freedom of Speech and the DMCA: Abuse of the Notification and Takedown Process

**Stephen McLeod Blythe\***  
University of Strathclyde, Glasgow

© Copyright; Digital technology; Freedom of expression; Internet service providers; Notification; Online infringement; United States

*The Digital Millennium Copyright Act's "notice and takedown" process is increasingly referred to as a model solution for content removal mechanisms worldwide. While it has emerged as a process capable of producing relatively consistent results, it also has significant problems—and is left open to different kinds of abuse. It is important to recognise these issues in order to ensure that they are not repeated in future legislation. To that end, this article examines the DMCA with reference to its historical context, and the general issues surrounding the enforcement of copyright infringement claims. It then goes on to discuss the notice and takedown process in detail—along with its advantages, disadvantages, criticisms and praise. Specific examples of the kinds of abuse reported by online service providers are outlined, along with explanations of the statutory construction that allows these situations to continue. To finish, the viability of potential alternatives and proposed changes are discussed.*

## Introduction

The Internet that we know today is a vastly different place from the Internet of 20 years ago. The famous claim that “legal concepts of property, expression, identity, movement, and context do not apply to us [online]”,<sup>1</sup> made by John Perry Barlow in the Declaration of the Independence of Cyberspace, in retrospect now seems alien, and perhaps even naive.

After two decades of exponential growth, the mysterious “World Wide Web” of yesteryear has now become firmly established as an essential network of global significance, and has thus been substantially co-opted into international legal frameworks. It is the standard medium, not just for everyday social interactions, but also as a powerful commercial business tool, opening up a “vast new area of expression and global communication”.<sup>2</sup> The immediate nature of online interactions has resulted in the varying technologies of the web credited with playing a major role in contemporary political events,<sup>3</sup> including the support of political revolution, and even the ultimate overthrow of governments.<sup>4</sup>

The rapid growth of the online space has brought with it a dizzying “kaleidoscope of changes”,<sup>5</sup> as well as a myriad of questions about our relationship to, and understanding of, intellectual property. Technological advances have allowed for innumerable digital copies of copyright protected materials to be produced and shared all over the world with little to no distribution costs. As a result, the Internet has become “a major source for the dissemination of intellectual property”.<sup>6</sup> There are now multiple actors responsible for different levels of enforcement online, rather than any single authority that copyright holders can look to for assistance with infringement claims.<sup>7</sup> Thus, the challenge of how to deal with the new technological landscape is one that both commercial organisations and legislators alike have had to confront, and it is not something that they have always managed to do particularly well.

This article explores the challenges faced by intellectual property holders, with a specific focus on one of the most significant tools used to combat copyright infringement: the Digital Millennium Copyright Act.<sup>8</sup> Despite the significant benefits for all parties concerned brought about by the DMCA, it has many critics, and is far from perfect. The statutory procedures are by their nature left open to abuse, and despite lying at the very heart of the Internet’s development, the issue of how to effectively tackle copyright infringement online remains, to this day, one of the most challenging to address.

\* LLB (Hons) (University of Glasgow), LLM, Internet Law & Policy (University of Strathclyde). E-Commerce and Privacy LLM Course Co-Ordinator (University of Strathclyde). Community Guardian (Automatic).

<sup>1</sup> J. Barlow, “Declaration of the Independence of Cyberspace” (2016), <https://www.eff.org/cyberspace-independence> [Accessed 14 December 2018].

<sup>2</sup> N. Netanel, *Copyright's Paradox: Property in Expression/Freedom of Expression* (Oxford: 2008), Google Play ebook edition, pp.5, 87.

<sup>3</sup> See the discussion of social media’s role on the 2011 English riots: S.A. Baker, “From the criminal crowd to the ‘mediated crowd’: the impact of social media on the 2011 English riots” (2012) 11 *Safer Communities* 1.

<sup>4</sup> S. Harlow and T.J. Johnson, “Overthrowing the Protest Paradigm? How the New York Times, Global Voices and Twitter Covered the Egyptian Revolution” (2011) 5 *International Journal of Communication* 1359.

<sup>5</sup> J. Sundell, “Tempting the Sword of Damocles: Reimagining the Copyright/DMCA Framework in a UGC World” (2011) 12 *Minn. Journal of Law, Science, and Technology* 335.

<sup>6</sup> Y. Tian, “Problems of Anti-Circumvention Rules in the DMCA & More Heterogeneous Solutions” (2005) 15 *Fordham Intellectual Property, Media and Entertainment Law Journal* 749, 750.

<sup>7</sup> B. Farrand, “Regulatory Capitalism, Decentered Enforcement, and its Legal Consequences for Digital Expression: The Use of Copyright Law to Restrict Freedom of Speech Online” (2013) 10 *Journal of Information Technology & Politics* 408, para.4.

<sup>8</sup> Herein DMCA.

## Intellectual property, the Internet, and freedom of speech

In the United States, copyright holders have a variety of rights conferred upon them under 17 USC §106 including the exclusive rights to reproduction,<sup>9</sup> the preparation and distribution of both copies<sup>10</sup> and “derivative works”,<sup>11</sup> as well as the public performance<sup>12</sup> and display of those works.<sup>13</sup>

From one perspective, copyright may be seen as the ultimate enemy of free speech, restricting the open transfer of common human knowledge and experience in order to protect the self-interest of the few. Taking this view, the Internet can therefore only reach its “free speech potential” if the enforcement of copyright has no place online.<sup>14</sup> To others, copyright law is the very “engine of free expression”,<sup>15</sup> with its core purpose to “promote the creation and publication of free expression”.<sup>16</sup> In other words, copyright is the mechanism by which content creators can safeguard commercial return on their efforts, thus incentivising the creation of new works in the first place.

Irrespective of the natural division between these two perspectives, it would appear self-evident that a “strong copyright system” also comes at a cost to the rights of others.<sup>17</sup> One cannot restrict the dissemination of material to particular actors without impacting on the freedom of another to make use of that same material. As a consequence, critics have argued that there has been a “denial of the relevance of free speech considerations” in relation to current copyright law.<sup>18</sup> Not all share this perspective of course, with some claiming that copyright is really only concerned with the protection of commercial interests in “trivial entertainment products”,<sup>19</sup> and as such poses no threat to genuine freedom of expression.

Irrespective of the view that one takes on the ideological clash between copyright holders and proponents of greater freedom of speech provisions, the dynamic introduced by the development of the Internet to the different actors involved in the creation, use, and dissemination of copyrighted content “adds a vast new dimension”<sup>20</sup> to the inherent tension between copyright and free speech. Now, we see courts being asked to apply

the basic principles of copyright “to circumstances that traditional copyright doctrine did not anticipate”<sup>21</sup>—something that arguably extends far beyond its application to “trivial entertainment products”.

## The DMCA

Congress enacted the DMCA in 1998 in order to confront some of the growing challenges being faced by the rapid technological development of the time. During this process, the House Committee on Commerce noted that the main goal of the legislation was to promote the growth of a digital economy, and to do so while respecting the rights of intellectual property holders.<sup>22</sup> In other words, the DMCA was designed to “serve several masters”,<sup>23</sup> with the law architected carefully in an attempt to “satisfy both sides”<sup>24</sup> of the issue: copyright holders, and operators of online platforms. The primary focus of this paper is the DMCA’s “notification and takedown” mechanism, contained within §512.

## Safe harbour

The DMCA provides certain categories of online service providers with a “safe harbour”<sup>25</sup> from liability for the infringing actions of their users, provided they comply with some specific requirements. These include adhering to the notification and takedown process, the details of which will be outlined in a following section. The safe harbour protection came about as the result of an understanding of the increasing potential for service providers to face litigation from copyright holders for the activities taking place on their platforms,<sup>26</sup> and also out of concern about the potential negative impact this would have on economic development in the emerging technological era. The resulting compromise left the responsibility for tracking down instances of unauthorised use of their intellectual property with the right holders themselves, rather than with the host of the content.<sup>27</sup> In other words, the DMCA did not impose an obligation on service providers to proactively hunt down allegedly infringing content.

<sup>9</sup> 17 USC §106(1).

<sup>10</sup> 17 USC §106(3).

<sup>11</sup> 17 USC §106(2).

<sup>12</sup> 17 USC §106(4) and (6).

<sup>13</sup> 17 USC §106(5).

<sup>14</sup> Netanel, *Copyright's Paradox* (2008), p.2, para.3.

<sup>15</sup> *Harper & Row, Publishers Inc v Nation Enterprises Inc* 471 U.S. 539 (1985).

<sup>16</sup> *Eldred v Ashcroft* 537 U.S. 186 (2003), p.34 para.2.

<sup>17</sup> Michael D. Birnhack, *Tel Aviv University Law Faculty Papers* (2008), Paper 56. p.1280 para.2, <http://law.bepress.com/taulwps/art56/> [Accessed 18 December 2018]

<sup>18</sup> See above, p.1281, para.1.

<sup>19</sup> Netanel, *Copyright's Paradox* (2008), p.27, para.1.

<sup>20</sup> Netanel, *Copyright's Paradox* (2008), p.22, para.2.

<sup>21</sup> Netanel, *Copyright's Paradox* (2008), p.70.

<sup>22</sup> Report of the House Committee on Commerce, H.R. Rep. No.105-551, Pt 2, pp.22–23 (1998).

<sup>23</sup> David Nimmer, “A Riff on Fair Use in the Digital Millennium Copyright Act” (2000) 148 *University of Pennsylvania Law Review*, p.703 para.1

<sup>24</sup> A. Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 *Berkeley Technology Law Journal*, p.411, para.3.

<sup>25</sup> While the DMCA refers to a “safe harbor”, for the purposes of this article I will be using the UK English spelling of “harbour” unless quoting.

<sup>26</sup> A. Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 *Berkeley Technology Law Journal*, para.1.

<sup>27</sup> A. Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 *Berkeley Technology Law Journal*, p.412, para.2.

In order to qualify for safe harbour, online service providers must register a “designated agent” to act as the recipient of copyright takedown notifications.<sup>28</sup> Their name, address, phone number, and email address must be made available publicly, including on the organisation’s website.<sup>29</sup> It must also be registered with the US Copyright Office,<sup>30</sup> which had over 66,000 designated agents listed as of February 2015.<sup>31</sup> As of December 2016, registrations must be submitted electronically, and all prior registrations had to be updated by 31 December 2017.<sup>32</sup> This change led to concerns that many site operators would unwittingly lose their safe harbour protections.<sup>33</sup>

In addition to removing infringing content upon receipt of a valid takedown notification, an online service provider is also required to adopt a policy to suspend or otherwise terminate the accounts of “repeat infringers”.<sup>34</sup> The specifics of the implementation are left up to the service provider, but this does not give them unlimited discretion. This point was illustrated in the case of *Disney v Hotfile*,<sup>35</sup> where the lack of an effectively implemented policy was central to the eventual loss of the file sharing service’s safe harbour. In the words of the court,

“while the statute does not require Hotfile to maintain a perfect policy ... it is apparent that Hotfile effectively did nothing to tie notices to repeat infringers.”<sup>36</sup>

Instead, they relied on their own judgment, only suspending the accounts of 43 users out of over 8 million takedown notifications.<sup>37</sup> A combination of this inaction, coupled with “the scale of the [infringing] activity” that was occurring on their platform, meant that they did not meet the requirements to qualify for safe harbour under the DMCA.

Another requirement is that service providers must not have either actual knowledge of infringing material on their platform, or circumstances that they could reasonably infer that infringing activity was taking place, known as “red flag” knowledge.<sup>38</sup> The case of *Viacom v*

*YouTube*<sup>39</sup> brought about an important test of the safe harbour protections in this regard, with Viacom suing the popular video sharing platform’s operators, contending that they were liable for both direct and contributory copyright infringement.<sup>40</sup> The initial summary judgement went in YouTube’s favour, with the court recognising their right to safe harbour as an intermediary under the DMCA.<sup>41</sup> After this judgment, the liability of service providers with regard to the red flag test has been reduced to the extent that it has been said there would need to be an “immense, crimson banner” before it would trigger a further obligation on them to investigate.<sup>42</sup>

### *Notification and takedown process*

The notification and takedown process is central to the operation of the DMCA, and provides one of the key compromises between the competing interests of the interested parties. It aimed to achieve this by establishing a standard process to have infringing material efficiently removed from the Internet, without the need to have a court intervene in the first instance.<sup>43</sup>

Notification and takedown itself involves a number of different parts, in a procedure that has been compared to a “complicated game of tennis”.<sup>44</sup> First, the complainant must submit a “takedown notification” to the host of the content that conforms to the formal requirements set out in the DMCA. In order to be considered valid, it must contain six specific elements.

These are:

- A signature of someone authorised to act on behalf of the copyright holder (either physical or electronic).<sup>45</sup>
- An identification of the copyrighted works that are allegedly being infringed.<sup>46</sup>
- An identification of where the infringing material is located.<sup>47</sup>
- Information to allow the service provider to contact the complainant (such as name, address, telephone number, email address).<sup>48</sup>

<sup>28</sup> 17 USC §512(e)(2).

<sup>29</sup> 17 USC §512(e)(2).

<sup>30</sup> 17 USC §512(e)(2).

<sup>31</sup> See [http://www.copyright.gov/onlinesp/list/a\\_agents.htm](http://www.copyright.gov/onlinesp/list/a_agents.htm) [Last accessed 28 February 2014].

<sup>32</sup> 37 CFR §201.38.

<sup>33</sup> E. Harmon, “Copyright Office Sets Trap for Unwary Website Owners” (1 November 2016), <https://www.eff.org/deeplinks/2016/11/copyright-office-sets-trap-unwary-website-owners> [Accessed 14 December 2018].

<sup>34</sup> 17 USC §512(i)(1)(A).

<sup>35</sup> Case No.11-20427-CIV-WILLIAMS, <http://digitalcommons.law.scu.edu/cgi/viewcontent.cgi?article=1588&context=historical> [Accessed 14 December 2018].

<sup>36</sup> Case No.11-20427-CIV-WILLIAMS, p.44, para.2.

<sup>37</sup> Case No.11-20427-CIV-WILLIAMS, p.44, paras 2–4.

<sup>38</sup> Sundell, “Tempting the Sword of Damocles” (2011) 12 Minn. Journal of Law, Science, and Technology 335, 345, para.1.

<sup>39</sup> No. 07 Civ. 2103.

<sup>40</sup> Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 Berkeley Technology Law Journal, p.422, para.1.

<sup>41</sup> Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 Berkeley Technology Law Journal, p.406, para.3.

<sup>42</sup> Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 Berkeley Technology Law Journal, p.417, para.1.

<sup>43</sup> J. Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure: Misuses, Abuses, and Shortcomings of the Process” (2009) 10 Minn. Journal of Law, Science, and Technology 387, 388, para.1.

<sup>44</sup> B. Boyden, “The Failure of the DMCA Notice and Takedown System: A Twentieth Century Solution to a Twenty-First Century Problem”, Center for the Protection of Intellectual Property, George Mason University School of Law (2013).

<sup>45</sup> 17 USC §512(e)(i).

<sup>46</sup> 17 USC §512(e)(ii).

<sup>47</sup> 17 USC §512(e)(iii).

<sup>48</sup> 17 USC §512(e)(iv).

- A “good faith belief” that the material’s use is not authorised by the copyright owner, agent or the law.<sup>49</sup>
- A statement that the notification is “accurate, and under penalty of perjury, that the complaining party is authorized to act on behalf of” the copyright holder.<sup>50</sup>

There are also a number of additional qualifications regarding the requirements, where the wording leaves room for interpretation. For example, §512(c)(i) requires that the signature of the authorised party be from a “person”, whereas the other clauses talk about the complaining “party”. If drafted intentionally, then this distinction suggests that while rights can be owned by an organisation, the notification must be signed by an individual acting on their behalf. Interestingly enough, there is no requirement that the person be named at all anywhere else in the takedown notification, outside of the signature. As the statute itself is unclear on this point, it raises the question of how online service providers are supposed to identify whether an illegible (and therefore non-electronic) signature is indeed of a person, and if a notice may be safely rejected as invalid if there is doubt.

In §512(c)(iv), the DMCA specifies that the complaining party must provide information that is “reasonably sufficient” for the service provider to be able to contact them. This includes a telephone number, address, or email address—but it does not state that all of these are required, or indeed that any more than one piece of information needs to be supplied. As a result, it would seem that a takedown notification that only included an email address would be valid.

Another requirement of the notification and takedown process is that the service provider must “remove or disable access to” the material that is identified by a complainant as infringing. While *prima facie* this obligation may seem clear, the specifics of to what extent material should be removed are unclear. In other words, there is no guidance to be found in the statute on whether it is sufficient for material to simply be removed from public availability, or whether the user that uploaded the material in the first place should be refused access. Far from just a trivial matter of implementation, this question has significant implications depending on interpretation. If allegedly infringing material is left accessible to the original uploader, then they are then conceivably free to download and then re-distribute it on another platform. However, should access be removed completely, then the

user could find themselves locked out even in cases where content has been removed as the result of an abusive takedown notification, with no equitable recourse.

### *Counter notification process*

Upon being notified by a service provider that material they have uploaded has been removed as the result of a takedown notification, a user may challenge the takedown by submitting a “counter notification”. In order to be formally valid, it must contain the following:

- “A physical or electronic signature of the subscriber”.<sup>51</sup>
- An “identification of the material that has been removed” as the result of the DMCA takedown notification, and where it was located before access was disabled or removed.<sup>52</sup>
- “The subscriber’s name, address, and telephone number”.<sup>53</sup>
- “A statement under penalty of perjury that the subscriber has a good faith belief that the material was removed or disabled as a result of mistake or misidentification of the material to be removed or disabled”.<sup>54</sup>
- “A statement that the subscriber consents to the jurisdiction of Federal District Court for the judicial district in which the address is located, or if the subscriber’s address is outside of the United States, for any judicial district in which the service provider may be found”.<sup>55</sup>
- A statement that “the subscriber will accept service of process from the person [who submitted the takedown notification]” or their agent.<sup>56</sup>

Upon receipt of a valid counter notification, the service provider is to then forward it on to the complainant.<sup>57</sup> If they do not receive notice that legal proceedings have then begun regarding the complaint, then they are to restore access to the material between 10 and 14 business.<sup>58</sup> Providers are not obliged to honour this process, or to restore access to material upon receipt of a valid response. Rather, doing so means that they cannot be held liable “for any claim based on the service provider’s good faith ... removal of material”.<sup>59</sup> In practical terms, platforms usually reserve the right to

<sup>49</sup> 17 USC §512(c)(v).

<sup>50</sup> 17 USC §512(c)(vi).

<sup>51</sup> 17 USC §512(g)(3)(A).

<sup>52</sup> 17 USC §512(g)(3)(B).

<sup>53</sup> 17 USC §512(g)(3)(C).

<sup>54</sup> 17 USC §512(g)(3)(D).

<sup>55</sup> 17 USC §512(g)(3)(D).

<sup>56</sup> 17 USC §512(g)(3)(D).

<sup>57</sup> 17 USC §512(g)(2)(B).

<sup>58</sup> 17 USC §512(g)(2)(C).

<sup>59</sup> 17 USC §512(g)(1).

terminate accounts or content at any time as part of their Terms of Service,<sup>60</sup> rendering the likelihood of any successful action questionable.

### Fair use and the DMCA

Not all unauthorised use of copyrighted material is considered infringing under US law, with the “fair use doctrine” allowing for exceptions.<sup>61</sup> This acts as “an affirmative defence to a copyright infringement accusation”.<sup>62</sup> In other words, it “affords a privilege to make what would otherwise be an infringing use of copyrighted expression”.<sup>63</sup> The Supreme Court has described fair use as part of the “built-in” protections for freedom of speech that exists in copyright law,<sup>64</sup> and in *Campbell v Acuff-Rose Music*,<sup>65</sup> fair use opportunities were said to be “necessary to fulfil copyright’s very purpose”.<sup>66</sup> Put another way, fair use is seen as a “free speech safety valve”,<sup>67</sup> helping to reduce the tension between copyright and freedom of speech, and as a result, it is “part of the constitutional fabric of copyright law”.<sup>68</sup>

The fair use doctrine holds that the use of materials for specific purposes, such as “criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research”, will not constitute an infringement of copyright, depending on the manner and context in which they were used.<sup>69</sup> There are four factors under US law that are to be taken into account when determining whether or not content falls under the fair use protections of 17 USC §107. These are “the purpose and character of the use”<sup>70</sup>; “the nature of the copyrighted work”<sup>71</sup>; “the amount and substantiality of the portion used in relation to the copyrighted work as a whole”<sup>72</sup>; and “the effect of the use upon the potential market for or value of the copyrighted work”.<sup>73</sup> Any fair

use adjudication will be based on a balance of the four above factors,<sup>74</sup> and therefore operate on a “case-by-case basis”.<sup>75</sup>

There are many examples where the use of material online that might otherwise have constituted infringing activity was judged to fall under fair use protections. These include a newspaper that used quotations of controversial “religious” texts for critical purposes<sup>76</sup>; members of an online forum who shared a short excerpt from a newspaper for discussion<sup>77</sup>; and the display of cached versions of websites in search results.<sup>78</sup>

The technology giant Google has built its success on a model that is “heavily reliant on the fair use doctrine”.<sup>79</sup> In the case of *Perfect 10 v Google*,<sup>80</sup> the Federal District Court rejected their argument that the use of thumbnails taken from websites in Google’s Image search was fair use.<sup>81</sup> If left to stand, this decision would clearly have had serious implications for the technology sector. However, it was reversed in the later case of *Perfect 10 v Amazon*,<sup>82</sup> where the Ninth Circuit found that the system involved was “highly transformative”,<sup>83</sup> and therefore fell under fair use protections. This decision was said to be “critical to the future of search engines”.<sup>84</sup>

One of the most significant judgments for the relationship between the DMCA and fair use came in *Lenz v Universal Music*,<sup>85</sup> also known as the “dancing baby” case. Having shared a home recording of her young son dancing to a Prince song on YouTube, the complainant, Stephanie Lenz, then found it had been removed soon after as the result of a takedown notification sent by the artist’s record label.<sup>86</sup> Lenz took legal action in response, and the court held that as fair use of material constitutes a “lawful use”,<sup>87</sup> copyright holders have a duty to take this into account before submitting a takedown notification.<sup>88</sup>

<sup>60</sup> See, for example, s.20 of Tumblr’s Terms of Service at <https://www.tumblr.com/policy/en/terms-of-service> [Accessed 14 December 2018].

<sup>61</sup> Sundell, “Tempting the Sword of Damocles” (2011) 12 *Minn. Journal of Law, Science, and Technology* 335, 342, para.2.

<sup>62</sup> A.C. Brannan, “Fair Use Doctrine and the Digital Millennium Copyright Act: Does Fair Use Exist on the Internet Under the DMCA?” (2001) 42 *Santa Clara Law Review* 247, para.3.

<sup>63</sup> Netanel, *Copyright’s Paradox* (2008), p.76.

<sup>64</sup> *Eldred v Ashcroft* 537 U.S. 186 (2003), p.29, para.2.

<sup>65</sup> *Campbell v Acuff-Rose Music* 510 U.S. 569 (1994).

<sup>66</sup> *Campbell v Acuff-Rose Music* 510 U.S. 569, 575 (1994) at para.1.

<sup>67</sup> Netanel, *Copyright’s Paradox* (2008), p.77.

<sup>68</sup> Band, “Google and Fair Use” (2008) 3 *Journal of Business and Technology Law* 1, 7, para.1.

<sup>69</sup> 17 USC §107.

<sup>70</sup> 17 USC §107 s.(1).

<sup>71</sup> 17 USC §107 s.(2).

<sup>72</sup> 17 USC §107 s.(3).

<sup>73</sup> 17 USC §107 s.(4).

<sup>74</sup> Brannan, “Fair Use Doctrine and the Digital Millennium Copyright Act” (2001) 42 *Santa Clara Law Review* 247, 252, para.7.

<sup>75</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 389 para.3.

<sup>76</sup> *Religious Technology Center v Lerma* 908 F. Supp. 1362, 1367 (E.D. Va. 1995).

<sup>77</sup> *Righthaven LLC v Democratic Underground*, No.2:10-cv-01356-RLH (GWF).

<sup>78</sup> *Field v Google Inc* 412 F. Supp. 2d 1106 (D. Nev. 2006).

<sup>79</sup> Band, “Google and Fair Use” (2008) 3 *Journal of Business and Technology Law* 1, para.1.

<sup>80</sup> *Perfect 10 Inc v Google* 416 F. Supp. 2d 828 (C.D. Cal. 2006).

<sup>81</sup> Band, “Google and Fair Use” (2008) 3 *Journal of Business and Technology Law* 1, 13, para.1.

<sup>82</sup> *Perfect 10, Inc. v Amazon.com, Inc.* 487 F.3d 701 (9th Circ. 2007).

<sup>83</sup> Band, “Google and Fair Use” (2008) 3 *Journal of Business and Technology Law* 1, 15, para.1.

<sup>84</sup> Band, “Google and Fair Use” (2008) 3 *Journal of Business and Technology Law* 1, 15, para.3.

<sup>85</sup> *Lenz v Universal Music* 572 F. Supp. 2d 1150 (N.D. Cal. 2008).

<sup>86</sup> Sundell, “Tempting the Sword of Damocles” (2011) 12 *Minn. Journal of Law, Science, and Technology* 335, 353, para.2.

<sup>87</sup> K. O’Donnell, “Lenz v. Universal Music Corp. and the Potential Effect of Fair Use Analysis Under the Takedown Procedures of §512 of the DMCA” (2009) 10 *Duke Law & Technology Review* 9, para.22, available at <https://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=1194&context=dltr> [Accessed 14 December 2018].

<sup>88</sup> See above.

## Benefits and criticisms of the DMCA

### *Benefits of the DMCA*

Aiming to find a workable legal compromise between a multitude of competing actors is a lofty goal, and it appears that, for all of its flaws, the DMCA has at least got something right. The notification and takedown process is now seen as the “go-to model” for dispute resolution, adopted in various forms in legal systems outside of the US.<sup>89</sup>

A well-structured copyright system is of benefit to society, both for freedom of speech, and the economy. A report in 2007 estimated that there was a loss of \$12.5 billion to the US economy every year from the piracy of sound recordings alone,<sup>90</sup> a loss of 71,060 jobs,<sup>91</sup> and that the various levels of the American Government were losing a “minimum of \$422 million in tax revenues annually”.<sup>92</sup>

Copyright is not just important to major industry groups, but is also “an integral part of our system of freedom of expression”.<sup>93</sup> The power to control the use of, and exploit, intellectual property supports artists, musicians, painters, writers and others to create new works in a sustainable manner. Copyright helps ensure that content creators are recognised for their contributions, as well as having the option to benefit financially from them. In addition, it also means that they retain the ability to prevent the use of works for purposes that are not compatible with the original intent, such as musicians refusing to allow their tracks to appear as part of political rallies, or in advertising.<sup>94</sup>

The ability to have infringing content removed quickly from the Internet in an age where multiple copies can be created in seconds is a must, and the DMCA provides a straightforward mechanism for this to take place, with online service providers tasked with removing infringing content “expeditiously” upon receipt of a valid takedown notification.<sup>95, 96</sup>

If we look solely at the volume of takedown requests issued by intellectual property holders to online service providers, it would appear that they have embraced the DMCA as a compromise to the problem of copyright infringement. In 2013 alone, Google reportedly received 235 million such notifications, with 9 per cent of them rejected for being invalid, or duplicates.<sup>97</sup> In just a single month from 2014, they reported 4.6 million takedown requests from member companies of the British Phonographic Industry.<sup>98</sup> The total figure received is increasing year on year, as much as 524 per cent in 2012.<sup>99</sup> Other companies also report significant engagement with the DMCA process, with Microsoft stating that they issue takedown notifications for “millions of infringing files per year”.<sup>100</sup> Despite changes in the online landscape, the DMCA retains its relevancy to this day.<sup>101</sup>

### *Criticisms of the notification and takedown process*

The DMCA remains the subject of great controversy,<sup>102</sup> attracting significant criticism from all sides. Chided as belonging to a different era,<sup>103</sup> it has been described as a system “that makes no one happy”,<sup>104</sup> as well as being “rife with controversy and confusion”.<sup>105</sup> While an efficient process for the removal of content is required, it has been said that attempting to use the provisions of the DMCA to combat copyright infringement even on a single site is akin to “trying to bail out an oil tanker with a thimble”,<sup>106</sup> owing to the sheer volume of infringing activity online. In the face of such a monumental task, DMCA takedown notifications are seen as “flawed and inefficient”.<sup>107</sup>

While there are many issues with the DMCA’s notification and takedown procedure, one of the most significant concerns is the unilateral power it grants to copyright holders, which operates without judicial oversight.<sup>108</sup> The process can result in the removal of material irrespective of whether it is being used in a lawful manner or not,<sup>109</sup> and the burden of proof is placed on the subscriber to provide a justification for the

<sup>89</sup> J. Urban, J. Karaganis and B. Schofield, “Notice and Takedown in Everyday Practice”, *UC Berkeley Public Law Research Paper No.2755628* (2017), version 2, p.19, para.4.

<sup>90</sup> S.E. Siwek, “The True Cost of Sound Recording Piracy to the U.S. Economy”, Institute for Policy Innovation, Report 118 (2007), p.i.

<sup>91</sup> Siwek, “The True Cost of Sound Recording Piracy to the U.S. Economy” (2007), p.i.

<sup>92</sup> Siwek, “The True Cost of Sound Recording Piracy to the U.S. Economy” (2007), p.i.

<sup>93</sup> Siwek, “The True Cost of Sound Recording Piracy to the U.S. Economy” (2007), p.51, para.2.

<sup>94</sup> Siwek, “The True Cost of Sound Recording Piracy to the U.S. Economy” (2007), pp.62–63.

<sup>95</sup> USC 17 §512(c).

<sup>96</sup> Netanel, *Copyright’s Paradox* (2008), p.128.

<sup>97</sup> “Google discarded 21,000,000 takedown requests in 2013” (27 December 2013), *TorrentFreak.com*, <http://torrentfreak.com/google-discarded-21000000-takedown-requests-in-2013-131227> [Accessed 14 December 2018].

<sup>98</sup> Google Transparency Report, <https://www.google.com/transparencyreport/removals/copyright> [Accessed 14 December 2018].

<sup>99</sup> D. Seng, “The State of the Discordant Union: An Empirical Analysis of DMCA Takedown Notices” (2014) 18 *Virginia Journal of Law and Technology* 11.

<sup>100</sup> *Amicus Brief of Microsoft Corporation and Electronic Arts Inc, in the case of Viacom International, Inc v YouTube Inc*, p.3, <http://docs.justia.com/cases/federal/appellate-courts/ca2/10-3270/112> [Accessed 14 December 2018].

<sup>101</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.28, para.2.

<sup>102</sup> Brannan, “Fair Use Doctrine and the Digital Millennium Copyright Act” (2001) 42 *Santa Clara Law Review* 247, para.1.

<sup>103</sup> Boyden, “The Failure of the DMCA Notice and Takedown System”, Center for the Protection of Intellectual Property, George Mason University School of Law (2013).

<sup>104</sup> Boyden, “The Failure of the DMCA Notice and Takedown System”, George Mason University School of Law (2013).

<sup>105</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 394, para.2.

<sup>106</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 394, para.2.

<sup>107</sup> Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 *Berkeley Technology Law Journal*, p.437, para.3.

<sup>108</sup> Farrand, “Regulatory Capitalism, Decentered Enforcement, and its Legal Consequences for Digital Expression” (2013) 10 *Journal of Information Technology & Politics* 408, 413, para.3.

<sup>109</sup> J.M. Miller, “Fair Use Through the Lenz of §512(c) of the DMCA: A Preemptive Defense to a Premature Remedy?” (2010) 95 *Iowa Law Review* 1697, 1708, para.3.

publication, resulting in “censorship before adjudication”.<sup>110</sup> In other words, website owners or publishers that are the subject of a DMCA takedown notification are in many ways deemed to be guilty before proven innocent.<sup>111</sup> Effectively, the state provides a framework “with which private citizens are able to silence” others.<sup>112</sup> It is perhaps inevitable that any effort to streamline the removal of allegedly infringing content will result in the erosion of the safeguards put in place to protect fair use, but the question is whether or not the discretion offered to right holders is proportionate or not.

The imbalanced nature of the DMCA also has a negative effect on online service providers, despite their safe harbour protections. In order to shield their users from frivolous or illegitimate copyright claims, platforms have to analyse each notice for both completeness and validity, as well as make a judgment call on any fair use argument. This sort of review requires a significant amount of both resources expertise, and for hosts that receive millions of notices, may prove to be impractical.

If a service provider does decide to take a proactive stance in filtering out takedown notifications, they also have to be prepared to risk losing their safe harbour protections in situations where they may refuse to comply with a notice. This is something that few are prepared to do,<sup>113</sup> even in cases where the probability of any resulting litigation is minimal. There would need to be a persuasive commercial argument made in order to make the decision to take on the potential costs that the legal risk would involve.<sup>114</sup> As a result of this inherent reluctance, many fraudulent or illegitimate DMCA takedown notifications will inevitably be processed, and content removed without the detailed scrutiny that may show up potential fair use defences. In addition, it has observed that it would be straightforward to force platform operators to shut down by sending multiple DMCA takedown notifications that would require attention to deal with properly.<sup>115</sup>

One of the other major criticisms of the DMCA is that it does not really solve the core problem of copyrighted material being shared without permission, offering “little protection”<sup>116</sup> for holders of intellectual property rights. As one piece of allegedly infringing material is removed as the result of a valid takedown notification, it can simply be re-uploaded by the infringing party elsewhere, in the same form—potentially even on the same platform. Despite this, the safe harbour provisions mean that no action can be taken against the online service provider, so long as they act within the terms of the statute. This situation leads to an endless cat and mouse scenario between the holders of intellectual property rights, and

those abusing them. As a result, the whole thing has been compared to the arcade game “whac-a-mole”, where copyright holders have to guess where the next offending party is going to appear.<sup>117</sup> To this end, small-scale copyright holders are at a particular disadvantage under the DMCA, with the “poor protection” that it offers.<sup>118</sup> The burden imposed to monitor the Internet for infringement rests especially heavily on their shoulders, compared to larger organisations with significant resources to devote to the task. For this reason, it can be easy to see the DMCA as a tool that only significantly benefits major parties, both in terms of service providers, and copyright holders.

### *Criticisms of the counter-notification process*

As well as general criticisms of §512, there are specific issues in relation to the counter-notification portion of the process, which is “limited in both structure and practice”.<sup>119</sup> In some ways, this should perhaps not come as too much of a surprise, as the procedural recourse for subscribers was only incorporated into the DMCA “at the last minute”.<sup>120</sup>

One of the first hurdles is that, in order to have access to allegedly infringing material restored, subscribers are required to submit a valid counter-notification to the service provider. However, to do so they must become aware that access to the disputed material has been disabled in the first place. There is no statutory requirement placed upon service providers to notify users that this has been done, and so users are forced to rely on the relevant platform’s policy decisions, which inevitably vary in their scope, and don’t necessarily include adequate notification.

Secondly (and as mentioned earlier), there is no obligation on a service provider to actually honour the counter-notification process, and, as a result, they may conclude that leaving content down is a more attractive prospect. This scenario seems more likely when we consider that there are practical questions involved in removing content in such a way that it can be restored efficiently at a later date. Reinstating access is not necessarily technically feasible for smaller platforms with limited resources available for developing such bespoke solutions. This creates another imbalance in the notice and takedown mechanism, with one of the key remedies available to subscribers dependent on the willingness of their host to comply.

<sup>110</sup> T.A. Lyons, “Scientology or Censorship: You Decide” (2000) Camden Rutgers School of Law Publications (2000), p.19, para.1.

<sup>111</sup> Sundell, “Tempting the Sword of Damocles” (2011) 12 Minn. Journal of Law, Science, and Technology 335, 356, para.3.

<sup>112</sup> Lyons, “Scientology or Censorship: You Decide”, Camden Rutgers School of Law Publications (2000), p.19, para.1.

<sup>113</sup> GartnerG2, “Copyright and Digital Media in a Post-Napster World”, (2003) The Berkman Center for Internet & Society at Harvard Law School, p.27, para.4, available at [https://cyber.harvard.edu/wg\\_home/uploads/254/2003-05.pdf](https://cyber.harvard.edu/wg_home/uploads/254/2003-05.pdf) [Accessed 14 December 2018].

<sup>114</sup> Netanel, *Copyright’s Paradox* (2008), p.127.

<sup>115</sup> *Design Furnishings Inc v Zen Path*, 2:10-02765, 2010 WL 4321568, at \*5 (E.D. Cal. 21 October 2010).

<sup>116</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 Minn. Journal of Law, Science, and Technology 387, 394, para.2.

<sup>117</sup> Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 Berkeley Technology Law Journal, p.406, para.2.

<sup>118</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 Minn. Journal of Law, Science, and Technology 387, 397, para.3.

<sup>119</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.44, para.2.

<sup>120</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.7, para.3.

Should a provider decide that they will accept, and give effect to valid counter-notifications, there are then procedural issues to be considered. Despite the obvious differences in the substantive requirements between the notification and counter notification processes, there are a few additional discrepancies in their *application*. First, as explained earlier, a complainant is only required to provide enough information that is “reasonably sufficient” for a service provider to contact them. In contrast, a subscriber must submit their full name, address and telephone number in order for their counter-notification to be considered valid. This leaves a situation where material can be removed with nothing more than an email address given, with far more information required to have access to that same material restored. Secondly, while takedown notifications can be submitted through a third party acting on behalf of the copyright holder, this option appears unavailable in the case of counter-notifications, as a result of the statute’s requirement that the subscriber’s name, address, telephone number and signature be detailed. Thirdly, there is a clear disparity in the requirement for allegedly infringing content to be removed “expeditiously”, and the minimum of 10 business days before it can be restored upon receipt of a valid counter-notification.<sup>121</sup>

These differences result in an imbalance in the DMCA, which leave the system open to abuse. While complainants can have material removed without providing anything more than an email address, or do so through an agent, the subscriber is forced to provide far more information in order to have access to the material reinstated. In the case of fraudulent takedowns, users are then faced with the choice of either giving up their full contact details to a potentially malicious complainant, or else to have their content permanently taken offline. This dichotomy was highlighted by a WordPress.com subscriber, who shared their dissatisfaction with the counter-notification requirements on their blog, after having access to material that they had published disabled. In their view, the initial takedown notification was a fraudulent abuse of the system, but in order to challenge it they were forced to provide personal details to an allegedly dishonest individual:

“WordPress offers customers like me a stark and unrealistic choice: fill in a DMCA ... counter-notice containing precious personal data of great value to the crooks who hack our bank accounts – or be taken down.”<sup>122</sup>

Another example in the same vein concerns the case of an independent author who found themselves the subject of fraudulent takedown notifications regarding their recently published book. They were also concerned about the requirement to provide their full name address in a counter-notification, stating: “I very much resent the idea that I might be forced to give identifying information to someone who has behaved fraudulently.”<sup>123</sup>

The anger displayed to the service providers at the prospect of having to provide personal information to the original complainant who filed the takedown notification may well be justified, but is ultimately misplaced. It is the requirements of the DMCA, and not the service provider, that requires a valid counter-notification to be submitted before access to disputed material can be restored. Either way, it demonstrates another aspect of the imbalance in the DMCA’s notification and takedown process, along with the potential for abuse.

The concerns outlined above have been shown to be well founded, and not just theoretical in nature, with a German newspaper reporting that terrorist groups submitted fraudulent takedown notifications to YouTube over content appearing on the channel of an Arabic Christian TV organisation. After counter-notifications were lodged, access to the material was restored, but the operators began to receive death threats, directly as a result of their contact information being passed on as part of the process.<sup>124</sup>

The imbalance of the information required is not the only issue with the counter notification process that leaves it open to abuse. After allegedly infringing material is taken offline by a service provider under the DMCA, access is not immediately restored upon the receipt of a counter-notification, but instead the request is put on hold for a period of “not less than 10, nor more than 14 business days”.<sup>125</sup> While ultimately content will be restored, this means that the takedown process has the potential to censor legitimate material for at least ten days, and far longer if the site owner does not notice and react immediately. This can cause significant issues,<sup>126</sup> particularly for time-sensitive pieces (such as those commenting on contemporary events), where the information would be rendered inaccessible for the most critical period in which it would gain exposure. The subsequent loss of both reputation and income for a publisher<sup>127</sup> makes it easy to see how those with nefarious intent can use the DMCA’s notification and takedown process as an effective censorship tool.

These examples highlight issues that have occurred when the statutory process was followed, but that is not always the case. For example, there are many instances

<sup>121</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.45, para.3.

<sup>122</sup> A. Jennings, “Has WordPress Surrendered to the Cybercrooks?” (25 October 2014), <https://transparencyinsportblog.wordpress.com/2014/10/25/has-wordpress-surrendered-to-the-cybercrooks/> [Last accessed 25 October 2014].

<sup>123</sup> B. Mills, “Independent Publishing and DMCA Abuse, or ‘How A Scammer Got My Book Blocked With Very Little Effort!’” (1 March 2015), *The Active Voice*, <http://the-active-voice.com/2015/03/01/nolander-blocked-at-amazon-and-smashwords/> [Accessed 14 December 2018].

<sup>124</sup> S. Karish, “Wer hat sie verraten? Googles YouTube-Daten!” (5 November 2014), *Frankfurter Allgemeine*, <http://www.faz.net/aktuell/feuilleton/debatten/YouTubes-daten-gefuehrden-islamkritiker-13247806-p3.html?printPagedArticle=true> [Accessed 14 December 2018].

<sup>125</sup> DMCA §512(g)(2)(C).

<sup>126</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 Minn. Journal of Law, Science, and Technology 387, 398, para.2.

<sup>127</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 Minn. Journal of Law, Science, and Technology 387, 398, para.3.

of access to material not being restored within the designated time after the receipt of a valid counter notification. One such occasion involved Chunlou Yung, a fan of a Swedish horror film that was set for an American re-make. Having set up a Facebook group to promote the English release, much of the content was removed as the result of a DMCA takedown notification issued by a group representing the film-makers. Based on a fair use argument,<sup>128</sup> Yung responded quickly with a counter-notification, but the content remained offline for almost 20 days before Facebook reinstated access—6 days longer than provided for in the DMCA—by which point he had decided to no longer promote the film, and closed down the community.<sup>129</sup> This demonstrates how publishers are at the mercy of the diligence of online service providers to stick to the timeline laid out in the DMCA, while suffering the consequences of the content being offline, and again highlights the systemic potential for abuse.

Submitting a counter-notification can be a daunting undertaking. Even where users are perfectly entitled to use the material in question, many lack the “tech savvy” required to engage with the process.<sup>130</sup> Those that do, still have to contend with its legal nature, which can be intimidating. The gravity of the mechanism is something that is emphasised by online service providers, with Twitter describing the action of submitting a counter notification as “serious business”.<sup>131</sup> As a result, subscribers may choose to leave perfectly legitimate content offline, rather than engage in a process that they deem to be too intimidating or legalistic. In practice, counter-notifications are rarely sent,<sup>132</sup> even where there is a wealth of detailed information available to help subscribers do so.<sup>133</sup> For example, Automattic reported that counter-notices were only received in response to 2 per cent of the takedown notifications they received in the period of January to July of 2016.<sup>134</sup>

Such a low level of challenge to DMCA takedown notifications could be seen as an argument that the process is working effectively, removing a significant amount of content without any apparent objection. However, the levels of abusive notices reported by organisations in their transparency reports<sup>135</sup> would suggest that the situation is not that straightforward. Rather, the number of incomplete

or invalid takedown notifications is significant,<sup>136</sup> and the imbalances in the notification and takedown procedure allow for it to be used to bully publishers to remove critical content without any real chance of recourse.<sup>137</sup> The lack of effectiveness in the procedural elements of the counter notification process shown in these criticisms demonstrate the very real potential for there to be a chilling effect on free speech as a result.

## Abuse of the DMCA

The previous sections have concentrated largely on issues with the procedural elements of the DMCA, and the effectiveness of them in dealing with copyright infringement. However, in practice, the use of the notification and takedown process is not solely restricted to the expression of legitimate copyright concerns, but also for the purposes of “copyfraud”.<sup>138</sup> “Examples of abuse abound”,<sup>139</sup> and “fake assertions of copyright are everywhere”,<sup>140</sup> with the legislation brandished by some complainants as a tool to cut down views that they find to be undesirable. In essence the DMCA is being abused in these circumstances as a means of achieving censorship. Perhaps most damning of all is the assertion that the system itself “encourages these kind of egregious removal requests”,<sup>141</sup> and may even lead complainants to perjure themselves in an effort to get content taken offline.<sup>142</sup>

The notification and takedown process has resulted in a substantial amount of material being removed from online distribution, “both infringing and non-infringing”.<sup>143</sup> This is something demonstrated in transparency reports published by major online service providers, which show that a significant proportion of takedown notifications are subsequently rejected upon receipt for either failing to fulfil the formal requirements, or for being an inappropriate use of the DMCA. Wikipedia reported that only 27 per cent of the takedown notifications they received between January and June 2016 were ultimately processed.<sup>144</sup> WordPress.com removed content in response to 55 per cent of the 4,258

<sup>128</sup> M. Masnick, “Movie Producers Want Sole Ownership of Facebook Fans” (21 September 2010), *TechDirt*, <https://www.techdirt.com/articles/20100913/20473110993/movie-producers-want-sole-ownership-of-facebook-fans.shtml> [Accessed 14 December 2018].

<sup>129</sup> J. Bailey, “The Facebook, the DMCA, and the Problem with Counternotices”, (13 October 2010), *PlagiarismToday*, <https://www.plagiarismtoday.com/2010/10/13/the-facebook-the-dmca-and-the-problem-with-counternotices> [Accessed 14 December 2018].

<sup>130</sup> GartnerG2, “Copyright and Digital Media in a Post-Napster World”, (2003) The Berkman Center for Internet & Society at Harvard Law School, p.28, para.1, available at [https://cyber.harvard.edu/wg\\_home/uploads/254/2003-05.pdf](https://cyber.harvard.edu/wg_home/uploads/254/2003-05.pdf) [Accessed 14 December 2018].

<sup>131</sup> See <https://support.twitter.com/articles/15795-copyright-and-dmca-policy#12> [Accessed 14 December 2018].

<sup>132</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 391, para.3.

<sup>133</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 395, para.3.

<sup>134</sup> See <https://transparency.automattic.com/intellectual-property/2016-h1> [Accessed 14 December 2018].

<sup>135</sup> See <https://transparency.automattic.com/intellectual-property/2016-h1> [Accessed 14 December 2018], and see further discussion on this point in the following section.

<sup>136</sup> A. Neill and E. Lee, “Fixing Section 512 – Legislative Reforms for the DMCA Safe Harbor Provisions” (2016) *American Intellectual Property Law Association Quarterly Journal*, available at <https://ssrn.com/abstract=2879696> [Accessed 14 December 2018].

<sup>137</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 403 para.2.

<sup>138</sup> J. Mazzone, “Copyfraud” (2006) 81 *New York University Law Review* 1026.

<sup>139</sup> Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 *Berkeley Technology Law Journal*, p.437 para.3.

<sup>140</sup> Mazzone, “Copyfraud” (2006) 81 *New York University Law Review* 1026, 1029, para.1.

<sup>141</sup> Sundell, “Tempting the Sword of Damocles (2011) 12 *Minn. Journal of Law, Science, and Technology* 335, 353, para.2.

<sup>142</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 400, para.1.

<sup>143</sup> Netanel, *Copyright’s Paradox* (2008), p.128.

<sup>144</sup> Wikipedia, “Requests for Content Alteration & Takedown”, <https://transparency.wikimedia.org/content.html> [Accessed 14 December 2018].

notifications they received between January and July 2016,<sup>145</sup> with Twitter reporting a higher figure of 74 per cent compliance out of 24,874 notices received between January and June 2016.<sup>146</sup> Reddit specifically noted in their 2014 report that they receive takedown notifications regarding content that was allegedly defamatory,<sup>147</sup> something that does not generally fall under the purview of copyright law.

This pattern is not solely restricted to the narratives published directly by service providers themselves. One independent study found that around 53 per cent of takedown notifications directed at Google Images over a certain period of time were from a single complainant, and none of them were valid.<sup>148</sup>

There are a number of different categories under which abuse of the DMCA can fall. These include attempts to utilise copyright law for non-copyrightable subject-matter, stifling criticism and targeting content that the complainant holds no rights in.<sup>149</sup> In the following sections, some of these examples are explored in more detail.

### Trade mark infringement

Inappropriate use of the DMCA as a vehicle to target trade mark infringement is a problem commonly reported by service providers. A specific illustration of this kind of misuse is given in a series of takedown notifications issued by the owners of WhatsApp to the online software development community Github.<sup>150</sup> WhatsApp, a mobile messaging app (which has since been acquired by Facebook<sup>151</sup>) targeted projects that were merely *related* to the operation of its service, accompanied with the following statement: “there continues to be an extensive amount of content that infringes on WhatsApp Inc.’s copyrights and trademarks”,<sup>152</sup> and that “this continues to cause significant harm to WhatsApp”.<sup>153</sup>

While the DMCA clearly applies to cases involving copyright infringement, it does not provide for trade mark protection.<sup>154</sup> Notably, there is no similar system to the notification and takedown process in place for these disputes.<sup>155</sup> By listing trade mark concerns as part of their takedown notice, WhatsApp appear to have sought the removal of legitimate content either through a misuse of the DMCA notification and takedown process, or by an attempt to “shoe-horn” their claim into its scope.<sup>156</sup> This view is reinforced by the fact that one of the specified, allegedly infringing projects only contained the name WhatsApp, and no other content over which copyright could be claimed.<sup>157</sup>

In another example, the photography website DigitalRev received a takedown notification concerning material posted in an article comparing a “Go Pro Hero 3” camera with another available on the market at the time.<sup>158</sup> This in itself would have been problematic, as the author would have a solid fair use defence, given that the material was being used for the purposes of “commentary or criticism”. However, the takedown notification itself contended that the review was infringing the complainant’s trade mark registrations, with no reference to any copyrightable subject-matter included at all.<sup>159</sup> The article was removed at first, only to be restored later, after the takedown was retracted on the basis that it had been an instance of “erroneous enforcement”.<sup>160</sup> In response, DigitalRev highlighted the issue in a follow-up article, claiming that “more than 50% of DMCA notices are filed with an abusive nature to suppress freedom of expression or to prevent fair competitions”.<sup>161</sup>

Comments left on coverage of the incident afterwards, claiming to be from representatives of GoPro, sought to explain that the notice was sent as DigitalRev was using “incorrect branding and representation of [the] product in their online commerce store”, and that “our letter did not clearly communicate this”.<sup>162</sup> Even if this explanation is authentic, it fails to explain why a DMCA takedown notification was used to address issues with the usage of

<sup>145</sup> “Intellectual Property”, *WordPress.com Transparency Report* (2016), <https://transparency.automattic.com/intellectual-property/2016-h1> [Accessed 14 December 2018].

<sup>146</sup> “Copyright Notices”, *Twitter Transparency Report*, <https://transparency.twitter.com/en/copyright-notices.html> [Accessed 14 December 2018].

<sup>147</sup> See <https://www.reddit.com/wiki/transparency/2014> [Accessed 14 December 2018].

<sup>148</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.12, para.7.

<sup>149</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 403, para.2.

<sup>150</sup> C. Doctorow, “Whatsapp abused the DMCA to censor related projects from Github” (21 February 2014), *BoingBoing.net*, <http://boingboing.net/2014/02/21/whatsapp-abused-the-dmca-to-ce.html> [Accessed 14 December 2018].

<sup>151</sup> D. Rushe, “WhatsApp: Facebook acquires messaging service in \$19bn deal” (20 February 2014), *Guardian Online*, <http://www.theguardian.com/technology/2014/feb/19/facebook-buys-whatsapp-16bn-deal> [Accessed 14 December 2018].

<sup>152</sup> Text of the takedown notice available at <https://github.com/github/dmca/blob/master/2014/2014-02-12-WhatsApp> [Accessed 3 January 2019].

<sup>153</sup> See <https://github.com/github/dmca/blob/master/2014/2014-02-12-WhatsApp> [Accessed 3 January 2019].

<sup>154</sup> “Frequently Asked Questions (and Answers) about DMCA Safe Harbor”, *Chilling Effects Clearing House*, <https://www.chillingeffects.org/dmca512/faq#QID56> [Accessed 14 December 2014]; and J.R. Brege and K.A. Oviess, “Taking Down Trademark Bullying: Skteching the Contours of a Trademark Notice and Takedown Statute” (2012) 12 *Wake Forest Journal of Business and Intellectual Property Law* 391, 397, para.1.

<sup>155</sup> Brege and Oviess, “Taking Down Trademark Bullying” (2012) 12 *Wake Forest Journal of Business and Intellectual Property Law* 391, 395, para.1.

<sup>156</sup> Brege and Oviess, “Taking Down Trademark Bullying” (2012) 12 *Wake Forest Journal of Business and Intellectual Property Law* 391, 397, para.1.

<sup>157</sup> Rushe, “WhatsApp: Facebook acquires messaging service in \$19bn deal” (20 February 2014), *Guardian Online*, <http://www.theguardian.com/technology/2014/feb/19/facebook-buys-whatsapp-16bn-deal> [Accessed 14 December 2018].

<sup>158</sup> M. Zhang, “GoPro Uses DMCA to Take Down Article Comparing its Camera with Rival” (20 March 2013), *PetaPixel*, <http://petapixel.com/2013/03/20/gopro-uses-dmca-to-take-down-article-comparing-its-camera-with-rival> [Accessed 14 December 2018].

<sup>159</sup> Zhang, “GoPro Uses DMCA to Take Down Article Comparing its Camera with Rival” (20 March 2013), *PetaPixel*, <http://petapixel.com/2013/03/20/gopro-uses-dmca-to-take-down-article-comparing-its-camera-with-rival> [Accessed 14 December 2018].

<sup>160</sup> “GoPro doesn’t like their Hero 3 Compared to Sony’s AS15?” (20 March 2013), *DigitalRev.com*, <https://store.digitalrev.com/article/gopro-doesn-t-like-their/ODUyNjU2ODcA> [Accessed 18 December 2018].

<sup>161</sup> See above.

<sup>162</sup> T. Cushing, “Digital Camera Review Taken Down by a Botched DMCA Notice that Makes Claims of Trademark Infringement” (21 March 2013), *TechDirt.com*, <https://www.techdirt.com/articles/20130320/10452722397/digital-camera-review-taken-down-botched-dmca-notice-that-makes-claims-trademark-infringement.shtml> [Accessed 14 December 2018].

trade marks in the first place. Rather than a problem of unclear communication, this is an example of using a completely inappropriate legal process for the situation involved.

Another incident demonstrating the improper use of the DMCA to target alleged trade mark infringement involved an online community based on a fitness regime named “CrossFit”. The organisation in question objected to the use of their trade mark, and submitted takedown notifications to the hosts of the community. Eventually, they sued for trade mark infringement, and the defendant submitted a counter-claim. During the proceedings, CrossFit argued they could have easily submitted an alternative trade mark action to get the disputed content taken down anyway (but didn’t), and so weren’t really abusing the system by making use of the DMCA for that purpose.<sup>163</sup> The court sensibly disagreed, stating that whether or not CrossFit could have had the material removed by some other means had “no bearing” on whether or not their actions complied with the DMCA.<sup>164</sup> As a result, the possibility of seeking damages under §512(f) was left open to the subscriber, and something that will be returned to in a later section.

The attitude of CrossFit illustrates the seemingly widespread view that the notification and takedown provisions of the DMCA are purely a means to an end, or another tool that can be deployed to remove disagreeable material from the Internet, irrespective of its legal suitability. In these cases, there appears to be remarkably scant regard for due process, so long as the desired result is obtained.

### Silencing critics

The above examples illustrate occasions where the DMCA was used inappropriately to target alleged trade mark infringement. In addition to this, there are also numerous examples of where the notification and takedown procedure has been used in an attempt to censor material<sup>165</sup> that is critical of individuals or organisations. This is yet another example that demonstrates how rather than being used for its intended purpose, “copyright has come systematically to stifle criticism”.<sup>166</sup>

Perhaps one of the most prominent examples of the DMCA being used as a tool of censorship relates to the controversial Church of Scientology,<sup>167</sup> which has brought numerous lawsuits against parties who have criticised the church and its “foibles” online.<sup>168</sup> This approach to copyright law enforcement has been described as an “attempt to chill free speech on the web”,<sup>169</sup> with the threat of litigation in of itself often enough to prevent others from speaking out, through acts of “self-censorship”.<sup>170</sup>

The use of copyright law by the CoS as a weapon against its critics is displayed in the case of *Religious Technology Centre v Netcom On-line Communications Servs Inc*<sup>171</sup> that took place before the DMCA’s enactment. Here, the CoS brought actions against a former member who was posting critical materials online, as well as his ISP, and the Bulletin Board Service provider where the discussions were taking place. The court rejected the argument that either the ISP or BBS were liable for direct copyright infringement as a result of actions undertaken by their users.<sup>172</sup> However, they did allow for the possibility that online service providers could be liable either vicariously, or under a theory of contributory infringement in differing circumstances.<sup>173</sup> It has been opined that it was this potential that helped advance the introduction of the DMCA, in order to address the issue in a statutory form.<sup>174</sup>

The notification and takedown procedure of the DMCA, in conjunction with the aggressive attitude of the CoS towards litigation, has been said to have “the most chilling effect” on online freedom of speech.<sup>175</sup> On just one occasion, the CoS sent over 4,000 takedown notifications concerning critical videos posted by an anonymous group to YouTube.<sup>176</sup> Rather than prevent the unauthorised distribution of intellectual property, it appears that the main intention of the CoS in utilising copyright law was to “silence critics and send a warning message to other disgruntled Church members”.<sup>177</sup> This is a prime example that demonstrates the inappropriate use of copyright as a tool for censorship, where “holders too often seek to use their proprietary control of expression to silence the speaker”.<sup>178</sup>

The Electronic Frontier Foundation<sup>179</sup> is an American organisation set up to “[defend] civil liberties in the digital world”.<sup>180</sup> Their stated aims are to “ensure that rights and freedoms are enhanced and protected as our use of

<sup>163</sup> *CrossFit Inc v Alvies*, No.13–3771, 2014 WL 251760 (N.D. Cal. 22 January 2014).

<sup>164</sup> *CrossFit Inc v Alvies*, No.13–3771, 2014 WL 251760 (N.D. Cal. 22 January 2014), p.6, para.1.

<sup>165</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 392, para.2.

<sup>166</sup> Netanel, *Copyright’s Paradox* (2008), p.20, para.1.

<sup>167</sup> CoS.

<sup>168</sup> Netanel, *Copyright’s Paradox* (2008), p.126.

<sup>169</sup> Lyons, “Scientology or Censorship: You Decide”, Camden Rutgers School of Law Publications (2000), p.4 para.1.

<sup>170</sup> Netanel, *Copyright’s Paradox* (2008), p.126.

<sup>171</sup> *Religious Technology Center v Netcom On-line Communication Servs, Inc* 923 F. Supp. 1231, 1240 (N.D. Cal. 1995).

<sup>172</sup> *Religious Technology Center v Netcom On-line Communication* 923 F. Supp. 1231, 1382, 1381 (N.D. Cal. 1995).

<sup>173</sup> *Religious Technology Center v Netcom On-Line Communication* 907 F. Supp. 1231, 1361 (N.D. Cal. 1995).

<sup>174</sup> Lyons, “Scientology or Censorship: You Decide” (2000), p.16, para.1.

<sup>175</sup> Lyons, “Scientology or Censorship: You Decide” (2000), p.18, para.1.

<sup>176</sup> Miller, “Fair Use Through the Lenz of §512(c) of the DMCA” (2010) 95 *Iowa Law Review* 1697, 1708, para.1.

<sup>177</sup> Lyons, “Scientology or Censorship: You Decide” (2000), p.18, para.2.

<sup>178</sup> Netanel, *Copyright’s Paradox* (2008), p.125.

<sup>179</sup> EFF.

<sup>180</sup> See <https://www EFF.org/about> [Accessed 14 December 2018].

technology grows”.<sup>181</sup> They have highlighted a number of different abuses of the DMCA process, particularly where it has been misused in an attempt to silence critics. One such instance involved a radio host named Rush Limbaugh. Rush attacked a Georgetown University law student named Sandra Fluke on his show, over a course of three days, for her role in testifying to Congress<sup>182</sup> in support of legislation regarding contraceptives.<sup>183</sup> The website Daily Kos published a video containing various clips of Rush’s attacks to YouTube.<sup>184</sup> Despite the obvious fair use argument, the material was promptly taken down as the result of a DMCA takedown notification sent to the host.<sup>185</sup> Google later restored the video before the mandated 10–14-day period was up, after the case garnered publicity.

In another example, Uri Geller, a TV psychic famous for claiming an ability to bend spoons with his mind, was subject to a YouTube video looking to expose his supposedly paranormal abilities as fraudulent. The post prompted the issuance of a DMCA takedown notification targeting the entire video. This action was taken despite the content in question only constituting a minor portion of the larger work, which would have made for a compelling fair use argument when considering its critical purpose. The EFF filed a complaint on behalf of the individual who uploaded the video, seeking damages under §512(f).<sup>186</sup> The case was eventually settled out of court, with part of the settlement including a requirement that the material in question be licensed under the Creative Commons, allowing for it to be re-used in future by anybody for non-commercial purposes.<sup>187</sup>

In 2007, a video blogger named Michelle Malkin posted a video criticising the behaviour of the artist Akon. The video included clips of the artist’s live performances, with Malkin condemning what she described as his “misogyny”.<sup>188</sup> Akon’s record label, Universal Music Group<sup>189</sup> issued a takedown notification regarding the video, which led to YouTube disabling access to it to give effect to the DMCA. After Malkin contacted the EFF for assistance,<sup>190</sup> a counter-notice was filed, on the basis that

the material fell under fair use protections. After this, it was restored without any further legal action being taken.<sup>191</sup> This again demonstrated an abuse of the system for the purposes of censorship, as the subject matter involved was not copyrightable material.<sup>192</sup>

In another instance, the NFL used the DMCA to target a video posted online that was critical of its copyright policy, and “almost certainly illegitimate”.<sup>193</sup> They then found that access was later restored upon the receipt of a valid counter-notification. Instead of following the correct process, which would be to initiate legal proceedings against the subscriber, the NFL sent another takedown notification concerning the same material.<sup>194</sup> Not only does this demonstrate an abuse of the takedown process to censor legitimate criticism, but also a lack of respect more generally for the “procedural sanctity” of the DMCA itself.<sup>195</sup>

Continuing on in the same vein, the Ralph Lauren fashion label came under fire after one of its adverts appeared to be digitally manipulated to such an extent that the model’s head was wider than her waist. The criticisms were published on a number of websites, including the online community and publishing site *boingboing.net*, which subsequently received a DMCA takedown notice via its host. With support from Wendy Seltzer of the Chilling Effects Clearinghouse project,<sup>196</sup> Boing Boing refused to take down the content, challenging Ralph Lauren to “sue and be damned”, relying on fair use protections for their criticism of the actions. No further action was taken,<sup>197</sup> but this instance again demonstrates the abuse of the DMCA to stifle criticism, rather than to protect legitimate copyright concerns.

In another incident, the price list for the fees charged to law enforcement agencies by the service provider Yahoo for compliance with requests for user information was published in 2009 on a site called Cryptome.org. Unhappy about the material’s distribution, and concerned about the potential negative press the release would garner, Yahoo sent a DMCA takedown notification to

<sup>181</sup> See <https://www.eff.org/about> [Accessed 14 December 2018].

<sup>182</sup> See her opening statement on YouTube: <https://www.YouTube.com/watch?v=xIRC0nsjtKQ> [Accessed 14 December 2018].

<sup>183</sup> M. Zimmerman, “Limbaugh Copies Michael Savage’s Bogus Copyright Theory, Sends DMCA to Silence Critics” (24 April 2012), *Electronic Frontier Foundation*, <https://www.eff.org/deeplinks/2012/04/limbaugh-copies-michael-savage-bogus-copyright-theory> [Accessed 14 December 2018].

<sup>184</sup> “53 of Rush Limbaugh’s most vile smears against Georgetown Law student Sandra Fluke” (5 March 2012), *YouTube*, <https://www.YouTube.com/watch?v=q1oOjKQfIN0> [Accessed 14 December 2018].

<sup>185</sup> “Rush Limbaugh demands YouTube remove *Daily Kos* video... watch it here” (23 April 2012), *Daily Kos*, <http://www.dailykos.com/story/2012/04/23/1085791/-Rush-Limbaugh-demands-YouTube-remove-Daily-Kos-video-watch-it-here> [Accessed 14 December 2018].

<sup>186</sup> “Sapient v. Geller Complaint”, *Electronic Frontier Foundation*, <https://www.eff.org/document/complaint-25> [Accessed 14 December 2018].

<sup>187</sup> “Sapient v. Geller”, *Electronic Frontier Foundation*, <https://www.eff.org/cases/sapient-v-geller> [Accessed 14 December 2018].

<sup>188</sup> “Malkin Fights Back Against Copyright Law Misuse by Universal Music Group” (9 May 2007), *Electronic Frontier Foundation*, <https://www.eff.org/deeplinks/2007/05/malkin-fights-back-against-copyright-law-misuse-universal-music-group> [Accessed 14 December 2018].

<sup>189</sup> UMG.

<sup>190</sup> M. Malkin, “Akon’s record company abuses DMCA to stifle criticism on YouTube” (3 May 2007), <http://michellemalkin.com/2007/05/03/akons-record-company-abuses-dmca-to-stifle-criticism-on-youtube> [Accessed 14 December 2018].

<sup>191</sup> M. Malkin, “UMG & YouTube retreat over Akon report” (14 May 2007), <http://michellemalkin.com/2007/05/14/umg-youtube-retreat-over-akon-report> [Accessed 14 December 2018].

<sup>192</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 392, para.2.

<sup>193</sup> Sundell, “Tempting the Sword of Damocles” (2011) 12 *Minn. Journal of Law, Science, and Technology* 335, 347, para.2.

<sup>194</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 396.

<sup>195</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 396, para.3.

<sup>196</sup> Now known as the “Lumen Database”.

<sup>197</sup> C. Doctorow, “The criticism that Ralph Lauren doesn’t want you to see!” (6 October 2009), *BoingBoing.net*, <http://boingboing.net/2009/10/06/the-criticism-that-r.html> [Accessed 14 December 2018].

Cryptome in an attempt to have it taken offline. Cryptome refused to comply,<sup>198</sup> and the material was still online as of December 2018.<sup>199</sup>

The majority of the preceding examples have illustrated situations where the DMCA has been abused in order to have content removed inappropriately where the complainant has had an intellectual property interest in the material, yet the use was clearly non-infringing. Another way in which the DMCA is abused is through the erroneous submission of takedown notifications where the complainant holds no rights to that over which they are claiming alleged copyright infringement. This is something that was also demonstrated in the *Viacom v YouTube* case introduced earlier, where the plaintiff submitted numerous takedown notifications that referred to material in which they held no intellectual property rights.<sup>200</sup> This was described by the actual owners of the works as a “blatant abuse” of the DMCA system as part of the defendant’s response to the action.<sup>201</sup>

The late artist Prince was known to be involved in a number of dubious copyright disputes. This was to such an extent that the EFF have included him in their “Takedown Hall of Shame”,<sup>202</sup> a section of their website used to highlight “the worst of the worst” in terms of “bogus” copyright complaints. One of these instances involved fan-shot videos from a performance by Prince at the Coachella festival. The videos in question showed the artist performing a cover of the song “Creep” by the British band Radiohead. After being uploaded to YouTube, Prince’s record label sought to have them removed, as they were allegedly infringing copyright.<sup>203</sup> While Prince had some rights as an artist in the distribution of the performance itself, commentators have pointed out that there was no copyright infringement in these circumstances that should have been remedied with the use of a DMCA takedown notice.<sup>204</sup>

Examples of erroneous takedowns are plentiful, and one just needs to spend some time looking through Google’s transparency report to discover some unexpected statistics, such as the six takedown notifications that were sent to Google relating to alleged copyright infringement on *whitehouse.gov*,<sup>205</sup> the 23 takedowns targeting *justice*

*.gov*,<sup>206</sup> or the 14 aimed at *nasa.gov*,<sup>207</sup> none of which are locations known for hosting pirated material. Perhaps wisely, Google reported that they removed search engine listings in response to zero of these particular requests.

### Automated takedown notifications

In order to deal with the onerous task of scouring the web for unauthorised instances of copyrighted material, right holders increasingly outsource the work to dedicated third parties.<sup>208</sup> These organisations often employ automated means to detect content, and then send out DMCA takedown notifications en masse.<sup>209</sup> One such organisation is MarkMonitor, who have described themselves as a “leading brand protection provider”.<sup>210</sup> Technology is deployed to search the Internet for the client’s brands or products, which then sends takedown notifications to the hosts of the allegedly infringing content.<sup>211</sup> This sort of automated approach is cost-effective for copyright holders, who do not have to dedicate significant resources towards the task of online revenue protection. However, the nature of the system means that it is imperfect, leading to material being inaccurately identified as infringing, and thus becoming the subject of an inaccurate takedown notification. This is an unsurprising eventuality, because as we have already seen in the examples up to this point, the DMCA has fostered “an environment that rewards indiscriminate, hair-trigger takedown requests”.<sup>212</sup> “Spray and pray” can often provide far more substantial results in terms of takedown volume than careful and targeted notifications.

Right holders claim that there is human involvement in the automated processes to avoid mistakes,<sup>213</sup> but in practice it is clear that they still happen. In just one study, about 4 per cent of notices were found to identify work that was different from that which they were claiming copyright over in the first place,<sup>214</sup> thus targeting unrelated material for takedown. Over 13 per cent of notices in the same study did not provide adequate information to identify the allegedly infringing work, often because the

<sup>198</sup> F.V. Lohmann, “Latest Bogus DMCA Takedown Award Winner: Yahoo!” (7 December 2009), *Electronic Frontier Foundation*, <https://www.eff.org/deeplinks/2009/12/todays-bogus-dmca-takedown-award-winner-yahoo> [Accessed 14 December 2018].

<sup>199</sup> “Yahoo! Compliance Guide for Law Enforcement”, *Cryptome.org*, <http://cryptome.org/isp-spy/yahoo-spy.pdf> [Accessed 14 December 2018].

<sup>200</sup> Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 *Berkeley Technology Law Journal*, p.437, para.3; and Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 398, para.2.

<sup>201</sup> Hassanabadi, “Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World”, (2011) 26 *Berkeley Technology Law Journal*, p.438 para.1; and Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 398, para.2.

<sup>202</sup> “Takedown Hall of Shame”, *Electronic Frontier Foundation*, <https://www.eff.org/takedowns> [Accessed 14 December 2018].

<sup>203</sup> H. d’Andrade, “Prince Issues One Takedown Too Many” (2 June 2008), *Electronic Frontier Foundation*, <https://www.eff.org/deeplinks/2008/06/prince-issues-one-takedown-too-many> [Accessed 4 October 2018].

<sup>204</sup> D’Andrade, “Prince Issues One Takedown Too Many” (2 June 2008), *Electronic Frontier Foundation*, <https://www.eff.org/deeplinks/2008/06/prince-issues-one-takedown-too-many> [Accessed 14 December 2018]; and S. Bayard, “Prince, Radiohead, and the Bootlegging Provision of the Copyright Act” (2 June 2008), *Digital Media Law Project*, <http://www.dmlp.org/blog/2008/prince-radiohead-and-bootlegging-provision-copyright-act> [Accessed 14 December 2018].

<sup>205</sup> See <https://www.google.com/transparencyreport/removals/copyright/searchdata/domains?id=whitehouse.gov> [Accessed 14 December 2018].

<sup>206</sup> See <https://www.google.com/transparencyreport/removals/copyright/searchdata/domains?id=justice.gov> [Accessed 14 December 2018].

<sup>207</sup> See <https://www.google.com/transparencyreport/removals/copyright/searchdata/domains?id=nasa.gov> [Accessed 14 December 2018].

<sup>208</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.2, para.6.

<sup>209</sup> Neill and Lee, “Fixing Section 512” (2016) *American Intellectual Property Law Association Quarterly Journal*, para.1, available at <https://ssrn.com/abstract=2879696> [Accessed 14 December 2018].

<sup>210</sup> See <https://www.markmonitor.com/why-markmonitor/the-leader-in-brand-protection-and-domain-management?cid=homepage> [Accessed 14 December 2018].

<sup>211</sup> “Datasheet: MarkMonitor AntiPiracy” (undated), [https://www.markmonitor.com/download/ds/ds-MarkMonitor\\_AntiPiracy.pdf](https://www.markmonitor.com/download/ds/ds-MarkMonitor_AntiPiracy.pdf) [Accessed 14 December 2018].

<sup>212</sup> Sundell, “Tempting the Sword of Damocles (2011) 12 *Minn. Journal of Law, Science, and Technology* 335, 346, para.2.

<sup>213</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.35, para.3.

<sup>214</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.90, para.3.

URLs in question related to a dynamic search or “category” style page.<sup>215</sup> These issues are the hallmarks of automated takedowns.

One of the most potentially embarrassing scenarios for a copyright holder is where the agent that they have enlisted to track down unauthorised uses of their intellectual property mistakenly targets the official source itself. This exact scenario was illustrated in a takedown notification issued by the third-party agent DtecNet (part of MarkMonitor) to Google on behalf of the American media organisation HBO. In the notification, a large number of URLs were listed as allegedly infringing HBO’s copyrights, including those on HBO’s own website.<sup>216</sup> Not only that, the takedown notification also listed other prominent media sources such as MTV’s Movie blog, and *IGN.com*—both of which contained reviews of the HBO film *Eastbound & Down*, and no pirated links.<sup>217</sup> Another example of this kind came again in the form of takedown notifications issued by DtecNet, but this time on behalf of Fox. Seeking to target the unauthorised distribution of their TV show *Homeland*, the takedowns named not just sources of piracy, but also managed to target the novel of the same name by Cory Doctorow, which was available under a Creative Commons licence.<sup>218</sup> Finally, the RIAA sent takedown notifications targeting content on websites operated by parties that they themselves had employed to promote the music of their members.<sup>219</sup>

This particular issue is one that comes up time and again, with one such example dubbed by TorrentFreak as the “the world’s most idiotic copyright complaint”.<sup>220</sup> In it, a takedown notification was submitted to Google from the Total Wipes Music Group, reportedly targeting the unauthorised distribution of various albums to which they held copyrights. However, stating that “We have an exclusive & worldwide deal for distributing this content”, they specified a list of 95 URLs, which included the download pages for a host of different kinds of software such as Skype, Joomla, Evernote, Ubuntu and Open Office<sup>221</sup>—in none of which Total Wipes had any intellectual property rights. This was just one example out of a number of takedown notifications where the group incorrectly identified material as infringing,<sup>222</sup> and in a statement to the online publication ARSTechnica, they blamed a technical glitch:

“Taking a look at [the url, it] is pretty clear that for a few hours only the word ‘download’ has been used by the script and that caused several illegal and wrong DMCA request [*sic*].”<sup>223</sup>

Aside from the obvious abuse of the DMCA here, and the resulting impact on the legitimate copyright holders who had their content removed, this sort of misidentification has other implications, in that it is particularly problematic given the legal nature of the takedown process. Ultimately, the signatory is stating under penalty of perjury that the individual notices sent out are accurate—whether or not they are checked manually beforehand. As a result, any failures in the detection technology could result in unexpected liability. It was hoped that the inclusion of a statement that the complainant had considered the fair use potential before sending the takedown notification would help give pause, and prevent the use of automated detection and reporting systems.<sup>224</sup> However, even after the effective implementation of this requirement as the result of *Lenz*, there appears to have been no real reduction in the volume of takedown notices reported by major online service providers in their transparency reports. This should come as no real surprise, as it is difficult to see why companies who were already content to sign off on bulk takedown notifications being sent out in their name “under penalty of perjury” would be deterred by the added requirement to say they had considered fair use, which is still determined by a subjective, rather than objective test.<sup>225</sup>

An additional problem with third-party services whose businesses are built on the notification and takedown system is that they have a vested interest in producing results—whether or not the takedown is strictly within the terms of the statute. Until early 2017, one such agent (DMCA.com) explicitly stated the following on their homepage: “We get stolen content removed. It’s 100% guaranteed – or you get your money back.”<sup>226</sup> As well as issuing takedown notices regarding material that was created by a client, they also claimed to work with “stolen content” such as pictures and videos where the complainant was the *subject*.<sup>227</sup> Usually, the rights in a

<sup>215</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.93, para.5.

<sup>216</sup> “DtecNet DMCA (Copyright) Complaint to Google” (19 December 2012), <https://lumendatabase.org/notices/652104> [Accessed 14 December 2018].

<sup>217</sup> See above.

<sup>218</sup> M. Masnick, “Fox Uses Bogus DMCA Claims to Censor Cory Doctorow’s Book About Censorship” (22 April 2013), <https://www.techdirt.com/articles/20130421/14043222791/fox-uses-bogus-dmca-claims-to-censor-cory-doctorows-book-about-censorship.shtml> [Accessed 14 December 2018].

<sup>219</sup> J. M. Miller, “Fair Use Through the *Lenz* of §512(c) of the DMCA: A Preemptive Defense to a Premature Remedy?” (2010) *Iowa Law Review*, pp.1725-1726.

<sup>220</sup> “The World’s Most Idiotic Copyright Complaint”, (22 February 2015), *TorrentFreak*, <https://torrentfreak.com/the-worlds-most-idiotic-copyright-complaint-150222> [Accessed 14 December 2018].

<sup>221</sup> “DMCA (copyright) Complaint to Google”, (5 February 2015), *ChillingEffects*, <https://lumendatabase.org/notices/10416081> [Accessed 14 December 2018].

<sup>222</sup> D. Kravets, “‘Bug’ causes music group to bombard Google with bogus DMCA takedowns” (23 February 2015), <http://arstechnica.com/tech-policy/2015/02/bug-causes-music-group-to-bombard-google-with-bogus-dmca-takedowns> [Accessed 14 December 2018].

<sup>223</sup> Kravets, “‘Bug’ causes music group to bombard Google with bogus DMCA takedowns” (23 February 2015), <http://arstechnica.com/tech-policy/2015/02/bug-causes-music-group-to-bombard-google-with-bogus-dmca-takedowns> [Accessed 14 December 2018].

<sup>224</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 410, para.2.

<sup>225</sup> Neill and Lee, “Fixing Section 512” (2016) *American Intellectual Property Law Association Quarterly Journal*, p.4 paras 1–2 available at <https://ssrn.com/abstract=2879696> [Accessed 14 December 2018].

<sup>226</sup> See <http://www.dmca.com> [Accessed 14 December 2018].

<sup>227</sup> See <http://www.dmca.com/Takedowns.aspx> [Accessed 14 December 2018], and <http://www.dmca.com/FAQ/How-do-I-get-my-picture-taken-off-the-internet> [Last accessed 17 January 2017].

photograph or video lie with the creator,<sup>228</sup> unless they have been acquiesced through contractual agreement. As a result, this guarantee seems misleading, or disingenuous at best. In addition, any attempt to use the DMCA to remove photographs where the complainant did not hold a copyright in could potentially give rise to liability under §512(f)—something that will be discussed in greater detail in an upcoming section.

### *Response by online service providers to abuse*

Online service providers have expressed concern at the levels of takedown notifications they receive that abuse the DMCA provisions,<sup>229</sup> which require a significant and disproportionate amount of resources to deal with effectively,<sup>230</sup> as opposed to the time spent on otherwise legitimate notices. These concerns have led to discussions in the American House of Representatives, with hearings taking place regarding the failings of the DMCA coming before a subcommittee of the Committee on the Judiciary in March 2014.<sup>231</sup> In a submitted amicus brief, the interested parties contend that “unfounded DMCA takedown notices are common, and impose a burden on both online service providers and the free exchange of ideas”.<sup>232</sup> They argue that in order to protect their users and push back against abusive or fraudulent uses of the DMCA, online service providers are required to devote significant resources to the cause, harming the development of their business, by not being able to use those elsewhere.<sup>233</sup> In addition, the amici also expressed concern about the negative effect of fraudulent or abusive DMCA takedown notices on copyright holders who have legitimate complaints, as the time taken to respond to their requests is increased.<sup>234</sup>

Paul Sieminski, General Counsel of Automattic, gave testimony on the sorts of abuse of the DMCA that they had come across as part of their daily operations. He referenced an earlier amicus brief that Automattic had participated in, where they had again highlighted abuses of the DMCA.<sup>235</sup> In it, they claimed to regularly receive takedown notices that “[appear] motivated not by an interest in protecting copyright but a desire to improperly silence critics”. One of the specific examples given was the improper use of the DMCA takedown process to target

unauthorised uses of a company’s name or logo on sites that are critical of their business practices—something that falls under fair use protections.<sup>236</sup> Another example given was that of a medical company who published fake customer testimonials on their website, and then submitted a takedown notification to have screenshots on a blog highlighting the practice removed.<sup>237</sup>

Tumblr also provided a number of examples of takedown notifications in the amicus brief which they considered to be “baseless and intended to silence lawful speech”.<sup>238</sup> One of these concerned a doctor, who submitted fraudulent takedown notifications posing as the right holder in order to have critical material about his practices removed.<sup>239</sup> Another concerned a model, who tried to use the DMCA to have photographs of her taken offline, despite the intellectual property rights lying with the photographer rather than her.<sup>240</sup> There was even an example where a well-known American politician submitted a takedown notice regarding photographs of himself used on a satirical website, even though they were taken by an individual with no relation or association to him, and therefore he did not hold any copyright.<sup>241</sup>

### **Remedies against DMCA abuse**

Abuse of the DMCA did not go without consideration by the statute’s drafters, with remedies to help combat abuse of the notice and takedown process explicitly provided for in the DMCA, under §512(f). It reads:

“Any person who knowingly materially misrepresents ... that material or activity is infringing, or that material or activity was removed or disabled by mistake or misidentification, shall be liable for any damages, including costs and attorneys’ fees, incurred.”<sup>242</sup>

This means that the party subject to a fraudulent DMCA takedown notice, as well as the online service provider, can file for damages occurring as the result of material that has been removed.

The first judgment in this area came in the important case of *Online Policy Group v Diebold*.<sup>243</sup> The facts concerned the publication of emails discussing known issues with electronic voting equipment, of which Diebold was the manufacturer. Two students from Swarthmore

<sup>228</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 Minn. Journal of Law, Science, and Technology 387, 394, para.3.

<sup>229</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.40, para.3.

<sup>230</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.40, para.2.

<sup>231</sup> M. Masnick, “If We’re Going to Change DMCA’s ‘Notice and Takedown’, Let’s Focus on How Widely It’s Abused” (14 March 2014), *TechDirt*, <https://www.techdirt.com/articles/20140314/11350426579/if-were-going-to-change-dmcas-notice-takedown-lets-focus-how-widely-its-abused.shtml> [Accessed 14 December 2018].

<sup>232</sup> See *Amicus Brief*, p.6, para.2, [https://www.eff.org/files/2013/12/13/osp\\_lenz\\_amicus\\_brief.pdf](https://www.eff.org/files/2013/12/13/osp_lenz_amicus_brief.pdf) [Accessed 14 December 2018].

<sup>233</sup> See *Amicus Brief*, p.10, para.1, [https://www.eff.org/files/2013/12/13/osp\\_lenz\\_amicus\\_brief.pdf](https://www.eff.org/files/2013/12/13/osp_lenz_amicus_brief.pdf) [Accessed 14 December 2018].

<sup>234</sup> See *Amicus Brief*, p.10, para.1, [https://www.eff.org/files/2013/12/13/osp\\_lenz\\_amicus\\_brief.pdf](https://www.eff.org/files/2013/12/13/osp_lenz_amicus_brief.pdf) [Accessed 14 December 2018].

<sup>235</sup> See *Amicus Brief*, [https://www.eff.org/files/2013/12/13/osp\\_lenz\\_amicus\\_brief.pdf](https://www.eff.org/files/2013/12/13/osp_lenz_amicus_brief.pdf) [Accessed 14 December 2018].

<sup>236</sup> See *Amicus Brief*, p.13, para.1, [https://www.eff.org/files/2013/12/13/osp\\_lenz\\_amicus\\_brief.pdf](https://www.eff.org/files/2013/12/13/osp_lenz_amicus_brief.pdf) [Accessed 14 December 2018].

<sup>237</sup> Testimony of Paul Sieminski (13 March 2014), p.3, <https://judiciary.house.gov/wp-content/uploads/2016/02/031314-Testimony-Sieminski.pdf> [Accessed 14 December 2018].

<sup>238</sup> See *Amicus Brief*, p.17, para.1, [https://www.eff.org/files/2013/12/13/osp\\_lenz\\_amicus\\_brief.pdf](https://www.eff.org/files/2013/12/13/osp_lenz_amicus_brief.pdf) [Accessed 14 December 2018].

<sup>239</sup> See *Amicus Brief*, p.17, para.3, [https://www.eff.org/files/2013/12/13/osp\\_lenz\\_amicus\\_brief.pdf](https://www.eff.org/files/2013/12/13/osp_lenz_amicus_brief.pdf) [Accessed 14 December 2018].

<sup>240</sup> See *Amicus Brief*, p.17, para.4, [https://www.eff.org/files/2013/12/13/osp\\_lenz\\_amicus\\_brief.pdf](https://www.eff.org/files/2013/12/13/osp_lenz_amicus_brief.pdf) [Accessed 14 December 2018].

<sup>241</sup> See *Amicus Brief*, p.17, para.6, [https://www.eff.org/files/2013/12/13/osp\\_lenz\\_amicus\\_brief.pdf](https://www.eff.org/files/2013/12/13/osp_lenz_amicus_brief.pdf) [Accessed 14 December 2018].

<sup>242</sup> DMCA §512(f).

<sup>243</sup> *Online Policy Group v Diebold*, 337 F. Supp. 2d 1195 (N.D. Cal. 2004).

College posted these conversations online, which were then linked to from the independent news organisation IndyMedia's website. Diebold issued a takedown notice under the DMCA to the Online Policy Group,<sup>244</sup> who was acting as IndyMedia's webhost. As the subject of the notice was links, and therefore not content that they directly hosted, OPG refused to disable access, and instead sued Diebold, along with the college students. The EFF, along with the Center for Internet and Society Cyberlaw Clinic from Stanford Law, took up the representation, and filed for damages under §512(f). Their argument was that Diebold had "knowingly materially misrepresented" that the material or activity that they were claiming copyright over was infringing. Diebold lost the case, and reportedly went on to agree to damages of \$125,000.<sup>245</sup>

In delivering the decision, the judge stated that "no reasonable copyright holder" would have thought that the email discussions were subject to copyright protections. He went on to say:

"The fact that Diebold never actually brought suit against any alleged infringer suggests strongly that Diebold sought to use the DMCA's safe harbor provisions – which were designed to protect ISPs, not copyright holders – as a sword to suppress publication of embarrassing content rather than as a shield to protect its intellectual property."<sup>246</sup>

The judge's comments are fascinating for a number of different reasons. First, it suggests that if a copyright holder only uses the notice and takedown process, and does not then proceed to take action against infringing parties, that it could be inferred that they do not in fact take the alleged infringement seriously. If this is so, then it suggests that the DMCA is only to be treated as a temporary stopgap measure to have content removed while legal proceedings are being prepared – rather than a solution in itself.

In November of 2013, Automattic announced that it intended to take action on behalf of its users in two cases where they believed that the DMCA process was being abused to censor the contents of blogs on their platform.<sup>247</sup> In one of the cases,<sup>248</sup> the facts concerned a student journalist named Oliver Hotham who published an email interview with a group called "Straight Pride UK" on his WordPress.com site. Unhappy with the way in which

their organisation was portrayed, Straight Pride submitted a DMCA takedown notification, and the allegedly infringing material was removed. The court held that this resulted in a misrepresentation by the complainant, as they "could not have reasonably believed" that it was protected by copyright.<sup>249</sup> As the defendant failed to plead, a default judgment was given, with a total of \$25,084 awarded in damages.<sup>250</sup> This was an important victory, but may prove to be largely symbolic, owing to the difficulty involved in collecting on the award from an overseas defendant.

Aside from the cases above, there are few examples available of successful claims brought under §512(f) for abuse of the takedown process. The bar is set high, and as a result, it is "exceedingly difficult for an end-user to succeed in a claim for misrepresentation against a copyright holder".<sup>251</sup> As a result, there is a lack of real consequences for abuse of the DMCA.<sup>252</sup> Even where such actions are victorious, there can be difficulties with collecting the damages awarded. Anybody can submit a DMCA takedown notification, and where the complainants is located outside America, it can prove extremely difficult to enforce against them any judgments made under §512(f).

Another issue with the §512(f) remedy is that in order for there to be damages, access to the material in question must actually have been removed, or had access to it disabled.<sup>253</sup> This means that actions can only be brought against parties who abuse the system where the receiving service provider actually processes the takedown notifications. As a result, there are few remedies against those actors who frequently submit fraudulent or abusive takedown notifications that are rebuffed.

## Improving the DMCA

It seems clear that the notification and takedown process has "evolved into a highly complex ecosystem",<sup>254</sup> and the many criticisms reinforce the view that the DMCA "slipping into irrelevancy".<sup>255</sup> With many platforms stressing their reliance on the safe harbour in order to maintain their economic operations,<sup>256</sup> it seems likely that without specific intervention, this abuse will continue unabated.<sup>257</sup> Significant change will undoubtedly prove a challenge, as running contrary to the commonly perceived copyright narrative of intermediaries versus rights holders,

<sup>244</sup> OPG.

<sup>245</sup> See <https://www.eff.org/cases/online-policy-group-v-diebold> [Accessed 14 December 2018].

<sup>246</sup> *Online Policy Group v Diebold* 337 F. Supp. 2d 1195, 1205 (N.D. Cal. 2004).

<sup>247</sup> P. Sieminski, "Striking Back Against Censorship" (21 November 2013), *WordPress.com News*, <http://en.blog.wordpress.com/2013/11/21/striking-back-against-censorship> [Accessed 14 December 2018].

<sup>248</sup> *Automattic Inc v Steiner* 82 F. Supp. 3d 1011, 1030, 1032 (N.D. Cal. 2015).

<sup>249</sup> *Automattic Inc v Steiner* 82 F. Supp. 3d 1011, 1030, 1032 (N.D. Cal. 2015) at \*10.

<sup>250</sup> *Automattic Inc v Steiner* 82 F. Supp. 3d 1011, 1030, 1032 (N.D. Cal. 2015) at Part IV. See <https://docs.justia.com/cases/federal/district-courts/california/candce/4-2013cv05413/272130/37> [Accessed 14 December 2018].

<sup>251</sup> O'Donnell, "Lenz v. Universal Music Corp. and the Potential Effect of Fair Use Analysis Under the Takedown Procedures of §512 of the DMCA" (2009) 10 *Duke Law & Technology Review*, available at <https://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=1194&context=dltr> [Accessed 3 January 2019].

<sup>252</sup> Cobia, "The Digital Millennium Copyright Act Takedown Notice Procedure" (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 394, para.2.

<sup>253</sup> USC 17 §512(f)(2).

<sup>254</sup> Urban et al., "Notice and Takedown in Everyday Practice" (2017), p.3 para.2.

<sup>255</sup> Hassanabadi, "Viacom v. YouTube – All Eyes Blind: The Limits of the DMCA in a Web 2.0 World", (2011) 26 *Berkeley Technology Law Journal*, p.405 para 1.

<sup>256</sup> Urban et al., "Notice and Takedown in Everyday Practice" (2017), p.114, para.2.

<sup>257</sup> Miller, "Fair Use Through the Lenz of §512(c) of the DMCA" (2010) 95 *Iowa Law Review* 1697, 1723, para.4.

the two groups “are not monolithic”,<sup>258</sup> with substantial nuance involved. With that caution in mind, there remain a number of different proposals that would help address the issues with §512 that have been outlined. Some of these are introduced and analysed below.

### *Procedural clarification and amendment*

The most obvious starting point for the improvement of the notification and takedown process is perhaps in its statutory requirements. Simple amendments to address the open questions outlined earlier in this paper would help bring clarity, and reduce a reliance on the interpretation and policy decisions of individual intermediaries.

Another major area of improvement would be to take steps to address the disparity between the formal requirements of a takedown versus a counter-notification. To achieve this, both parties should be allowed to act through a designated third-party agent, rather than this avenue being open solely to the original complainant. In addition, the 10- to 14-day period that must pass after a counter-notification has been received before access to allegedly infringing material can be restored by a service provider should also be shortened, or done away with altogether. This would reduce the immediate harmful impact of fraudulent or abusive takedown notifications, by allowing access to the content to be quickly reinstated. Given that the subscriber is stating that they have the right to use the content as part of the counter notification process—there appears to be little requirement for this interstitial buffer.

Secondly, our understanding of copyright must be reshaped in light of how we now culturally engage with material. There should be explicit exceptions under the DMCA for material that is reproduced without seeking any commercial gain, and used merely as cultural reference.<sup>259</sup>

### *Penalties for abuse*

It is clear that there are no real practical penalties for those that submit notices in bad faith that may otherwise be considered formally valid.<sup>260</sup> To help deter abuse of the DMCA, one approach would be for those who repeatedly submit fraudulent or abusive takedown notifications to be subject to the same kind of repeat infringer policy that applies to those who consistently infringe copyrights. This could be done through a temporary suspension of their privilege to submit takedown notifications, or in extreme cases, even by suspending their copyright enforcement rights entirely for a temporary basis.<sup>261</sup> This

is something that at least one online service provider has elected to pursue unilaterally, with “The Ultimate Ebook Library” threatening to ignore all future takedown notifications from a particular complainant who they considered to have repeatedly abused the process.<sup>262</sup> However, this is a risky strategy, as without statutory backing, the platform would lose its safe harbour protections, and risks opening itself up to future liability from legitimate copyright claims that are not acted upon, even if they originate from a serial DMCA abuser.

### *Deeper involvement of the US Copyright Office*

Writing in 2009, Jeffrey Cobia put forward the suggestion that in order to combat DMCA abuse, an additional branch of the US Copyright Office could be created which would conduct an initial investigation into all DMCA takedown notifications.<sup>263</sup> This would help ensure that the implications for freedom of speech and fair use were given due consideration. Cobia argued that while there may be a backlog initially, that copyrights should also be required to be formally registered in order to receive protection. This would help reduce the complexity of the cases, as well as the training required to deal with them,<sup>264</sup> and such a revised system would see a reduction in fraudulent and arbitrary claims over time.<sup>265</sup> However, it is difficult to see how this would operate in practice today.

A requirement for all copyrights to be registered with the US Copyright Office would effectively mean that any time anybody took a photograph, or wrote a blog post, or recorded a video on their phone, they would need to go through a formal registration process in order to ensure that their rights were protected from unauthorised dissemination and reproduction. As well as creating an undue burden on right holders as a result, it would also place immense pressure on the USCO as a central repository. The registration requirement may make sense to some extent in a commercial setting, but not in the world of instant authorship and content publication. Another question that would need to be considered would be the overall role of the DMCA, which has become the de facto process for many international complaints to have content taken down online, thanks to the dominance of the American technology sector.

If there were practical solutions to the problems posed by a focus on registration, it remains difficult to see how any single agency could cope with the vast quantities of takedown notifications that are currently handled by online service providers, many of whom currently do not have a manual review process. Google alone has received billions of takedown notices, affecting over one million

<sup>258</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.4, para.3.

<sup>259</sup> Sundell, “Tempting the Sword of Damocles” (2011) 12 Minn. Journal of Law, Science, and Technology 335, 350, para.2.

<sup>260</sup> Urban et al., “Notice and Takedown in Everyday Practice” (2017), p.117, para.1.

<sup>261</sup> Sundell, “Tempting the Sword of Damocles” (2011) 12 Minn. Journal of Law, Science, and Technology 335, p. 1725–1726.

<sup>262</sup> “Ebook Library Punishes Anti-Piracy Outfit for Wrongful DMCA Notices” (11 March 2015), *TorrentFreak.com*, <https://torrentfreak.com/ebook-library-punishes-anti-piracy-outfit-for-wrongful-dmca-notices-150311/> [Accessed 14 December 2018].

<sup>263</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 Minn. Journal of Law, Science, and Technology 387, 404–405.

<sup>264</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 Minn. Journal of Law, Science, and Technology 387, 405, para.1.

<sup>265</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 Minn. Journal of Law, Science, and Technology 387, 405, para.3.

separate websites from March 2011 to February 2017.<sup>266</sup> Clearly, sweeping changes would need to be made to core parts of the DMCA to reduce this kind of volume substantially in order for any single agency to handle it. One such step would be to outlaw the use of automated bots to send out takedown notifications, though that would be incredibly problematic to detect or to enforce in practice. It seems that the costs involved in the creation of such a department would indeed be prohibitive.

Finances aside, another significant issue with the proposal would concern the time taken to process requests. One of the main benefits of the DMCA for copyright holders is the ability to have access to allegedly infringing content removed rapidly, without the need for the involvement of a third party to make that determination. Even if response times were relatively low, including the USCO as a first call for every single takedown notification would inevitably add to the time involved.

Finally, establishing a branch within the USCO with the aim of rejecting takedown notifications that target fair use of material would effectively turn that branch into a court of first instance. As outlined earlier, the fair use doctrine is highly dependent on the facts of each situation, and depends on judicial interpretation for its application. It is often far from certain which way a case will go, even if there is a solid fair use argument. It seems inevitable that pursuing this approach as a solution would instead result in increased litigation, in order to overturn the initial decisions of the USCO.

It seems clear that the absence of any real negative fallout from abuse of the DMCA means that the notification and takedown process is simply viewed as another tool in the arsenal of “content bullies”<sup>267</sup> to have material they dislike taken offline, irrespective of its legality, and so perhaps the most effective change to help prevent abuse of the DMCA would simply be to take steps ensure that there are real consequences for those who misuse the system,<sup>268</sup> as “a penalty of perjury that does not include a tangible consequence is not an effective deterrent”.<sup>269</sup> The current scope for damages under §512(f) is inadequate, and ineffective, with much resting on poorly defined ideas of what constitutes fair use.<sup>270</sup> In order to ensure consistency within the law, the doctrine of fair use should be more tightly defined, rather than operating on the particular facts involved.<sup>271</sup> This would have the dual benefit of reducing fraudulent submissions,

while also providing subscribers with clear guidelines on what use was and was not permissible.<sup>272</sup> There have been specific suggestions made with regard to how the above may be achieved, including the alteration of the statutory language to more explicitly spell out who would be eligible to claim damages, for what, and in what circumstances,<sup>273</sup> so this is not an aim which would be practically impossible to achieve.

These examples demonstrate just some of the possible changes that could be adopted to help curtail abuse of the DMCA, and address the procedural idiosyncrasies that result in imbalance. Whatever path is ultimately taken, it is unlikely to happen quickly, with intellectual property right holders arguing that online service providers should be doing more to ensure that their platforms are not repeatedly used for hosting infringing content through a “notice and staydown” system<sup>274</sup> and the platforms themselves pushing for more to be done about the indiscriminate use of the DMCA for inappropriate reasons.

## Summary

The compromise reached in the DMCA notification and takedown process between the interests of copyright holders, online service providers, and protecting freedom of speech has now existed for 20 years, throughout the formative years of today’s digital economy. It has successfully protected technology firms from liability—helping ensure their exponential growth and economic benefits—while also giving copyright holders the means to have infringing content swiftly removed without having to resort to litigation. However, it is far from the perfect solution, and there are many examples of its shortcomings.

Freedom of speech is central to the understanding of our “liberal democratic society”.<sup>275</sup> It is enshrined in art.19 of the Universal Declaration of Human Rights, as well as a myriad of other international treaties and constitutional documents, including the American Constitution under the First Amendment. It is crucial that we approach intellectual property issues with this at the forefront of our mind; “[giving] those values considerable, if not overriding, weight in copyright law and policy”.<sup>276</sup>

For the “built-in” protections for freedom of speech in copyright law<sup>277</sup> to have any real effect, there has to be an adequate means for users to be able to make use of

<sup>266</sup> Google Transparency Report, <https://www.google.com/transparencyreport/removals/copyright> [Accessed 14 December 2018].

<sup>267</sup> Neill and Lee, “Fixing Section 512” (2016) *American Intellectual Property Law Association Quarterly Journal*, p.2 para 2 available at <https://ssrn.com/abstract=2879696> [Accessed 14 December 2018].

<sup>268</sup> Sundell “Tempting the Sword of Damocles” (2011) 12 *Minn. Journal of Law, Science, and Technology* 335, 357, para.2.

<sup>269</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 406, para.2.

<sup>270</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 406, para.3.

<sup>271</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 406, para.3.

<sup>272</sup> Sundell, “Tempting the Sword of Damocles” (2011) 12 *Minn. Journal of Law, Science, and Technology* 335, 362, para.4.

<sup>273</sup> Neill and Lee, “Fixing Section 512” (2016) *American Intellectual Property Law Association Quarterly Journal*, pp.10–11 available at <https://ssrn.com/abstract=2879696> [Accessed 14 December 2018].

<sup>274</sup> Neill and Lee, “Fixing Section 512” (2016) *American Intellectual Property Law Association Quarterly Journal*, pp.14–15, available at <https://ssrn.com/abstract=2879696> [Accessed 14 December 2018].

<sup>275</sup> Netanel, *Copyright’s Paradox* (2008), p.24, para.4.

<sup>276</sup> Netanel, *Copyright’s Paradox* (2008), p.24, para.4.

<sup>277</sup> *Eldred v Ashcroft* 123 S. Ct 769, 789 (2003).

them. At present, it is almost entirely dependent on the willingness of an individual online service provider to open themselves up to liability, imposing an “additional layer of censorship” into the process.<sup>278</sup> In addition, despite the “flowery rhetoric”,<sup>279</sup> surrounding the doctrine of fair use, the protections are often weak and inconsistent in practice,<sup>280</sup> described perhaps more accurately as the “right to hire a lawyer”, rather than a reliable free speech defence.<sup>281</sup>

The notification and takedown process is a “blunt instrument”,<sup>282</sup> and it is clear that there is a fundamental bias in the DMCA towards the interest of copyright holders.<sup>283</sup> This, along with the lack of real consequences for submitting a fraudulent or abusive takedown results in a system that fails to give meaningful protection to the users of online platforms.<sup>284</sup> Of course, while copyright

in some form is an essential mechanism to ensure the above takes place, it does not follow that the restrictive understanding that exists today is required.<sup>285</sup> The expansion of copyright’s remit goes against its core purpose,<sup>286</sup> and we must find ways to restrain the use of intellectual property rights online to “within their designated limits”,<sup>287</sup> ensuring that “copyright’s free speech safeguards ... remain vibrant in the digital arena”.<sup>288</sup>

With high stakes, it is imperative that the DMCA adapts to meet the contemporary challenges that are faced with regards to copyright infringement, and freedom of speech online. The notification and takedown process is already a powerful tool, and fair use an uncertain shield to stand behind. Abuse of the provisions makes it almost impossible to fight back.

<sup>278</sup> Netanel, *Copyright’s Paradox* (2008), p.127.

<sup>279</sup> Netanel, *Copyright’s Paradox* (2008), p.77.

<sup>280</sup> Netanel, *Copyright’s Paradox* (2008), p.77.

<sup>281</sup> Netanel, *Copyright’s Paradox* (2008), p.77.

<sup>282</sup> Netanel, *Copyright’s Paradox* (2008), p.77, para.3.

<sup>283</sup> Cobia, “The Digital Millennium Copyright Act Takedown Notice Procedure” (2009) 10 *Minn. Journal of Law, Science, and Technology* 387, 399, para.2.

<sup>284</sup> O’Donnell, “Lenz v. Universal Music Corp. and the Potential Effect of Fair Use Analysis Under the Takedown Procedures of §512 of the DMCA” (2009) 10 *Duke Law & Technology Review*, available at <https://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=1194&context=dltr> [Accessed 3 January 2019], para.20.

<sup>285</sup> Netanel, *Copyright’s Paradox* (2008), p.103.

<sup>286</sup> Netanel, *Copyright’s Paradox* (2008), p.94.

<sup>287</sup> Mazzone, “Copyfraud” (2006) 81 *New York University Law Review* 1026, 1031, para.1.

<sup>288</sup> Netanel, *Copyright’s Paradox* (2008), p.88.