

The Hotham case: analysing the scope of the DMCA

Can the Digital Millennium Copyright Act ('DMCA') be used to remove content that may not infringe copyright interests, but that the 'copyright owner' disapproves of? What options are available to an internet service provider that receives such a takedown request? A recent incident involving a blogger, the organisation 'Straight Pride UK' and online service provider WordPress brings these questions to the forefront as Kathy Ossian of Ossian Law PC explains.

A key purpose of the DMCA¹ is to provide copyright owners with a way to seek removal of infringing content from a website. At the same time, the Act affords the site's service provider immunity from vicarious infringement through safe harbor provisions. To avail itself of the DMCA's safe harbor provisions, a service provider that receives a takedown request conforming with the statutory requirements must act 'expeditiously to remove, or disable access to' the content².

Most online service providers also give the poster of the content notice of the request and an opportunity to provide a counter-notice showing that the content does not infringe³. The DMCA specifically prohibits any material misrepresentation that online content is infringing (or has been improperly removed) and provides civil remedies for damages and attorney fees incurred by the alleged infringer, copyright owner and/or service provider injured as a result of such a misrepresentation⁴.

As a practical matter, a takedown request culminating in the removal of content espousing a contrary view from the person or entity seeking its removal may also garner

considerable publicity in the form of the re-posting of the content on other sites.

The Hotham-Straight Pride controversy

This summer, Oliver Hotham, whose blog⁵ is hosted by WordPress⁶, learned of Straight Pride UK, an organisation apparently advocating for 'straight equality.'⁷ Hotham sent Straight Pride a letter identifying himself as 'a freelance journalist' and asking questions about the organisation⁸.

Straight Pride responded by emailing Hotham a document entitled 'Press Release.' Hotham made some organisational and grammatical changes to the answers. He also noted that the organisation failed to answer two of his questions - one on the bullying of LGBTI and the other relating to other 'pride' movements. Hotham sent Straight Pride an email offering a second opportunity to respond and stating that if they didn't do so, he would 'make it clear in the article' that they were avoiding the questions. Hotham waited two days and, having received no response, published his blog article about the organisation called 'Oliver Hotham, - It's Great When You're Straight...Yeah,' including his edited versions of the answers to the remaining questions.

Soon after the publication of the article, Straight Pride's Press Officer, Nick Steiner, emailed Hotham; Steiner told Hotham that he did not have consent to publish the answers. Steiner requested that Hotham take down the article within seven days or Straight Pride would send a DMCA takedown request to WordPress to have it removed. Hotham did not remove the article, so Straight Pride sent the blogging site's US based operator, WordPress, a DMCA takedown request.

Article removal

True to its 'Digital Millennium Copyright Act Notice,'⁹ WordPress removed the content in response to Straight Pride's takedown request that, at least on its face, satisfied the statutory requirements, including verifying the accuracy of the request under penalty of perjury¹⁰. WordPress also notified Hotham of his right to submit a counter-notice to WordPress if he believed the copyright infringement notice 'was submitted in error.'¹¹ In taking these actions, WordPress was complying with the safe harbor provisions of the DMCA and WordPress' own posted procedure for addressing DMCA takedown requests.

The next move belonged to Hotham. As he explained in his follow-up article, submitting a counter-notice would require him to consent to jurisdiction 'for any judicial district in which [WordPress] may be found' and this was not something that UK-based Hotham was willing or able to agree to¹². Thus, WordPress did not restore the article.

Nevertheless, Hotham's original article was reposted hundreds of times by others and can easily be found online through a browser search of the article name.

In a statement afterwards, WordPress General Counsel Paul Sieminski stated "[w]e think this was a case of abuse of the DMCA and we don't think that taking it down was the right result. It is censorship using the DMCA."¹³ Straight Pride issued its own statement, reiterating that its communication with Hotham was not intended for publication, and that the article 'caus[ed] a great deal of illegal Harrassment and unwanted contact.'¹⁴

Options for online service providers

Could WordPress have handled the

Hotham/Straight Pride matter differently? Probably not - to maintain its safe harbor status under the DMCA, WordPress must afford a presumption of validity to any takedown request that, on its face, meets the statutory requirements.

The opportunity for the poster to submit a counter-notice provides the means to sort out those DMCA requests that are attempts at censorship from legitimate reports of copyright infringement. Where, as with Hotham, the poster chooses not to file a counter-notice, it is not surprising that the takedown request will prevail.

Faced with conflicting DMCA notices and counter-notices, an online service provider will likely let the parties fight directly. An example is a lawsuit between two bloggers on opposite sides of a home birthing debate¹⁵. Crosely-Cocoran, a midwife, posted a photo of herself on her blog in a graphic hand pose with the caption that she was giving Tuteur, a physician, 'something else to go back to her blog and obsess about.' Tuteur then copied the photo and posted it on her own blog without Crosely-Cocoran's express permission.

Crosely-Cocoran submitted a DMCA takedown request to Tuteur's web host. Tuteur filed a counter-notice. The web host notified both parties that it was up to them 'to pursue legal action.' The current lawsuit commenced whereby Tuteur alleges that Crosley-Cocoran made a material misrepresentation in her takedown request in violation of Section 523(f) of the DMCA. Crosley-Cocoran filed a motion to dismiss, which the court denied, leaving open the potential for Crosley-Cocoran to face damages under Section 512(f)¹⁶.

Deterring manipulation of the

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DMCA takedown process

The Hotham/Straight Pride controversy and the Tuteur/Crosely-Cocoran lawsuit illustrate how the DMCA takedown process can extend beyond copyright infringement issues. Under the safe harbor provisions of the DMCA, an online service provider has little discretion to act outside of the requirements of the Act and the provider's own posted procedures.

Perhaps the threat of court enforcement of statutory damages for a material misrepresentation in the DMCA takedown process, such as those under consideration in the Tuteur case, may serve as a deterrent to this type of behaviour. The re-posting of the content in question, as played out by Hotham's article, appears to remain an even more practical, affordable and expedient deterrent.

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1. Pub. L. 105-304 (8 October 1998). This article focuses specifically on DMCA Title II, also known as the Online Copyright Infringement Liability Limitation Act, 17 U.S.C. 512 ('OCILLA') which offers a safe harbor to online and internet service providers against liability for copyright infringement if they follow the OCILLA's safe harbor guidelines.

2. 17 U.S.C. 512.
3. For e.g. Vimeo.com's DMCA Notifications and Counter-Notifications Process at <http://vimeo.com/dmca> and Twitter's Copyright and DMCA policy at <http://support.twitter.com/articles/15795-copyright-and-dmca-policy>

4. 'Any person who knowingly materially misrepresents under this section (1) that material or activity is infringing, or (2) that material or activity was removed or disabled by mistake or misrepresentation, shall be liable for any damages, including costs and attorneys' fees, incurred by the alleged infringer, by any copyright owner . . . or by a service provider, who is injured by such misrepresentation . . .' 17 U.S.C. 512 (f)
5. <http://oliverhotham.wordpress.com>
6. WordPress's site is found at <http://wordpress.com> and is owned by Automattic Inc. Automattic is referred to as WordPress throughout this article.

7. When Hotham first contacted Straight Pride, the organisation had a website located at www.straightprideuk.com. The site appears to have no content as of 14 October 2013.

8. The source for the recitation of facts in this section is largely taken from Hotham's blog and the updated article 'The sordid tale of how I was censored by StraightPride UK' found at <http://oliverhotham.wordpress.com/2013/08/11/the-sordid-tale-of-how-i-was-censored-by-straight-pride-uk/>

9. <http://automattic.com/dmca/>

10. WordPress' DMCA notice states that: '[y]ou must include: A physical or electronic signature of the copyright owner or a person authorized to act on their behalf; Identification of the copyrighted work claimed to have been infringed; A description of the nature and exact location of the content that you claim to infringe your copyright, in sufficient detail to permit Automattic to find and positively identify that content. For example we require a link to the specific blog post (not just the name of the blog) that contains the content and a description of which specific portion of the blog post - an image, a link, the text, etc - your complaint refers to; Your name, address, telephone number and email address; A statement that you have a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law; and A statement that the information in the notification is accurate, and under penalty of perjury, that you are either the copyright owner or a person authorized to act on their behalf.'

11. WordPress' Counter-Notice policies and form are found at <http://automattic.com/dmca/dmca-counter-notice/>
12. <http://oliverhotham.wordpress.com/2013/08/11/the-sordid-tale-of-how-i-was-censored-by-straight-pride-uk/>
13. A. Hern, 'WordPress pulls interview with anti-gay group Straight Pride UK' (13 August 2013): <http://www.theguardian.com/technology/2013/aug/13/wordpress-straight-pride-uk>

14. See B. Smith, 'Straight Pride UK update: official statement' (12 August 2013) found at <http://ciswhitefemale.wordpress.com/2013/08/12/straight-pride-uk-update-official-statement/> where the entire Straight Pride official statement is posted.

15. Tuteur v. Crosley-Cocoran, Civil Action No. 13-10159-RGS.

16. Ibid., 'Memorandum and Order on Show Cause Response and Defendant's Motion to Dismiss' (10 September 2013): https://www.eff.org/sites/default/files/tuteur_order.pdf