

No. _____

In The
Supreme Court of the United States

VICTOR ELIAS PHOTOGRAPHY, LLC,
Petitioner,

v.

ICE PORTAL, INC.,
A DIVISION OF SHIJI (US), INC.,
Respondent.

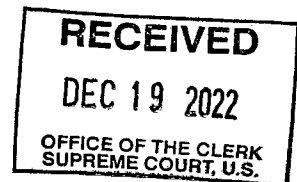
ON PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

Section 1202(b) of the Copyright Act, as amended by the Digital Millennium Copyright Act (DMCA), provides that “[n]o person shall, without the authority of the copyright owner or the law: (1) intentionally remove or alter any copyright management information...knowing, or...having reasonable grounds to know, that it will induce, enable, facilitate, or conceal an infringement of any right under this title.” 17 U.S.C. § 1202(b). Section 1202(c) of the statute defines “copyright management information” (CMI) to include “information conveyed in connection with copies...of a work...in digital form” such as the “title,” “name of...the author,” and “[i]dentifying numbers or symbols referring to such information or links to such information.” 17 U.S.C. §1202. The question presented is:

Whether a plaintiff alleging a violation of § 1202(b) is required to demonstrate that the defendant’s “intentional[] remov[al] or alter[ation]” of CMI “conveyed in connection with copies of [the plaintiff’s] work” was connected, linked or associated in some identifiable way to known instances of infringement, even though the plain language of the statute contains no such requirement.

PARTIES TO THE PROCEEDINGS

Applicant Victor Elias Photography, LLC was the plaintiff and appellant in the proceedings below.

Respondent Ice Portal, Inc., a division of Shiji (US), Inc. was the defendant and the appellee in the proceedings below.

RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, applicant Victor Elias Photography, LLC is a limited liability company that issues no stock and for which no Rule 29.6 statement is required.

STATEMENT OF RELATED CASES

There are none.

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Victor Elias Photography, LLC respectfully petitions for a writ of certiorari to review the judgment of the Eleventh Circuit.

OPINIONS BELOW

The opinion of the court of appeals (App. 1a-21a) is reported at 43 F.4th 1313. The order of the district court granting respondent's motion for summary judgment (App. 22a-35a) is not reported (but is available at 2021 WL 2384618 and 2021 U.S. Dist. LEXIS 86216).

JURISDICTION

The court of appeals entered its judgment on August 12, 2022. On October 28, 2022, in Application 22A357, Justice Thomas extended the time for filing a certiorari petition to and including December 10, 2022, which fell on a Saturday. Pursuant to the rules of this court, the petition would be due on the next day that is not a Saturday, Sunday, or legal holiday.

The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Relevant provisions of the Copyright Act (17 U.S.C.) as amended by the Digital Millennium Copyright Act, are reproduced at App. 53a-60a.

INTRODUCTION

The Eleventh Circuit's decision renders toothless the Digital Millennium Copyright Act's restrictions on removal of copyright management information from copyrighted works online contained in 17 U.S.C. § 1202(b). The restrictions prohibit

scrubbing out metadata attached to works online and implement the WIPO Copyright Treaty and WIPO Performances and Phonogram Treaty in force in nearly 100 countries. The restrictions on metadata scrubbing impose both civil and criminal penalties against online digital thieves. Copyright owners, especially photographers, depend upon these restrictions to protect their works and police infringement online.

The Court should grant the petition. The plain language of the statute directly contradicts the Eleventh Circuit's decision. The statute plainly penalizes violators who intentionally remove copyright management information metadata placed there by copyright owners to track their works online whether or not the violator also committed infringement of the works, and regardless of whether a connection exists between online infringements and the violator's CMI metadata scrubbing. Intentional CMI removal combined with constructive knowledge that removal induces, enables, facilitates, or conceals infringement violates the statute even in the absence of a connection between the removal and any infringement the copyright owner suffered. The court of appeals erroneously affirmed the district court's dismissal on summary judgment because Elias failed to demonstrate a connection between his "CMI cleansed photographs [that] appeared in at least two places on the internet," and Shiji's admitted, repeated, and knowing scrubbing of CMI from Elias' photographs before distribution all over the internet.

The Eleventh Circuit's decision is wrong. There is no requirement in the plain language of § 1202(b) that the plaintiff demonstrate specific connections

between the defendants' CMI removal and particular instances of infringement. Criminal liability is imposed under the statute on intentional CMI removers who know that their CMI removal will induce, enable, facilitate or conceal infringement. Civil liability is imposed against those same intentional CMI removers based on constructive knowledge – “reasonable grounds to know” – that their CMI removal will induce, enable, facilitate or conceal infringement. No proof of actual infringement or even potential infringement occurring anywhere is required for a plaintiff to prevail. Rather, as the Second Circuit determined in *Mango v. BuzzFeed, Inc.*, the plain language requires intentional removal of CMI coupled with proof of “constructive knowledge of future *concealment*, not future infringement.” 970 F.3d 167, 172 (2d Cir. 2020) (emphasis in original).

The Eleventh Circuit below split with the Second Circuit's interpretation of § 1202(b) when it rejected the application of the plain language of the statute against Shiji based on Elias' evidence that the same photographs Shiji stripped metadata from appeared online at travel websites without Elias' permission and in violation of his rights under the Copyright Act. The court of appeals below did “not believe that Congress meant to impose liability under the DMCA based on such a tenuous connection,” 43 F.4th at 1424, and sided with the Ninth Circuit in *Stevens v. CoreLogic, Inc.* that similarly required plaintiffs prove infringements directly connected to metadata removal to prevail. 899 F.3d 666, 673 (9th Cir. 2018).

Both the decision of the Eleventh Circuit in *Elias* and of the Ninth Circuit in *Stevens* effectively

wipe out legal protections for the integrity of CMI metadata granted by Congress to copyright owners in the plain language of § 1202(b). U.S. copyright owners who use CMI metadata to protect and track the use and misuse of their works online no longer possess a valuable legal remedy available to copyright owners in the rest of the world. Even more frustrating, there is simply no legitimate statutory construction or legislative authority for the Eleventh Circuit's requirement that a plaintiff come forward with proof of a connection between the defendant's CMI removal and some instance of infringement suffered by the plaintiff in the past. Section 1202(b) contains no such requirement in the plain language, and the Copyright Office has counseled against imposing one.

The Court should grant the petition to guide the courts in the correct reading of § 1202(b) based on its plain language, and to resolve the spit between the Eleventh and Ninth Circuits on one hand, and the Second Circuit on the other.

STATEMENT OF THE CASE

a. Statutory Background

1. In 1996, the World Intellectual Property Organization (WIPO), a specialized agency of the United Nations which administers most of the international treaties in the field of intellectual property (patents, trademarks, and copyrights), convened a diplomatic conference in Geneva, Switzerland, to consider three draft treaties in the field of intellectual property. Delegates representing more than 160 countries participated in the conference, which ultimately adopted the WIPO

Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT).

On July 28, 1997, the President submitted to the Senate for its advice and consent to ratification of the treaties by the United States, accompanied by recommendations for implementing legislation. Ex. Rept. 105-25 - WIPO Copyright Treaty (WCT) (1996) and WIPO Performances and Phonograms Treaty (WPPT) (1996), Ex.Rept.105-25, 105th Cong. (2022), <https://www.congress.gov/congressional-report/105th-congress/executive-report/25/1>. On October 21, 1998, the Senate resolved by advice and consent to the WCT and WPPT with certain minor exceptions not applicable here. *Id.*

2. Article 12 of the WCT requires:

(1) Contracting Parties shall provide adequate and effective legal remedies against any person knowingly performing any of the following acts knowing, or with respect to civil remedies having reasonable grounds to know, that it will induce, enable, facilitate or conceal an infringement of any right covered by this Treaty or the Berne Convention:

(i) to remove or alter any electronic rights management information without authority;

(ii) to distribute, import for distribution, broadcast or communicate to the public, without authority, works or copies of works knowing that electronic rights management information has been removed or altered without authority.

(2) As used in this Article, “rights management information” means information which identifies the work, the author of the work, the owner of any right in the work, or information about the terms and conditions of use of the work, and any numbers or codes that represent such information, when any of these items of information is attached to a copy of a work or appears in connection with the communication of a work to the public.

Treaty Document 105-17 - WIPO Copyright Treaty (WCT) (1996) and WIPO Performances and Phonograms Treaty (WPPT) (1996) (2022), <https://www.congress.gov/treaty-document/105th-congress/17>.

3. Article 19 of the WPPT provides:

(1) Contracting Parties shall provide adequate and effective legal remedies against any person knowingly performing any of the following acts knowing, or with respect to civil remedies having reasonable grounds to know, that it will induce, enable, facilitate or conceal an infringement of any right covered by this Treaty:

(i) to remove or alter any electronic rights management information without authority;

(ii) to distribute, import for distribution, broadcast, communicate or make available to the public, without authority, performances, copies of fixed

performances or phonograms knowing that electronic rights management information has been removed or altered without authority.

(2) As used in this Article, "rights management information" means information which identifies the performer, the performance of the performer, the producer of the phonogram, the phonogram, the owner of any right in the performance or phonogram, or information about the terms and conditions of use of the performance or phonogram, and any numbers or codes that represent such information, when any of these items of information is attached to a copy of a fixed performance or a phonogram or appears in connection with the communication or making available of a fixed performance or a phonogram to the public.

Id.

2. On October 28, 1998, the Digital Millennium Copyright Act (DMCA), which implemented *inter alia* Article 12 of the WCT and Article 19 of the WPPT, became law. 112 Stat. 2860, Pub. L. 105-304, 105th Cong. (1998). DMCA § 1202(b) imposes liability for removal or alteration of copyright management information:

(b) Removal or alteration of copyright management information. No person shall, without the authority of the copyright owner or the law--

(1) intentionally remove or alter any copyright management information,

(2) distribute or import for distribution copyright management information knowing that the copyright management information has been removed or altered without authority of the copyright owner or the law, or

(3) distribute, import for distribution, or publicly perform works, copies of works, or phonorecords, knowing that copyright management information has been removed or altered without authority of the copyright owner or the law,

knowing, or, with respect to civil remedies under section 1203 [17 U.S.C. § 1203], having reasonable grounds to know, that it will induce, enable, facilitate, or conceal an infringement of any right under this title.

17 U.S.C. § 1202(b).

3. Section 1202(b)(1) prohibits the removal or alteration of CMI. Section 1202(b)(3) prohibits distribution of copies of works with CMI removed or altered. Both subsections are enforceable in civil actions for damages. 17 U.S.C. § 1203(a) (“Any person injured by a violation of section . . . 1202 may bring a civil action in an appropriate United States district court for such violation.”). Both subsections may also be the subject of criminal prosecutions. See 17 U.S.C. § 1204(a).

4. “Copyright management information” (CMI) is defined in § 1202(c) as:

any of the following information conveyed in connection with copies or phonorecords of a work or performances or displays of a work, including in digital form, except that such term does not include any personally identifying information about a user of a work or of a copy, phonorecord, performance, or display of a work:

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

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

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

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

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

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

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

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

17 U.S.C. § 1202(c).

b. Factual Background

1. Victor Elias is a professional advertising and fine art photographer specializing in commissioned advertising photography of hotels and resorts worldwide for hotelier clients like Starwood, Marriott, and Wyndham. Elias' photographic style, and his serene and tantalizing visuals of resort properties, are sought after by hotel properties who hire and rehire Elias to capture the beauty of their hotel and resort architecture, landscaping, guest rooms and amenities. Elias' company owns Elias' images by written assignment.

Elias zealously protects the copyrights in his images. In addition to registering copyright promptly, he retains copyright ownership of his images and only issues limited licenses to his hotel clients of the rights necessary for their use. And, relevant to this case, Elias imprints all his images with his copyright management information embedded in the metadata of the images.

The 218 registered photographs at issue in this case were taken by Elias from 2014 through 2017 of eleven luxury hotels in Mexico, El Salvador, and Puerto Rico. None of Elias' licensing agreements permitted the removal or alteration of Elias' copyright management information. To the contrary, the licenses specifically required attribution of Elias' photographs as "Credit: Victor Elias Photography" or "Victor Elias Photography."

Like many professional photographers, Elias has been a victim of rampant infringement online where copying is as easy as right clicking an image and choosing "save." Elias' livelihood depends upon his continued ability to control and license his images using CMI metadata. When a travel magazine lawfully uses an Elias image, the magazine extracts attribution information from image metadata and credits Elias in the gutter identifying him as the author and source; this helps Elias secure future business. CMI in the metadata of Elias' images also permit him to search out and identify infringing uses of his images online and pursue rights violators. Elias policed the use of his images by his hotel clients, and their retention of Elias' embedded CMI metadata, and confirmed that the hotels complied with their obligation to retain and not delete or alter Elias' embedded metadata when they used his images.

2. Shiji's business since 2004 is distributing photographs to online travel agencies (OTA) for its hotel clients. Shiji maintains over 1.5 million images in its database and distributes those images to hundreds of OTAs worldwide. Shiji's proprietary system downloads image files from its hotel clients and saves them to Shiji's server, along with a list in

spreadsheet form containing information about each image. Shiji's proprietary system then makes multiple JPEG copies of the photos it received in various industry standard sizes optimized for faster display by OTAs on the internet and saves those copies on Shiji's server where OTAs access them along with the information about each photo.

It is undisputed that Shiji's proprietary system strips out the embedded CMI metadata added to images by photographers like Elias.

3. Shiji knew since at least 2014 that its proprietary system scrubbed CMI metadata from photographers' images. In two arbitrations, one commenced in 2014 and another in 2016, Shiji's competitor Leonardo accused Shiji of scrubbing images of CMI inserted by Leonardo, and then republishing the images on Shiji's own website for financial gain. Leonardo accused Shiji of removing CMI from the images and distributing the images knowing they were cleansed of CMI in violation of § 1202(b). The two most senior executives of Shiji admitted at depositions in both arbitrations that they knew Shiji's system scrubbed images of metadata years before Elias' suit was filed.

Shiji also knew, or at least had reasonable grounds to know, that its removal of CMI from images run through its proprietary CMI metadata scrubbing system would induce, enable, facilitate, or conceal infringements of the images Shiji distributed to OTAs. Shiji was accused in both arbitrations of distributing images knowing they were cleansed of CMI and thereby inducing, enabling, facilitating, or concealing Shiji's own infringement of copyrighted images.

4. Shiji knew from the two arbitrations with Leonardo commenced in 2014 and 2016, and from Shiji's relationship with its client Radisson, that retention of CMI image metadata, was not only an essential business requirement, but a requirement of law.

Shiji was accused in both arbitrations of violating § 1202(b). Therefore, Shiji knew what the law required of it when processing images belonging to others, namely not to scrub images of CMI metadata.

Shiji was asked by its client Radisson in 2020 to write software to extract information from CMI metadata contained in Radisson's images housed in Shiji's database. Shiji knew that its own clients placed a value on Shiji's retention of CMI metadata, and that Shiji's own clients entrusted Shiji to maintain and not strip out that metadata from images in its custody and control.

c. Proceedings Below

1. Elias commenced this action on August 29, 2019. Elias' first amended complaint (FAC) filed on October 4, 2019 against Shiji alleged a single count for removal or alteration of copyright management information in violation of 17 U.S.C. § 1202. (Appx. 36a-52a).

The FAC alleged that Elias consistently embeds CMI metadata in his images. Image metadata allows him to police infringement using online search engines since CMI metadata is full text searchable and discoverable. Elias visits OTA websites and searches for hotels he photographed to examine the photos that appear. Elias uses ImageRights' software

service and TinEye's reverse image search service to find visual matches for Elias' images online.

The FAC alleged that in September of 2016, Elias discovered numerous infringements of his images on websites for OTAs that were scrubbed of his CMI metadata. Some of these OTA websites also displayed Elias' images with false gutter credit and false attribution. Several of Elias' images reflected credit reading "provided by ICE Portal," Shiji's image distribution company. Elias' embedded CMI metadata was scrubbed from all these images. Elias' investigations discovered dozens of infringements. In all cases of infringement that Elias discovered, his embedded CMI metadata was scrubbed from his images.

Shiji produced spreadsheets in discovery showing they received Elias' photos from its hotel clients containing Elias' embedded CMI metadata intact. Thereafter, Shiji's system made multiple JPEG copies of Elias' photographs and, in the process, scrubbed out Elias' CMI metadata from images. Shiji admitted its proprietary system did not retain embedded CMI metadata during processing through Shiji's system. Shiji explained that retaining CMI metadata was never a "business requirement" for the company. Even after Elias' case was filed it appeared that Shiji did nothing to change its CMI metadata scrubbing system.

2. The parties cross-moved for summary judgment. The district court granted Shiji's motion. The district court determined that there were insufficient issues of fact for a trial on the issue of whether Shiji knew that its removal of Elias' CMI metadata would induce, enable, facilitate, or conceal

infringement of Elias' images. Relying upon the Ninth Circuit's decision in *Stevens*, the district court found that Shiji's use of Elias' photographs was not an infringement of copyright because Shiji was licensed to distribute Elias' images to OTAs and therefore Shiji did not know, nor should it have known, that its CMI metadata scrubbing would induce, enable, facilitate, or conceal infringement of Elias' images. The district court also concluded that Elias failed to prove that Shiji's removal of CMI was "the reason, or even the likely reason, for the infringing use of the images Plaintiff has found on the internet."

3. Elias appealed timely to the Eleventh Circuit. On August 12, 2022, the court of appeals affirmed.

REASONS FOR GRANTING THE PETITION

This case provides an ideal vehicle for review by this Court and an opportunity to resolve the question presented to determine the proof required and mental state necessary for a violation of § 1202(b).

The policy issues are important. The internet is the world's biggest copy machine. The ease with which digital works can be copied and distributed worldwide discourages copyright owners from making their works available online without protection against piracy. Two treaties signed by over 100 countries recognize that CMI metadata requires protection to further the purposes of copyright and discourage infringement. Congress enacted the DMCA to implement the U.S.'s treaty obligations under WCT and WPPT. The use of CMI metadata provides important protections for copyright owners

and should be encouraged, not discouraged. The Eleventh Circuit's decision eviscerates the protections for CMI integrity provided by § 1202(b), and discourages copyright owners from using CMI metadata because it deprives them of an effective remedy when CMI is scrubbed from their works.

The decision below rewrote § 1202(b) to require evidence linking the defendant's removal of CMI with specific instances of infringement. Violations were difficult to prove before the Eleventh Circuit's decision because of the steep mental state requirement, but now establishing liability requires plaintiffs to prove a negative by eliminating all likely future infringement scenarios involving third parties unrelated to the defendant. Future plaintiffs cannot prevail unless they find the needle in the haystack by scouring the enormity of the internet for definitive evidence linking the defendant's removal of CMI with specific instances of infringement of the plaintiff's images online caused by defendant's metadata scrubbing.

This case is the ideal vehicle in which to resolve the statutory question presented.

I. THE COURT SHOULD GRANT REVIEW TO RESOLVE A CONFLICT AMONG THE COURTS OF APPEALS ON A MATTER OF SIGNIFICANT PRACTICAL IMPORTANCE TO COPYRIGHT OWNERS

a. The Courts of Appeals are Divided on the Question Presented and Will Remain So Absent this Court's Review

The Second Circuit referred to § 1202(b) as containing a “double-scienter” requirement. See *Mango*, 970 F.3d at 171 citing § 1202(b)(3); *Zuma Press, Inc. v. Getty Images (US), Inc.*, 845 F. App’x 54, 57 (2d Cir. 2021) (citing *Mango*). The statute calls for proof of “double scienter” because “the defendant who distributed improperly attributed copyrighted material must have actual knowledge that CMI ‘has been removed or altered without authority of the copyright owner or the law,’ as well as actual or constructive knowledge that such distribution ‘will induce, enable, facilitate, or conceal an infringement.’” *Mango*, 970 F.3d at 171.

To prove a violation of § 1202(b)(2) for distributing works with CMI removed, the Second Circuit requires proof of “(1) the existence of CMI in connection with a copyrighted work; and (2) that a defendant ‘distribute[d] ... works [or] copies of works’; (3) while ‘knowing that [CMI] has been removed or altered without authority of the copyright owner or the law’; and (4) while ‘knowing, or ... having reasonable grounds to know’ that such distribution ‘will induce, enable, facilitate, or conceal an infringement.’”

Mango, 970 F.3d at 171 citing § 1202(b) and *Fischer v. Forrest*, 968 F.3d 216, 222–23 (2d Cir. 2020).

The Second Circuit in *Mango* did not require either a) specific proof that CMI removal caused an actual infringement by anyone, or b) specific knowledge of the existence of an actual infringement anywhere. Neither does the text of § 1202(b). The statute only requires the plaintiff to prove the defendant possess the mental state of knowing, or having a reasonable basis to know, that his actions “will induce, enable, facilitate, or conceal infringement.” § 1202(b). The statute requires only general knowledge, not specific knowledge.

The Ninth Circuit in *Stevens*, like the Eleventh Circuit below, requires plaintiffs prove specific knowledge by defendants of identifiable infringements to withstand summary judgment.

In *Stevens* the plaintiffs alleged CoreLogic, a provider of software to multiple listing services (MLS), operated MLS software that failed to preserve embedded photographic CMI metadata by default. *Stevens*, 899 F.3d at 672. CoreLogic’s software stripped out, deleted, and failed to preserve embedded CMI metadata. *Id.* “After receiving the Photographers’ initial complaint, CoreLogic modified its software to ensure that EXIF metadata is copied and restored to images processed by CoreLogic’s MLS software.” *Id.* While the photographers in *Stevens* contended that even after CoreLogic modified its software, it continued “to remove IPTC metadata,” *id.*, the Ninth Circuit affirmed summary judgment for CoreLogic.

The Ninth Circuit in *Stevens* focused on the second scienter element of knowing or having reasonable grounds to know that removal of CMI would induce, enable, facilitate, or conceal an infringement. *Stevens* held that a plaintiff must show the defendant possessed “a state of mind in which the knower is familiar with a pattern of conduct’ or [was] ‘aware of an established modus operandi that will in the future cause a person to engage in’ a certain act,” *Stevens*, 899 F.3d at 674, quoting *United States v. Todd*, 627 F.3d 329, 334 (9th Cir. 2010).¹

The Ninth Circuit also required that plaintiffs prove specific knowledge by defendants of identifiable infringements. “To avoid superfluity, the mental state requirement in Section 1202(b) must have a more specific application than the universal possibility of encouraging infringement; specific allegations as to how identifiable infringements ‘will’ be affected are necessary.” *Stevens*, 899 F.3d at 674. In order to prevail, a plaintiff must “provide evidence from which one can infer that future infringement is likely, albeit not certain, to occur as a result of the removal or alteration of CMI.” *Id.*, 899 F.3d at 675.

b. The Question Presented is Important

Congress enacted the DMCA because “of the ease with which software (and other electronic media) can be copied,” and “the ease with which pirates could copy and distribute a copyrightable work in digital

¹ *Todd*, a criminal sex trafficking case, arguably required a higher level of knowledge than the constructive knowledge that suffices for civil liability for violations of § 1202(b).

form.” *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 458 (2007) quoting *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 435 (2d Cir. 2001). Image piracy is on the rise; one study found that in 2018, approximately 2.5 billion images were used without authorization per day on the internet. Copytrack Global Infringement Report: International Image Theft in Comparison (2019) available at https://www.copytrack.com/wp-content/uploads/2019/03/Global_Infringement_Report_2019_EN.pdf (accessed Dec. 11, 2022). Photographers are frequent victims; over 1,000 lawsuits were filed by photographers in federal courts against commercial businesses for copyright infringement between Mar. 1, 2020 and Mar. 1, 2021. See Eckhause, M., *Fighting Image Piracy or Copyright Trolling? An Empirical Study of Photography Copyright Infringement Lawsuits*, 86 Albany L.R. — (forthcoming) available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4126676 (accessed Dec. 11, 2022).

The internet is the world’s biggest copy machine. The ease with which digital works can be copied and distributed worldwide discourages copyright owners to make their works available online without protection against piracy. S. Rept. 105-190 at 8.

The use of CMI metadata provides important protections for copyright owners and should be encouraged, not discouraged. “The purpose of CMI is to facilitate licensing of copyright for use on the Internet and to discourage piracy.” S. Rept. 105-190 at 13, fn. 18. Examples of the use of CMI metadata to enable image sharing online includes the Google

Licensable Image Badge feature that reads embedded metadata and notifies users of Google's Image Search of the image's availability for licensing. Google's own documentation encourages developers to include metadata in images in order to facilitate these search results. See Google Search Central, Image License, (<https://developers.google.com/search/docs/advanced/structured-data/image-license-metadata>).

The use of CMI metadata also helps solve the "orphan work" problem. A digital photograph with no CMI can become an "orphan" work where the copyright owner cannot be identified. "When a defendant creates an 'orphan work' by removing CMI, there is the added risk to the copyright owner that future legislation will eliminate or limit copyright remedies against future infringers of such 'orphan works.'" "Orphan Works And Mass Digitization" A Report of the Register of Copyrights (June 2015) at 1 (<https://www.copyright.gov/orphan/reports/orphanworks2015>).

Due to the ease with which digital works can be copied and distributed worldwide virtually instantaneously, copyright owners will hesitate to make their works readily available on the Internet without reasonable assurance that they will be protected against piracy. The DMCA provides this protection and creates the legal platform for launching the global digital on-line marketplace for copyrighted works.

c. This Case Provides an Appropriate Vehicle for Resolution of the Question Presented

This case is the ideal vehicle in which to resolve the statutory question presented. The plaintiff's § 1202(b) claim is unaccompanied by an infringement claim against the defendant making it possible to squarely address the question presented.

The factual scenario has emerged before in *Stevens*, *Mango*, and other cases of online infringement. The procedural posture at summary judgment with the facts crystalized makes for efficient determination by this Court.

No better vehicle will emerge.

II. THE ELEVENTH CIRCUIT'S DECISION CONFLICTS WITH THE COPYRIGHT ACT

The Eleventh Circuit, relying on *Stevens*, affirmed dismissal of Elias' complaint for § 1202(b) violations because it found "no evidence linking Shiji's actions of removing the photographs' CMI with the instances of infringement Mr. Elias uncovered on the internet." *Elias*, 43 F.4th at 1323. Despite presenting evidence that Elias' photographs found on OTA websites were stripped of CMI, and despite evidence that the infringing images Elias found on non-party websites were also stripped of CMI, the court of appeals determined Elias' argument that Shiji should have known its CMI removal would induce, enable, facilitate, or conceal an infringement "rest[ed] on speculative and unsupported assumptions."

For example, the argument presumes that infringing parties would go to an OTA website (instead of the Hotels' or Elias LLC's own website) to copy the image. It also presumes that an infringing party would download the image, as opposed to taking a screenshot or screengrab of the image. Yet nothing in the record substantiates these inferences. For example, Mr. Elias admitted that he did not know from which website the third-party infringers copied the images. It is also unclear how the infringing parties copied the images — anyone with a smart phone could simply take a screenshot of the photograph from a website, which process inherently does not preserve the photograph's embedded CMI. Similarly, Mr. Elias acknowledged that unscrupulous infringers could easily remove CMI themselves.

Elias, 43 F.4th at 1323-24.

The court of appeals demanded too much of Elias. The statute contains no requirement that a plaintiff eliminate all likely future infringements by third parties unrelated to the defendant to prevail. Yet that's exactly what the court of appeals required.

a. **A Careful Reading of the Statute's Text Establishes that the Eleventh Circuit's Construction is Incorrect**

The Second Circuit determined in *Mango* that the plain language of § 1202(b) did not require proof that a defendant knew, or had reasonable grounds to know, that its conduct would lead to specific future, third-party infringement. *Mango*, 970 F.3d at 171.

First, “an infringement” is not limited to the infringing acts of third parties. The plain meaning of the statutory language also encompasses an infringement committed by the defendant himself. This includes the knowing, unauthorized infringement that serves as the basis for establishing the first scienter element of Section 1202(b). In other words, a defendant’s awareness that distributing copyrighted material without proper attribution of CMI will conceal his own infringing conduct satisfies the DMCA’s second scienter requirement.

Second, “an infringement” is not limited to future infringing conduct. Although the word “will” indicates future action, in the context of Section 1202(b), it is used in conjunction with the words “induce, enable, facilitate, or conceal,” not “an infringement.” *Id.* So the statutory language requires constructive knowledge of future concealment, not future infringement.

We thus reject the argument that a defendant must know or have reason to know about likely future infringement by third parties. Instead, Section 1202(b)(3) also encompasses “an infringement” that, upon distribution, “will . . . conceal” the fact of that infringement.

Mango, 970 F.3d at 172.

In a footnote, the Second Circuit noted that “interpreting Section 1202(b) to limit liability to defendants with knowledge of likely future infringements by third parties would be inconsistent with the purpose of the DMCA, which is to provide broad protections to copyright owners.” *Id.* at fn. 2 citing *Murphy v. Millennium Radio Grp. LLC*, 650 F.3d 295, 303 (3d Cir. 2011) (“As for the purpose of the statute as a whole, it is undisputed that the DMCA was intended to expand—in some cases . . . significantly—the rights of copyright owners.”).

The Eleventh Circuit raised the burden placed on the plaintiff by the statute beyond the plain language. A copyright owner’s burden to prove a defendant’s mental state is expressly lower than that required to prove criminal liability; a defendant need only have “reasonable grounds to know.” 17 U.S.C. § 1202(b). Requiring a plaintiff to prove a defendant’s knowledge of likely future infringements by third parties goes too far and contradicts the provision of the following section that permits the court to “reduce or remit the total award of damages” in cases where the violator demonstrates its violation was innocent. 17 U.S.C. § 1203(c)(5)(A) (“The court in its discretion may reduce or remit the total award of damages in any case in which the violator sustains the burden of

proving, and the court finds, that the violator was not aware and had no reason to believe that its acts constituted a violation.”)

b. The Eleventh Circuit’s Interpretation is Inconsistent with the Statute’s Purposes

During debate on the DMCA, the Register of Copyrights requested that Congress make clear that § 1202(b)’s requirement that the removal of CMI induce, enable, facilitate or conceal infringement does not require actual or constructive knowledge of “any particular act of infringement” but rather “just to make infringement generally possible or easier to accomplish.”

Some copyright owners have expressed concern that this standard will be too difficult to meet, requiring proof of an ultimate infringement in order to find a violation. The Copyright Office believes that it is important to make clear, possibly in legislative history, that the reference to infringement does not mean that the actor must have intended to further any particular act of infringement--just to make infringement generally possible or easier to accomplish.

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

Marybeth Peters, Register of Copyrights), available at https://www.copyright.gov/docs/2180_stat.html.

The Eleventh Circuit's application of § 1202(b) contradicts the purpose of the statute. By demanding "evidence linking Shiji's actions 'of removing the photographs' CMI with the instances of infringement Mr. Elias uncovered on the internet," *Elias*, 43 F.4th at 1323, the court of appeals required evidence that the actor intended to further a particular act of infringement, rather than simply making infringement possible or easier to accomplish. This frustrates the purpose of the statute at its core: to protect the integrity of CMI metadata without the need to prove specific instances of infringement that occurred in connection with its removal.

CONCLUSION

The petition for writ of certiorari should be granted.

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Respectfully submitted,

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