

The Good, the Bad, and the JPEG: Staying Safe in the Constant Showdown over Digital Content Use Online

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If “a picture is worth a thousand words,” is it worth it to use one picture in an online article that could end up costing thousands of dollars? Given the power of visual content to drive traffic to websites, it is clear why digital media companies use videos, photographs, illustrations, and memes to engage readers, even at the risk of increased vulnerability to copyright infringement claims. And the copyright pitfalls have grown and multiplied recently, which means digital media companies need to pay even closer attention to the management of their legal exposure when it comes to copyrights.

The last several years have seen a significant increase in the number of copyright infringement claims filed by photographers and photo licensing agencies, particularly against online and digital media platforms that license or use third-party content.¹ There are likely several reasons for the uptick, such as the increased availability and variety of content monitoring and enforcement services that search the Internet for protected content; the ubiquity of digital and social media platforms and small independent blog sites; the widespread unlicensed use of images encouraged by the ease of downloading image files online; and a misunderstanding of copyright law and its ramifications, including the common misconception that if it is on the Internet, it is free for the taking. These conditions have created the perfect storm for professional (and amateur) photographers and content licensors to use the copyright law to leverage settlement fees as a supplemental—and sometimes even primary—source of income in a depressed market where everyone with a smartphone fancies themselves an amateur Annie Leibovitz.

There is no question that copyright creators, authors, and their lawful assignees should be paid fairly for their work. However, an environment ripe for copyright infringement and enforcement is also ripe for abuse of the laws meant to protect creators. The digital media realm is a breeding ground for extremely aggressive litigators employing high-volume practices—some based solely online—known for tactics such as automatic filing of cookie-cutter complaints that often overlook the subtleties of copyright law and enforcement, not to mention basic litigation practice. This species of “shoot first, ask questions later” litigation has had significant implications for digital media companies of all types and sizes. These

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companies face not only a threat of significant financial exposure either through the legal system or with settlements made under pressure, but also the precarious task of determining lawful from unlawful use, an evaluation that is far from clear-cut, and often involves complex analyses such as the mercurial fair use doctrine.²

There is a delicate balance between ensuring compensation and deterring infringement on the one hand, and on the other hand strong-arming unwitting defendants into high-dollar settlements—often far more than the photographer or other copyright owner would ever have earned—by threatening costly litigation and highly unlikely worst-case-scenario damages awards.³ This article sets forth some basic best practices in responding to, evaluating, and defending against these types of copyright claims, as well as some steps that digital media companies large and small can take to reduce their risk of finding themselves on the business end of a copyright infringement complaint in the first place.

You've Received a Demand Letter—Now What?

Step One: Takedown

As is sometimes the case, an accused infringer may receive a demand letter pointing to a specific image or images located at a particular URL. Before removing the specific image at issue, take a screenshot of the image as it was posted, and of the web page or platform on which it was used, as well as any other websites the image or post linked to. Save this information for purposes of discovery; not only do you have an obligation to preserve relevant evidence once litigation is likely, but a detailed file will help you fend off any later claim that you “spoliated” evidence—a claim that plaintiffs sometimes make, which is especially perplexing when their initial demand letter instructed you to remove the image.⁴

Unless you are sure you have a license to use the specific image at issue (and therefore have an air-tight defense, discussed below), or you very quickly agree to a license arrangement with the copyright owner, you should remove the allegedly infringing image. If it turns out to be infringing, the longer it is up, the more damages the plaintiff will claim. Additionally, courts tend to look kindly upon defendants who cooperate with a copyright owner's request to remove images, and it can weigh in your favor in a court's analysis.⁵ If you are not sure whether the image was licensed, err on the side of caution. If it turns out to be a lawful use, you can always put it back up.

Step Two: Investigate Internally

The next step is to review your records and discuss the matter with your own personnel to determine what happened. If the claimed image is in fact the one that you used, the most important question is whether you have a license for the image. If not, find out who posted the image on your website or platform, when it was initially posted, how the image was procured, and whether it was paid for (and to whom payment was issued). As a technical matter, was the image file copied and uploaded? Or was it embedded (i.e., in-line linked to, or “framed” from another website)?⁶ These questions are key thresholds in determining your liability exposure.⁷

If the image was licensed from the photographer or from an authorized licensor for an authorized purpose, you are likely in the clear. If there was no permission and the image was merely “right-click licensed” (i.e., copied and saved) from a site like Google Images or a social media platform like Face-

book, Twitter, Instagram, or Pinterest and re-uploaded to your site, an infringement may have occurred assuming the use was not “fair.” Similarly, if the image was licensed from a third party that was not authorized to do so, you may still be liable. However, at least in some jurisdictions (e.g., the Ninth Circuit), if the image was *embedded* rather than *copied*, the embedder (i.e., you) may not be considered to have infringed, but that is not the case in other jurisdictions (e.g., New York), and the issue is up for grabs in still other jurisdictions.⁸

Another part of the internal investigation is analyzing whether you have a potential fair use defense. Fair use is a notoriously gray area of the law, and one with which attorneys and judges often struggle, and which courts and experts alike interpret differently.⁹ The basic factors relevant to a consideration of fair use include (1) the purpose and character of the use (whether the use of the image was commercial, and whether the use was “transformative”); (2) the nature of the copyrighted work (whether it was primarily creative or primarily factual);¹⁰ (3) how much of the image was used, and whether the “heart” of the work was used; and (4) whether the potential market for licensing the image was harmed.¹¹ An internal discussion of these factors may be useful, but the fair use discussion is probably one to have with an experienced copyright lawyer who is familiar with the relevant case law and has experience in making fair use arguments to judges.

Independent of the fair use analysis, you should attempt to determine, at least roughly, how much the image at issue would have cost to license. Relevant points of reference include actual licenses of that image assuming that data is available; prior licenses for similar types of images from similar caliber photographers; in the absence of any relevant à la carte licenses, reference to image subscription services, parsing out how much an individual image would cost on a monthly plan; and reference to image licensors like Getty Images, Shutterstock, Masterfile, and AP Images, whose websites allow you to price out a one-time license fee for a specific image for your particular market and usage type.

Determining a reasonable license fee is extremely important in the context of damages and settlement. Aggressive plaintiffs and their lawyers may throw around numbers like \$30,000 and \$150,000, referring to the Copyright Act’s highest thresholds for statutory damages¹²—the part of the law that allows plaintiffs with registered copyrights to recover certain minimum amounts of damages without having to prove their losses, and even if the actual licensing value of the image is minimal. But these theoretical numbers are often bandied about in vague threats in attempts to leverage a large settlement by instilling fear of a huge damages award later.

In reality, the availability of statutory damages depends on the owner having a valid copyright registration (discussed below), and the amount of a statutory damages award is ultimately within the discretion of the court. In other words, what a plaintiff wants is not synonymous with what a plaintiff is likely to recover.¹³ Indeed, in many courts, a statutory damages award is based on a benchmark of a reasonable license fee the particular defendant (or a comparable defendant) would have paid for the type of use the defendant made, multiplied three or five times (depending on willfulness), and then rounded up to the statutory minimum of \$750 if the resulting product is less.¹⁴ Having a general idea of the possible range of realistic damages, and knowing the law to support your position, can be helpful in negotiating an early settlement.

Finally, it helps to know your adversaries. Do some research on the photographer and his or her lawyers. Discovering their track records, reputations, and penchant for litigiousness can help set expectations for settlement and moving ahead into litigation. Settling early with a notoriously aggressive party or attorney may seem distasteful, but oftentimes the projected cost of litigation will force a defendant to look beyond principle. But sometimes not—more on this below.

Step Three: Respond to the Claim

Once you have investigated internally, spoken with counsel, and formulated your position, you will need to respond to the copyright owners themselves, or to their attorneys, to either forestall the initiation of litigation or slow the train if it has already left the station. If your investigation reveals you did not have a license and you do not have any other defense (remembering that innocent intent is not a defense to a strict liability tort like copyright infringement), it is often best to settle quickly; the demand (which was likely already too high at the outset) tends to go up even higher if a claimant is forced to file a complaint or proceed with a lawsuit in progress. The key is to negotiate a settlement that you can live with and that presumably is less than the cost to litigate.

As this article is not shy about observing, plaintiffs and their lawyers and other representatives in image use cases will inevitably ask for far more money right out of the starting gate than they would ever get at trial.¹⁵ They often cite the \$150,000 maximum damages range—which is unprecedented in cases that do not involve rampant piracy or extreme ill will—and try to portray themselves as generous when they “come down” to an offer of, say, \$25,000 which, as explained above, is itself usually outsized as against the typical award. Your job, or the job of your attorney, is to bring that number back down to earth using whatever tools you have at your disposal. If the use is arguably fair or subject to any other defense (discussed below), use those defenses as leverage and, ideally, back them up with case law. However, it is not uncommon for a plaintiff’s attorney to represent that his or her client is entitled to an astronomical award despite clear precedent to the contrary.¹⁶

Defenses or not, you should demand to see the plaintiff’s copyright registration if it has not already been provided; you can also check for a registration on copyright.gov. There are three reasons for making this demand. First, in some jurisdictions, failure to secure a registration is a bar to suit (in others, a pending registration may suffice).¹⁷ Second, a registration that is procedurally or administratively faulty can also derail what might seem to the photographer and his or her lawyer as an open-and-shut case, as it may rob that party of standing to sue in the first place. Third, a valid registration secured prior to the alleged infringement (or, if after the infringement, within three months of the first publication of the image) is necessary for a plaintiff to seek statutory damages and attorney fees.¹⁸ Oftentimes high-volume plaintiffs’ lawyers will send demands or file complaints without a valid or timely copyright registration, and sometimes calling out these deficiencies will shut down the case when the attorney realizes the claim is barred or not worth pursuing in light of the fact that a claim over use of a work that was not timely registered opens the door only to profits attributable to the infringement (which tend to be quite low and often difficult to prove) and the reasonable license fee that a similarly situated defendant would have paid.

If the allegedly infringed image is validly registered, the strongest pushback will come from your internal investigation concerning the value of the image or similar images. The plaintiff and/or the lawyer must be educated about the proper benchmark for damages—i.e., the reasonable license fee a comparable defendant would have paid—and that their likely recovery will be limited to a multiple of that benchmark. If the photographer or lawyer is insistent on an unreasonable sum, ask to see copies of licenses previously paid for the image (or similar images) to back up their claim. It is also helpful to remind a plaintiff's attorney that an award of attorney fees against a defendant is not a foregone conclusion.¹⁹ It is important, at this point, to control the other side's expectations of damages and a lawyer's expectation of attorney fees, and make a record of good faith negotiation based on precedent. Being reasonable, and making a record of the other side being unreasonable, can be very useful down the line.²⁰

"You Got Served"

You tried your best. You utilized reason, logic, the rule of law, and on-point cases. Nonetheless, the photographer and/or opposing counsel wants to "see you in court," perhaps seeing dollar signs. Or, as is common with one or two firms, you were simply sued without any advanced notice at all. If you believe the complaint is truly frivolous given the availability of defenses and based on facts you have explained to the other side, discuss with your attorney the possibility of a "Rule 11" motion, which seeks sanctions against parties and attorneys under the Federal Rules of Civil Procedure for bringing frivolous claims.²¹ Rule 11 motions are not to be taken lightly, and it is unwise, not to mention ironic, to bring a frivolous Rule 11 motion. However, such motions are worth exploring in certain circumstances, and if well-founded, can pressure an overzealous plaintiff toward settlement, or even to withdraw a claim entirely.

Rule 11 aside, you have already done your due diligence, and your internal investigation will likely outline what defenses you have at your disposal. These defenses include fair use, de minimis use (using only a tiny portion of a work), and lack of standing (i.e., lack of registration, or issues of ownership such as defective registrations or incomplete chains of title). Some defenses may be ripe for a motion to dismiss, although defenses like fair use are typically fact-sensitive and unlikely to succeed this early in the case.²²

This rule is not without exceptions, especially in the realm of news reporting,²³ and sometimes in connection with the recently popularized claim for tampering with "copyright management information" (CMI).²⁴ In short, CMI is information conveyed in connection with copyrighted works and includes things like the title or other information identifying the work, the name of the author, and the copyright notice and information set forth in the notice.²⁵ Plaintiffs, rightly or not, often accuse defendants of deleting or falsifying CMI in violation of § 1202 of the Copyright Act, likely because § 1203 has its own statutory damages provision, allowing for damages between \$2,500 and \$25,000 in the court's discretion²⁶—another source of financial leverage. However, § 1202 requires that tampering be done knowingly or with the intent to "induce, enable, facilitate, or conceal" copyright infringement;²⁷ while this is easy boilerplate to add to a complaint, pleading a plausible violation can be challenging, and may be clear fodder for a motion to dismiss.²⁸

Whether to move to dismiss, or simply answer and move into discovery, is a fact-sensitive decision to make together with your attorney, based on the strength of your arguments, the costs associated with making the motion, and potential future implications. For instance, if the plaintiff ultimately prevails in the case, he or she may claim that a particularly weak motion to dismiss or defense was “objectively unreasonable,” and would justify an award of attorney fees.²⁹ On the flip side, if your motion is particularly strong and ultimately successful, you may be able to argue for an award of your own attorney fees in light of the *plaintiff's* objectively unreasonable claim.³⁰

If you choose to answer the complaint, or if your motion to dismiss is unsuccessful, the case will march on toward discovery. Before incurring the significant expenditure of time and money commanded by discovery, mediation is a common way to potentially resolve the case early on. Many judges will suggest mediation right at the outset given the potentially small amounts at issue, and may refer the parties to the magistrate judge or a court-appointed mediator. These methods are free (apart from the cost of drafting a mediation statement and counsel's appearance at the mediation), but the parties may, of course, opt to hire a private mediator. Attorneys have differing opinions on the merits of mediation, but it is arguably a worthwhile investment because, even if it does not lead to settlement, it often is a good opportunity to showcase your arguments and to get an idea of the opposing side's factual, legal, and settlement positions.

Ultimately the decision to litigate, mediate, or settle involves a cost-benefit analysis. Litigation is extremely expensive, and the costs often eclipse the amounts at issue; as a defendant, there is zero monetary upside. Principle may be an intangible reason to fight, but one must determine how much that is worth. Resolving any lawsuit, and particularly leverage-driven suits like image copyright cases where defendants often feel as though they are being “held up,” involves coming to a number you can live with (financially and philosophically) that is less than the cost to litigate. Other considerations include the potential for reputational harm by being subject to public court proceedings and possibly a judgment, and the ability to make good law (a reason to fight) or bad law (a reason to settle), which a copyright lawyer can readily explain.

Takeaways: Looking to the Future

Dealing with copyright claims and litigation involves complicated analyses, financial burden, and stressful uncertainty. One way in which legislators are considering reducing financial burdens is through the creation of a copyright small claims court, as proposed in a House Bill introduced this past fall.³¹ This tribunal would fall under the auspices of the U.S. Copyright Office and would provide an alternative forum for lower-value copyright claims, with a total cap on liability of \$30,000 for any one proceeding. There would also be no fee-shifting; that is, the parties would bear their own cost, even if they win, and representation by a lawyer would not be necessary. Cases would also be handled through written submission and telephonic or web-based conferences. The goal is to reduce the costs and increase the speed of adjudicating copyright claims by avoiding the expenditures attendant to federal copyright litigation. A possible side-effect of encouraging the more efficient and cost-effective small claims process may be fewer overly aggressive claims for small dollar amounts clogging the federal court dockets and draining the resources of the recipients of such claims.

While the small claims process is a step in the right direction, until the financial incentives for aggressive—and often abusive—claims are removed or amended (i.e., statutory damages), an ounce of prevention is worth a pound of cure, and the most effective form of prevention is education about best practices in image licensing. It is critical to ensure that all employees (even temps and interns) are trained and instructed on what images they can and cannot use. Whether this education is provided internally or through outside counsel, the key points of the training should be memorialized in written policies or employee manuals signed by all trainees. Using licensed images should be the default choice—specifically, images from trusted subscription services like Getty Images and Shutterstock, which offer a range of subscription plans and à la carte options that are more affordable than one might expect. Contrary to popular belief, Google Images is not a collection of licensable images, nor are those images in the public domain. Similarly, screenshots of videos on YouTube—while sometimes considered fair use or de minimis use—are not necessarily free for the taking.

Just because people think images on the Internet or on social media are free, and just because many in the digital media industry use them as if they are free, does not make the so-called “right-click” license legally “right.” If you or your employees need to consider using other visual content outside a trusted licensing source, check with counsel before using it. Another option is using Creative Commons licenses, which often allow for certain types of use without further permissions or license fees (although many do contain other conditions, and all require attribution/credit to the copyright owner).³² Additionally, solely relying on traffic agreements between websites, wherein media entities agree to “trade traffic” and both use images licensed by only one of the entities, will not hold up in court. Taking all these preventative steps will not only reduce the risk of liability, but in the event of a lawsuit will also take much of the force out of a plaintiff’s argument that the alleged infringement was “willful” and therefore subject to enhanced damages.

Today’s climate of mass-produced, algorithm-supported copyright litigation by contingency fee law firms provides every incentive and virtually no downside to litigation for the millions of potential plaintiffs whose images make their way online. Until the playing field is leveled, content users must look out for themselves, be proactive and diligent in their procurement of content, and realize that even after more than 25 years, content use in the Internet-age is still a bit like the Wild West: sometimes it is not clear who should be considered an outlaw.

Endnotes

1. See, e.g., Morgan E. Pietz, *Copyright Court: A New Approach to Recapturing Revenue Lost to Infringement: How Existing Court Rules, Tactics from the “Trolls,” and Innovative Lawyering Can Immediately Create a Copyright Small Claims Procedure That Solves BitTorrent and Photo Piracy*, 64 J. COPYRIGHT SOC’Y U.S.A. 1, 14–15 n.51 (2017) (noting that in the period ranging from January 1, 2009, to June 30, 2015, one of the top 15 copyright plaintiffs in the country included BWP Media USA, Inc., a photo agency filing 194 cases).

2. See *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939) (coining the fair use doctrine as the “most troublesome in the whole law of copyright”); see also *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1183 (9th Cir. 2012) (explaining that fair use “is neither a mechanistic exercise nor a gestalt undertaking, but a considered legal judgment”).
3. Many complaints, for instance, will allege that plaintiffs should be awarded statutory damages of up to \$150,000 per copyrighted work infringed, pursuant to 17 U.S.C. § 504. See, e.g., *Complaint ¶ 49, Barcroft Media, Ltd. v. Coed Media Grp., LLC (Barcroft II)*, No. 16 Civ. 7634 (JMF), 2017 WL 5032993 (S.D.N.Y. Nov. 2, 2017) (alleging that “[a]s a direct and proximate result of Defendant’s misconduct, Plaintiffs have been substantially harmed and should be awarded statutory damages against Defendant pursuant to 17 U.S.C. § 504(c) of up to \$150,000 per infringement in an amount to be proven,” where plaintiffs were ultimately awarded only \$10,880 in damages); *FameFlynet, Inc. v. Shoshanna Collection, LLC*, No. 16 Civ. 7645, 2017 WL 4402568, at *5 (S.D.N.Y. Oct. 2, 2017) (awarding the plaintiff \$750 in damages despite its \$150,000 demand).
4. See *Barcroft Media, Ltd. v. Coed Media Grp., LLC (Barcroft I)*, No. 16 Civ. 7634 (JMF), 2017 WL 4334138, at *1 (S.D.N.Y. Sept. 28, 2017) (denying the plaintiffs’ motion for spoliation, in part, because their possession of screenshots of the uses at issue contradicted any claim that the evidence at issue was “lost”).
5. See *Barcroft II*, 2017 WL 5032993, at *10 (“Several other considerations inform the Court’s assessment of the damages needed to ‘discourage wrongful conduct.’ First, after receiving FameFlynet’s cease-and-desist letter, CMG sought to license FameFlynet’s content and took down the referenced Images, as well as other unlicensed Images.” (citation omitted)).
6. When an image is “embedded” on a website, the image appears “seamlessly integrated” on the website, “although the underlying images may be hosted in varying locations.” *Goldman v. Breitbart News Network, LLC*, No. 17 Civ. 3144 (KBF), 2018 WL 911340, at *2 (S.D.N.Y. Feb. 15, 2018).
7. Given the decision in *Breitbart*, 2018 WL 911340, however, the state of the law concerning “embedded” images is in flux. In *Breitbart*, Judge Forrest of the U.S. District Court for the Southern District of New York held that embedding does not immunize content users from copyright infringement claims. The court declined to adopt the Ninth Circuit’s “server test” as set forth in *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007), holding that the fact that the image was hosted on a server owned and operated by an unrelated third party does not shield defendants from a finding that a plaintiff’s display right had been violated. Plaintiff Goldman’s companion case against Advance Publications, Inc., is still pending, with Judge Carter staying discovery until the U.S. Court of Appeals for the Second Circuit resolves the interlocutory appeal of the *Breitbart* case. It remains to be seen whether Judge Carter will be influenced by Judge Forrest’s decision. But for now, embedding is not a defense to copyright infringement, at least in New York.

8. *Compare Perfect 10*, 508 F.3d 1146 (holding that Google’s framing and hyperlinking as part of an image search engine constituted a fair use of Perfect 10’s images), *with Breitbart*, 2018 WL 911340 (holding that embedding does not immunize content users from copyright infringement claims).
9. *See supra* note 2; *see also* *Barcroft Media, Ltd. v. Coed Media Grp., LLC (Barcroft III)*, No. 16 Civ. 7634 (JMF), 2018 WL 357298, at *2 (S.D.N.Y. Jan. 10, 2018) (explaining that fair use “turns on a fact-intensive, multifactor inquiry” and opining that the defendant’s assertion of a fair use defense was not objectively unreasonable given its recent success in asserting the defense in another matter).
10. *See Barcroft II*, 2017 WL 5032993, at *7 (concluding that the second factor weighs in favor of the alleged infringer when the photographs at issue are paparazzi photos, because they “are essentially factual in nature” and “further from the core of copyright protections than creative or fictional works would be”).
11. *See* *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006) (determining that the final factor—“the effect of the use upon the potential market for or value of the copyrighted work”—looks “to not only the market harm caused by the particular infringement, but also to whether, if the challenged use becomes widespread, it will adversely affect the potential market for the copyrighted work”); *see also* *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 568 (1985) (“[T]o negate fair use one need only show that if the challenged use ‘should become widespread, it would adversely affect the *potential* market for the copyrighted work.’”).
12. A copyright owner whose rights have been violated may elect to recover either statutory damages or actual damages and profits. *See* 17 U.S.C. § 504(c)(1) (“[T]he copyright owner may elect, at any time before final judgment is rendered, to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in the action, with respect to any one work, for which any one infringer is liable . . . in a sum of not less than \$750 or more than \$30,000 as the court considers just.”). If a court determines that the defendant’s infringement was willful, it may, in its discretion, enhance the statutory damages award up to \$150,000 per infringed work. *See id.* § 504(c)(2). Alternatively, if the infringer “was not aware and had no reason to believe that [its] acts constituted an infringement,” the court may “reduce the award of statutory damages to a sum of not less than \$200.” *Id.*
13. *See* *Fitzgerald Publ’g Co. v. Baylor Publ’g Co.*, 807 F.2d 1110, 1116 (2d Cir. 1986) (stating that the Copyright Act affords “wide discretion . . . in setting the amount of statutory damages”).
14. *See Barcroft II*, 2017 WL 5032993, at *8 (“[C]ourts often impose as statutory damages a multiple of the applicable licensing fee a defendant would have paid but for the infringement.”); *Erickson Prods., Inc. v. Only Websites, Inc.*, No. 12-cv-1693 (PGG), 2016 WL 1337277 (S.D.N.Y. Mar. 31, 2016) (awarding “three times the licensing fee the plaintiffs charge typically to those who wish to obtain online usage for an Erickson copyrighted photograph”); *Broad. Music, Inc. v. Ken V, Inc.*, 159 F. Supp. 3d 981, 989–90 (E.D. Mo. 2016) (noting the “general trend of awarding damages of approximately three times the licensing fees” for purposes of statutory damages, and awarding damages accordingly); *BWP Media USA Inc. v. Uropa Media, Inc.*, No. 13 Civ. 7871 (JSR) (JCF), 2014 WL 2011775, at *2 (S.D.N.Y. May 16,

2014) (awarding statutory damages in the amount of three times the plaintiff's unpaid licensing fee); *Nat'l Photo Grp., LLC v. Bigstar Entm't, Inc.*, No. 13 Civ. 5467 (VSB) (JLC), 2014 WL 1396543, at *4 (S.D.N.Y. Apr. 11, 2014) (recommending an award of \$9,000, three times the plaintiff's licensing fee, citing that an award of statutory damages of three to five times the plaintiff's licensing fee is commonly applied), *report and recommendation adopted*, No. 13 Civ. 5467 (VSB) (JLC), 2014 WL 5051275 (S.D.N.Y. Oct. 8, 2014); *Realsongs v. 3A N. Park Ave. Rest Corp.*, 749 F. Supp. 2d 81 (E.D.N.Y. 2010) (recommending an award of \$15,000 in statutory damages, approximately three times the licensing fee for each of five infringed works); *Cynthia Hunt Prods., Ltd. v. Evolution of Fitness Houston Inc.*, No. H-07-0170, 2007 WL 2363148, at *7 (S.D. Tex. Aug. 16, 2007) (awarding statutory damages for three times the amount invoiced for use of copyrighted photographs).

15. *See supra* note 3.

16. *See Barcroft II*, 2017 WL 5032993, at *11 n.5 (“Plaintiffs originally contended that they were entitled to the greater of five times the minimum statutory amount or five times a reasonable licensing fee for each infringing use. . . . Plaintiffs’ request was based on an erroneous reading of case law and the function of the statutory minimum, which sets a damages floor for an infringing use and is not intended to substitute for a reasonable licensing fee”)

17. *Compare* *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1341 (11th Cir. 2017) (requiring deposit, application, and examination of an application prior to filing suit), *and* *Muench Photography, Inc. v. Houghton Mifflin Harcourt Publ’g Co.*, No. 09 Civ. 2669 (LAP), 2012 WL 1021535, at *5 (S.D.N.Y. Mar. 26, 2012) (“Courts in this Circuit have . . . required that a plaintiff either hold a valid copyright registration outright or have applied and been refused a registration prior to filing a civil claim, both before and after *Reed Elsevier*. A pending application does not suffice.”), *and* *Tooker v. Copley*, 3 U.S.P.Q.2d (BNA) 1396 (S.D.N.Y. 1987) (finding that the plaintiff must obtain a response from the Copyright Office; an application alone is insufficient), *with* *Cosmetic Ideas, Inc. v. IAC/InteractiveCorp*, 606 F.3d 612, 619 (9th Cir. 2010) (concluding that merely securing an application as a pre-requisite to suit “better fulfills Congress’s purpose of providing broad copyright protection while maintaining a robust federal register”).

18. *See* 17 U.S.C. § 412(2).

19. *See* *BWP Media USA, Inc. v. Mishka NYC LLC*, No. 13 Civ. 4435, 2016 WL 8309676, at *2 (S.D.N.Y. Dec. 28, 2016) (denying motion for attorney fees, explaining that, per *Kirtsaeng v. John Wiley & Sons*, 136 S. Ct. 1979, 1985 (2016), courts “may not ‘award attorney’s fees as a matter of course’”); *see also* *Kanongataa v. Am. Broad. Cos. (Kanongataa II)*, No. 16 Civ. 7382 (LAK), 2017 WL 2684067, at *2 (S.D.N.Y. June 21, 2017) (awarding attorney fees to the *defendants* where “no reasonable lawyer with any familiarity with the law of copyright could have thought that the fleeting and minimal uses . . . was anything but fair”).

20. *See Barcroft III*, No. 16 Civ. 7634 (JMF), 2018 WL 357298, at *2 (S.D.N.Y. Jan. 10, 2018) (considering the plaintiffs' troubling litigation tactics in declining to award attorney fees in their favor, including the plaintiffs' filing of a boilerplate complaint; delay in amending their complaint; service of perfunctory or nonresponsive discovery responses; erroneous denial that pertinent information existed; lack of attention in briefing to pertinent issues in the case; filing of a frivolous motion for spoliation sanctions; forcing the defendant to incur the expense of preparing witnesses for trial and then passing on asking them any questions; failure to support inflated damages claims with documentation or witness testimony; and taking unreasonable settlement positions).
21. *See* FED. R. CIV. P. 11.
22. *See* *Graham v. Prince*, 265 F. Supp. 3d 366, 376 (S.D.N.Y. 2017) ("The determination of fair use is a 'mixed question of fact and law,' which necessitates 'an open-ended and context-sensitive inquiry.'" (quoting *Cariou v. Prince*, 714 F.3d 694, 704–05 (2d Cir. 2013))).
23. *See* *Kanongataa v. COED Media Group, LLC (Kanongataa I)*, No. 16 Civ. 7472 (LAK) (S.D.N.Y. Feb. 15, 2017), ECF No. 27 (granting motion to dismiss because use of a single-frame screenshot of a 45-minute video, in the context of news reporting and social commentary, was *de minimis*).
24. *Id.* (granting motion to dismiss because the complaint failed to assert a plausible 17 U.S.C. § 1202 claim).
25. *See* 17 U.S.C. § 1202(c).
26. *See id.* § 1203(c)(3).
27. *See id.* § 1202(a)–(b).
28. *Kanongataa I*, No. 16 Civ. 7472 (LAK), ECF No. 27 (granting motion to dismiss § 1202 claim because *Kanongataa* failed to state a plausible claim that COED Media intended to conceal an infringement).
29. *See* *Crown Awards, Inc. v. Discount Trophy & Co.*, 564 F. Supp. 2d 290, 296 (S.D.N.Y. 2008) (granting the plaintiff's motion for attorney fees because the defendant's (1) malicious prosecution counterclaim was premature and lacked an essential element, (2) summary judgment motion was based on the improper notion that the court could find a declaration was entirely credible, and (3) independent creation defense was predicated on testimony that the court found inherently incredible), *aff'd*, 326 F. App'x 575 (2d Cir. 2009).
30. *See Kanongataa II*, No. 16 Civ. 7382 (LAK), 2017 WL 2684067, at *2 (S.D.N.Y. June 21, 2017) (awarding attorney fees to the defendants in light of the clear fair use associated with news reporting).
31. *See* CASE Act of 2017, H.R. 3945, 115th Cong. (2017).

32. See *CC Search*, CREATIVE COMMONS, <https://search.creativecommons.org> (last visited Aug. 20, 2018).