

SOCIAL MEDIA AND ORGANIZING
Laws Affecting Critical Use of Social Media

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TABLE OF CONTENTS

I. INTRODUCTION	1
II. COMMUNICATIONS DECENCY ACT	1
A. Principal provisions of the CDA and definitions	1
B. <i>Zeran v. America Online</i>	3
C. No obligation to monitor	6
D. Creators of content are generally not protected	7
E. Protection extends only to material intended for Internet publication.....	9
F. No duty to remove material.....	11
G. No Liability for <i>Removing</i> Material	12
H. The Seventh Circuit, alone, does not necessarily follow <i>Zeran</i>	12
I. Inducing illegal postings forfeits immunity: <i>Roomates.com</i>	14
1. Ninth Circuit decision in <i>Roomates.com</i>	14
2. Other efforts to impose liability based on <i>Roommates</i> -type analysis have been unsuccessful	17
J. Immunity extends only to claims that the information published on the internet is illegal.....	20
K. “Users” are protected as well as “providers”	21
L. The courts have rejected a distinction between publishers and distributors	22
M. Early resolution of the CDA defense is favored	23
III. DIGITAL MILLENIUM COPYRIGHT ACT.....	23
A. Purposes and structure of the DMCA	23
B. “Take-down” notices by copyright owners.....	26

C. The burden is on the copyright owner to find infringements.....	27
D. But the internet service provider must have a policy for dealing with repeat offenders”	28
E. A copyright owner must take the “fair use” doctrine into account when deciding whether to give a take-down notice	29
F. DMCA creates a cause of action against a copyright owner who gives a take-down notice materially misrepresenting its rights	29
G. Preemption.....	31
IV. TRADEMARK, TRADE NAME OR COPYRIGHT INFRINGEMENT.....	31
A. Critical use of trademarks and tradenames	31
B. Use of copyrighted material	34

I. INTRODUCTION

Union campaigns can be furthered by criticizing employers and their allies through the use of social media. Two laws specific to the use of the Internet, the Communications Decency Act and the Digital Millennium Copyright Act, regulate such use and provide significant opportunities. A third body of law, based in the Lanham Act and protecting “fair use” of trademarked and copyrighted material, is intertwined with the two Internet laws and also bears on other uses of the Internet.

In quick summary, the Communications Decency Act protects, against state defamation law, republication through interactive Internet media of material the republisher does not create but finds on the Internet. The Digital Millennium Copyright Act provides a structure for the quick resolution of copyright claims concerning material on the Internet. It provides additional protection for fair use of trademarked and copyrighted property by creating a cause of action against the owner for improper assertion of claims. The fair use doctrine, properly understood, allows the creative use of intellectual property to comment on the property itself and perhaps its owner or licensees closely associated with the property.

II. COMMUNICATIONS DECENCY ACT

A. Principal provisions of the CDA and definitions

The Communications Decency Act of 1996 (“CDA”), 47 U.S.C. § 230, was passed in 1996 in response to the decision in *Stratton Oakmont, Inc. v. Prodigy Services Co.*, 1995 WL 323710 (N.Y.Sup.Ct. May 24, 1995). In *Stratton Oakmont*, an anonymous person made a post to a bulletin board maintained by Prodigy, an internet service

provider, concerning Stratton Oakmont. Stratton Oakmont is a securities investment banking firm. The post alleged that Stratton Oakmont engaged in criminal fraud. Stratton Oakmont sued Prodigy. The court held that the complaint stated a cause of action against Prodigy because Prodigy exercised editorial control over postings on its bulletin boards and advertised that control to its subscribers. *Id.* at *5.

CDA Section 230(c)(1) provides: “No provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider.” Note that this subsection applies to users as well as providers. Neither of these terms is specifically defined in the law. But “interactive computer service” is defined in subsection 230(f)(2):

The term “interactive computer service” means any information service, system, or access software provider that provides or enables computer access by multiple users to a computer server, including specifically a service or system that provides access to the Internet and such systems operated or services offered by libraries or educational institutions.

“Information content provider” is defined in subsection (f)(3):

The term “information content provider” means any person or entity that is responsible, in whole or in part, for the creation or development of information provided through the Internet or any other interactive computer service.

The statute also encourages the exercise of some editorial control over Internet postings – and in this way most directly overrules *Stratton Oakmont* – by protecting providers and users from liability for blocking (not editing) material. Subsection (c)(2)(A) provides:

No provider or user of an interactive computer service shall be held liable on account of—

any action voluntarily taken in good faith to restrict access to or availability of material that the provider or user considers to be obscene, lewd, lascivious, filthy, excessively violent, harassing, or otherwise objectionable, whether or not such material is constitutionally protected.

To be an “internet service provider,” it is not necessary to provide access to the Internet. An online message board qualifies. *Universal Communications Systems, Inc., v. Lycos, Inc.*, 478 F.3d 413, 419 (1st Cir. 2007). Commercial sales sites like eBay and Amazon also qualify under this definition. *Gentry v. eBay, Inc.*, 99 Cal.App.4th 816 (2002); *Corbis Corp. v. Amazon.com, Inc.*, 351 F.Supp.2d 1090 (W.D. Wash. 2004). Social media like MySpace, Facebook and Twitter would certainly meet the definition, see *Doe v. Myspace, Inc.*, 528 F.3d 413 (5th Cir. 2008). So do websites. *Jones v. Dirty World Entertainment Recordings*, 755 F.3d 398, 408 (6th Cir. 2014). A union website with an interactive page would therefore qualify. “Information” within the meaning of the CDA includes computer programs, even harmful ones like “punchers.” *Green v. America Online*, 318 F.3d 465, 472 (3d Cir. 2003).

Congress has extended the protection of § 230 to guard against evasion through obtaining foreign judgments against service providers and then attempting to enforce them in the United States. See 28 U.S.C. § 4102(c)(1) (providing that U.S. courts “shall not recognize or enforce” foreign defamation judgments that are inconsistent with § 230). This is a crucial protection in light of the nearly-global accessibility of websites.

B. Zeran v. America Online

The first and most important case decided after the CDA was passed was *Zeran v. America Online, Inc.*, 129 F.3d 327 (4th Cir. 1997), *certiorari den.* 524 U.S. 937 (1998). Someone anonymously posted on an America Online bulletin board phony messages

stating that Kenneth Zeran was offering for sale t-shirts and other articles with offensive references to the Oklahoma City federal court bombing. The message gave Zeran's telephone number. He received many abusive calls including death threats. He contacted AOL to complain. AOL took down the messages but declined to post a retraction. *Id.* at 329. Zeran sued AOL for defamation under the "republication of libel" doctrine. The Court of Appeals upheld dismissal of his claims on the grounds that the CDA "immunizes computer service providers like AOL from liability for information that originates with third parties." *Id.* at 327. The court explained that AOL is an "interactive computer service" that not only offers a connection to the Internet but allows subscribers to access information stored on AOL's proprietary network. The court held that the "plain language" of CDA Section 230(c)(1) "creates a federal immunity to any cause of action that would make service providers liable for information originated with a third-party user of the service." *Id.* at 330. The court went beyond plain language, however, and explained that its decision was consistent with the purposes behind the law. The CDA "was enacted, in part, to maintain the robust nature of Internet communication." *Id.* The court emphasized the congressional statements of purposes contained in the law itself, particularly emphasizing the passages declaring a policy of promoting the use of the Internet "with a minimum of government regulation," Section 230(a)(4), and "to preserve the vibrant and competitive free market that presently exists for the Internet and other interactive computer services, unfettered by Federal or State regulation," Section 230(b)(2). *Id.* The court also stated that another important purpose of the CDA was "encourage service providers to self-regulate the dissemination of offensive material over

their services.” *Id.* at 331. In the court’s view, this purpose would be undermined if service providers were subject to liability for failing to delete or post retractions for allegedly defamatory material. This exposure would lead service providers to delete far too much in the interest of self-protection. *Id.* at 333. Accordingly, “Section 230 forbids the imposition of publisher liability on a service provider for the exercise of its editorial and its self-regulatory functions.”

Zeran argued that even if AOL did not have responsibility for the original posting, it was required to post a retraction when it was notified of the false and defamatory nature of the posting. The court disagreed. It found that this would impose an impossible burden on service providers because of the vast amount of speech communicated through interactive computer services. *Id.* at 333. Each notification like that sent by Zeran to AOL “would require a careful yet rapid investigation of the circumstances surrounding the posted information, a legal judgment concerning the information’s defamatory character and an on-the-spot editorial decision whether to risk liability by allowing the continued publication of that information.” *Id.*

The court found the CDA explicitly preemptive of state law, including the law of defamation “[I]t is equally plain that Congress’ desire to promote unfettered speech on the Internet must supersede conflicting common law causes of action.” *Id.* at 334.

Importantly, the CDA only protects re-publishers. The original publisher of a defamatory statement enjoys no protection even if the statement is made on the Internet. *Id.* at 330-331.

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C. No obligation to monitor

Following *Zeran*, the courts have ruled consistently that internet service providers have no obligation to monitor or investigate what users are doing on their sites in order to enjoy immunity under Section 230(c)(1). See *Ricci v. Teamsters Local 456*, 781 F.3d 25 (2d Cir. 2015) (Go Daddy’s refusal to delete newsletter created by union attacking dissident member); *Klayman v. Zuckerberg*, 753 F.3d 1354 (D.C. Cir. 2014) (Facebook immune from claims arising from delay in removing postings calling for *intifada*); *Green v. America Online*, *supra* (no liability for failing to police postings to remove harmful content). In *Doe v. Myspace, Inc.*, *supra*, a minor created a Myspace profile in violation of its rules of use. She entered into communication with a man that led them to meet, whereupon he sexually assaulted her. The child’s and mother’s complaint against Myspace was dismissed on grounds of CDA immunity. The court rejected their contention that Myspace had a duty to protect minors by ensuring that they did not use the site. “Their allegations are merely another way of claiming that Myspace was liable for publishing the communications and they speak to Myspace’s role as a publisher of online third-party-generated content.” *Id.* at 420.

In 2018, Congress created an exception to section 230 for violations of state and federal human-trafficking laws. See *Allow States and Victims to Fight Online Sex Trafficking Act ("FOSTA")*, Pub. L. No. 115-164, 132 Stat. 1253 (2018). A “statutory claim for knowingly or intentionally benefiting from participation in a human-trafficking venture is not barred by section 230 and may proceed to further litigation.” *In re Facebook, Inc.*, 625 S.W. 3d 80, 83 (Tex. 2021). But in keeping with the law before the

amendment, publishers are liable only if they actively participate in the creation of the illegal material and have no affirmative duty to protect users.

All the actions Plaintiffs allege Facebook should have taken to protect them—warnings, restrictions on eligibility for accounts, removal of postings, etc.—are actions courts have consistently viewed as those of a "publisher" for purposes of section 230. Regardless of whether Plaintiffs' claims are couched as failure to warn, negligence, or some other tort of omission, any liability would be premised on second-guessing of Facebook's "decisions relating to the monitoring, screening, and deletion of [third-party] content from its network."

Id. at 93. A publisher “participates” in an illegal post only when it engages in an “overt act” in furtherance of the illegality of what is posted. *Id.* at 96-97

D. Creators of content are generally not protected

As a general proposition, creators of information are not protected by Section 230. *Gentry v. eBay, Inc., supra.* Along with the perpetrators, eBay was sued for offering forged sports memorabilia on its online auction site. The fraudsters were the ones who created the false descriptions of the goods, without any involvement by eBay. eBay has categories of items for sale and they used one of those categories to offer their fake goods. The plaintiffs claimed that eBay thereby provided the means for them to do it. The court found that this was not enough to make eBay a “creator” or “developer” of the material and it was therefore immune under the CDA. *Id.* at 716. The plaintiffs had an interesting alternative argument. eBay has a rating system for sellers and buyers. The ratings are a compilation of feedback from participants in its online markets. eBay itself does the compilation. The ratings for the people engaged in the sports memorabilia fraud were manipulated by them and their co-conspirators to elevate their ratings and thus reassure buyers. The court concluded, however, that “simply compiling false and/or

misleading content created by the individual defendants and other co-conspirators” did not transform eBay into an information content provider because “it did not create or develop the underlying misinformation.” *Id.* at 718.

The limit between content creation and publishing was taken quite far in *Ben Ezra Weinstein & Co., Inc., v. America Online Inc.*, 206 F.3d 980 (10th Cir. 2000), where the plaintiff claimed it was defamed because of inaccurate information about its stock contained in one of AOL’s information services. The material on the service was not created by AOL but by a firm AOL contracted to provide this information. *Id.* at 983. AOL occasionally sent emails to the contractor notifying it of inaccuracies in its data and asking that these be corrected. It did not perform the corrections itself. It also occasionally blocked access to any information about a particular stock. The court held that these traditional editorial functions did not make AOL an “information content provider” as defined in Section 230(f) and so it was immune under the CDA. *Id.* at 985-986 (following *Zeran*).

The question of what constitutes “creation” of information provided through an interactive site was developed more extensively in *Henderson v. Source for Public Data, LP*, 53 F. 4th 110 (4th Cir. 2022). The defendant was accused of violating the Fair Credit Reporting Act (FRCA). It provided online consumer reports to potential employers and others. It acquired the information, “parsed” it and put it into its standardized format. Some information was alleged to be inaccurate; some information required by the FRCA was missing. Source for Public Data defended on the grounds of immunity under Section 230(1). Where a publisher “materially contributes to a message’s unlawful content” by

“adding new content,” it becomes a creator of the message and loses immunity. *Id.* at 128. In this case, Source for Public Data’s “summaries and omissions” of the data it collected went “beyond formatting or procedural alterations and change the substance of the content altered,” and became content creation. *Id.* at 129.

The Ninth Circuit has suggested that the immunity granted by Section 230(c)(2)(A) goes beyond that of 230(c)(1), to protect even the original creators or developers of information when they take action to remove objectionable items, in order to encourage such self-correction. *Barnes v. Yahoo!, Inc.*, 570 F.3d 1096, 1105 (9th Cir. 2009). The California Supreme Court saw the same distinction between the purposes of Sections 230(c)(1) and 230(c)(2). *Barrett v. Rosenthal*, 40 Cal.4th 33, 66 (2006).

E. Protection extends only to material intended for Internet publication

One of the requirements for immunity is that the material involved be posted on the Internet, or at least intended for such publication. “No provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider.” Section 230(c)(1). “Information content provider” is someone “responsible...for the creation or development of information provided through the Internet or any other interactive computer service.” Section 230(f)(3). This does not pose a problem in most cases. Postings are to various services on the Internet, including websites, Facebook, Twitter and many more.

It was an issue, however, in the first Ninth Circuit case to adopt the pro-immunity approach of *Zeran*. *Batzel v. Smith*, 330 F.3d 1018 (9th Cir. 2003). A handyman sent an

email to an individual who maintains a website on stolen artwork. He alleged that one of his clients claimed to be a descendent of Himmler and had many items of old artwork in her house, which he speculated had been stolen from Jews during World War II. *Id.* at 1021. The recipient of the email then sent it out to his worldwide listserv of law enforcement and others interested in tracking stolen artwork. *Id.* at 1021-1022. The man who sent the email later claimed that he had no idea it would be published this way. *Id.* at 1022. The Court of Appeals first held that CDA immunity is not limited to those who provide access to the Internet itself but extends to other interactive computer services, including listserves. *Id.* at 1030-1031. Second, it held that for the service provider to be protected, the material must be intended for the Internet. A provider may not take a print publication, put it on the Internet, and then expect immunity. *Id.* at 1032-1033. Third, the court decided that even though email makes use of the Internet, such communications are not necessarily what Congress intended in the CDA. In fact, treating emails this way, which would enable recipients to freely publish them widely without fear of defamation and liability, would chill the use of email and run contrary to the purposes of Congress in promoting the development of the Internet. *Id.* at 1033-1034. Therefore, the court held CDA immunity exists only when information is “furnished... to the provider or user under circumstances in which a reasonable person in the position of the service provider or user would conclude that the information was provided for publication on the Internet or other ‘interactive computer service’.” *Id.* at 1034. The case was remanded because of the doubt about what the handyman intended when he sent his email.

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F. No duty to remove material

Batzel also held that it is immaterial to CDA immunity whether a decision to post comes in the form of pre-screening material before it becomes public or removing it afterward. *Id.* at 1032. This became important in *Barnes v. Yahoo!, Inc.*, *supra*, where a woman sued Yahoo for not removing sexually-explicit photographs of her posted by her ex-boyfriend on a profile of her he created on a Yahoo website. She made several attempts to get Yahoo to remove the material. Eventually Yahoo represented that it would remove the material but failed to do so. 570 F.3d at 1098-1099. She sued Yahoo not for defamation but under an Oregon tort law making a person who undertakes to perform a service for the protection of another liable for non-performance. *Id.* at 1099. After pointing out that Section 230 provides immunity under any law where a necessary element is that the wrongdoer be a publisher or speaker, not just defamation, the court held that removal of material is part of a publisher's function, just like selection. Therefore, Section 230 immunity existed and the tort of "negligent undertaking" was preempted. *Id.* at 1102-1103.

The court saved the plaintiff's action, however, by recasting the complaint as one for promissory estoppel based on Yahoo's alleged promise to remove the material. *Id.* at 1107-1110. The court believed that a sound distinction could be made between tort and contract when it comes to CDA immunity. If a publisher fails to remove despite demands, or does so imperfectly, there is no liability. But if it goes further and promises that it will take action and then fails, the action against it is based on its promise rather than its action or inaction as a publisher. *Id.* at 1107-1108. The message to website hosts

is clear: don't undertake to do anything unless it really will be done. It is also obviously better not to promise to do something within a particular time frame or "right away."

The California Supreme Court extended the right of an internet publisher not to remove material even after a court has ruled that the material is libelous. *Hassell v. Bird*, 5 Cal.5th 522, 420 P. 3d 776 (2018). The court invalidated an injunction ordering Yelp to remove libelous posts.

G. No Liability for Removing Material

In *Sikhs for Justice v. Facebook*, 2015 WL 7075696 (N.D. Cal. 2015), the court held that the CDA barred plaintiff's claim that Facebook violated Title II of the 1964 Civil Rights Act by removing plaintiff's Facebook page in India, allegedly in cooperation with the Indian government's discrimination against religious minorities. The court held, consistently with previous cases, that the decision what to publish is an editorial function which comes within the immunity afforded by the CDA.

H. The Seventh Circuit, alone, does not necessarily follow *Zeran*

The Seventh Circuit has taken a somewhat different approach. *Doe v. GTE Corporation*, 347 F.3d 655 (7th Cir. 2003) involved the sale through Internet sites of videos taken surreptitiously in college athletic locker rooms, bathrooms and showers. The athletes in the videos sued everyone but the sellers vanished and the colleges enjoyed immunity. Only the internet service providers, who did not share in the revenue from the sales of the videos, remained. They relied upon Section 230(c)(1). The court found this subsection less clear than other courts have seen it. The court thought that the interpretation of the law immunizing providers from liability, whether they do or do not

cancel the material posted on their sites, is out of keeping with the title of the law. *Id.* at 660. It suggested that Section 230(c)(1) is a definitional section (defining who is not a “publisher”) for use in defining the only true immunity conferred by the statute: that in Section 230(c)(2) for those who exercise editorial control. But it also recognized the possibility that Section 230(c)(1) means that there is protection from defamation law that requires one be a publisher, but not from other state laws regulating intermediaries that pass on information. *Id.*

The court did not resolve the question of how the statute should be interpreted, however, because this was not a defamation case. It involved an invasion of privacy. The court concluded there was no authority supporting liability for an otherwise-lawful carrier (electronic or physical) that is used for the delivery of harmful materials. *Id.* at 660-661.

The Seventh Circuit took the issue up again in *Chicago Lawyers Committee for Civil Rights under Law, Inc., v. Craigslist, Inc.*, 519 F.3d 666 (7th Cir. 2008). Craigslist was sued for allowing housing ads that overtly or inferentially showed that the listers were engaged in discrimination in the renting of multi-family housing in violation of federal law. Naturally, Craigslist defended with the CDA. It did not rely upon Section 230(c)(2) because it exercises no editorial control over the listings. Instead, it claimed immunity under Section 230(c)(1). *Id.* at 669. The court was skeptical. It pointed out that the word “immunity” is not used in subsection (c)(1). It quoted extensively from its analysis in *Doe v. GTE*, summarized above. *Id.* at 770. It also reminded readers that an internet service provider is liable for contributory copyright infringement if its system is

designed to permit the illegal acquisition of copyrighted material, citing *Metro Goldwyn Mayer Studios v. Grokster, Ltd.*, 545 U.S. 913 (2005) and *In re Aimster Copyright Litigation*, 334 F.3d 643 (7th Cir. 2003). The court viewed this as incompatible with an expansive view of Section 230(c)(1). *Id.*¹

Despite its doubts, however, the Seventh Circuit once again came to the same result as the other courts of appeals. Because Craigslist could be liable under the Fair Housing Act only “in a capacity as publisher,” and Section 230(c)(1) specifically forbids this characterization, the court found that no claim had been stated against it, despite the fact that it could not claim any protection under Section 230(c)(2) for having blocked any material.

I. Inducing illegal postings forfeits immunity: Roomates.com

1. Ninth Circuit decision in *Roomates.com*

In what amounts to a companion case decided shortly after *Lawyers Committee*, the Ninth Circuit – one of the courts that has viewed the protection under Section 230(c)(1) expansively – took a step back in *Fair Housing Council of San Fernando Valley v. Roommates.com, LLC*, 521 F.3d 1157 (9th Cir. 2008) (en banc). The Roommates.com website is like the housing section of Craigslist, with a big difference. It provides a forum to link people offering housing and those seeking it. Unlike Craigslist, Roommates.com provides guidance to its users. Both listers and seekers must create profiles. This includes stated preferences for roommates, including illegal

¹ This observation has limited significance in light of the provision in the CDA providing, “Nothing in this section shall be construed to limit or expand any law pertaining to intellectual property.” Section 230(e)(2).

preferences. The Ninth Circuit picked up on the Seventh Circuit's point that the statute should be interpreted in line with its caption. *Id.* at 1163 – 1164. It also emphasized the purpose of the statute to overrule *Stratton Oakmont* and give protection to those who exercise control over postings. *Id.* Because of the push from the internet service provider for subscribers to respond with unlawful conditions on housing choices, it became in the court's view an "information content provider" within the meaning of Section 230(f)(3) because it participated in the "development" of the content supplied by the subscribers. *Id.* at 1165 – 1166.

The court said its decision was consistent with *Batzel*. It contrasted the "editor's minor changes to the spelling, grammar and length of third-party content," which do not strip a provider of CDA immunity, with Roommates.com's "website design to solicit and enforce housing preferences that are alleged to be illegal." *Id.* at 1170. It also regarded as parallel to its decision the holding in *Batzel* that if the material in question had been sent to the provider for posting, then immunity existed, but if that was not the case and it was the provider's decision to put it online, then the provider became a creator or developer of the material and thus not immune. *Id.*

The court also distinguished and explained its previous decision in *Carafano v. Metroplash.com, Inc.*, 339 F.3d 1119 (9th Cir. 2003). Like *Roommates.com*, *Carafano* involved the creation of a profile as part of the use of a dating website. A partially-true, partially-false profile about a movie star was posted by someone else; profiles on the service were constructed in accordance with detailed questions. The court in *Carafano* found CDA immunity because a profile has no content until a user fills it in. *Carafano*,

339 F.3d at 1124. The court in *Roommates.com* said this holding was too broad, but that *Carafano* was correctly decided, even as the law was explained in *Roommates.com*, because the false profile put up by a prankster about actress Christianne Carafano “was created and developed entirely by the malevolent user without prompting or help from the website operator.” *Roommates.com*, 521 F.3d at 1171. The tools provided by the website operator for the creation of a profile were themselves neutral. “[T]he website did absolutely nothing to encourage the posting of defamatory content – indeed, the defamatory posting was contrary to the website’s express policies.” *Id.*

Further pressing home its distinction, the court held that *Roommates.com* would not be liable for anything said in the open-ended, unedited “Additional Comments” section of the profile page. *Id.* at 1173-1174. The court rejected the plaintiff’s argument that because of the discriminatory questions that precede “Additional Comments,” the website operator led users to express themselves in discriminatory ways in the latter section. The court reasoned that *Roommates.com* did not tell subscribers what kind of information to put in the section. Moreover, it was concerned not to go too far in limiting immunity. *Id.* at 1174. Keeping in mind the purpose of the CDA, close cases “must be resolved in favor of immunity.” *Id.* Three judges would have immunized the website with respect to the entirety of the profile pages. *Id.* at 1176-1190.

Roommates and *Lawyers Committee* land in essentially the same place: if a website is intentionally designed to facilitate illegal acts, it may not enjoy immunity under Section 230(c)(1). This is how the cases were read by the Eighth Circuit in *Johnson v. Arden*, 614 F.3d 785, 792 (8th Cir. 2010) which held that allegedly

defamatory statements about a cat breeder on the website ComplaintsBoard.com did not subject the service provider to potential liability where there is no evidence that the service provider “designed its website to be a portal for defamatory material or do anything to induce defamatory postings.”

The Seventh Circuit took a similar approach in *Huon v. Denton*, 841 F.3d 733 (7th Cir. 2016). Gawker published a blog site about the plaintiff, an accused but acquitted rapist. Many comments were posted, some of which were defamatory. The plaintiff alleged that Gawker employees may have contributed to the creation of the defamatory posts, either by writing the posts themselves or by writing other posts designed to encourage additional ones which could be expected to be defamatory. The court found that the plaintiff had sufficiently alleged that Gawker was not just a “publisher” but was also a “creator”. This decision is a warning to those who try too hard to promote interest in their sites by adding their own material.

2. Other efforts to impose liability based on *Roommates*-type analysis have been unsuccessful

Several other cases involve attempts to get around CDA immunity by alleging in various ways that service providers have brought about the wrongful conduct. They have met with a notable lack of success.

Nemet Chevrolet, Ltd., 591 F.3d 250 (4th Cir. 2009). The CDA gave immunity to the website consumeraffairs.com, despite allegations that the website was structured to solicit complaints, steered the complaints into specific categories designed to attract consumer class action lawyers, and contacted customers to ask questions (the specifics

were not alleged) and help consumers draft their complaints (again, the specifics were not alleged). *Id.* at 256-257.

Shiamili v. The Real Estate Group of New York, Inc., 17 NY3d 281 (2011). The New York Court of Appeals described the “national consensus” under the *Zeran* line of cases. *Id.* at 288-289. The plaintiff in *Shiamili* is the founder and chief executive officer of a New York realty company. The defendant is a competitor that sponsored a “blog” about the real estate industry in New York. The blog was accessible to the public. Someone posted a comment about the plaintiff, making “several allegedly defamatory statements suggesting that Shiamili mistreated his employees and was racist and anti-Semitic, referring to one of the company’s agents as ‘his token Jew’.” *Id.* at 284-285. The website administrator moved this from a thread to an independent post. After doing so, more derogatory and allegedly defamatory comments about the plaintiff were added by anonymous users. *Id.* at 285. The court agreed with previous cases that the statute does not distinguish between “neutral” and selective publishers. *Id.* at 289. Accordingly, the “defendants did not become ‘content providers’ by virtue of moving one of the comments to its own post. Reposting content created and initially posted by a third party is well within ‘a publisher’s editorial functions’.” *Id.* at 291, citing *Zeran*. The court held that even a website that is “designed to implicitly encourage [] users to post negative comments” is protected by the CDA; in fact, “[c]reating an open forum for third parties to post content – including negative commentary – is at the core of what Section 230 protects.” *Id.* at 290-291. However, the website in question was about the New York real estate industry in general, not just about the plaintiff, and the court

distinguished *Doctors Assoc. Inc., v. QIP Holder, LLC*, 210 WL 669870, 210 U.S. Dist. LEXIS 14687 (D. Conn. 2010) on this basis. *Id.* at 291.² The plaintiff tried to make use of *Roommates*, which now seems to be standard for those still trying to get around Section 230. That case was distinguished “easily” because the website in *Shiamili* did not prompt users to post illegal information, and those maintaining the site did not work with users to supply wrongful content.³

Jones v. Dirty World Entertainment Recordings, supra. A website that invited people to report “dirt” on others, and then commented on what it chose to publish, was not the “developer” of posts that had illegal content. It is not necessary for an interactive website to be neutral. It may encourage negative postings and still retain its immunity under the CDA as long as it does not itself create illegal content. *Id.* at 414-415. “Some of this content will be unwelcome to others—*e.g.*, unfavorable reviews of consumer products and services, allegations of price gouging, complaints of fraud on consumers, reports of bed bugs, collections of cease-and-desist notices relating to online speech. And much of this content is commented upon by the website operators who make the forum available.” *Id.* at 414. The person or organization maintaining a website may decide

² The *Doctor’s Associates* case grew out of a campaign by Quizno’s to convince consumers that its sandwiches are better than Subway’s. It did this through commercials and also through an Internet-based “contest” for videos about the difference between the sandwiches. The contest rules for the videos required that Subway’s product be criticized and Quizno’s sandwiches be praised. The court found that it could not conclude at the pleading stage that Quiznos was not responsible for the creation and development of the contestants’ materials. *Id.* at *24.

³ When defendants reposted the comment about plaintiff, they added some material. The post was given the heading “Ardor Realty and *Those People*,” a subheading and a picture of Jesus Christ with the plaintiff’s face and the words “Chris Shiamili, King of the Token Jews.” *Id.* at 285. The defendants were clearly “content providers” with respect to this material, but the court found that it was not defamatory in itself because no reasonable reader could have concluded it was conveying facts about the plaintiff, nor did it develop or contribute materially to the content it introduced. *Id.* at 292-293.

which postings to publish and may comment on them, without thereby adopting them as its own. These are “traditional editorial functions” and exercising them does not constitute “development” of the content of the postings. *Id.* at 416.

Universal Communications Systems, Inc., v. Lycos, Inc., supra. The host of an online message board about stocks was immune from defamation, securities fraud and cyberstalking claims. The court rejected the plaintiff’s contention that the host contributed to the violations by constructing its site so that the same person could register multiple times and thereby create the false impression of multiple critics of a company.

Obado v. Magedson, 612 Fed.Appx. 90, 93-94 (3rd Cir. 2015). Alleged manipulation of search features to give prominence to derogatory postings about the plaintiff was still within the editorial prerogative protect by the CDA.

Similar to *Roommates* and an instructive contrast to the many unsuccessful attempts to impose liability on service providers as developers of content is *FTC v. Accusearch, Inc.*, 570 F.3d 1187 (10th Cir. 2009) where no CDA immunity was afforded to the operator of a website that fulfilled users’ requests for telephone records that were (and could only be) obtained illegally.

J. Immunity extends only to claims that the information published on the internet is illegal

Section 230(c)(1) is about who may be treated as a publisher of online communications. It confers no protection against laws taxing commercial transactions carried on through the Internet. *City of Chicago v. Stubhub!, Inc.*, 624 F.3d 363 (7th Cir. 2010).

Where a commercial site like Amazon.com is the seller of the products advertised, Section 230 does not immunize it from product defect liability because this liability

depends on the quality of the product, not what is said about it on the internet. *Erie Ins. Co. v. Amazon. com, Inc.*, 925 F. 3d 135, 139-140 (4th Cir. 2019). However, it is not liable for products sold by others on its site, even when Amazon performs “fulfillment” services like warehousing and delivery (although this is not because of Section 230 but part of products liability law). *Id.* at 141-142.

Other examples of conduct not immunized by Section 230 because it does not depend on what was published on the internet are failure to give consumers copies of credit reports made available on a website, *Henderson v. Source for Public Data, LP*, 53 F. 4th 110 (4th Cir. 2022), failure to obtain certifications required by the Fair Credit Reporting Act from employers seeking credit reports, *Id.*, and Airbnb and Homeaway’s off-line processing of rentals of unlicensed dwelling units, *Homeaway.com v. Santa Monica*, 918 F.3d 676 (9th Cir. 2019).

K. “Users” are protected as well as “providers”

Most cases have involved internet service providers, not users. In *Barrett v. Rosenthal, supra*, the California Supreme Court considered the extent of protection given to a “user” as opposed to a “provider” under Section 230(c)(1). It held that user should be given its plain meaning of “one who uses” an interactive computer service. *Id.* at 74. It found no basis for concluding that Congress intended to treat “users” and “providers” differently with respect to immunity for the re-publication of content provided by others. *Id.* The court rejected proffered distinctions between “active” and “passive” users finding them both impractical and without any basis in the statute or legislative history. *Id.* at 75-76. The court reached this conclusion while recognizing that individual users do

not face the same kinds of challenges to screen massive amounts of material as do providers. *Id.* at 74. Users’ “lack of comparable financial and legal resources” as compared to providers makes the threat of litigation no less intimidating. *Id.* at 77.

L. The courts have rejected a distinction between publishers and distributors

There is an academic debate about whether CDA immunity extends to all categories of “publishers,” as the common law of defamation distinguishes between primary publishers, secondary publishers and distributors. The federal courts have shown little interest. *Barnes*, 570 F.3d at 1103-1104; *Zeran*, 129 F.3d at 332. The California Supreme Court in *Barrett v. Rosenthal*, *supra*, rejected the idea that the term “publisher” in Section 230(c)(1) was not intended to include “distributor.” *Id.* at 65-66. The court pointed out that the legislative history shows Congress “chose to protect even the most active Internet publishers, those who take an aggressive role in publishing third-party content,” and that it would be anomalous to deny protection to the less-active distributors. *Id.* at 69-70. The court agreed with *Zeran* that it is inconsistent with the principles underlying the CDA to impose notice-based liability on providers and users. *Id.* at 72-73. Inquiry would be too time-consuming and complex; it would discourage self-regulation because under the common law, there is no liability unless the distributor knows of the defamatory statement; and this kind of liability would give rise to a “heckler’s veto” and confer a “broad power of censorship on those offended by internet speech,” citing *Reno v. American Civil Liberties Union*, 521 U.S. 844, 880 (1997). *Id.* at 873. On the other hand, being a “publisher” means nothing unless the law being resisted is based on whether or not one is a “publisher”.

M. Early resolution of the CDA defense is favored

Because the purpose of the CDA is to create an immunity from suit, avoiding protracted legal battles which themselves would have a chilling effect, the question of CDA immunity is to be resolved at the “earliest possible stage of the case.” *Nemet Chevrolet, Ltd., supra*, 591 F.3d at 254-255 (4th Cir. 2009); *Roommates*, 521 F.3d at 1175.

III. DIGITAL MILLENIUM COPYRIGHT ACT

A. Purposes and structure of the DMCA

In 1998, Congress took more action to protect internet service providers from liability in order to further the development of this new world of communications. It passed the Digital Millennium Copyright Act, 17 U.S.C. § 512 (“DMCA”). The CDA deals primarily with defamation and other torts. The DMCA is about trademark and copyright. Like the CDA, the DMCA protects internet service providers from liability. Unlike the CDA, which gives very expansive protection to providers and users for the republication of content supplied by others, the DMCA balances the interests of copyright holders, users (including original publishers) and internet service providers. The DMCA provides a sequential shifting of responsibilities among these three when a claim of copyright infringement is made.

“Service provider” as used in the DMCA clearly applies to social media. Section 512(k) provides the definition:

As used in subsection (a), the term “service provider” means an entity offering the transmission, routing, or providing of connections for digital online communications, between or among points specified by a user, of

material of the user's choosing, without modification to the content of the material sent or received.

The part of the Act that is relevant to social media is Subsection 512(c).⁴ The main thrust of Section 512(c) is to immunize service providers for the storage on their sites of material that may infringe copyrights. Section 512(c)(1). A service provider is immune from infringement when it doesn't know of the infringement or lacks awareness of factual circumstances from which infringing activity is apparent. Section 512(c)(1)(i) and (ii). Furthermore, upon obtaining knowledge or awareness, to maintain its immunity the service provider must act expeditiously to remove or disable access to the infringing material. Section 512(c)(1)(A)(iii). It must not receive any financial benefit "directly attributable" to the infringing activity. Section 512(c)(1)(B).

One of the ways that the provider may obtain knowledge of infringement is by notice from the copyright holder. Section 512(c)(1)(C). This notice is what triggers the shifting of responsibilities. In order to enjoy the protections of the DMCA, the provider must have a designated agent for service of notice about copyright infringement. The Register of Copyrights maintains a directory of these agents. Section 512(c)(2). A copyright holder who believes infringement has taken place must give notice of the claimed infringement to the provider. The contents of the notice are carefully specified in the statute. Section 512(c)(3). An effective notice must:

- Be written and signed by an authorized person, including the signer's address, telephone number and electronic mail address;

⁴ Thus the exception in Section 512(k)(1)(B) referring to subsection (a) does not affect the hosts of social media. They are undoubtedly "provider[s] of online services or network access."

- Identify the copyrighted work that is said to be infringed;
- Identify the material that the holder claims is infringing;
- Include a statement under penalty of perjury of a good faith belief in the use of the copyrighted material is not authorized, that the notification is accurate and that the signer is authorized to act on behalf of the owner.

Unless the notice substantially complies with these requirements, it does not constitute “actual knowledge” by the provider about the alleged infringement. Section 512(c)(3)(B)(i). But if the notice substantially identifies the copyrighted work, identifies the allegedly infringing material and gives the provider means to contact the complainant, then the provider must contact the complainant and help satisfy the other requirements for effective notice. Section 512(c)(3)(B)(ii).

When all this is done, the provider takes down or disables access to the allegedly infringing material. It incurs no liability for doing so, even though the claim of infringement may be mistaken, as long as it acts in good faith and gives the user who put up the material an opportunity to counter the claim of infringement. Section 512(g). The provider must take “reasonable steps promptly to notify the subscriber.” Section 512(c)(g)(2)(A). The subscriber may give the provider counter-notification. Like the copyright holders’ notice, the statute spells out what the subscriber’s counter-notification must contain. Section 512(g)(3)(A)-(D). The elements are:

- A writing, signed by the subscriber and the subscriber’s name, address, and telephone number;

- Identification of the material that was removed or to which access was disabled, including where it was before such an action was taken;
- A statement under penalty of perjury of a good faith belief that the action was the result of “mistake or misidentification” of the material;
- Consent to jurisdiction of the United States District Court for the district in which the subscriber’s address is located and to accept service of process from the copyright holder.

The provider must give a copy of the counter-notice to the copyright holder and notify the copyright holder that the material will be restored in ten business days. Section 512(g)(2)(B). Unless the copyright holder files an action in the court where the subscriber’s address is located, and notifies the provider, the provider restores the material in no less than ten or more than fourteen days. Section 512(g)(2)(C).

B. “Take-down” notices by copyright owners

A take-down notice that does not perfectly comply with all of these requirements but does so substantially still obligates the internet service provider to take action against the allegedly infringing material. *ALS Scan, Inc. v. RemarQ Communities, Inc.*, 239 F.3d 619 (4th Cir. 2001). In *ALS Scan*, the service provider made a variety of newsgroups available to subscribers. Two of the newsgroups were devoted to “adult” photographs and had domain names that used part of the plaintiff’s business name. The plaintiff alleged that most of the material distributed in these news groups consisted of unauthorized copies of its photographs. Its take-down notice did not identify each and every allegedly infringing photograph and where it was located in the newsgroups. The

court held that when a copyright owner gives notice “with respect to multiple works, not all must be identified – only a ‘representative list’.” *Id.* at 625. In this case, it was enough that the notice identified the news groups in question, asserted that virtually all the images on those sites were its copyrighted works and referred the service provider to addresses where it could find the plaintiff’s copyright information. *Id.* One part of the take-down notice that may not be omitted is the declaration under penalty of perjury that the person sending the notice is authorized to do so and has a good faith belief that the use is infringing. *Perfect 10, Inc. v. CBILL LLC*, 488 F.3d 1102, 1112 (9th Cir. 2007).

C. The burden is on the copyright owner to find infringements

The DMCA notification procedures place the burden of policing copyright infringement on the owners of the copyright. *Perfect 10, Inc., supra*, 488 F.3d at 1113. In *UMG Recordings, Inc. v. Shelter Capital Partners, LLC*, 667 F.3d 1022 (9th Cir. 2011), the court held that the video service Veoh was only required to take down material specifically identified by copyright owners and not to search its system for all videos using music by the artists identified in the notices. *Id.* at 1042. Although an informal email from someone other than a copyright holder identifying specific infringing material might be “actual knowledge” triggering the provider’s obligation to take down the material, a copyright holder must follow the notification requirements of Section 512(c)(3). *Id.* at 1040. The court emphasized that Veoh was entitled to the safe harbor because it claimed it promptly removed allegedly infringing material promptly when notified, which the plaintiff did not rebut. *Id.* at 1040, 1043.

Viacom monitored YouTube for several months and accumulated about 100,000 videos it thought were infringing. It sent a mass take-down notice and the next day, YouTube had removed virtually all of them. *Viacom International, Inc. v. YouTube, Inc.*, 718 F.Supp.2d 514, 524 (S.D.N.Y. 2010). Viacom sued just the same. It contended that because there was so much infringement, YouTube had notice and therefore could not rely on the DMCA's protection. The court disagreed. "A general knowledge that infringement is 'ubiquitous' does not impose a duty on the service provider to monitor or search its service for infringements." *Id.* at 525. *See also UMG*, 667 F.3d at 1038 (general awareness of infringement is not enough to give a provider actual notice.) Because YouTube promptly removed material upon receiving the take-down notice from Viacom, it was protected. *Id.* at 526.

D. But the internet service provider must have a policy for dealing with repeat offenders

In order to enjoy the protection of the DMCA, the service provider must have "reasonably implemented" a policy that provides for the termination "in appropriate circumstances" of "repeat infringers." Section 512(i)(1)(A). A policy is "reasonably implemented" if the provider "has a working notification system, a procedure for dealing with the DMCA-compliant notifications, and if it does not actively prevent copyright owners from collecting information needed to issue such notifications." *Perfect 10, Inc., supra*. "Repeat infringer" is not defined. Service providers are given latitude in deciding when to take action to terminate a user who receives more than one DCMA take-down notice. *Corbis Corp., supra; UMG v. Veoh*, 665 F.Supp.2d 1099, 1116 (C.D. Cal. 2009), *aff'd UMG Recordings, Inc. v. Shelter Capital Partners, LLC*, 667 F.3d 1022 (9th Cir.

2011) (two strikes); *Viacom, supra*, 718 F.Supp.2d at 227-528 (three strikes). Of course, the mere fact that a take-down notice has been given does not establish that infringement has taken place. *Corbis, supra*.

E. A copyright owner must take the “fair use” doctrine into account when deciding whether to give a take-down notice

In order for a copyright owner to give a “take-down notice” under the DMCA, it must evaluate whether the material makes fair use of the copyright. *Lenz v. Universal Music Corp.*, 801 F.3d 1126, 1132-1133 (9th Cir. 2015). “[F]air use is ‘authorized by the law’ and a copyright holder must consider the existence of fair use before sending a takedown notification under § 512(c)”. *Id.* at 1133.

F. DMCA creates a cause of action against a copyright owner who gives a take-down notice materially misrepresenting its rights

Section 512(f) provides:

(f) Misrepresentations.--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 misidentification,

shall be liable for any damages, including costs and attorneys’ fees, incurred by the alleged infringer, by any copyright owner or copyright owner's authorized licensee, or by a service provider, who is injured by such misrepresentation, as the result of the service provider relying upon such misrepresentation in removing or disabling access to the material or activity claimed to be infringing, or in replacing the removed material or ceasing to disable access to it.

To be liable under Section 512(f), the copyright holder must not have a “good faith belief” that the material is actually infringing and this is a subjective, rather than

objective, standard. *Rossi v. Motion Picture Association of America, Inc.*, 391 F.3d 1000, 1004 (9th Cir. 2004); *Lenz, supra*, 801 F.3d at 1134.

There has been at least one successful case under Section 512(f). *Online Policy Group v. Diebold, Inc.*, 337 F.Supp.2d 1195 (N.D.Cal. 2004). Diebold makes electronic voting machines. A big batch of internal Diebold emails revealing problems with the machine was posted on an Internet site. Diebold gave a mass take-down notice for the entire collection. It claimed copyright protection for “portions” of the email archive but never identified any specific emails that contained copyrighted content. *Id.* at 1203. It apparently also conceded at least some of the materials were subject to the fair use doctrine. The court interpreted Section 512(f)’s requirements that the copyright owner “knowingly” and “materially” misrepresents that infringement has occurred to mean that owner actually knew or should have known with reasonable care or diligence that it was misrepresenting the facts, and that the misrepresentation “affected” the service provider’s response. *Id.* at 1204. In this case, no reasonable copyright holder could have believed that there was actual infringement and the result of Diebold’s take-down notice was that the material was taken down, which was the precise result Diebold intended. It was therefore liable under Section 512(f). The DMCA was not designed to be used as a “sword to suppress publication of embarrassing content rather than as a shield to protect [] intellectual property.” *Id.* at 1204-1205.

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G. Preemption

The law has an express preemption provision. Section 230(e) is mostly anti-preemption but it importantly proscribes the application of inconsistent State of local laws:

(1) No effect on criminal law

Nothing in this section shall be construed to impair the enforcement of section 223 or 231 of this title, chapter 71 (relating to obscenity) or 110 (relating to sexual exploitation of children) of title 18, or any other Federal criminal statute.

(2) No effect on intellectual property law

Nothing in this section shall be construed to limit or expand any law pertaining to intellectual property.

(3) State law

Nothing in this section shall be construed to prevent any State from enforcing any State law that is consistent with this section. No cause of action may be brought and no liability may be imposed under any State or local law that is inconsistent with this section.

(4) No effect on communications privacy law

Nothing in this section shall be construed to limit the application of the Electronic Communications Privacy Act of 1986 or any of the amendments made by such Act, or any similar State law.

(Emphasis added)

State law is preempted to the extent that if applied, it would prevent a party from complying with the DMCA. *Online Policy Group, supra*, 337 F.Supp.2d at 1205.

IV. TRADEMARK, TRADE NAME OR COPYRIGHT INFRINGEMENT

A. Critical use of trademarks and tradenames

Trademark and trade name protection is given by the Lanham Act, 15 U.S. §§1111, et seq. Liability is imposed only where a party's action has created a likelihood of confusion as to the origins of "goods, services, or commercial activities." 15 U.S.C.

§1125(a)(1). Under this basic rule, virtually everything we can conceive a union doing in the course of a campaign is not actionable. When a union uses a trade name or trademark in a boycott message, there is no reasonable chance that anyone would be so confused as to think the company was boycotting itself. *See, e.g., Cintas Corp. v. UNITE HERE*, 601 F. Supp. 2d 571 (S.D. NY), *affirmed* 2009 WL 4577027, 187 LRRM 2800 (2nd Cir. 2009); *Senco Products, Inc. v. International Union of Electrical Workers*, 311 F.Supp. 590, 591-92 (S.D. Ohio 1970).

That is true of every publication antagonistic to the owner of the name or mark. The First Amendment does not permit businesses to use federal trademark law to suppress criticism of the business; the trademark laws only prevent the destruction of a trademark's ability to associate the mark with the appropriate products or services. *See L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 31 (1st Cir. 1987); *Smith v. Chanel, Inc.*, 402 F.2d 562, 565-66 (9th Cir. 1968). Constitutional protection for non-commercial editorial speech outweighs any incidental interest in preventing identification of a company by reference to its name and logo, *see, e.g., Cliff Notes v. Bantam Doubleday Dell Pub. Group*, 886 F.2d 490, 492-96 (2nd Cir. 1989), or a book or song title, *see, e.g., Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 & n. 7 (5th Cir. 1999) and *Park v. LaFace Records, Inc.*, 296 F.2d 437, 451-52 (6th Cir. 2003). Generally, the types of communications issued by unions are noncommercial speech. *See Edward J. De Bartolo Corp. v. Florida Gulf Coast Building and Construction Trades Council*, 485 U.S. 568, 576 (1988).

The object of the law is to prevent someone other than the true owner of the name of mark from passing off its goods or services as those of the owner. About the only way this could occur in a labor dispute is if the union sold articles like T-shirts, caps or buttons with a union message including the name or mark. Even then, the chances of anyone believing that goods with hostile references to the company were produced by the company is virtually nil. As a precaution, however, it is advisable for the union to give away rather than sell these items. *But see Smith v. Wal-Mart Stores*, 537 F.2d 1302 (N.D.Ga. 2008) (products with logos mocking Wal-Mart and comparing it to Nazi Germany with names like “Walocaust” on mugs, underwear, camisoles, teddy bears, bumper stickers and bibs for sale online was protected parody).

The owner of a trademark or trade name thinking of suing a union for infringement in the course of a campaign faces difficult remedial problems. In federal court, injunctive relief is barred by the Norris-LaGuardia Act, 29 U.S.C. §§101 et seq. *Marriott Corp. v. Great Am. Serv. Trades Council*, 552 F.2d 176 (7th Cir. 1977); *CNA Fin. Corp. v. Teamsters Local 743*, 515 F.Supp. 942 (N.D. Ill. 1981); *Senco Products, supra*, 311 F.Supp. at 591-92.

Even more fundamentally, in the usual infringement action, the owner is seeking to stop the sale of goods or services that are misleadingly labeled. At best, this is commercial speech entitled to reduced constitutional protection. *See Virginia Pharmacy Bd. v. Virginia Citizens Customer Council, Inc.*, 425 U.S. 748 (1976). The union, however, will not be selling anything. Its message will be a boycott or some other form of publicity. Such exercises of free speech may not be enjoined. "Prior restraints" of free

speech are unconstitutional. *Organization For A Better Austin v. Keefe*, 402 U.S. 415 (1971). This is a very powerful doctrine which has prevailed even against assertions of national security. *New York Times Co. v. U.S.*, 403 U.S. 713 (1971) (Pentagon Papers case).

B. Use of copyrighted material

Copyright issues also come up in the course of union campaigns. Sometimes it is because copyrighted material such as newspaper or magazine articles, or news broadcasts, are included in campaign materials. Other times it is because some copyrighted work of a target company is being ridiculed.

In virtually all cases, the defense to a threat of suit for copyright infringement is reliance upon the "fair use" doctrine codified in 17 U.S.C. §107. Section 107 provides:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include--

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

Although there are four tests and "all are to be explored, and the results weighed

together, in light of the purposes of copyright”, *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994), the key one is the degree of transformation involved. That is, how unlike is the new work to the thing that was borrowed. "The more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against the finding of fair use." *Id.* at 579. Although the fact that a publication is commercial as opposed to nonprofit is a factor that tends to weigh against a finding of fair use, *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984), "the mere fact that a use is educational and not for profit does not insulate it from a finding of infringement." *Campbell v. Acuff-Rose, supra*, 510 U.S. at 584.

Under the second statutory factor, there has been recognition that some works are "closer to the core of intended copyright protection than others," with works of fiction and imagination accorded core treatment and factual and news accounts entitled to less protection. *Campbell v. Acuff-Rose*, 510 U.S. at 586.

Under the third factor, the question is the relation between the portion used and the entirety of the copyrighted work. It is not simply a matter of quantity, but of quality and importance, too. *Campbell v. Acuff-Rose*, 510 U.S. at 587. Courts speak of whether a new work uses the "heart" of the copyrighted one.

The fourth factor is market analysis. The question is the extent of market harm caused by the alleged infringement:

When a commercial use amounts to a mere duplication of the entirety of an original, it clearly 'supersede[s] the objects,' [cit. om.], of the original and serves as a market replacement for it, making it likely that cognizable market harm to the original will occur. [cit. om.]. But when, on the contrary, the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred.

Campbell v. Acuff-Rose, 510 U.S. at 591. But the Court has cautioned that the only market harm that is relevant in copyright analysis is that which occurs from product substitution. Harm that flows from comment or criticism does not count. *Campbell v. Acuff-Rose*, 510 U.S. at 593.

The court in *Campbell v. Acuff-Rose* drew a very important distinction between parody and satire. Parody is where the copyrighted work is the target of the comment or criticism. Satire is where the protected work is “merely a vehicle to poke fun at another target.” *Campbell v. Acuff-Rose*, 510 U.S. at 580. This principle was applied in *Henley v. DeVore*, 733 F.Supp.2d 1144 (C.D. Cal. 2010). Don Henley sued over videos put on YouTube by Republican politician Charles DeVore. The videos mocked President Obama and Nancy Pelosi with lyrics set to Henley’s tunes, “The Boys Of Summer” and “All She Wants To Do Is Dance.” *Id.* at 1147-1148. Henley sued and DeVore and his publicist defended on grounds of fair use. In what seems like a stretch given the purpose of the videos to raise money for DeVore’s campaign by showing his criticism of Obama and Pelosi, the defendants claimed that they were really aiming at Henley because his political views were supposedly in line with those of the politicians attacked in the videos. *Id.* at 1154. This led the court to consider, at length, the question of whether the protection for fair use parody extends to criticism of the author of a work as opposed to the work itself because in this case, there was no criticism of the original songs but of Henley, their author. *Id.* at 1152-1155. In the end, however, the court found it unnecessary to resolve the question because one of the altered songs did not make any comment on Henley and in the other, the comment was a “minor jab” that could not

justify use of the entire song. *Id.* at 1155. Moreover, assuming that criticism of the author can qualify as parody, “it must target the author directly, as opposed to targeting the author’s views generally.” *Id.* at 1157. Simply mocking political views which the author may share with others is not enough. *Id.* at 1158.

In *Bourne Co. v. 20th Century Fox*, 602 F.Supp.2d 499 (S.D.N.Y. 2009), plaintiff was the sole owner of the copyrighted song “When You Wish Upon A Star.” He owned the copyright registrations for the unpublished version of the song, the published version in *Pinocchio*, published sheet music, and other arrangements. This song was written for *Pinocchio* (the movie) and sung by the character Jiminy Cricket. It has been used by the Walt Disney Company as licensee in “The Wonderful World Of Disney” TV series, in Walt Disney Pictures’ opening logs, and in TV ads for Disneyland.

Defendants were creators/producers of the “Family Guy” TV show, which aired an episode containing the song “I Need A Jew,” which was a thinly-veiled copy of the music from “When You Wish Upon A Star,” paired with new anti-Semitic lyrics. Defendants argued that the song was an integral part of Disney’s personality and reputation (both Walt’s, and the Company’s) and is associated with Walt Disney in the public mind. Defendants had sought a license to use the song but Plaintiff refused. Defendants argued that one of the song’s intentions was to make a point about Disney’s alleged anti-Semitism. It was found to be fair use.

A very prominent and instructive case is about the role of the fair use doctrine to protect criticism but not appropriation of intellectual property is *Cariou v. Prince*, 714 F. 3d 694 (2nd Cir. 2013). The artist Richard Prince took apart a book of photographs of

Rastafarians made and copyrighted by Patrick Cariou. Prince incorporated the photographs into 29 works of his own. The photographs were sometimes enlarged, cropped, tinted or over-painted and sometimes included in collages with other articles. *Id.* at 699-700. Prince's works sold well, some for millions of dollars. Cariou sued for copyright infringement.

Prince defended on the fair use doctrine. The District Court rejected the defense because Prince's artwork in no way referred back to or commented on Cariou's work. It held that to be fair use, the new work must "in some way comment on, relate to the historical context of, or critically refer back to the original works." *Cariou v. Prince*, 784 F.Supp.2d 337, 348 (S.D.N.Y.2011). Prince argued that he is an "appropriation artist" and that taking the work of others and re-combining it with elements of his choosing is fair use even though he has no interest in the original meaning of the photographs he uses and admitted that he doesn't "really have a message" he attempts to communicate when making art. *Id.* at 349. The District Court rejected this approach to fair use, finding that it would obliterate any real limits to the doctrine. *Id.* at 348-349.

The Court of Appeals reversed, except for five of Prince's works. It disagreed that "comment" on the original is a necessary component of fair use. "The law imposes no requirement that a work comment on the original or its author in order to be considered transformative, and a secondary work may constitute a fair use even if it serves some purpose other than those (criticism, comment, news reporting, teaching, scholarship, and research) identified in the preamble to the statute." 714 F. 3d at 706. What counts the most is transformation, the creation of a "fundamentally different aesthetic." *Id.* at 708. The Court of Appeals also disregarded Prince's testimony that he didn't have any particular message in mind

when he made his works nor did he pay any attention to what Cariou's intentions had been. Instead, fair use inquiry focuses on how the work would "reasonably be perceived." *Id.* at 707. The court also saw as important that Prince's works were sold to a much different audience (the rich and famous) than Cariou's (people interested in Rastarian culture). *Id.* at 709. The Court of Appeals decision appears to be contrary to the Supreme Court's reasoning about the difference between parody and satire, which does indeed take "comment on the original" into account in a serious way. This was recognized in *Dr. Seuss Enterprises, LP v. COMICMIX LLC*, 983 F. 3d 443, 452 (9th Cir. 2020). The court held that a parody is a comment on the original work and is transformative, earning credit for the "central purpose" under the first and most important factor of fair use analysis. A comic book "mashing up" Star Trek characters in a Dr. Seuss-style world was not a parody—and therefore not transformative—because the drawings merely mimicked Dr. Seuss's style uncritically. *Id.* at 453.

The sum of these points is quite clear: when copyrighted things are used in union campaign materials, it is important to make sure that the degree of transformation is as great as possible and the distinction between parody and satire is always kept in mind.