



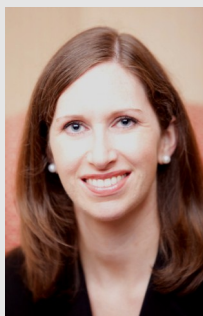
# THE QUARTERLY JOURNAL

CHATTANOOGA CHAPTER OF THE FEDERAL BAR ASSOCIATION

July 2013

Volume 2, Issue 3

## COMBATTING THEFT OF DIGITAL PHOTOGRAPHS AND CONTENT



By Autumn Witt Boyd  
Attorney, Harmon &  
Seidman LLC, and  
former law clerk to  
United States District  
Judge Curtis L. Collier

You don't have to specialize in intellectual property law to field questions from clients about a major problem in the Internet Age: online theft of photographs, website designs or text. Too often, Internet outlaws think nothing of stealing what your client has worked hard to create. While some "borrowing" may be harmless, other types of theft can damage your client's business or affect her reputation. The Digital Millennium Copyright Act ("DMCA") is one avenue to provide a toolbox full of options when faced with theft of online content.

Congress passed the DMCA in 1998 to address copyright infringement and piracy on the Internet. The DMCA, found at 17 U.S.C. § 1201 *et seq.*, prohibits the manipulation of any "technological measure that effectively controls access to" a copyrighted work, such as anti-copying technologies. The DMCA also forbids the use of false "copyright management information." An example of a violation is attributing authorship to someone who was not indeed the creator of content. Another example is removing copyright management information in a manner that would enable copyright infringements.

While the DMCA in general serves to protect owners of digital property, another key provision of the DMCA limits liability for copyright infringement for certain Internet Service Providers (ISPs). This "safe harbor" provision protects ISPs that store material online at the direction of its users, so long as the ISPs follow certain rules after being properly notified of a violation. The "safe harbor" does not protect the actual infringer, but instead furnishes a mechanism, called a "takedown process," for content owners to request that ISPs remove infringements of copyrighted works, and limits the ISP's liability if it follows the procedure.

The takedown process is detailed below, but it is important to understand that the process is coupled with a "good faith" requirement. In order to comply, a content owner requesting the removal of content must have a "good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law." 17 U.S.C. § 512(c)(3)(A)(v). If the process is used without this good faith, a client may be liable for damages, including costs and attorneys' fees.

The appropriate and prescribed response to digital thievery, in terms of the "takedown process," varies based on the type of

copyrighted work, the kind of unauthorized use, and the damage done.

### The Guileless Grab

In the first scenario, assume your client posted a family vacation photograph on a public website, without any copy protection. The photograph is only personally, not commercially, valuable. Your client, while browsing a local website, later finds his photograph used to advertise products of an unrelated company, without permission. Your client is justifiably upset, but not damaged monetarily. He wants his photo removed, immediately.

**Main goal:** Removal of his photograph.

**Best response:** Phone call or letter followed by takedown request letters if necessary.

The first step in any of these examples is to make a record of the infringement. Take a screenshot of the offending website, showing the exact website URL and including time and date stamp. Make sure to record each different URL where the image appears, since photos are often posted in more than one place on a website. After you contact the infringer or send a takedown letter, this material may be impossible to retrieve, which could hinder your client's ability to later file suit.

Second, a quick phone call or e-mail to the offending company may just do the trick. Oftentimes the offender (or her web designer) has simply made an honest mistake and is eager to correct it.

If instead you receive pushback or refusal to take down the photograph, the next step is to send a "takedown letter" following the procedure outlined in section 512 of the DMCA. Importantly, the DMCA does not require that a copyrighted work be registered with the United States Copyright Office to use the takedown procedures. A general outline of the procedure follows.

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Research the website's ISP. You may have to dig deep, searching with the IP address (a sequence of numbers) at [www.arin.net/](http://www.arin.net/). The Copyright Office also keeps a database of ISPs' designated agents for DCMA notifications at: [http://www.copyright.gov/onlinesp/list/a\\_agents.html](http://www.copyright.gov/onlinesp/list/a_agents.html). Not all ISPs are listed in this database-- if you cannot locate a mailing address elsewhere, you can conduct a search at [arin.net](http://www.arin.net/) by typing in the ISP's website address.

Consider any legitimate defenses the user may have (*i.e.* fair use) and conduct a reasonable investigation to ensure you have a "good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law."

Draft a letter requesting removal and certifying a "good faith belief" that the use is unauthorized. Send it to the infringing website's ISP, any other websites hosting infringing material (*i.e.*, YouTube.com, etc.), and Google or other search engines that retrieve the infringing website(s) as a result of searches. Google will only research specific URLs, and will not respond to a general request, for example, that a certain image be removed wherever it may be found.

You should not send a DMCA letter to the infringer himself, who is not covered by the DMCA's safe harbor provisions. Instead, you should send an ordinary cease-and-desist letter to the actual infringer if your initial informal contact is unsuccessful.

Google's response to the DMCA puts an interesting twist on the takedown procedure. If you send a takedown letter to Google, it will forward the letter (with the *attorney's* name, address and other identifying information removed) to a website titled, "Chilling Effects" (<http://www.chillingeffects.org>) for publication. It will also post a link to your letter on the Chilling Effects site where the infringement would have appeared as a search result. You should balance the benefit of sending a takedown letter with the potential detriment of having your letter, and your client's name, appear in response to searches on Google.

In response, the ISPs to whom you send the letter will forward it to the alleged infringer for a reply. The alleged infringer may then make a counter notification, which will be forwarded to the copyright holder. If a counter-notification is received, the copyright holder only has 14 days to evaluate any asserted defenses to its good-faith belief of infringement and either file an infringement suit or allow the online service to re-post the material.

If these efforts do not yield a takedown, the last resort is to file a copyright infringement action in federal court. This is an expensive solution, and is not likely to be your client's first

choice for the family photograph at issue in this scenario. Service of a draft complaint, with a letter stating your intention to file it with the court, may convince the infringer to remove the photograph if all else has failed.

### The Pernicious Pinch

At the other end of the spectrum, assume your client has devoted time, creativity, and resources to developing an impressive website, containing detailed text, custom graphics, and photographs. One of her customers calls to tell her that a competitor's website looks awfully similar. After investigating, you find that the competitor has copied paragraphs of text verbatim, as well as several graphics and photographs. Additionally, your client included a watermark on the photographs and graphics that showed they belonged to her company. Her competitor removed that watermark from the photographs on its website.

*Main goal:* Compensation for unauthorized use, and removal of infringed text and images.

*Best response:* Demand letter followed by takedown request letters and lawsuit, if necessary.

The Copyright Act provides enhanced remedies, including up to \$150,000 per willfully infringed work and fees/costs if a work is registered prior to infringement or within one month after the copyright owner learns of infringement.

Because the infringer in this situation is a competitor, and may have profited from the use of your client's copyrighted works to grow its business, you will want to consider a copyright infringement action. In addition to the standard remedies for copyright infringement found in 17 U.S.C. § 504, § 1203 of the DMCA provides an additional remedy for the removal of the watermark.

As outlined above, the infringement should be documented before any contact is made with the infringer. If the works are not already registered with the Copyright Office, now is the time to do so. The Copyright Act provides enhanced remedies, including statutory damages up to \$150,000 per willfully infringed work and attorney's fees and costs, if a work is registered prior to infringement or within one month after the copyright owner learns of infringement. The Copyright Act requires that works must be registered prior to filing an infringement action, so registration at this time is smart if litigation is on the horizon, even if it is too late to benefit from the enhanced damages provisions. Registration is not expensive or difficult, and many clients are capable of registering their works without an attorney's help through the Copyright Office website, [www.copyright.gov](http://www.copyright.gov).

After registration, usually the next step is sending a demand letter requesting payment for the unauthorized use and asking that the infringer remove the copyrighted works. However, if litigation is likely and the infringer is located in an unfavorable jurisdiction, there is a possibility it might file an anticipatory

## OPINION/EDITORIAL

ELIZABETH FORD

FEDERAL DEFENDER

### HAPPY (OR SAD) 50<sup>TH</sup> ANNIVERSARY TO *GIDEON V. WAINWRIGHT*

Never did it cross our minds that we would be asking people to save the federal defender's office. After all, this is the year of the fiftieth anniversary of the Supreme Court's decision in *Gideon v. Wainwright*, and we are within one year of celebrating the fiftieth anniversary of the Criminal Justice Act (CJA), the model for indigent representation around the world.

Approximately 90% of those individuals prosecuted in federal court qualify for court appointed counsel. The CJA requires and allows district courts to decide how indigent defendants will be represented. In our district, approximately 60% of the indigent appointments are vetted to the community defender, Federal Defender Services of Eastern Tennessee (FDSET). The remaining appointments are assigned to qualified attorneys who are members of the local CJA panel. CJA Panel appointments are made primarily when the FDSET has a conflict of interest in representation due to multi-defendant indictments and investigations.

During the last few months and on a nationwide scale, federal defenders have seen their budgets cut more than 10% from the federal budget sequester. The CJA budget, which funds both federal defender offices and panel attorneys, is a part of the Judiciary's budget. Decisions about office budgets and staffing are made by various committees of the Judicial Conference.

The 10% reduction has resulted and will continue to result in serious consequences that threaten the tenets of *Gideon* and Justice Hugo Black's urging that all defendants should stand equal before the law. There have been permanent layoffs and extensive furloughs forced upon defenders' offices. Our FDSET avoided both layoffs and furloughs through a series of cost savings measures, including the suspension of pension contributions for half of the year. This immediate measure will not even begin to address the budget crisis in store for FDSET in 2014—a crisis that will absolutely have a dire impact upon our local FDSET office.

It is the opinion of the agencies and offices involved that federal defender budgets will be slashed an additional 23%. Since

salaries, benefits, and rent represent 90% of our operating budget, a cut of that size may mean elimination of the Chattanooga and Greeneville offices. Those two offices, which are comprised of 13 dedicated professionals, opened 716 cases in fiscal year 2012 alone.

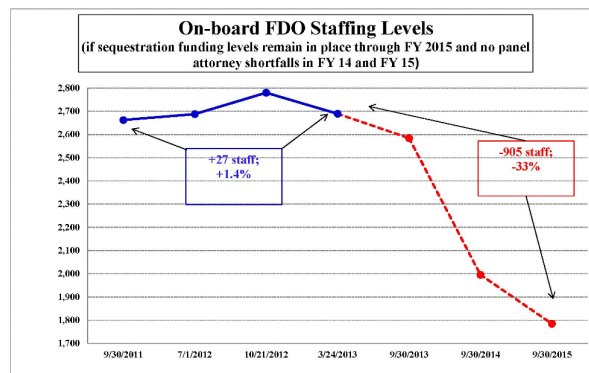
Some have suggested assigning more cases to CJA panel attorneys. That will only serve to increase costs. Nationally, the CJA panel currently tags the federal government at \$1.8 million per day. Our district is not unique in that FDSET's costs per case are significantly lower than the panel's cost per case. If FDSET is forced to close offices, more cases will go to the CJA panel. That will cause the cases to cost more, resulting in less money for defender offices. This will only perpetuate the downward spiral and result in an obliteration of *Gideon*.

What can be done? In the short term, a temporary suspension of CJA panel payments would permit federal defenders to maintain current staffing levels. This interim proposal is only a **suspension** of payments. Panel attorneys would still ultimately be reimbursed.

The only long term solution is for Congress to approve an anomaly. This special appropriation would enable the federal defender program to continue to represent indigent defendants in the cost efficient, competent manner that it has for almost 50 years.

If you believe that our current system of defender/panel attorney representation of indigent defendants should continue and an anomaly should be passed, please let your Congressman and Senators know and ask them to support an anomaly for the Judiciary. Please also consult any local

members of the relevant committees to advocate on behalf of federal defenders. Committee information may be found at <http://www.uscourts.gov/FederalCourts/JudicialConference/Membership/JudicialConferenceMembers.aspx> or <http://news.uscourts.gov/chief-judge-traxler-chair-executive-committee>. If you have any questions, please call me at (865) 637-7979 or email me at [Elizabeth\\_Ford@fd.org](mailto:Elizabeth_Ford@fd.org).





## HOWARD'S TALENTED TENTH PROGRAM WRAPS UP ITS SECOND YEAR OF PARTNERSHIP WITH THE CHATTANOOGA CHAPTER



*by Douglas S. Hamill*

In April, the FBA hosted a barbecue for students involved in Howard High School's "Talented Tenth" program, along with the students' FBA mentors. The Talented Tenth program, open to 10th through 12th graders, equips high-achieving students - the top 10 percent - to develop leadership skills and to prepare students to enter professional life. But more importantly, it teaches the students to become problem-solvers and positive influences in the community. After all, these students will be the leaders of tomorrow, and they are developing skills to better improve their neighborhoods, communities, families, and hopefully their peers.

Exavious Farley is the program's coordinator. Over time, he has become a mentor to the students - not just a teacher. The students, too, have grown together as a unit. As Senior Jaliyah Truss stated, "We're more than just a class. We're a family."

Participating students not only learn and nurture leadership skills in the program, but they also dedicate time serving others. For example, the group volunteered time at the Ronald McDonald House, sprucing it up and helping staff and volunteers with chores. They have also performed service projects at rival schools, Tyner and Brainerd.

Many students at the barbeque expressed appreciation for the time spent throughout the year with their FBA mentors. For example, Senior Jessica Cummings went to the movies with her mentor, Katharine Gardner. Mentor Kara West took Jaliyah Truss to the Tennessee Valley Railroad Museum because Jaliyah has an interest in engineering. Such mentoring not only benefits the students in terms of cultivating professional contacts and learning about career paths and college options, but also provides emotional encouragement and confidence to help propel students forward to their next stage in life.

In fact, the next stage for many program participants is bright with opportunity. Several seniors are headed off to college in the fall. As Jessica Cummings stated, "I'm excited about college, but I'm really going to miss our group. This has been such a great semester. I don't want it to end."

In the Talented Tenth program, the Chapter continues to work with bright and energetic young ambassadors who have the vision and tools to tackle the problems in our communities. The Chattanooga Chapter is grateful to have participated in at least a small, but significant, part in our community's bright future.

Pictured Above, L-R: The Honorable Rob Philyaw with mentee Deshaun Wilson; Chapter President Katharine Gardner with mentee Jessica Cummings

# LABOR PAYNE

## WAITING FOR THE TRAIN

Air conditioning technology has reached Rhea County. It's just spread thin. Some of the local businesses are asking a single window unit, the size of a dorm room microwave, to chase out an encroaching summer heat that evokes Harper Lee's description: *"Somehow, it was hotter then: a black dog suffered on a summer's day; bony mules hitched to Hoover carts flicked flies in the sweltering shade of the live oaks on the square. Men's stiff collars wilted by nine in the morning."*

In the cavernous courtroom of *State of Tennessee v. John T. Scopes* fame in the Rhea County courthouse, counsel is not required to ingest salt tablets or Powerade to make it through opening argument, but there is indeed a gradual wilting that occurs as the air conditioning slowly fails and the summer afternoon stillness starts to make breathing, speaking, and thinking seem more superfluous.

Every 30 to 40 minutes, a freight train rolls through downtown Dayton and blows its whistle for several long intervals. The judge asks that the attorneys stop wherever they are in the case and stand in complete silence until the train has passed. Even if you are about to spring the trap at the climax of your pithy cross examination, you must pause and listen to the train and your own unspoken thoughts left hanging under the courtroom's high ceiling.

A moment of silence in a court proceeding is an eerie thing. Behind all the speaking and questioning, you are reminded, there was always the unilateral participation of the jurors, engaged in the quiet acts of listening, thinking, and daydreaming in the background. *But listening, thinking, and daydreaming of what?*

This summer, in Rhea County, I "spearheaded" my first trial. I say, spearheaded, rather than "first chaired," because I received expert support and direction from Doug Hamill. From beginning to end, it was a thoroughly enriching experience, but what I will remember the most often is the inexorable presence of the jurors, from the moment they congregated as a hundred-strong pool of impenetrable faces to the final scene when twelve

people shambled back out into the sunshine.

In the *Scopes* trial courtroom, the proceedings occur on a peculiar raised platform at the top center of the timeless space. The parties, jurors, judge, clerk and reporter are huddled up in such a way that one cannot help but feel the strange intimacy of the overbooked airplane or interminable elevator ride. Seated inches away from the jurors, I became acutely aware of the idea that I was in some sort of conversation with these people, but it was an oddly one-sided conversation.

Who am I to speak about the law to a group of people? Am I one of them talking about an experience we now share? Or am I a stranger pedaling an even stranger exception to other strangers? The law has increasingly become the process of bringing the city to the country, the corporate to the individual, and statutory zeitgeist to the status quo of the community. As an advocate for a party, you are not the embodiment of the law, but you are surely caught between the law and a group of people whose perceptions you cannot know, whose shared experience you can only guess at.

I'm reminded of a line from Mark Strand's poem, "Anywhere Could Be Somewhere": *I might have come from the outskirts of a city from which others have come or maybe a city from which only I have come. Who's to know? . . . They say things are happening at the border, but which border is anyone's guess.* (Knopf, 2012).

As attorneys, we pride ourselves on perspicacity and clairvoyance. However, the world is neither transparent nor static. People are only semi-permeable and only on certain days. In order to get a message across to a group of people, you have to respect their borders even though you don't exactly know where those borders are. So, that's what I thought about in Rhea County while waiting for the train: not what to say next, but what could be left out, curtailed, distilled to make the most of someone else's time and judgment. And I reminded myself to breathe.

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### *Combating Theft, cont'd from page 2*

declaratory judgment action. Sometimes filing suit in your client's home district is preferable to losing the venue advantage by attempting to negotiate; you always have the option to wait to serve the complaint while you attempt to resolve the dispute. If informal negotiation fails, the takedown steps outlined above can be utilized to ask that the ISP take down the infringing content.

If the last resort, an infringement action, is required, a copyright holder is entitled to his or her actual damages from the

infringement (either lost sales or the fee she would have charged for use of her work), as well as the infringer's profits from infringement. These can be substantial damages in a case involving competitors.

While the DMCA provides new tools to enforce existing copyright laws, as well as giving new protections to copyright owners of digital works, many times the old-fashioned tactics of a cease and desist letter and negotiation win the day.

## MESSAGE FROM THE CHAPTER PRESIDENT

By Katharine M. Gardner

With the sauna-like weather we've been having recently, it's hard to focus on that cool, clear month of October with its beautiful yellows, oranges and reds. But I would like you to turn your attention to that month and two wonderful events your local FBA chapter will be sponsoring then. On October 11 at the Chattanooga Hotel, your FBA Chapter will host *The Sixth Circuit: A Year in Review - 2013*. In addition to seasoned, knowledgeable lawyers who will offer the latest updates in civil and criminal law in the Sixth Circuit, the seminar will feature Sixth Circuit Judge Jane Branstetter Stranch as our keynote luncheon speaker. We will also have a panel of judges featuring Chief Judge Thomas A. Varlan, District Judge Curtis Collier, District Judge Harry S. Mattice, Bankruptcy Judge Shelley Rucker, and Magistrate Judge Bill Carter. District Judge Ronnie Greer will speak on ethics. We are applying for 6 hours of CLE credit. A reception will follow the event. Look for more details in this issue of the Journal and in your emails from the Chattanooga Chapter of the FBA.

Our second event in October will take place on Halloween at the Hunter Art Museum. Intellectual property attorney Raymond Dowd will present *Murder, Mystery and Masterpieces: Fascinating Tales of Art Theft* at 6 pm. Come enjoy cocktails and receive an hour of CLE credit while hearing some of Mr. Dowd's intriguing stories of recovering art stolen by notorious thieves, including the Nazis during WWII.

Your FBA Chapter is working hard to present events which are both interesting and fun. Please keep a lookout for our emails on these and other events, such as a one hour lunch and learn CLE with District Judge Sandy Mattice coming up in August. Hope to see you in October if not sooner!

## THE CLERK'S CORNER



### —TIPS FROM INSIDE THE CHAMBERS—

Do not assume that because there is a motion to dismiss pending in your case, you can wait to conduct discovery until the motion to dismiss is ruled upon. Many an unhappy litigant has run out of time to conduct discovery and has found his/her motion for an extension of the discovery deadline disfavored by the Court. Better to file a motion to stay discovery pending a ruling on the motion to dismiss and proceed apace with discovery unless and until the Court actually grants a stay.

Familiarize yourself with the Standing Orders found at <http://www.tned.uscourts.gov/localrules.php>

Every page of every document filed electronically in the Court Record is now assigned a Page ID Number. This Page ID Number is placed in the bottom right corner of the page. The Court of Appeals requires citation to the record in the form of these Page ID Numbers. You can also search the record by Page ID Number for quick reference. Therefore, when Bates stamping documents, do not put your Bates stamp in the bottom right corner; otherwise, when you file a Bates stamped document, the Page ID Number will be placed on top of the Bates number rendering both numbers illegible and useless.

If you are a new practitioner with this Court or if you are engaging in an activity in this Court that is new to you, please always check the relevant judge's preferences page, available at <http://www.tned.uscourts.gov/judges.php> to make sure that you follow the preferred procedures for each judge.

## **Chattanooga Chapter**

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WE ARE ON THE WEB:

[www.fedbar.org/chattanooga](http://www.fedbar.org/chattanooga)

THE QUARTERLY JOURNAL IS THE PROUD RECIPIENT OF THE 2012  
MERITORIOUS NEWSLETTER RECOGNITION AWARD FROM THE  
NATIONAL FEDERAL BAR ASSOCIATION.

## **UPCOMING FBA EVENTS AND CLE**

### **FBA Lunch with a Judge**

August 23, 2013, 12-1:15 p.m. , \$25 (includes lunch)

The Joel W. Solomon Federal Building

We invite you to come and have lunch with Judge Mattice.

For more information, contact Lynzi Archibald at Miller & Martin, at [larchibald@millermartin.com](mailto:larchibald@millermartin.com)

### **FBA Annual Meeting**

September 26-28, 2013

San Juan, Puerto Rico

<http://www.fedbar.org/Education/Calendar-CLE-events/2013-Annual-Meeting-and-Convention.aspx>

### **Sixth Circuit Seminar**

October 11, 2013

Chattanooga, Tennessee

Earn CLE and valuable information via federal judges and esteemed panelists from this Circuit. For more information, contact Lynzi Archibald at Miller & Martin, at [larchibald@millermartin.com](mailto:larchibald@millermartin.com)

### **Murder, Mystery, and Masterpieces: Fascinating Tales Of Art Theft**

October 31, 2013, 6 p.m.

Hunter Museum of American Art

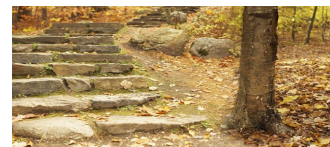
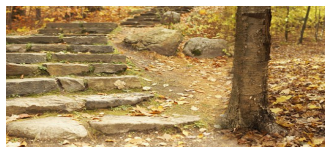
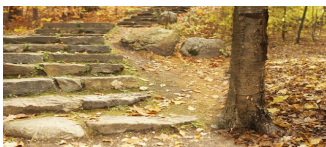
New York IP Attorney Raymond Dowd and the Chattanooga Chapter will present on WWII stolen art

## **MILESTONE MEMBERS**

The Chattanooga Chapter congratulates the following members who  
have reached milestones of continuous membership in the FBA:

5 Years:           Yousef A. Hamadeh, D. Aaron Love, John L. Medearis,  
                          Katharine Gardner

15 Years:         David W. Noblit







# THE QUARTERLY JOURNAL

CHATTANOOGA CHAPTER OF THE FEDERAL BAR ASSOCIATION

July 2013

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## LUNCH WITH A JUDGE

The Chattanooga Chapter is hosting its first-ever “Lunch with a Judge” on August 23, 2013, from 12:00-1:15 at the Joel W. Solomon Federal Building. Judge Mattice has graciously agreed to host the lunch and discuss current topics in federal practice. \$25 registration includes lunch.

To Register, Suggest a Topic, or Request Additional Information, please Contact Lynzi J. Archibald, [larchibald@millermartin.com](mailto:larchibald@millermartin.com)

**LIMITED SPACE**

**SIGN UP TODAY!**

*THE QUARTERLY JOURNAL*

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