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This Week's Feature

Embedding in a State of Flux: New York Courts Challenge Decade Old Reasoning from the Ninth Circuit

By Adam R. Bialek and Sarah Fink

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For more than a decade, under the protection developed by the Ninth Circuit in *Perfect 10, Inc. v. Amazon, Inc.*, 508 F.3d 1146 (9th Cir. 2007), website operators used content from other sites using in-line links or embeds, while skirting copyright infringement lawsuits. These operators argued that the Ninth Circuit's "Server Test" created a loophole that protected them from violating copyright law, since the website operator never hosted the content on its server, but merely provided directions for the user to find the content on the internet, while seemingly staying focused on the website's page.

In 2018, the protective wall created by the Server Test started to show some cracks when a judge sitting in the Southern District of New York within the Second Circuit, in *Goldman v. Breitbart*, declined to adopt the Server Test and found that embedding content could be considered a violation of the copyright owner's display right. Judges sitting in New York courts have continued the trend started in *Goldman*, and recently have been finding for copyright owners when embedding is at issue.

Sharing and reposting photographs on social media is as technically easy as a cut and paste of a photo or a URL. The environment of many social media sites makes it feel natural and even desirable to share and repost photographs that originally appeared on others' sites and pages. But user beware: it is fairly well established that, absent fair use, a simple cut and paste of a copyrighted photograph from a social media post into another webpage could be a violation of copyright. However, the issue of embedding a link to a copyrighted photo is less settled, and a divide in the circuit courts of appeal—which appears to be in the offing—may require consideration by the U.S. Supreme Court.

The Initial Crack in the Server Test

The Second Circuit, which includes the district courts that sit in New York, and the Ninth Circuit, which includes the district courts that sit in California, are arguably the most important in the country for the development of the laws concerning social media. On the issue of embedding, the Ninth Circuit has held that pasting a link (or using specialized coding) to a webpage with copyrighted material, i.e., "embedding," is not copyright infringement because the host of the embedded link does not make a copy of the original webpage; instead, the link sends the reader to the server with the original copy of the copyrighted material.

On February 15, 2018, in *Goldman v. Breitbart*, Judge Katherine B. Forrest, then of the U.S. District Court for the Southern District of New York, rejected defendants' motion for partial summary judgment and called into question the applicability and rationale behind the 2007 ruling in *Perfect 10*. The Server Test advanced in *Perfect 10* had underpinned the growth of websites offering content that used images stored on other websites through in-line linking, framing, and embedding—coding techniques that permit the display of content served from other sources.

In *Goldman*, the court noted that under the definitions in section 101 of the Copyright Act, to display a work publicly means "to transmit… a… display of the work… by means of *any device or process*." The court further explained that "to transmit a display is to 'communicate it *by any device or process* whereby images or sounds are received beyond the place from where they are sent.'" Finding that the statute was plainly drafted with the intent to include the circumstances found in *Goldman*, the court noted that "devices and processes are further defined to mean ones 'now known or later developed.'" Since it was claimed that the *Goldman* defendants' websites actively took steps to "display" the image (by coding the website to call up the image), the court found that the defendants employed a "process" to display the work. In other words, the court declined to adopt the Server Test.

While Judge Forrest denied the *Goldman* defendants' defense based on the Server Test, she did not determine liability for the plaintiff on the motion. She noted that in *Goldman*, there "are genuine questions about whether plaintiff effectively released his image into the public

domain when he posted it to his Snapchat account." She also noted that there was a "very serious and strong fair use defense, a defense under the Digital Millennium Copyright Act, and limitations on damages from innocent infringement."

Since *Goldman* resolved outside of court after the motion was denied, the Second Circuit never had the opportunity to consider the reasoning behind Judge Forrest's decision. Lacking a viable defense under the Server Test, defendants began to argue that their use of images that had originally appeared on social media sites were licensed uses and permitted under the terms of the social media site. But, the Southern District of New York, with an assist from certain social media sites, has extended the effect that *Goldman* started in challenging the *Perfect 10* Server Test and has been consistent in finding for the plaintiff, absent a showing of fair use.

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Recent Embed Rulings

In two recent cases, the District Court for the Southern District of New York has been presented with license defenses proffered by defendants in copyright cases based on embedding links to photographs on social media. *Ziff Davis v. Sinclair* (No. 18-790); *McGucken v. Newsweek* (No. 19-9617). In both cases, the court considered embedding a link to a photograph that originally appeared in a post on an Instagram account. In both cases, the defendant media outlets (Sinclair and Newsweek) argued that Instagram had granted it a sublicense to the copyrighted photograph based on language in the boilerplate terms of use and policies that a user agrees to when posting on Instagram. And, in both cases, the court explained that the terms of use and other policies of Instagram granted Instagram the right to sublicense a photo posted to it, but that there was no evidence that Instagram had actually granted a sublicense to the defendant. Instagram also recently released a statement to the effect that it does not automatically grant a sublicense to users. *See, e.g.,* "Instagram Just Threw Users of Its Embedding API Under the Bus," June 4, 2020, *Arstechnica.com*.

Instagram, Facebook, and Twitter all use language in their terms of use that grants *the platform* a license to posted material and the right to sublicense anything posted on the site. Pinterest goes further and explicitly grants a license to Pinterest *and its users* to "repin" an original post with copyrighted material, but only on the Pinterest platform. The relevant language from the Pinterest terms of use sets forth:

> You grant Pinterest and our users a non-exclusive, royalty-free, transferable, sublicensable, worldwide license to use, store, display, reproduce, save, modify, create derivative works, perform, and distribute your User Content on Pinterest solely for the purposes of operating, developing, providing, and using Pinterest.

More copyright infringement cases based on embedding links are being filed every day. For example, on October 22, 2020, a group of six plaintiffs sued Buzzfeed for embedding links to copyrighted photos on its website. *Hunley, et al. v. Buzzfeed, Inc.*, S.D.N.Y. No. 20-8844. Each of the photos was initially posted on the photographer's individual Instagram account. Wisely, that group chose to sue in the Southern District of New York, where it appears to be a given that the case will not be dismissed based on a theory of implied sublicense and where the Server Test likely does not apply.

But Fair Use Is Still a Viable Defense

However, as Judge Forrest initially noted in *Goldman,* there remain issues of fair use that need to be addressed. Fair use is still a valid defense under certain circumstances. For example, in *Boesen v. United Sports Publications* (E.D.N.Y. No. 20-1552), plaintiff Boesen claimed that United Sports Publications violated his copyright by embedding a link to an Instagram post that included a photograph taken and copyrighted by Boesen in the *Long Island Tennis* magazine's website. The court, however, found that the use of the embedded content was fair use and dismissed the case. Judge Ross explained that the article *was about the original Instagram post*, which included the photograph and was the medium by which the subject of the photograph announced her retirement from professional tennis. The alleged offending article was not about the contents of the

photograph; therefore, the court viewed it as a transformative, fair use.

Conclusion

For now, it appears that the Southern District of New York judges are leaning toward accepting Judge Forrest's analysis of embedding and taking a limited view of the licenses granted by social media sites. Until this issue reaches the Second Circuit, where affirmance will give rise to a conflict with the Ninth Circuit on the Server Test, website owners and operators will need to be careful when embedding content on their websites, even when using the embed feature of a website.

Adam Bialek, *a partner in the New York City office of* **Wilson Elser**, *is co-chair of the firm's intellectual property practice. His nationwide team of highly qualified attorneys offers clients a full range of IP and cyber/media legal services. Adam is experienced with all facets of intellectual property law, internet law, art law, data security and privacy, and cyber/media risk matters, including insurance coverage pertaining to these areas.*

Sarah Fink, an associate in the Garden City, New York, office, of **Wilson Elser**, focuses her practice on all types of intellectual property (IP) litigation and protection, including patent, trademark, copyright, and trade secret. She has extensive experience with litigating IP infringement actions in all industries, with a specialty in the life sciences and technology sectors. Sarah also litigates and arbitrates IP-related business disputes, such as false advertising and unfair competition claims, in state and federal court.

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Hope

By Matthew P. Keris, DRI Atlantic Region Director

As I sit here in December 2020, I realize this is the most bittersweet period during the COVID-19 Pandemic. With vaccinations ready to start, I see a tangible return to normalcy. However, as we wait for the vaccine distribution, we have to endure a long, dark winter with spiking infection rates and overwhelmed hospitals. I feel both optimism and dread at the same time, knowing that this pandemic will end soon, but with great cost.

Hope is what will get me through these last, harsh months of the pandemic. It is what helped us through the September 11, 2001, attacks, the wars that followed, and economic recession. For me, it also provides inspiration and introspection to our current situation.

What I hope we learn from the pandemic is that life is short, and it is important to enjoy the small things. More time with family. No work commute. Learning to be productive while working from home. These are some of the silver linings of the pandemic. When the world returns to what it was, we should not quickly forget how important this is. Carry over the good parts from the pandemic, if there were any for you.

What I hope for in the future is the return of meaningful personal interactions. I had the good fortune of participating in a week-long, jury trial during the pandemic. I say this because it gave me a taste of what I had been sorely missing. I cannot tell you how wonderful it was to wear courtroom attire and interact with live witnesses after months of isolation at home, attending Zoom depositions in sweatpants, and preparing overdue claims evaluations. It felt great being exhausted at 11 p.m. while preparing for the next day, uncertain how the case would turn. I could not believe I missed feeling the pit in my stomach as the jury deliberated. When you have your first trial after the pandemic, I hope you feel as great as I did. I never thought the stress of a trial would make me feel so alive.

It has been difficult to not see my DRI friends and colleagues over the last several months. If it were not for DRI, I would not have had an opportunity to meet so many smart, funny, and compassionate legal professionals from across the country. With COVID-19 forcing several meeting postponements, I lost opportunities to make new acquaintances and reconnect with others. It denied me the opportunity to say goodbye personally to members of the DRI board whose terms expired during this time period—no handshakes, hugs, or personal farewells. There is a good chance that I will never see many of them again in person, which saddens me. I regret not being able to tell them in person how great it was to get to know and work with them.

The COVID-19 pandemic should remind us that life is unpredictable. When the world returns to what it was, leave no regrets. Whether it is a trip you want to take, an experience you want to try, or a purchase you have be delaying, know that there are few "do-overs" in life. It has also showed me that the strength of DRI is its members and the relationships made. One of the finest benefits of being an active member of DRI is the personal connections that you make by simply participating. When we return to normal, do not wait to become involved. DRI membership affords so much more than website access, legal updates, and a magazine subscription. It offers you the opportunity to meet some of the best people you will ever know. After this is over, I hope to see you at the Annual Meeting, participate in a DRI for Life event, and work on a service project. At a minimum, let's have a cocktail. It will be my treat.

Matthew P. Keris *is a shareholder in* **Marshall Dennehey Warner Coleman & Goggin PC***'s Health Care Department and chair of the firm's Electronic Medical Record and Audit Trail Practice Group. He has defended doctors, health systems, long-term care providers, and medical device manufacturers for more than two decades.*

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More Statements, More Donations, and More Promises???

By Kenneth M. Battle

My name is Kenneth Marquis Battle. I am the son of Kenneth Marquis Tuck and Pamela Battle. My father served in the United States Navy and was a Vietnam War veteran. When my father join the U.S. Navy during Vietnam, he actually joined on his own! He was not drafted. His older brother had fled the country to live in Canada after being sent draft papers for the Korean War. My father was driven by a sense of justice and loyalty to make amends of sorts for his older brother, so he joined the Navy. At the time, the Civil Rights Act was still fresh, Jim Crow was still alive and well in the South, and my father constantly had trouble finding a decent job. Most of my family on his side are from Mississippi and Tennessee. Though his parents loved the South, he had no desire to go there, other than for short visits. My father believed that joining the Navy would give him a leg up. He thought he would get more respect from white people and better job opportunities.

My father often spoke of how racist the Navy was back in those days. He was constantly called a nigger, given the most menial jobs, and never given an opportunity to thrive. I remember seeing a picture of the crew from his ship. He was one of about three Black men in a group of maybe 400. He told me stories about his time in the Navy, especially the one and only time he was actually in a gun battle. Oddly enough, he said that was one of the few times where his race didn't matter. Not one person on his side (or the other side for that matter) cared that he was Black. He was able to get some measure of satisfaction from those who mistreated him during his naval service. As it turns out, boxing was a big deal in the Navy. And they allowed him to box. He often told me that, although he felt powerless to stand up for himself or lash out against the random acts of racism and prejudice he endured, climbing into that ring provided him with some small measure of payback. He explained that during a boxing match, it felt like he was fighting against racism and oppression in his own little way. It kept him sane during an otherwise tumultuous period in his life.

After being discharged from the Navy, my father discovered that he had been fighting for a country that was not fighting for him. He was shunned by critics of the war, unable to get a good job, and still called a nigger when he "stepped out of line" with white folks. He pretty much remained disillusioned about society for the rest of his life, passing away very young due to a car accident. My family says that he was extremely intelligent, something I like to think I inherited.

My mother dropped out of community college after she became pregnant with me. Though my maternal grandparents lived a middle class lifestyle, my mother could not afford to, with only a high school education and a young child. We ended up on welfare and living in a housing project called Dearborn Homes. Funny thing about welfare, it wasn't until sometime during my college years when I learned that that the vast majority of people receiving welfare and government assistance were white. Growing up, I was conditioned by my surroundings, the media, and politics, to envision welfare as something only Black people received. I grew ashamed to be associated with welfare, especially during high school, because I went to an upper middle class school across town.

My mother was the stereotypical single mother, raising me and my younger sister and brother, primarily alone. This made for some very lean years, hard times, tears, and pain. However, through it all, she took great care of us and pushed us to excel in school. For some reason, education was her soap box, and she stood on it! My friends teased that we were like the U.S. Postal Service—neither rain, nor sleet, nor snow stopped us from going to school.

As we aged and became more self-sufficient, my mother was able to work. She had to fight tooth and nail to enter the work world after raising a family. All she wanted was an opportunity. Once she found a good job, it gave her a sense of pride and dignity that I had not seen in her eyes before. I wanted to be like that. I wanted to work, earn a great living, and be able to pay all my bills. I never had desires for a fancy car or a mansion, other than what I saw on television. I did not enter the legal profession for fortune or fame.

I am the attorney who always wanted to be an attorney. If you talk to my childhood friends, they will tell you that I've always wanted to be an attorney—ever since I was very young. I have to thank the wonderful teachers at Daniel Hale Williams Elementary School for helping me to understand what attorneys did for a living and encouraging me to do it.

Besides, every report card I received for eight years said I talk too much, so perhaps they felt it was my calling.

Throughout my elementary and high school years, I had as many detractors as I had encouragers. Some felt that society itself, "The Man," would make it impossible for a kid from the ghetto to practice law. So many had been beaten down and beaten back—their dreams and hopes for a better life destroyed. I'm blessed because every time I would get down, depressed, or anxious, people would come into my life who helped to boost me back up. They told me to follow my dreams and assured me that I could do it. I fought through a neighborhood infested with gangs, violence, and drugs; an elementary school with few resources; and a high school full of judgmental peers who looked down on me because of my meager means—just to get to college.

It's time to be purposeful. An old saying in the Dearborn Homes, and likely elsewhere, is "don't talk about it, be about it." It simply means that actions speak louder than words.

During my college and law school years, I was introduced to a more diverse student populace. It amazed me how everyone prejudged each other. I thought that every white person I met had the ability to pay his or her bills and buy whatever books were required for class. Every white person who talked to me assumed I was on a scholarship, part of a quota, and lacked the credentials to be there. Both Blacks and whites assumed that every person of Asian descent was smart and spoke with a heavy accent. I opened my mind and decided to be purposeful about eliminating my own prejudices, choosing to judge individuals by the content of their character. I hoped that others would do the same.

Here we are, in present-day America, after an awful year where we saw a global pandemic attack us, politics and racism divide us, and financial struggles worry us. Where are we? I must admit that I am just tired. As my colleague Stacy Douglas so eloquently put it, "Sick and Tired." My exhaustion comes from a feeling of hopelessness. Years ago, when I was very new to the practice of law, I remember reading a manifesto by Charles Morgan and a call to action written by Roderick Palmore, very powerful in-house attorneys who espoused the need for the inclusion of more women and minority lawyers in law firms, assigned to meaningful matters, or retained as outside counsel. I was in awe and very excited about this, thinking they had changed the legal profession. However, fifteen to twenty years later, I just don't see the amount of progress I expected.

Honestly, after the George Floyd incident, I anticipated that there would be statements made, donations to worthy causes related to diversity and inclusion, and promises. I knew there would be corporate statements condemning systemic racism and cheering diversity efforts. The legal profession was no exception. I saw companies that have used the same nondiverse attorneys at the same nondiverse law firms make statements condemning systemic racism, while masterfully crafting statements supporting diversity and inclusion. Other incidents erupted. And then more statements, more donations, and more promises.

It's time to be purposeful. An old saying in the Dearborn Homes, and likely elsewhere, is "don't talk about it, be about it." It simply means that actions speak louder than words. Many people who read this article wield the power and authority to 1) fight systemic racism in their workplaces; 2) hire qualified and talented people of color and women to diversify their workforces; 3) promote well-deserving women and people of color to partner, deputy chief counsel, or general counsel; 4) provide fair and equal opportunity for people of color and women to secure your business, and then actually hire them; 5) stop searching for fault with diversity and inclusion movements, embrace them; 6) dispense with the fear and anxiety and hire that woman or person of color as your chief executive officer; or 7) actively source and bring on diverse board members to your companies. I imagine it will take strength, conviction, and faith to do one, or all, of these things. So, to my nondiverse colleagues asking what you can do, you can use whatever you have, be it power, influence, position, authority, to *act.* Statements, donations, and promises are wonderful, but your actions are immeasurable!

Kenneth M. Battle *is the managing partner of* **O'Connor & Battle LLP** *in Chicago. He has practiced defense litigation, in its various forms, for over 20 years. He strives to maintain a firm culture teeming with extremely talented people who believe in diversity and inclusion. Ken is often called upon to engage in presentations on topics such as employment law, civil rights, and trial tactics. He obtained his B.A. in Sociology from the University of Illinois at Urbana-Champaign and his J.D. from Case Western Reserve University School of Law.*

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Buchanan Food Drive Was a Big Success!

Members of Buchanan Ingersoll & Rooney PC cooked, shopped, and donated to ensure that this Thanksgiving, families in need in Buchanan's fifteen markets had access to food. The firm proudly donated $50,000 to food banks across the country at a time when food insecurity is at an all-time high. Food truly changes everything. #BuchananCares

Sandberg Phoenix Supports Motion for Kids

Sandberg Phoenix is committed to investing in the communities it serves. Year-after-year its members continuously impress by their passion to create change in their communities and champion this firm value.

For more than ten years, Sandberg Phoenix has participated in **Motion for Kids**, coordinated through their Community Connections Committee during the holiday season. Motion for Kids provides an annual holiday event for St. Louis-area children in the foster care system, or those whose lives have been severely affected by the criminal justice system. This year, Sandberg Phoenix plans to sponsor over 100 kids through Motion for Kids.

"DRI Cares" content is coordinated by **James Craven** of Wiggin and Dana LLP and **Rebecca Nickelson** of Sinars Slowikowski Tomaska LLC. To submit items for upcoming issues, please contact them at jcraven@wiggin.com and **rnickelson@sinarslaw.com**.

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Lily Turner

Why is it important to help other people who need our help?

So that when you need help, they will help you, and to be kind.

If you could put on a project to help out others, what would you do?

I would have one where we pack bags of food and send them to the homeless.

What's a memory that makes you happy?

When I was snuggling with my mommy.

What is the hardest thing about being a kid?

You have to do lots of homework and I don't really like that.

If you could make one rule that everyone in the world had to follow, what rule would you make?

To be nice.

What do you want to be when you grow up?

A nurse that helps babies.

Lily is the seven-year-old daughter of Sara and Kile Turner*. Sara is a shareholder in the Birmingham, Alabama, office of* **Baker Donelson** *and a DRI National Director. Kile is a member of* **Norman Wood Kendrick & Turner***, also in Birmingham, and a past chair of the DRI Young Lawyers Committee.*

"DRIKids" content is coordinated by **Diane Pumphrey** of Wilkins Patterson Smith Pumphrey & Stephenson PA and **Laura Emmett** of Strigberger Brown Armstrong LLP. To submit items for upcoming issues, please contact them at dpumphrey@wilkinspatterson.com and lemmett@sbalawyers.ca.

Quote of the Week

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– P. B. S. Pinchback