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## N&M Presents Trademark and IP Issues for the Wine Industry

Our wine practice group has compiled helpful information about intellectual property issues for winery businesses, both large and small. Articles I through VI in this ongoing series are now available at our website [here](#). Additionally, attorneys Richard Biagi and Jeremy Roe have authored *The Pros and Cons of Using and Registering a Family Name with Wines*. This article is available [here](#).

To learn more about our wine practice group, please visit the [Wine Practice section](#) of our N&M website.

## DMCA Take Down Policy – An Overview

[Daniel J. Schaeffer](#), Neal & McDevitt, LLC

Companies that invite or allow visitors to their websites to post material - video, photographs, or even simple written comments - run the risk that a visitor will post something that infringes someone else's copyright. Under traditional copyright law, the website owner could have been liable as a publisher of the infringing material.

Title II of the Digital Millennium Copyright Act (DMCA) added a section to the Copyright Act, 17 U.S.C. 512, called the Online Copyright Infringement Liability Limitation Act (OCILLA), which provided a "safe harbor" for online service providers whose users posted materials that were accused of copyright infringement. The definition of "online service provider" includes anyone who hosts a website where materials can be posted or stored at a user's direction. As long as a web host does not receive a direct financial benefit from the infringement and does not have actual knowledge of the infringement, it can avoid liability by having specific procedures in place to address infringement claims.

The process is well-defined. Any web host that wants to be able to take advantage of the safe harbor defense must register a designated agent with the Copyright Office. The Copyright Office makes a directory of designated agents, organized by service provider name, available on the Internet at [http://www.copyright.gov/onlinesp/list/a\\_agents.html](http://www.copyright.gov/onlinesp/list/a_agents.html). If a copyright owner believes that something on the website infringes its copyright, it sends a notification to the designated agent.

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## DMCA Take Down Policy (cont'd)

On receipt of proper notice, the web host is required to take the accused material off its website and notify the user who posted it that the material has been accused of infringing and removed. The user has the option to issue a counter-notice if he believes that the material was improperly taken down, and the web host must inform the complaining copyright owner. The web host then waits at least 10 days, but if the copyright owner does not file an infringement lawsuit against the user within 14 days after the counter-notice, then the web host must put the user's material back up on the website.

A company that hosts (or plans to host) any websites where users can contribute content of any sort should promptly register a designated agent, and should develop and implement a plan to respond to any takedown notifications that agent receives. Without a designated agent and appropriate takedown procedures in place, the web host is vulnerable to copyright litigation and potential liability.

A company that is concerned about its copyrighted content being posted without authorization on the Internet should be prepared to submit a proper and complete takedown notification, and to follow up if necessary with a lawsuit against a user who submits a counter-notice and continues to infringe.

### ***Elements of a proper takedown notification***

(17 U.S.C. 512(c)(3)(A))

- (i) A physical or electronic signature of a person authorized to act on behalf of the owner of an exclusive right that is allegedly infringed.
- (ii) Identification of the copyrighted work claimed to have been infringed, or, if multiple copyrighted works at a single online site are covered by a single notification, a representative list of such works at that site.
- (iii) Identification of the material that is claimed to be infringing or to be the subject of infringing activity and that is to be removed or access to which is to be disabled, and information reasonably sufficient to permit the service provider to locate the material.
- (iv) Information reasonably sufficient to permit the service provider to contact the complaining party, such as an address, telephone number, and, if available, an electronic mail address at which the complaining party may be contacted.
- (v) A statement that the complaining party has 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.
- (vi) A statement that the information in the notification is accurate, and under penalty of perjury, that the complaining party is authorized to act on behalf of the owner of an exclusive right that is allegedly infringed.

### ***Elements of a proper counter-notice***

(17 U.S.C. 512(g)(3))

- (i) A physical or electronic signature of the subscriber.
- ii) Identification of the material that has been removed or to which access has been disabled and the location at which the material appeared before it was removed or access to it was disabled.
- (iii) A statement under penalty of perjury that the subscriber has a good faith belief that the material was removed or disabled as a result of mistake or misidentification of the material to be removed or disabled.
- (iv) The subscriber's name, address, and telephone number, and a statement that the subscriber consents to the jurisdiction of Federal District Court for the judicial district in which the address is located, or if the subscriber's address is outside of the United States, for any judicial district in which the service provider may be found, and that the subscriber will accept service of process from the person who submitted the takedown notification or an agent of such person.

## YouTube Prevails In Long-Standing Copyright Dispute

*Daniel J. Schaeffer, Neal & McDevitt, LLC*

On June 23, 2010, YouTube, Inc. and its parent, Google, Inc. won a solid (if not necessarily permanent) victory in their defense against copyright infringement claims filed by Viacom International, Inc. and several others. In a closely-watched case pending since 2007 - notable for revelations that Viacom, while complaining of infringement on YouTube, was surreptitiously uploading its own videos to YouTube to attract viral attention - the U.S. District Court for the Southern District of New York granted YouTube's motion for summary judgment, ruling that, as a matter of law, the safe harbor provisions of the Digital Millennium Copyright Act shielded the video website from claims of direct, vicarious, and contributory copyright infringement.

Focusing on videos available on YouTube prior to May 2008 (when YouTube implemented a "digital fingerprinting" system to help copyright owners identify infringing videos), Viacom argued that YouTube had "actual knowledge" of infringing videos and was "aware of circumstances from which infringing activity [was] apparent" but failed to take adequate steps to prevent such activity, and thus could not be protected by the safe harbor provisions. The Court described the "critical question" as whether YouTube's general awareness of the existence of infringing materials on its website - as opposed to actual or constructive knowledge of specific, identified infringing materials - would satisfy the DMCA's knowledge requirement and thus exclude YouTube from safe harbor protection.

Reviewing the extensive legislative history behind the DMCA's safe harbor provisions, along with several prior cases from other jurisdictions, the Court held that "[g]eneral knowledge that infringement is 'ubiquitous' does not impose a duty on the service provider to monitor or search its service for infringements." Since YouTube promptly removed allegedly infringing materials whenever it was informed of specific instances of infringement, the Court held, it had satisfied the requirements of the safe harbor provisions and was thus entitled to their protection.

Viacom intends to appeal the summary judgment to the Second Circuit Court of Appeals, so it remains to be seen whether YouTube and Google will ultimately prevail.

## Under TDRA, Famous VICTORIA'S SECRET Mark Is Tarnished by VICTOR'S LITTLE SECRET

*Lisa A. Iverson, Neal & McDevitt, LLC*

N&M attorney Lisa A. Iverson reviews the Sixth Circuit's recent opinion in *V Secret Catalogue, Inc. v. Moseley*, No. 08-5793 (6th Cir. May 19, 2010), in which the court affirmed that VICTOR'S LITTLE SECRET tarnishes the famous VICTORIA'S SECRET mark.

The article was published in the July 15, 2010 edition of the INTA Bulletin, and is reprinted with permission [here](#).

## IP Quick Hits

### **TTAB SUSTAINS DILUTION BY BLURRING CLAIM BASED ON SURVEY EVIDENCE**

In *National Pork Board v. Supreme Lobster & Seafood Co.*, Opp. No. 91166701 (T.T.A.B. June 11, 2010), the Board sustained an opposition by the owner of the mark THE OTHER WHITE MEAT, based on a claim of dilution by blurring by registration of the mark THE OTHER RED MEAT for intended use with fresh and frozen salmon. The Board found the opposer's survey evidence, as well as robust advertising expenditures, to prove sufficient fame. The survey also showed that 35% of respondents associated THE OTHER RED MEAT with the opposer. The case provides an example of how survey evidence should be used to succeed with a dilution claim.

### **9TH CIRCUIT REVERSES MONETARY AND INJUNCTIVE RELIEF AGAINST BRATZ MAKER**

In *Mattel, Inc. v. MGA Entertainment, Inc.*, No. 09-55673 (9th Cir. July 22, 2010), the Ninth Circuit reversed a \$10 million damages award for Mattel and a permanent injunction preventing MGA from making and selling its line of Bratz dolls. The court admonished the district court for failing to look solely at the copyright protectable elements of Mattel's Barbie products versus those in the Bratz dolls when conducting its infringement analysis, stating that copyrights "cover only the particular expression of the bratty-doll idea, not the idea itself."

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## N&M Attorney Honored

Neal & McDevitt congratulates associate attorney Jeremy M. Roe for his selection as a recipient of the David C. Hilliard Award for service with the Chicago Bar Association Young Lawyer Section's Intellectual Property Committee.

Jeremy was a Vice Chair of the IP committee during the 2009-2010 term, and he is currently serving as Chair of the IP committee during the 2010-2011 term. The CBA-YLS IP Committee provides a host of programs geared toward young professionals, as well as to those with an interest in the legal issues related to copyrights, trademarks, and patents.

Please join us in congratulating Jeremy on this honor.



*If you have any questions about the materials printed here, please contact Jeremy Roe at [jroe@nealmcdevitt.com](mailto:jroe@nealmcdevitt.com).*

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