

# CASE ACT SMALL-CLAIMS ENFORCEMENT THROUGH THE COPYRIGHT CLAIMS BOARD

Updated from the forthcoming 2022 updates to Chapter 4 (Copyright Protection in Cyberspace)  
*E-Commerce and Internet Law: Legal Treatise with Forms 2d Edition*  
A 5-volume legal treatise by Ian C. Ballon (Thomson/West Publishing, [www.IanBallon.net](http://www.IanBallon.net))

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## BALLON'S ANNUAL ACC BRIEFING ON INTERNET AND MOBILE LAW AND LITIGATION TRENDS

ASSOCIATION OF CORPORATE COUNSEL  
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#### 4.08[8] CASE Act Small-Claims Enforcement through the Copyright Claims Board

The Copyright Alternative in Small-Claims Enforcement Act of 2020 – or CASE Act – provides for alternative resolution of certain small claims through the U.S. Copyright Office’s Copyright Claims Board.<sup>1</sup> Pursuant to the CASE Act, the Copyright Claims Board must be established by December 22, 2021 (with authority delegated to the Copyright Office to delay that time for up to an additional six months). Resolving eligible disputes before the Copyright Claims Board, instead of court, is supposed to be entirely voluntary, but persons and entities that fail to opt out within 60 days following service may find themselves subject to a CASE act proceeding that they might otherwise have preferred to resolve through federal court litigation (which, among other things, ensures the right to a jury trial, broader discovery, and adjudication by a federal judge subject to binding precedent with full rights of appeal) or not at all.<sup>2</sup> If a party opts out of a Copyright Claims Board proceeding, the other party may – but is by no means required to – file suit in federal court. Given the cap on damages applicable to CASE Act determinations by the Copyright Claims Board and the ability of individuals and even companies to represent themselves before the Board without having to retain counsel, opting out won’t necessarily trigger federal court litigation in every instance. The CASE Act, however, likely will increase the volume of copyright claims overall, as those who otherwise would not have chosen to file suit seek to vindicate their rights before the Copyright Claims Board. The CASE Act also potentially could be abused by copyright trolls seeking quick settlements from large companies and by copyright owners (or ostensible rights owners) or competitors seeking to use the Board’s procedures as an inexpensive mechanism to keep material offline in response to counter notifications submitted by users pursuant to 17 U.S.C.A. § 512(g) of the Digital Millennium Copyright Act, although the CASE Act directs the Copyright Office to take measures to avoid abuse.

The CASE Act provides a means for voluntary alternative dispute resolution for three types of claims (and certain related counterclaims asserted solely against the claimant arising out of the same transaction or occurrence, or an agreement (such as a license) that could affect the relief awarded to the claimant)<sup>3</sup> –

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<sup>1</sup> See 17 U.S.C.A. §§ 1501 to 1511.

<sup>2</sup> See 17 U.S.C.A. § 1506(g)(1) (providing that the right to opt-out is waived in most cases if not timely asserted within 60 days of service).

<sup>3</sup> See 17 U.S.C.A. § 1504(c)(4). That section permits counterclaims asserted solely against a claimant (and not others):

(A) pursuant to which the counterclaimant seeks damages, if any, within the limitations set forth in subsection (e)(1) [17 U.S.C.A. § 1504(e)(1)]; and

(B) that--

(i) arises under section 106 or section 512(f) and out of the same transaction or occurrence that is the subject of a claim of infringement brought under paragraph (1), a claim of noninfringement brought under paragraph (2), or a claim of misrepresentation brought under paragraph (3) [of 17 U.S.C.A. § 1504(c)]; or

(ii) arises under an agreement pertaining to the same transaction or occurrence that is the subject of a claim of infringement brought under paragraph (1) [17 U.S.C.A. § 1504(c)(1)], if the

- infringement of an exclusive right in a copyrighted work<sup>4</sup> by a legal or beneficial owner of the exclusive right at the time of infringement, for which the claimant seeks damages<sup>5</sup> (pursuant to 17 U.S.C.A. § 1504(c)(1), for damages as permitted by 17 U.S.C.A. § 504(e)(1)),
- noninfringement (pursuant to 17 U.S.C.A. § 1504(c)(2)), or
- misrepresentation in connection with a notification of claimed infringement or a counter notification pursuant to 17 U.S.C.A. § 512(f) of the Digital Millennium Copyright Act<sup>6</sup> (under 17 U.S.C.A. § 1504(c)(3), but with relief limited to that authorized by the CASE Act).<sup>7</sup>

Other potential claims or counterclaims may not be brought.<sup>8</sup> Nor may claims finally adjudicated by a court of competent jurisdiction be relitigated.<sup>9</sup> Claims pending before a court of competent jurisdiction likewise are not subject to a determination by the Copyright Claims Board, unless the court has granted a stay to permit the claim or counterclaim to proceed before the Copyright Claims Board.<sup>10</sup> Legal or equitable defenses, however, may be asserted in response to claims or counterclaims.<sup>11</sup>

Complaints initiated with the Copyright Claims Board may involve a single claim or multiple claims, and may be brought by multiple claimants against multiple respondents, provided that all claims asserted in any one proceeding “arise out of the same allegedly infringing activity or continuous course of infringing activities and do not, in the aggregate, result in a recovery . . . for damages that exceed the limitations . . .” for recovery in Copyright Claims Board proceedings set forth in 17 U.S.C.A. § 1504(e)(1),<sup>12</sup> which are discussed below later in this subsection and typically will be capped at \$30,000 per proceeding (or less for claims for infringement of untimely registered works).

Thus, claims for injunctive relief or more complicated multi-party or multi-claim disputes

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agreement could affect the relief awarded to the claimant.

*Id.*

<sup>4</sup> The exclusive rights of a copyright owner pursuant to 17 U.S.C.A. § 106 are analyzed in section 4.04[1].

<sup>5</sup> As noted later in this section, the Board is also authorized to include a requirement that a party cease certain conduct, if a party agrees to do so in order to mitigate the amount of any damage award. *See* 17 U.S.C.A. §§ 1504(e)(2), 1504(e)(1).

<sup>6</sup> Section 512(f) of the DMCA is analyzed in section 4.12[9][D] in this chapter.

<sup>7</sup> *See* 17 U.S.C.A. §§ 1501(1), 1504(c).

<sup>8</sup> *See* 17 U.S.C.A. § 1504(d)(1).

<sup>9</sup> *See* 17 U.S.C.A. § 1504(d)(2).

<sup>10</sup> *See* 17 U.S.C.A. § 1504(d)(2).

<sup>11</sup> *See* 17 U.S.C.A. § 1504(c)(5).

<sup>12</sup> *See* 17 U.S.C.A. § 1504(c)(6).

will not be suitable for Copyright Claims Board adjudication (except if and to the extent that a court stays individual claims or counterclaims to allow resolution of just those claims or counterclaims before the Board). Parties with potentially substantial damage claims may also prefer to file suit in court. On the other hand, individuals and smaller companies may prefer to avoid the legal fees associated with litigation, by initiating a claim with the Copyright Claims Board and either representing themselves, obtaining pro bono representation from a law student, or retaining a lawyer willing to handle a dispute where the maximum potential recovery is \$30,000. Parties seeking to assert claims for misrepresentations in notifications and counter notifications, pursuant to 17 U.S.C.A. § 512(f), may also prefer to avail themselves of the remedies available before the Copyright Claims Board given that damages in section 512(f) cases are often difficult to prove or *de minimis* (especially when asserted by individual users, as opposed to copyright owners or service providers).<sup>13</sup>

Claims may be brought by both eligible U.S. and foreign persons and entities. Claims may not be asserted, however, *against* a person or entity residing outside the United States, but if such a person or entity brings a claim, a counterclaim may be asserted against that person or entity.<sup>14</sup>

Claims and counterclaims likewise may not be asserted by or against federal or state government entities.<sup>15</sup>

Copyright Claims Board complaints alleging copyright infringement also may qualify as actions taken in response to counter notifications under 17 U.S.C.A. § 512(g) of the Digital Millennium Copyright Act<sup>16</sup> and therefore may provide copyright owners with a lower cost and lower risk alternative to filing suit in federal court to prevent material from being restored by a service provider in response to a DMCA counter notification. This provision of the CASE Act, however, potentially could be abused by some copyright owners (especially mere applicants for registration<sup>17</sup>) to keep material offline for extended period of time. Conversely, the restriction on initiating Copyright Claims Board proceedings against foreign nationals may limit its utility for copyright owners in cases of alleged infringement by non-Americans. While a user who submits a counter notification to a service provider to restore access to material taken down in response to a DMCA notification must assent to jurisdiction in a U.S. court as part of the counter notification,<sup>18</sup> that user need not consent to proceedings before the Copyright Claims Board (and

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<sup>13</sup> See *infra* § 4.12[9][D] (analyzing section 512(f) claims).

<sup>14</sup> See 17 U.S.C.A. § 1504(d)(4).

<sup>15</sup> See 17 U.S.C.A. § 1504(d)(3).

<sup>16</sup> See 17 U.S.C.A. § 1507(d); see generally *infra* § 4.12[9][C] (analyzing counter notifications and the requirements for copyright owners to submit evidence of filing a lawsuit or initiating a Copyright Claims Board action to prevent restoration of removed material in response to a DMCA notification).

<sup>17</sup> As discussed later in this section, when a claim is brought by an applicant, the proceeding may be held in abeyance pending a determination on registration – potentially for a year or longer. See 17 U.S.C.A. §§ 1505(a), 1505(b). Yet under the DMCA, the material would remain offline pending a legal determination of the merit of the claim. See 17 U.S.C.A. § 512(g); *infra* § 4.12[9][C].

<sup>18</sup> See 17 U.S.C.A. § 512(g)(2)(C); see generally *infra* § 4.12[9][C] (analyzing counter notifications and the requirements for copyright owners to submit evidence of filing a lawsuit or initiating a Copyright Claims Board action to prevent restoration of removed material in response to a DMCA notification).

likely would have little incentive to do so) and the 60 day period to opt out would not apply since any complaint brought against a foreign person or entity would be invalid.

Copyright Claims Board proceedings will be adjudicated pursuant to the Copyright Act, judicial precedent, and regulations to be promulgated by the Copyright Office.<sup>19</sup> Given circuit splits and local practice under different provisions of the Copyright Act, parties will need to assess in individual cases whether they are better off proceeding before the Copyright Claims Board or in court, based on circuit court law and local practice. Where judicial precedents are in conflict, the CASE Act directs the Copyright Claims Board to apply the law of the federal jurisdiction where the case could have been brought or, where there are more than one such jurisdictions, the one that the “Board determines has the most significant ties to the parties and conduct at issue.”<sup>20</sup> Needless to say, a plaintiff may sue in any district where venue is proper (and where the court has personal jurisdiction over the defendant) – not simply in the court that has the most significant ties.<sup>21</sup>

Proceedings will take place at the office of the Copyright Claims Board, but in-person appearances will not be required. Decisions generally will be rendered based on written submissions and internet-based video applications and other telecommunications facilities (except where material evidence or testimony cannot be furnished by these means).<sup>22</sup> A party may, but is not required, to be represented by an attorney or a law student qualified under applicable law that permits law students to appear pro bono.<sup>23</sup> Other aspects of Board proceedings (including provisions for settlement, evidentiary submissions, hearings and limited discovery) are set forth in 17 U.S.C.A. § 1506 and likely will be augmented by Copyright Office regulations. As noted earlier in this section, a party properly served with notice of a Copyright Claims Board proceeding has the unrestricted right to opt-out, but loses that right, and accordingly also loses the right to litigate the claim in federal court (and is deemed to have waived its right to a jury trial), if it fails to do so within 60 days of being served<sup>24</sup> (although the Board has discretion to extend this period in exceptional circumstances<sup>25</sup>). The CASE Act does, however, allow any party (including presumably a party who missed the opportunity to opt out) to obtain dismissal of the proceeding if the party receives notice of a pending or putative class action, arising out of the same transaction or occurrence.<sup>26</sup>

Conversely, federal courts may refer eligible cases for adjudication of claims or counterclaims by the Copyright Claims Board, with the consent of the parties, as an alternative

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<sup>19</sup> See 17 U.S.C.A. § 1503(b)(1).

<sup>20</sup> See 17 U.S.C.A. § 1506(a)(2).

<sup>21</sup> See generally *infra* chapters 53 (personal jurisdiction), 54 (venue).

<sup>22</sup> See 17 U.S.C.A. § 1506(c).

<sup>23</sup> See 17 U.S.C.A. § 1506(d).

<sup>24</sup> See 17 U.S.C.A. § 1506(g)(1).

<sup>25</sup> See 17 U.S.C.A. § 1506(i).

<sup>26</sup> See 17 U.S.C.A. § 1506(q)(3). Other grounds for voluntary dismissal are set forth in section 1506(q).

dispute resolution process.<sup>27</sup>

Where a lawsuit is filed that is already the subject of a Copyright Claims Board proceeding, the court “shall issue a stay or enter such other relief as the court determines appropriate . . . .”<sup>28</sup>

Damages in a Copyright Claims Board proceeding will be capped at \$30,000, exclusive of attorneys’ fees and costs.<sup>29</sup> In addition to the cap, the CASE Act creates a financial incentive for a respondent to agree to allow the Board to include in its final determination a requirement that the respondent cease activity that is found to be infringing, including removing or disabling access to, or destroying, infringing materials (or for claims brought under section 512(f) for misrepresentations in a DMCA notification or counter notification, that the respondent cease sending takedown notices or counter notices to the other party regarding the conduct at issue before the Board, if that notice or counter notice is found to be a knowing material misrepresentation).<sup>30</sup>

For infringement, a claimant may elect, at any time before a final determination is rendered, actual damages and profits or statutory damages (or no damages at all).<sup>31</sup> The Board may hold parties jointly and severally liable “if all such parties and relevant claims or counterclaims arise from the same activity or activities.”<sup>32</sup>

As in court under the Copyright Act, but subject to the \$30,000 cap per proceeding, actual damages and profits may be recovered, pursuant to the provisions of 17 U.S.C.A. § 504(b),<sup>33</sup> with the award taking into consideration, in appropriate cases, whether the accused infringer has agreed to cease or mitigate the infringing activity.<sup>34</sup>

Statutory damages alternatively may be sought, and may be awarded pursuant to 17 U.S.C.A. § 504(c),<sup>35</sup> but subject to four additional considerations and limitations. First, as noted above, recovery in any one proceeding is limited to \$30,000, excluding attorneys’ fees and costs.<sup>36</sup> Second, the amount of any statutory damage award must be determined without any consideration of willfulness.<sup>37</sup> Third, the Copyright Claims Board has discretion to consider, as

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<sup>27</sup> See 17 U.S.C.A. § 1509(a); 28 U.S.C.A. § 651.

<sup>28</sup> See 17 U.S.C.A. § 1509(a).

<sup>29</sup> See 17 U.S.C.A. § 1504(e)(1)(D).

<sup>30</sup> See 17 U.S.C.A. § 1504(e)(2).

<sup>31</sup> See 17 U.S.C.A. § 1504(e)(1)(B).

<sup>32</sup> See 17 U.S.C.A. § 1504(f).

<sup>33</sup> See generally *infra* §§ 4.14[1], 4.14[3] (analyzing actual damages and profits under the Copyright Act).

<sup>34</sup> See 17 U.S.C.A. § 1504(e)(1)(A)(i).

<sup>35</sup> See generally *infra* §§ 4.14[1], 4.14[2] (analyzing statutory damages under the Copyright Act).

<sup>36</sup> See 17 U.S.C.A. § 1504(e)(1)(D).

<sup>37</sup> See 17 U.S.C.A. § 1504(e)(1)(A)(ii)(III). In court proceedings, where willfulness is shown, a copyright owner may recover up to \$150,000 per work infringed for works timely registered, and may impact the size of an award even when a judge or jury awards a lower amount. See generally *infra* § 4.14[2][A] (analyzing willful, nonwillful



an additional factor in awarding statutory damages, whether the alleged infringer has agreed to cease or mitigate the infringing activity pursuant to 17 U.S.C.A. § 1504(e)(2).<sup>38</sup> Fourth, statutory damages for infringement of any one work is capped at (a) \$15,000 for a work that has been timely registered and (b) \$7,500 for a work that has not been timely registered (further capped to a total of \$15,000 in any one proceeding).<sup>39</sup> Since statutory damages are not recoverable at all in a court proceeding when a work was untimely registered, copyright owners who failed to timely register their works, cannot establish actual damages, and are willing to forego injunctive relief, may have an incentive to bring potentially meritorious claims before the Copyright Claims Board, rather than to file suit in court, although the \$15,000 cap per proceeding means that the incentive will mainly be attractive to individuals and smaller entities (and also may be used by copyright trolls willing to file multiple proceedings). To deter troll suits, the Register of Copyrights may establish regulations limiting the number of proceedings that the same claimant may bring in a given year.<sup>40</sup>

Copyright damages are analyzed extensively below in section 4.14.

Attorneys' fees and costs generally will not be awarded, except in cases of bad faith, where the Board may award up to \$5,000 in attorneys' fees and costs (or \$2,500 in costs for those representing themselves without counsel) and, in extraordinary circumstances, such as where a party has demonstrated a pattern or practice of bad faith conduct, a higher amount above these limits.<sup>41</sup>

Proceedings before the Copyright Claims Board will be adjudicated by three Copyright Claims Officers, who will be attorneys who have each been in practice for at least seven years.<sup>42</sup> Two of the Copyright Claims Officers must have substantial experience in the evaluation, litigation, or adjudication of copyright infringement claims, and, between the two Officers, have represented or presided over a diversity of copyright interests, including those of both owners and users of copyrighted works.<sup>43</sup> The third Claims Officer must have substantial familiarity with copyright law and experience in alternative dispute resolution.<sup>44</sup> Ultimately, it remains to be seen who the three Copyright Claims Officers will be, and what their specific prior experience will have been, as well as the identity of Copyright Claims Attorneys, who will assist in the administration of the Copyright Claims Board and who must have at least 3 years of substantial experience in copyright law but not necessarily diversity of experience representing both

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and innocent infringement).

<sup>38</sup> See 17 U.S.C.A. § 1504(e)(1)(A)(ii)(IV).

<sup>39</sup> See 17 U.S.C.A. § 1504(e)(1)(A)(ii).

<sup>40</sup> See 17 U.S.C.A. § 1504(g); see also *id.* § 1510(a)(1).

<sup>41</sup> See 17 U.S.C.A. §§ 1504(e)(3), 1506(y)(2).

<sup>42</sup> 17 U.S.C.A. § 1502(b)(3). As discussed later in this section, claims for \$5,000 or less may be addressed by a single adjudicator pursuant to regulations that will be promulgated by the Copyright Office before the Copyright Claims Board becomes operations (between December 22, 2021 and June 22, 2022).

<sup>43</sup> See 17 U.S.C.A. § 1502(b)(3).

<sup>44</sup> See 17 U.S.C.A. § 1502(b)(3)(A)(ii)(III).

copyright owners and users.<sup>45</sup>

As in federal court, proceedings before the Copyright Claims Board will be subject to the same three year statute of limitations as other copyright claims<sup>46</sup> (but a proceeding commenced before the Board will toll the time permitted under 17 U.S.C.A. § 507(b) for filing suit in federal court for copyright infringement (based on the same claim) during the time when the Board proceeding is pending<sup>47</sup>). Claimants likewise generally must have a registered copyright to pursue a claim for infringement (which, as in a court proceeding, will be entitled to the presumptions provided by 17 U.S.C.A. § 410(c) if registered within 5 years of first publication).<sup>48</sup> Unlike in federal court, however, a claimant may also proceed, at least initially, based solely on a paid application provided that the Copyright Claims Board may not render a determination until a registration certificate has been obtained and copies have been given to the other parties to the proceeding (and, if a proceeding may not proceed further because a registration certificate has yet been obtained, the proceeding will be held in abeyance subject to provisions allowing for dismissal without prejudice if the proceeding has been held in abeyance for more than one year).<sup>49</sup> The Copyright Office's refusal to register a work will result in the dismissal without prejudice of a proceeding initiated based on a mere application.<sup>50</sup>

The CASE Act requires the Register of Copyrights to establish regulations allowing the Copyright Office to determine registration applications on an expedited basis when an unregistered work is at issue before the Copyright Claims Board.<sup>51</sup> The regulations will also allow for libraries and archives to preemptively opt out of board proceedings and provide for single Officer determinations of claims of \$5,000 or less (exclusive of attorneys' fees and costs),<sup>52</sup> among other things.

Determinations by the Board may be challenged by a request for reconsideration and, if unsuccessful, review by the Register of Copyrights "limited to consideration of whether the Copyright Claims Board abused its discretion in denying reconsideration of the determination."<sup>53</sup> A final determination also may be challenged in federal court, within 90 days, on narrow grounds, (a) if the determination was issued as a result of fraud, corruption, misrepresentation, or

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<sup>45</sup> See 17 U.S.C.A. § 1502(b)(3)(B).

<sup>46</sup> See 17 U.S.C.A. § 1504(b); *see generally supra* § 4.08[7] (analyzing the statute of limitations in copyright litigation).

<sup>47</sup> See 17 U.S.C.A. § 1504(b)(2). Once a final determination has been made, however, the same claims and counterclaims asserted and finally determined by the Board may not be relitigated between the same parties. *See id.*; *id.* § 1507(a).

<sup>48</sup> See 17 U.S.C.A. §§ 1505(a), 1505(b)(3), 1505(c).

<sup>49</sup> See 17 U.S.C.A. §§ 1505(a), 1505(b).

<sup>50</sup> See 17 U.S.C.A. § 1505(b)(3); *see generally infra* § 4.19 (analyzing the requirement for registration or rejection of a copyright registration certificate to proceed in court and the mechanism available in federal court for challenging the Copyright Office's refusal to register a work).

<sup>51</sup> See 17 U.S.C.A. § 1506(aa).

<sup>52</sup> See 17 U.S.C.A. § 1506(z).

<sup>53</sup> See 17 U.S.C.A. §§ 1506(w), 1506(x).

other misconduct, (b) if the Copyright Claims Board exceeded its authority or failed to render a final determination concerning the subject matter at issue, or (c) in the case of a default determination or determination based on a failure to prosecute, if it is established that the default or failure was due to excusable neglect.<sup>54</sup>

Final determinations will have preclusive effect in any court or tribunal, but only between the same parties, and only with respect to claims and counterclaims asserted and finally determined by the Board.<sup>55</sup> Thus, the preclusive effect of a determination is narrower than in federal court and does not reach claims that could have, but were not in fact, asserted in a Copyright Claims Board proceeding. The CASE Act also provides that final determinations will not have a preclusive effect on determinations of ownership or have any effect on a class action proceeding in federal court.<sup>56</sup>

Where a party fails to pay damage or otherwise comply with a final determination, the aggrieved party may apply to a federal court to confirm the award and reduce it to a judgment.<sup>57</sup> Such an application must be made within one year of the latest of the date the final determination issued, the date of any reconsideration by the Copyright Claims Board or review by the Register of Copyrights is resolved, or the date an amended final determination issued.<sup>58</sup>

Board determinations will be published and made available on a publicly accessible website,<sup>59</sup> and thus may be cited in subsequent Board proceedings as influential, although the CASE Act makes clear they “may not be cited or relied upon as legal precedent . . .” before the Board or in any court or tribunal.<sup>60</sup>

The provisions governing CASE Act proceedings set forth in 17 U.S.C.A. § 1504 – including the voluntary nature of the proceedings, right to opt-out, waiver of the right to opt-out by failing to respond within 60 days of being served with a copy of the complaint, tolling, the claims and counterclaims that may be asserted, and those that may not be, remedies and damage limitations, and joint and several liability – may not be waived except pursuant to the terms of the CASE Act.<sup>61</sup> Thus, any effort to preemptively opt out of Copyright Claims Board proceedings or to require contracting parties to opt-out of CASE Act remedies or to agree by contract to expand or contract the scope of claims and defenses that could be considered or remedies awarded, will be void.

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<sup>54</sup> See 17 U.S.C.A. § 1508(c).

<sup>55</sup> See 17 U.S.C.A. § 1507(a).

<sup>56</sup> See 17 U.S.C.A. § 1507.

<sup>57</sup> See 17 U.S.C.A. § 1508.

<sup>58</sup> See 17 U.S.C.A. § 1508(a).

<sup>59</sup> See 17 U.S.C.A. § 1506(t)(3).

<sup>60</sup> See 17 U.S.C.A. § 1507(a).

<sup>61</sup> See 17 U.S.C.A. § 1504(a).

# E-COMMERCE & INTERNET LAW: TREATISE WITH FORMS 2D 2022

*Ian C. Ballon*

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- ◆ Antitrust in the era of techlash
- ◆ The CPRA, Virginia, Colorado and Nevada privacy laws, GDPR, California IoT security statute, state data broker laws, and other privacy and cybersecurity laws
- ◆ Software copyrightability and fair use after *Google v. Oracle*
- ◆ Mobile and online contract formation, unconscionability and enforcement of arbitration and class action waiver clauses in an era of mass arbitration
- ◆ TCPA law and litigation after *Facebook v. Duguid* - the most comprehensive analysis of the statute, regulations, and conflicting case law found anywhere
- ◆ The Cybersecurity Information Sharing Act (CISA), state security breach statutes and regulations, and the Defend Trade Secrets Act (DTSA) -- and their impact on screen scraping and database protection, cybersecurity information sharing and trade secret protection, & privacy
- ◆ Platform moderation and liability, safe harbors, and defenses (including the CDA and DMCA)
- ◆ Dormant Commerce Clause restrictions on state law regulation of online and mobile commerce
- ◆ The law of SEO and SEM – and its impact on e-commerce vendors
- ◆ Defending cybersecurity breach and data privacy class action suits – case law, trends & strategy
- ◆ IP issues including Copyright and Lanham Act fair use, *Rogers v. Grimaldi*, patentable subject matter, negative trade secrets, rights of publicity laws governing the use of a person's images and attributes, initial interest confusion, software copyrightability, damages in internet and mobile cases, the use of hashtags in social media marketing, new rules governing fee awards, and the applicability and scope of federal and state safe harbors and exemptions
- ◆ Online anonymity and pseudonymity – state and federal laws governing permissible disclosures and subpoenas
- ◆ Sponsored links, embedded links, #hashtags, and internet, mobile and social media advertising
- ◆ Enforcing judgments against foreign domain name registrants
- ◆ Valuing domain name registrations from sales data
- ◆ Applying the First Sale Doctrine to virtual goods
- ◆ Exhaustive statutory and case law analysis of the Digital Millennium Copyright Act, the Communications Decency Act (including exclusions for certain IP & FOSTA-SESTA), the Video Privacy Protection Act, and Illinois Biometric Privacy Act
- ◆ Analysis of the CLOUD Act, BOTS Act, SPEECH Act, Consumer Review Fairness Act, N.J. Truth-in-Consumer Contract, Warranty and Notice Act, Family Movie Act and more
- ◆ Click fraud
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- ◆ Practical tips, checklists and forms that go beyond the typical legal treatise
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*E-Commerce & Internet Law* is a comprehensive, authoritative work covering law, legal analysis, regulatory issues, emerging trends, and practical strategies. It includes practice tips and forms, nearly 10,000 detailed footnotes, and references to hundreds of unpublished court decisions, many of which are not available elsewhere. Its unique organization facilitates finding quick answers to your questions.

The updated new edition offers an unparalleled reference and practical resource. Organized into five sectioned volumes, the 59 chapters cover:

- Sources of Internet Law and Practice
- Intellectual Property
- Licenses and Contracts
- Data Privacy, Cybersecurity and Advertising
- The Conduct and Regulation of E-Commerce
- Internet Speech, Defamation, Online Torts and the Good Samaritan Exemption
- Obscenity, Pornography, Adult Entertainment and the Protection of Children
- Theft of Digital Information and Related Internet Crimes
- Platform liability for Internet Sites and Services (Including Social Networks, Blogs and Cloud services)
- Civil Jurisdiction and Litigation

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- ◆ Covers laws specific to the Internet and explains how the laws of the physical world apply to internet and mobile transactions and liability risks
- ◆ Addresses both law and best practices
- ◆ Includes the hottest issues, such as IP and privacy aspects of artificial intelligence & machine learning, social media advertising, cloud storage, platform liability, and more!
- ◆ Comprehensive treatment of intellectual property, data privacy and mobile and Internet security breach law

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 2. A Framework for Developing New Law  
 3. [Reserved]

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4. Copyright Protection in Cyberspace  
 5. Data Scraping, Database Protection, and the Use of Bots and Artificial Intelligence to Gather Content and Information  
 6. Trademark, Service Mark, Trade Name and Trade Dress Protection in Cyberspace  
 7. Rights in Internet Domain Names

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**Volume 2**


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- Chapter* 8. Internet Patents  
 9. Unique Intellectual Property Issues in Search Engine Marketing, Optimization and Related Indexing, Information Location Tools and Internet and Social Media Advertising Practices  
 10. Misappropriation of Trade Secrets in Cyberspace  
 11. Employer Rights in the Creation and Protection of Internet-Related Intellectual Property  
 12. Privacy and Publicity Rights of Celebrities and Others in Cyberspace  
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 16. Internet Licenses: Rights Subject to License and Limitations Imposed on Content, Access and Development  
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 18. Drafting Internet Content and Development Licenses  
 19. Website Development and Hosting Agreements  
 20. Website Cross-Promotion and Cooperation: Co-Branding, Widget and Linking Agreements  
 21. Obtaining Assent in Cyberspace: Contract Formation for Click-Through and Other Unilateral Contracts  
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## ABOUT THE AUTHOR

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Ian Ballon is Co-Chair of Greenberg Traurig LLP's Global Intellectual Property and Technology Practice Group and is a litigator in the firm's Silicon Valley Los Angeles and Washington, DC offices. He defends data privacy, cybersecurity breach, AdTech, TCPA, and other Internet and mobile class action suits and litigates copyright, trademark, patent, trade secret, right of publicity, database, AI and other intellectual property cases, including disputes involving safe harbors and exemptions, platform liability and fair use.



Mr. Ballon was the recipient of the 2010 Vanguard Award from the State Bar of California's Intellectual Property Law Section. He also has been recognized by *The Los Angeles and San Francisco Daily Journal* as one of the Top Intellectual Property litigators in every year the list has been published (2009-2021), Top Cybersecurity and Artificial Intelligence (AI) lawyers, and Top 100 lawyers in California.

Mr. Ballon was named a "Groundbreaker" by *The Recorder* at its 2017 Bay Area Litigation Departments of the Year awards ceremony and was selected as an "Intellectual Property Trailblazer" by the *National Law Journal*.

Mr. Ballon was selected as the Lawyer of the Year for information technology law in the 2022, 2021, 2020, 2019, 2018, 2016 and 2013 editions of *The Best Lawyers in America* and is listed in Legal 500 U.S., Law Dragon and Chambers and Partners USA Guide. He also serves as Executive Director of Stanford University Law School's Center for the Digital Economy.

Mr. Ballon received his B.A. *magna cum laude* from Tufts University, his J.D. *with honors* from George Washington University Law School and an LLM in international and comparative law from Georgetown University Law Center. He also holds the C.I.P.P./U.S. certification from the International Association of Privacy Professionals (IAPP).

Mr. Ballon is also the author of *The Complete CAN-SPAM Act Handbook* (West 2008) and *The Complete State Security Breach Notification Compliance Handbook* (West 2009), published by Thomson West ([www.IanBallon.net](http://www.IanBallon.net)).

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## NEW AND IMPORTANT FEATURES FOR 2022

- > **Antitrust in the era of techlash** (chapter 34)
- > **Platform moderation and liability, safe harbors and defenses** (ch. 49, 4, 6, 8, 37)
- > **Privacy and IP aspects of Artificial Intelligence (AI) and machine learning** (ch. 5, 26)
- > **How *TransUnion v. Ramirez* (2021) changes the law of standing in cybersecurity breach, data privacy, AdTech and TCPA class action suits.**
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- > **Software copyrightability and fair use in light of the U.S. Supreme Court's 2021 decision in *Google LLC v. Oracle America, Inc.*, 141 S. Ct. 1183 (2021)** (ch 4)
- > **Rethinking 20 years of database and screen scraping case law in light of the U.S. Supreme Court's opinion in *Van Buren v. United States*, 141 S. Ct. 1648 (2021)** (ch5)
- > **FOSTA-SESTA and ways to maximize CDA protection** (ch 37)
- > **IP aspects of the use of #hashtags in social media** (ch 6)
- > **The CLOUD Act** (chapter 50)
- > **Virginia, Colorado and Nevada privacy laws** (ch 26)
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- > **Digital economy litigation strategies**
- > **Circuit-by-circuit, claim-by-claim analysis of CDA opinions**
- > **How new Copyright Claims Board proceedings will disrupt DMCA compliance for copyright owners, service providers and users** (ch 4)
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- > **Dormant Commerce Clause challenges to state privacy and other laws – explained**
- > **First Amendment protections and restrictions on social media posts and the digital economy – important new case law**
- > **The GDPR, ePrivacy Directive and transferring data from the EU/EEA** (by Françoise Gilbert and Viola Bensinger) (ch. 26)
- > **Patent law** (updated by Josh Raskin) (chapter 8)
- > **Idea protection & misappropriation** (ch 13)
- > **Revisiting links, embedded links, sponsored links, and SEO/SEM practices and liability** (chapter 9)
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