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### Is There a De Minimis Defense for Trivial Use of Concededly Infringing Material? Ninth Circuit Says No.

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On September 9, 2021, the U.S. Court of Appeals for the Ninth Circuit reversed the district court's grant of summary judgment in favor of the defendant in [\*Bell v. Wilmott Storage Servs., LLC\*](#).<sup>1</sup> In its decision, the panel clarified that the de minimis doctrine does not excuse technical violations of a copyright holder's exclusive rights, even if trivial. Rather, the court held that the de minimis inquiry only concerns the amount and substantiality of the copying. The extent of a defendant's use of an allegedly infringing work and the defendant's awareness of the alleged infringement are irrelevant to the de minimis use inquiry. The Ninth Circuit's clarification of the de minimis inquiry provides important guidance for navigating permissible uses of copyrighted works and defending claims.

#### Background

The plaintiff, a lawyer and photographer named Richard Bell, took a landscape photograph of the Indianapolis skyline in 2000 and published the photo online later that year.<sup>2</sup> Numerous entities have copied the photo, and Bell has been no stranger to copyright infringement lawsuits. He has filed over 100 lawsuits concerning this photo alone.<sup>3</sup>

In 2018, by running a reverse image search on Google Images, Bell discovered a copy of his photo on a server database associated with VisitUSA.com, a web site maintained by the defendant, Wilmott Storage Services. The copy was not visible to ordinary users navigating through the site; it could only be seen by running a reverse image search or by inserting the specific pinpoint address of the web page containing the image. And Wilmott was ignorant of the photo's existence on its server until Bell notified the company of his claim. Indeed, the court noted that the photo had likely been present on the server when Wilmott acquired the VisitUSA.com website from a third party in 2012. Wilmott attempted to remove the photo in response to the notification, but Bell sued Wilmott for unlawfully infringing his exclusive right to publicly display the copyrighted work.<sup>4</sup>

At the close of discovery, Wilmott moved for summary judgment on its affirmative defenses of de minimis use, fair use, and the statute of limitations. Bell cross-moved for summary judgment on liability. Wilmott argued that its use of the photo was at most a "technical" violation that could not sustain a finding of liability, contending that, because it had not actively used the photo, its use qualified as de minimis and therefore non-infringing.<sup>5</sup> The district court embraced this theory of de minimis use and granted summary judgment to Wilmott without reaching the other defenses.<sup>6</sup>

## The Court's Clarification of the De Minimis Inquiry

On appeal, there was no need to assess whether the allegedly infringing work was substantially similar to the copyrighted work, as the degree of copying was concededly total. The Ninth Circuit thus focused on whether Wilmott had engaged in any act that violated one of the exclusive rights reserved to copyright holders under Section 106 of the Copyright Act. Applying the “server test” adopted by the Ninth Circuit in *Perfect 10, Inc. v. Amazon, Inc.*<sup>7</sup> and applied in numerous cases since, the appellate court reasoned that Wilmott had engaged in an infringing display because its server “was continuously transmitting the image to those who used the specific pinpoint address or were conducting reverse image searches using the same ... photo.”<sup>8</sup>

Under the panel's analysis of the display right, it did not matter whether anyone other than the plaintiff actually found or viewed the photo on VisitUSA.com.<sup>9</sup> It was enough that Wilmott “ma[de] it accessible to the public on its server.”<sup>10</sup> The court held that “the de minimis concept applies to the amount or substantiality of the copying—and not the extent of the defendant's use of the infringing work.”<sup>11</sup> The court clarified that the de minimis use inquiry examines only “whether so little of a copyrighted work has been copied that the allegedly infringing work is not substantially similar to the copyrighted work and is thus non-infringing.”<sup>12</sup> Properly viewed, according to the court, “the de minimis doctrine [is not] a defense to infringement, but rather ... an answer to the question of whether the infringing work and the copyrighted work are substantially similar so as to make the copying actionable.”<sup>13</sup> The court also noted that the First, Third, Fourth, and Eleventh Circuits had similarly concluded that there is no de minimis defense for allegedly minimal use of concededly infringing material.<sup>14</sup>

Because the entire photo at issue in *Bell* had been copied, the court found that the de minimis use defense could not apply.<sup>15</sup> The court determined that whether Wilmott was aware of the presence of the image on its server and how many others had viewed the image on the VisitUSA.com web site were

irrelevant to the de minimis use analysis because “‘use’ in this context does not refer to how extensively a defendant uses an indisputably infringing work.”<sup>16</sup> The court observed that “nowhere in the Act's numerous and detailed provisions is there any exception for the de minimis use of a concededly infringing work, i.e., for a ‘technical violation.’”<sup>17</sup> As further support for its conclusion, the court noted that a plaintiff need not prove actual damages to obtain statutory damages under Section 504(c) of the Copyright Act, and it pointed to the availability of a reduced statutory damages award for innocent infringement as evidence that the de minimis doctrine was not needed to protect accidental or unwitting infringement.<sup>18</sup> Section 106 grants the copyright owner the exclusive rights to reproduce, distribute, and display the copyrighted work, and the Act is silent as to how the copy is used once it is made because “the unlicensed copying itself is the violation.”<sup>19</sup> While innocent intent and technical use may be relevant for other aspects of copyright infringement lawsuits, such as fair use and damages, they are irrelevant for the de minimis inquiry.<sup>20</sup>

Wilmott also argued an alternative theory of the de minimis use defense: because it had not intentionally caused the public display of the Indianapolis photo, there had been no volitional act of infringement. Non-volitional conduct is not infringing.<sup>21</sup> However, the court rejected Wilmott's “unintentional violation” theory of de minimis use. In the copyright infringement context, volition refers to proximate cause, not intent, which is immaterial to the question of liability. Therefore, by assuming responsibility for and maintaining the server on which the Indianapolis photo was stored, Wilmott caused the display, and its conduct “is therefore plainly volitional for purposes of copyright infringement.”<sup>22</sup>

## The Concurring Opinions

While Wilmott's de minimis defense was rejected by the Ninth Circuit, the panel's concurring opinions provide some hope for Wilmott and similarly situated defendants. In one concurring opinion, Judge Choe-Groves noted that she would have remanded the case to the district court to first decide whether Bell even owned the copyright, as there were facts and other litigation that suggested that he did not.<sup>23</sup> In a

separate concurring opinion, Judges Clifton and Wardlaw expressed sympathy with the district court's decision to resolve the case promptly, noting that this was an egregious scenario where a seeming "copyright troll" with a questionable claim on the underlying copyright was pursuing a defendant who did not know about the infringement and there was no proof that any third party had ever accessed the infringing copy. Given the facts, the judges discouraged further pursuit of the claim and recommended no more than a limited statutory damages award if the plaintiff nonetheless elected to proceed and ultimately succeeded.<sup>24</sup>

## Key Takeaways

- In the Ninth Circuit, the de minimis inquiry is limited to assessing the similarity of the plaintiff's copyrighted work and the defendant's allegedly infringing work. The extent of the defendant's exploitation of the allegedly infringing work, no matter how limited, does not afford a basis for a de minimis use defense to liability.
- The Ninth Circuit's view of the scope of the de minimis doctrine is shared by some, but not all, of its sister circuits.
- While a defendant may not be able to rely on a de minimis use defense to avoid liability for the trivial exploitation of a concededly infringing work, the limited extent of such use nonetheless remains an important factor for other considerations in copyright disputes, including actual damages, statutory damages, willfulness, fair use, and, for disputes that also include claims for falsification or alteration or copyright management information, the alleged infringer's knowledge and intent.

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<sup>7</sup> 508 F.3d 1146, 1159 (9th Cir. 2007). Under the server test, online content is publicly displayed by the entity that stores and serves the image, but it is not displayed by another website that merely likes to or embeds that content. *Id.* Some courts in other jurisdictions, including in the Southern District of New York, have expressed disagreement with the server test and declined to follow it. See, e.g., *Goldman v. Breitbart News Network, LLC*, 302 F. Supp. 3d 585, 595 (S.D.N.Y. 2018); *Nicklen v. Sinclair Broad. Grp., Inc.*, No. 20-cv-10300, 2021 WL 3239510, at \*5 (S.D.N.Y. July 30, 2021); see also Todd Larson & Michael Goodyear, [Embedding the Server Test Rift: S.D.N.Y. Decision Bucks Ninth Circuit Once Again](#), Weil Intellectual Property/Media Alert (Aug. 9, 2021).

<sup>8</sup> *Bell* at 15-16.

<sup>9</sup> *Id.* at 17 ("The Copyright Act does not require proof that the protected work was actually viewed by anyone.").

<sup>10</sup> *Id.* at 13; see also *id.* at 16-17.

<sup>11</sup> *Id.* at 21 (emphasis added).

<sup>12</sup> *Id.* at 6.

<sup>13</sup> *Id.* at 18.

<sup>14</sup> *Id.* at 18-23 (citing *Situation Mgmt. Sys., Inc. v. ASP Consulting LLC*, 560 F.3d 53, 59 (1st Cir. 2009); *Dun & Bradstreet Software Servs., Inc. v. Grace Consulting, Inc.*, 307 F.3d 197, 208 (3d Cir. 2002); *Silicon Knights, Inc. v. Epic Games, Inc.*, 551 F. App'x 646, 648-49 (4th Cir. 2014); *Palmer v. Braun*, 287 F.3d 1325, 1334 (11th Cir. 2002)). The court acknowledged Wilmott's reliance on the Second Circuit's decision in *Knickerbocker Toy Co. v. Azrak-Hamway Int'l, Inc.*, 668 F.2d 699 (2d Cir. 1982), but criticized Wilmott's reading of that case as "strained." *Bell* at 25.

<sup>15</sup> *Id.* at 27.

<sup>16</sup> *Id.* at 22.

<sup>17</sup> *Id.* at 29.

<sup>18</sup> *Id.* at 31.

<sup>19</sup> *Id.* at 30 (emphasis in original).

<sup>20</sup> *Id.* at 31.

<sup>21</sup> *Id.* at 32.

<sup>22</sup> *Id.* at 33.

<sup>23</sup> *Id.* at 35-38 (Choe-Groves, J., concurring).

<sup>24</sup> *Id.* at 34-35 (Clifton, J., concurring).

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<sup>1</sup> No. 19-55882 (9th Cir. Sept. 9, 2021) ("*Bell*").

<sup>2</sup> *Id.* at 7-8.

<sup>3</sup> *Id.* at 8.

<sup>4</sup> *Id.* at 9.

<sup>5</sup> *Id.* at 27.

<sup>6</sup> *Bell v. Wilmott Storage Servs., LLC*, 18-cv-7328, 2019 WL 4391117, \*3 (C.D. Cal. July 1, 2019).

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