

Banner & Witcoff Obtains Dismissal of Claims under the Digital Millennium Copyright Act, the Lanham Act, and Illinois State Law

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On February 8, 2012, Banner & Witcoff obtained a dismissal of various claims asserted against its client, Techny Advisors, LLC in *Personal Keepsakes, Inc. v. Personalizationmall.com, et al.*, Case No. 11 C 5177 (N.D. Ill., Feb. 8, 2012) (Memorandum Opinion and Order of February 8, 2012).

The plaintiff alleged that Techny provided false copyright management information (CMI) in its general website terms and conditions, which made various statements about copyrights. The court found that these website terms were not placed close to the allegedly infringed copyrighted works, but rather, appeared on another page of Techny's website. The court stated that some courts have held, persuasively, that a defendant must remove the CMI from the "body" or the "area around" the work to violate the Digital Millennium Copyright Act (DMCA). The court stated that rule is consistent with the text of the statute, which requires the CMI to be "conveyed" with the copyrighted work. According to the court, "[s]uch a rule prevents a 'gotcha' system where a picture or piece of text has no CMI near it but the plaintiff relies on a general copyright notice buried elsewhere on the website."

The court stated that it need not determine exactly how close the CMI must be to the work to pass muster under the DMCA. The court held that "as a matter of law, if a general copyright notice appears on an entirely different webpage than the work at issue, then that CMI is not 'conveyed' with the work and no claim will lie under the DMCA." The court held that the plaintiff could not base a DMCA claim on Techny's general copyright notice placed elsewhere its website, and dismissed the DMCA claim based on Techny's general copyright notices.

The court also dismissed the DMCA claim that Techny removed CMI of the plaintiff because the plaintiff's alleged CMI was not CMI. According to the court, a dot com name on the plaintiff's web site was not CMI because the dot com name was not the owner listed in the copyright registrations attached to the Complaint. In addition, the titles of the works on plaintiff's website could not be CMI because the copyright registrations did not list the titles of the works as they appeared on the plaintiff's website. According to the court, the point of CMI is to inform the public that something is copyrighted and to prevent infringement. Allowing a plaintiff to make out a DMCA claim based on alleged CMI that does not link up in any way to the copyright registration "is an invitation for unfair litigation against parties who have tried to tread carefully to avoid copyright infringement."

In addition, the court dismissed with prejudice the plaintiff's Lanham Act claims with prejudice against Techny after holding that those claims would "push the Lanham Act into the exclusive realm of copyright."

The court also dismissed with prejudice the plaintiff's state law claims against Techny after holding that those claims were "simply copyright claims in different clothing" and are "preempted by the Copyright Act."

Robert H. Resis of Banner & Witcoff's Chicago office represents Techny.

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