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To Embed or Not to Embed?: A New Challenge to Embedding Images From Social Media

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Embedding content from a social media site in one's website initially seemed to be a safe harbor from a copyright infringement claim. In 2007, the Ninth Circuit adopted the so-called "server test," ruling that in-line linking of images – now more commonly referred to as embedding – did not violate the exclusive display, copying or distribution rights of the copyright holder because, via HTML instructions, users are only directed to the website where the images are stored.[1] That ruling, at least as to violation of the display right, has recently been rejected, with at least one court finding a violation of a copyright owner's exclusive display right regardless of whether a third-party server hosted the image.[2]

The latest battle over embedding adds more complexity to this issue, suggesting there may be copyright infringement even when the copyright owner has given permission to a social media site to allow others to embed his or her work.

In *Sinclair v. Ziff Davis*, 18-CV-790 (KMW), in the Southern District of New York, Judge Kimba Wood issued her own conflicting rulings on that question – first granting dismissal, then reversing her ruling in a copyright infringement complaint based on embedding an image. In *Sinclair*, a professional photographer sued Mashable, Inc. and its parent company Ziff Davis alleging that Mashable embedded, in an article on its website, a photograph that she created and subsequently published on her Instagram account. Ziff Davis and Mashable moved to dismiss the complaint. The Court first granted dismissal on April 13, 2020, but then reversed that ruling, upon Sinclair's motion for reconsideration, in a decision dated June 24, 2020.[3]

In so ruling, the Court did not consider whether the server test precludes a copyright infringement claim for embedding an image hosted on another site. Instead, the Court focused on the agreements and terms that govern the sublicensing of work uploaded to a social media site (Instagram) by its users.

Illustrating the uncertainties surrounding this issue, both of the Court's rulings were based on the language in Instagram's policies. The relevant provisions stated that a user "'grant[s] to Instagram a non-exclusive, fully paid and royalty-free, transferable, sub-licensable, worldwide license to the Content that you post on or through [Instagram], subject to [Instagram's] Privacy Policy.'"[4] The Court also understood from the policies that:

All content that users upload and designate as “public” is searchable by the public and subject to use by others via Instagram’s API. ([Privacy Policy] § 2.) The API enables its users to embed publicly-posted content in their websites. (Platform Policy, Preamble.)[5]

In *Sinclair I,* the Court granted dismissal of the complaint in April, 2020, concluding that Sinclair granted the right to sublicense to Instagram, who in turn, validly exercised that right in a sublicense of the photograph to Mashable.[6] Based on Sinclair’s uploading of the photograph to Instagram and designating it “public,” the Court found that plaintiff agreed to allow Mashable, as a sublicensee to Instagram, to embed her work on its website.[7] The Court found separate grounds to dismiss the complaint against Ziff Davis, recognizing the legal separation between a parent and its subsidiary, and that the complaint failed to allege that Ziff Davis had any involvement in the alleged infringing use of the photograph.[8]

In June, upon motion for reconsideration, the Court took a different view of this matter. While the Court upheld its finding that Sinclair authorized Instagram to grant a sublicense to its API users, like Mashable, to embed her public content, the Court reversed its finding that, at this stage, there was sufficient evidence that Instagram, in fact, “exercised its right to grant a sublicense to Mashable.”[9] In reviewing again the same terms of the Platform Policy – which governs the rights granted to Instagram’s API users – the Court found that the statement that Instagram “‘provide[s] the Instagram API to help broadcasters and publishers discover content, get digital rights to media, and share media using web embeds’” did not convey the requisite “explicit consent” required for a license to grant rights to a licensee.[10] The Court observed significant ambiguity in that language, specifically as to whether it meant that that API users may embed the public content of third party users on their websites, presumably as opposed to embedding their own Instagram content onto their website.[11]

Sinclair II’s “explicit consent” requirement relies on two prior rulings: 1) the ruling in *Ward v. Nat’l Geographic Soc’y*, under an earlier version of the Copyright Act, that a licensee has no right to sublicense any rights acquired absent the explicit authorization of the copyright holder;[12] and 2) the ruling in *Agence Fr. Presse v. Morel* finding no license where Agence France Presse (“AFP”) downloaded and published photos that Morel posted on Twitter and Twitpic, because, Twitter’s explicit license only applied to its partners and, the statement in Twitter’s terms of use that it “encourage[s] and permit[s] broad re-use of Content” was insufficient to convey a license to AFP.[13]

The primary distinction between *Sinclair*, *Ward* and *Morel* is that both *Ward* and *Morel* involved alleged infringing uses that were not contemplated by any sublicense. In *Ward*, that court found there was no sublicense granted by the copyright owner at all. In *Morel*, the infringement complained of was activity far beyond anything that could be read into Twitter’s terms of use or policies — the images at issue in *Morel* were downloaded from Twitter and licensed to others through a photo licensing agency. In *Sinclair*, both of the Court’s rulings recognized that Sinclair did expressly grant a sublicense to Instagram to allow its Instagram’s API users to embed her public content.

The question of whether Instagram exercised that grant of a sublicense to its API users is better answered by a determination of Instagram’s intent, rather than an explicit consent standard.[14] Consideration of intent still may not change the outcome at the pleading stage, but there appears to be ample evidence of Instagram’s intent to grant its API users the right to embed third-party public content including: 1) the language of the Instagram’s policies; 2) the open and notorious use of Instagram’s API by users to embed third party content; and 3) most notably, the documentation for the Instagram API, which in describing the Instagram oEmbed endpoint,[15] explains: “You can get a public Instagram photo or video post’s embed HTML code and

use it to embed the post in other websites . . . *People own their Instagram content, so each embedded post gives proper attribution by displaying the post owner's username and linking to the post owner's profile*."[16]

It is likely that Instagram did exercise its right to sublicense to its API users the right to embed third-party content. To create the mechanism for such activity and not provide the authorization for such use seems incongruent and unintentional. However, the Court's finding is an indication that, to avoid subjecting Instagram API users to infringement claims, explicit language is needed in the terms and policies granting to its API users the right to embed third-party public content.

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[1] *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1159-62 (9th Cir. 2007). A general discussion of linking to copyrighted material is provided by the Digital Media Law.

[2] *See Goldman v. Breitbart News Network, LLC*, 302 F. Supp. 3d 585, 586 (S.D.N.Y. 2018) (ruling that when defendants caused the embedded Tweets of plaintiff's copyrighted image (which plaintiff never posted to Twitter) to appear on their websites, plaintiff's exclusive display right was violated — regardless of whether a third-party server hosted the image).

[3] *Sinclair v. Ziff Davis, LLC*, No. 18-CV-790 (KMW), 2020 U.S. Dist. LEXIS 64319 (S.D.N.Y. Apr. 13, 2020) ("*Sinclair I*"); *Sinclair v. Ziff Davis, LLC*, No. 18-CV-790 (KMW), 2020 U.S. Dist. LEXIS 110627, 2020 WL 3450136 (S.D.N.Y. June 24, 2020) ("*Sinclair II*").

[4] *Sinclair I*, 2020 U.S. Dist. LEXIS 64319, at *6 (quoting the Terms of Use, Rights § 1). Instagram's current Terms of Use (effective April 19, 2018).

[5] *Sinclair I*, 2020 U.S. Dist. LEXIS 64319, at *6 -*7. Instagram's current version of its Privacy Policy, last revised August 21, 2020. *see* n. 10 for Instagram's Platform Policy.

[6] *Sinclair I*, 2020 U.S. Dist. LEXIS 64319, at *5 – *7 (recognizing that "[a] copyright owner who permits a licensee to grant sublicenses cannot bring an infringement suit against a sublicensee, so long as both licensee and sublicensee act, respectively, within the terms of their license and sublicense") (citing *United States Naval Inst. v. Charter Communs., Inc.,* 936 F.2d 692, 695 (2d Cir. 1991)).

[7] *Id.,* at *7.

[8] *Id.*, at *12.

[9] *Sinclair II*, LLC, 2020 U.S. Dist. LEXIS 110627, at *2.

[10] *Id*., at *3 – *4. Instagram's current Platform Policy, effective August 31, 2020, contains similar language; (indicating that "we provide the Instagram Platform to help broadcasters and publishers discover content, get digital rights to media, and share media using web embeds").

[11] Judge Wood was also persuaded by another S.D.N.Y. decision by Judge Failla, issued just prior to her reconsideration, which denied dismissal of a copyright infringement action against a publisher embedding content from Instagram. Judge Failla, in denying dismissal, similarly found that the plaintiff granted a right to sublicense to Instagram, but found no express grant of a sublicense to API users in Instagram's terms and policies, only that these documents "clearly foresee the possibility of entities such as Defendant using web embeds to share other users' content." *McGucken v.*

Newsweek LLC, 19 Civ. 9617 (KPF), 2020 U.S. Dist. LEXIS 96126, *11 (S.D.N.Y. June 1, 2020).

[12] 208 F. Supp. 2d 429, 442-43 (S.D.N.Y. 2002). The application of *Ward's* analysis to the current 1978 Copyright Act is a significant recognition of the viability of the 1909 Act's indivisibility doctrine, which did not recognize an ability to sub-divide ownership rights in a copyright and did not recognize a right to sell or sub-divide a license unless that right was expressly granted. *See* 3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 10.01 (2001). The Ninth Circuit has applied this limitation on the transfer of licenses to the 1976 Copyright Act. *See Gardner v. Nike, Inc.,* 279 F.3d 774, 780 (9th Cir. 2002) (holding that the 1976 Act does not allow a copyright licensee to transfer its rights under an exclusive license without the consent of the original licensor).

[13] 769 F. Supp. 2d 295, 299-300, 302-302 (S.D.N.Y. 2011).

[14] 3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 10.03 (2019) ("As with all matters of contract law, the essence of the inquiry here is to effectuate the intent of the parties.").

[15] "Application Program Interface (API) permits the interaction between two systems. . . .[A]n API endpoint is the point of entry in a communication channel when two systems are interacting." Last Call: The Rapid API Blog, Endpoint – What is an API Endpoint*?*

[16] Facebook for Developers, Instagram oEmbed (Legacy), (expiring October 24, 2020) (emphasis added); Facebook for Developers, Embed Button.

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