

DMCA Scierter Requirement Not Satisfied without Evidence of Knowledge of Inducement or Concealment

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Interpreting a provision of the Digital Millennium Copyright Act (DMCA), 17 U.S.C. § 1202(b), for the first time, the US Court of Appeals for the Eleventh Circuit affirmed a summary judgment ruling that the plaintiff failed to satisfy the second scienter requirement of § 1202(b) by not showing that the defendant knew, or had reasonable grounds to know, that its actions would induce, enable, facilitate or conceal a copyright claim. *Victor Elias Photography, LLC v. Ice Portal, Inc.*, Case No. 21-11892 (11th Cir. Aug. 12, 2022) (Newsom, Marcus, JJ; **Covington**, Distr. J.)

Victor Elias is a professional photographer who takes photographs for hotels and resorts throughout the United States, Mexico and the Caribbean. Between 2013 and 2017, Elias took pictures for Starwood Hotels & Resorts and Wyndham Hotel & Resorts. As part of his process, Elias embedded copyright management information (CMI) into the image files.

During this period and into 2018, Starwood and Wyndham contracted with Ice Portal (a division of Shiji at the time of the appeal) to process thousands of images, including 220 images taken by Elias, and make them available to online travel agents. This processing included converting the images to JPEG format, making copies in various industry-standards sizes and optimizing the files for faster display. The processing sometimes resulted in the loss of an image file's metadata. In 2016, Elias discovered infringing online uses of his images that lacked the embedded CMI. He filed suit against Ice Portal, contending that the stripping of metadata resulted in loss of his embedded CMI, which violated two sections of the DMCA: 17 U.S.C. §§ 1202(a) and 1202(b).

Following discovery, the district found that Elias could not “satisfy the ‘second scienter requirement’ of the statute” and granted Shiji’s motion for summary judgment. Relying on the 2018 Ninth Circuit case *Stevens v. Corelogic*, the district court found that Elias had not established that Shiji “knew or had reason to know that its action would induce, enable, facilitate, or conceal infringement.” The court determined that Elias failed to demonstrate that the removal of CMI “is the reason, or even the likely reason, for the infringing use of the images,” or that “Shiji was even aware that searching for terms embedded in the extended attributes was a method used by copyright holders to find infringement on the internet.” Elias appealed.

Because this was a novel issue for the Eleventh Circuit, the Court interpreted § 1202(b) as an issue of first impression. After considering the plain terms of the statute and the opinions of sister circuits,

the Court agreed with its sister circuits that to satisfy the scienter requirement of §1202(b), a plaintiff “must make an affirmative showing . . . [that] the defendant was aware [of] or had reasonable grounds to be aware of the probable future impact of its actions.”

Elias urged the Eleventh Circuit to adopt a standard that would only require a plaintiff to demonstrate that CMI was knowingly removed without consent and that the defendant either “knows, or has reasonable grounds to know, that its actions ‘make infringement generally possible or easier to accomplish.’” The Court refused to adopt this interpretation and opted to follow the *Stevens* case, where the Ninth Circuit found that such a general approach “won’t wash” with the statute. Based on the statute and legislative history, the Ninth Circuit concluded that the plaintiff must “provide evidence from which one can infer that future infringement is likely, albeit not certain, to occur as a result of the removal or alteration of CMI.”

Relying on this interpretation, the Eleventh Circuit found that Elias had failed to show that Shiji had the necessary knowledge that the metadata stripping would contribute to copyright infringement, or even that the infringed images were linked to Shiji and its software. Because the evidence presented by Elias was insufficient to create a genuine issue of material fact, the Court affirmed the district court’s decision.

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