

# IP in the Twitter-Sphere: EDNY Considers Whether Embedded Images Protected by Fair Use Doctrine

by Steve Kramarsky

In today's environment, the line between "social media" and "news media" (to the extent it ever existed) is becoming increasingly blurred. A 2019 Pew Research study indicated that more than half of Americans get their news in whole or in part from social media, including Facebook, Twitter, and Reddit. More than one in five Americans, according to that survey, rely primarily on social media for their news. Platforms and algorithms originally designed to connect people and share personal stories have thus moved closer and closer to the center of the news ecosystem, due in part to their ability to spread news quickly and target user interests in a way that traditional news sources cannot. From the most profound announcements to the most mundane, the contemporary expectation is that it will be "heard first" on Twitter or a similar social platform.

That shifting landscape has provided a challenge for courts asked to apply traditional intellectual property standards to new media. Are social media platforms a place for friends to stay updated on each other's lives? A place for businesses to advertise products? A place for Presidential proclamations and up-to-the-second reporting on society's most important issues? The answer is: It depends. And the extremely flexible character of social media has required equal flexibility in the courts' intellectual property analysis. Happily, under U.S. copyright law, that kind of flexibility is possible.

## Embedded Content: The Problem of the Retweet

Take, for example, the problem of embedded content. Social media is as much about re-publication as it is about original creation. Much of the appeal of Twitter and Facebook comes from the sharing and re-sharing of information originally posted by others, and the services provide tools for that purpose. Sharing content this way, through a "live link" to the original work (as opposed to making a static copy and adding it to one's own work), is called "embedding." Embedded content is "live," so if the original publisher makes a change or takes the content down, that change is reflected in the embedded version.

Historically, embedded content had not been viewed as a potential infringement. In a 2007 decision (*Perfect 10 v. Amazon.com*, 508 F.3d 1146 (9th Cir. 2007)), the Ninth Circuit articulated the "server test" which held generally that publication (and thus infringement) could only occur from the server originally hosting the material and not from a mere link to that material. But a series of decisions from New York federal courts beginning in 2018 have rejected the server test, and now the state of the

law is less clear. At least in the Second Circuit it seems likely that embedded content *can* constitute infringement under some circumstances, especially if the social media platform requires the consent of the author for embedding (as Instagram says it does).

## The Fair Use Doctrine

But the issue doesn't end there. Even if embedded content can constitute infringement under some circumstances, it will not always rise to that level. For example, under §107 of the Copyright Act, the "fair use" of a copyrighted work "for purposes such as criticism, comment, news reporting, teaching ..., scholarship, or research," even without authorization, does not constitute infringement. 17 U.S.C. §107. The fair use doctrine is essentially intended to promote the creation and distribution of creative works by allowing the use of copyrighted works in a manner that is sufficiently "transformative" to prevent harm to the original work. Fair use is intended to encourage expressive forms by excepting uses intended to express new meaning from actions for copyright infringement. See *NXIVM v. Ross Inst.*, 364 F.3d 471, 476 (2d Cir. 2004).

Courts consider four non-exclusive statutory factors when determining whether an otherwise infringing use is fair: the "purpose and character" of the new work; the nature of the copyrighted work; the amount and substantiality of the copying; and the potential impact on the market for the copyrighted work.

The first factor is often considered the most significant, and it can be challenging to apply to social media sharing. That factor analyzes the "purpose and character" of the allegedly infringing work (here, the social media post including the embedded link) to determine whether it is sufficiently different from the copyrighted work to label the use "transformative." Thus, a court must determine what the creator of the allegedly infringing work intended to express, and whether that new work serves a purpose sufficiently different from that of the original work. Several hundred years of case law have informed the application of that factor to "traditional" works, so the boundaries tend to be fairly clear: newspapers report news, books tell a story. That distinction is enshrined in the statute.

But social media presents a new challenge. What is the purpose of a social media post? The answer may depend on both its author and its contents. A nuanced analysis is required, and courts have not been perfectly consistent as they grapple with the boundaries of the fair use doctrine in this new context. A recent decision by Judge Ross in the Eastern District of New York examined these issues in the context of an embedded Instagram post containing copyrighted material.

## 'Boesen v. United Sports Publications'

On March 25, 2020, Michael Boesen, a professional photographer based in Denmark, brought an action in the Eastern District of New York alleging that United Sports Publications had infringed his copyright

by embedding an Instagram post containing a photograph he had taken of Caroline Wozniacki, a tennis player. United Sports Publications had published an article reporting that Ms. Wozniacki had announced her retirement from tennis through an Instagram post. The article embedded Wozniacki's Instagram post, which included a photograph of her taken by Boesen in 2002, at the outset of her career, and a caption announcing her retirement. As a result, the article contained an image over which Boesen asserted copyright. United Sports Publications moved to dismiss the complaint, arguing that its use of the Instagram post was protected by fair use, and Judge Ross granted the motion to dismiss. *Boesen v. United Sports Publications*, 2020 WL 6393010 (E.D.N.Y. Nov. 2, 2020).

## An International Challenge

As the Second Circuit noted, circuits are split as to whether private arbitrations are within the scope of 28 USC §1782. It thus remains an open question whether parties may avail themselves of United States District Courts to obtain discovery from non-parties to assist in the prosecution of foreign arbitrations, but at least in New York that avenue is not available. This does not mean that arbitration is the wrong choice—particularly when the alternative is an uncertain foreign tribunal that may have its own limitations on discovery and even due process—but it is a choice, at least at the contracting stage, that comes with some tradeoffs. And, in advising clients on that choice, it is worth understanding how it may actually play out.

*First*, Judge Ross considered the “purpose and character” of the use of the contested work, noting “the central purpose of this investigation is to see ... whether the work merely supersede[s] the objects of the original creation ... or instead adds something new.” The court further noted that republication of an image merely “to present the content of that image” has been held not to be fair use. However, the court found that the article in question did not merely present the photograph as an image of Wozniacki. Rather, the article embedded an Instagram post announcing her retirement—the very subject of the article—which “incidentally included the photograph.”

That use was “transformative” for purposes of the first fair use factor because the embedded Instagram post, which Wozniacki had used to announce her retirement, “was the very thing the Article was reporting on.” In so-holding, the court drew an analogy to a recent SDNY case which held that an article embedding an Instagram post by Cardi B “announcing that her lipstick collaboration with Tom Ford had sold out,” was “transformative” because “the Post—or, put differently, the fact that Cardi B had disseminated the Post—was the very thing the article was reporting on.” See *Walsh v. Townsquare Media*, 2020 WL 2837009, at \*4 (S.D.N.Y. June 1, 2020).

The court considered and rejected plaintiff's argument that the underlying purpose of his photograph was to demonstrate Wozniacki's performance in a tennis match and that there was no functional difference between that use and “defendant's reporting on Wozniacki's retirement.” The court noted that plaintiff

appeared to be attempting to shoehorn his claim into a line of decisions stating that use of an image to illustrate reporting on the *subject* of that image may not be protected by fair use. But the court quickly rejected that argument, noting that it “might succeed if the photograph depicted Wozniacki at a podium announcing her retirement” but not where, as here, the image was selected specifically because Wozniacki’s chose to include it in her Instagram retirement announcement. Overall, the court found the first factor “strongly favors” the defendant.

*Second*, the court considered the “nature of the copyrighted work,” though it noted that factor “has rarely played a significant role” in the fair use analysis. The court nonetheless considered “(1) whether the work is expressive or creative ... with a greater leeway being allowed to a claim of fair use where the work is factual” and (2) whether the work was unpublished, with greater protection afforded to unpublished work. The court noted that the copyrighted work had both “informational and creative elements” but, based on its publication to both plaintiff’s and Wozniacki’s Instagram, it was not entitled to the protection afforded to unpublished works. The second factor thus tipped “slightly in defendant’s favor.”

*Third*, the court considered the substantiality of the use, analyzing the “proportion of the original work used” to determine “whether the quantity and value of the materials used[] are reasonable in relation to the purpose of the copying.” The court noted that defendant had no control over the amount of the copyrighted work used and also that the Instagram post contained a low-quality version of the original photograph. Based on those factors, and the centrality of Wozniacki’s post to the defendant’s article reporting on that post, the court determined the proportion of the work used to be reasonable and found the third factor “favors defendant.”

*Fourth*, Judge Ross considered the likely impact of the infringing use on the market for the original. The court found it “implausible” that defendant’s use, embedding the copyrighted work in an article on a different subject, would impact the market for the original photograph. Thus, the court found that all four factors favored defendant and that the use qualified for the fair use defense.

## Continuing Analysis

Although there is a substantial difference of opinion among the Circuits as to whether embedded content can constitute infringement at all, there is wide agreement that statutory protections such as fair use continue to apply. The application of those protections, however, requires detailed, case-by-case analysis which can cause difficulty for even the most technologically sophisticated courts.

For example, the opinion in *Boesen* is careful and well-reasoned, but the court seems to struggle with the boundaries it is setting. The court suggests, in dicta, that it’s reasoning might have been different if Wozniacki’s Instagram post had contained a photograph of her announcing her retirement. But given the fundamental thrust of the court’s reasoning, it is unclear that distinction should have made a difference:

was the article a general announcement that Wozniacki was retiring, or a report on her choice to do so through Instagram? If the latter, then the embedded Instagram post should be fair use, regardless of what photo content Wozniacki chose to use. And if that distinction makes a difference (as the court seems to suggest) then the analysis is close to becoming so complex as to be largely unpredictable, which is rarely good policy.

Without clear standards, the purpose of the fair use doctrine—to encourage creative expression and avoid chilling “transformative” speech—may be inhibited. It will be up to the courts to continue to provide guidance as this area of the law develops.

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