



COPYRIGHT CLAIMS BOARD

Docket number: 22-CCB-0045

February 28, 2023

David G Oppenheimer

CLAIMANT

v.

Douglas A Prutton

RESPONDENT

FINAL DETERMINATION

This matter has been fully submitted by the parties. For the reasons that follow, the Copyright Claims Board (Board) finds in favor of Claimant David G. Oppenheimer and awards him \$1000 in statutory damages.

I. Procedural History

This claim was referred to the Board, pursuant to 17 U.S.C. § 1509(b), on April 6, 2022—two months before the Board opened to receive claims—by the United States District Court for the Northern District of California. In the complaint filed in that court, Oppenheimer alleged copyright infringement and violations of the Digital Millennium Copyright Act for removal of Copyright Management Information. When consenting to have the claim heard by the Board, Claimant agreed in a signed stipulation to dismiss the Copyright Management Information claim, so that the Board could hear the parties' remaining cause of action. At a September 8, 2022 conference with the Board, the parties agreed that discovery had been completed prior to the case coming before the Board and that no further discovery was needed. The case before the Board proceeded to the written testimony stage, which was completed on January 31, 2023. This case is now ready for final determination.

II. Factual History

The facts relevant to this Final Determination are largely uncontested.

Oppenheimer states that he has been a professional photographer since 1998. Oppenheimer Reply Decl. (Dkt. 12), at 1. He owns the copyright in an aerial photograph he took of the Ronald V. Dellums Federal Building and U.S. Courthouse in Oakland, California (Reg. No. VAu 1-282-763) (the "Work"). Claimant Party Statement (Dkt. 7), at Declaration of David G. Oppenheimer ("Oppenheimer Decl.") ¶¶ 1-2 & Exs. A & B. His July 29, 2017 registration for the Work states that the Work was created in June 2017. *Id.* at Ex. B.

On approximately June 4, 2018, Oppenheimer discovered that the Work was on display on the business website of the Respondent, Douglas A. Prutton, to market his services as a lawyer. *Id.* ¶¶ 4-5. The Work was displayed as one of four relatively small photographs superimposed on a larger photograph on a subpage of Prutton’s website, titled “Where We Work.” *Id.* at Oppenheimer Decl. Ex. D.

Prutton admits to the copying and display of the Work without permission. He states that his adult daughter—who is not an attorney—in an effort to help him improve his website, found the Work on the internet and put it on his website. Declaration of Mariana C. Prutton (Dkt. 9) ¶ 2; Declaration of Douglas A. Prutton (Dkt. 10) ¶ 3 (“Prutton Decl.”). He acknowledges that he is “not claiming that I am somehow shielded from responsibility because it was my daughter, not I, who posted the photograph on my website.” Respondent Party Statement (Dkt. 8), at 5. He states that he removed the photograph from his website in 2019 upon receiving a letter from Oppenheimer’s attorney advising him of Oppenheimer’s objection to the use. Prutton Decl. ¶ 4. He also asserts that he used GoDaddy to create and maintain his website, and his daughter put the Work in the internal “My Photos” portion of his GoDaddy account, where it remained until at least March 25, 2021. *Id.* ¶ 11.

Oppenheimer states that he is a “longtime professional photographer” and that he makes his work available through his website for licensing. Oppenheimer Decl. ¶¶ 2, 4. He seeks statutory damages. “[I]f the extent” that actual damages will be considered by the Board, he attaches a hypothetical \$2775 per year license for the Work that he generated by entering certain information into an online software program called “fotoQuote,” which then created a “Sample Photography Quote.” *Id.* ¶¶ 6-8 & Ex. E. He submits no evidence of ever licensing the Work or any of his other works.

III. Defenses

Before discussing the merits, the Board notes certain allegations and arguments that it is not considering in this Final Determination. Prutton makes numerous statements regarding Oppenheimer’s supposed unscrupulous history as a “copyright troll,” and makes detailed references to the parties’ settlement discussions. Respondent Party Statement (Dkt. 8), at 1-3, 8, 10-11. While it appears that Oppenheimer is a frequent copyright litigator, the Board is not considering Prutton’s broadsides and discussion of Oppenheimer’s settlement demands in reaching its

decision on the merits and damages. Likewise, Oppenheimer’s discussions of Prutton’s alleged removal of copyright management information, alleged cropping of the Work at issue, and alleged “willfulness,” Claimant Party Statement (Dkt. 7) at 1-4, Claimant Reply (Dkt. 11) at 3-4 & 6—allegations denied by Prutton in sworn declarations—are not relevant to the Final Determination, as willfulness is not considered in a Board proceeding. 17 U.S.C. § 1504(e)(1)(A)(ii)(III).

Prutton admits that Oppenheimer’s photograph was posted on Prutton’s website and does not contest any of the elements of copyright infringement. Respondent Party Statement (Dkt. 8), at 5. As such, the Board will focus its liability discussion on the two defenses raised by Prutton: fair use and unclean hands.

Prutton’s statement that “both of these defenses have been successfully asserted in cases brought by Mr. Oppenheimer,” *id.*, mischaracterizes the cases he cites for support. In those cases, *Oppenheimer v. The ACL LLC*, 504 F. Supp. 3d 503 (W.D.N.C. 2020) and *Oppenheimer v. Scarafile*, 2022 WL 2704875 (D.S.C. July 12, 2022), the courts did not decide that fair use or unclean hands were valid defenses to Oppenheimer’s claims. Rather, in each case, the court merely denied *Oppenheimer’s* summary judgment motion to strike the defenses, finding that the defendant had made enough allegations to support factors related to those defenses that they would not be stricken on summary judgment. *The ACL*, 504 F. Supp. 3d at 511-12; *Scarafile*, 2022 WL 2704875, at *6, *9.

A. Fair Use

Four non-exclusive factors are considered when analyzing a fair use defense: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and, (4) the effect of the use upon the potential market for or value of the copyrighted work. 17 U.S.C. § 107; *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1174 (9th Cir. 2012).

In his papers, Prutton does not address any of the first three factors. Because the proponent of the affirmative defense of fair use has the burden of proof on the issue, *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 459 (9th Cir. 2020), *cert. den.*, 141 S. Ct. 2803 (2021), his failure to address three of the four factors is fatal to that defense.

Moreover, based on the evidence in the record, the Board cannot conclude that any of those three factors weighs in favor of fair use. For the first factor, Prutton’s website promoting his law firm is commercial in nature. Further, he used Oppenheimer’s photograph to illustrate what the photograph depicts—the Ronald V. Dellums Federal Building and U.S. Courthouse—so the use was not transformative. *See McGucken v. Pub. Ocean Ltd.*, 42 F.4th 1149, 1158 (9th Cir. 2022). As to the second factor, Oppenheimer’s photograph was creative in nature, which weighs against fair use. *VHT, Inc. v. Zillow Grp., Inc.*, 918 F.3d 723, 743 (9th Cir. 2019) (“Our decisions . . . provide a roadmap for analyzing the second factor, which focuses on the nature of the copyrighted work. In those cases, we held that photographers’ images are creative, especially when they are created for public viewing.”). Finally, with reference to the third factor, Prutton’s use of the entirety of the Work also disfavors fair use. *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 820 (9th Cir. 2003) (“While wholesale copying does not preclude fair use per se, copying an entire work militates against a finding of fair use.”).

Prutton chose to address only the fourth factor, the effect of his use on the market for the Work. Prutton’s sole relevant factual allegation regarding this factor is that Oppenheimer admitted in discovery “that he had not sold or licensed a single copy of the photo involved in this case.” Prutton Decl. ¶ 14. Oppenheimer does not deny this statement and presents no evidence of having ever licensed the Work.

When addressing this factor, Prutton asserts that Oppenheimer is “unable to show” that Prutton’s use of the Work has or will have an effect on the market. However, fair use is an affirmative defense. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994); *Dr. Seuss Enters, L.P. v. ComicMix LLC*, 983 F.3d at 459 (“Not much about the fair use doctrine lends itself to absolute statements, but the Supreme Court and our circuit have unequivocally placed the burden of proof on the proponent of the affirmative defense of fair use.”). As such, it is Prutton who must prove that the fair use defense insulates him from liability. He does not satisfy that burden.

It is true that if Oppenheimer has not actually licensed the Work—and he has not come forward with any evidence to suggest that he has licensed any of his photographs—any market effect caused by Prutton’s use of the Work may be minimal. However, that does not mean that this factor weighs in Prutton’s favor in this case. While not identifying any specific licenses for any of his photos in the past, Oppenheimer does state that he makes

his photographs available for license on a public website and that this Work was likewise available. Oppenheimer Decl. ¶ 4 & Ex. C. Other cases where Oppenheimer has been a litigant show that he has some licensing history, however minimal. *See Scarafife*, 2022 WL 2704875, at *4 (suggesting Oppenheimer made “less than \$5,000” from licensing his works in 2017). Therefore, there is a market available for this Work, which Prutton evaded by copying and displaying the Work on his website without permission. Because Prutton’s use of the work was commercial and “amount[ed] to mere duplication of the entirety of” the work, cognizable market harm is presumed to exist.

Brammer v. Violent Hues Prods., LLC, 922 F.3d 255, 268 (4th Cir. 2019) (citing *Campbell*, 510 U.S. at 591); *Leadsinger, Inc. v. BMG Music Publ’g*, 512 F.3d 522, 531 (9th Cir. 2008). Furthermore, even if Oppenheimer had decided not to license the Work at all, he has the right to make that decision rather than see his works used without permission. *See Harper & Row, Publrs. v. Nation Enters.*, 471 U.S. 539, 551 (1985) (“Publication of an author’s expression before he has authorized its dissemination seriously infringes the author’s right to decide when and whether it will be made public”); *Monge*, 688 F.3d at 1181 (deciding that the market factor tipped against defendant and stating that the factor “focuses on *potential*, not just actual, market harm”) (emphasis in original). Regardless, were the Board to decide that this factor favors Prutton because Oppenheimer has not licensed this Work, it would not weigh so strongly in his favor that it would outweigh the other three factors in this case.

Prutton has not satisfied his burden on the affirmative defense of fair use. Taking into account all of the fair use factors, the Board concludes that not a single factor supports a finding that Prutton’s use of the Work constituted a fair use.

B. Unclean Hands

Prutton also raises the affirmative defense of “unclean hands.” His reasoning for this defense rests on the premise that Oppenheimer was unreasonable in settlement negotiations and has a long history of copyright litigation; he also suggests that Oppenheimer’s primary revenue stream from his photographs is litigation, not sales or licensing. Respondent Party Statement (Dkt. 8), at 1-2, 8.

“The application of the unclean hands doctrine is generally a fact intensive inquiry and the defense is recognized only rarely.” *Kaseberg v. Conaco, LLC*, 360 F. Supp. 3d 1026, 1038 (S.D. Cal. 2018) (quotations and citations omitted).

In the Ninth Circuit, “unclean hands is a defense to copyright infringement ‘when the plaintiff’s transgression is of serious proportions and relates directly to the subject matter of the infringement action.’” *Oracle Am., Inc. v. Terix Comp. Co., Inc.*, 2015 WL 1886968, at *5 (N.D. Cal. Apr. 24, 2015) (quoting *Dream Games of Arizona, Inc. v. PC Onsite*, 561 F.3d 983, 990-91 (9th Cir. 2009)). “A defendant asserting that a plaintiff’s claim is barred by unclean hands must show that the plaintiff acted unfairly or fraudulently respecting the matter in controversy.” *Oracle Am., Inc. v. Hewlett Packard Enter. Co.*, 2017 WL 2311296, at *2 (N.D. Cal. May 26, 2017) (quotations and citations omitted).

Prutton does not present any evidence of actions taken in this case that would lead to the rarely-recognized finding of unclean hands. To find that an infringement lawsuit brought by a copyright owner amounts to unclean hands simply due to the volume of other lawsuits by the same owner would take away the right of copyright owners to sue for actual infringements like the one that clearly occurred here. *See Rosen v. Masterpiece Mktg. Grp., LLC*, 2016 WL 7444698, at *6 (C.D. Cal. May 3, 2016) (“MMG’s allegations that Plaintiff ‘is a serial litigator’ who has ‘intentionally create[d] litigation to supplement his income’ flies in the face of the Copyright Act, which authorized ‘[t]he legal or beneficial owner of an exclusive right under a copyright . . . to institute an action for any infringement of that particular right while he or she is the owner of it.’”) (quoting 17 U.S.C. § 501(b)). *See also Golden v. Michael Grecco Prods., Inc.*, 524 F. Supp. 3d 52, 65 (E.D.N.Y. 2021) (stating that “being a litigious and opportunistic copyright holder . . . is not a basis for an ‘unclean hands’ defense”); *O’Neil v. Ratajkowski*, 563 F. Supp. 3d 112, 135-36 (S.D.N.Y. 2021) (rejecting the unclean hands defense based on the plaintiff being a frequent litigator who asks for disproportionate damages).

Because Prutton’s asserted defenses are without merit, the Board finds for Oppenheimer on the issue of liability and moves to the question of damages.

IV. Damages

Oppenheimer requests statutory damages. Before the Board, the maximum award of statutory damages is \$15,000 per work for works timely registered (either before the infringement started or within three months of first publication of the infringed work) and \$7,500 for works not timely registered. 17 U.S.C. § 1504(e)(1)(A)(ii). While there is no

concrete evidence of when the Work was first used by Prutton, it appears likely that it was after the Work's July 29, 2017 registration. More importantly, the registration states that it covers photographs taken in June 2017, just a month before registration. Therefore, this Work appears to have been registered timely. The issue is moot, however, given that the Board would not award over \$7,500 in this case regardless of the cap. The Board notes that in his papers, Oppenheimer requests statutory damages of \$30,000, a demand that is not viable for one infringed work. 17 U.S.C. § 1504(e)(1)(A)(ii)(I). Instead, his demand will be construed as a demand for the highest amount of damages the Board can award.

A. Innocent Infringer Defense

The typical minimum award in the statutory range is \$750 per work infringed. 17 U.S.C. § 504(c)(1). Prutton suggests that the Board award only \$200, citing what is known as the Section 504 “innocent infringer” defense. Respondent Party Statement (Dkt. 8), at 9. Section 504 of the Copyright Act allows a reduction of the statutory minimum from \$750 down to as low as \$200 in a court's discretion where the infringer “sustains the burden of proving, and the court finds, that such infringer was not aware and had no reason to believe that his or her acts constituted an infringement of copyright.” 17 U.S.C. § 504(c)(2).

Nothing in the Board's mandate under 17 U.S.C. § 1504 would prohibit awarding as little as \$200, should a respondent satisfy the burden of proof under the innocent infringer standard. The Board must act in accordance with section 504(c), unless the CASE Act sets forth a specific condition. 17 U.S.C. § 1504(e)(1)(A)(ii). That the statute sets lower maximums for damage awards than are available in federal court does not affect the minimum. 17 U.S.C. § 1504(e)(1)(A)(ii)(III) states only that the Board may not consider whether the infringement was made “willfully,” a factor courts may use in *raising* the statutory maximum or the damages within the statutory range.

However, Prutton offers no further evidence or argument in an attempt to satisfy his burden of proof as to why an attorney (or his adult daughter) taking a photograph that did not belong to him and placing it on his commercial website without permission would have “no reason to believe” that such acts constituted copyright infringement.

Oppenheimer submits evidence that at least in some places where the Work is posted, there are full copyright notices. Oppenheimer Decl. ¶ 4 & Ex. C. The innocent infringer defense to mitigate damages is unavailable if a

defendant “had access” to copies where the notice was available. 17 U.S.C. § 401(d). Section 401(d) (and its companion provision section 402(d)) “gives publishers the option to trade the extra burden of providing copyright notice for absolute protection against the innocent infringer defense.” *Maverick Recording Co. v. Harper*, 598 F.3d 193, 199 (5th Cir. 2010); *BMG Music v. Gonzalez*, 430 F.3d 888, 891-892 (7th Cir. 2005).

However, in this case, the Board does not need to decide whether Prutton had access to copies of the Work with a copyright notice. The burden placed upon Prutton, an attorney, to prove that he “was unaware and had no reason to believe that his or her acts constituted an infringement of copyright” is clearly not satisfied here. *See Golden*, 524 F. Supp.3d at 66-67 (rejecting defendant’s assertion of innocent infringement based on his belief that an image that he found on the internet was posted “with permission and was free to use,” and observing that accepting that argument “would lead courts to apply lower statutory damages to any layperson’s use of the many copyrighted images available on the internet without notice of their copyrighted status”).

B. Damages Award

In asking for the maximum statutory award, Oppenheimer correctly states that there is no requirement to tie statutory damages to actual damages, and that courts have wide discretion as long as the award falls in the statutory range. That is true, including in the Ninth Circuit, where Prutton resides. *See Harris v. Emus Records Corp.*, 734 F.2d 1329, 1335 (9th Cir. 1984)). However, it is also true that the general standard of such courts, including in the Northern District of California from which this case was referred, is to establish a relationship between statutory damages and actual damages. *See Stockfood Am., Inc. v. Sequoia Wholesale Florist, Inc.*, 2021 WL 4597080, at *6 (N.D. Cal. June 22, 2021) (“An award of statutory damages must bear a plausible relationship to plaintiff’s actual damages.”) (quotations omitted); *Mon Cheri Bridals, LLC v. Cloudflare, Inc.*, 2021 WL 1222492, at *2 (N.D. Cal. Apr. 1, 2021) (granting a motion to compel information on plaintiff’s lost profits since statutory damages should be related to actual damages and plaintiffs would not commit to seek only minimum statutory damages); *IO Group, Inc. v. Jordan*, 708 F. Supp.2d 989, 1003 (N.D. Cal. 2010).

In applying this principle, various courts have limited statutory damages to the \$750 minimum where a plaintiff does not submit valid proof of actual damages. *See, e.g., Atari Interactive, Inc. v. Redbubble, Inc.*, 546 F. Supp. 3d 883,

888-89 (N.D. Cal. 2021) (“Harmonizing these principles [related to statutory damages], the Court concludes that Atari may seek an award of minimum statutory damages without disclosing any damages calculations but, to avoid a potential windfall, it must provide some evidence of its lost profits or Redbubble’s profits if it seeks an award greater than the statutory minimum.”).

Prutton declares that Oppenheimer admitted in discovery that he has never sold any copies of or licensed the Work. Prutton Decl. ¶ 14. Oppenheimer does not contest this assertion. Oppenheimer has also made the choice to present no evidence of licensing the Work or any of his other photographs. Rather than submit any evidence, Oppenheimer declares that he entered information about the type of photograph at issue into an Internet website, “fotoQuote,” which generated a number representing what he should charge for licensing the Work: \$2,775 per year. Oppenheimer Decl. ¶¶ 7-8 & Ex. E. He provides no evidence or argument that would support acceptance by the Board of the number supposedly generated by fotoQuote as an accurate or reliable measure of damages. The Board therefore disregards that submission. *See Oppenheimer v. Griffin*, 2019 WL 7373784, at *6-7 (W.D.N.C. December 31, 2019) (in a case brought by Oppenheimer, rejecting fotoQuote calculation because it “is not reflective of the Plaintiff’s lost revenue here”).

Claimant has been awarded the \$750 statutory damages minimum in at least two cases similar to this one. *See id.* at *18-19; *Oppenheimer v. Holt*, 2015 WL 2062189, at *2 (W.D.N.C. May 4, 2015) (holding, where Oppenheimer did not provide evidence as to lost revenues, that “[t]he burden of proof as to damages is on the Plaintiffs and they have not persuaded the Court that the Defendant’s conduct in this case warrants a statutory award greater than \$750.00 in damages”).

Based on the slim record regarding damages that the parties have given the Board, the Board concludes that an award at or near the bottom of the permissible range of statutory damages is appropriate. Two members of the Board would award \$1000, based on the analysis that follows. The third member would award \$750. Accordingly, the Board awards \$1000 in statutory damages.

In deciding statutory damages, courts have looked at various nonexclusive factors, including: “(1) the expenses saved and the profits reaped; (2) the revenues lost by the plaintiff; (3) the value of the copyright; (4) the deterrent

effect on others besides the defendant; (5) whether the defendant's conduct was innocent or willful; (6) whether a defendant has cooperated in providing particular records from which to assess the value of the infringing material produced; and (7) the potential for discouraging the defendant.” *Mon Cheri Bridals*, 2021 WL 1222492, at *1 (quotations and citations omitted). Furthermore, in considering damages for a copyright infringement, courts are “guided by ‘what is just in the particular case, considering the nature of the copyright [and] the circumstances of the infringement.’” *Peer Int’l Corp. v. Pausa Records, Inc.*, 909 F.2d 1332, 1336 (9th Cir. 1990) (quoting *F.W. Woolworth Co. v. Contemporary Arts, Inc.*, 344 U.S. 228, 232 (1952)).

While some of the factors courts often look at are not present here—or relate to willfulness, which is outside of the Board’s ability to address—the totality of the “circumstances of the infringement” justify a small increase from the minimum. Prutton used a small image of the Work on a subpage of a website and there is no evidence that Oppenheimer suffered any damages or that Prutton reaped any gains from the use. However, Prutton’s use was commercial in nature and lasted at least a year. The Work is an aerial photograph, which arguably gives it extra value. The size of the image placed on his law firm website was not large, but it was clearly larger than thumbnail-sized. On balance, the damages awarded should exceed the minimum of the statutory range. *See, e.g., Stross*, 2021 WL 2453388, at *4 (in a default judgment, awarding \$1500 for the use of a photograph on a commercial website despite lack of evidence as to harm to plaintiff or benefit to defendant); *Nat’l Hair Growth Centers of Arizona, LLC v. Edmund*, 2019 WL 2249976, at *6 (S.D. Cal. May 23, 2019) (in a default judgment, awarding statutory damages of \$1000 per photograph infringed where there was no evidence of harm, and noting other cases with similar awards).

V. Conclusion

The Board finds the respondent, Douglas A. Prutton, liable for infringement, and awards the claimant, David G. Oppenheimer, \$1000 in statutory damages.

Copyright Claims Board