

[DO NOT PUBLISH]

In the
United States Court of Appeals
For the Eleventh Circuit

No. 21-14236

Non-Argument Calendar

ALPER AUTOMOTIVE, INC.,
A Florida Corporation
d.b.a. AA Ignition,

Plaintiff-Counter Defendant-Appellee,

versus

DAY TO DAY IMPORTS, INC.,
A California Corporation,

Defendant-Counter Claimant-Appellant.

Appeal from the United States District Court
for the Southern District of Florida
D.C. Docket No. 9:18-cv-81753-BER

Before WILSON, JORDAN, and NEWSOM, Circuit Judges.

PER CURIAM:

Defendant-Appellant Day To Day Imports, Inc. (DDI) appeals the district court's order, after a bench trial, that found DDI violated Section 512(f) of the Digital Millennium Copyright Act (DMCA). After careful review, we affirm.

I. BACKGROUND

The basis for this copyright litigation is a set of replacement stickers for the dashboard climate controls for certain General Motors (GM) vehicles. In 2011, Harold Walters incorporated original artwork behind the set of those replacement stickers. Walters began selling his stickers through online markets and submitted his design to the U.S. Copyright Office in 2017.¹ The U.S. Copyright Office granted a copyright for Walters's design.

In 2016, DDI began selling a similar set of climate control stickers but without Walters's artwork through online markets,

¹ In his application, Walters put 2017 as the date of original design, but that was amended to 2011.

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including Amazon. Walters submitted a Takedown Notice to Amazon. Under the DMCA, a person who believes his copyright is being infringed can notify the online market in writing and must identify the allegedly infringing listing with particularity. 17 U.S.C. § 512(c). DDI received notification that Amazon had taken down the listing due to copyright infringement.

DDI, through counsel, reached out to Walters to address how DDI allegedly infringed Walters's copyright. Walters explained to DDI that he had a valid copyright and provided DDI with his copyright registration numbers. But Walters did not provide DDI with a copy of his design nor did DDI request a copy of the design from the U.S. Copyright Office. After negotiating with Walters, DDI paid Walters to license the copyrights and allowed Walters to continue to sell his stickers on eBay while DDI would sell the licensed stickers on Amazon. Walters permitted DDI to submit a Takedown Notice to Amazon.

In April 2018, Plaintiff-Appellee Alper Automotive, Inc. (Alper) began selling a sticker that contained the same dashboard climate controls as DDI and Walters but also included another decal. On May 8, 2018, DDI's counsel sent a Takedown Notice to Amazon that identified Alper's sticker as infringing DDI's license of Walters's copyright. At first, Amazon did not remove the listing until DDI sent another Takedown Notice on May 15, 2018. Amazon took down Alper's listing on May 17, 2018.

On May 17, 2018, Alper received notice that DDI had reported the copyright infringement and that Amazon had removed

Alper's listing. Alper's counsel contacted DDI's counsel to address the alleged copyright infringement. Throughout the discussion, DDI explained that it did not have a copy of Walters's design submitted to the U.S. Copyright Office but had seen the work and claimed Alper's stickers were identical. Ultimately, Alper and DDI did not resolve the alleged copyright infringement.

On June 7, 2018, Alper emailed Amazon and disputed the Takedown Notice, specifically that the work was not identical to DDI's work nor was DDI's work entitled to copyright protection because it was standard dashboard icons. Amazon reinstated Alper's listing on June 22, 2018. This cycle of DDI sending a Takedown Notice and Alper disputing that notice occurred with DDI's August 2 and November 1 Takedown Notices.²

On November 19, 2018, DDI again sent a Takedown Notice that again included Alper's reinstated listing. On November 29, 2018, Amazon removed Alper's listing, and Alper immediately appealed. Alper's counsel contacted DDI's counsel at this time to discuss the changes Alper made to its sticker and to hopefully settle. Amazon reinstated Alper's listing on December 2, 2018. On December 5, 2018, after discussing the issue with other attorneys and Amazon Legal, Alper's counsel rescinded the settlement proposal. Alper's counsel explained that Alper's listing does not infringe on

² These Takedown Notices also included listings from other companies that were not reinstated by Amazon.

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DDI's copyright and that if DDI continued to file invalid Takedown Notices, Alper would take legal action.

On December 23, 2018, DDI's counsel received an email from Amazon stating it received DDI's reports of infringement and had acted against the infringers, including Alper. Alper appealed and Amazon reinstated Alper's listing.³

On December 27, 2018, Alper sued DDI in the Southern District of Florida for five claims, including 17 U.S.C. § 512(f) about DDI's submitted Takedown Notices. DDI counterclaimed for copyright infringement and joined Walters to the suit. Relevant to this appeal, the district court conducted a three-day bench trial on Alper's Section 512(f) claim only.⁴

After the bench trial, the district court entered its Findings of Facts and Conclusions of Law. Ultimately, the district court found that the May, August, and November 1 Takedown Notices did not violate Section 512(f). However, the district court found:

12. When it submitted the November 19 DMCA Takedown Notice, Defendant [DDI] had a subjective

³ As the district court noted, the December emails were a technical glitch by Amazon but would not have happened but for the November 19, 2018 Takedown Notice.

⁴ Alper's remaining claims and DDI's counterclaims were handled either by settlement or through summary judgment.

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