

Copy That



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LAST RITES FOR THE SERVER TEST?

FOR NEARLY 20 YEARS THE NINTH CIRCUIT has maintained that unauthorized embedding of a copyright holder's work cannot be infringement, explaining that "where the image remains on third-party's server and is not fixed in the memory of the infringer's computer...embedding is not display" and thus violates no copyright interest.¹ For nearly as long just about every court outside of the Ninth Circuit (a slew of district courts—no other appellate court has ever ruled on the validity of the test) has said "nonsense." As a result, whether a copyright owner can protect her work against unauthorized displays accomplished through embedding depends almost entirely on where she can bring her claim of infringement.

Time and again courts in the Ninth Circuit have been asked to reconsider the wisdom of the "server test" and bring its jurisprudence in line with the rest of the country. Indeed, in 2023 and 2024 yours truly filed an *amicus* brief in support of *en banc* review in *Hunley v. Instagram*, a petition for *en banc* review in *McGucken v. Valnet*, and then a *cert* petition in *McGucken v. Valnet*—all asking very nicely and politely to please reconsider it in light of its near universal rejection everywhere else. Unfortunately, the Ninth Circuit said "nah, we're good" and the Supreme Court denied review—likely because there is no actual circuit split.

That may be about to change.

On July 29, 2025 a judge in the Southern District of Mississippi became what appears to be the first judge outside of the Ninth Circuit to apply the "server test" to an embedding case.² Coincidentally, on that very same day a judge in the Western District of Texas rejected the test, following a 2017 Northern District of Texas ruling³ in

finding that "[t]he plain text of the Copyright Act, the legislative history behind its enactment, and subsequent Supreme Court Jurisprudence provide no support for the server test[.]"⁴ The Fifth Circuit has now granted interlocutory review to address this split among its district courts—the first time another circuit has directly addressed the validity of the test outside the Ninth Circuit.⁵ That appeal should be fully briefed at the time of this article's publication.

This is big news. The stage is set for the standoff between the Ninth Circuit and the rest of the country to be resolved.

It is possible that the Fifth Circuit will adopt the "server test" and avoid a split, but don't count on it because the test is indefensible when you look under the hood at its justification. To understand why, a little Copyright 101 is in order...if you will indulge me.

Why The Server Test is Misguided

At the risk of stating the obvious, the Copyright Act does not just protect copyright owners against the making of illicit copies. Rather, 17 U.S.C. § 106 imbues a copyright owner with a bundle of rights including "the exclusive right[s] to—or to license others to—reproduce, perform publicly, display publicly, prepare derivative works of, and distribute copies of, his copyrighted work."

These rights are discrete and "[t]he word 'copying' is shorthand for the infringing of any of the copyright owner's five exclusive rights described in section 106" of the Copyright Act. *Arista Records, LLC v. Doe 3*, 604 F.3d 110, 117 (2d Cir. 2010) (cleaned up). Thus, one can violate the right to prepare derivative works without making an actual copy of the protected work, violate the distribution right by selling or disseminating illicit copies despite not having made those copies, violate the right to make reproductions without violating the public displaying right, and so on. Yet under the "server test" one apparently cannot violate the display right without first also violating the copyright holder's reproduction right. See the problem?

The "server test" makes no sense logically and is at odds with both the plain language of the Act and Supreme Court precedent interpreting it. Section 106 grants copyright holders the exclusive public display right for their original works that fall within the subject matter of copyright. 17 U.S.C. § 106(5) (setting forth the exclusive right to "display the copyrighted work publicly") And one displays a work when he or she "show[s] a copy of it, either directly or by means of...any...device or process." 17 U.S.C. § 101. Importantly, there is nothing in the Act requiring that the party "show[ing] a copy" of a work—a.k.a. the infringer—have made or be storing that copy to commit infringement.

In *Perfect 10, Inc. v. Amazon.com, Inc.* the Ninth Circuit reached a contrary conclusion by drawing a non sequitur out of the Act's definitions of "display" and "copy." Specifically, it reasoned that under Section

101: (1) “[t]o ‘display’ a work means to show a copy of it either directly or by means of a film, slide, television image, or any other device or process...,” and (2) “‘Copies’ are material objects...in which a work is fixed...and from which the work can be perceived, reproduced, or otherwise communicated,” therefore (3) one cannot directly display / communicate a copy of a work if one “does not have any ‘material objects...in which a work is fixed.’” 508 F.3d 1146, 1160–1161 (9th Cir. 2007).

The *Perfect 10* holding begs the question of why the HTML instructions used to embed do not constitute a “process” through which a “copy” of a work stored on a third-party server is newly displayed. To answer that question, the opinion feebly states that “[p]roviding these HTML instructions is not equivalent to showing a copy [because they]...do not themselves cause infringing images to appear on the user’s computer screen.” In other words, ignoring that the job of HTML embedding instructions is to cause a copy displayed at one URL to be displayed at another URL, the Ninth Circuit concludes that cause of the display is *really* the user’s browser interacting with the server hosting the image—even though the process created by the offending embedding instruction is what causes that interaction.

Not surprisingly, courts outside the Ninth Circuit have recognized that the “server test” erroneously collapses the display right into the reproduction right and destroys the ability of a copyright holder to control the display of copyright-protected works by potential licensees—or worse, by free-riding competitors. These courts rely on the language of the Copyright Act and the teachings of the Supreme Court that to determine whether a work is infringed under the Copyright Act the offending use should be viewed “as presented to, and perceptible by, [a] user.” *New York Times Co. v. Tasini*, 533 U.S. 483, 499 (2001) (citing 17 U.S.C. §§ 101–102). This is because the Copyright Act is not concerned with the “behind-the-scenes way” that content is delivered to the recipient, *Am. Broad. Cos. v. Aereo, Inc.*, 134 S. Ct. 2498, 2507–08 (2014), as such technical considerations are “not adequate to place [the defendant’s] activities outside the scope of the act” (*id.* at 2511). See also *Tasini*, 533 U.S. at 448, 451 (rejecting any distinction between different technological means, reasoning it “means nothing to the subscriber” as the technology was “invisible to subscriber and broadcaster alike” and by which Aereo “perform[ed] the same work;” “show[ed] the same images and ma[de] audible the same sounds”).

The server test is squarely at odds with *Tasini* and *Aero* because it immunizes certain infringers based on how they display a copyrighted image on a website:

- ▶▶ If a website publisher displays an article by “using a computer to fill a computer screen with a copy of the photographic image fixed in the computer’s memory,” that is infringement. *Perfect 10*, 508 F.3d at 1160.
- ▶▶ If, on the other hand, the same website publisher shows exactly the same article to exactly the same user by “embedding”

a link to it—an invisible technological process by which the website’s backend HTML code “gives the address of the image to the user’s browser” and the browser “interacts with the [third-party] computer that stores the” computer code that represents the image—that is not infringement. *Id.* at 1161.

In other words, the fixation requirement undergirding the server test rests on the nature of the behind-the-scenes background technological process, specifically, on the technicality that an embedded link points a user’s web browser to an author’s image “fixed” elsewhere (rather than to a file on the operator’s own computer server)—a distinction that was rejected as immaterial in *Aereo*. 134 S. Ct. 2498, 2507 (2014) (“We do not see how this single difference, invisible to subscriber and broadcaster alike, could transform” an actionable infringing use to one over which a copyright owner has no control).

The Server Test Frustrates the Display Right for No Purpose

The “server test” is a fundamentally flawed concept that frustrates the display right for no real payoff. According to its proponents, it is critical to ensure that the internet remains a free and open source for sharing content, and a parade of horrors will come to pass if websites cannot embed third-party content with impunity. But over the past 15+ years in which courts outside of the Ninth Circuit have consistently rejected the server test, no such parade has been seen.

And there are other tools to adequately protect otherwise “unauthorized” copyright uses that are socially beneficial—perhaps most importantly “fair use.” Indeed, *Perfect 10* considered whether the thumbnail images of the content stored by Google were infringing and “conclude[d] that Google’s use of Perfect 10’s thumbnails is a fair use.” 508 F.3d at 1168. Applied to any other case of embedding, fair use analysis would consider how much of a work is “framed” and how that framing is done under, *inter alia*, the first and third enumerated fair use factors under 17 U.S.C. § 107(1) (the purpose and character of the use, and the amount and substantiality of the portion used). Conversely, the fourth factor (effect on the market)—sometimes called the most important factor—demonstrates a major problem with the server test as a blanket, stand-alone free-pass, *i.e.*, that when a publisher uses framing in lieu of licensing, such as in the numerous cases that have rejected the server test, the server test wreaks heavy damage on the licensing market for uses that would never otherwise be deemed “fair.”

Copyright industries collectively contribute trillions of dollars in value to the U.S. gross domestic product (“GDP”). According to an annual report prepared for the International Intellectual Property Alliance in 2024, the value added by copyright industries to the U.S. economy has increased steadily in recent years and, in 2023, accounted for about 12.3% of the U.S. GDP. These copyright industries together employ approximately 21 million people—nearly 10% of total U.S. employment. The creative economy contributed \$3.3 trillion to the U.S. economy in 2023.

And with respect to the flow of information, the Copyright Office has recognized that “[a] majority of Americans now get their news from digital devices, and a majority of those who do say their primary source is not a newspaper’s website, but a search index, a social media feed, or a specialized service that aggregates news from other sources. Digital distribution enables these ‘news aggregators’ to provide links to and snippets of others’ published reporting at low cost and with a wide reach.” *Copyright Protections for Press Publishers*, U.S. Copyright Office, (June 30, 2022); see also Elisa Shearer, *More Than Eight-in-Ten Americans Get News From Digital Devices*, PEW RSCH. CTR. (Jan. 12, 2021), <https://www.pewresearch.org/fact-tank/2021/01/12/more-than-eight-in-ten-americans-get-news-from-digital-devices/>.

What this means, practically, is that the creators behind our news sources and our creative economy in general must utilize online platforms (where their work is subject to embedding) to successfully promote themselves and generate income. The *de jure* license created by the “server test” (allowing any third party to freely display any original work through embedding) vitiates the rights of copyright owners to control the display of their work and earn a reasonable return for their investment of time, training, experience, skill and talent. It also hobbles the incentives for others to invest in the creation of new works.

The “server test” has not found a meaningful life outside the Ninth Circuit, and inside the Ninth it has essentially become a zombie sucking the life out of display-right violation claims. With a little Senecan luck (i.e., “luck is what happens when preparation meets opportunity”) we will soon have a *bona fide* circuit split that will lead to the “server test” being read its last rites despite an intransigent Ninth Circuit. ◀◀

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Endnotes

1. *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1159 (9th Cir. 2007).
2. *Emmerich Newspapers, Inc. v. Particle Media, Inc.*, 2025 WL 2146609 (S.D. Miss. July 29, 2025).
3. *Leaders Institute, LLC v Jackson*, 2017 WL 5629514 (N.D. Tex. 2017).

4. *Urbanimage Media LTD. v. IHeartMedia, Inc.*, 793 F.Supp.3d 852 (W.D. Tex., July 29, 2025).
5. *Emmerich Newspapers, Inc. v. Particle Media, Inc.*, Case No. 25-60550 (5th Cir.).

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(Fed. Cir. Nov. 26, 2018) As the Federal Circuit noted, “[n]o law or precedent suggests that surnames cannot be registered as trademarks if they have acquired distinctiveness in trademark use. . . .” The Federal Circuit based its ruling on the board’s finding that SCHLAFly acquired distinctiveness in association with beer based on more than twenty-five years of continuous use of the name, evidence of seventy-five million beers sold during a recent five-year time period, and media coverage in USA Today, the Washington Post and The Wall Street Journal.

15. https://www.supremecourt.gov/opinions/19pdf/19-46_8n59.pdf.
16. <https://guidelines.euipo.europa.eu/1803468/1788554/trademark-guidelines/3-2-2-4-general-principles-of-examination-of-distinctiveness>.
17. <https://www.euro-ip.com/content/uploads/2017/05/acquired-distinctiveness.pdf>.
18. <https://ponti.pro/en/news/the-kit-kat-case-the-secondary-meaning-in-the-eu/>.
19. EUIPO Case R 513/2011-2 *Société des Produits Nestlé SA v Cadbury Holdings Ltd.*
20. <https://cdn.www.gob.pe/uploads/document/file/1676341/Decision486.pdf.pdf?v=1613495833>
21. <https://www.inta.org/perspectives/features/applying-secondary-meaning-in-mexico/>.
22. For example, the General Inter-American Convention for Trade Mark and Commercial Protection (also known as the Washington Convention or the Pan-American Convention of 1929), the Paris Convention for the Protection of Industrial Property, the Agreement on Trade-Related Intellectual Property Rights (TRIPS), and bilateral free trade agreements with Chile and Uruguay.
23. <https://www.gov.br/inpi/pt-br/central-de-conteudo/legislacao/arquivos/documentos/2025spr-15-portaria-da-distintividade-adquirida.pdf>.
24. <https://www.kasznarleonardos.com/en/bpto-establishes-framework-for-secondary-meaning-in-brazil-ordinance-no-15-2025-regulates-recognition-of-secondary-meaning/#:~:text=Brazil:%20Ordinance%20no.,15/2025%20regulates%20recognition%20of%20secondary%20meaning,the%20Brazilian%20trademark%20registration%20system>.
25. <https://moellerip.com/the-moeller-blog/brazil-establishes-secondary-meaning-framework-for-trademarks-with-ordinance-no-15-2025/>.
26. <https://www.daniel-ip.com/en/blog/bpto-recognizes-acquired-distinctiveness-a-turning-point-for-trademark-owners-in-brazil/>.
27. <https://guerraip.com/en/2025/02/17/inpi-to-accept-registration-of-marks-with-secondary-meaning/>.