



# COPYRIGHT CLAIMS BOARD

Docket number: 24-CCB-0323

November 4, 2024

Daniel M. Van Doren

CLAIMANT

v.

Francisco Hernandez and  
El Centenario Mexican Grill

RESPONDENTS

## ORDER TO AMEND NONCOMPLIANT CLAIM

The Copyright Claims Board (Board) finds that your claim does not comply with the requirements of the CASE Act and related regulations. Your claim cannot move forward unless it is amended.

If you wish to proceed with this claim, you must file an amended claim by **December 4, 2024**. If you do not, the Board must dismiss your claim without prejudice, although you may file again in the future before the Board or in federal court. If you file an amended claim and it is found compliant, you will be notified and directed to proceed with service. There is no additional filing fee for an amended claim. 17 U.S.C. § 1506(f)(1)(B).

To make your amended claim compliant, you must resolve the issues identified below. 37 C.F.R. § 224.1(c)(2). You may also choose to correct or edit any errors or other information in your claim before you file it again. You do not need to provide a legal argument in your claim – just a statement of facts and circumstances. Being specific in your description gives the other party and the Board more information about your claim. There is no character limit, so please be as detailed as possible.

### Proper Respondent

You are raising a claim of copyright infringement. You name two respondents, Francisco Hernandez (Hernandez) and El Centenario Mexican Grill (El Centenario). Your claim does not present any facts about Hernandez. To support an infringement claim against Hernandez, you must present more facts in an amended claim that indicate why he could be held liable for the alleged infringement, such as how he personally participated in or is responsible for the infringing activities.

Copyright law grants exclusive rights to copyright owners. These include the right to reproduce, distribute, and publicly display the work, and to make a “derivative work,” which is a work based on the original work. Someone who does one of those activities without the copyright owner’s permission may be infringing the copyright, unless they have a legitimate defense. More information about exclusive rights is available on page 3 of the [Starting an Infringement Claim](#) chapter of the CCB Handbook.

You allege that El Centenario had access to your library of Mexican restaurant stock photography as your social media management client and continued to use your photographs without permission after your business relationship ended. However, your claim does not state who Hernandez is or how he used your exclusive rights in

the allegedly infringed works without permission. For example, your claim does not state or show that he copied, distributed, or displayed your photographs, or prepared derivative work based on your photographs, which would be required to support a claim of direct infringement against him.

A copyright infringement claim may also be raised against a “secondary infringer” who does not engage in any infringing acts directly, but profits from or facilitates acts of direct infringement by others. To support a claim of secondary infringement against Hernandez, your amended claim must include additional facts about how he acted in relation to directly infringing activities by another party. In particular, a secondary infringement claim must be based on either “vicarious liability” or “contributory liability.” Your claim does not include enough facts to support either of these grounds for secondary infringement:

- A **vicarious liability** claim must state facts that indicate that the respondent had the right and the ability to supervise or control a third party’s infringing activity and received a direct financial benefit from the infringement.
- A **contributory liability** claim must state facts that indicate that the respondent knows about a third party’s infringing activity and induces, causes, or substantially contributes to that infringing conduct.

If you intend to assert a claim of secondary infringement against Hernandez, then your amended claim must include more facts that support either vicarious or contributory liability. If you want the Board to find him *vicariously liable* for another party’s use of your photographs, your amended claim must include allegations of facts showing that he was able to control or supervise the specific infringement, and that he profited directly from that use. Alternatively, if you want the Board to find Hernandez *contributorily liable* for another party’s use of your photographs, your amended claim must include allegations of fact showing that he knew, or had reason to know, that uses of the photographs would be infringing, and that he facilitated that infringing conduct by inducing, causing, or materially contributing to that use.

More information about vicarious and contributory liability is available at page 21 of the [Starting an Infringement Claim](#) chapter of the CCB Handbook.

## Relief Sought

The Board can grant only certain types of relief. If you seek damages for your infringement claim, you can seek either (1) actual damages and the profits of the infringer attributable to the infringement, or (2) statutory damages. *Actual damages* are money damages awarded based on the proven harm or loss you suffered. An example of actual damages may be the amount of lost sales revenue or licensing fees you experienced. An award can also include any additional profits the respondent made from the infringement. *Statutory damages* are money damages awarded to a successful claimant within a range set by law, without a need to provide proof of the actual amount of harm or loss.

It appears that you are seeking a larger statutory damages award than the Board can grant. In the “Description of harm suffered and relief sought” section of your claim, you state that you are seeking \$30,000 in statutory damages. The most that respondents can be ordered to pay in damages (actual or statutory) in a Board proceeding is \$30,000. 17 U.S.C. § 1504(e)(1)(D). However, the maximum amount of statutory damages available from the Board is \$15,000 per work of yours that was infringed if the infringed works were timely registered and \$7,500 per

work, and no more than \$15,000 total, if they were not timely registered. 17 U.S.C. § 1504(e)(1)(A)(ii)(II). A work is not timely registered if it was (1) unpublished and the copyright was registered after the infringement started, or (2) published and the copyright was registered after the infringement started and more than three months after the publication of the work. 17 U.S.C. § 412. More information about the available forms of relief can be found in the [Damages](#) chapter of the CCB Handbook, and on pages 6-7 of the [Starting an Infringement Claim](#) chapter.

You allege that the infringement started on September 4, 2024. You state that the Copyright Office has not yet registered your photographs, and you list the service request number of a pending application for registration. Copyright Office records show that in the application, you stated that the photographs were published in 2022. Based on those stated facts, it appears that the copyright for the photographs was not registered when the alleged infringement commenced, so your request for \$30,000 in statutory damages does not appear to be permissible.

You are not required to choose between actual or statutory damages at this point. 17 U.S.C. § 1504(e)(1)(B). You are not required to request damages at all. *Id.* § 1504(c)(1) & (e)(1)(B)(ii). If you file an amended claim, you may include a request for damages without giving a specific amount, or without stating that the damages you are seeking are actual damages or statutory damages. However, if you give a dollar figure for statutory damages, you will need to limit that request to an amount the Board can grant. Whether the photographs were published in 2022, or were unpublished when the alleged infringement began, the Board may not award you more than \$15,000 in statutory damages in this proceeding. Therefore, if you seek damages in your amended claim, you must either not specify that you seek “statutory damages,” not specify the amount you seek, or request no more than \$15,000.

### **Pending Litigation**

The Board cannot hear any “claim or counterclaim that has been finally adjudicated by a court of competent jurisdiction or that is pending before a court of competent jurisdiction, unless that court has granted a stay to permit that claim or counterclaim to proceed before the Copyright Claims Board.” 17 U.S.C. § 1504(d)(2). If your claims against the respondents are currently in litigation or have been finally determined in court, you cannot raise the same claims against them before the Board.

Materials included in your claim indicate that some aspects of the dispute may be pending in court, and that the court has not granted a stay to permit your claims to proceed before the Board. While the Board can hear a copyright infringement claim, it cannot hear a claim based in contract, which also means it cannot hear a claim amounting to an allegation that someone had permission to use your work, but failed to pay the agreed upon amount. You allege that on August 3, 2024, a representative of El Centenario signed an agreement to license the photographs for \$1,500, due within 30 days, but El Centenario did not make the agreed-upon payment, and has continued to use the photographs. In the “Description of harm suffered and relief sought” section, you state:

By the time this case will be heard, a small claims judgement should have been made for the value of the licensing agreement, but that court will lack the authority to adjudicate the harms incurred from the time payment for the infringed work was due, to the point when payment for the signed agreement will be forced by the State of Michigan.

That statement indicates that you have brought a claim in small claims court in Michigan to force the \$1,500 payment, and that your basis for recovery in court would be to enforce the agreement. This would indeed be a contract claim that the Board cannot hear. However, you seem to suggest that because El Centenario did not pay, the Board should consider the agreement unenforceable and find its continued use of the photographs infringing so that you can bring, not a contractual claim, but a copyright infringement claim before the Board. As a result, it appears that your theories of recovery in court and before the Board are in conflict. It also appears that you are seeking to recover actual damages in court for the value of a lost licensing fee, while you are seeking statutory damages in this proceeding based on the same series of acts. A copyright infringer may be held liable for either the copyright owner's actual damages and additional profits of the infringer, or statutory damages, but not both. 17 U.S.C. §§ 504(a) & 1504(e)(1)(A). The Board cannot hear this claim if, at the same time, you are pursuing overlapping or conflicting claims for relief in court.

If you file an amended claim, you must include more information about your litigation in small claims court. Identify the defendant(s) and the nature of your claim(s) in that case; provide enough facts to indicate whether those claims are based on, or seek relief for, the same allegedly wrongful acts at issue in this proceeding; and if they are, then state whether that court has granted a stay so that your claim before the Board may proceed.

To submit an amended claim, log into your eCCB account and take the following steps:

1. From your dashboard, click the “**Amend claim**” button and select your docket number from the dropdown list.
2. Your claim will unlock for editing. The information you originally entered will appear in the same order as in your original claim.
3. Make the necessary edits. If you have filed supplemental documents, you must re-upload any documents you wish to include in the amended claim on the “**Documentation**” page. Please include only documents directly related to your claim, and label them clearly.
4. Once you have completed your edits, continue to click through the fillable claim form until you reach the “**Review**” page. The Review page includes all the information that you have provided in the claim up to this point. Carefully double-check the information on this page. If you have any corrections, you can select “**Edit**” to revise any entries necessary. Each section of information has an “**Edit**” button, which will take you back to that section so you can make changes. After you make changes, you can click “**Save & review**” to return to the Review page. Please review your claim carefully. Once you submit your amended claim, you will be unable to edit the claim while it is in compliance review.
5. Once you have completed your review and any revisions, you must confirm that the information in your claim is accurate and truthful to the best of your knowledge. To complete the declaration, type your full name into the “**Digital signature**” box near the bottom of the “**Review filing**” page and click “**Agree & submit.**”

If you have questions, please contact [asktheboard@ccb.gov](mailto:asktheboard@ccb.gov). Include your docket number in the subject line. The Board is unable to provide legal advice. We can only provide legal information and assistance concerning Board procedures and requirements. If you would like to seek further guidance from a lawyer or a law student at reduced or no cost, please visit the [Pro Bono Assistance](#) page on ccb.gov. You may also refer to the [Compliance Review](#) chapter of the CCB Handbook for more assistance.

Copyright Claims Board