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## Unregistered Complaints

Christine Suzanne Davik

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## Unregistered Complaints

Christine Suzanne Davik\*

### ABSTRACT

*In March, the U.S. Supreme Court handed down its highly-anticipated decision in *Fourth Estate Public Benefit Corporation v. Wall-Street.com, LLC*, which resolved a split among U.S. Courts of Appeals concerning the point in time when a copyright owner is first able to file suit against an alleged infringer. While at first glance this case may merely appear to be a simple issue of statutory interpretation, namely whether it is upon application for registration or once a determination has been made on registration by the U.S. Copyright Office, this Article argues this decision is a clarion call for a much-needed amendment to the Copyright Act. Although the Court may have correctly construed the registration prerequisite in Section 411(a) of the Copyright Act, this Article argues that neither of the two approaches before the Court was a truly appropriate option. Alternatively, this Article proffers the requirement of infringement must be removed entirely to properly account for technological changes in the methods and speed by which copyrightable works are now created, reproduced, and distributed. This will ensure that all copyright owners are able to access the courthouse without delay, in accord with virtually every other area of law.*

*Unfortunately, as it currently stands post-Fourth Estate, most U.S. copyright owners cannot seek relief immediately upon detecting infringement of their work. Instead, they must wait months and in some cases years for the Copyright Office to complete its review, despite the existence of federal copyright protection that attaches automatically upon creation of the work. As such, the author of an unregistered work is left with a right to prevent copyright infringement but an inability to do so. Adding to the inequities of this situation is the fact that due to treaty obligations prohibiting formalities that stand in the way of enforcing one's copyright rights, owners of foreign works do not have to comply with this registration prerequisite. Instead, these owners can proceed directly to federal court to protect their works.*

*Accordingly, this Article advocates for complete removal of the registration prerequisite. In doing so, this Article stands in stark contrast to the recent scholarly trend in the field of copyright law advocating for more, not fewer,*

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\* Professor of Law, University of Maine School of Law. Many thanks to the participants at the Texas A&M University School of Law Intellectual Property Scholars Roundtable and the 2020 Works-in-Progress Intellectual Property Colloquium held at Santa University School of Law School for extremely valuable comments and conversations on earlier drafts of this piece. I am also grateful to Christine Dulac and Maureen Quinlan for their exceptional research assistance.

*formalities associated with one's copyright rights. This includes calls by many legal scholars for the "re-incentivization" of federal registration by taking away certain rights and the availability of particular defenses as a consequence for failing to seek an earlier copyright registration. While many of these proposals are an understandable reaction to the significant increase in both the breadth and depth of copyright rights over the past several decades, emphasizing registration is not an appropriate way to achieve balance in light of the numerous barriers to registration in its current form, especially for individual artists or smaller entities. Consequently, after examining the various arguments in support of and in opposition to the repeal of the registration requirement, this Article ultimately concludes that the overwhelming advantages to eliminating the Section 411(a) prerequisite outweigh any perceived or actual drawbacks.*

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## I. INTRODUCTION

On March 4, 2019, the U.S. Supreme Court handed down its decision in *Fourth Estate Public Benefit Corporation v. Wall-Street.com, LLC*.<sup>1</sup> This much-anticipated opinion resolved the split among U.S. Courts of Appeals concerning the point in time when a copyright owner is first able to file suit against an alleged infringer.<sup>2</sup> Unlike most areas of law, U.S. copyright owners cannot simply seek relief immediately upon detecting infringement of their work. Instead, copyright owners must ensure that they have first complied with a peculiarity of copyright law, namely registering the work with the U.S. Copyright Office.<sup>3</sup>

Unfortunately, the registration process can take months and in some cases years to complete,<sup>4</sup> thereby significantly delaying the ability of copyright owners to stop infringement, despite federal copyright protection existing automatically upon creation of the work.<sup>5</sup> As such, the author of an unregistered work is left with a right to prevent copyright infringement but an inability to do so.<sup>6</sup> Adding to the inequities of this situation is the fact that owners of foreign works do not have to comply with this registration prerequisite; instead, they can proceed directly to federal court to protect their work.<sup>7</sup>

This incongruent treatment is the result of changes made to the Copyright Act by Congress some thirty years ago in order to comply with the United States' foreign treaty obligations created by the decision to become a

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1. *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881 (2019).

2. *See infra* Part III.C (examining the *Fourth Estate* case in detail).

3. 17 U.S.C. § 411(a) (2018). Registration is also a prerequisite to certain remedies for infringement, namely the ability to obtain an award of statutory damages or attorney's fees. *See* § 412. The Copyright Act provides such registration must occur prior to the commencement of the infringement unless such registration is made within three months after the first publication of the work in question. *Id.* Additionally, unlike Section 411(a) which requires registration prior to filing suit only for U.S. works, Section 412 makes no such distinction and is applicable to both U.S. and foreign works. *Id.* While there are many strong arguments for repealing this prerequisite as well, the cost-benefit analysis is different. As such, the concerns associated with the continuing existence of Section 412 is beyond the scope of this article.

4. *See infra* Part IV (discussing the significant increase in average processing times of copyright applications for registration).

5. 17 U.S.C. § 102 (2018). This provision states in pertinent part as follows: "(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." *Id.*

6. *See infra* Part II.B (examining the debate concerning accession to the Berne Convention).

7. *Id.*

member of the Berne Convention (“Berne”), the premier international copyright agreement.<sup>8</sup> More specifically, Berne provides that “the enjoyment and the exercise of [copyright] shall not be subject to any formalities,” and the U.S. Copyright Act’s registration requirement found in Section 411(a) was regarded as violating this principle.<sup>9</sup> Instead of simply repealing the provision, Congress amended it to apply only to owners of U.S. works, thereby creating an unfortunate double standard.<sup>10</sup>

For years, many federal courts attempted to ameliorate the unfairness of Congress’ decision to place this additional obstacle only upon owners of U.S. works seeking protection from copyright infringement.<sup>11</sup> To accomplish this, federal courts interpreted the language “no civil action for infringement of the copyright in any United States work shall be instituted until . . . registration of the copyright claim *has been made* in accordance with this title” to be met as soon as a complete application was submitted to the U.S. Copyright Office.<sup>12</sup> The aptly named “application approach,” allowed copyright owners of U.S. works to effectively apply for federal copyright registration and file a copyright infringement lawsuit on the same day. Accordingly, federal courts adopting this approach largely equalized the ability of all copyright owners to access the federal court system, regardless of whether the work allegedly infringed was a U.S. work or a foreign work.

Nonetheless, not all federal courts subscribed to this line of reasoning.<sup>13</sup> Others held that apart from the narrowly defined categories of works exempt from Section 411(a)’s mandate, the statute was not fulfilled until the Register of Copyrights actually registered the work.<sup>14</sup> Consequently, courts following the so-called “registration approach” would not allow a copyright infringement case involving a U.S. work to proceed unless there was proof of a federal copyright registration.

The U.S. Supreme Court granted certiorari in *Fourth Estate* to ascertain when registration occurs under the Copyright Act and thereby settle the

8. *Id.*; *see also*, Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886.

9. Berne Convention for the Protection of Literary and Artistic Works, *supra* note 8.

10. *See infra* note 76 and accompanying text.

11. *See infra* Part III.A (identifying courts and cases following the “application approach”).

12. 17 U.S.C. § 411(a) (2018) (emphasis added). To constitute a “complete application,” deposit materials and the required filing fee would also need to be included with the application for federal copyright registration. *Id.*

13. *See infra* Part III.B (identifying courts and cases following the “registration approach”).

14. The exceptions to this requirement include U.S. works for which preregistration is an option or applications for federal copyright protection that have been refused registration. *See infra* Part II (analyzing these exceptions to the traditional approach).

dispute among U.S. Courts of Appeals on this issue.<sup>15</sup> Ultimately, the Court decided Section 411(a) requires more than the submission of application materials for federal copyright registration. According to the Court, “registration” does not take place until the Copyright Office has decided whether a given work is entitled to registration, thus adopting the “registration approach.”<sup>16</sup> While the Court appears to have decided this case correctly from a statutory interpretation standpoint, the result is exceptionally problematic.

The U.S. Supreme Court’s decision in *Fourth Estate* serves as a clarion call for much-needed amendments to the Copyright Act. Further, it is not enough to simply redefine “registration” to include the act of filing for a federal copyright registration. In order to properly account for technological changes in the methods and speed by which copyrightable works are now created, reproduced, and distributed, all copyright owners should be able to access the courthouse without delay. Removal of this antiquated requirement will level the proverbial playing field between U.S. works and foreign works, while also adding much needed international harmonization to an area of law that Congress has repeatedly amended in previous attempts to meet this stated objective.<sup>17</sup> Ironically, in advocating for the repeal of Section 411(a), this Article stands in contrast to the recent scholarly trend in the field of copyright law advocating for more, not fewer, formalities.<sup>18</sup>

This Article begins in Part I by reviewing relevant provisions of the Copyright Act and examining earlier, unsuccessful legislative attempts to eliminate Section 411(a)’s registration prerequisite. Next, Part II discusses the federal circuit court split leading to the Supreme Court’s decision. Additionally, this section considers the unanimous opinion issued by Justice Ruth Bader Ginsburg, including her acknowledgment that the current

15. *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 138 S. Ct. 2707 (2018).

16. *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881, 888 (2019).

17. See *infra* Part II (discussing the Copyright Act of 1976 and the Berne Implementation Act of 1989 passed in part to achieve harmony with the laws of other countries, notably).

18. See *infra* Part IV.D; see also, e.g., Amanda Reid, *Claiming the Copyright*, 34 YALE L. & POL’Y REV. 425, 427 (2016) (“One way to check and re-balance the interests of copyright holders and users is with formalities.”); Michael W. Carroll, *A Realist Approach to Copyright Law’s Formalities*, 28 BERKELEY TECH. L.J. 1511, 1513, 1516–16 (2013) (“This Article joins in the general move in favor of increased public formalities . . . [As others] have previously elaborated, formal requirements, such as publication-with-notice, registration, deposit, and renewal or maintenance, serve a variety of functions that align with copyright law’s principal economic goal of providing authors, publishers, and their investors with potential profits for culturally appealing works.”); Jane C. Ginsburg, *The U.S. Experience with Mandatory Copyright Formalities: A Love/Hate Relationship*, 33 COLUM. J.L. & ARTS 311, 312 (2010) (Examining the “current vogue for ‘reformatizing copyright’” and discussing how “formalities, long lamented in U.S. copyright commentary, have now garnered favor . . .”).

situation is “unfortunate” and “has not worked as Congress likely envisioned.”<sup>19</sup> Part III analyzes the numerous arguments in support of and in opposition to the repeal of the registration requirement. Ultimately, this Article concludes the overwhelming advantages to amending Section 411(a) outweigh any perceived or actual drawbacks.

## II. CONTINUAL CONGRESSIONAL CHANGE TO SECTION 411(A)

The Copyright Act of 1976 protects “original works of authorship fixed in any tangible medium of expression.”<sup>20</sup> The types of works covered by copyright law are exceptionally broad and include photographs, computer programs, musical compositions, and architectural works.<sup>21</sup> As mentioned above, copyright protection exists instantly upon creation of the work and automatically provides the owner with a comprehensive set of exclusive rights such as reproduction, distribution, and public performance or display.<sup>22</sup> Consequently, anyone who violates these rights is an infringer of the copyright.<sup>23</sup> Nevertheless, the Copyright Act does not allow the copyright owner to immediately enforce these rights.<sup>24</sup>

### A. *Promulgating Section 411(a) of the 1976 Copyright Act*

In connection with the enactment of the Copyright Act of 1976, Congress made several changes to earlier law concerning the ability of a copyright owner to bring suit for infringement. However, eliminating the necessity of a federal registration was not one of them. As the House Report accompanying the 1976 revisions affirmed:

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19. *Fourth Estate*, 139 S.Ct. at 892.

20. 17 U.S.C. § 102 (2018). The U.S. Constitution expressly authorizes Congress to promulgate laws in this subject area. U.S. CONST. art. I, § 8, cl. 8. Specifically, Article 1, Section 8, Clause 8 grants Congress the power to “secur[e] for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”). *Id.*

21. 17 U.S.C. § 102 (2018). The full list of protectable categories of works is as follows: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. *Id.*

22. 17 U.S.C. § 106 (2018); *see also Fourth Estate*, 139 S. Ct. at 887; *Eldred v. Ashcroft*, 537 U.S. 186, 195 (2003).

23. *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 157 (2010) (17 U.S.C. § 501(a) (2018)).

24. *See infra* note 25 and accompanying text. This stands in sharp contrast to another major form of intellectual property, namely trademark law. The Lanham Act allows owners of federal trademarks to file an infringement claim without first seeking a registration through the U.S. Patent and Trademark Office. This dichotomy is problematic as it is not uncommon for a trademark infringement suit to also include copyright claims. *See infra* Part IV.C.3 (examining this contrast in more detail).



The first sentence of Section 411(a) restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted. Under the bill, as under the law now in effect, a copyright owner who has not registered his claim can have a valid cause of action against someone who has infringed his copyright, but he cannot enforce his rights in the courts until he has made registration.<sup>25</sup>

Instead, the changes were largely limited to issues surrounding the procedures for filing a copyright infringement suit in cases where the owner of a work had attempted to register it, but the application was eventually denied by the Register of Copyrights.<sup>26</sup> Many courts interpreted the precursor to Section 411(a) as still requiring the owner to obtain the registration certificate, and this entailed bringing a mandamus action against the Registrar.<sup>27</sup> Only after this step was complete could the owner of the refused work proceed with the lawsuit.<sup>28</sup> To alleviate the continued need to follow such a convoluted practice, Section 411(a) also incorporated the following language: “[If] registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.”<sup>29</sup> Moreover, additional language was included to clarify that the presence or absence of the Register of Copyright in a particular suit would not impact the ability of the case to go forward.<sup>30</sup>

Notwithstanding Section 411(a) of the 1976 Copyright Act, many of the more progressive modifications were made with a view toward possible membership in the Berne Convention.<sup>31</sup> The Berne Convention was, and still is, regarded as the “most respected international copyright treaty.”<sup>32</sup> Berne dates from 1886 and, even prior to the United States joining, included close

25. H.R. REP. NO. 94-1476, at 157 (1976), 1976 WL 14045.

26. *Reed Elsevier*, 559 U.S. at 164; *Fourth Estate*, 139 S. Ct. at 890.

27. *See e.g.*, *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 640–41 (2d Cir. 1958).

28. *Id.*

29. 17 U.S.C. § 411(a) (2018).

30. *Id.* Accordingly, the last line of Section 411(a) now includes the following language: “The Register may, at his or her option, become a party to the action with respect to the issue of registrability within sixty days after such service, but the Register’s failure to become a party shall not deprive the court of jurisdiction to determine that issue.” *Id.*

31. H.R. REP. NO. 100-609, at 21 (1988) (“It can safely be stated that Congress drafted and passed the 1976 Act with a “weather eye” on Berne.”); *see also Hearings on Berne Convention Implementation Act of 1987, Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary*, 100th Cong., 664-87 (1988) [hereinafter *House Berne Hearings*] (statement of Paul L. Goldstein, Professor, Stanford Law School).

32. *See e.g.*, H.R. REP. NO. 100-609, at 11 (1988).

to 100 members.<sup>33</sup> The signatories represented an exceptionally diverse grouping of countries with the United States notably absent.<sup>34</sup> As the Director General of the World Intellectual Property Organization, the global organization that administers the Convention, stated in 1986 on the occasion of the treaty's 100<sup>th</sup> Anniversary, "the absence of the United States of America from the Berne Union has, from the very beginning, been considered as regrettable . . . For the continued strength and further development of the Berne Union, United States membership would be of great significance."<sup>35</sup>

The objective "of the Berne Union [is the] development of 'effective and harmonious' copyright laws among all nations."<sup>36</sup> In order to achieve these goals, Berne requires its members' domestic copyright laws to meet prescribed minimum levels of protection and prohibits most formalities. The Berne Convention defines a "formality" as the imposition of a governmental precondition for the "enjoyment [or] exercise" of a copyright owner's rights.<sup>37</sup> Many formalities were viewed as problematic because they created barriers to obtaining copyright protection or resulted in the inadvertent loss of protection. Even though numerous changes were made to copyright law in connection with the passage of the 1976 Act, some formalities nevertheless remained.<sup>38</sup> Areas of potential non-compliance included the requirement of copyright

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33. Berne Convention for the Protection of Literary and Artistic Works, *supra* note 8. The Convention has been revised seven times since it was originally concluded. *Id.* This includes Paris (1896), Berlin (1908), Berne (1914), Rome (1928), Brussels (1948), Stockholm (1967), and the current version Paris (1971). *Id.*

34. S. REP. NO. 100-352, at 2 (1988). The actual number was 77 members and included "most of the free market countries, a number of developing nations, and several nations of the Eastern Bloc." *Id.*

35. Arpad Bogsch, *The First Hundred Years of the Berne Convention for the Protection of Literary and Artistic Works*, 22 COPYRIGHT: MONTHLY REVIEW OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION 291, 298-99 (1986) [https://www.wipo.int/edocs/pubdocs/en/copyright/120/wipo\\_pub\\_120\\_1986\\_09.pdf](https://www.wipo.int/edocs/pubdocs/en/copyright/120/wipo_pub_120_1986_09.pdf) [perma.cc/28ET-YFRT]

36. H.R. REP. NO. 100-609, at 20 (1988).

37. S. REP. NO. 100-352, at 12 (1988), *citing* Berne Convention for the Protection of Literary and Artistic Works, *supra* note 8, at art. 5(2).

38. There were varying degrees of disagreement between experts and the reports of both the House and Senate concerning the extent to which U.S. law still needed to be altered for Berne membership. *See e.g.*, H.R. REP. NO. 100-609, at 40 (1988) ("The Committee received conflicting testimony about the nature of the prohibited formalities."). This divergence of opinion is reflected in the many different hearings and eventual bills introduced in Congress attempting to potentially reconcile U.S. law with the requirements of the Berne Convention. *See e.g.*, Berne Convention Implementation Act of 1986, S. 2904, 99th Cong. (1986); Berne Convention Implementation Act of 1988, S. 1301, 100th Cong. (1988); Berne Convention Implementation Act of 1987, S. 1971, 100th Cong. (1987); Berne Implementation Act of 1988, H.R. 4262, 100th Cong. (1988) (enacted as Pub. L. No. 100-568). In comparison to some of the other implementation bills, H.R. 4262 took a "minimalist" approach while S. 1301 proposed quite substantial revisions.

notice<sup>39</sup> and, most relevant to this Article, the necessity of federally registering one's copyright before bringing a legal action for infringement of the work.

### *B. Berne Convention Implementation Act of 1988*

Despite more than a century of intransigence, it became increasingly clear that the benefits of U.S. membership in the Berne Convention outweighed the purported onus of compliance.<sup>40</sup> This was due in large part to the increasing importance of intellectual property to the U.S. economy.<sup>41</sup> In the mid-to-late 1980s, the United States was experiencing substantial trade deficits in most categories of goods and services.<sup>42</sup> However, this was not the case with regard to copyrighted works, as the United States had become the world's largest exporter of such materials.<sup>43</sup> In fact, this sector of the economy was generating a trade surplus of more than one billion dollars.<sup>44</sup> Nonetheless, around the same time, the U.S. International Trade Commission estimated American companies were losing approximately fifty billion dollars per year due to global piracy.<sup>45</sup> Such losses were the result of advances in technology that made it easier to copy and disseminate copyrighted works, but also arguably caused by "inadequate legal protection for United States intellectual property around the world."<sup>46</sup>

Yet the United States did not have much leverage to request improvements in the copyright laws of other nations as historically the United States had been incredibly reluctant to amend its own provisions to simply remove its remaining formalities. Accordingly, the "American negotiating position [was] placed at a disadvantage with regard to improved copyright protection in foreign countries" because the "United States neither belongs to the Berne Union nor has a copyright law that would allow us to join."<sup>47</sup> As the House Report detailed:

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39. The requirement of copyright notice was previously one of the biggest barriers to the United States membership in Berne. *See* S. REP. NO. 100-352, at 12 (1988). As the Senate Report aptly stated: "The requirement that a work bear some sort of a notice of copyright in order to obtain or maintain copyright protection has been a feature of every U.S. copyright law since the original Copyright Act of 1790." *Id.* Additionally, the Committee agreed with the Register of Copyright regarding the need to eliminate this provision, noting "the same conclusion has been reached by virtually every witness and commentator who has addressed the [Section 401 et seq.] notice provisions of current U.S. copyright law." *Id.* At 13.

40. *Id.* at 14–15

41. *Id.* at 15.

42. *Id.* at 2.

43. *Id.*

44. In 1987, the surplus was more than 1.5 million dollars. *Id.*

45. *Id.*

46. *Id.*

47. H.R. REP. NO. 100-609, at 18 (1988).

In bilateral negotiations, foreign countries often point to the perceived deficiencies in U.S. protection, creating an excuse to avoid making improvements to their own laws. By way of illustration, in bilateral negotiations with Singapore and Korea, the American negotiators were repeatedly asked the difficult question of why the United States was pushing so hard for strong copyright protection in these countries while we did not adhere to the Berne Convention.<sup>48</sup>

Adding to the impetus for change at the time, the United States had successfully lobbied to include intellectual property as one of the topics of negotiation in connection with the General Agreement on Tariffs and Trade (“GATT”), a multilateral trade agreement focused on removing barriers to international trade.<sup>49</sup> Differences in the protection of intellectual property were increasingly seen as creating barriers to trade, and there was a growing recognition of the need for harmonization in this area of the law.<sup>50</sup> As one commentator aptly stated: “No major trading nation in today’s world can enjoy the indulgence of having intellectual property laws significantly different from those of the world community. In one sense, unusual intellectual property laws are a tariff and an unnatural barrier to world trade.”<sup>51</sup>

Consequently, between 1985 and 1988, both the Senate and House of Representatives conducted numerous hearings on the possibility of U.S. adherence to the Berne Convention.<sup>52</sup> Ultimately, this resulted in two very different bills originating from each chamber in 1988. While the House version of the Berne Convention Implementation Act of 1988 utilized a “minimalist approach,” the Senate included more comprehensive amendments to the current copyright law.<sup>53</sup>

The U.S. House Committee on the Judiciary’s report accompanying its bill, H.R. 4262, provided that the objectives of the legislation were to amend

the Copyright Act only where there is a clear conflict with the express provisions of the Berne Convention (Paris Act of 1971); and further, to amend only insofar as it is necessary to resolve the conflict in a manner compatible with the public interest, respecting the pre-existing balance of rights and limitations in the Copyright Act as a whole.<sup>54</sup>

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48. *Id.*

49. *Id.* at 19. Specifically, it was placed on the agenda of the Uruguay Round Negotiations. *Id.*

50. J. Thomas McCarthy, *Intellectual Property – America’s Overlooked Export*, 20 U. DAYTON L. REV. 809, 811–13 (1995).

51. *Id.* at 816.

52. *See* S. REP. NO. 100-352, at 5-6 (1988); H.R. REP. NO. 100-609, at 7–10 (1988).

53. *See* H.R. REP. NO. 100-609, at 7; S. REP. NO. 100-352.

54. H.R. REP. NO. 100-609, at 20.

As such, the changes originally proposed by the House bill were quite limited<sup>55</sup> and did not include any amendments to the registration prerequisite of Section 411(a). Although the House Report acknowledged that there were “divergent views” on whether the “requirement that claimants seek registration before copyright infringement suits,” was compatible with Berne, the [House Judiciary] Committee ultimately decided the precondition was merely “procedural in nature and does not in any sense lead to a ‘loss of copyright.’”<sup>56</sup> Additionally, the Committee questionably claimed this determination was strengthened by the fact that other Berne Convention countries “maintain registration systems” and “have procedural requirements for bringing copyright infringement actions: papers must be served and filed, documents must be produced, court costs and litigation costs must be paid.”<sup>57</sup> While it is difficult to liken registration as a prerequisite to the filing of a lawsuit with an obligation to provide service of process or the mere presence of an optional copyright registry, the House Judiciary Committee initially took this position in its report.<sup>58</sup> Even so, the Committee “considered the contention that other countries might retaliate against the United States” if changes were not made to Section 411(a) after joining Berne but in the end, decided “these concerns are probably not well-founded and are certainly speculative.”<sup>59</sup> Nonetheless, the House eventually relented on this issue, agreeing to change this portion of the proposed legislation to avoid a conflict with the Berne Convention’s prohibition on formalities.<sup>60</sup>

The report from the Senate Committee on the Judiciary analyzed the issues associated with Section 411(a) much differently, and accordingly, it recommended significant amendments to the language of the provision.<sup>61</sup> From the perspective of the Senate Judiciary Committee, “[t]he failure to register a claim of copyright in a work has profound consequences for the ability of an author or other copyright claimant to enforce his or her claim to

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55. *Id.* at 25–27, 38, 50. These changes included: amending the compulsory jukebox licensing system (“Section 8 of the bill proposes changes to the current jukebox compulsory license by creating a new licensing system based on negotiations with the compulsory license used as a fall-back should negotiations fail.”), removing the requirement of notice (“The amendments to sections 401 and 402 make use of the copyright notice voluntary – a work will no longer fall into the public domain at any time because it is published without notice.”), and rejecting the call to expand protection for architectural works (The Subcommittee “decided to scale back the extent of the amendments” and left current law providing for protection on architectural plans but not the building itself intact) or moral rights (“[T]he Committee finds that current United States law meets the requirements of the Berne Convention.”). *Id.*

56. *Id.* at 41.

57. *Id.* at 42–43. See Section IV *infra* for further evaluation of this determination.

58. H.R. REP. NO. 100-609, at 41.

59. *Id.* at 43.

60. *Infra* note 204.

61. S. REP. NO. 100-352, at 64–65.

copyright.”<sup>62</sup> While the Senate report recognized the author of an unregistered work technically has a copyright in the work, practically speaking the “‘enjoyment and exercise’ of that copyright is severely limited, or perhaps non-existent, if [the author] is barred access to the only forum in which [he or she] may seek to prevent, or to be compensated for, unauthorized reproductions or other infringements of the work.”<sup>63</sup> The result was the author of an unregistered work has at most “a right without a remedy.”<sup>64</sup> The report also highlighted the fact that no other “major player in the Berne system . . . requires registration as a condition of judicial enforcement of copyright.”<sup>65</sup> Additionally, no such requirement is “found in the copyright systems of those Berne members, such as the United Kingdom and other Commonwealth countries, whose legal systems, like ours, derive from the common law.”<sup>66</sup>

Unlike the House Committee, the Senate was concerned about the negative impact this could have on international copyright protection if no changes were made to Section 411(a).<sup>67</sup> As the report elucidated, “[i]f the world’s largest exporter of copyrighted goods takes the position that a government agency may, without violating Berne standards, be entrusted with the keys to the courthouse door in infringement actions, other countries may seize upon this precedent to impose truly onerous and unjustified prerequisites to copyright enforcement in their legal systems.”<sup>68</sup> The Senate Committee also disagreed with the House Committee’s position that the prospect of retaliation was purely speculative, instead viewing it as a genuine risk of retaining Section 411(a) in its current form.<sup>69</sup> Additionally, the report cautioned:

This . . . would undermine the advantages for enhanced trade in copyrighted works that would otherwise flow from adherence to Berne. The burden lifted from the shoulders of our trade negotiators by U.S. adherence to Berne would be replaced by another difficult addition to the agenda of our bilateral discussions on copyright policy.<sup>70</sup>

Not surprisingly, the Senate’s version of the Berne Convention Implementation Act of 1988 would have replaced Section 411(a) with the

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62. *Id.* at 13.

63. *Id.* at 16.

64. *Id.*

65. *Id.* at 18.

66. *Id.*

67. *Id.* at 18–20.

68. *Id.* at 17.

69. *Id.* at 18.

70. *Id.*

following language: “Registration is not a prerequisite to the institution of a civil action for infringement of a copyright.”<sup>71</sup>

Ultimately, the House and Senate compromised by seizing upon an exception to the treaty’s prohibition on formalities.<sup>72</sup> While the Berne Convention forbids member states from imposing preconditions that impinge on the ability to “enjoy and exercise” copyright rights, this bar only applies to foreign works.<sup>73</sup> Therefore, the United States would technically be free to require compliance with additional obligations for domestic works.<sup>74</sup> The end result was an amendment to Section 411(a) that read as follows: “[N]o civil action for infringement of the copyright in any United States work shall be instituted until registration of the copyright claim has been made in accordance with this title.”<sup>75</sup> Accordingly, this created an unfortunate double standard concerning access to the courts dependent upon where the work was first published.<sup>76</sup> While owners of foreign works could now immediately file a copyright infringement suit in the United States, owners of domestic works could not because the exemption to the registration requirement was not universally applicable. The arguable unfairness of the situation did not go unnoticed.<sup>77</sup>

### C. Copyright Reform Act of 1993

In 1993, bills were introduced concurrently in both chambers of Congress to repeal Section 411(a) and thereby rectify the imbalance between the handling of domestic and foreign works under the statute.<sup>78</sup> As the sponsor of the Senate bill stated, “Congress created a two-tier system that continued to impose [the registration] requirement on American authors, but exempted foreign authors. So we in effect, decided to discriminate against American authors, and we continue to do so.”<sup>79</sup> Additionally, the sponsor of the House bill remarked that “While the two-tier approach permitted adherence to the Berne Convention, it has resulted in U.S. authors being less favorably treated

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71. *Id.* at 36. As reflected in the House Report, there was an “overwhelming consensus” that the then current balance of rights in the Copyright Act reflected “deeply felt legal, economic and social values . . .” notwithstanding the benefits of international harmony. H.R. REP. NO. 100-609, at 20 (1988).

72. S. REP. NO. 100-352, at 16; H.R. REP. NO. 100-609, at 40.

73. S. REP. NO. 100-352, at 18–19.

74. *Id.*

75. 17 U.S.C. § 411(a) (2018).

76. *Id.*

77. *Id.*

78. H.R. 897, 103d Cong. (1993); S. 373, 103d Cong. (1993).

79. *Copyright Reform Act of 1993: Hearing on S. 373 Before the Subcomm. on Patents, Copyright and Trademarks of the Senate*, 103d Cong. 2-3 (1993) [hereinafter *Hearing on Copyright Reform Act*] (statement of Senator Dennis DeConcini).

than foreign authors. With Berne adherence behind us, it is time to rethink the two-tier approach.”<sup>80</sup>

In connection with Congressional hearings on the bills, numerous creators testified to the challenges and negative impacts associated with the registration precondition in place for U.S. works.<sup>81</sup> Authors and photographers explained the practical impossibility of registering all of one’s artistic outputs due to the sheer volume of works produced and attendant costs.<sup>82</sup> As one author stated, “[t]o register every copyright is an impossibility for the fertile and prolific creator. [Many] cannot afford the burden of registering every one of their poems, essays, stories, photographs, sketches.”<sup>83</sup> This was especially problematic for professional photographers, who often produce thousands of photos each month,<sup>84</sup> and large photographic studio chains, which can generate almost half a million during the same time period.<sup>85</sup> Somewhat relatedly, many individuals also testified to the fact that creative types frequently do not have the time to devote to completing copyright registration forms or are simply unaware of the necessity of copyright registration and its importance to protecting their works.<sup>86</sup>

Additionally, in some creative industries, infringement may even occur prior to the authorized commercial release of the work. This is due to the fact that “works intended for publication usually are not registered until they are in final form and are being disseminated to the public.”<sup>87</sup> For example, some companies are often not able to immediately register the works due to testing

80. 139 CONG. REC. E33701 (daily ed. Feb. 16, 1993) (statement of Rep. Hughes).

81. See *Hearing on Copyright Reform Act*, *supra* note 79.

82. *Id.*

83. *Id.* at 48 (testimony of Erica Jong).

84. *Id.* at 161 (submission of Jim Marie of Purple Mesa Productions) (“Like many professional photographers, I produce thousands of individual images each year, to be more specific I produced 1,436 images in the last 30 days! Time constraints, limited staff (I am the chief cook and bottle washer in my business) and complicated forms make registration of each photograph a virtual impossibility.”).

85. *Id.* at 180–81 (statement of Olan Mills, II, Chairman of the Board, Olan Mills, Inc.: “Our lawyers tell us that the prior registration requirements have greatly complicated that enforcement effort. So, you might ask, why don’t we register? Simply stated, advance registration would be an enormous burden. We do not know what photographs will be infringed, so we would need to register each and every photograph. As I said before, we have 900 studios. In total, our company produces well over 100,000 photographs per week.”).

86. *Id.* at 48 (testimony of Erica Jong) (“Most do not even know about the requirements of registration as a precondition for meaningful enforcement”); *Id.* at 132 (testimony of Enid Greene Waldholtz, Corporate Counsel, Novell, Inc.) (“[T]his is something that’s magnified greatly in the smaller companies who don’t have the resources or the knowledge of the copyright registration requirements to protect themselves.”).

87. Preregistration of Certain Unpublished Copyright Claims, 70 Fed. Reg. 42, 286 (2005) (to be codified at 36 C.F.R. Part § 202); see also H.R. REP. NO. 109-33, at 4 (2005).



and adjustments that must occur prior to the release of a new product. As the corporate counsel of one such entity explained:

[In] the software industry, the pressures of getting your product to market are such that we don't always get our registration on file by the time we roll out the product. We are still making changes to the product at the last possible moment before reproduction for sale . . . . Another software company, very prominent in the industry, had to file suit recently to combat piracy of one of their beta releases. And so it is not unusual for even the largest software companies to not have registered their products at the time it is rolled out.<sup>88</sup>

Consequently, the delay between discovering an infringement and procuring the obligatory registration can result in the loss of thousands of dollars in potential sales.<sup>89</sup>

Ultimately, despite the many persuasive arguments concerning the harms associated with the registration prerequisite, the legislation was never enacted. While the House version of the bill passed twice, the Senate's companion bill never made it to the floor.<sup>90</sup> However, more than a decade later, the problems of pre-release infringement and its connection to Section 411(a) would once again be examined by Congress.

#### D. *Family Entertainment and Copyright Act of 2005*

In 2005, copyright owners from the entertainment industry succeeded in convincing Congress that the current law needed to be amended as “the existing rules making copyright registration a prerequisite for suit for infringement of United States works . . . [were] unduly burdensome on plaintiffs seeking relief against pre-release infringement in civil suits for copyright.”<sup>91</sup> Instead of completely removing the requirement of registration under Section 411(a), the legislative history makes clear the Family Entertainment and Copyright Act of 2005 (“FECA”) was a response to a specific type of pre-registration infringement, namely the “illicit camcording” of motion pictures.<sup>92</sup> The Senate Report accompanying the legislation described the typical acts associated with such illegal recordings as follows:

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88. *Hearing on Copyright Reform Act*, *supra* note 79, at 132 (testimony of Enid Greene Waldholtz, Corporate Counsel, Novell, Inc.).

89. *Id.* (“We lost thousands of dollars in potential sales to software pirates just in the interim between the time we found the infringement and the time we got *expedited* registration.”) (emphasis added). *See infra* Section IV.C.1 (discussing the monetary costs associated with the expedited registration process and how it is not a solution to the delays attendant in the current system).

90. 5 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 17:80 (rev. ed. 2018).

91. Preregistration of Certain Unpublished Copyright Claims, *supra* note 87.

92. *See* H.R. REP. NO. 109-33, at 2 (2005).

[A]n offender attends a pre-opening “screening” or a first-weekend theatrical release, and uses sophisticated digital equipment to record the movie. A camcorder version is then sold to a local production factory or to an overseas producer where it is converted into DVDs or similar products and sold on the street for a few dollars per copy . . . . Causing greater financial harm, these camcorder versions are posted on the Internet through certain peer-to-peer networks and made available for millions of users to download.<sup>93</sup>

Such infringements purportedly resulted in a significant loss for the Motion Picture Association of America (“MPAA”), as studies found these “camcorder versions of movies in theatrical release account[ed] for more than 90 percent of the first copies of motion pictures illegally distributed on the Internet.”<sup>94</sup> In order to remedy the situation, FECA directed the Register of Copyright to issue regulations in order to create a process by which works could be “preregistered.”<sup>95</sup> However, such preregistration would merely serve “as a place-holder for limited purposes, mainly when a copyright owner needs to sue for infringement while a work is still being prepared for commercial release.”<sup>96</sup> The statute also expressly restricted preregistration to those categories of copyrightable works that had historically been infringed prior to their authorized commercial distribution.<sup>97</sup>

Ultimately, the Register of Copyrights determined the following classes of works were eligible for preregistration<sup>98</sup>: (1) motion pictures; (2) sound

93. *Id.*

94. *Id.*

95. 17 U.S.C. § 408(f) (2018).

96. U.S. COPYRIGHT OFFICE, *Preregistration Information*, <http://www.copyright.gov/prereg/help.html> [perma.cc/4UG3-77UZ] (last accessed April 12, 2020).

97. *Id.*

98. It is also worth mentioning the other category of copyrighted works that had previously been granted special treatment with regard to the necessity of registration prior to an infringement suit. At the time the Copyright Act of 1976 was originally passed, Congress carved out a small exception to the registration prerequisite for broadcasts that were being transmitted live. S. REP. NO. 100-352, at 46. Very little is said about this provision in the legislative history aside from the fact that it “is intended to deal with the special situation presented by works that are being transmitted ‘live’ at the same time they are being fixed in tangible form for the first time.” H.R. REP. NO. 105-25, at 157 (1997); *see also* 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 7.16 (Matthew Bender ed., rev. ed. 2018) [hereinafter NIMMER & NIMMER] (describing the exception as “[t]his strange provision”). Such works did not require prior registration in order to bring an infringement action, but instead a suit could be brought even before the work’s first fixation. 17 U.S.C. § 411(b) (2018); *see also* NIMMER & NIMMER § 7.16. However, the statute expressly provided that in order to be eligible to utilize this exception, owners of such works were also required to serve notice upon the infringer not less than ten days before such fixation, identify the work along with the specific time and source of its first transmission, and declare an intention to secure copyright in the work. 17 U.S.C. § 411(b) (2018). Additionally, the copyright owner was required to register the work within three

recordings; (3) musical compositions; (4) literary works being prepared for publication in book form; (5) computer programs (including videogames); and (6) advertising or marketing photographs.<sup>99</sup> Additionally, the regulations stipulate a copyrighted work must also be unpublished and be in the process of becoming prepared for commercial distribution.<sup>100</sup> Moreover, as the Copyright Office has made clear, “[p]registration is not a substitute for registration,”<sup>101</sup> and therefore, the work must ultimately be registered the earlier of three months after the first publication of the work or one month after the copyright owner has learned of the infringement.<sup>102</sup> If the owner of a preregistered work fails to register the work during the required time frame, a court must dismiss an action for copyright infringement that occurred before or within the first two months after first publication.<sup>103</sup>

While FECA provided some relief from the registration prerequisite under Section 411(a), it was quite limited. As only certain categories of works in very specific contexts were able to utilize the new preregistration process, the vast majority of copyrighted works created in the United States were still subject to the traditional rule mandating registration prior to bringing an infringement suit.<sup>104</sup> However, courts were increasingly attempting to mitigate the harshness of this statutory requirement through a combination of various statutory interpretations and public policy arguments. Ultimately, the U.S. Supreme Court weighed in on these practices and resolved the split among U.S. Courts of Appeals.

### III. CONFLICTING JUDICIAL OPINIONS

Prior to 2010, courts often classified the registration requirement under Section 411(a) as jurisdictional in nature.<sup>105</sup> In fact, approximately 200

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months after its first transmission. *Id.* In 1997, a technical amendment was made to this provision, changing the time frame for the service of notice upon the potential infringer from 10 days to “not less than 48 hours.” H.R. 672, 105th Cong. (1997). According to the legislative history, this modification was necessary because the “provision has proven problematic when applied to a number of sporting events, especially elimination play-offs. In many instances the teams and the times of the games are not known 10 days in advance. Therefore, this notice provision is amended to provide for notice of not less than 48 hours.” H.R. REP. NO. 105-25, at 16 (1997); NIMMER & NIMMER, § 7.16. Eventually, this provision was recodified as 17 U.S.C. § 411(c) due to a later amendment. *See* NIMMER & NIMMER § 7.16.

99. Preregistration of Copyrights, 37 C.F.R. § 202.16 (2018).

100. *Id.*

101. U.S. COPYRIGHT OFFICE, *supra* note 96.

102. Family Entertainment and Copyright Act of 2005, U.S.C. § 408(f) (2019).

103. U.S. COPYRIGHT OFFICE, *supra* note 96.

104. Preregistration of Copyrights, 37 U.S.C. § 202.16 (2018).

105. *See, e.g.,* Stuart Weitzman, LLC v. Microcomputer Resources, Inc., 542 F.3d 859, 863 (11th Cir. 2008) (“Normally, of course, the district court would certainly have subject matter jurisdiction over a copyright infringement claim. However, the Copyright Act makes clear that ‘no action for infringement of the copyright in any

decisions had regarded it as such.<sup>106</sup> However, in *Reed Elsevier, Inc. v. Muchnick*, the U.S. Supreme Court held Section 411(a) did not restrict a federal court's subject matter jurisdiction.<sup>107</sup> While recognizing the provision had historically been treated as "jurisdictional" and was therefore a factor in the analysis, the Court held this characterization was not dispositive.<sup>108</sup> Instead, the Court determined the provision was merely imposing "a type of precondition to suit that supports nonjurisdictional treatment under our precedents."<sup>109</sup> The Court supported its position by explaining that Section 411(a) is not clearly labeled as jurisdictional, is not located in a jurisdiction-granting provision, and contains numerous congressionally authorized exceptions such as its inapplicability to non-U.S. works.<sup>110</sup> The concurrence further emphasized that earlier decisions characterizing registration as jurisdictional should be accorded "no precedential effect" as none of them were "from this Court, and most are 'drive-by jurisdictional rulings.'"<sup>111</sup>

*Reed's* definitive characterization of Section 411(a)'s registration prerequisite as nonjurisdictional, along with the concurrence questioning the value of prior caselaw related to this provision, brought the developing split among the federal courts into sharper focus. Both before and after *Reed*, there were two conflicting interpretations of Section 411(a)'s registration requirement in the circuit courts.<sup>112</sup> Some courts began to interpret the requirement of registration under Section 411(a) as fulfilled once a complete

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United States work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title.' 17 U.S.C. § 411(a) (noting also that an infringement action may be brought if application for a copyright has been made and denied). 'The consensus among federal appellate courts is that the provisions of 17 U.S.C. § 411(a) are jurisdictional.'").

106. *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 173–74 (2010) (Ginsburg, J., concurring) (citing Brief for Court-Appointed Amicus Curiae in Support of Judgment Below at 38, *Reed Elsevier, Inc.*, 559 U.S. 154 (No. 08-103)).

107. *Reed Elsevier, Inc.*, 559 U.S. at 157.

108. *Id.* at 169.

109. *Id.* at 166.

110. *Id.* at 165. *See supra* Section II.B for a discussion regarding Congress' removal of non-US works from the registration precondition under Section 411(a) as part of the changes necessary for the United States to become a member of the Berne Convention. Additionally, the Court made passing reference to the special treatment of live broadcasts under Section 411(c). *See also supra* note 98 (explaining this limited exception).

111. *Reed Elsevier, Inc.*, 559 U.S. at 173–174 (Ginsburg, J., concurring); *see also* NIMMER & NIMMER, *supra* note 98, § 7.16(B)(2)(c).

112. *See* *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 615 (9th Cir. 2010) (attributing the names for these two approaches to the Tenth Circuit in *La Resolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005)) *abrogated by* *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881 (2019).

application<sup>113</sup> for registration was filed with the Copyright Office – this became known as the “application approach.”<sup>114</sup> Such a reading of the statute was further bolstered by the removal of jurisdiction from the analysis post-*Reed*. Other courts maintained the prerequisite was only satisfied once the Copyright Office acted upon an application and either approved or rejected

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113. In order to constitute a complete application, the application itself, the filing fee, and any necessary deposit materials would need to be submitted. *See* 17 U.S.C. § 408 (“Copyright registration in general”).

114. *See, e.g., Cosmetic Ideas*, 606 F.3d at 619–21 (holding the application approach is the proper interpretation); *Penpower Tech., Ltd. v. S.P.C. Tech.*, 627 F. Supp. 2d 1083, 1091 (N.D. Ca. 2008) (“The Court is convinced that the plain language of § 411 permits a plaintiff to initiate a copyright infringement claim before the actual issuance of a registration certificate.”); *Action Tapes, Inc. v. Mattson*, 462 F.3d 1010, 1013 (8th Cir. 2006) (“A copyright in a work ‘subsists from its creation.’ However, the copyright owner may not sue for infringement under the federal Copyright Act until the owner has delivered the deposit, application, and fee required for registration to the United States Copyright Office.”) (citations omitted); *Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 365 (5th Cir. 2004) (“Although some circuits require that a plaintiff actually obtain a certificate from the Copyright Office before bringing suit, the Fifth Circuit requires only that the Copyright Office actually receive the application, deposit, and fee before a plaintiff files an infringement action”); *Chi. Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003) (“Although a copyright no longer need be registered with the Copyright Office to be valid, an application for registration must be filed before the copyright can be sued upon”); *Geoscan, Inc. of Tex. v. Geotrace Techs., Inc.*, 226 F.3d 387, 393 (5th Cir. 2000) (“[A] plaintiff has complied with all statutory formalities for copyright registration when the Copyright office receives the plaintiff’s application for registration, fee, and deposit.”); *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386–87 (5th Cir. 1984) (holding only the “payment of the required fee, deposit of the work in question, and receipt by the Copyright Office of a registration application” is necessary to bring suit); *Lakedreams v. Taylor*, 932 F.2d 1103, 1108 (5th Cir. 1991) (“A plaintiff has complied with the statutory formalities when the Copyright Office receives the plaintiff’s application for registration, fee and deposit”); *Caner v. Autry*, 16 F. Supp. 3d 689, 708 (W.D. Va. 2014) (“[T]he Application Approach represents a better reading of the provisions of the Copyright Act at issue, and . . . it better effectuates the policies Congress meant to promote through that Act.”); *Phx. Renovation Corp. v. Rodriguez*, 403 F. Supp. 2d 510, 515 (E.D. Va. 2005) (“[A] complaint alleging that the copyright holder properly applied for registration with the Copyright Office is sufficient to satisfy the precondition to an infringement action.”); *Int’l Kitchen Exhaust Cleaning Ass’n v. Power Washers of N. Am.*, 81 F. Supp. 2d 70, 72 (D.D.C. 2000) (“Having considered Power Washers’ motion, Kitchen Exhaust’s opposition thereto, and the record of this case, the court concludes that Kitchen Exhaust’s attempts at registration before filing suit were adequate under the Copyright Act . . .”); *see also, Gable-Leigh v. N. Am. Miss*, No. 01-1019, 2001 U.S. Dist. LEXIS 25614, 2001 WL 521695, at \*4 (C.D. Cal. April 13, 2001).

it.<sup>115</sup> This was referred to as the so-called “registration approach.”<sup>116</sup> Ultimately, in March 2019, the Supreme Court revisited Section 411(a) in order to resolve this split in *Fourth Estate*.<sup>117</sup> In the meantime, as one court rightly stated, “[c]opious judicial ink has been spilled over the proper prerequisites for bringing a copyright suit in federal court.”<sup>118</sup>

### A. The “Application Approach”

Courts adopting the application approach, as well as the leading treatise on Copyright Law,<sup>119</sup> claimed that it better comported with the language of various statutory provisions in the Copyright Act, effectively addressed a number of policy concerns, and reflected Congress’ overall purpose in passing the 1976 Act, namely providing broad copyright protection.<sup>120</sup> Examining the statutory language of Section 411(a) first, courts often viewed the following language as supporting their position:

In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute an action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.<sup>121</sup>

Since the Copyright Act allows a copyright owner to file an infringement action regardless of whether the Register of Copyrights ultimately determines the work is entitled to registration or alternatively is rejected, adherents to this

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115. See *supra* Section II.A. (discussing the change to copyright law that made it clear copyright owners could proceed with a copyright infringement lawsuit even if the Register of Copyrights determined the work in question was not copyrightable after evaluating an application for registration).

116. *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1340 (11th Cir. 2017), *aff’d*, 139 S. Ct. 881 (2019); *La Resolana*, 416 F.3d at 1208 (“A suit for copyright infringement cannot be brought unless and until the copyright is registered.”); *Patrick Collins, Inc. v. Does 1-26*, 843 F. Supp. 2d 565, 568 (E.D. Pa. 2011) (“Under 17 U.S.C. § 411(a), absent certain circumstances not applicable here, one cannot bring a copyright infringement action until the copyright is registered.”); *Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc.*, 315 F. Supp. 2d 1053, 1055 (C.D. Cal. 2004) (“[T]he plain language of the Copyright Act unambiguously mandates the actual issuance of a registration certificate before a copyright action is brought . . .”).

117. 139 S. Ct. 881, 887 (2019).

118. *Caner*, 16 F. Supp. 3d at 705.

119. NIMMER & NIMMER, *supra* note 98, § 7.16(B)(3)(b)(ii).

120. *Caner*, 16 F. Supp. 3d at 708; *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 619 (9th Cir. 2010), *abrogated by* *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881 (2019).

121. 17 U.S.C. § 411(a) (2018).

approach argued it was logical to conclude the application to register is sufficient to fulfill the precondition to filing an infringement action.<sup>122</sup>

Many of the courts adhering to this interpretation of the Copyright Act also pointed to Section 410(d) to reinforce their conclusion. Section 410(d) states: “The effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.”<sup>123</sup> As this subsection provides for a later approved registration to be back-dated to the original date of application,<sup>124</sup> courts held this lent additional strength to the argument that “registration” occurs on the day the application is actually received by the Copyright Office.<sup>125</sup>

Likewise, Section 408(a) can also be read to provide further credence to the argument that “registration” requires only submission of a completed application. This provision of the Copyright Act states: “[T]he owner of a copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708.”<sup>126</sup> Impliedly, the “sole requirement for obtaining registration is delivery of the appropriate documents and fee.”<sup>127</sup> Additionally, courts relied on the last portion of Section 408(a), which stipulates “registration is not a condition of copyright protection” to further strengthen their argument.<sup>128</sup>

Aside from the statutory language, proponents of the application approach argued it “most efficaciously facilitates the judicial protection of copyrights through infringement actions.”<sup>129</sup> Courts were concerned about

122. *Prunte v. Universal Music Group*, 484 F. Supp. 2d 32, 40 (D.D.C. 2007) (citing *NIMMER & NIMMER*, *supra* note 98, at § 7.16(B)(1)(a)(i)); *see also Cosmetic Ideas*, 606 F.3d at 621.

123. 17 U.S.C. § 410(d) (2018).

124. *See Cosmetic Ideas*, 606 F.3d at 618; *Prunte*, 484 F. Supp. 2d at 40. The Ninth Circuit in *Cosmetic Ideas* acknowledged a possible limitation to this argument “because this back-dating does not occur until after the Copyright Office or a court has deemed the registration acceptable, the statute could be read to require action by the Register to effect registration.” *Cosmetic Ideas*, 606 F.3d at 618.

125. *Foraste v. Brown Univ.*, 248 F. Supp. 2d 71 (D.R.I. 2003); *see also Cosmetic Ideas*, 606 F.3d at 618; *Prunte*, 484 F. Supp. 2d. at 40.

126. 17 U.S.C. § 408(a) (2018).

127. *Cosmetic Ideas*, 606 F.3d at 617; *see also Prunte*, 484 F. Supp. 2d at 40; *Iconbazaar, L.L.C. v. America Online, Inc.*, 308 F. Supp. 2d 630, 634 (M.D.N.C. 2004).

128. 17 U.S.C. § 408(a) (2018); *La Resolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1203–04 (10th Cir. 2005) (discussing the arguments of those courts adopting the “application approach,” but ultimately deciding to utilize the “registration approach”), *abrogated by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010).

129. *La Resolana*, 416 F.3d at 1203 (citing *NIMMER & NIMMER*, *supra* note 98 at § 7.16(B)(1)(a)).

the delays that would occur if litigants were required to wait for the Copyright Office to review an application for registration, especially since the legal action would be able to proceed regardless of the determination made by the Register on the issue of copyrightability.<sup>130</sup> Moreover, the Register's eventual decision is subject to review by the courts.<sup>131</sup> However, in the meantime, an alleged infringer "may continue to dilute the copyright"<sup>132</sup> during the time it takes "for a government official [to be] able to sift through and approve what is surely a large stack of copyright registration applications."<sup>133</sup>

A strong argument could be made that the application approach best promoted judicial economy. This was because in any case in which the copyright owner had applied to register a work but had not yet received a response from the Copyright Office, courts adhering to the registration approach had to dismiss the case. More often than not, the copyright owner would refile the infringement action in a matter of weeks or months.<sup>134</sup> Not surprisingly, even proponents of the registration approach acknowledged this practice "leads to an inefficient and peculiar result."<sup>135</sup>

Furthermore, there was also a risk the owner of a copyrighted work might completely lose the ability to sue for infringement. Section 507(b) of the Copyright Act prohibits any civil action "commenced within three years after the claim accrued."<sup>136</sup> Consequently, in a registration approach jurisdiction, a copyright owner who filed for an application for registration of the work near the end of the statute of limitations period "could see the statute of limitations expire during the time it took the Copyright Office to act on the application."<sup>137</sup> Nonetheless, courts following the registration approach were rarely sympathetic to such concerns. Instead, courts held the potential for this type of loss would serve to encourage owners to register more quickly.<sup>138</sup> Moreover, many courts also viewed resort to policy-based arguments or

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130. See e.g., *Cosmetic Ideas*, 606 F.3d at 619–620; *Caner v. Autry*, 16 F. Supp. 3d 689, 708 (W.D. Va. 2014); *Iconbazaar*, 308 F. Supp. 2d at 634; *Phoenix Renovation Corp. v. Rodriguez*, 403 F. Supp. 2d 510, 514–515 (E.D. Va. 2005).

131. *Cosmetic Ideas*, 606 F.3d at 621.

132. *Caner*, 16 F. Supp. 3d at 708.

133. *La Resolana*, 416 F.3d at 1197.

134. *Cosmetic Ideas*, 606 F.3d at 620.

135. *Id.* (internal citations omitted); *Loree Rodkin Mgmt Corp. v. Ross-Simons, Inc.*, 315 F. Supp. 2d 1053, 1056–57 (C.D. Cal 2004); *Strategy Source, Inc., v. Lee*, 233 F. Supp. 2d 1, 3 (D.D.C. 2002).

136. 17 U.S.C. § 507(b) (2018).

137. *Cosmetic Ideas*, 606 F.3d at 620.

138. See e.g., *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1342 (11th Cir. 2017) ("True, an owner who files an application late in the statute of limitations period risks losing the right to enforce his copyright in an infringement action because of the time needed to review an application. But this potential loss encourages an owner to register his copyright soon after he obtains the copyright and before infringement occurs.").



legislative history as simply unnecessary in light of what they regarded as clear statutory language supporting the registration approach.<sup>139</sup>

### B. The “Registration Approach”

Courts adhering to the registration approach often characterized the answer to the question of when a copyrighted work is “registered” under Section 411(a) as straightforward. The Eleventh Circuit’s statements in *Fourth Estate Public Benefit Corporation v. Wall-Street.com, LLC* reflect such certitude: “[T]he text of the Copyright Act makes clear that the registration approach that we [previously] endorsed . . . is correct. Filing an application does not amount to registration.”<sup>140</sup>

Courts professedly found support for the registration approach in Section 410 which details the registration process itself. Subsection (a) states:

When, after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office.<sup>141</sup>

Courts argued this language plainly stipulates registration can only occur after the Copyright Office has actually reviewed the application and that

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139. *Id.* (“Fourth Estate devotes its remaining statutory arguments to legislative history and policy, but ‘[w]hen,’ as here, ‘the words of a statute are unambiguous, then . . . judicial inquiry is complete.’ Indeed, ‘[e]ven if a statute’s legislative history evinces an intent contrary to its straightforward statutory command, we do not resort to legislative history to cloud a statutory text that is clear.’”) (citations omitted); *see also* *La Resolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1197 (10th Cir. 2005) (“The Application approach, at first glance, has some appeal . . . . Courts adopting the Application approach plausibly claim that their approach provides a sort of rough justice because it allows copyright owners to file suit while still maintaining the requirement that an owner obtain a certificate before a court can invoke the remedies contained in Title 17. Whatever the practical force of this argument, we cannot ignore the plain meaning of the statute, nor change the legislative scheme.”) (citations omitted), *abrogated by* *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010); *Patrick Collins, Inc. v. Doe*, 843 F. Supp. 2d 565, 570 (E.D. Pa. 2011) (“We certainly understand the strong, largely meritorious, policy considerations that weigh in favor of permitting a copyright infringement plaintiff to sue during the pendency of his copyright application. In the end, perhaps the application approach makes more practical sense, perhaps not. Either way, our own policy views do not give us license to rewrite an unambiguous statute. In enacting 17 U.S.C. § 411(a), Congress chose the registration approach, and we must abide by that decision.”) (citations omitted).

140. 856 F.3d at 1341.

141. 17 U.S.C. § 410(a) (2018).

merely filing an application is insufficient to constitute registration.<sup>142</sup> Otherwise, the examination requirement would arguably “be meaningless if filing and registration were synonymous.”<sup>143</sup>

Relatedly, courts also pointed to Subsection (b) of Section 410 as support for the registration approach. This provision of the Copyright Act provides as follows: “In any case in which the Register of Copyright determines that . . . the material deposited does not constitute copyrightable subject matter or the claim is invalid for any other reason, the Register shall refuse registration.”<sup>144</sup> These courts contended that the Copyright Office would not have the ability to reject an application purportedly submitted for registration if it occurred immediately upon filing.<sup>145</sup>

Additionally, courts maintained that Section 410(d) further substantiated their position on when registration occurs under the Copyright Act. As discussed above,<sup>146</sup> this subsection provides that the effective date of a copyright registration is retroactive to the date on which the copyright owner originally filed the application.<sup>147</sup> However, advocates of the registration approach highlight the portion of the statutory language that allows for such backdating only after the Register of Copyright has deemed the submission “acceptable.”<sup>148</sup> According to supporters of the registration approach, this further confirms the necessity of review and approval by the Register of Copyrights before registration can be said to have taken place, thereby rendering the mere act of filing an application legally insufficient.<sup>149</sup>

Aside from the language of the Copyright Act itself, courts also held that their interpretation of the registration prerequisite under Section 411(a) was supported by Congressional changes to the statute, in particular, the Berne Convention Implementation Act of 1988 and FECA.<sup>150</sup> As detailed above,<sup>151</sup> both pieces of legislation made changes to Section 411(a), namely removing the necessity of registration prior to filing an infringement action for foreign works and creating a new preregistration procedure for a limited class of domestic works. Congress’ choice to eliminate this precondition for some works, but not all, arguably confirms registration must generally be made

142. *Fourth Estate*, 856 F.3d at 1341.

143. *La Resolana*, 416 F.3d at 1202 (citing *Robinson v. Princeton Review, Inc.*, 1996 WL 663880, \*7 (S.D.N.Y. 1996)); *see also* *Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc.*, 315 F. Supp. 2d 1053, 1056 (C.D. Cal. 2004).

144. 17 U.S.C. § 410(b) (2018).

145. *Fourth Estate*, 856 F.3d at 1341.

146. Notwithstanding arguments to the contrary, proponents of the application approach also view this provision of the Copyright Act as supporting their preferred definition of registration. *See supra* Section III.A.

147. 17 U.S.C. § 410(d) (2018).

148. *Fourth Estate*, 856 F.3d at 1341–42.

149. *Id.* at 1342.

150. *See e.g.*, *La Resolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1205–07 (10th Cir. 2005).

151. *See supra* Sections II.B & II.D.

absent an explicit statutory exemption. Eventually, however, the Supreme Court would have to decide which approach was the correct one.

### C. *The U.S. Supreme Court's Approach*

In *Fourth Estate*, the petitioner, Fourth Estate Public Benefit Corporation (“Fourth Estate”), sued the respondent Wall-Street, LLC (“Wall-Street”) for copyright infringement.<sup>152</sup> The two parties had previously entered into a licensing agreement in which Fourth Estate had allowed Wall-Street to display its news content on Wall-Street’s website.<sup>153</sup> However, the license agreement required Wall-Street to completely remove from its website all Fourth Estate content prior to canceling the agreement.<sup>154</sup> Nonetheless, when Wall-Street terminated the contract, it continued to display content on its website produced by Fourth Estate in violation of the license.<sup>155</sup> Subsequently, Fourth Estate sued Wall-Street and its owner.<sup>156</sup>

The complaint alleged that while Fourth Estate had filed applications for registration with the Register of Copyrights, the Copyright Office had not yet rendered any decisions concerning their copyrightability.<sup>157</sup> Consequently, Wall-Street and its owner filed a motion to dismiss arguing the Copyright Act requires more than merely filing an application, but instead, requires either a registration or a denial of a registration prior to filing suit.<sup>158</sup> The District Court agreed and dismissed the suit, and the Eleventh Circuit affirmed.<sup>159</sup> The Supreme Court granted certiorari to resolve the question of when Section 411(a)’s copyright registration requirement was met.<sup>160</sup> Specifically, “Has registration . . . been made in accordance with [Title 17] as soon as the claimant delivers the required application, copies of the work, and fee to the Copyright Office; or has registration . . . been made only after the Copyright Office reviews and registers the copyright?”<sup>161</sup>

The Court began by observing that under the Copyright Act protection attaches as soon as a work is created.<sup>162</sup> As such, the author immediately

152. 139 S. Ct. 881, 887 (2019).

153. *Id.*

154. *Id.*

155. *Id.*

156. *Id.*

157. According to the Court, “[c]onsideration of Fourth Estate’s filings was initially delayed because the check Fourth Estate sent in payment of the filing fee was rejected by Fourth Estate’s bank as uncollectible. *Id.* at 887 n.2.

158. *Id.*; *see also* Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC, 856 F.3d 1338, 1339 (11th Cir. 2017).

159. *Fourth Estate*, 139 S. Ct. at 887. Ultimately, the Copyright Office denied Fourth Estate’s applications for registration. *Id.* However, the issue of copyrightability was not before the Court. *Id.* at 887 n.3.

160. *Id.* at 886–87.

161. *Id.* at 886 (internal quotation marks omitted).

162. *Id.* at 887; *see also* 17 U.S.C. § 102(a) (2018).

acquires a number of exclusive rights, including the right of reproduction, distribution, and public display.<sup>163</sup> Furthermore, the Court recognized the “Copyright Act entitles a copyright owner to institute a civil action for infringement of those exclusive rights.”<sup>164</sup> Nonetheless, as the Court correctly pointed out, “[b]efore pursuing an infringement claim in court, . . . a copyright claimant generally must comply with Section 411(a)’s requirement that ‘registration of the copyright claim has been made.’”<sup>165</sup>

The Court next took a detailed look at the statutory language of Section 411(a) – beginning with the first two sentences of the provision – which states as follows:

[N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.<sup>166</sup>

The Court held this language focuses on the action of the Copyright Office in approving or denying registration as opposed to the copyright owner’s act of applying.<sup>167</sup> Therefore, if merely filing an application for registration was sufficient, “allowing suit upon refusal of registration – would be superfluous.”<sup>168</sup> The Court then analyzed the final sentence of Section 411(a) which allows the Register to “become a party to the action with respect to the issue of registrability of the copyright claim.”<sup>169</sup> The Court similarly held this portion of the statutory provision requires the Register to render a decision on the copyrightability of a given application before a suit can be filed.<sup>170</sup> Per the Court, a different interpretation would negate the ability of the Register to join the litigation and deprive a court “the benefit of the Register’s assessment.”<sup>171</sup>

The Court also examined a number of other provisions that it viewed as supportive of its reading of registration in Section 411(a) and thus

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163. *Fourth Estate*, 139 S. Ct. at 887 (citing 17 U.S.C. § 106 (2018)).

164. *Id.* at 887 (citing 17 U.S.C. § 501(b) (2018)).

165. *Id.* (citing 17 U.S.C. § 411(a) (2018)). The Court took notice of the fact that the potential statutory exceptions to the requirement of registration were not present and that all the parties were in agreement on this issue. *Id.* at 888.

166. *Id.* at 888 (citing 17 U.S.C. § 411(a) (2018)).

167. *Id.*

168. *Id.* at 889.

169. *Id.* (citing 17 U.S.C. § 411(a) (2018)).

170. *Id.*

171. *Id.*

necessitating action by the Register.<sup>172</sup> This included subsections (a), (b), and (d) of Section 410, which the Court maintained “confirms that application is discrete from, and precedes, registration.” In so doing, the Court affirmed the analysis previously taken by lower courts following the “registration approach.”<sup>173</sup> Additionally, the Court evaluated Section 408(f), which allows for the preregistration of certain types of works under specific circumstances.<sup>174</sup> According to the Court, “[a] copyright owner who fears republication infringement would have no reason to apply for preregistration, however, if she could instead simply complete an application for registration and immediately commence an infringement suit.”<sup>175</sup>

Next, the Court addressed various arguments advanced by Fourth Estate. Aside from a number of statutory interpretation claims with which the Court disagreed,<sup>176</sup> Fourth Estate raised the possibility that a copyright owner could completely lose the ability to bring suit if the “registration approach” were adopted. This might occur because the statute of limitations for copyright infringement actions is three years and the current processing time for applications submitted to the Copyright Office is seven months.<sup>177</sup> While the Court acknowledged that processing times have increased, the Court nonetheless viewed Fourth Estate’s concerns as “overstated.”<sup>178</sup> Furthermore, the Court stated “[d]elays in Copyright Office processing of applications, it appears, are attributable, in large measure, to staffing and budgetary shortages that Congress can alleviate, but courts cannot cure. Unfortunate as the current administrative lag may be, that factor does not allow us to revise § 411(a)’s congressionally composed text.”<sup>179</sup> The Court concluded by holding, “‘registration . . . has been made’ within the meaning of 17 U.S.C. § 411(a) not when an application for registration is filed, but when the Register has registered a copyright after examining a properly filed application.”<sup>180</sup>

172. *Id.*

173. *Id.*; see also *supra* Section III.B. (examining the analysis of “registration approach” courts).

174. *Fourth Estate*, 139 S. Ct. at 889; see also *supra* Section II.D. (reviewing the promulgation of the preregistration option as part of the Family Entertainment and Copyright Act of 2005).

175. *Fourth Estate*, 139 S. Ct. at 889–90 (citing *TRW Inc. v. Andrews*, 534 U.S. 19, 29 (2001)) (rejecting an interpretation that “would in practical effect render [a provision] superfluous in all but the most unusual circumstances”).

176. *Id.* at 890–92. Fourth Estate argued that the phrase “make registration” and “registration has been made” refer to submissions by the copyright owner as opposed to the Copyright Office’s response to such applications. *Id.* at 890. Additionally, Fourth Estate maintained that as the Copyright Act states in Section 408(a) that “registration is not a condition of copyright protection,” an application for registration, not the registration itself, should be sufficient to allow the copyright owner into court. *Id.* at 891.

177. *Id.* at 892.

178. *Id.*

179. *Id.*

180. *Id.*

#### IV. DISPENSING WITH THE REGISTRATION PREREQUISITE FOR INFRINGEMENT ACTIONS

The Court's decision in *Fourth Estate* to adopt the "registration approach" is the correct decision from a purely statutory interpretation perspective, as it allows for a less contrived reading of the Copyright Act's provisions. Nonetheless, the Court did not seem to fully appreciate the numerous barriers imposed on copyright owners trying to protect their works by requiring a registration decision prior to filing an infringement action. As a report co-authored by Former Register of Copyrights Barbara Ringer found, "the requirement can result in harm and injustice to copyright owners by effectively preventing or unduly delaying injunctive relief, by requiring expensive and unproductive paperwork where many copyrights are involved in a suit, and by offering defendants an opportunity for dilatory tactics."<sup>181</sup> While courts could previously utilize the "application approach" to mitigate the shortcomings inherent with a system that grants rights immediately upon a work's creation but does not expressly provide for prompt access to the courts to enforce such rights, this is no longer a possibility. Consequently, it is now more imperative than ever to amend the copyright law to eliminate the Section 411(a) registration prerequisite. As detailed below, while there may be some arguable benefit to incentivizing federal copyright registration and relatedly for preserving Section 411(a) as a part of this approach, they are negligible when contrasted with the many drawbacks associated with maintaining this precondition. Moreover, as highlighted in the following discussion, removal of the registration prerequisite will also likely provide numerous independent benefits over the current system. This Section concludes with a brief discussion of the recent trend in academic scholarship advocating for a return of copyright formalities and why it appears to be misguided, at least regarding the copyright prerequisite of Section 411(a).

##### A. Purported Need to Incentivize Copyright Registration

One of the leading arguments in opposition to eliminating Section 411(a) is that it would have a substantial, negative impact on the number of federal copyright registrations. Discussions concerning the need for incentivizing registration were a significant part of the deliberations surrounding the passage of the 1976 Copyright Act. This was due to the fact that one of the biggest changes to copyright law wrought by the new legislation was the removal of mandatory registration for the protection of copyrightable work.<sup>182</sup>

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181. *Hearing on Copyright Reform Act*, *supra* note 79, at 30 (Report of Co-Chairs Barbara Ringer and Robert Wedgeworth, Library of Congress Advisory Committee on Copyright Registration and Deposit).

182. 17 U.S.C. § 408 (2018) ("Copyright registration in general"). Subsection 408(a) provides as follows:

(a) Registration Permissive. At any time during the subsistence of the first term of copyright in any published or unpublished work in which the copyright was

Even though “registration was made optional, Congress still valued having a robust federal register of existing copyrights.”<sup>183</sup> Copyright registration arguably “provides a useful public record”<sup>184</sup> and supplies “the Library of Congress with an efficient means of obtaining copies of copyrighted works.”<sup>185</sup> This is due to the fact that applicants are generally required to include “two complete copies or phonorecords of the best edition of the work” as part of the application process.<sup>186</sup> However, as more fully explored below, there are numerous limitations to the claim that the maintenance of Section 411(a) is necessary or even appropriate to achieve these purported goals.

### 1. More Important Incentives Remain

The ability to bring a lawsuit in the event of copyright infringement is not the only incentive to federally registering a work. In fact, the 1976 revision to the Copyright Act provides “two even more powerful incentives . . . as [S]ection 410(c) gives a timely registration prima facie effect in infringement litigation, and [S]ection 412 conditions the availability of the powerful remedies of statutory damages and attorneys’ fees upon timely registration.”<sup>187</sup> Furthermore, the annual statistics concerning applications relative to the number of infringement suits filed are “comparatively minuscule” and appear to have “little positive effect on the general goals of registration and deposit.”<sup>188</sup> For example, in 2017 the Copyright Office

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secured before January 1, 1978, and during the subsistence of any copyright secured on or after that date, the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708. Such registration is not a condition of copyright protection.

*Id.*

183. *Cosmetic Ideas Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 619 (9th Cir. 2010) (citing Copyrights Act H.R. REP. NO. 94-1476, at 158 (1976)).

184. S. REP. NO. 100-352, at 19 (1988).

185. *Id.*

186. 17 U.S.C. § 408 (2018) (“Copyright registration in general”). Subsection (b) provides as follows: “(b) Deposit for Copyright Registration. Except as provided by subsection (c), the material deposited for registration shall include – (1) in the case of an unpublished work, one complete copy or phonorecord; (2) in the case of a published work, two complete copies or phonorecords of the best edition; (3) in the case of a work first published outside the United States, one complete copy or phonorecord as so published; (4) in the case of a contribution to a collective work, one complete copy or phonorecord of the best edition of the collective work.”

187. S. REP. NO. 100-352, at 19 (1988).

188. *Hearing on Copyright Reform Act*, *supra* note 79, at 185 (Draft Working Paper of Paul L. Goldstein, Professor, Stanford Law School) (comparing the 1,831 copyright infringement suits filed in 1991 to the 634,797 works submitted for registration the same year and concluding that Section 411(a) “can thus be said to have spurred the registration of, at most, only 1,831 works – only slightly more than one-quarter of one percent of all applications filed that year. Even this figure is overly

received 539,662 applications for registration,<sup>189</sup> while the number of new lawsuits filed alleging copyright infringement during the same time frame was 3,472.<sup>190</sup> Additionally, the statistics do not specify exactly when or why an application for registration was filed. Even if we generously assume all the applications associated with copyright infringement suits were filed solely in anticipation of impending litigation and to comply with Section 411(a), this only accounts for less than one percent of the submissions to the Copyright Office. Although Section 411(a) allows copyright owners to access the courts,

two even more powerful incentives included in the 1976 revision of the Copyright Act govern what the copyright proprietor may seek once the courthouse door is opened: [S]ection 410(c) gives a timely registration prima facie effect in infringement litigation, and [S]ection 412 conditions the availability of the powerful remedies of statutory damages and attorneys' fees upon timely registration.<sup>191</sup>

#### i. Prima Facie Validity

If a copyright owner files an application for registration of a work either before or within five years following its first publication, the registration certificate “[c]onstitutes prima facie validity of the copyright and of the facts stated in the certificate” per Section 410(c) of the Copyright Act.<sup>192</sup> As such, this causes a “shift of the burden of going forward on this issue to the defendant.”<sup>193</sup> Conversely, if a copyright owner fails to register a work in accordance with the timeline stated in Section 410(c), the proprietor “will remain at a substantial disadvantage in the ensuing litigation.” This is due to the fact that the now purported copyright owner will need to first prove the work is copyrightable.<sup>194</sup> Additionally, the “proprietor will assume the burden of proving authorship of the work, and, for a published work, establishing the

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generous since a substantial number of these 1,831 works were probably registered earlier, ante litem motem.”).

189. U.S. COPYRIGHT OFF., FISCAL 2017 ANNUAL REPORT (2018), <https://www.copyright.gov/reports/annual/2017/ar2017.pdf> [perma.cc/J7KG-U8CN].

190. *Fewer Copyright Infringement Lawsuits Filed*, TRANSACTIONAL RECORDS ACCESS CLEARINGHOUSE (“TRAC”) REP., <https://trac.syr.edu/tracreports/civil/483/> [perma.cc/QS9U-TAA6] (last visited May 9, 2019) (The total of 3,472 for FY 2017 is based on the first eleven months of FY 2017 in which 3,183 suits were actually filed and an additional estimate for the twelfth month of 289 new lawsuits).

191. S. REP. NO. 100-352, at 19–20 (1988). The Report also noted “Section 205 (c) and (e) also provide an incentive for transferees of copyright [20] ownership to ensure that registration is made. Finally, of course, there are the intangible factors that may lead authors to register their works with the Copyright Office in the belief that a registration certificate constitutes a government agency’s stamp of approval on the fruit of the author’s creative efforts.” *Id.*

192. 17 U.S.C. § 410(c) (2018).

193. S. REP. NO. 100-352, at 21 n.5 (1988).

194. *Id.* at 20, 24.



origin of the work in either the United States, or a country with which the United States has either multilateral or bilateral copyright relations, or demonstrating some other basis upon which the court's enforcement powers under U.S. law may be invoked."<sup>195</sup> Consequently, in the vast majority of cases, plaintiffs will likely continue to register their works in order to avoid an otherwise time consuming and unnecessary impediment to prevailing on their claim of copyright infringement.<sup>196</sup>

## ii. Statutory Damages and Attorney's Fees

Not only does a registration certificate make it easier to prove the necessary elements of a successful copyright infringement case, but once a viable claim is established, a federal registration allows for the possibility of important, additional remedies otherwise not available to the copyright owner. Under Section 412, statutory damages are available so long as the work at issue was registered either prior to the time of infringement or within three months of first publication.<sup>197</sup> If a copyright owner elects to recover statutory damages in place of actual damages and profits, the amount is usually in the range of \$750 to \$30,000 per work infringed.<sup>198</sup> However, if the infringement was willful, a court can award up to \$150,000 per work infringed.<sup>199</sup> Statutory damages can be especially helpful in cases where actual damages are difficult to determine or where a work "has seemingly little extrinsic value."<sup>200</sup>

Another significant benefit of timely federal registration is the successful litigant may be entitled to attorney's fees. Section 505 of the Copyright Act provides a court with "wide latitude to award attorney's fees" to the prevailing party "based on the totality of circumstances in a case."<sup>201</sup> As the U.S. Court of Appeals for the Tenth Circuit stated in connection with a copyright infringement case, the prospect of attorney's fees can be especially valuable

195. *Id.* at 20.

196. *Id.* at 24.

197. 17 U.S.C. § 412 (2018) ("Registration as prerequisite to certain remedies for Infringement"); *see also* NIMMER & NIMMER, *supra* note 98, at § 7.16(C) (2019).

198. § 504(c)(1) ("Remedies for infringement: Damages and profits").

199. § 504(c)(2). This section also allows a court to reduce the statutory damage award under certain circumstances, including cases of "innocent infringement." *Id.* The statute provides as follows: "In a case 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, the court in its discretion may reduce the award of statutory damages to a sum of not less than \$200." *Id.*

200. *La Resolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1199–1200 (10th Cir. 2005), *abrogated by* *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010).

201. *Kirtsaeng v. John Wiley & Sons, Inc.*, 136 S. Ct. 1979, 1985 (2016); 17 U.S.C. § 505 (2018) ("Remedies for infringement: Costs and attorney's fees"); *see also*, *Fogarty v. Fantasy, Inc.*, 510 U.S. 517, 533 (1994).

“[f]or copyright owners hesitant to engage in the long and expensive process of litigation.”<sup>202</sup>

### iii. Questionable Impact

Clearly, the repeal of Section 411(a) would not remove all the available incentives associated with registration, let alone the most powerful ones. Consequently, the argument that the elimination of Section 411(a) would have a substantial effect on the number of copyrightable works registered is speculative at best. Quite simply, “it is unlikely that many copyright claimants would choose to forego registration, given the attendant increased difficulties they would encounter in seeking to prove and to obtain redress for infringements.”<sup>203</sup>

## 2. Acquisition of Materials for the Library of Congress

One of the other principal arguments against the repeal of Section 411(a) is that doing so would adversely affect the Library of Congress’ acquisition of deposits. Representative of such concerns is the following statement in a House report associated with an earlier bill concerning accession to the Berne Convention and the purported necessity of Section 411(a) to both U.S. and non-U.S. works:<sup>204</sup>

Registration is an important source of acquisitions for the Library of Congress . . . . In a time of fiscal restraint, the absence of this acquisition source—which is virtually cost-free to the taxpayer—would have to be replaced by either the expenditure of public monies or the establishment of increased fees by the Library, or a combination of both. Moreover, registration as a prerequisite to suit helps to ensure the existence of a central, public record of copyright claims. This publicly available depository of information is of benefit to both copyright owners and users.<sup>205</sup>

While the objections raised may have some validity, they appear to be highly overstated. As discussed above, even without Section 411(a), many more powerful incentives to registration remain.<sup>206</sup> Moreover, as explored in more detail below, the Copyright Act contains two separate deposit

202. *La Resolana*, 416 F.3d at 1199–1200.

203. S. REP. NO. 100-352, at 21 (1988).

204. As discussed above, Congress eventually reached a compromise in which Section 411(a) was amended to exclude foreign works from its purview in order to comply with Berne’s prohibition on formalities. *See supra* Section II.B (examining the debate concerning accession to the Berne Convention).

205. H.R. REP. NO. 100-609, at 42 (1988).

206. *See supra* Section IV.A.1 (discussing prima facie validity, statutory damages, and attorney’s fees).

provisions.<sup>207</sup> While Section 408 is tied to the copyright registration process, Section 407 contains a mandatory deposit obligation that is instead triggered by the act of publication.<sup>208</sup>

The strength of the acquisition argument is limited by the fact that Section 407 could be utilized if particular published works are so needed for the Library's collections.<sup>209</sup> Some commentators have even proposed expanding this statutory authority<sup>210</sup> and enforcing the requirement more regularly<sup>211</sup> to minimize any possible impacts on the Library of Congress' collections. Additionally, as further explored in the following subsections:

[T]he Library of Congress need not add all deposited works to its collection, it apparently is not required to preserve those works which it does add to its collection, and those which it does not so add, although retained by the Copyright Office, need only be preserved "for the longest period considered practicable and desirable by the Register of Copyrights and the Librarian of Congress."<sup>212</sup>

Lastly, there is the more fundamental issue of whether the inequities associated with placing the burden of "library building" on creators attempting to register their copyrightable works is still appropriate.

#### i. Section 407: Mandatory Deposit and Major Exemptions

Section 407(a) of the Copyright Act requires the owner of a copyrighted work published in the United States to deposit in the U.S. Copyright Office two complete copies of the best edition of the work within three months after a work is published for the use of the Library of Congress.<sup>213</sup> Furthermore, the owner of a work first published in a foreign country but then distributed in the United States must also comply with the mandatory deposit requirement.<sup>214</sup> Although the federal copyright registration process and its

207. U.S. COPYRIGHT OFF., U.S. COPYRIGHT CIRCULAR 7D: MANDATORY DEPOSIT OF COPIES OR PHONORECORDS FOR THE LIBRARY OF CONGRESS (2019), <https://www.copyright.gov/circs/circ07d.pdf> [perma.cc/6LJ5-V4QD].

208. 17 U.S.C. §§ 407, 408 (2018).

209. § 407.

210. *See e.g., Hearing on Copyright Reform Act, supra* note 79, at 5–6 (Statement of Dr. James H. Billington, the Librarian of Congress, accompanied by Mary Levering, Acting Register of Copyrights, Barbara Ringer and Robert Wedgeworth, Co-chairs, Copyright Advisory Committee).

211. *But see infra* Part IV.A.2.iv (examining the concerns with placing the onus of library building on a copyright owner).

212. NIMMER & NIMMER, *supra* note 98, § 7.17[A] (citing 17 U.S.C. § 704(d) (2018)).

213. 17 U.S.C. § 407(a) (2018).

214. *See* 37 C.F.R. § 202.19(c)(10) (2019) ("Deposit of published copies or phonorecords for the Library of Congress"); *see also* NIMMER & NIMMER, *supra* note 98, § 7.17(c)(2).

attendant deposit requirement under Section 408 can concomitantly satisfy Section 407(a), works for which an application has never been filed will still need to independently meet this mandatory deposit obligation.<sup>215</sup> This is due to the fact that the purpose of deposit and registration are similar but not identical.<sup>216</sup> While deposit is designed to “provide the Library of Congress via the Copyright Office with copies and phonorecords of all works published within the United States,” registration is meant “to create a written record of the copyright ownership in a work.”<sup>217</sup>

Failure to comply with the mandatory deposit requirement following a written demand by the Register of Copyrights can result in an initial fine of up to \$250 per work and a required payment to the Library of Congress equal to the retail cost of the material sought.<sup>218</sup> An additional fine of \$2500 can be assessed in the event the owner of the work “willfully or repeatedly fails or refuses to comply.”<sup>219</sup> As such, the mandatory deposit provisions already provide the Library of Congress with the means by which to acquire copies of almost any copyrightable work so desired. Consequently, the elimination of Section 411(a)’s registration prerequisite is unlikely to have any meaningful effect on this facet of the Library of Congress’ acquisitions program.<sup>220</sup>

Moreover, many categories of works are no longer required to be deposited. Section 407(c) allows the Register of Copyright to designate entire classes of materials as exempt from such deposit obligations altogether.<sup>221</sup> The list of excluded categories is extensive<sup>222</sup> and is “intended to apply to that

215. See NIMMER & NIMMER, *supra* note 98, § 7.17(F).

216. *Id.* at § 7.17(A).

217. *Id.*

218. 17 U.S.C. § 407(d) (2018).

219. *Id.*

220. S. REP. NO. 100-352, at 22–23 (1988).

221. § 407(d).

222. 37 C.F.R. § 202.19(c) states as follows:

The following categories of material are exempt from the deposit requirements of section 407(a) of title 17:

- (1) Diagrams and models illustrating scientific or technical works or formulating scientific or technical information in linear or three-dimensional form, such as an architectural or engineering blueprint, plan, or design, a mechanical drawing, or an anatomical model.
- (2) Greeting cards, picture postcards, and stationery.
- (3) Lectures, sermons, speeches, and addresses when published individually and not as a collection of the works of one or more authors.
- (4) Literary, dramatic, and musical works published only as embodied in phonorecords. This category does not exempt the owner of copyright, or of the exclusive right of publication, in a sound recording resulting from the fixation of such works in a phonorecord from the applicable deposit requirements for the sound recording.
- (5) Electronic works published in the United States and available only online. This exemption includes electronic serials available only online only until such time as a demand is issued by the Copyright Office under the regulations set forth in § 202.24. This exemption does not apply to works that are published

‘material the Library [of Congress] neither needs nor wants’ for its archival purposes.”<sup>223</sup> Additionally, at least historically, it appears that “a significant amount of litigation involves works falling within one of these exempt categories.”<sup>224</sup> Collectively, this further diminishes the argument that Section 411(a) is necessary to ensure the Library of Congress’ acquisition activities will not be adversely affected.<sup>225</sup>

ii. Section 408: Deposits of Questionable Utility

Section 408 of the Copyright Act ordinarily requires an applicant seeking federal registration to submit a completed application form, the requisite filing fee, and a deposit of two copies of the work.<sup>226</sup> While large

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in both online, electronic formats and in physical formats, which remain subject to the appropriate mandatory deposit requirements.

(6) Three-dimensional sculptural works, and any works published only as reproduced in or on jewelry, dolls, toys, games, plaques, floor coverings, wallpaper and similar commercial wall coverings, textiles and other fabrics, packaging material, or any useful article. Globes, relief models, and similar cartographic representations of area are not within this category and are subject to the applicable deposit requirements.

(7) Prints, labels, and other advertising matter, including catalogs, published in connection with the rental lease, lending, licensing, or sale of articles of merchandise, works of authorship, or services.

(8) Tests and answer material for tests when published separately from other literary works.

(9) Works first published as individual contributions to collective works. This category does not exempt the owner of copyright, or of the exclusive right of publication, in the collective work as a whole, from the applicable deposit requirements for the collective work.

(10) Works first published outside the United States and later published in the United States without change in copyrightable content, if:

(i) Registration for the work was made under 17 U.S.C. 408 before the work was published in the United States; or

(ii) Registration for the work was made under 17 U.S.C. 408 after the work was published in the United States but before a demand for deposit is made under 17 U.S.C. 407(d).

(11) Works published only as embodied in a soundtrack that is an integral part of a motion picture. This category does not exempt the owner of copyright, or of the exclusive right of publication, in the motion picture, from the applicable deposit requirements for the motion picture.

(12) Motion pictures that consist of television transmission programs and that have been published, if at all, only by reason of a license or other grant to a nonprofit institution of the right to make a fixation of such programs directly from a transmission to the public, with or without the right to make further uses of such fixations.

223. NIMMER & NIMMER, *supra* note 98, § 7.17(C)(3) (citing H.R. REP. 94-1476, at 150 (1976)).

224. 139 CONG. REC. E337 (daily ed. Feb. 16, 1993) (statement of Rep. Hughes).

225. *Id.*

226. 17 U.S.C. § 408 (2018).

categories of works are now excluded from mandatory deposit under Section 407,<sup>227</sup> these deposit exemptions do not apply to works for which federal copyright registration is sought under Section 408. While one might claim this is a clear area in which removal of Section 411(a)'s registration prerequisite may have a direct effect on the scope and breadth of the Library of Congress' collections, this is unlikely to be the case. First, "the fundamental criteria governing regulations issued under section 407(c), which allows exemptions from the deposit requirements for certain categories of works, [are] the needs and wants of the Library."<sup>228</sup> Quite simply, those excluded are not the type of works likely to be chosen for inclusion in any Library of Congress collection.<sup>229</sup>

Furthermore, works that would otherwise be subject to mandatory deposit but for fulfillment through the federal copyright application process under Section 408 still may not be especially helpful or insightful. The following Congressional testimony from an attorney for a large computer software manufacturer is illustrative:

In our particular industry, we don't believe that the current deposit requirements are assisting the Library in maintaining its collections. The deposit requirements require us only to submit approximately 75 pages of what's called source code that for lack of a better word would appear to you as gobbledy-gook. It's a page of symbols, letters, numbers that are unintelligible to anyone but software engineers. When you take into account that products in the market today may include over a million lines of this code, submitting 75 pages of that code does nothing to enhance the collections of the Library of Congress.<sup>230</sup>

But it is not just deposits of computer programs that are of questionable utility. Many other types of works are likely to be of little or no value to the Library of Congress. Nonetheless, copies must still be deposited in order to obtain a federal registration and ultimately to permit timely enforcement of one's rights in the event of copyright infringement. The futility of this situation was well-described back in 1993 by Olan Mills II, in connection with

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227. See *supra* Section IV.A.2.i. (discussing the extensive exemptions under Section 407).

228. H.R. REP. NO. 94-1476, at 151 (1976).

229. See NIMMER & NIMMER, *supra* note 98, § 7.17(C)(3) (citing H.R. REP. 94-1476, at 151 (1976)).

230. *Hearing on Copyright Reform Act, supra* note 79, at 102–03 (testimony of Enid Greene Waldholtz, Corporate Counsel, Novell, Inc.). Today, the number of pages of source code that must generally be submitted is 50. 37 C.F.R. § 202.20(c)(2)(vii)(A)(1) (2019). This includes the first twenty-five pages and the last twenty-five pages plus "the page of the source code that contains the copyright notice (if any)." *Id.*

a Senate Hearing considering legislation to repeal Section 411(a),<sup>231</sup> but it still rings true today:

I am told that the Library of Congress has expressed a concern that repeal of [Section 411(a)] would deprive it of its ability to obtain materials for its collections. I do not understand this concern. Several years ago, our lawyer called the Copyright Office to ask whether we should deposit copies of our output. We were advised quite clearly that hundreds of thousands of Olan Mills photographs were not wanted. The message was in essence, “don’t call us, we’ll call you.” No one ever has. Olan Mills, Inc. (and I suspect most responsible businesses) will provide the Library of Congress with any copies of works that it wants. But we should not be required to flood it with hundreds of thousands of portraits of no general interest to anyone. Nor should we be mired in paperwork intended to facilitate such a wasteful exercise.<sup>232</sup>

Objections of this kind to the Copyright Act’s current deposit requirements are further amplified by the fact that the Library of Congress is not required to add materials deposited under Section 408 to its collections and can even be destroyed in accordance with Section 704, as discussed in more detail in the next subsection.

### iii. Section 704: Deposit and Destroy

Whether copies of works are submitted to the Copyright Office in accordance with Section 407 or Section 408, the Copyright Act makes clear that all materials deposited become the property of the United States, even those works for which copyright registration is denied.<sup>233</sup> Nonetheless, despite the contention such materials are critical to the continued expansion of the Library of Congress’ holdings, there is no requirement the works actually be added to any of the Library’s collections.<sup>234</sup> This is due to the fact that Section 704 of the Copyright Act provides the Library of Congress with the authority to decide which materials it wants to include in, or alternatively exclude from, its collections.<sup>235</sup>

Deposits rejected by the Library of Congress are placed in government storage facilities or otherwise retained under the control of the Copyright Office.<sup>236</sup> Pursuant to Section 704, material deposited in connection with an unpublished work must be preserved for the full duration of its copyright term,

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231. *See supra* Section II.C. (reviewing the proposed Copyright Reform Act of 1993).

232. *Hearing on Copyright Reform Act, supra* note 79, at 181 (statement of Olan Mills, II, Chairman of the Board, Olan Mills, Inc.).

233. 17 U.S.C. § 704(a) (2018).

234. §§ 704(b), (d); *see also* NIMMER & NIMMER, *supra* note 98, § 7.17(A).

235. §§ 704(b), (d).

236. § 704(d).

while published works are to be held “for the longest period considered practicable and desirable.”<sup>237</sup> When the 1976 Copyright Act was initially passed, the Copyright Office did not have any stated limits on the length of time published works would be held under this statutory provision. However, in 1983, a new policy was issued by the Copyright Office and approved by the Librarian of Congress due to stated concerns regarding overall storage space limitations and its related statutory obligations to retain unpublished deposits for the term of the copyright.<sup>238</sup> Consequently, the revised retention schedule calls for maintaining published deposits for a period of only five years.<sup>239</sup> After this time not only is there is no further obligation to preserve these works, but the Register of Copyright or the Librarian of Congress can order the works to be discarded in accordance with Section 704(d).<sup>240</sup> Clearly, it is difficult to argue these deposit materials are vital to the continued expansion of the Library of Congress collections.

#### iv. Arguable Inequities Associated with “Library Building”

Despite the discussion above concerning the perceived or actual loss that could potentially occur through the repeal of Section 411(a), there still exists the fundamental question of whether it is even proper to tie the deposit requirement to the copyright registration process. This is especially true because registration with the accompanying deposit as part of the application is a mandatory step to the enforcement of one’s copyright in a given work at present. The statement of the Business Software Alliance submitted in connection with Senate hearings on the registration prerequisite reflects part of this debate:

Mandatory registration is not necessary or appropriate as a means of building the Library’s collections...There [is] a strong consensus that Library acquisitions policy should not drive copyright registration policy. In addition, the requirement that copyright registrants give up copies of their works to the Library without compensation constitutes a burden imposed on authors which is unrelated with the purpose of the copyright system as provided in Article I, Section 2 of the Constitution, to “promote progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries.”<sup>241</sup>

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237. *Id.*

238. Policy Statement on Deposit Retention Schedule, 48 Fed. Reg. 12,862 (Mar. 28, 1983); *see also* 139 CONG. REC. E337 (daily ed. Feb. 16, 1993) (statement of Rep. Hughes).

239. 48 Fed. Reg. 12, 862 (Mar. 28, 1983).

240. *Id.*

241. *Hearing on Copyright Reform Act, supra* note 79, at 178 (Statement of the Business Software Alliance).



Moreover, the Senate testimony of an individual artist further echoes and expands on these concerns:

As American creators, we wish, of course, to have the richest possible national library. But we see no reason to link the deposit of works in the Library of Congress with copyright enforcement. Our copyright law provides authors with an incentive to create by granting us exclusive rights to license our words. Our ability to enforce these rights, essential to making a living for us, should not be tied to the great and worthy good of creating and maintaining a great national library.<sup>242</sup>

There are no easy answers to the issue of how best to balance the responsibilities and burdens associated with building a strong Library of Congress. However, removing the Section 411(a) registration prerequisite would likely be a good start. By doing so, those who wish to take advantage of the benefits of registration could weigh the pros and cons of doing so with the related costs of providing the required deposit copies and paying the filing fee, not to mention the time connected with such endeavors. But the ability to enforce one's copyright in the federal court system would no longer be connected to registration of the work with the Copyright Office and the attendant costs of the application process. Additionally, such an approach would be more in line with the policies of other nations.<sup>243</sup> While some have suggested additional congressional appropriations to fund the purchase of materials for the Library of Congress,<sup>244</sup> this is unlikely to be a viable solution in light of the current economic and political situation in the United States.

### *B. Copyright Office as "Gatekeeper"*

Another principal argument in opposition to the repeal of Section 411(a) is the purported role it plays in preventing dubious copyright infringement claims from entering the courthouse. The following is representative of this line of reasoning:

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242. *Id.* at 49 (Statement of Erica Jong).

243. *Id.* at 73 (Statement of Irwin Karp, Committee for Literary Property Studies: "[N]o other nation in the world that has a copyright law, and many have brilliant and formidable national libraries, none of them coerce depositing by requiring registration as a condition for remedies. In fact, none of them have registration systems. We are the only people in the world that continue to impose these formalities."); *Id.* at 5 (Comments of Senator DeConcini: "The time has come for the Library to move in the direction of the legal deposit systems upon which the national library systems of most other countries are based.").

244. *See e.g., id.* at 4-5 (Comments of Senator DeConcini: "We therefore propose that first, Congress accept a comprehensive package of recommendations supporting deposit acquisitions for the Library and the copyright registration system. This package should be enacted as a whole and adequately funded and staffed if there are to be changes in the copyright registration system.").

In the past, some suits have been kept out of court by the necessity of filing for registration prior to institution of litigation and by the unwillingness of potential plaintiffs to bring suit under section 411(a) following a refusal to register because of the unfavorable light in which a judge might view the refusal to register and the undesirability of having the Copyright Office intervene in opposition. In a world without section 411(a), it is likely that a greater number of suits would be brought in Federal court. It certainly is no answer to permit the Copyright Office to intervene in such suits. The Office should not be forced into devoting (as would be the case) a substantial part of its limited resources to litigation.<sup>245</sup>

While at first glance such sentiments might appear to be compelling, further examination reveals a lack of evidentiary support for these claims. Studies show over the last several decades, the Copyright Office receives on average approximately 500,000 applications for registration each year<sup>246</sup> and typically registers between 98–99% of the works submitted for federal copyright registration.<sup>247</sup> Such statistics prompted one commentator to aptly state: “It makes little sense to delay all cases for the sake of the 1 percent.”<sup>248</sup>

Additionally, in light of the fact that each year only about 2000 copyright infringement lawsuits are filed, it is highly unlikely the elimination of the registration prerequisite would have any significant effect on court dockets.<sup>249</sup> In fact, data provided by the Copyright Office during a five-year period reveals that “a total of thirteen infringement actions were filed . . . by copyright claimants whose registration applications had been refused.”<sup>250</sup> This suggests the repeal of Section 411(a) would increase the number of infringement cases filed by only “two or three per annum.”<sup>251</sup> This hardly presupposes a reasonable likelihood of a “flood” of litigation.

Moreover, as indicated above,<sup>252</sup> Section 411(a) of the Copyright Act expressly allows an applicant to proceed with a copyright infringement action even after a refusal by the Register of Copyrights to register a work.<sup>253</sup> Consequently, the deterrent effect of Section 411(a) is exceptionally

245. H.R. REP. NO. 100-609, at 43 (1988).

246. *See e.g.*, UNITED STATES COPYRIGHT OFFICE, ANNUAL REPORTS, available at [https://www.copyright.gov/history/annual\\_reports.html](https://www.copyright.gov/history/annual_reports.html) [perma.cc/65XM-3BDN] (last visited May 9, 2020) (providing access to every annual report issued by the Copyright Office since 1866).

247. Brief of the United States at 4 n.2, *Reed Elsevier v. Muchnick*, 559 U.S. 154 (2010); *see also*, *NIMMER & NIMMER*, *supra* note 98, § 7.16.

248. *Id.* at § 7.16 n.196.

249. *Id.*

250. S. REP. NO. 100-352, at 21 (1988).

251. *Id.*

252. *See supra* Section II.A.

253. 17 U.S.C. § 411(a) (2018).

limited,<sup>254</sup> especially when the high registration rate and the small number of actual cases filed are taken into consideration. Add to the calculation the ability of courts to sanction plaintiffs who bring meritless claims, including in copyright infringement cases the award of a defendant's attorney's fees, and this further lessens the forcefulness of the argument Section 411(a) is necessary to prevent frivolous litigation.<sup>255</sup>

Nonetheless, one ostensible advantage of the current system is that prior to filing a copyright infringement suit on a work denied registration, the applicant is required to serve notice on the Register of Copyrights and provide a copy of the complaint.<sup>256</sup> Additionally, pursuant to Section 411(a) of the Copyright Act, the Register then has the "option [to] become a party to the action with respect to the issue of registrability of the copyright claim by entering an appearance within sixty days after such service."<sup>257</sup> If litigants were allowed to proceed without first registering their work, the Register of Copyrights would not be apprised of an infringement suit in a manner similar to rejected applicants under the current law. Although this would only affect the exceptionally small percentage of works the Register has historically refused to register, it may appear to be a potentially valid concern. However, Section 508 of the Copyright Act ensures the Register of Copyrights will still be apprised of the suit.<sup>258</sup> The provision requires clerks of the courts of the United States to send "[w]ithin one month after the filing of any action under this title . . . the names and addresses of the parties and the title, author, and registration number of each work involved in the action."<sup>259</sup> Alternatively, in the unlikely event that reliance on Section 508 proved to be onerous or inadequate, the issue could be easily resolved by requiring any party filing a copyright infringement without the benefit of a copyright registration to serve notice on the Register of Copyrights in the manner currently required under Section 411(a) for applicants denied registration.

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254. 139 CONG. REC. E337 (daily ed. Feb. 16, 1993) (statement of Rep. Hughes) ("[I]t is argued that section 411(a) weeds out frivolous claims. The problem with this argument is that section 411(a) permits claimants to file suit after a rejection. Thus, at most, section 411(a) deters only the assertion of frivolous claims by those who are not sufficiently determined to bring suit after a rejection.").

255. *Hearing on Copyright Reform Act*, *supra* note 79, at 116 (prepared statement of Paul Batista, Executive Director of the Graphic Artists Guild, Inc.) ("There is no merit to the suggestion that repeal of [Section 411(a)] will lead to an increase in frivolous or harassing litigation. No small business person can risk valuable time and resources pursuing a meritless infringement claim . . . . Furthermore, any plaintiff asserting a frivolous or harassing claim in court would face the prospect of paying the defendant's attorney's fees under Section 505. The courts have the power and discretion to protect defendants from meritless claims, and they have not hesitated to use that authority to sanction copyright plaintiffs where appropriate in the past.").

256. 17 U.S.C. § 411(a) (2018); *see also supra* Section II.A. discussing the addition of this portion of the provision.

257. § 411(a).

258. § 508.

259. *Id.*; *see also, e.g.*, S. REP. NO. 100-352, at 25 n.7 (1988).

Aside from keeping out baseless claims and ensuring the Register of Copyrights receives notice of pending copyright infringement cases, proponents of Section 411(a) often argue the registration prerequisite also streamlines the litigation process itself. For example, former Register of Copyrights Ralph Oman has stated that “the requirement of registration as a precondition of an infringement suit simplifies and expedites litigation . . . [and] its elimination will be burdensome to the federal courts.”<sup>260</sup> However, the strength of this position is dramatically lessened by changes to copyright law that have occurred over time.<sup>261</sup> Modifications such as “the repeal of mandatory formalities and the expansion of copyrightable subject” have largely eradicated the force of any arguable screening function provided by the Copyright Office.<sup>262</sup>

Furthermore, “Review of judicial opinions in infringement cases suggests that courts largely make independent evaluations of issues of fact and copyright validity rather than relying on certificates of registration.”<sup>263</sup> In many ways, this is not very surprising as Congress vested the federal courts with the power to enforce copyright law, not the Copyright Office.<sup>264</sup> As the Ninth Circuit aptly stated, “the Register’s decision of whether or not to grant a registration certificate is largely perfunctory”<sup>265</sup> as the Register’s review is limited to only determining whether “the material deposited is ‘copyrightable subject matter’ and that the legal and formal requirements of the Copyright Act are met.”<sup>266</sup> Although a timely registration certificate provides prima facie evidence of the validity of copyrightability and the facts contained therein,<sup>267</sup> it is ultimately the role of the courts to determine these issues.<sup>268</sup>

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260. S. REP. NO. 100-352, at 23 (1988).

261. *Hearing on Copyright Reform Act*, *supra* note 79, at 30.

262. *Id.*

263. *Id.*

264. *See e.g.*, S. REP. NO. 100-352, at 24 (1988) (“[I]t is the courts, not the Copyright Office, that interpret and apply the copyright law to disputes arising from alleged infringements. While Congress could have chosen to give the Copyright Office the power to conduct administrative proceedings to decide such disputes, it has never done so. Rather, it has assigned that role to the courts, in adversary proceedings in which one party shoulders the burden of proving his entitlement to relief.”).

265. *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 621 (9th Cir. 2010).

266. *Id.* at 621 n.13 (“After the Register’s determination, the courts are empowered to review any denial of a certificate, and approval by the Register gives an applicant only prima facie evidence of copyright, leaving the courts to make the ultimate determination in either instance.”).

267. 17 U.S.C § 410(c) (2018); *see also supra* Section IV.A.1.i (discussing prima facie validity).

268. *See e.g.*, *NIMMER & NIMMER*, *supra* note 98, § 12.11(B)(3) (“Some courts, even in infringement cases, although typically not expressing themselves in such language, apparently defer to Copyright Office determinations of copyrightability through issuance of a registration certificate. A few expressly take the determination into their own hands. The most common pattern, however, is for courts adjudicating

Moreover, courts are in no way constrained by the earlier determinations of the Copyright Office's decision to approve or deny registration of the work in question.<sup>269</sup> Consequently, the repeal of Section 411(a)'s registration requirement is not only unlikely to create additional burdens on the court system, but it would also have little to no impact on judicial practices in copyright infringement actions.

### *C. Independent Justifications for the Elimination of Section 411(a)'s Registration Requirement*

Aside from the numerous deficiencies in the claims advanced by proponents of Section 411(a) examined above, there are a few additional rationales for repealing the prerequisite of federal copyright registration prior to bringing a copyright infringement suit. First, dispensing with this portion of Section 411(a) would allow individuals and entities to seek relief for copyright infringement more expediently. This is particularly important considering the continual technological advancements that have made the reproduction and distribution of copyrighted works less costly and much easier. Second, the prerequisite is incongruent with the goal of global harmonization, which has repeatedly been the motivation for so many of the changes to domestic copyright law over the years. Moreover, the dual treatment of U.S. and foreign works is also internally inconsistent and similarly untenable. Maintaining a registration prerequisite for owners of U.S. works conflicts with the general movement toward harmonization as the United States essentially stands alone on this requirement. Third, Section 411(a) creates a peculiar inconsistency between copyright and trademark law, which is arguably problematic due to the overlap between these two areas of law and the frequency with which a single complaint includes claims for both types of infringement.

#### 1. Copyright Enforcement

Long gone are the days when an actual, tangible book needs to be obtained and each page individually photocopied to reproduce the work, a floppy disk acquired to download and duplicate a computer program, or a CD attained to replicate an album. Instead, a perfect copy can be made quickly

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infringement actions simply to reach their own determinations, without advertising either to the agency's general level of expertise or to the Copyright Office's particular determination via its issuance (or denial) of a certificate." (citing *I.C. ex rel. Solovsky v. Delta Galil USA*, 135 F. Supp. 3d 196, 213 (S.D.N.Y. 2015)).

269. *See e.g.*, S. REP. NO. 100-352, at 24 (1988) ("[U]nder current law, the courts are already required to undertake an independent determination of copyrightability. Courts can – and do – decide that, despite the issuance of a registration certificate, the plaintiff is not entitled to claim the protection of the copyright laws, just as they can – and do – decide that the Office's refusal to issue a registration certificate does not foreclose the plaintiff from proving that the work is copyrightable.").

and easily disseminated around the world almost instantaneously. Additionally, widespread reproductions of copyrighted works can often be completed on a large-scale at very little cost as a result of extensive technological advancements. Consequently, expeditious access to the courts to remedy infringements has become essential.

One of the benefits and leading rationales for many courts that adopted the application approach<sup>270</sup> was that it avoided “unnecessary delay in copyright infringement litigation, which could permit an infringing party to continue to profit from its wrongful acts.”<sup>271</sup> As a result of the Supreme Court’s decision in *Fourth Estate*, copyright owners that may not have registered their work prior to the acts of infringement<sup>272</sup> are once again thrown into a “legal limbo” in which they have copyright protection but no means to timely enforce such rights.<sup>273</sup> As even the Supreme Court noted in its *Fourth Estate* decision, the registration process is far from prompt. The Court observed that while copyright registration processing times used to be from one to two weeks in the 1950s,<sup>274</sup> today it takes on average seven months.<sup>275</sup> As such, the Court acknowledged the “statutory scheme has not worked as Congress likely envisioned.”<sup>276</sup> The Court also noted these delays were largely attributable “to staffing and budgetary shortages” that Congress cannot cure.<sup>277</sup> Nevertheless, while the Court described the situation as “unfortunate,” it also held this “factor does not allow us to revise § 411(a)’s congressionally composed text.”<sup>278</sup>

The Court provided a somewhat conciliatory suggestion, namely utilizing the Copyright Office’s expedited claims service.<sup>279</sup> In circumstances such as pending or prospective litigation, the Copyright Office does allow copyright claimants to request special handling that typically provides a very quick turnaround, usually no more than five working days.<sup>280</sup> Unfortunately, the option of expediting an application is not a real solution to the problem, as it comes at a prohibitively high price for many – an additional \$800 fee per

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270. See *supra* Section III.A (examining the application approach in detail).

271. *Cosmetic Ideas Inc.*, 606 F.3d at 619.

272. See *supra* Section II.C (discussing some of the practical and financial impediments to copyright registration).

273. See *Cosmetic Ideas*, 606 F.3d at 620 (“The application approach avoids this legal limbo – and avoids prolonging the period of infringement – by allowing a litigant to proceed with an infringement suit as soon as he has taken all of the necessary steps to register the copyright at issue.”).

274. *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881, 886 (2019).

275. *Id.*

276. *Id.* at 892.

277. *Id.*

278. *Id.*

279. *Id.* at 892 n.6.

280. *Id.*

work;<sup>281</sup> plus there is no guarantee the application will be processed in such an accelerated manner. One commentator appropriately characterized this “alternative” as follows:

[F]ew copyright claimants are aware of the expedited procedure; the procedure itself is costly; and, even if pursued, the expedited procedure does not ensure the prompt issuance or denial of a certificate if the Copyright Office chooses to engage in protracted correspondence with the applicant before definitively accepting or rejecting the application.<sup>282</sup>

Furthermore, the expedited process doesn’t solve the more fundamental problem faced by all copyright owners of domestic works, namely an inability to obtain prompt and equal access to the federal court system, especially when preliminary relief may be warranted.

Section 502 of the Copyright Act provides for “temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright.”<sup>283</sup> Such relief may be particularly important in clear cases of piracy or situations where it might be especially difficult to ascertain the full extent of copying, thereby making it all but impossible to determine an appropriate monetary damage award.<sup>284</sup> Moreover, in some instances, an injunction is even more valuable to a copyright owner than any sort of financial remuneration for losses incurred from the infringement.<sup>285</sup> This is attributable to the fact that “[t]he exigencies of copyright litigation often require the immediate issuance of a temporary restraining order, followed by a temporary injunction, upon the discovery of an infringing copy.”<sup>286</sup> Of course, injunctive relief is not appropriate in every copyright infringement case. It is exceptionally important that other factors be considered, most notably the potential existence of fair use, the possible conflict with the First Amendment, and the impact on the public domain.<sup>287</sup> Nonetheless, “Issuance of injunctive relief is a long-standing remedy in U.S.

281. *Id.*

282. See *Hearing on Copyright Reform Act*, *supra* note 79, at 185 (Draft Working Paper of Paul L. Goldstein, Professor, Stanford Law School).

283. 17 U.S.C. § 502 (2018).

284. See Pamela Samuelson & Members of the CPP, *The Copyright Principles Project: Directions for Reform* 25 BERKELEY TECH. L.J. 1175, 1223–24 (2010).

285. See *e.g.*, *La Resolana Architects v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1199–1200 (Stating that in terms of remedies available under the Copyright Act, “perhaps most important, a registrant can obtain an injunction against an infringer.”).

286. See *Hearing on Copyright Reform Act*, *supra* note 79, at 185 (Draft Working Paper of Paul L. Goldstein, Professor, Stanford Law School).

287. See Samuelson et al., *supra* note 284, at 1223–24; NIMMER & NIMMER, *supra* note 98, § 14.06(A)(1)(c); Richard Dannay, *Copyright Injunctions and Fair Use: Enter eBay – Four-Factor Fatigue or Four-Factor Freedom*, 55 J. COPYRIGHT SOC’Y U.S.A. 449, 460 (2008).

copyright law, and that is as it should be.”<sup>288</sup> But for U.S. copyright owners that discover their work has been infringed prior to registration, they cannot immediately gain access to the courthouse due to the registration prerequisite. Furthermore, absent repeal of Section 411(a)’s stipulation, the attendant wait associated with the registration process and the inability to obtain a preliminary injunction may make it impossible to achieve fair remuneration for the harms suffered, as “justice delayed will often mean justice denied.”<sup>289</sup>

## 2. Inconsistencies: Inside and Out

As previously discussed,<sup>290</sup> in order to become a member of the Berne Convention, the United States was required to amend its copyright laws to remove all prohibited formalities against nationals from other Berne Convention member nations, including Section 411(a)’s registration prerequisite. However, due to a peculiarity of the Berne Convention,<sup>291</sup> there is no such requirement that U.S. nationals be treated as favorably.<sup>292</sup> Consequently, while an owner of a foreign work can bring a copyright infringement suit immediately, an owner of a U.S. work must not only apply for federal registration but, following the *Fourth Estate* case, must actually wait until the Copyright Office has determined whether or not the work is entitled to registration. At the time, Congress could have removed the precondition of registration for all copyright owners but ultimately decided against this course of action.

As such, owners of U.S. works shoulder the burdens and harms associated with Section 411(a)’s requirement. Perhaps not surprisingly, this bifurcated approach has been described as “demoralizing” and “discriminatory.”<sup>293</sup> Moreover, this incongruous differentiation between domestic and international works may put U.S. copyright owners at a

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288. Samuelson et al., *supra* note 284, at 1223.

289. See *Hearing on Copyright Reform Act*, *supra* note 64, at 185 (Draft Working Paper of Paul L. Goldstein, Professor, Stanford Law School).

290. See *supra* Section II.B. (Berne Convention Implementation Act of 1988); see also *supra* Section II.C. (Copyright Reform Act of 1993).

291. See e.g., NIMMER & NIMMER, *supra* note 98, §17.01 (B)(1)(a) (“[T]he Convention does not purport to govern the scope of formalities that a country may place on its own nationals to secure copyright protection.”) (citing Berne Convention (Paris text), art. 5(1) (“Authors shall enjoy . . . in countries of the Union other than the country of origin . . .”).

292. See *Hearing on Copyright Reform Act*, *supra* note 79, at 186–87 (Draft Working Paper of Paul L. Goldstein, Professor, Stanford Law School); *id.* at 30 (Report of Co-Chairs Barbara Ringer and Robert Wedgeworth, Library of Congress Advisory Committee on Copyright Registration and Deposit).

293. *Hearing on Copyright Reform Act*, *supra* note 79, at 176, 187 (Draft Working Paper of Paul L. Goldstein, Professor, Stanford Law School).



competitive disadvantage<sup>294</sup> without any “real countervailing benefits to the United States copyright system.”<sup>295</sup>

The dual standard is particularly untenable given the purposeful movement of U.S. copyright law toward increasing international harmonization over the past fifty years. For example, many of the revisions made as part of the 1976 Copyright Act<sup>296</sup> and the Berne Convention Implementation Act of 1988<sup>297</sup> were designed to position “American copyright law on a footing similar to most other countries, especially in the industrial world” and as a result “our domestic law as well as the international legal system [would be] improved.”<sup>298</sup> Relatedly, in 1998, the Sonny Bono Copyright Term Extension Act (“CTEA”) was enacted, which, among other things, extended the duration of copyright protection in the United States by twenty years.<sup>299</sup> As a result, a work created today by an individual artist is granted a copyright term of the life of the author plus seventy years, as opposed to the previous length of life of the author plus fifty years.<sup>300</sup> Proponents of the CTEA greatly emphasized the need to harmonize U.S. law with a similar change made in the European Union a few years earlier.<sup>301</sup>

It is worth noting the requirement of registration prior to instituting suit cannot be attributed to harmonization as it was atypical of other countries’ copyright laws prior to the enactment of the Copyright Act of 1976 and continues to be so today. Elimination of the registration requirement for all is therefore necessary to equalize the current imbalance in the treatment of U.S. copyright owners. Such a change would also result in the United States finally becoming aligned with international law on this issue. Consequently, the United States would no longer stand out as an anomaly, something domestic copyright law has ostensibly tried to avoid over the last five decades.

### 3. Intersection Between Trademarks and Copyrights

While copyright law and trademark law are distinct areas of intellectual property law, there is a significant overlap between the two. Unlike patent law which requires a determination by the United States Patent and Trademark

294. *Id.* at 176 (Statement of the Business Software Alliance).

295. *Id.* at 185 (Draft Working Paper of Paul L. Goldstein, Professor, Stanford Law School).

296. *See supra* Section II.A (Promulgating Section 411(a) of the 1976 Copyright Act).

297. *See supra* Section II.B (Berne Convention Implementation Act of 1988).

298. H.R. REP. NO. 100-609, at 7 (1988).

299. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified in scattered sections of 17 U.S.C.).

300. 17 U.S.C. § 302 (2018) (“Duration of copyright: Works created on or after January 1, 1978”).

301. Council of the European Communities, *Council Directive 93/98/EEC of 29 October 1993 Harmonizing the Term of Copyright and Certain Related Rights*, (1993) <https://eur-lex.europa.eu/eli/dir/1993/98/oj> [perma.cc/77UB-9E7C].

Office (“USPTO”) that the property is protectable prior to a grant of rights,<sup>302</sup> copyright law and trademark law do not require such a determination. A trademark is potentially protectable once it is used in commerce in connection with the sale of the goods or services.<sup>303</sup> Although there are clear benefits from federal trademark registration, it is by no means required. As such, if a trademark owner discovers the mark has been infringed, a trademark infringement claim can be filed immediately in federal court.<sup>304</sup> In other words, there is no need to wait for the USPTO to pass on the sufficiency and protectability of the mark at issue prior to instituting a lawsuit.

Furthermore, as the U.S. Supreme Court has made clear, the mere fact that a work is protectable under one area of intellectual property law does not preclude protection under another area.<sup>305</sup> It is not uncommon, “especially with respect to logos,” for a “given work to be protected by independent copyright and trademark rights.”<sup>306</sup> However, if the work has not been previously registered under copyright law, the owner can only proceed with the trademark claim. Consequently, even if it would have been otherwise warranted, the delay will likely result in a “forfeit[ure of] the right to an immediate temporary restraining order or preliminary injunctive relief” on the copyright claim.<sup>307</sup> While this predicament may not be a sufficient reason to amend Section 411(a) of the Copyright Act, it is yet another example of the many shortcomings associated with the registration prerequisite.

#### *D. Formalities: Back to the Future*

Despite the historic shift away from formalities as a result of the global harmonization of copyright law generally and U.S. movement toward accession to membership in the Berne Convention specifically, there has been a contemporary push for their reintroduction. While a comprehensive review of the academic literature advocating for the reestablishment of various types of copyright formalities and rationales for their use is beyond the scope of this

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302. See 35 U.S.C. §§ 101, et seq. (2018) (“Inventions patentable”).

303. See 15 U.S.C. § 1125 (2018) (“False designation of origin, false descriptions, and dilution forbidden”).

304. *Id.*

305. See *e.g.*, *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (“We do hold that the patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art. Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted.”); see also INT’L TRADEMARK ASS’N, *Board Resolutions: Copyright Registration as a Precondition of Infringement Suit*, <https://www.inta.org/Advocacy/Pages/BR20171107.aspx> [perma.cc/G9HA-NVD5] (last accessed June 12, 2019) (citing 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 6.5 (4th ed. 2016) (“The courts have generally held that patent, trademark and copyright are separate and independent forms of protection. As a general principle, the presence or absence of one does not automatically preclude protection under another.”)).

306. INT’L TRADEMARK ASS’N, *supra* note 305.

307. *Id.*

Article, an examination of the primary arguments put forth for a renewed emphasis on the requirement of registration is particularly relevant. Although many of the concerns raised are valid, conditioning copyright rights on registration, at least in its current form, is imprudent.

Much of the ardor for the return of formalities, especially the requirement of registration, is due in large part to the significant increase in both the breadth and length of copyright rights which is heightened by the earlier shift in copyright law to an “automatic protection regime.”<sup>308</sup> As one scholar noted, “[c]opyright has historically been a limited right. Yet today these limits have expanded to an unprecedented scope.”<sup>309</sup> Relatedly, a report issued by the Copyright Principles Project (“CPP”), a group made up of law professors and lawyers from both private practices and within the copyright industry, maintained that “the duration of copyright nowadays is longer than is needed to achieve the normative goals of a good copyright regime” and “[t]he switch to a life-plus-years model and the twenty-year extension have contributed” to a number of growing problems.<sup>310</sup>

Among the cited complications engendered by these changes is the issue of so-called “orphan works.” As the CPP report explained, “those wishing to license older works often cannot locate the rights holders even after a reasonably diligent search” which “inhibits appropriate reuses of older works that may be important to preserve as part of our cultural heritage.”<sup>311</sup> Similarly, even for modern works, “there is no simple way to distinguish between those works whose authors care about copyright protection and those who do not” as rights attach for all copyrightable works immediately upon creation.<sup>312</sup> As a result of these developments, scholars have understandably raised concerns about the imbalance this has produced between the public interest and the rights of copyright owners. In doing so, many have also credited formalities with previously preventing or at least lessening such harms arising from current copyright policy.<sup>313</sup>

For instance, as one commentator observed, “[f]or nearly two centuries, U.S. copyright law relied on statutory formalities,” including filing a registration with the government, in an attempt to create balance.<sup>314</sup> The CPP report similarly noted that registration “made it relatively simple for persons who were interested in licensing certain uses of protected works to check the central registry for contact information about the copyright owners.”<sup>315</sup>

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308. Samuelson et al., *supra* note 284, at 1186.

309. Reid, *supra* note 18, at 427.

310. Samuelson et al., *supra* note 284, at 1185.

311. *Id.*

312. *Id.* at 1198.

313. Reid, *supra* note 18, at 427; *see also, e.g.*, Samuelson et al., *supra* note 284, at 1185–87; Carroll, *supra* note 18, at 1511; Daniel Gervais & Dashiell Renaud, *The Future of United States Copyright Formalities: Why We Should Prioritize Recordation, and How To Do It*, 28 BERKELEY TECH. L.J. 1459 (2013).

314. Reid, *supra* note 18, at 427.

315. Samuelson et al., *supra* note 284, at 1186.

Additionally, the CPP report cautioned that as a result of this “deformalization,” potentially beneficial reuses of many copyrighted works are inhibited.<sup>316</sup> Consequently, the CPP report proffered “a more robust registration system” and a “‘reformatizing’ [of] copyright law.”<sup>317</sup>

While none of the various proposals to “re-incentivize” registration suggested a return to the strict rules of the past which could easily lead to a work falling into the public domain for even a minor error or omission, all of them included the loss of certain rights or provided additional defenses to the alleged infringer for failing to register the work at issue.<sup>318</sup> For example, the CPP report suggested that infringement could “be found for copying of non-literal elements of registered works but not for such copying as to unregistered works.”<sup>319</sup> Relatedly, “[r]egistered rights holders might also be able to sue to stop certain non-commercial exploitations of a work likely to have market impairing effects,”<sup>320</sup> while unregistered works would only be protected from “exact or near-exact that would cause commercial harm.”<sup>321</sup> Furthermore, fair uses could be defined differently as between registered and unregistered works, with the latter more broadly construed.<sup>322</sup> Other scholars have suggested alternative approaches, including allowing users of an unregistered work “to rely on an innocent infringer defense when facing a claim for infringement.”<sup>323</sup>

Although the goal of ensuring there are “reasonable ways for the public to get information about who owns which rights in which works and whether works are or are not available for use or are in the public domain,”<sup>324</sup> is both a laudable and imperative objective, achieving it through the formality of federal registration and a threat of limited enforcement is problematic. As earlier discussed in great detail, there are numerous barriers to registration in its current form, especially for individual artists or smaller entities. One scholar fittingly described the effect of such formalities as “shield[ing] large copyright owners who routinely comply with formalities from the infringement claims of smaller copyright owners, particularly individual authors, who may lack the information or resources systematically to register and deposit their works.”<sup>325</sup> Additionally, for those creating numerous works in a short period of time, the ability to identify which ones could be commercially successful and warrant a copyright registration prior to infringement is virtually impossible to predict. While at some point in the future we might have the ability to simply and quickly federally register a

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316. *Id.* at 1198.

317. *Id.*

318. *Id.*

319. *Id.* at 1201.

320. *Id.*

321. *Id.* at 1200.

322. *Id.*

323. Reid, *supra* note 18, at 428.

324. Samuelson et al., *supra* note 284, at 1186.

325. Ginsburg, *supra* note 18, at 314.

copyrightable work, or alternatively place all relevant information about it in a publicly accessible database, we are unfortunately not quite there yet.<sup>326</sup> In the meantime, the use of such copyright registration formalities should at least for now remain a thing of the past.

## V. CONCLUSION

The U.S. Supreme Court's decision in *Fourth Estate Public Benefit Corporation v. Wall-Street.com, LLC* goes beyond merely settling the split among U.S. Courts of Appeals regarding the definition of registration for purposes of satisfying Section 411(a)'s precondition. Instead, it should serve as a clarion call for a much-needed amendment to the Copyright Act. By repealing the provision's registration prerequisite, a U.S. copyright owner of an unregistered works will no longer be left with a right without a remedy.

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326. See e.g., Carroll, *supra* note 18, at 1522 (2013) ("Digital technologies offer opportunities to make affixing notice to a work or registering an author's claim to copyright in a database trivially easy in places with ready computer and Internet access.").